

Commissioner's Decision #1411  
Décision du commissaire n° 1411

TOPIC/SUJET:  
J60 (Printed Matter/Imprimés)

Application No.: 2,761,560  
Demande n°.: 2,761,560

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,761,560 having been rejected under subsection 30(3) of the *Patent Rules*, has been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Panel and the decision to refuse if the application is not amended as directed follow.

Agent for the Applicant:

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## INTRODUCTION

- [1] Patent application number 2,761,560, entitled “TOPICAL PAGE LAYOUT,” is owned by Target Brands, Inc. and stands rejected after the Applicant’s response to a Final Action did not overcome the rejection. A review of the rejected application has therefore been conducted by the Patent Appeal Board pursuant to paragraph 30(6)(c) of the *Patent Rules*. For the reasons set out below, our recommendation is that the Applicant be notified that the deletion of claims 1 – 8 and renumbering of claims 9 – 20 are necessary as claims 1 – 8 are directed to non-statutory subject matter.
- [2] The present application relates to “the presentation of product information on a webpage with a particular layout involving different regions and scrolling options;” see Final Action at page 2, para. 1. More specifically, the invention relates to an optimal layout comprising an upper graphic region, middle graphic region, and lower graphic regions. There are 20 claims on file in the application; claims 1-8 are directed to a method of transmitting a web page and claims 9-20 are directed to a computer system for a retail environment including a “widget bar” that includes “one or more user reviews from one or more socially networked users... and one or more aggregate customer reviews.”
- [3] In our view, claims 1-8 do not comply with section 2 of the *Patent Act* as they are directed to non-statutory subject matter. We recommend that the application be refused unless claims 1-8 are deleted from the specification and claims 9-20 are renumbered accordingly.

## APPLICATION HISTORY

- [4] On July 9<sup>th</sup>, 2014, the Examiner wrote a Final Action (FA) pursuant to subsection 30(4) of the *Patent Rules*, in which the Examiner maintained that claims 1 to 20 are directed to matter outside the categories of invention within section 2 of the *Patent Act*.

- [5] In a letter of response to the FA dated January 9th, 2015, the Applicant provided representations as to why, in its view, claims 1 to 20 constituted patentable subject-matter within the definition of “invention” in section 2 of the *Patent Act*.
- [6] As the Examiner considered the application not to comply with the *Patent Act*, pursuant to subsection 30(6) of the *Patent Rules* the application was forwarded to the Patent Appeal Board for review on April 2<sup>nd</sup>, 2015, along with an explanation outlined in a Summary of Reasons [“SOR”]. While the SOR maintained that claims 1-8 constituted non-statutory subject matter, it stated that claims 9-20 were now considered allowable.
- [7] In a letter dated June 30, 2015, (the “Acknowledgement Letter”) the Board forwarded the Applicant the SOR and offered the Applicant an opportunity to make further written submissions and/or attend an oral hearing.
- [8] The Applicant responded on September 30, 2015 (the “Response to the Acknowledgement Letter”), indicating, in relevant part, as follows:
- Applicant would be happy to remove the disputed claims 1 – 8 in the interest of obtaining allowance. The Manual of Patent Office Practice does not describe a process for proceeding in such circumstances, but Applicant assumes that it must be within the authority of the Patent Appeal Board to remand the case back to the Examiner so that the claims can be amended as required and the case proceed to allowance. Applicant would appreciate the Patent Appeal Board issuing a rule to this effect.
- [9] Although the Applicant does not, in the response to the SOR, argue the patentability of claims 1-8, the Response to the Acknowledgement Letter has the effect of confirming that the Applicant will not be making any further submissions in support of these claims if its application can proceed to allowance containing only claims 9 to 20.

[10] This Panel of the Board was formed to conduct a review of this application.

## **ISSUES**

[11] The only issue in this review is whether the claims are directed to statutory subject matter.

## **LEGAL PRINCIPLES**

### **Claim construction**

[12] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*Free World Trust*] essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings. (see also *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at paras 49(f) and (g) and 52.) In accordance with the *Manual of Patent Office Practice* [MOPOP], Chapter 13.05 *Examination of the claims using purposive construction* (June 2015), available at the CIPO website, the first step of purposive claim construction is to identify the person skilled in the art and their relevant common general knowledge (“CGK”). The next step is to identify the problem addressed by the inventors and the solution put forth in the application. Essential elements can then be identified as those required to achieve the disclosed solution as claimed.

### **Statutory subject matter**

[13] The definition of invention is set out in section 2 of the *Patent Act*:

“invention” means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

[14] Following the Federal Court of Appeal decision in *Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 [*Amazon FCA*], the Patent Office released two

Practice Notices (PN 2013-02 *Examination Practice Respecting Purposive Construction* and PN 2013-03 *Examination Practice Respecting Computer-Implemented Inventions*) that clarified the Patent Office's approach to claim construction and computer implemented inventions, respectively.

- [15] As stated in section 12.06.01 of MOPOP, “[w]here a claim includes a feature having a solely intellectual or aesthetic significance, and no statutory feature of the claim appears to form part of the contribution, the claim is objected to under section 2 of the *Patent Act* on the grounds that the feature having solely intellectual or aesthetic significance is not, of itself, a statutory invention.” The phrase “and no statutory feature of the claim appears to form part of the contribution” [emphasis added] reflects the former framework that is no longer followed by the Patent Office. As noted in PN 2013-03, “PN 2013-02 (Examination Practice Respecting Purposive Construction) mandates the use of purposive construction in place of other approaches to claim analysis. In particular, the ‘contribution approach’ ...is not to be used.” However, apart from its reference to the “contribution approach,” section 12.06.01 of MOPOP still reflects current Patent Office practice that features of solely intellectual or aesthetic significance are excluded from the definition of invention. Section 12.06.01 also clarifies that:

The expression “feature having a purely intellectual or aesthetic significance” applies to certain features that cannot, in a practical sense, affect the functioning of an invention. Such a feature therefore cannot change the manner in which the practical form of an invention operates to solve the problem for which it is the solution, and consequently can never be an essential element of a statutory invention.

- [16] One specific example of this principle is printed matter. In particular, section 12.06.04 of MOPOP provides as follows:

**12.06.04 Printed matter**

A very recognizable application of the principle set out in 12.06.01 is in respect of printed matter. Where printed matter does not provide a new functionality to the

substrate on which it is printed, there has not been a statutory contribution. For the printed matter and the substrate to be, together, a practical form of an invention, they must solve a practical problem related to the use of the printed matter in general, and not based on the solely intellectual or aesthetic content of the printed matter itself.

[17] Finally, this section of MOPOP clarifies that “[t]he term ‘printed matter’ should, in this sense, not be restricted to traditional ‘ink-on-paper’ printing. Any display of information wherein the sole contribution is in the information itself is not a statutory invention.”

[18] With the guidance of PN 2013-02 in mind, the essential elements of the claims as purposively construed are assessed for subject matter.

## **ANALYSIS**

### **Claims 1-8**

[19] Turning first to claims 1-8, the Examiner applied the current Patent Office practice and construed the claims. The Final Action states that the problem to be solved by the present application is “how to present relevant, or topical, information in an optimal layout.” The essential elements to solve this problem “relate to the presentation of product information with different regions in a tiled method.”

[20] The essential elements were found to relate to “presentations of information, defined by their intellectual meaning and appearance,” later adding “[t]he essential aspects of the claims relate only to the layout of information (ie. upper graphic region, middle graphic region, lower graphic regions);” see FA at page 2, paras. 5 and 6.

[21] In its response to the FA, the Applicant indicated that it “would be happy to remove the disputed claims 1-8 in the interest of obtaining allowance.”

[22] Having reviewed the prosecution, the Application, and principles set out above at paras. 12-18, the Panel agrees with the conclusions set out in the Final Action regarding claims 1-8 as they are directed to a form of non-functional printed matter (see paras. 16 and 17, above).

### **Claims 9-20 containing a widget bar**

[23] Looking to claims 9-20, the Final Action stated:

...it is clear from the specification that any particular technology or equipment involved in the serving of the website does not materially affect the provision of the proposed solution and thus is not essential to the invention... Claims are not automatically statutory for referring to the use of a computer system or other physical tool. The computers and network infrastructure may help form the context or environment for the actual invention, but are not part of that proposed improvement itself.

...

[scroll means, widget bar, etc.] ... relate to the layout (ie. presentation) of information. To the extent that any technical, functional components are involved this particular layout of information, these features are not essential to solve the problem. The essential aspects of the claims relate only to the layout of information (ie, upper graphic region, middle graphic region, lower graphic regions).

[24] In its response, the Applicant submitted the following:

...the remaining independent claim 9 recites many functional limitations such as a “vertical scroll means”... a “horizontal rotating carousel”... and a “widget bar”... Independent claim 9 also recites “socially networked” elements... A social network of course, comprises the physical infrastructure and functionality of such an information communication system. All of those are functional, technical elements which the Patent Office has always recognized as indicative of acceptable subject matter.

[25] The Examiner was persuaded by the Applicant's response, finding the widget bar to be statutory stating:

Upon further consideration, the examiner considers the widget bar of claim 9 and its claimed functionality as performed by the computer system an essential element to solve the problem that is stated in the final action. It is a mechanism for presenting relevant information that is statutory. Claims 9-20 are therefore considered allowable.

[26] Thus there is no disagreement between the Applicant and Examiner regarding claims 9-20.

[27] It is apparent from the SOR that the Applicant's response to the Final Action was sufficient to convince the Examiner that the presence of the widget bar rendered claims 9 to 20 patentable. We further note that if this conclusion was reached at an earlier stage in the prosecution (i.e. prior to issuing a Final Action under subsection 30(3) of the *Patent Rules*), the *Patent Rules* would have permitted the Applicant to delete claims 1-8, renumber claims 9-20, and the application in all likelihood would have been allowed. Given the facts in the present case and that the Panel agrees with the finding in the SOR that claims 1-8 are directed to non-statutory subject matter, as set out above, the Panel sees no reason to reach a different outcome. On this basis, the Panel has reasonable grounds to believe that claims 9-20 comply with the *Patent Act* and *Rules*.

## **Conclusion**

[28] On the basis of this review, the Panel is satisfied that the view set out in the SOR is appropriate in this case. In particular, and in view of the position taken by the Applicant in its Response to the Acknowledgement Letter, the Panel agrees with the Examiner that:

- claims 1 to 8 are directed to matter outside the categories of invention within section 2 of the *Patent Act*; and
- claims 9 to 20 comply with the *Patent Act* and *Rules*.

[29] It follows from this that the Panel is of the view that although the application, including claims 1 to 8, does not comply with the *Patent Act* or *Rules*, specific amendments are necessary to render the application allowable. These amendments in particular are to delete claims 1 to 8 currently on file and to re-number current claims 9 to 20 as claims 1 to 12 and adjust any relevant claim dependencies therein.

## RECOMMENDATION

[30] In view of the above, we recommend that the Applicant be notified, in accordance with subsection 30(6.3) of the *Patent Rules*, that a specific amendment, namely that claims 1-8 be deleted and claims 9-20 renumbered accordingly, is necessary for compliance with the *Patent Act* and *Patent Rules*.

Mark Couture  
Member

T. Nessim Abu-Zahra  
Member

Kristina Bodnar  
Member

## DECISION

[31] I concur with the findings and the recommendation of the Panel. In accordance with subsection 30(6.3) of the *Patent Rules*, I hereby notify the Applicant that the above amendments must be made within three (3) months of the date of this decision, failing which I intend to refuse the application.

[32] In accordance with paragraph 31(b) of the *Patent Rules*, the following amendments, and only these amendments, may be made to the application:

- i) delete claims 1 to 8 on file; and
- ii) renumber claims 9 to 20 as claims 1 to 12 and adjust claim dependencies accordingly.

Johanne Bélisle

Commissioner of Patents

Dated at Gatineau, Quebec,

this 14<sup>th</sup> day of October, 2016