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Commissioner's Decision #1600
Décision du Commissaire nº 1600
Date: 2021-11-05

TOPIC:	O00	Obviousness
	B00	Indefiniteness
SUJET:	O00	Évidence
	B00	Indéfini

Application No. : 2,592,742

Demande nº 2 592 742

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,592,742, 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 require the Applicant to make necessary amendments to the application, failing which the application would be refused .

Agent for the Applicant:

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INTRODUCTION

[1] This recommendation concerns the review of rejected Canadian patent application number 2,592,742 which is entitled “IMPROVING ADVERTISEMENT APPROVAL” and is owned by GOOGLE LLC (“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 require the Applicant to make necessary amendments to the application, failing which the application would be refused.

BACKGROUND

The application

[3] The application, based on a previously filed *Patent Cooperation Treaty* application, is considered to have a filing date of December 27, 2005, and was laid open to public inspection on July 13, 2006.

[4] The application relates to online advertising. More specifically, it relates to a method and system for automatically approving online advertisements based on predetermined policy rules.

[5] The claims under review are claims 1 to 22 on file, dated February 15, 2017 (“claims on file”), which were rejected in the FA.

Prosecution history

[6] On June 12, 2018, the FA was issued pursuant to subsection 30(4) of the *Patent Rules* (SOR/96-423) as they read immediately before October 30, 2019 (“the former *Rules*”), in which the application was rejected on the basis of obviousness. The FA stated that the claims on file were obvious and did not comply with section 28.3 of the *Patent Act*.

[7] On December 12, 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 22 were also proposed ("the proposed claims") to overcome the obviousness defect raised in the FA.

[8] Since the Examiner maintained the position that the application did not comply with section 28.3 of the *Patent Act* after considering the R-FA, the application was forwarded to the Board on March 19, 2019, along with a Summary of Reasons (SOR), explaining the Examiner's rationale for identifying the defect.

[9] The SOR was forwarded to the Applicant on March 22, 2019. In a letter dated July 25, 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 August 5, 2021 ("PR letter"), the Panel presented its preliminary analysis and rationale, and was of the preliminary view that:

- claims 1, 2, 6 to 12, 18 to 20, and 22 on file would not have been obvious and comply with section 28.3 of the *Patent Act*;
- claims 3 to 5, 13 to 17, and 21 on file would have been obvious and do not comply with paragraph 28.3(b) of the *Patent Act*;
- claim 2 on file is indefinite and does not comply with subsection 27(4) of the *Patent Act*; and
- the proposed claims are considered a "necessary" amendment under subsection 86(11) of the *Patent Rules*.

[12] The PR letter also offered the Applicant the opportunities to make written submissions and to attend an oral hearing.

[13] In a letter dated September 17, 2021, the Applicant stated that they would be satisfied with a decision that corresponds to the view expressed in the PR letter.

[14] No further written submission has been received.

ISSUE

[15] This review will address the following issues:

- 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 claims on file are definite and thus comply with subsection 27(4) of the *Patent Act*.

[16] In this review, we will first consider the obviousness and indefiniteness issues that pertain to the claims on file. We will then consider whether the proposed claims constitute amendments necessary for compliance with the *Patent Act* and *Patent Rules*.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Purposive construction

[17] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66, and *Whirlpool Corp v Camco Inc*, 2000 SCC 67, purposive construction is performed from the point of view of the person skilled in the art in light of the relevant common general knowledge (CGK), considering the whole of the disclosure including the specification and drawings. In addition to interpreting the meaning of the terms of a claim, purposive construction distinguishes the essential elements of the claim from the non-essential elements. Whether or not an element is essential depends 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.

[18] "Patentable Subject-Matter under the *Patent Act*" (CIPO, November 2020) [*PN2020–04*] also discusses the application of these principles, pointing out that all elements set out in a claim are presumed essential unless it is established otherwise or such presumption is contrary to the claim language.

Obviousness

[19] 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.

[20] 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?

<u>Indefiniteness</u>

[21] Subsection 27(4) of the *Patent Act* requires that a claim 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.

[22] In *Minerals Separation North American Corp v Noranda Mines Ltd*, [1947] Ex CR 306, 12 CPR 99, at page 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.

ANALYSIS

[23] In the FA, the following documents were referenced:

D1: US 2004/0073484A1	April 15, 2004	Camporeale et al.
D2: KR 20030044189A	June 9, 2003	Jung
D3: US 2004/0054661A1	March 18, 2004	Cheung et al.
D4: US 6,493,744B1	December 10, 2002	Emens et al.

D5: “Use standard redirects: don’t break the back button!”, W3C, available at https://web.archive.org/web/20040719025558/http://www.w3.org/QA/Tips/reback, archived July 19, 2004.

[24] D1 discloses a system for electronic display advertising in which advertisers are presented with advertising venues for automated display of selected advertisements. D2 discloses a system and method for advertising on the Internet wherein targeted advertisements are displayed to a user if predetermined conditions are met. D3 discloses a method and system for improving Internet search results via automatic assessment of candidate search listings. D4 discloses an automatic method for rating data files for objectionable contents in a distributed computer system. D5 provides web page design guidelines regarding redirects.

<u>Purposive construction</u>

The person skilled in the art and their common general knowledge

[25] The FA (page 2) identified the skilled person and their CGK as:

> The skilled person is skilled in the fields of computer, software engineering and online advertising technologies.
>
> …

> The skilled person is familiar with different types of ideas for providing ads on web pages and administering said online ads (see original description, pars. [0002] - [0005]). In particular, the skilled person is familiar with automatically administering online ads such that they comply with predetermined policies, for example as demonstrated in D1-D4.

[26] In the R-FA (page 2), the Applicant disagreed with the above identification and argued that “D1-D4 do not necessarily form part of the common knowledge” and “do not suggest automatically administering online ads such that they comply with predetermined policies”.

[27] Since the Applicant did not provide a definition of the skilled person and their CGK, and did not agree with the identification of the FA, based on the “Background Information” section of the present application, we identified the skilled person in the PR letter as:

- A team of persons skilled in the field of online advertisement administration systems and technologists experienced with developing and providing the software, tools and infrastructure conventionally used to support the activities and designs of such systems.

[28] The Applicant did not dispute this characterization and we adopt it in this review.

[29] In the PR letter, we also relied upon the following documents to more clearly establish the CGK:

D6: “MARK TWAIN FORUM: Survival Guide,” August 28, 1998, available at http://www.twainweb.net/surv.html

D7: HTML 4.0 Specification, W3C Recommendation, April 24, 1998, available at https://www.w3.org/TR/1998/REC-html40-19980424/

[30] D6 describes some typical web-based content posting management rules. D7 is the HTML 4.0 standard from W3C, which specifies the publishing language of the World Wide Web.

[31] Based on certain points of CGK extracted from D1 to D7 and the “Background Information” section of the present application, the PR letter identified the following knowledge as CGK:

- Knowledge regarding design, implementation, operation, and maintenance of a computerized online content management system, the online content including online advertisements (see D1);
- Knowledge of well-known techniques of online content review based on certain predetermined rules, including providing hints and suggestions regarding how to improve rejected contents to comply with the rules (see D6: “rejected postings” as a typical example); and
- Knowledge of well-known guidelines of web page design, including guidelines on designing linked resources (see D7: section 12.1.1, which provides guidelines and examples on providing a link “for more information”).

[32] The Applicant did not dispute this identification and we adopt it in this review.

Meaning of “policy rules”

[33] The term “policy rules” is considered to be significant to our analysis. The PR letter provided our estimation of how the skilled person would interpret this term:

> Although the specification does not provide a definition of the term “policy rules,” it recites that they may include suggestions for correction, and simple rules such as rules regarding spelling, spacing, capitalization, inappropriate text, and trademark violations (paragraph [0039]). Further, claims on file also recite that “wherein each policy rule of the one or more policy rules specifies a policy type that indicates where in the advertisement to apply the policy rule and data.”
>
> 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 this term:
>
> - “Policy rules”: one or more rules that are used to verify that an online advertisement complies with said rules.

[34] The Applicant did not dispute this further identification and we adopt it in this review.

The essential elements

[35] There are 22 claims in the claims on file, including independent claims 1, 3, 13, 15, and 21, and dependent claims 2, 4 to 12, 14, 16 to 20, and 22.

[36] Independent claims 1, 3, 13, and 15 are directed to methods. Claim 21 is directed

to an apparatus. The independent claims are reproduced below:

1. A computer-implemented method for improving advertisement approval, the method comprising:

a) accepting an advertisement, by an automated ad policy checking component of a computer system including at least one computer, for use with an online ad serving system;

b) automatically checking, by the automated ad policy checking component, the advertisement for compliance with one or more policy rules of the online ad serving system to generate automatic checking results, wherein each policy rule of the one or more policy rules specifies a policy type that indicates where in the advertisement to apply the policy rule and data to collect to check for a violation;

c) automatically determining, by the automated ad policy checking component, whether or not to approve the advertisement using the automatic checking results; and

d) if it was determined to approve the advertisement, then at least initially permitting, by the automated ad policy checking component, the advertisement to be served by the online ad serving system, and if it was determined not to approve the advertisement, then at least initially inhibiting, by the automated ad policy checking component, the advertisement from being served by the ad serving system,

wherein if it was determined to approve the advertisement, then further scheduling, by the automated ad policy checking component, a follow up check of the advertisement,

wherein the advertisement includes a link to a landing page, and wherein the follow up check tests the landing page for compliance with policy rules, and wherein the policy rules include at least one of (A) ensuring that the ad landing page generates no pop-ups, and (B) ensuring that the ad landing page does not disable a “back” operation in a browser.

3. A computer-implemented method for improving advertisement approval, the method comprising:

a) accepting an advertisement, by an automated ad policy checking component of a computer system including at least one computer, for use with an online ad serving system;

b) automatically checking, by the automated ad policy checking component, the advertisement for compliance with one or more policy rules of the online ad serving system to generate automatic checking results, wherein each policy rule of the one or more policy rules specifics a policy type that indicates where in the advertisement to apply the policy rule and data to collect to check for a violation;

c) automatically determining, by the automated ad policy checking component, whether or not to approve the advertisement using the automatic checking results; and

d) if it was determined not to approve the advertisement, then providing, by the automated ad policy checking component, hints for making the ad comply with one or more violated policy rules to at least one of (A) an advertiser associated with the ad, and (B) an ad serving system customer service representative.

13. A computer-implemented method for improving advertisement approval, the method comprising:

a) accepting an advertisement, by an automated ad policy checking component of a computer system including at least one computer, for use with an online ad serving system;

b) automatically checking, by the automated ad policy checking component, the advertisement for compliance with one or more policy rules of the online ad serving system to generate automatic checking results, wherein each policy rule of the one or more policy rules specifics a policy type that indicates where in the advertisement to apply the policy rule and data to collect to check for a violation; and

c) automatically determining, by the automated ad policy checking component, whether or not to approve the advertisement using the automatic checking results, wherein each of the one or more policy rules includes a suggestion for avoiding a violation of the policy rule.

15. A computer-implemented method for improving advertisement approval, the method comprising:

a) accepting an advertisement, by an automated ad policy checking component of a computer system including at least one computer, for use with an online ad serving system;

b) automatically checking, by the automated ad policy checking component, the advertisement for compliance with one or more policy rule of the online ad serving system to generate automatic checking results, wherein each policy rule of the one or more policy rules specifics a policy type that indicates where in the advertisement to apply the policy rule and data to collect to check for a violation; and

c) automatically determining, by the automated ad policy checking component, whether or not to approve the advertisement using the automatic checking results, wherein each of the one or more policy rules includes a link, executable by an ad delivery system customer service representative but not by an advertiser, to find further information about the policy rule.

21. Apparatus comprising:

> a) at least one processor; and
>
> b) at least one storage device storing processor executable instructions which, when executed by the at least one processor, cause the at least one processor to perform the method of any one of claims 1 to 20.

[37] According to *PN2020–04*, purposive construction is conducted by considering where the skilled person would have understood the Applicant to have intended to place the fences around the monopoly being claimed.

[38] Considering the whole of the specification, the skilled person would understand that there is no use of language in the claims indicating that any of the elements are optional, a preferred embodiment, one of a list of alternatives, or otherwise non-essential. Therefore, all elements recited in each of the claims are presumed to be essential.

<u>Obviousness</u>

(1)(a) Identify the notional "person skilled in the art"

[39] The person skilled in the art has been identified above at paragraphs [27].

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

[40] The relevant CGK of the skilled person has been identified above at paragraph [31].

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

[41] As previously explained, all claimed elements are presumed to be essential for this review. Therefore, we take into account all elements of the claims for consideration of obviousness.

(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

[42] In the FA, D1 to D5 were cited for the obviousness objection. Additionally, the following document came to our attention during the preliminary review:

D8: US 2002/0188527A1 December 12, 2002 Dillard et al.

[43] D8 discloses a system and method for managing online promotions. For this review, D8 is considered to be the closest prior art.

[44] The PR letter explained that D8 disclosed the following elements of independent claims 1, 3, 13, and 15:

- accepting an advertisement, by an automated ad policy checking component of a computer system including at least one computer, for use with an online ad serving system (D8: Fig. 2, paragraphs [0067], [0082], and [0083]);
- automatically checking, by the automated ad policy checking component, the advertisement for compliance with one or more policy rules of the online ad serving system to generate automatic checking results, wherein each policy rule of the one or more policy rules specifies a policy type that indicates where in the advertisement to apply the policy rule and data to collect to check for a violation (D8: Fig. 2, paragraphs [0067], [0082], and [0083], the offer management tool executes automated checks based on pre-defined rules);
- automatically determining, by the automated ad policy checking component, whether or not to approve the advertisement using the automatic checking results; and if it was determined to approve the advertisement, then at least initially permitting, by the automated ad policy checking component, the advertisement to be served by the online ad serving system, and if it was determined not to approve the advertisement, then at least initially inhibiting, by the automated ad policy checking component, the advertisement from being served by the ad serving system (D8: Fig. 2; paragraphs [0082] and [0083]).

[45] The PR letter also set out the differences between D8 and the features of claims 1, 3, 13, and 15:

> In our preliminary view, the differences between D8 and the features of claim 1 are that D8 does not disclose or suggest:
>
> (1) wherein if it was determined to approve the advertisement, then further scheduling, by the automated ad policy checking component, a follow up check of the advertisement, wherein the advertisement includes a link to a landing page; and
>
> (2) wherein the follow up check tests the landing page for compliance with policy rules, and wherein the policy rules include at least one of (A) ensuring that the ad landing page generates no pop-ups, and (B) ensuring that the ad landing page does not disable a “back” operation in a browser.

> In our preliminary view, the difference between D8 and the features of claim 3 is that D8 does not disclose or suggest:
>
> > (3) if it was determined not to approve the advertisement, then providing, by the automated ad policy checking component, hints for making the ad comply with one or more violated policy rules to at least one of (A) an advertiser associated with the ad, and (B) an ad serving system customer service representative.
>
> In our preliminary view, the difference between D8 and the features of claim 13 is that D8 does not disclose or suggest:
>
> > (4) wherein each of the one or more policy rules includes a suggestion for avoiding a violation of the policy rule.
>
> In our preliminary view, the difference between D8 and the feature of claim 15 is that D8 does not disclose or suggest:
>
> > (5) wherein each of the one or more policy rules includes a link, executable by an ad delivery system customer service representative but not by an advertiser, to find further information about the policy rule.

Claim 21 and the dependent claims will be addressed in step (4).

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

[46] For the independent claims, the Panel explained in the PR letter why claim 1 would not have been obvious, and why claims 3, 13, and 15 would have been obvious, to the skilled person in view of the cited prior art and the CGK:

> With regard to feature (1), which appears in claim 1, it is our preliminary view that none of the documents D1 to D5 and D8, when considered alone or in combination, disclose or suggest this feature.
>
> In the FA (pages 3 to 4), the examiner stated that the "follow up check… would not result in any unexpected surprising or unexpected advantages or disadvantages or effects, it seems it is straightforward option for a skilled person in the art." We preliminarily disagree. Although D1 discloses that an advertiser may review a <u>rejected</u> advertisement and resubmit it for another review (paragraph [0044], it does not disclose or suggest scheduling a follow up check by an automated ad policy component for <u>approved</u> advertisements. Similarly, D8 discloses that rejected advertisements are not posted online (paragraphs [0082] and [0083]), but does not disclose scheduling a follow up check for approved advertisement.

> It is also our preliminary view that feature (1) is not part of the CGK of the skilled person. In paragraphs [0056], the present application recites that the follow up check "may reconfirm existing and new policy rules (thereby ensuring consistency), and/or to enforce persistent policies." In our preliminarily view, scheduling a follow up check for an approved advertisement is advantageous since it ensures that the advertisement confirms to new and existing policy rules, especially persistent policy rules. Since none of the prior art on record discloses or suggests this feature, and it appears that this feature is not a well-known practice in the art, feature (1) is not considered to be part of the CGK of the skilled person, and is not considered a straightforward implementation choice. Therefore, it is our preliminary view that it would require a degree of invention to arrive at the claimed subject-matter of claim 1 on file, and thus claim 1 on file would not have been obvious to the skilled person.
>
> Feature (2) is not considered further in this review because claim 1 on file is found to be unobvious based on feature (1).
>
> With regard to features (3) and (4), which appear in claims 3 and 13, respectively, it is our preliminary view that providing a hint or suggestion regarding compliance with certain rules after a content review rejection is CGK in the field of web-based publications. Further, D8 discloses that the advertisement management system may be used by a variety of people, such as "administrators," "operators," and "users" (paragraphs [0066] and [0080]).
>
> With regard to feature (5), which appears in claim 15, it is our preliminary view that providing a link for further information is a well-known practice in the field and considered to be CGK. In fact, the original HTML 4.0 specification provides multiple examples on this feature (D8).
>
> Accordingly, in our preliminary view, considering features (3), (4), and (5), individually or combination with other claimed elements, the skilled person would arrive at the claimed subject-matter of claims 3, 13, and 15 without any degree of ingenuity. Therefore, claims 3, 13, and 15 would have been obvious to the skilled person (emphases in the original).

[47] For dependent claims 2, 6 to 12, 18 to 20, and 22 on file, since they are dependent upon claim 1 on file, which we have found to be unobvious, it is our preliminary view that these claims would not have been obvious to the skilled person. Similarly, for claim 21, when it depends on any one of claims 1, 2, 6 to 12, and 18 to 20, it would not have been obvious to the skilled person.

[48] The PR letter further explained that claims 4, 5, 14, 16, and 17 would have been obvious to the skilled person:

> Claims 4 and 5 recite that the hints are provided in an email message, or a dynamically generated page loaded into a browser. In D8, the online advertisement is generated dynamically in a location on a web page (paragraphs [0022] and [0025], Fig. 9, Fig. 10). Since the advertisement information is displayed in the dynamically generated location of the web page, it would have been a straightforward option for the skilled person to implement the hints in the same location. Also, using emails to deliver information such as hints or suggestions are considered to be CGK.
>
> Claim 14 recites that each of the policy rules includes a link for further information about the rule. As explained above, links for further information are part of CGK. Therefore, we preliminarily consider that the claimed subject-matter would have been obvious to the skilled person.
>
> Claim 16 recites that each of the policy rules further includes machine executable code for checking an advertisement to determine whether or not the policy rule is violated. D8 discloses this feature in paragraphs [0028] and [0082], and thus this feature does not constitute a difference.
>
> Claim 17 recites that each of the one or more policy rules further includes an indication of the portion of an advertisement to be checked by the machine executable code. It is our preliminary view that this feature is implied in paragraphs [0028] and [0082] of D8, and thus this feature does not constitute a difference.

[49] In view of above, the skilled person would consider that there is no inventive ingenuity involved in the additional features recited by claims 4, 5, 14, 16, 17, and 21 (when it depends on any one of claims 3 to 5, and 13 to 17), considered individually or in combination with other claimed features.

[50] In summary, the Panel considers that the subject-matter of claims 1, 2, 6 to 12, 18 to 20, 21 (when it depends on any one of claims 1, 2, 6 to 12, and 18 to 20), and 22 on file would not have been obvious to the skilled person. Therefore, these claims comply with section 28.3 of the *Patent Act*. The Panel also considers that the subject-matter of claims 3 to 5, 13 to 17, and 21 (when it depends on any one of claims 3 to 5, and 13 to 17) on file would have been obvious to the skilled person in view of D8 and the CGK. Therefore, these claims do not comply with paragraph 28.3(b) of the *Patent Act*.

<u>Indefiniteness</u>

[51] Claim 2 on file recites:

> 2. The computer-implemented method of claim 1 wherein if it was determined to approve the advertisement, then further time stamping, by

> the automated ad policy checking component, the advertisement to facilitate the follow lip check of the advertisement [emphasis added].

[52] The Panel considers that the term “follow lip” is not clear. The term “follow lip” is not mentioned in the specification. Instead, paragraph [0056] recites “when an ad is marked as approved, it may also be time stamped or scheduled for a follow-up check”. Hence it appears that the term “follow lip check” should read “follow up check.” Therefore, claim 2 on file is indefinite and does not comply with subsection 27(4) of the *Patent Act*.

Proposed claims

[53] The PR letter explained why we considered the proposed claims a “necessary” amendment under subsection 86(11) of the *Patent Rules*:

> In the proposed claims, claims 3, 13, and 15 on file were amended to be dependent on claim 1 on file; claim 22 on file was re-numbered as claim 21; and claim 21 on file was re-numbered as claim 22 with updated dependencies.
>
> Since it is our preliminary view that claim 1 on file would not have been obvious to the skilled person, as explained above, the proposed claims 1 to 22 are preliminarily considered to have been unobvious based on the fact that claim 1 of the proposed claims is the same as claim 1 on file and claims 2 to 22 of the proposed claims are dependent, directly or indirectly, upon claim 1.
>
> Further, claim 2 of the proposed claims was amended to recite “facilitate the follow up check.” In our preliminary view, claim 2 of the proposed claims overcomes the indefiniteness defect of claim 2 on file and complies with subsection 27(4) of the *Patent Act*.
>
> Therefore, it is our preliminary view that the proposed claims would not have been obvious and are not indefinite. Consequently, we preliminarily consider that the proposed claims a “necessary” amendment under subsection 86(11) of the *Patent Rules* (emphasis in the original).

CONCLUSIONS

[54] We are of the view that:

- claims 1, 2, 6 to 12, 18 to 20, 21 (when it depends on any one of claims 1, 2, 6 to 12 and 18 to 20), and 22 on file would not have been obvious and comply with section 28.3 of the *Patent Act*;

- claims 3 to 5, 13 to 17, and 21 (when it depends on any one of claims 3 to 5 and 13 to 17) on file would have been obvious and do not comply with paragraph 28.3(b) of the *Patent Act*;

- claim 2 on file is indefinite and does not comply with subsection 27(4) of the *Patent Act*; and

- the proposed claims are considered a “necessary” amendment under subsection 86(11) of the *Patent Rules*.

RECOMMENDATION OF THE BOARD

[55] In view of the above, we recommend that the Applicant be notified, in accordance with subsection 86(11) of the *Patent Rules*, that the amendments proposed in the letter of December 12, 2018, namely the deletion of claims 1 to 22 on file and the insertion of proposed claims 1 to 22, are necessary for compliance with the *Patent Act* and *Patent Rules*.

Liang Ji	Paul Fitzner	Kristina Bodnar
Member	Member	Member

DECISION OF THE COMMISSIONER

[56] I concur with the conclusions and recommendation of the Patent Appeal Board. In accordance with subsection 86(11) of the *Patent Rules*, I hereby notify the Applicant that the following amendments, and only the following amendments, must be made within three (3) months of the date of this decision, failing which I intend to refuse the application:

i) the deletion of claims 1 to 22 on file; and

ii) the insertion of claims 1 to 22 proposed in the letter of December 12, 2018.

Virginie Ethier
Assistant Commissioner of Patents

Dated at Gatineau, Quebec,

This 5th day of November 2021.