

Citation: The Strategic Coach (Re), 2020 CACP 30
Commissioner's Decision #1550
Décision du Commissaire #1550
Date: 2020-08-06

TOPIC: J10 Computer Programs

J40 Mental Steps

O00 Obviousness

B00 Ambiguity or Indefiniteness

C00 Adequacy or Deficiency of Description

A11 New Matter

SUJET: J10 Programmes d'ordinateur

J40 Processus psychologique

O00 Évidence

B00 Caractère ambigu ou indéfini

C00 Caractère Adéquat ou Inadéquat de la
Description

A11 Nouvelle matière

Application No. : 2,711,875
Demande n° 2 711 875

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,711,875, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019 (“former *Rules*”) has consequently been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251) (“*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 2,711,875 (“the instant application”), which is entitled “MANAGING PROFESSIONAL DEVELOPMENT” and is owned by THE STRATEGIC COACH (“the Applicant”). A review of the rejected application has been conducted by the Patent Appeal Board (“the Board”) pursuant to paragraph 199(3)(c) of the *Patent Rules*. As explained in more detail below, our recommendation is that the Commissioner of Patents refuse the application.

BACKGROUND

The Application

- [2] The instant application was filed in Canada on August 2, 2010. It was laid open to public inspection on February 3, 2011.
- [3] The instant application relates to a method of managing professional development, wherein professional goals are identified, a client’s progress towards the goals is evaluated and a required time frame for achieving the identified goals is provided to the client.

Prosecution History

- [4] On May 16, 2017, a Final Action (“FA”) was written pursuant to subsection 30(4) of the former *Rules*. The FA stated that the instant application is defective on the grounds that all of the claims 1-20 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 claims 1-20 on file would have been obvious and therefore do not comply with section 28.3 of the *Patent Act*. The FA also indicated that claim 11 on file is indefinite and therefore does not comply with subsection 27(4) of the *Patent Act*.
- [5] In a November 16, 2017 response to the FA (“R-FA”), the Applicant submitted proposed claims 1-19 (“proposed claims-1”), which included editorial revisions to claim 9 on file and the deletion of claim 11. Editorial revisions were also proposed for the description. The R-FA included arguments in favor of the patentability of the claims, as well as submissions in respect of current office practice with respect to claim construction.
- [6] As the Examiner considered the application not to comply with the *Patent Act*, pursuant to paragraph 30(6)(c) of the former *Rules*, the application was forwarded to the Board for

review on May 2, 2018 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 did not mention the indefiniteness defect in respect of claim 11 on file but given the proposed deletion of claim 11, this issue would have been moot.

- [7] In a letter dated May 4, 2018, the Board forwarded to the Applicant a copy of the SOR and requested that the Applicant confirm its continued interest in having the application reviewed.
- [8] In a response dated August 2, 2018, the Applicant indicated its continued interest in having the application reviewed. On August 24, 2018, the Applicant made a voluntary submission of prior art that had been made of record during the prosecution of the corresponding US application.
- [9] The present panel (“the Panel”) of the Board was formed to review the instant application under paragraph 199(3)(c) of the *Patent Rules*.
- [10] In a preliminary review letter (“PR letter”) dated February 6, 2020, the Panel set out its preliminary analysis of the statutory subject-matter and obviousness issues with respect to the claims on file. We also addressed the indefiniteness issue with respect to claim 11 on file and noted a similar defect with respect to claim 9. The Panel identified a new defect in respect of the sufficiency of the specification under subsection 27(3) of the *Patent Act*. The Applicant was given notice of this new defect and given an opportunity to respond to the new and outstanding defects. The PR letter provided a preliminary analysis of proposed claims-1, indicating that this proposed claim set would not overcome the statutory subject-matter defect. The PR letter set out a proposed hearing date and due date for written submissions.
- [11] The oral hearing for this case was originally confirmed for March 23, 2020, but due to the circumstances surrounding the COVID-19 pandemic, the hearing was postponed. It was held on May 22, 2020 via videoconference.
- [12] With the response to the PR letter (“R-PR”) dated March 6, 2020, the Applicant submitted proposed claims 1-19 (“proposed claims-2”), which included the proposed amendments in proposed claims-1, as well as further proposed amendments to the independent claims to include an additional feature.

[13] At the oral hearing on May 22, 2020, the Panel identified a new issue in respect of proposed claims-2, namely the possible introduction of impermissible new matter to the claims, contrary to section 38.2 of the *Patent Act*. The new matter issue arose as a result of the additional feature added to the independent claims in proposed claims-2. The Panel also indicated at the hearing that the introduction of the additional feature and its effect on the Panel's understanding of the scope of the claims on file could affect the Panel's preliminary view as to the non-obviousness of the claims. At the hearing, it was agreed that the Applicant would be given a further opportunity to make submissions in respect of the new matter issue and its effect on the other outstanding issues.

[14] Further submissions were received on June 2, 2020. With these supplemental written submissions ("SR-PR"), the Applicant submitted a new proposed claim set 1-19 ("proposed claims-3"), which included all of the previously proposed claim amendments, plus additional proposed amendments to the independent claims to add additional features. As previously confirmed with the Applicant at the oral hearing, it is only proposed claims-3 that will be considered as part of this recommendation.

ISSUES

[15] The issues to be addressed with respect to the specification and the claims on file are whether:

- Claims 1-20 on file are directed to statutory subject-matter;
- Claims 1-20 would have been obvious;
- Claims 9 and 11 are indefinite; and
- The specification is sufficient.

[16] After considering the claims on file and in view of our conclusions with respect to them, we turn to the proposed claims (proposed claims-3) and consider whether they constitute amendments necessary for compliance with the *Patent Act* and *Patent Rules*, pursuant to subsection 86(11) of the *Patent Rules*.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Claim Construction

[17] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*FreeWorldTrust*], 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 [*Whirlpool*]). In accordance with the *Manual of Patent Office Practice [MOPOP]*, §12.02 (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.

Indefiniteness

[18] Subsection 27(4) of the *Patent Act* requires claims to distinctly and explicitly define subject-matter:

The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

[19] In *Minerals Separation North American Corp v Noranda Mines Ltd*, [1947] Ex CR 306, 12 CPR 99 at 146, the Court emphasized both the obligation of an Applicant to make clear in the claims the ambit of the monopoly sought and the requirement that the terms used in the claims be clear and precise:

By his claims the inventor puts fences around the fields of his monopoly and warns the public against trespassing on his property. His fences must be clearly placed in order to give the necessary warning and he must not fence in any property that is not his own. The terms of a claim must be free from avoidable ambiguity or obscurity and must not be flexible; they must be clear and precise so that the public will be able to know not only where it must not trespass but also where it may safely go.

Statutory Subject-Matter

[20] 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.

[21] 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.

[22] 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

[23] 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.

[24] In *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 [*Sanofi*] at paragraph 67, 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?

Sufficiency

[25] Paragraphs 27(3)(a) and (b) of the *Patent Act* require, respectively, that the specification of a patent (1) describe the invention, and (2) set out the steps for its production and use:

The specification of an invention must:

a) correctly and fully describe the invention and its operation or use as contemplated by the inventor;

b) set out clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected, to make, construct, compound or use it.

[26] The relevant jurisprudence reveals that a determination of whether the specification complies with paragraphs 27(3)(a) and 27(3)(b) of the *Patent Act* requires that three questions be answered: What is the invention? How does it work? Having only the specification, can the person of skill in the art produce the invention using only the instructions contained in the disclosure? see: *Teva Canada Ltd v Novartis AG*, 2013 FC 141 citing *Teva Canada Ltd v Pfizer Canada Inc*, 2012 SCC 60 [*Teva*] and *Consolboard v MacMillan Bloedel* (1981), 56 CPR 2d 145 (SCC) [*Consolboard*]. Although the common general knowledge can be relied upon, an affirmative answer to the third question requires that the person of skill in the art not be called upon to display inventive ingenuity or undertake undue experimentation: *Aventis Pharma Inc. v Apotex Inc*, 2005 FC 1283; *Mobil Oil Corp v Hercules Canada Inc*, [1995] FCJ. No. 1243; *Merck & Co v Apotex Inc*, [1995] 2 FC 723.

[27] In *Consolboard*, at pages 154-155, the Supreme Court referred to the textbook *Canadian Law and Practice Relating to Letters Patent for Inventions* (1969, 4th ed.) from which it quoted H.G. Fox as saying “the inventor must, in return for the grant of a patent, give to the public an adequate description of the invention with sufficiently complete and accurate details as will enable a workman, skilled in the art to which the invention relates, to construct or use that invention when the period of the monopoly has expired”.

[28] The relevant date for assessing compliance with subsection 27(3) of the *Patent Act* is the filing date (*Teva*, para 90).

New Matter

[29] Section 38.2 of the *Patent Act* sets forth the conditions under which amendments may be made to the specification or drawings of a patent application:

38.2 (1) Subject to subsections (2) and (3) and the regulations, the specification and any drawings furnished as part of an application for a patent in Canada may be amended before the patent is issued.

Restriction on amendments to specifications

(2) The specification may not be amended to describe matter not reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art with respect to the application.

Restriction on amendments to drawings

(3) Drawings may not be amended to add matter not reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art with respect to the application.

[30] The question as to whether matter added to the specification or drawings by amendment complies with section 38.2 of the *Patent Act* is considered from the point of view of the skilled person.

[31] The assessment as to the presence of new matter therefore requires a comparison of the pending specification with the originally filed specification and drawings and a determination as to whether the subject-matter of the amendments is that which would have been reasonably inferred from the original specification or drawings by the skilled person.

ANALYSIS

Indefiniteness

[32] In the PR letter at page 5, we expressed our preliminary view that claims 9 and 11 on file are indefinite and do not comply with subsection 27(4) of the *Patent Act*. However, the Applicant had already proposed deleting claim 11 and amending claim 9 in the R-FA to address this defect:

In the FA at page 6, it was contended that claim 11 on file is indefinite as there is no antecedent for “the next step” and “minimum income baseline” is referred to using an indefinite article, leading to confusion as to whether a further “minimum income baseline” is present beyond that set out in claim 1.

In our preliminary view, as there is no reference in claim 10, on which claim 11 depends, or in any previous claim to which claim 10 refers to a “next step”, the person skilled in the art would be left uncertain as to the scope of this claim. Likewise, the introduction of an undefined additional “minimum income baseline” would also leave the person skilled in the art uncertain as to the claim scope.

In the R-FA, the Applicant proposed deleting claim 11 on file, which would render this defect moot. The Applicant further proposed amending claim 9 on file to also eliminate the problematic “the next step” language also present in that claim.

In our preliminary view, in light of the above, claim 11 on file is indefinite and is therefore non-compliant with subsection 27(4) of the *Patent Act*.

However, we are also of the preliminary view that claim 9 on file is also indefinite and non-compliant with subsection 27(4) of the *Patent Act* and as such give the Applicant notice under subsection 86(9) of the *Patent Rules* of this new defect.

[33] As we indicated in the PR letter, the above does not affect our ability to assess the other issues affecting the claims on file.

[34] In the R-PR, the Applicant submitted that proposed claims-2 would address the above noted issue, in which the same amendments were proposed as those in the R-FA. This issue was not further addressed in the SR-PR.

[35] In light of the above, we conclude that claims 9 and 11 on file are indefinite and are therefore non-compliant with subsection 27(4) of the *Patent Act*.

Claim Construction

[36] As we did in the PR letter, we set out independent claims 1 and 13 below. Independent claim 19 is a computer-readable medium claim in which the medium stores instructions embodying the steps set out in independent system claim 13:

1. A method for managing professional development, the method comprising:
 - receiving client information indicating a current status of a client, the current status concerning:
 - a plurality of profitable professional tasks performed by the client, and
 - an amount of profit for each of the professional tasks performed by the client;
 - executing computer-readable instructions stored in memory to set a goal for the client, wherein execution of the instructions by a processor:
 - identifies a professional goal associated with the client based on the received current status concerning a professional task performed by the client,

calculates client progress toward the identified professional goal based on the received current status concerning the professional task performed by the client,

calculates a number of dedicated days required to achieve the professional goal, the calculation based on the calculated client progress,

calculates a minimum income baseline for professional tasks based on the amount of profit for the professional tasks, and

generates an intermediate professional goal between the baseline and the identified professional goal, the intermediate goal including an income goal based on the minimum income baseline, the amount of profit for each of the professional tasks, calculated client progress, and calculated number of dedicated days; and

communicating to the client a recommendation for achieving the generated intermediate professional goal, the recommendation indicating the calculated number of dedicated days required to achieve the intermediate professional goal, the minimum income baseline, and a plurality of tasks upon which to focus.

13. A system for managing professional development, the system comprising:

a memory configured to store client information indicating a status of a client, the status concerning a professional task performed by the client;

a processor configured to execute computer-readable instructions stored in memory to:

identify a professional goal associated with the client based on the client information,

calculate client progress toward the identified professional goal based on the client information, and

determine a number of dedicated days required to achieve the professional goal, the determination based on the calculated user progress; and

an interface configured to communicate to the client a recommendation for achieving the professional goal, the recommendation indicating the number of dedicated days required to achieve the professional goal.

Submissions with respect to Office Practice

[37] In the PR letter at page 7, we addressed the Applicant's general submissions in the R-FA with respect to Office Practice regarding claim construction. The Applicant contended that the Office approach to purposive construction was not supported by Canadian jurisprudence, pointing to the Supreme Court of Canada's decisions in *FreeWorldTrust*, highlighting the criteria set out therein for the identification of elements as essential or non-essential:

The approach to purposive construction during examination set out in *MOPOP §12.02* represents the Patent Office's interpretation of the jurisprudence set out above by the Applicant. The application of the jurisprudence is discussed therein as follows:

In *Canada (Attorney General) v Amazon.com Inc*, the Federal Court of Appeal observed that, during examination, Supreme Court jurisprudence "requires the Commissioner's identification of the actual invention to be grounded in a purposive construction of the patent claims".

The application of the principles of purposive construction to the examination of a patent application must take into account the role of the patent examiner and the purpose and context of examination.

In *Free World Trust* and *Whirlpool*, the Supreme Court outlined that purposive construction is performed by the court to objectively determine what the person skilled in the art would, as of the date of publication of the patent application and on the basis of the particular words or phrases used in the claim, have understood the applicant to have intended to be the scope of protection sought for the disclosed invention.

MOPOP §12.02.01 then sets out the steps to be followed in purposively construing a claim:

When examining a claim, an examiner must read the claim in an informed and purposive way. Prior to construing a claim an examiner will:

1. Identify the person of ordinary skill in the art [see 12.02.02b]; and
2. Identify the relevant common general knowledge of the person of ordinary skill in the art at the time of publication [see 12.02.02c].

The above steps provide the context in which the claim is to be read. Once the context is determined the examiner will:

3. Identify the problem addressed by the application and its solution as contemplated by the inventor [see 12.02.02d]; and
4. Determine the meaning of the terms used in the claim and identify the elements of the claim that are essential to solve the identified problem [see 12.02.02e].

The claim construction analysis below has also been performed in accordance with the steps set out in *MOPOP §12.02.01*.

[38] In the R-PR at pages 2-3, the Applicant noted that the Panel had rejected the Applicant's interpretation of the *FreeWorldTrust* decision, but made no further general submissions. Without acquiescing to the Panel's preliminary views, the Applicant's submissions focussed on addressing the steps of the Office approach to claim construction set out in *MOPOP §12.02*. No submissions on this point were made in the SR-PR.

[39] We proceed to construe the claims in light of the Office approach to claim construction.

The person skilled in the art

[40] In the PR letter at page 8, we applied the characterization of the person skilled in the art used in the FA, which had not been disputed by the Applicant in the R-FA. The person skilled in the art was characterized as:

a team of professional development advisors/consultants and software engineers having a general knowledge of designing computer programs and networks including database servers.

[41] The above was not disputed in the R-PR or SR-PR. We proceed with this characterization.

The relevant common general knowledge

[42] In the PR letter at page 8, we reviewed the relevant CGK as identified in the FA, which was not disputed by the Applicant. We identified further points of CGK taken from the Description of Related Art section of the instant application: [Emphasis added]

In the FA at page 2, the relevant CGK of the person skilled in the art was set out:

The person skilled in the art would possess technical knowledge of how to program computer software, how to use databases and computer networks in order to enable communication of the clients with servers via network. Furthermore, the skilled person would also know how to define various goals in professional development and how to evaluate progress towards achieving the goals by using a known measurable metric (for example in terms of estimated time needed to achieve the goals, dedicated days etc.) and how to compare results to a certain baseline.

Again, the Applicant did not dispute this characterization in the FA.

While we adopt the description of the relevant CGK as set out in the FA, we also identify the following generalized background points taken from the Description of Related Art section of the instant application:

- knowledge of various online applications that are used to help individuals manage various aspects of their lives (e.g., quitting smoking, losing weight, earning an occupational certification) and that can be associated with online communities that provide support and advice;
- knowledge that professional development is typically difficult to measure;
- knowledge that professional developments goals may be unique to an individual;

- knowledge that the analysis of the factors involved in professional development is complex;
- knowledge that most professional development programs are tailored to individuals and are therefore costly;
- knowledge that it has been difficult to scale up such professional development service to many clients and to coordinate group support; and
- knowledge of the need for improved systems and methods to manage professional development.

[43] In the R-PR at pages 3-4, the Applicant disagreed with the above emphasized portion of the relevant CGK taken from the FA. The Applicant contended that the points are vague, indefinite and ambiguous and that they are inconsistent with the problem defined in the instant application at paragraph [0004]. The Applicant also contended that these points are inconsistent with the generalized points of CGK set out in the PR letter and taken from the instant application itself, which state “that the analysis of the factors involved in professional development is complex” and that “it has been difficult to scale up such professional development service to many clients and to coordinate group support.”

[44] We acknowledge that specific details of such points would be difficult to clarify.

[45] As the Applicant did not dispute any of the other points of CGK, we will proceed on the basis of the relevant CGK set out in the PR letter, minus the emphasized portion from the FA set out above. However, we note that the absence of such knowledge as part of the relevant CGK reinforces our later conclusions regarding the sufficiency of the specification under subsection 27(3) of the *Patent Act*.

The problem to be solved

[46] In the PR letter at page 9, after reviewing the instant application, the FA and the Applicant’s submissions in the R-FA, we preliminarily agreed with the problem as set out in the FA, with the addition of further aspects (both of which are highlighted below):

In the FA at page 2, the problem to be solved was identified as:

As indicated by the applicant in the background of the application, current professional development management methods suffer from a difficulty to measure progress to achieving professional goals as compared to methods of tracking weight, number of cigarettes smoker or number of credits earned toward a certificate.

While the Applicant made no specific submissions with respect to the problem in the R-FA, it did contend that: the claimed invention relates to “real-time” setting of professional goals; that the claims solve technical problems; and that they provide improvements to the technical field of professional development management (R-FA at page 3).

With respect to the “real-time” setting of professional goals, we can find no suggestion in the instant application that the process of analyzing a client’s progress and determining a suitable professional goal requires any “real-time” analysis and somehow depends on the calculations being performed by a computer in order to provide any useful results. The instant application does not suggest that the recommendations to be provided to a client as a result of the disclosed method are so time-sensitive that the skilled person would understand there to be a requirement for computerized “real-time” analysis.

The problems alleged by the Applicant in relation to the standardization of professional development management across varying individual circumstances, do not, in our preliminary view, appear to be “technical” in any way. The instant application discusses various calculations that are used in the analysis of an individual’s circumstances, as well as progress, and later development of professional goals for that individual, but there is no evident technical problems that were addressed.

The computer-related components described in the instant application at paras [0018]-[0023] and [0039]-[0045] are generic in nature, comprising well-known computing and storage devices used to perform the required calculations and store data. The lack of technical detail regarding the implementation of the disclosed calculation modules in a computerized system indicates that there were no problems associated with the computer implementation of the calculations and no computer problem to be overcome.

With respect to the contention that the claimed invention relates to the technical field of professional development management, the Applicant asserts that the claims relate to an interactive tool in support of such a characterization. However, as discussed above, we are of the preliminary view that there were no problems to be solved associated with any such computer implementation.

In light of the above, we agree with the problem identified in the FA, but in our preliminary view, consistent with the information provided as part of the Description of Related Art at para [0004], the problem to be solved also relates to the fact that managing professional development is more difficult to scale up and apply generally to a larger group, since goals can be based on issues unique to an individual professional.

[47] In the R-PR at page 4, the Applicant contended that the problem to be solved as identified above is technical in nature. Specifically the Applicant contended that “the problem to be solved is how to program a computer to measure and track business development in a way that can be scaled in order to be applied to a larger group.” The Applicant contends that the manual process of tracking business development cannot readily be implemented on a computer and that the problem is how to provide a computer-implemented method.

[48] At the hearing the Applicant made consistent submissions, contending the problem was

coming up with a scheme that would allow a computer to perform the prior art manual steps that could not be performed by a computer. The actual programming or code, in the Applicant's view, was not part of the problem to be solved.

[49] As set out in the PR letter, we have already considered whether the problem to be solved is technical in nature. The lack of technical detail regarding the implementation of the disclosed calculation modules in a computerized system indicates that there were no problems associated with the computer implementation of the calculations. The computer implementation described in the instant application is set out at a high level involving the specification of modules, with an emphasis on the high-level calculations that are to be performed by such modules. There are no details provided as to how specifically a computer would be programmed to perform such calculations, which might point to a problem related to the computer implementation.

[50] Further, while the Applicant's proposed scheme may allow the method of professional development to be scaled up and performed by a computer, this does not mean that a computer problem was present. The need to scale up and apply a method for managing professional development generally to a larger group is not a problem unique to a computer implementation.

[51] The SR-PR included no further submissions in respect of the problem to be solved.

[52] In light of the above, we conclude that the problem to be solved is as set out in the PR letter, namely:

As indicated by the applicant in the background of the application, current professional development management methods suffer from a difficulty to measure progress to achieving professional goals as compared to methods of tracking weight, number of cigarettes smoker or number of credits earned toward a certificate.

.....

the problem to be solved also relates to the fact that managing professional development is more difficult to scale up and apply generally to a larger group, since goals can be based on issues unique to an individual professional.

The solution

[53] In the PR letter at page 10, after reviewing the FA and the Applicant's submissions in the R-FA, we preliminarily agreed with the solution set out in the FA:

In the FA at page 2, the solution was characterized as:

a method for managing professional development, wherein professional goals are identified, the client's progress toward the goals is evaluated and the required time to achieve the goals is communicated to the client.

The Applicant made no specific submissions in relation to the solution disclosed, other than generally contending that the computer elements were essential to the claimed invention. As discussed above in relation to the problem to be solved, we are of the preliminary view that there was no computer problem to be solved in implementing the calculations discussed in the instant application and therefore the computer elements do not form part of the solution. The Applicant contends at page 4 of the R-FA that generic computers are incapable of performing the steps of the claimed invention. However, it is the implementation of the calculations that is the issue in determining the problem to be solved, the solution and the related essential elements. The use of generic computers to embody a series of calculations, with no discussion of any technical difficulties in doing so, indicates, as noted above, that no computer problems were addressed in arriving at the invention disclosed.

In light of the above, we preliminarily agree with the solution set out in the FA.

[54] In the R-PR at page 5, the Applicant contends that the solution set out above trivializes the problems facing the inventors. The Applicant contends that the solution provides specific steps to provide a scalable computer-implemented method that can be applied to larger groups, namely the steps identified as essential elements of independent claims 1, 12 and 18 on file in the PR letter.

[55] However, the identification of the solution is not the same as the identification of the essential elements of a claim. According to *MOPOP* §12.02, a solution to the problem to be solved must be identified before determining which elements of the claims are essential.

[56] The Applicant also contends that the claims describe:

what amounts to an interactive tool that is used by the client to update their status track their progress toward a professional goal. This interactive tool is then used to calculate the client's progress and make projections based on that progress. The interactive tool is also used by the client to identify a professional goal from several potential professional goals, and then generate an intermediate goal that will move the client closer to that professional goal. In addition to that, the interactive tool then generates recommendations for use by the client as guidance in achieving intermediate goal.

[57] The assertion that the claims relate to an interactive tool was previously made as part of the Applicant's position in the R-FA that the invention relates to the technical field of professional development management. This point was addressed in the PR letter as part of the discussion of the problem to be solved. Consistent with our preliminary view set out in

the PR letter, it is our view that there were no problems to be solved associated with any computer implementation, including the creation of an interactive tool. Further, concerning the alleged interactive nature of the disclosed invention, the method steps comprise the provision of output information based on inputs from the client, which in our view does not make the method “interactive”. Input information is processed according to certain calculations and an output is provided in the form of a recommendation to the client.

[58] No further submissions in respect of the solution were made in the SR-PR.

[59] In light of the above, it is our view that solution is as set out in the PR letter, namely:

a method for managing professional development, wherein professional goals are identified, the client's progress toward the goals is evaluated and the required time to achieve the goals is communicated to the client.

The essential elements of the claims

[60] In the PR letter at pages 10-11, we set out the two lists of essential elements of the claims on file as identified in the FA. We preliminarily agreed that the lists of essential elements reflected the construed subject-matter of independent claims 1 and 13/19, respectively, after addressing the Applicant's submissions in the R-FA. Considering our preliminary view in the PR letter, the essential elements of claims 1 and 13/19 on file were:

Claim 1

- receiving client information indicating a current status of a client, the current status concerning professional tasks performed by the client, and an amount of profit for each task performed by the client;
- identifying professional goals associated with the client based on the received client status;
- calculating client progress toward the identified professional goals based on the received current status concerning the professional tasks performed by the client;
- calculating a number of dedicated days required to achieve the professional goals, the determination based on the calculated user progress; and
- calculating a minimum income baseline for professional tasks based on the amount of profits;
- generating an intermediate professional goal between the baseline and the identified professional goal, the intermediate goal including an income goal based on the minimum income baseline, the amount of profit for each of the professional tasks, calculated client progress, and calculated number of dedicated days; and

- communicating to the client a recommendation for achieving the professional goals, the recommendation indicating the number of dedicated days required to achieve the professional goals, the minimum income baseline, and a plurality of tasks upon which to focus.

Claims 13/19

- receiving and storing client information indicating a current status of a client, the current status concerning professional tasks performed by the client;
- identifying professional goals associated with the client based on the received client information;
- calculating client progress toward the identified professional goals based on the current status concerning the professional tasks performed by the client;
- determining a number of dedicated days required to achieve the professional goals, the determination based on the calculated user progress; and
- communicating to the client a recommendation for achieving the professional goals, the recommendation indicating the number of dedicated days required to achieve the professional goals.

[61] Addressing the Applicant's submissions in the R-FA, we stated:

In the R-FA at page 5, the Applicant contended that the FA omitted the computer-related elements of the claims, pointing to the criteria set out in *FreeWorldTrust* as support for their inclusion.

As we previously presented, in accordance with the problem/solution approach set out in *MOPOP §12.02.01*, it is our preliminary view that the computer-related elements of the claims on file are not essential. Given that the essential steps set out in the FA reflect the steps of independent claims 1 and 13 (and therefore 19), we preliminarily agree with the essential elements set out in the FA.

[62] The Applicant did not make any specific submissions with respect to the essential elements of the claims, other than as part of the submissions in respect of the problem and solution, discussed above. In particular, the Applicant's points regarding the computer implementation being part of the problem to be solved and the solution relating to an interactive tool, by implication, would mean that the computer-related elements of the claims are essential. We explained above and in the PR letter why we disagree with such a position.

[63] No further submissions in respect of the essential elements of the claims on file were made in the SR-PR.

[64] In light of the above, we conclude that the essential elements of independent claims 1, 13 and 19 are as set out above and in the PR letter.

[65] As we did in the PR letter, we will address the additional elements of the dependent claims below in our assessment of statutory subject-matter, as needed.

Scope of the identification of a professional goal step

[66] In the discussion of the prosecution history of the instant application above, we noted that as a result of the addition of a certain feature to proposed claims-2, we raised an issue at the hearing regarding the possible introduction of impermissible new matter to the independent claims, contrary to section 38.2 of the *Patent Act*. In particular, as part of the R-PR, the Applicant proposed adding a feature to the independent claims as part of the step of identifying a professional goal for a client, namely “the professional goal comprising achieving the client’s income goal.” The proposed introduction of this feature suggested that the identification of a professional goal in the claims could be based on the client’s own self-determined goal input to the method, rather than the professional goal being identified based on some analysis of client-supplied information.

[67] As a result of the discussion at the hearing regarding whether such a feature would be supported by the specification and drawings or whether it would constitute impermissible new matter, and the possible subsequent effect on our understanding of the scope of the claims on file and the rest of the specification, at this point we feel it necessary to set out explicitly our understanding of the scope of the step of the claims where a professional goal associated with a client is identified.

[68] In the PR letter at pages 13-14 under the assessment of obviousness at *Sanofi* step 3, we discussed the differences between the independent claims on file and the state of the art, noting that:

the method and system disclosed in D1 do not identify or set any goals, whether long-term or intermediate, based on the information received from a client. The method and system of D1 relies on user-defined “self-determined goals.” As discussed at col. 5, lines 36-40 of D1, the client must answer questions regarding their desired long-term and short-term goals that are used by the method and system to determine progress towards the goals and to provide feedback:

[q]uestions in process step 100 ask about long-term and short-term goals including but not limited to yearly and monthly dollar goals. The user also

responds to questions about dollar goals for various open accounts using the telephone keypad.

There is no disclosure or suggestion in D1 of the setting or identification of goals for a client as a result of the analysis of information received from the client. Although the FA referred to col. 5, lines 24-50 in support of D1 disclosing the identification of goals based on received client information, we can find no support in D1 for such a position.

[69] As is evident from the above passages, our understanding of the goal identification steps of the claims was that such goals were not identified by the client themselves (i.e., self-determined goals, as described above). The goals were identified based on some analysis of the information that was input by a client. If we had interpreted this step of the claims as including self-determined goals, this step would have been encompassed within the state of the art.

[70] We understand that claims must not be construed with an eye towards the prior art. In this case, this discussion is necessary in order to clarify the claim interpretation that was used in the PR letter obviousness prior art analysis and that is to be used in this recommendation. The goal identification step is a case of “where the shoe pinches” (*Shire Biochem Inc v Canada (Health)*, 2008 FC 538 at paragraph 22).

[71] Our understanding of the goal identification step was supported by the submissions made by the Applicant itself in the R-FA in the context of obviousness. In the R-FA at page 8-9 the Applicant explicitly described a difference between the state of the art and the claims as being that the state of the art teaches “self-determined goals” whereas the instant application teaches the identification of goals from information about tasks performed by the user [Emphasis in *italics* added]:

There is no teaching that D1 "identifies a professional goal associated with the client based on the received current status concerning a professional task performed by the client," as recited in independent claim 1. Instead of identifying a professional goal, D1 teaches "self-determined goals":

This invention relates to a ... method that improves an individual's ability to achieve measurable, self-determined goals ... (see D1, column 1, lines 6 to 10, emphasis added).

Moreover, *the self-determined goals in D1 are goals that have been inputted by the user, rather than goals that have been identified from information about tasks performed by the user as required by independent claim 1.* For example, D1 recites that the goal is already known when the data is collected, as "collection of goal-related data" (see O1, column 5, lines 25 and 26) and "collecting goal-related data" (D1, column 5, line 66).

Indeed, D1 explicitly teaches that the goals are entered by the user, rather than being identified from data about tasks. For example, D1 discloses:

In FIG. 1A, after collecting goal-related data in process step 100, process step 102 computes the user's progress towards the goals entered by the user (see D1, column 5, line 65 to column 6, line 1, emphasis added)

The input server 402 then plays another prerecorded message asking the user to enter the dollar goal for this account, followed by the "#" symbol at step 588. The user enters this amount [dollar goal] and the input server 402 saves this information along with the new account number and the user's voice recording associated with the account number (see D1, column 14, lines 1 to 6, emphasis added).

Thus, D1 does not identify goals or generate intermediate goals.

- [72] By the Applicant's own submissions in the R-FA, the claims require that the professional goals be identified based on some analysis of data such as tasks and are not those that are entered by the user (i.e., self-determined goals).
- [73] This was our understanding of the scope of this step in the PR letter as well and it is further supported by the description of the invention in the instant application.
- [74] For example, at paragraphs [0030] and [0031], information concerning client status is received, which may include information concerning professional status such as job title, industry, current income, working hours, type of task performed in the job, etc. Such information can also be later provided as an update after the initial identification of a professional goal. With the information received, at step 320, illustrated in Figure 3, a professional goal is identified based on the supplied client information. As stated in paragraph [0031], "[f]or new clients, one or more professional goals may be generated based on the information provided by the client." This paragraph also specifies that a client "may be queried to focus a professional goal." However, in our view, the person skilled in the art would not take this to suggest that the professional goal is identified by the client, merely that the client is queried to refine a goal previously identified based on the supplied information.
- [75] In support of the proposed addition to the claims in proposed claims-2, as well as the same proposed addition in proposed claims-3, the Applicant, in the SR-PR, pointed to the passage in paragraph [0006] (identified as [0008] in the SR-PR) where it is stated that "[p]rofessional goals may include a level of income, efficiency, type of task performed, etc." However, while this statement speaks to what an identified professional goal may be,

it does not speak to how the goal is identified.

[76] We also note that even in claims 13 and 19 on file, which use more general language at the goal identification step, namely, “identify a professional goal associated with the client based on the client information”, the stored client information is previously defined as “indicating a status of a client, the status concerning a professional task performed by the client”, as it is in claim 1 on file.

[77] Reference was also made in the SR-PR to paragraph [0011] and a passage stating “[t]he professional goal may include achieving a certain income goal, and the identification of profitable tasks allows individuals to focus their efforts on those tasks” [Emphasis in original]. We are unable to locate the referenced passage in the description. However, regardless, this passage does not speak to who or what identifies the professional goal. Other references were made to the description at paragraphs [0020], [0030] and [0031] in support of a client-identified professional goal falling within the scope of the claims, but, in our view, none of these references support such a position.

[78] In light of the above, it is our view that the step in the claims on file where a professional goal is identified would be interpreted by the person skilled in the art as specifying that such a professional goal is identified based on some analysis of the client-supplied information (e.g., based on the received current status concerning a professional task), rather than drawn directly from the client-supplied information (i.e., a self-determined goal).

[79] This interpretation of the scope of the claims on file is important when considering the sufficiency issue, as well as the determination as to whether or not impermissible new matter has been added to proposed claims-3, both of which are discussed later in this recommendation.

Statutory Subject-Matter

[80] In the PR letter at pages 11-12 we expressed our preliminary view in respect of the statutory subject-matter issue:

In the FA at page 4, it was stated that the essential elements of the claims are not directed to a patentable category of invention and therefore do not comply with section 2 of the *Patent Act*. In the portion of the FA dealing with the essential elements, it was stated that they “are

directed to an abstract scheme of organizing human activities and lie, therefore, outside the definition of invention.”

In our preliminary view, given the essential elements of the independent claims set out above, which relate to a series of rules and calculations and the associated input and output of information, the subject-matter of these claims is akin to mental steps and scientific principles or abstract theorems. It is not directed to “something with physical existence, or something that manifests a discernable effect or change” (*Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 at paragraph [66] [*Amazon*]).

We further note that the invention in *Schlumberger Canada Ltd v Commissioner of Patents* (1981), 56 CPR (2d) 204 (FCA), referred to in *Amazon*, and the essential elements of the claims on file in the instant application, are very similar. In both cases, a computer may be used to perform the calculations that make up the methods, but it is not essential that the methods be implemented in this manner. Both cases relate to the analysis of inputs through various calculations. The use of a computer, though convenient, is not essential to perform the analysis.

In light of the above, it is our preliminary view that independent claims 1, 13 and 19 are directed to non-statutory subject-matter and are therefore non-compliant with section 2 of the *Patent Act*.

With respect to dependent claims 2-12, 14-18 and 20, in our preliminary view, the additional elements of these claims represent further refinements of the inputs, outputs, rules and calculations used in the essential steps of the independent claims, and likewise are directed to non-statutory subject-matter and are therefore non-compliant with section 2 of the *Patent Act*.

[81] In the R-PR at page 5, the Applicant contended that:

receiving information, identifying a professional goal based on the received information, calculating progress towards the identified professional goal, calculating a minimum income baseline, generating an intermediate professional goal, and communicating a recommendation for achieving the generated intermediate professional goal, when considered in totality, are individually and as an ordered combination more than just an abstract idea of organizing human activities. Rather, as noted above, the invention as claimed provide a specific computer-implemented invention that overcomes the technical problems of the prior art'. Thus, the claimed invention as a whole is directed to a technical solution to a technical problem and complies with section 2 of the *Patent Act*.

[82] Although our preliminary view was that the claims on file were directed to subject-matter that is abstract, we did not characterize them as organizing human activity. Rather the claims on file were directed to a series of rules and calculations and the associated input and output of information, the subject-matter of the claims on file being akin to mental steps and scientific principles or abstract theorems.

[83] We have discussed above under Claim Construction why the essential elements of the

claims on file do not include a computer implementation of the claimed method steps and why the problem and solution are not technical in nature.

[84] At the hearing, the Applicant contended that the list of essential elements identified by the Panel and set out above constitute a framework for implementing a method of managing professional development on a computer, that the steps are required to provide a computer implementation that could be rapidly scaled up, and in this manner were directed to statutory subject-matter.

[85] However, in our view, there is nothing in the steps that constitute the essential elements of the claims that requires a computer for execution. The steps would be applicable regardless of whether a computer was used to implement them. Therefore, in our view the steps do not represent a framework that is more than a series of rules and calculations and the associated input and output of information.

[86] In light of the above, we conclude that claims 1-20 on file are directed to non-statutory subject-matter and therefore do not comply with section 2 of the *Patent Act*.

Obviousness

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

[87] We have identified the person skilled in the art above under Claim Construction.

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

[88] The relevant common general knowledge of the person skilled in the art has also been identified under Claim Construction.

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

[89] As we did in the PR letter, below we use the identified essential elements of the claims on file in our analysis at *Sanofi* steps (3) and (4). Further, our construction of the goal identification step of the claims will also be applied.

(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

[90] In the PR letter at pages 12-14, we compared the prior art document applied in the FA and the claims on file, confirming the differences identified in the FA and identifying further differences:

In the FA, the following prior art document was applied to assert obviousness of the claims on file:

D1: US 5,954,510 Merrill et al. Pub: September 21, 1999

D1 discloses an interactive goal-achievement and learning system and method that is designed to improve “an individual’s ability to achieve measurable, self-determined goals over periods of time using interactive information exchange, feedback and reinforcement” (D1 at col. 1, lines 7-12).

In the FA at page 5, after comparing the essential elements of claim 1 on file with those of D1, it was stated that D1 does not disclose:

- use of dedicated days as a measure to achieve the professional goals and
- calculating a minimum income baseline for professional tasks based on the amount of profit for the professional tasks.

In the R-FA at page 7-14, and as noted in the SOR, the Applicant contended that several elements of claim 1 on file were not disclosed by D1, in addition to those identified in the FA, namely:

- the reception of information regarding an amount of profit for each of the professional tasks performed by a client;
- the identification of a professional goal associated with a client based on the current status of a professional task;
- the generation of an intermediate professional goal between the baseline and the identified professional goal, the intermediate goal including an income goal based on the minimum income baseline, an amount of profit for each professional task, calculated client progress and calculated number of dedicated days;
- the communication of a recommendation for achieving a generated intermediate professional goal, the recommendation indicating the calculated number of dedicated days required to achieve the intermediate professional goal, the minimum income baseline, and a plurality of tasks on which to focus; and
- the setting of goals for a client based on information received from the client.

We note that the last point enumerated by the Applicant appears to be the same as the second.

After reviewing D1, we agree with the Applicant that there are more differences between claim 1 on file and D1 than those set out in the FA.

As the FA admits, there is no disclosure in D1 of the calculation of a number of days required to achieve a professional goal, whether it is determined by the client or by the method and system itself. With respect to sales goals, D1 contemplates the calculation of progress towards a client-identified goal, but makes no prediction as to the time period that it will take to achieve it. The time period over which to achieve a client-identified goal is in fact entered by the client (D1 at col. 5, 63-65). Likewise, for the embodiments disclosed relating to weight loss and investing, D1 discloses the calculation of progress towards the client-identified goal, but not any estimate of the length of time it will take to achieve it (D1 at col. 6, lines 14-27). Since D1 does not disclose the calculation of a number of days to achieve the professional goal, there is also not disclosure of any recommendation to the client that includes this calculated value.

Further, the method and system disclosed in D1 do not identify or set any goals, whether long-term or intermediate, based on the information received from a client. The method and system of D1 relies on user-defined "self-determined goals." As discussed at col. 5, lines 36-40 of D1, the client must answer questions regarding their desired long-term and short-term goals that are used by the method and system to determine progress towards the goals and to provide feedback:

[q]uestions in process step 100 ask about long-term and short-term goals including but not limited to yearly and monthly dollar goals. The user also

responds to questions about dollar goals for various open accounts using the telephone keypad.

There is no disclosure or suggestion in D1 of the setting or identification of goals for a client as a result of the analysis of information received from the client. Although the FA referred to col. 5, lines 24-50 in support of D1 disclosing the identification of goals based on received client information, we can find no support in D1 for such a position.

D1 also does not disclose the calculation of any minimum income baseline for the client's professional tasks based on the amount of profit for the tasks, as acknowledged in the FA. While D1 discloses the ranking of sales accounts based on likelihood and size of sale (D1 at col. 16, lines 40-41), there is no disclosure or suggestion of any determination of a minimum income baseline based on the client's professional tasks, which determination is then used to make a recommendation to the client as to which tasks upon which to focus in order to achieve the predetermined professional goal, in accordance with the second to last difference identified by the Applicant in the R-FA, and set out above.

We note that with respect to the other independent claims 13 and 19 on file, with the exception of the calculation and application of a minimum income baseline for the clients' professional tasks, the remaining differences also apply to those independent claims.

[91] Given our ultimate preliminary view in the PR letter that claims 1-20 on file would not have been obvious, the Applicant simply acknowledged this position in the R-PR. In the SR-PR, the Applicant made further submissions on obviousness, but these related to the non-obviousness of the claims on file even if the claims were construed to encompass the client self-identification of goals. We have already reviewed this issue above under Claim Construction and given our conclusion in this respect, our obviousness analysis in the PR letter is not affected.

[92] In light of the above, the differences between the prior art and the independent claims on file are those set out the PR letter.

(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?

[93] After considering the relevant CGK and the prior art documents submitted by the Applicant in the voluntary submission dated August 24, 2018, we were of the preliminary view that claims 1-20 on file would not have been obvious and were therefore compliant with section 28.3 of the *Patent Act*:

In our preliminary view, based on our analysis at step (3), above, there is no disclosure or suggestion in prior art document D1 of the identification of professional goals based on

information received from a client, nor is there any disclosure or suggestion of the determination of a number of dedicated days to achieve such goals based on the client's progress.

While the relevant CGK includes the knowledge of evaluating progress towards achieving a goal, it does not include any suggestion of a method of identifying the goal itself based on client-supplied information. Further, the relevant CGK does not suggest the determination of a time period to achieve the goal, whether the goal is client-identified or determined based on the client-supplied professional task related information.

In our preliminary view, the above noted differences, which apply to all of independent claims 1, 13 and 19 on file, would not have been obvious in view of D1 and the relevant CGK. Likewise, dependent claims 2-12, 14-18 and 20, which include the features of independent claims, 1, 13 and 19, respectively, also would not have been obvious.

We have reviewed the prior art documents identified in the Applicant's voluntary submission of prior art dated August 24, 2018. In our preliminary view, these documents also do not disclose or suggest the combination of features of the independent claims on file.

In light of the above, it is our preliminary view that claims 1-20 on file would not have been obvious and are therefore compliant with section 28.3 of the *Patent Act*.

[94] As stated in relation to the submissions in respect of step (3), the Applicant, in the R-PR, simply acknowledged our preliminary view above.

[95] In light of the above, we conclude that claims 1-20 on file would not have been obvious and are therefore compliant with section 28.3 of the *Patent Act*.

Sufficiency

[96] In the PR letter at page 15, we gave the Applicant notice of a new defect in respect of the sufficiency of the specification and expressed our preliminary view:

In particular, in our preliminary view, the specification does not provide sufficient disclosure of the steps of the method set out in the claims on file such that a person skilled in the art would be able to practice the invention claimed without the exercise of any inventive ingenuity, as required for compliance with paragraph 27(3)(b) of the *Patent Act*.

In claim 1 on file, a professional goal is identified for a client based on the current status concerning the client's professional task. However, the description only discusses this determination in general terms at para [0031], where it is stated that "a professional goal is identified based on the client information provided." The information provided, per para [0030], may include professional status, current income, working hours, etc., but there is no criteria or relationships disclosed between the client information and the identified goal.

Further, the lack of a disclosed relationship between the provided client information and an identified goal, which would be a concern even for a specific professional field, leads to even more concerns about the level of disclosure given that claim 1 on file and the other

independent claims 13 and 19 encompass the management of professional development from a myriad of fields. The same issue applies to the dependent claims on file. Likewise, Figure 3 merely sets out the broad step of determining a professional goal using the supplied client information as well.

Therefore a person skilled in the art would not be able to practice the invention of the claims on file with only the specification of the instant application.

- [97] In the R-PR at pages 6-7, the Applicant submits that the specification is sufficient, that the application “clearly delineates what are professional goals and how they are identified.” As examples, the Applicant points to possible professional goals as set out in paragraph [0006] of the instant application. However, this passage merely speaks to professional goals that may be identified, not how they are identified.
- [98] The Applicant also points to the claim limitation where a professional goal is identified based on a current status of a client. However, we have already discussed the insufficiency of this limitation in the PR letter. The Applicant points to the system querying a client to focus a professional goal, as described in paragraph [0031] of the instant application. However, this does not specify how the original suggested goal was determined that is to be more clearly delineated by the system queries and the client’s responses. If the Applicant is suggesting that it is the client that provides a goal in response to the system queries, in our view this is not suggested by the specification or drawings, as discussed above under Claim Construction and as discussed later in association with the new matter issue raised in respect of proposed claims-2 (and ultimately proposed claims-3).
- [99] The Applicant points to paragraph [0009] of the instant application for the point that a client’s current status may indicate a portion of client income earned from a professional task. This may be used to generate a projected income for a day from the task and then a number of dedicated days may be determined that are needed to achieve a professional goal. While the language of paragraph [0009] does not match the passage quoted by the Applicant in the R-PR, in any case, this does not address the issue of how the professional goal is originally identified. It merely serves to illustrate how a timeframe indicator to achieve a professional goal can be generated.
- [100] The Applicant also points to paragraph [0020], which refers to a client providing a status information and the determination of client progress toward a professional goal. This does not provide any further clues as to how the goal against which progress is determined was originally identified.

[101] None of the submissions in the R-PR or SR-PR clarify how the original professional goal is to be identified as part of the associated step in the claims on file.

[102] As previously noted, with the R-PR the Applicant proposed amending the independent claims to specify “the professional goal comprising achieving the client’s income goal” (as part of proposed claims-2). This proposed amendment was also included with proposed claims-3 submitted with the SR-PR. If such a feature were supported by the original specification and drawings, it would of course solve the sufficiency issue, as the Applicant contended that it does in the SR-PR, since the professional goal could be self-determined by a client. However, as discussed below in relation to the proposed claims and the issue of new matter, it is not supported or reasonably to be inferred from the original specification and drawings.

[103] In view of the removal from the relevant CGK of points relating to how to define various goals in professional development and the Applicant’s point regarding it being virtually impossible for a person skilled in the art at the time of filing of the instant application to know “how to define goals in professional development...” (R-FA at page 3), the deficiency of the specification cannot be overcome by means of the relevant CGK of the person skilled in the art.

[104] In light of the above, we conclude that the specification is insufficient as it does not enable a person skilled in the art to practice the claimed invention across its scope, contrary to the requirements set out in paragraph 27(3)(b) of the *Patent Act*.

Proposed claims

[105] In the PR letter at page 16, we set out our preliminary view that proposed claims-1 submitted with the R-FA would not alter the outcome of the assessment of statutory subject-matter. We further set out our preliminary view that the proposed amendments to the description would not be “necessary”:

The Applicant submitted proposed claims 1-19 with the R-FA, with editorial revisions being proposed for claim 9 on file and claim 11 having been deleted. Further, editorial revisions were proposed for the disclosure.

In our preliminary view, while the proposed amendments to the claims on file would address the indefiniteness defect set out above, the proposed amendments to the disclosure are not considered “necessary” for compliance with the *Patent Act* and *Patent Rules* as required by

subsection 86(11) of the *Patent Rules*, and therefore we would not recommend that they be required in a Commissioner's Decision.

Further, the proposed amendments to the claims on file would not alter our preliminary view that the claims are directed to non-statutory subject-matter. Therefore, they are not considered "necessary" for compliance with the *Patent Act* and *Patent Rules* as required by subsection 86(11) of the *Patent Rules*.

[106] The Applicant provided submissions and proposed claims amendments both in the R-PR and SR-PR. As we stated at the oral hearing, we will consider the latest proposed claim set (proposed claims-3) to determine whether they would overcome the defects identified above.

[107] As discussed at the hearing and addressed in the SR-PR by the Applicant, the Panel identified a potential defect of impermissible new matter having been introduced in proposed claims-2. The relevant proposed amendment was carried over into proposed claims-3. We address this issue below.

[108] For convenient reference we set out proposed claim 1 as it appeared as part of the SR-PR submissions, with emphasis on the newly added features provided by the Applicant. Similar amendments were proposed for the other independent claims:

1. A method for managing professional development, the method comprising:
 - receiving client information indicating a current status of a client, the current status concerning:
 - a plurality of profitable professional tasks performed by the client, and
 - an amount of profit for each of the professional tasks performed by the client;
 - executing computer-readable instructions stored in memory to set a goal for the client, wherein execution of the instructions by a processor:
 - identifies a professional goal associated with the client based on the received current status concerning a professional task performed by the client, the professional goal comprising achieving the client's income goal,
 - calculates client progress toward the identified professional goal based on the received current status concerning the professional task performed by the client,
 - calculates a number of dedicated days required to achieve the professional goal, the calculation based on the calculated client progress,
 - calculates a minimum income baseline for professional tasks based on the amount of profit for the professional tasks, and

generates an intermediate professional goal between the baseline and the identified professional goal, the intermediate goal including an income goal based on the minimum income baseline, the amount of profit for each of the professional tasks, calculated client progress, and calculated number of dedicated days;

communicating to the client a recommendation for achieving the generated intermediate professional goal, the recommendation indicating the calculated number of dedicated days required to achieve the intermediate professional goal, the minimum income baseline, and a plurality of tasks upon which to focus, the recommendation comprising a calendar scheduling the dedicated days;

receiving updated client information indicating an updated status of the client; and
updating the calendar by modifying the scheduling of the dedicated days in accordance with the updated status of the client.

New Matter

[109] Before dealing with the other issues associated with proposed claims-3, in our view it is first necessary to address the new matter issue, in order to determine if such a feature should even be considered as part of proposed claims-3. We note at the outset that we take no issue with the proposed additional features relating to the output of a calendar or to its update based on updated client status.

[110] We have already discussed in relation to the construction of the claims on file why it is our view that there is no support in the instant application for an interpretation of the professional goal identification step such that the goal is a client self-determined goal. It is the proposed addition of such a feature to the claims that raised the impermissible new matter issue.

[111] Other than amendments to introduce consistency clauses to coincide with the then pending claim sets and an editorial amendment to the last page, the description portion of the instant application has not been significantly altered during prosecution and as such, its present content is consistent with that as originally filed. The drawings have not changed during prosecution.

[112] Original independent claims 1 and 13, though broader in scope than the claims on file and proposed claims-3, still characterized the identification of a professional goal as based on received information relating to a current status of a professional task performed by a client.

[113] As in the current version of the specification, there is no information provided as to how a

professional goal is to be determined based on the client input status information.

Paragraph [0006] of the original description dated August 2, 2010 makes reference to the provision of status information by a client, “which may include information about a professional task performed by the client and a portion of income associated with the task.” Client progress towards a professional goal may then be determined. Examples of professional goals are listed such as level of income, efficiency, type of tasks performed, etc., as they are in the current version of the description. However, no information is provided as to how the professional goal benchmark is first determined.

[114] Paragraph [0025] refers to the use of a focus day calculator 220 that may determine how many focus days are required to achieve a professional goal, but again no information is provided as to how the professional goal is determined.

[115] Figure 3 of the original specification, which is the same as that of the present version, sets out the basic steps of the exemplary method of the invention. Information concerning client status is received and a professional goal is then identified based on the client status.

Paragraph [0031] states that:

For continuing clients, a professional goal may have been previously identified. For new clients, one or more professional goals may be generated based on the information provided by the client. [Emphasis added]

[116] In our view, the original specification and drawings neither suggest, nor is it reasonably to be inferred from them, that the professional goal for a client is one input by the client themselves (i.e., a self-determined goal as is claimed in proposed claims-3). Rather the professional goal is identified as a result of some analysis of the information provided by a client, which analysis would not be necessary if the professional goal was simply input by a client.

[117] In the SR-PR, the Applicant provided submissions in support of the professional goal being the client’s own self-determined goal, pointing to various portions of the specification, which correspond to portions of the original specification. We have already discussed these references in relation to Claim Construction in determining if the claim language could be construed to include client self-determined goals. We concluded that it could not. Likewise, these portions of the specification do not support the explicit addition of such a feature.

[118] In light of the above, we conclude that the proposed addition to the claims on file of the feature “the professional goal comprising achieving the client’s income goal” would

constitute the addition of impermissible new matter, contrary to the requirements of section 38.2 of the *Patent Act*. As such, the remaining analysis of proposed claims-3 will not take into account this feature.

Indefiniteness

[119] Proposed claims-3 include the previously proposed amendments to delete claim 11 on file and to amend claim 9 so as to remove reference to “the next step.” We agree that these proposed amendments would overcome the identified defect of indefiniteness and would render the claims compliant with subsection 27(4) of the *Patent Act*. However, given our conclusions below in regard to statutory subject-matter and impermissible new matter, proposed claims-3 as a whole are not compliant with the *Patent Act* and *Patent Rules*.

Statutory Subject-Matter

[120] As stated in the PR letter, the proposed amendments with respect to claims 9 and 11 on file would not change the nature of the claimed invention and therefore would not alter our conclusion above as to the non-statutory nature of the claims.

[121] Following on proposals discussed at the oral hearing, the Applicant submitted further amendments to the claims on file to specify that the recommendation that may result from the rules and calculations that make up the claims on file include a calendar scheduling the dedicated days that would be required to reach an identified professional goal. These proposed amendments also specify that as a result of received updated client status information, the output calendar information can be updated.

[122] In our view, the addition of such features to the claims on file would not alter our conclusions in respect of non-statutory subject-matter. The additional features merely set out another type of output information (i.e., calendar scheduling the dedicated days), as well as a further input (i.e., update client status) and a further output (i.e., an updated calendar). The proposed claims would still represent a series of rules and calculations and the associated input and output of information, as was the case with the claims on file. Such subject-matter is akin to mental steps and scientific principles or abstract theorems. It is not directed to “something with physical existence, or something that manifests a discernable effect or change” (*Amazon* paragraph 66).

Obviousness

[123] As the subject-matter of proposed claims-3 would be narrower in scope than that of the claims on file, which we have concluded would not have been obvious, proposed claims-3 would also not have been obvious.

Sufficiency

[124] As proposed claims-3 do not provide further disclosure of how the step of identifying a professional goal is to be practiced by the person skilled in the art, or narrow the scope of the claims on file to a point where they would be enabled over their scope, the description would still be insufficient, contrary to paragraph 27(3)(b) of the *Patent Act*.

CONCLUSIONS

[125] We have determined that:

- claims 1-20 on file are directed to non-statutory subject-matter and are therefore non-compliant with section 2 of the *Patent Act*;
- claims 9 and 11 are indefinite and are therefore non-compliant with subsection 27(4) of the *Patent Act*; and
- the specification is insufficient and does not enable the practice of the claimed invention across its scope, contrary to paragraph 27(3)(b) of the *Patent Act*.

[126] We have further determined that proposed claims 1-19 submitted with the SR-PR (proposed claims-3) do not overcome the non-statutory subject-matter and insufficiency defects, and further introduce a defect of impermissible new matter. They are therefore not “necessary” for compliance with the *Patent Act* and *Patent Rules* as required by subsection 86(11) of the *Patent Rules*.

RECOMMENDATION OF THE BOARD

[127] In view of the above, the Panel recommends that the application be refused on the grounds that:

- claims 1-20 on file are directed to non-statutory subject-matter and are therefore non-compliant with section 2 of the *Patent Act*;
- claims 9 and 11 are indefinite and are therefore non-compliant with subsection 27(4) of the *Patent Act*; and
- the specification is insufficient and does not enable the practice of the claimed invention across its scope, contrary to paragraph 27(3)(b) of the *Patent Act*.

Stephen MacNeil

Alison Canteenwalla

Mara Gravelle

Member

Member

Member

DECISION OF THE COMMISSIONER

[128] I concur with the conclusion and recommendation of the Board that the application be refused on the grounds that:

- claims 1-20 on file are directed to non-statutory subject-matter and are therefore non-compliant with section 2 of the *Patent Act*;
- claims 9 and 11 are indefinite and are therefore non-compliant with subsection 27(4) of the *Patent Act*; and
- the specification is insufficient and does not enable the practice of the claimed invention across its scope, contrary to paragraph 27(3)(b) of the *Patent Act*.

[129] 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 6th day of August, 2020