CIPO Releases a Revised Chapter 16 of the MOPOP Relating to Computer-implemented Inventions

By Dr. Kay Palmer

The Canadian Intellectual Property Office (CIPO) released a revised Chapter 16 of the Manual of Patent Office Practice (MOPOP) relating to computer-implemented inventions on October 1, 2010. This chapter outlines the examination practices of the CIPO with respect to computer-implemented inventions and attempts to clarify the teachings of other chapters of MOPOP, in particular Chapters 12 (relating to Utility and Subject Matter) and 13 (relating to Examination of Applications), with respect to computer-implemented inventions specifically. It is important to remember, however, that MOPOP is based on the CIPO's interpretation of the Patent Act, Patent Rules and jurisprudence available prior to the release date of the chapter.

Patent Applicants in Canada should at the same time be aware that there is outstanding litigation in Canada relating to statutory subject matter. Resolution of this litigation should provide further clarity to Applicants in Canada and impact CIPO's current practices with respect to statutory subject matter. Specifically, the Canadian Patent Appeal Board's ("PAB") decision regarding Amazon.com 1-Click, is currently under appeal to the Federal Court. The PAB decision was, and continues to be, fairly controversial, having led to, among other things, the CIPO's newly articulated practice of considering the "form and substance" of a claim to determine if the claim is patentable. In particular, if the "substance" of the claim does not relate to a "field of technology", the claim is not directed to statutory subject matter regardless of the form of the claim. For example, in a claim to an apparatus comprising a general-purpose computer configured to perform a method, a Patent Examiner may argue that all of the parts of the computer are known or obvious and hence that the only new possible contribution is in the method. If the method is non-statutory (e.g. business methods are currently considered non-statutory by the CIPO), the claim as a whole would be rejected. The implementation by the CIPO of this new practice with respect to computer-implemented inventions can be seen in revised Chapter 16 of the MOPOP.

Given the issues pending before the Federal Court, Applicants seeking protection for computer implemented inventions should try to avoid looking solely to current CIPO practice as the deciding factor about whether to file a patent application into Canada. Moreover, Applicants should consider this outstanding litigation when developing a prosecution strategy for currently pending Canadian applications and how the Federal Court may clarify the law as grounded in Canadian jurisprudence. One of the challenges with the PAB decision regarding the Amazon.com 1-Click application, is the manner in which legal practice in the US and Europe was relied upon notwithstanding the differences in law between these jurisdictions and with the law in Canada.