

Commissioner's Decision #1469

Décision du commissaire #1469

TOPICS: J00 Meaning of Art
J60 Printed Matter
O00 Obviousness

SUJETS: J00 Signification de la technique
J60 Imprimés
O00 Évidence

Application No: 2,686,074

Demande no: 2 686 074

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,686,074, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423), has consequently been reviewed in accordance with paragraph 30(6)(c) of the *Patent Rules*. The recommendation of the Board and the decision of the Commissioner are to refuse the application.

Agent for the Applicant

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INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,686,074 (“the instant application”), which is entitled “IMPROVED COLOR SELECTION, COORDINATION AND PURCHASE SYSTEM” and is owned by BEHR PROCESS CORPORATION (“the Applicant”). A review of the rejected application has been conducted by the Patent Appeal Board (“the Board”) pursuant to paragraph 30(6)(c) of the *Patent Rules*. As explained in more detail below, our recommendation is that the Commissioner of Patents refuse the application.
- [2] This recommendation and Commissioner’s Decision are being released concurrently with the recommendation and Commissioner’s Decision for co-pending Canadian patent application number 2,685,815, owned by the same Applicant.

BACKGROUND

The Application

- [3] The instant application was filed in Canada on November 18, 2009 and was laid open to public inspection on January 22, 2011.
- [4] The instant application relates to a paint color selection system and method for displaying paint colors for selection by a user. A paint project image is displayed on a website, the image employing a plurality of colors, with the image containing at least one “hot spot” at a color location that provides an animated display feature to attract the attention of the user. Selection of the “hotspot” by a user causes the display of information related to the color area.

Prosecution History

- [5] On August 4, 2015, a Final Action (“FA”) was written pursuant to subsection 30(4) of the *Patent Rules*. The FA stated that the instant application is defective on the grounds that all of the claims 1-47 on file at the time of the FA (“claims on file”) encompass non-statutory subject-matter and therefore do not comply with section 2 of the *Patent Act* and that the claims on file would have been obvious and therefore do not comply with section 28.3 of the *Patent Act*. The FA also set out a defect in relation to the breadth of the claims in relation to the description under subsection 27(3) of the *Patent Act* and a defect under section 84 of the *Patent Rules*.
- [6] In a February 4, 2016 response to the FA (“R-FA”), the Applicant submitted proposed claims 1-46 (“proposed claims”) that incorporated the subject matter of claim 13 on file into the independent claims. Amendments were also proposed to address the defects under subsection 27(3) of the *Patent Act* and section 84 of the *Patent Rules*. Arguments in favor of the patentability of the claims were submitted as well.
- [7] As the Examiner considered the application not to comply with the *Patent Act* and *Patent Rules*, pursuant to paragraph 30(6)(c) of the *Patent Rules*, the application was forwarded to the Board for review on June 27, 2016 along with an explanation outlined in a Summary of Reasons (“SOR”). The SOR set out the position that the claims on file were still considered to be defective due to non-statutory subject-matter and obviousness. The SOR explained that the amendments proposed in the R-FA did not overcome these defects. The SOR indicated that the defects in relation to subsection 27(3) of the *Patent Act* and section 84 of the *Patent Rules* would be overcome by the amendments proposed in the R-FA to the description and the claims.
- [8] In a letter dated July 13, 2016, the Board forwarded to the Applicant a copy of the SOR and offered the Applicant an opportunity to make further submissions and/or attend an oral hearing.

[9] In a response to the SOR (“R-SOR”) dated November 2, 2017, the Applicant provided further written submissions and resubmitted the proposed claims included with the R-FA for consideration.

[10] The present panel (“the Panel”) was formed to review the instant application under paragraph 30(6)(c) of the *Patent Rules*.

[11] In a preliminary review letter (“PR letter”) dated February 23, 2018, the Panel set out its preliminary analysis of the statutory subject-matter and obviousness issues with respect to the claims on file as well as the proposed claims.

[12] The Applicant provided written submissions in response to the PR letter (“R-PR”) on March 29, 2018.

[13] An oral hearing was held on April 12, 2018 at which time the Applicant made oral submissions in relation to both the instant application and co-pending application no. 2,685,815.

ISSUES

[14] The issues to be addressed by the present review are whether:

- claims 1-47 on file are directed to statutory subject-matter; and
- claims 1-47 on file would have been obvious.

[15] If the claims on file are considered defective, we will turn to the proposed claims 1-46 and consider whether they constitute amendments necessary for compliance with the *Patent Act* and *Patent Rules*.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Claim Construction

- [16] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66, 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*, §13.05 (revised June 2015), 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

- [17] 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.

- [18] The Office examination memo PN 2013-03 entitled “*Examination Practice Respecting Computer-Implemented Inventions*” (“PN 2013-03”) clarifies examination practice with respect to the Office’s approach to computer implemented inventions.
- [19] As stated in *PN 2013-03*, Office practice considers that where a computer is found to be an essential element of a construed claim, the claimed subject-matter will generally be statutory. Where, on the other hand, it is determined that the essential elements of a construed claim are limited to matter excluded from the definition of invention (for example, fine arts, methods of medical treatment, features lacking in physicality, or claims

where the subject-matter is a mere idea, scheme, rule or set of rules), the claim will not be compliant with section 2 of the *Patent Act*.

Obviousness

[20] The *Patent Act* requires that the subject-matter of a claim not be obvious to a person skilled in the art. Section 28.3 of the *Patent Act* states:

28.3 The subject-matter defined by a claim in an application for a patent in Canada must be subject matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to

- (a) information disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant in such a manner that the information became available to the public in Canada or elsewhere; and
- (b) information disclosed before the claim date by a person not mentioned in paragraph (a) in such a manner that the information became available to the public in Canada or elsewhere.

[21] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 at paragraph 67 [*Sanofi*], the Supreme Court of Canada stated that it is useful in an obviousness inquiry to use the following four-step approach:

- (1) (a) Identify the notional “person skilled in the art”;
(b) Identify the relevant common general knowledge of that person;
- (2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
- (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed;

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

ANALYSIS

Claim Construction

[22] In the R-PR, the Applicant contends, as in the R-SOR, that the Panel applied the wrong principles in performing a construction of the claims. These points have already been addressed in the PR letter, in which the Panel explained that we have followed the claim construction approach set out in *MOPOP* §13.05.01.

The person skilled in the art

[23] In the PR letter, the person skilled in the art was characterized as a:

a team of persons comprising a color expert and computer programmers. These persons have a web design and multimedia programming background and have knowledge of computer programs, networks and servers, and of digital color management and of display of information. The team also includes marketing and paint sales professionals.

[24] The above characterization was not disputed by the Applicant in the R-PR. We apply it in our analysis below.

The relevant common general knowledge

[25] In the PR letter, the relevant CGK, as taken from the FA, was set out as including:

- Color display systems to assist consumers in selecting paint colors and automated computer or web-based color selection, coordination and/or purchase systems;

- The use of servers and networks, the display of webpages including the general use of pull-down menus and animation (such as the revolving hourglass known from Microsoft Windows 3.1, popular in the 1990s, and attention-drawing animation elements used in toddlers' computer games);
- Printed, hard-copy brochures displaying color family groups and images of interior designs used for decades to promote the sales of paint, and color chip in-store displays; and
- The selection of a particular color amongst a group or family of displayed colors and links to navigate between, at least, the color selection system and the purchase functions.

[26] We stated in the PR letter that:

To the above list of relevant points of CGK, the Panels adds the discussion in the Background portion of the instant application where the Applicant discloses that it was well known to provide color selection, coordination and purchase systems to consumers over the internet. The Applicant also discloses that it was well known to present webpages that allow for the presentation of text, graphics, audio and video media and other formats of data. Such webpages can also support "active content" that provides enhanced interaction with the delivered content in comparison with static content (text, graphics, audio or video).

[27] The Applicant did not dispute any of the points above in the R-PR and we consider them in our analysis below.

The problem to be solved

[28] In the PR letter, after considering the Applicant's submissions in the R-SOR, the Panel characterized the problem to be solved as one that:

relates to the desire to produce a more attractive product information webpage, one which will attract users and cause them to seek out further product information.

- [29] In the R-PR, the Applicant characterizes the problem as being “directed to providing computer display features that improve upon previous computer displays, by providing practical benefits, including the user’s attention being more effectively drawn to facilitate better colour selection, and the user being able to see colour sheen better to facilitate better sheen selection.” This characterization relates to the proposed claims that incorporate the color sheen selection tool and its functionality as set out in dependent claim 13 on file.
- [30] At the hearing, the Applicant focused on the same points noted above relating to the color sheen selection tool, rather than the animated hotspots that characterize the independent claims on file.
- [31] The Applicant contends in the R-PR that the Panel has not considered the problem addressed by claim 13 on file (where the features of the color sheen selection tool are specified) as part of the assessment.
- [32] However, in the PR letter, we set out our preliminary view that the application “describes the use of generic computer network system components in implementing the invention, such as multiple remote computers, load balancers, web servers, as well as known software elements for implementing the animation portion of the invention, such as an swf application that controls flash player animation on a user’s display” and that “the lack of detail regarding the implementation of ‘hotspots’ or animated features is taken to mean that the technical details necessary for implementation of such a feature is part of the relevant CGK of the skilled person. Otherwise, the specification of the instant application would be lacking sufficient information to enable the invention claimed and would be non-compliant with subsection 27(3) of the *Patent Act*.” In our view, based on the CGK and the lack of technical details relating to the animation features, the underlying functionality to provide for the animated features was already well-known. This view applies to the animated

features of the invention in general, including the hotspots and the color sheen selection tool of claim 13 on file.

[33] At the hearing the Applicant submitted that even assuming that the underlying functionality was CGK, nobody would have known that the color sheen would have been more effectively displayed using such functionality. However, in our view a person skilled in the art, aware of the animation functionality, would also have been aware of its inherent display enhancing properties. Therefore, we see no problem to be solved relating to the underlying functionality of the color sheen selection tool or relating to any display problems particular to the display of paint color sheens.

[34] In our view, the problem to be solved by claim 13 on file is not different from the problem to be solved by the invention as previously set out in the PR letter.

[35] In light of the above, it is our view that the problem to be solved by the proposed invention is as set out in the PR letter, noted above.

The solution

[36] In the PR letter, the solution provided by the instant application was characterized as the provision of:

a more attractive webpage layout, one which will be more effective in catching the consumer's attention and cause them to further explore the website content.

[37] In the R-PR, the Applicant contends that the "technical solution to a technical problem" includes the computer display features that provide for more effectively drawing a user's attention and provide for better display of colour sheen. However, in light of our view of the problem to be solved, the computer display features would not form part of the solution.

[38] In light of the above, in our view the solution of the proposed invention is as set out in the PR letter, noted above.

Essential Elements

[39] Claim 1 on file of the instant application is representative of the claims and is reproduced below:

1. A paint color selection apparatus comprising:
a website comprising one or more servers or computers for supplying data for generating a plurality of web pages, the web pages comprising:
a first page for display on a computer controlled display apparatus, the first page comprising a first project image employing a plurality of different colors, each color located in a respective region of said image;
at least one hot spot located in one of said regions, the hot spot comprising an attention-drawing animation feature; and
wherein a first selection operation performable on said hot spot causes display of at least one color name, said color name being that of the color of the region where said hot spot lies.

[40] In the PR letter, after reviewing the FA and subsequent prosecution, including the R-SOR, the Panel set out its preliminary view as to the essential elements of the claims on file:

In the preliminary analysis above, the Panel has followed the approach set out in *MOPOP §13.05.01* and has determined that neither the computer-related components nor the basic functionality itself, which provides for the claimed attention-drawing animation features, are part of the solution.

As such, it is our preliminary view that the essential elements of the independent claims on file comprise the particular arrangement and display of information presented by the more attractive webpage, including the display of a first project image employing a plurality of different colors, each color in a respective region of the image, and at least one of the regions containing an attention-drawing element related to more information about the color of the region.

It is also our preliminary view that the features of the dependent claims on file, including those relating to the color sheen selection tool, do not add any further essential features to those of the independent claims on file. Again, the computer components and functionality necessary to provide for the particular webpage display and content do not form part of the solution and therefore elements relating to these cannot be considered essential. As such, the further

features of the dependent claims also relate to the particular information displayed and its arrangement (e.g., the particular location of a hotspot, the particular animated content, paint product details, etc.).

[41] In the R-PR, the Applicant maintained, as was the case in the R-SOR, that the computer-related features of the claims are essential. The Applicant contends that because the problem and solution relate to the provision of a webpage, a computer must be an essential element of the claims. Otherwise the claims would be inoperable.

[42] However, the solution identified above focuses on the layout of a webpage and arrangement of its content, rather than on the fact that such content is displayed on a webpage. There were no problems to be solved in generating animated features such as hotspots or the movements associated with the colour sheen selection tool. As such, while a computer and the well-known functionality associated with it may define the context or the environment of the invention claimed, they do not change the nature of the solution to the problem (*MOPOP* §13.05.02c).

[43] In light of the above, in our view, the essential elements of the claims on file are those set out in the PR letter, namely “the particular arrangement and display of information presented by the more attractive webpage, including the display of a first project image employing a plurality of different colors, each color in a respective region of the image, and at least one of the regions containing an attention-drawing element related to more information about the color of the region.”

Statutory Subject-Matter

[44] In the PR letter, after reviewing the FA and the Applicant’s submissions in the R-SOR, which related to the criteria for patentability set out in *Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328, we stated that:

While we agree with the legal principles the Applicant has pointed to above, we note that in assessing an invention for statutory subject-matter, or any criteria of patentability, it is first necessary to perform a purposive construction of the

claims (*Whirlpool* at paragraph 43). After having performed a claim construction above, in accordance with the office practice set out in *MOPOP* §13.05, the Panel has arrived at the preliminary view that the claims on file are directed to the particular arrangement and display of information presented by the more attractive webpage, including the display of a first project image employing a plurality of different colors, each color in a respective region of the image, and at least one of the regions containing an attention-drawing element related to more information about the color of the region. Therefore the claims on file as construed contain no essential computer-related components or, in our view, anything that would manifest a discernable effect or change of character or condition in a physical object.

In our preliminary view, the claims on file as construed are therefore directed to the information on the webpage itself, which would only have some intellectual meaning and in that sense would be considered abstract.

- [45] In the R-PR, the Applicant submitted that “[c]reating any visible content – as the claimed apparatus does, even according to the Panel – produces a discernable effect. The effect is discernable visually, and also electronically, since a webpage is by definition electronically generated within a computer. This is true even if the computer is inessential to the claims, as the Panel asserts.”

- [46] At the hearing, the Applicant asserted similar points in relation to the color sheen selection tool of claim 13 on file, in particular that the color sheen selection tool and its enhanced display characteristics allow a user to see the color sheen more accurately in order to make a better paint color selection decision.

- [47] However, as set out in our analysis of the essential elements of the claims above, the claims on file as construed in accordance with the approach set out in *MOPOP* §13.05.01, are directed to the information on the webpage itself, not the underlying functionality that may cause a discernable effect or change of character or condition in a physical object. The information itself has only intellectual meaning and is considered to be abstract.

- [48] In light of the above, it is our view that claims 1-47 on file are directed to non-statutory subject-matter and therefore non-compliant with section 2 of the *Patent Act*.

Obviousness

(1)(a) Identify the notional “person skilled in the art”

[49] The person skilled in the art has been set out above under Claim Construction at paragraph [23].

(1)(b) Identify the relevant common general knowledge of that person

[50] The relevant CGK has also been identified above under Claim Construction at paragraphs [25]-[26].

(2) Identify the inventive concept of the claim in question or if that cannot readily be done, construe it

[51] In the PR letter, the Panel considered the essential elements of the claims identified under Claim Construction to be representative of the inventive concept of the claims as well:

In light of our identification of the essential elements of the claims above, we take this to be representative of the inventive concept of the claims as well.

To clarify, the inventive concept then becomes the particular arrangement and display of information presented by the more attractive webpage, including the display of a first project image employing a plurality of different colors, each color in a respective region of the image, and at least one of the regions containing an attention-drawing element related to more information about the color of the region.

[52] In the R-PR, the Applicant did not directly dispute the inventive concept identified in the PR letter, except in so far as the essential elements of the claims on file were disputed. The Panel applies below the inventive concept as identified in the PR letter.

(3) Identify what if any differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed

[53] In the PR letter, with respect to the state of the art, we stated that:

In the FA two pieces of prior art were applied, as set out below:

D6:	US 6572377	Masters	June 3, 2003
D7:	US 5737553	Bartok	April 7, 1998

After review of the prosecution, it is the Panel's preliminary view that a more relevant piece of prior art than D6 is one discussed in the instant application itself at paragraph [0071], namely:

D8:	US 2006/0195369A1	Webb et al.	August 31, 2006
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Below we discuss the teachings of D7 and D8.

D7 discloses an apparatus and method for mapping hotspot objects of arbitrary shape and size to selected portions of an image presentable on a display connected to a computer. Each pixel of a display is mapped to a color and each color to a definition of a functional object such as an application or executable statement. Hotspot objects (or "hotspots" as used in the instant application) may be created by a user and linked with a function to be performed upon selection of the hotspot object. A user may click or double-click a mouse button while a cursor is positioned over a hotspot object to launch a functional object mapped to a color which is within the hotspot object (D7 at col. 3, lines 27-35). After opening an object associated with a hotspot the user may be presented with an expansion object 94 that may represent further detail in relation to the hotspot object. An additional expansion object level may be further provided by double clicking on an expansion object 94 (D7 at col. 7, lines 16-23). The hotspot objects may be buttons, icons, boxes or the like. Examples of such hotspot objects are shown in Figure 2 of D7.

D8 discloses a color selection, coordination, purchase and delivery system for paints and decorative materials. The system comprises a webpage which may display a room scene as well as information related to color selection, item purchase, and information related to events or promotions. The webpage includes various tabs providing optional content such as "My Workbook", "Explore Color", "eStore", "Inspiration", "Expert Advice" and "Products" (D8 at paragraphs [0047]-[0048]). A user can select a specific color by name or browse through a selection of colors and choose matching colors. Users may click on a displayed image which produces an enlarged view of that image as well as an associated color palette (D8 at paragraph [0068]). Users may also click on buttons such as "view sample" and be provided with flash video content on using certain website functions (D8 at paragraph [0069]). Color sample order pages may include color sheen options as part of a "project type" option (D8 at paragraph [0074]). Navigating through color palettes is provided by a series of buttons allowing a user to move between colors and shades (D8 at paragraphs [0120]-[0126]). Screen changes may be accomplished by using animation. For example, color chips may slide to the bottom of a screen and reduce in size by activation of a Browse function (see e.g., D8 at paragraphs [0121], [0130], [0135], [0138] and [0147]).

[54] Given the inventive concept of the claims identified above, we expressed our preliminary view in the PR letter that the difference between the “state of the art”, as best represented by D8, and the inventive concept was the inventive concept itself.

[55] In the PR letter, we also noted an additional difference identified in the FA that we considered as well at *Sanofi* step 4:

The FA at page 6 identified the difference between the state of the art and the inventive concept as the provision of animated hotspots for identifying the color of a selected region. The Applicant also considered the provision of such hotspots and their function to provide color information as a difference with respect to the state of the art (R-SOR at paragraphs 105-106). For completeness, we will also consider this difference below at *Sanofi* step 4.

[56] In the R-PR, the Applicant did not dispute the above points. We consider them below at step 4.

(4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[57] In the PR letter, with respect to the difference identified by the Panel, we expressed our preliminary view that this difference would have been obvious to the person skilled in the art:

It is our preliminary view that variation in the particular arrangement and display of information on a webpage would have been obvious in view of D8 and D7 taken together. In our view, the arrangement and display of such information will naturally vary with the particular layout chosen by any given website designer. While the particular layout may involve some creativity on the part of the webpage designer, this is more akin to the creativity required to produce an industrial design rather than a change that would require the inventive ingenuity necessary to support a patent. Displaying certain colors in a certain arrangement or positioning a hotspot in a particular location depends on the precise implementation chosen by the designer, and many such options would have been self-evident to such a person, with the effects of any such choice self-evident as well.

[58] With respect to the difference identified in the FA, we stated:

With respect to the difference of the use of attention-drawing animated hotspots that when selected, display color-related information, it is our preliminary view that such a difference would also have been obvious in view of D8 and D7 taken together. D8 discloses a paint color exploration and selection webpage that provides the user with the ability to explore various paint color properties and arrangements as well as disclosing the use of animation in providing for a more visually attractive user experience. The selection of items in D8 and the subsequent execution of certain functions is equivalent to the hotspots of the instant application, the difference being simply the size of the area chosen to be linked with a particular function (e.g., the display of color information by clicking on an image as opposed to an area within the image).

In any case, D7 discloses a method of forming hotspots within an image and the provision of multiple selectable levels of information upon selection of the hotspot. As the use of such hotspots on a display was known from D7, in our view their use in a webpage design such as that of D8, given the known advantages of using such attention drawing elements from the CGK, would have been obvious. Further, although, as the Applicant asserts at paragraphs 108- 110 of the R-SOR, the hotspots in D7 are not “animated”, it was well-known from the relevant CGK to use such animated content to draw attention. The Applicant does not claim to have invented the animation functionality but merely a particular arrangement and display of it, which again, in our view would have varied with the particular webpage being created based on the desired content and effect on the user.

[59] In the R-PR, the Applicant focused the submissions on the features of the color sheen selection tool of claim 13 on file but stated that the same points apply to the attention-drawing animation hotspots of the claims on file. At the hearing, the Applicant focused on the color sheen selection tool as well. In the R-PR, the Applicant contended that:

the colour sheen selection tool produces practical benefits – not merely aesthetic or visual ones. According to the specification, the color sheen tool functions to “allow the user to make informed decisions” about color sheen. The purpose of the chip movement feature is to “enhance the displayed sheen characteristics” to permit more effective selection. Enlargement of the sheen chips is described as allowing for “closer inspection” of each sheen chip.

[60] As was stated in the PR letter with respect to the proposed claims, in which the features of the color sheen selection tool had been incorporated into the independent claims:

the use of attention-drawing animation was well-known from the CGK and was also known to be used in association with paint selection webpages from D8 (e.g., the animation disclosed as part of screen changes). The color sheen selection tool merely uses the same type of animation (movement and changes in size) to provide for a more pleasing user experience, an obvious desire of anyone creating such webpages.

[61] The underlying functionality of the color sheen tool providing for animated movement and size changes was already known in the prior art, as was the underlying functionality of the animated hotspots. Therefore, even assuming as the Applicant contends that there were practical benefits to such animation, they were inherent in the previously known functionality, which, as noted in the PR letter and set out above, was already associated with paint selection webpages. To the skilled person, there was nothing unobvious about the use of such functionality or its benefits in the context of a paint selection webpage.

Conclusion on Obviousness of Claims on File

[62] Having considered the record before us, including the Applicant's submissions in the R-PR and at the hearing, we conclude that claims 1-47 on file would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.

Proposed Claims

[63] In the R-PR, the Applicant did not propose any claim amendments beyond those already proposed as part of the R-SOR. As discussed above, the proposed claims incorporate the features of the color sheen selection tool of claim 13 on file into the independent claims on file. As we have already addressed the patentability of these features under both statutory subject matter and obviousness above, we need not further address them here.

[64] In light of the above, we conclude that proposed claims 1-46 would not overcome the statutory subject-matter and obviousness defects and therefore the introduction of these

claims does not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

CONCLUSIONS

[65] We have determined that claims 1-47 on file are directed to non-statutory subject matter and are therefore non-compliant with section 2 of the *Patent Act* and that claims 1-47 on file would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*. We have further determined that proposed claims 1-46 would not overcome the statutory subject-matter and obviousness defects and therefore the introduction of these claims does not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

RECOMMENDATION OF THE BOARD

[66] In view of the above, the Panel recommends that the application be refused on the grounds that the claims on file are directed to non-statutory subject-matter and are therefore non-compliant with section 2 of the *Patent Act* and that the claims on file would have been obvious and are therefore non-compliant with section 28.3 of the *Patent Act*.

[67] Further, proposed claims 1-46 do not overcome the obviousness defect and therefore the introduction of these claims does not constitute a specific amendment that is “necessary” pursuant to subsection 30(6.3) of the *Patent Rules*.

Stephen MacNeil
Member

Paul Fitzner
Member

Leigh Matheson
Member

DECISION

[68] I concur with the conclusions and recommendation of the Board that the application be refused on the grounds that the claims on file are directed to non-statutory subject-matter and are therefore non-compliant with section 2 of the *Patent Act* and that the claims on file would have been obvious and therefore non-compliant with section 28.3 of the *Patent Act*.

[69] Therefore, in accordance with section 40 of the *Patent Act*, I refuse to grant a patent on this application. Under section 41 of the *Patent Act*, the Applicant has six months within which to appeal my decision to the Federal Court of Canada.

Johanne Bélisle
Commissioner of Patents

Dated at Gatineau, Quebec,
this 20th day of December, 2018.