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Date: 2021-03-25

TOPIC: O00 Obviousness  
C00 Adequacy or Deficiency of  
Description  
SUJET: O00 Évidence  
C00 Caractère Adéquat ou  
Inadéquat de la Description

Application No.: 2,554,462

Demande n° 2 554 462

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,554,462, having been rejected under subsection 30(3) of the *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019, has consequently been reviewed in accordance with paragraph 199(3)(c) of the *Patent Rules* (SOR/2019-251). The recommendation of the Board and the decision of the Commissioner are to refuse the application.

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## INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,554,462 which is entitled “PROVIDING A MARKETPLACE FOR WEB SERVICES” and is owned by AMAZON TECHNOLOGIES, INC. (“the Applicant”).
- [2] 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* (SOR/2019-251) (“the *Patent Rules*”). As explained in more detail below, our recommendation to the Commissioner of Patents is to refuse the application.

## BACKGROUND

### The application

- [3] The application, based on a previously filed *Patent Cooperation Treaty* application, is considered to have a filing date of January 26, 2005, and was laid open to public inspection on August 11, 2005.
- [4] The application relates to Web service (WS) transactions. More specifically, it relates to a method of facilitating transactions between electronic WS providers and consumers using an intermediary.
- [5] The claims under review are claims 1 to 86 on file, dated December 15, 2016 (“claims on file”).

### Prosecution history

- [6] On June 20, 2018, a Final Action (“FA”) was issued pursuant to subsection 30(4) of the former *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019, in which the application was rejected on the basis of obviousness and insufficiency. The FA stated that the claims on file were obvious and did not comply with section 28.3 of the *Patent Act*, and that the description did not correctly and fully describe the invention and thus did not comply with subsection 27(3) of the *Patent Act*.
- [7] On December 18, 2018, a response to the FA (“R-FA”) was filed by the Applicant. In the R-FA, the Applicant argued that the claims would not have been obvious. In the R-FA, a set of amended claims 1 to 85 was proposed (“proposed claims”) to overcome the

obviousness defect raised in the FA. The Applicant also proposed amendments to the description to be consistent with the language of the proposed claims. The Applicant further argued that the specification enabled the skilled person to make and use the claimed invention.

- [8] Since the Examiner maintained the position that the application did not comply with section 28.3 and subsection 27(3) of the *Patent Act* after considering the R-FA and the proposed claims, the application was forwarded to the Board on March 4, 2019, along with a Summary of Reasons (SOR), explaining the Examiner’s rationale for identifying the defects.
- [9] The SOR was forwarded to the Applicant on March 6, 2019. In a letter dated May 22, 2019, the Applicant expressed continued interest in having the application reviewed by the Board.
- [10] The present panel (“the Panel”) was formed to review the application under paragraph 199(3)(c) of the *Patent Rules*.
- [11] In a preliminary review letter dated January 11, 2021 (“PR letter”), the Panel presented its preliminary analysis and rationale and was of the preliminary view that the claims on file would have been obvious and thus did not comply with paragraph 28.3(b) of the *Patent Act*, and that the specification enabled the skilled person to make and use the claimed invention and complied with subsection 27(3) of the *Patent Act*. The Panel further considered that the proposed claims and the proposed amendments to the description would not constitute “necessary” amendments as required by subsection 86(11) of the *Patent Rules* since the proposed claims would have been obvious to the skilled person. The PR letter also offered the Applicant the opportunities to make written submissions and to attend an oral hearing.
- [12] In an email communication dated February 9, 2021, the Applicant indicated that they did not wish to participate in the oral hearing and would not make further written submissions.

## **ISSUE**

- [13] There are two issues to be addressed in this review:
- whether the claims on file define subject-matter that would have been unobvious, as required by section 28.3 of the *Patent Act*; and

- whether the specification enables the skilled person to practise the claimed invention, as required by subsection 27(3) of the *Patent Act*.

[14] In this review, we will first address the obviousness issue. Second, we will consider the sufficiency issue. Finally, we will consider the proposed claims.

## **LEGAL PRINCIPLES AND OFFICE PRACTICE**

### Purposive construction

[15] Following the decision of the Federal Court of Canada in *Choueifaty v Canada (AG)* 2020 FC 837 [*Choueifaty*], the Patent Office issued “Patentable subject-matter under the *Patent Act*,” (CIPO, November 2020) [*PN2020-04*]. *Choueifaty* (at paragraphs [31] to [40]) emphasizes the importance of following the principles of purposive construction, when determining whether claimed elements are essential or non-essential, as set out in *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*Free World Trust*] and *Whirlpool Corp v Camco Inc*, 2000 SCC 67 [*Whirlpool*].

[16] In accordance with *Free World Trust*, essential elements are identified through a purposive construction of the claims done by considering the whole of the disclosure, including the specification and drawings (see also *Whirlpool* at paragraphs [49] and [52]). Whether or not an element is essential depends both on the intent expressed in or inferred from the claim, and on whether it would have been obvious to the skilled person that a variant has a material effect upon the way the invention works (*Free World Trust* at paragraphs [55], [57], and [59]). Since the purposive construction of a claim takes into account what the skilled person would understand to be the nature of the invention, it is necessary to identify the skilled person and their relevant common general knowledge (CGK).

### Obviousness

[17] The *Patent Act* requires that the subject-matter of a claim not be obvious. Section 28.3 of the *Patent Act* states:

- 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.

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

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

### Enablement

[19] A review of the prosecution of the present application indicates that the objection in the FA under subsection 27(3) of the *Patent Act* is directed to the question of whether the specification of the application enables the skilled person to practise the claimed invention.

[20] Paragraph 27(3)(b) of the *Patent Act* reads that the specification of an invention must:

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[.]

[21] A positive determination that the specification complies with paragraph 27(3)(b) of the *Patent Act* requires that, having only the specification, the person of skill in the art be able to practise the invention using only the instructions contained in the disclosure (*Teva Canada Ltd v Novartis AG*, 2013 FC 141 [*Teva FC*], citing *Teva Canada Ltd v Pfizer Canada Inc*, 2012 SCC 60 and *Consolboard Inc v MacMillan Bloedel (Sask) Ltd* (1981), 56 CPR (2d) 145 (SCC)). Although the CGK can be relied upon, the person of skill in the art should not be called upon to display inventive ingenuity or undertake undue experimentation.

## ANALYSIS

### Purposive construction

#### *The person skilled in the art*

[22] In the PR letter (page 5), the Panel adopted the identification of the person skilled in the art as stated in the FA:

The skilled person is skilled in the fields of computer programming, web services, e-commerce and business methods associated with e-commerce.

[23] The Applicant has not disputed this characterization and we adopt it in this review.

#### *The common general knowledge*

[24] In the PR letter (page 5), the Panel adopted the identification of the CGK used in the FA:

The FA (page 2) considered certain parts of the following documents as CGK:

<b>D1:</b> US 2003/0195813	October 16, 2003	Pallister et al.
<b>D3:</b> WO 02/063501	August 15, 2002	Stennicke
<b>D4:</b> WO 01/01276	January 4, 2001	Lazarus et al.

The FA (page 2) identified the CGK of the skilled person as:

The skilled person is familiar with e-commerce systems which sell/provide access to “web services”. The skilled person would also be aware that the term “web services” may refer to software functionality which may be provided over the internet, such as APIs (application program interfaces), for example as returning XML data over HTTP to a client in response to a web service request specified as a URL (see description page 2 lines 4-16), i.e. providing a webpage and/or associated functionality to a user/client over the Internet. A skilled person, such as one who is familiar with business methods relating to e-commerce is also aware that “web service” may also refer to technology that is delivered to a consumer or business over the Internet. Typically, this is done by a software company that sells software to its customers as a service (see applicant’s response of 2015-10-07 page 16 last paragraph). The skilled person is aware of the idea of selling various types of products and services over the internet by an “intermediary”, including “web services” over the internet (see D1, D3 and D4).

[25] The Applicant has not disputed this characterization and we adopt it in this review.

[26] Additionally, the following documents were relied upon by the PR letter to more clearly

establish the CGK:

**D5:** Web Services Architecture, W3C Working Draft, November 14, 2002

**D6:** Web Services Conceptual Architecture (WSCA 1.0), IBM, May 2001

[27] Based on certain points of CGK extracted from D5 and D6, the “Background” section of the present application, and the R-FA (page 17), the Panel also considered the following knowledge as CGK in the PR letter:

- Knowledge regarding design, implementation, operation, and maintenance of a computerized intermediary, such as an electronic marketplace, between consumers and WS providers, using conventional computer technologies and conventional communications networks, including design, implementation, and operation of components performing the following functionalities (D5: section 3):
  - registering consumers and providers (D5: section 3.1);
  - storing a list of available WS providers and providing WS provider details in response to provider lookup requests (D5: section 3.1, 3.3.4.2); and
  - providing application program interfaces for consumers and providers to communicate with the intermediary via communications networks (D5: section 3.1);
- Knowledge regarding design and implementation of billing and payment functions for WS in an intermediary (D6: “Intermediaries”); and
- Knowledge regarding buyer and seller account management functions such as purchase/sell histories provided by electronic marketplaces (it was well known that online electronic marketplaces such as *ebay.com* and *amazon.com* provided account management functions to both consumers and providers of goods and services before claim date of the present application).

[28] The Applicant has not disputed this further identification and we adopt it in this review.

#### *The essential elements*

[29] There is no evidence leading to a determination of any claimed elements being non-essential and there is no claim language indicating any of the elements to be optional, a preferred embodiment, or one of a list of alternatives. Therefore, all the claimed elements are presumed to be essential.

#### *Claim scope*



[30] In the PR letter (pages 6 to 7), we provided our estimation of the expression “invoking an application on behalf of a consumer by an intermediary,” which is used in the claims. The scope of this expression is considered to be significant to our analysis:

According to the present application, after a “WS access request” is received from a service requestor, a “WS invoker” in the intermediary performs interactions with one or more WS providers to invoke appropriate WS from a WS provider and to receive response information (pages 22, 30, and 31; Fig. 6).

After considering the specification as a whole, in view of the nature of the skilled person with their CGK, we provide our estimation of the skilled person’s understanding of the term for this review:

- “Invoking an application on behalf of a consumer by an intermediary”: after receiving a WS invocation request, an intermediary communicates with a WS provider to invoke the requested WS, wherein the same intermediary receives response information relating to the invocation request from the provider and passes the response information back to the consumer. During the invocation process, the consumer does not directly send the invocation request to the WS provider. Instead, the invocation request is either relayed by the intermediary to the WS provider, or received and repackaged by the intermediary before being sent to the WS provider.

[31] The Applicant has not disputed this estimation and we adopt it in this review.

### Obviousness

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

[32] The person skilled in the art has been identified above at paragraph [22].

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

[33] The relevant CGK of the skilled person has been identified above at paragraphs [24] and [27].

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

[34] As explained above, we have taken into account all the elements of the claims for our consideration of obviousness.

[35] There are 86 claims on file, including independent claims 1, 82, and 84, and dependent claims 2 to 81, 83, 85, and 86. In our view, claim 1 is representative of the claims on file:

1. A computer-implemented method comprising:

registering, by one or more computing systems that provide an electronic marketplace for use as an intermediary to enable access to Web services, and in response to registration requests from multiple Web service providers, multiple Web services with the electronic marketplace that are each available by a programmatic interaction of a remote application via a defined application program interface to exchange information, wherein the registered Web services are available for purchase via the electronic marketplace by Web service consumers and each has at least one associated use price;

providing, by the one or more computing systems, information about the registered Web services to multiple consumers of Web services;

in response to an access request received from a first consumer of the multiple consumers, performing, by the one or more computing systems, a sale to the first consumer for access to an indicated Web service of the registered Web services in exchange for an access fee from the first consumer that is based on a use price associated with the indicated Web service;

providing, by the one or more computing systems and for the first consumer after the sale, access to the indicated Web service, including invoking, by an application of the electronic marketplace over one or more computer networks and via a defined application program interface, the indicated Web service from a provider of the indicated Web service on behalf of the first consumer, and further including providing response information from the invoking to the first consumer;

providing, by the one or more computing systems, payment to the provider of the indicated Web service based on the access fee from the first consumer; and

providing, by the one or more computing systems and in response to a request from the first consumer, information to the first consumer about one or more prior invocations of the indicated Web service that have been performed on behalf of the first consumer, to enable the first consumer to monitor the prior invocations.

[36] Independent claims 82 and 84 recite similar elements as claim 1 and will not be discussed separately in this review.

[37] Additional features of the dependent claims will be considered at step (4).

*(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*

[38] In the FA, D1 was cited as representing the “state of the art.”

[39] Additionally, the PR letter (page 8) identified another document as relevant prior art:

- D7: US 2003/0191677 A1 October 9, 2003 Akkiraju et al.

[40] D7 discloses a system and method for providing electronic commerce WS from a variety of service providers to customers through an intermediary, wherein the intermediary uses a

“Common Alliance Interface” to communicate with customers and uses a “Webservice interface” to communicate with service providers. In this review, we consider that D7 is the closest art. D1 will not be considered further.

[41] In the PR letter (pages 8 to 9), the Panel presented its preliminary view that D7 disclosed the following elements of independent claim 1:

In our preliminary view, D7 discloses the following features of claim 1:

- registering, by one or more computing systems that provide an electronic marketplace for use as an intermediary to enable access to WSs, and in response to registration requests from multiple WS providers, multiple WSs with the electronic marketplace that are each available by a programmatic interaction of a remote application via a defined application program interface to exchange information, wherein the registered WSs are available for purchase via the electronic marketplace by WS consumers and each has at least one associated use price (D7: paragraphs [0012] and [0020]; Figure 2; “an intermediary and independent process that can interact with all types of services, including Web Services”; a registry containing information of all available service providers is stored locally in the Business Process Layer; program interfaces Common Alliance Interface and Webservice Interface are structured between customers and the intermediary, and providers and the intermediary, respectively);
- providing, by the one or more computing systems, information about the registered WSs to multiple consumers of WSs (D7: paragraphs [0014] and [0020]);
- in response to an access request received from a first consumer of the multiple consumers, performing, by the one or more computing systems, a sale to the first consumer for access to an indicated WS of the registered WSs in exchange for an access fee from the first consumer that is based on a use price associated with the indicated WS (D7: paragraphs [0014], [0054], [0062], [0070] to [0073]; Figure 2, Figure 4); and
- providing, by the one or more computing systems and for the first consumer after the sale, access to the indicated WS, including invoking, by an application of the electronic marketplace over one or more computer networks and via a defined application program interface, the indicated WS from a provider of the indicated WS on behalf of the first consumer, and further including providing response information from the invoking to the first consumer (D7: paragraphs [0020], [0038] to [0041]; Figure 2, Figure 4; the intermediary receives a service request from a consumer and splits the user request, “so that separate requests are created for each SSP with an entry for the requested service in the UDDI Registry 210. The Business Process Layer then generates appropriate method signatures for each of the split requests and sends an XML string corresponding to each method signature to the respective Adaptation Layer 222, via the Webservice Interface 214, to invoke the requested service.” In this case, the intermediary invokes multiple WSs via the Webservice Interface on behalf of the consumer and receives responses from multiple services providers).

[42] Given the analysis above, regarding the differences between D7 and the claimed subject-

matter of the independent claims, the Panel identified that D7 did not disclose or teach (page 10 of the PR letter):

(i) providing, by the one or more computing systems, payment to the provider of the indicated WS based on the access fee from the first consumer; and

(ii) providing, by the one or more computing systems and in response to a request from the first consumer, information to the first consumer about one or more prior invocations of the indicated WS that have been performed on behalf of the first consumer, to enable the first consumer to monitor the prior invocations.

[43] The Applicant has not disputed this identification and we adopt it in this review.

*(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?*

[44] In the PR letter (page 10), the Panel explained why features (i) and (ii) would have been obvious to the skilled person in view of D7 and the CGK:

Regarding difference (i), although D7 does not explicitly disclose providing payment to WS providers, D7 discloses that billing information is provided by the providers in response to service requests received at the intermediary, which are then forwarded to the consumer (D7: paragraphs [0070] to [0073]). Since the consumer does not communicate with the providers directly, it naturally follows that the payment from the consumer is provided to the provider via the intermediary. Furthermore, it was CGK that WS intermediaries were often used to perform billing and payment functions before the claimed date (e.g., W3C clearly mentioned this functionality in D5). Therefore, it is our preliminary view that difference (i) would have been obvious to the skilled person as a straightforward implementation choice.

Regarding difference (ii), referring to our identification of the CGK above, users of an online electronic marketplace were typically provided online access to their account information such as account status and account transaction history data. For the skilled person with relevant knowledge regarding implementations of intermediaries providing WS to users, it is our preliminary view that this identified difference would have been obvious.

Furthermore, as recited by the Applicant in the R-FA (page 17), “[t]he claimed use of a computing system to act as an intermediary to invoke a web service from a remote provider on behalf of the customer, and relay the web service’s response to the customer, is a feature whose inventiveness resides primarily in its conception.” The “conception” of using an intermediary to facilitate WS invocations between consumers and providers is disclosed by D7. Furthermore, this functionality has no interactions with the claimed payment processing or monitoring functions of the intermediary. In our preliminary view, combining the invocation feature with the claimed payment processing and monitoring features does not introduce additional functionality beyond their known separate functions.

Therefore, in our preliminary view, independent claims 1, 82, and 84 would have been obvious to the skilled person based on the teachings of D7 in light of the CGK.

[45] The PR letter (pages 11 to 12) also provided our rationale as to why the dependent claims would have been obvious:

Dependent claims 2 to 81, 83, 85, and 86 share the same set of the inventive concept elements as claims 1, 82, and 84. Additionally, they recite further features.

Claims 2, 3, 10, 15, 16, 21 to 35, and 77 to 80 recite registration, pricing, and subscription management features. It was well-known before the claim date of the present application that online commercial services providers, such as electronic marketplaces, often utilized various registration, pricing, and subscription management functions. In view of the CGK and the lack of implementation details of these functionalities in the present application, it is our preliminary view that these administrative features are part of the CGK of the skilled person.

Claims 4, 5, 36 to 38, 40, and 41 recite monitoring and notification functions of the intermediary. These are preliminarily considered to be well-known features of conventional electronic marketplaces serving online customers and providers.

Claims 7 to 9, 19, 20, and 48 to 56 are directed to composite WS and multiple WS invocations. D7 discloses similar features in paragraphs [0039] to [0042]. Therefore, it is our preliminary view that these features would have been obvious to the skilled person.

Claims 6, 11, 12, 17, 18, 39, 42 to 47, and 59 recite features relating to security and privacy such as access control features. It is well-known that security and access control features are considered necessary functionalities of online electronic marketplaces. In view of the CGK and the lack of implementation details of these functionalities in the present application, it is our preliminary view that these features are part of the CGK and would have been obvious to the skilled person.

Claims 14 and 70 recite that the Web store sells items other than WSs. This feature is preliminarily considered to be part of the CGK since many electronic marketplace websites, such as *ebay.com* and *amazon.com*, had this functionality well before the claim date of the present application.

Claims 57, 58, 74, and 75 recite that consumers are prevented from directly invoking indicated WS, and information about how to invoke the WS is obfuscated. D7 discloses these features in paragraphs [0039] to [0041].

Claims 13, 60 to 69, and 71 to 73 recite functions relating to searching requests and responses to the searching requests of providers. Some of the recited information includes recommendations, reviews, and ratings of the providers listed. These features are preliminarily considered well-known features of electronic marketplaces. They were widely available in electronic marketplaces such as *ebay.com* and *amazon.com* before the claim date of the present application.

Claims 76 and 81 recite storing response information provided previously to a consumer and using the stored response information in response to subsequent access requests. In paragraph [0046], D7 discloses that a database in the intermediary may be used to store

information from various service providers. In our preliminary view, it would have been obvious for the skilled person to implement automatic responses to requests from consumers in an intermediary, utilizing stored service provider information in a database located inside the intermediary.

Claims 83, 85, and 86 recite similar features presented in claims 1, 82, and 84. As discussed above, we preliminarily consider that these features would have been obvious to the skilled person.

In summary, we are of the preliminary view that the claimed features of the dependent claims 2 to 81, 83, 85, and 86, when considered alone or in combination with other features of the claimed subject-matter, do not introduce any additional inventive features.

Consequently, all dependent claims would have been obvious to the skilled person in view of D7 and the CGK.

[46] The Applicant has not disputed the analysis above.

#### *Conclusion on obviousness*

[47] We consider that the claimed subject-matter of claims 1 to 86 on file would have been obvious to the skilled person. Therefore, the claims on file do not comply with paragraph 28.3(b) of the *Patent Act*.

#### Enablement

[48] In the FA (pages 6 to 7), the Examiner indicated that the description did not set out clearly the steps and their necessary sequence in the process in such full, clear, concise and exact terms as to enable a person skilled in the art to practise the invention. The examiner further argued that the present application “recite[s] the features of the claim in desired result claim language, a wish list of desired functionalities. There appears to be no specific details on how to go about achieving any of the claimed desired results, or how to integrate any of the features with each other in order to achieve the claimed e-commerce functionality.”

[49] In the R-FA (page 17), the Applicant argued that:

In the present case, before the 2004 claim date of the present application, the skilled reader would have separately known (1) how to cause a client or customer computer to invoke a web service (WS) from a remote WS provider, and (2) how to cause a computer to send information to another computer over a network. The claimed use of a computing system to act as an intermediary to invoke a web service from a remote provider on behalf of the customer, and relay the web service’s response to the customer, is a feature whose inventiveness resides primarily in its conception. Once informed of the invention as conceived, the notional skilled person would not require any further information to make or technically implement a working embodiment, because they would already have the required

enabling knowledge in the form of their knowledge of separate tasks (1) and (2) mentioned at the beginning of this paragraph.

Thus, although the conception of using a computing system as an intermediary to invoke a WS from a remote WS provider on the customer's behalf may be inventive, its technical implementation does not require any additional enabling knowledge or details that the notional skilled person would not already have.

...

Applicant therefore respectfully submits that the specification meets and exceeds the requirements of section 27(3) [emphasis in the original].

[50] As explained in the PR letter (page 14), we consider that the specification enables the skilled person to practise the claimed invention:

As indicated in the CGK section above, we preliminarily agree that the knowledge of how to implement the features of invoking a WS from a remote WS provider on the customer's behalf, WS service product registration, consumer subscription, and WS Marketplace Portal are part of CGK of the skilled person. Therefore, we are of the preliminary view that the claims are fully supported and the description does not suffer from enablement issues for the following reasons.

We consider the objections under subsection 27(3) of the *Patent Act* raised in the FA are substantially directed to the one question of whether the specification enables the skilled person to make or use the claimed invention. In our preliminary view, based on the specification as a whole and our identification of the CGK, we consider that the WS marketplace as recited comprises well-known components to perform functions such as consumer subscription, provider subscription, provider lookup, usage monitoring for both consumers and providers, and invocation of WS from the marketplace, since the specification does not provide any specific technical implementation requirements on claimed features, or any specific implementation details regarding the constructions of the claimed components. As the design and implementation of these feature and components are considered to be CGK, the skilled person would understand how the invention works and how to implement these features and functions using widely available hardware and software components, having only the specification and his or her knowledge of the CGK. As explained in *Teva FC*, paragraph [292], “[e]very skilled person brings to the reading of a patent his knowledge of the field in which the patent operates. The person of ordinary skill in the art would be expected to bring to his reading of the patent a foundation of common general knowledge that would enable him or her to understand and practise the patent.” In this case, we are of the preliminary view that a skilled person would be able to practise the claimed subject-matter of the present application based on the specification and the CGK.

Therefore, it is our preliminary view that the specification complies with the requirements of subsection 27(3) of the *Patent Act*.

[51] The Applicant has not disputed this analysis.

Proposed claims

[52] In the PR letter (pages 14 to 16), the Panel explained why we did not consider the proposed claims to be “necessary” amendments under subsection 86(11) of the *Patent Rules*:

The proposed claims add features of claims 57 to 58 of the claims on file to independent claims 1, 82, and 84 on file (page 2 of the R-FA). More specifically, these features recite:

- preventing the first consumer from directly invoking the indicated Web service, wherein preventing comprises obfuscating information about how to invoke the indicated Web service in information made available to the first consumer.

Additionally, the following feature was deleted from claim 1 on file:

- providing, by the one or more computing systems and in response to a request from the first consumer, information to the first consumer about one or more prior invocations of the indicated Web service that have been performed on behalf of the first consumer, to enable the first consumer to monitor the prior invocations.

As discussed in the Obviousness section, features of claims 57 and 58 on file were disclosed by D7. More specifically, D7 discloses that (paragraph [0041]):

However, the UDDI Registry - as well as the Business Process Layer - are transparent to the user. The user/customer simply requests the desired e-Logistics service. The Common Alliance Interface 201 then splits this user request so that separate requests are created for each SSP with an entry for the requested service in the UDDI Registry 210. The Business Process Layer then generates appropriate method signatures for each of the split requests and sends an XML string corresponding to each method signature to the respective Adaptation Layer 222, via the Webservice Interface 214, to invoke the requested service. The request is then sent to the appropriate Shipping Service Provider (SSP) Legacy Application 221 (which corresponds to server 110). A response is sent back by the Legacy Application 221, aggregated if necessary for a particular SSP and converted to an appropriate XML string (using the Web Services Definition Language) by the Adaptation Layer 222, and sent to the Business Process Layer via the Web service Interface 214. Requests from multiple SSPs are then aggregated at the Common Alliance Interface 201 for presentation to the user/customer (emphases added).

It is clear from the paragraph above that the consumer is prevented from directly invoking the WS and has no knowledge of the actual invocation process. The Business Process Layer inside the intermediary parses the service request from the consumer and sends invocation requests to service provider(s) on behalf of the consumer.

Therefore, it is our preliminary view that the additional features of claims 1, 81, and 83 of the proposed claims would have been obvious to the skilled person with their CGK and in view of the teachings of D7. These features, when considered alone or in combination with other features of the claimed subject-matter, would have been obvious to the skilled person.

Dependent claim 57 of the proposed claims corresponds to the deleted features from claim 1 on file. Dependent claims 2 to 56, 58 to 80, 82, and 84 to 85 [of the proposed claims] correspond to dependent claims 2 to 56, 59 to 81, 83, and 85 to 86 [on file], respectively.



Since there is no additional feature in these claims, we are of the preliminary view that these claims would have been obvious for the same reasons stated above.

[53] The Applicant has not disputed this analysis.

[54] Since the Panel is of the view that the proposed claims would have been obvious to the skilled person and cannot be considered “necessary” amendments under subsection 86(11) of the *Patent Rules*, it is not necessary to consider the insufficiency issue for the proposed claims.

## CONCLUSIONS

[55] We are of the view that:

- claims 1 to 86 on file would have been obvious and thus do not comply with paragraph 28.3(b) of the *Patent Act*;
- the specification enables the skilled person to make and use the claimed invention and thus complies with subsection 27(3) of the *Patent Act*; and
- the proposed claims 1 to 85 cannot be considered “necessary” amendments under subsection 86(11) of the *Patent Rules*.

## RECOMMENDATION OF THE BOARD

[56] In view of the above, the Panel recommends that the application be refused on the ground that all claims on file would have been obvious and therefore do not comply with paragraph 28.3(b) of the *Patent Act*.

Liang Ji

Leigh Matheson

Robilyn Vanos

Member

Member

Member



**DECISION OF THE COMMISSIONER**

[57] I concur with the findings of the Board and its recommendation that the application should be refused because the claims on file would have been obvious and do not comply with paragraph 28.3(b) of the *Patent Act*.

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

Virginie Ethier

Assistant Commissioner of Patents

Dated at Gatineau, Quebec,

This 25<sup>th</sup> day of March, 2021