

Citation: Illinois Tool Works Inc. (Re), 2022 CACP 13
Commissioner's Decision # 1620
Décision du Commissaire n° 1620
Date: 2022-04-13

TOPIC: J00 Meaning of Art

J60 Printed Matter

G00 Utility

F01 Novelty – Anticipation

O00 Obviousness

B00 Claims - Ambiguity or
Indefiniteness

SUJET: J00 Signification de la
technique

J60 Imprimés

G00 Utilité

F01 Nouveauté -Antériorité

O00 Évidence

B00 Caractère ambigu ou
indéfini

Application No. : 2,871,509
Demande n° 2 871 509

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,871,509, 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 Patent Appeal Board and the decision of the Commissioner are to withdraw the rejection and allow the application.

Agent for the Applicant:

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INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,871,509 (“the instant application”), which is entitled “CONTAINER CARRIER” and is owned by ILLINOIS TOOL WORKS INC. (“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, the Board’s recommendation is that the Commissioner of Patents withdraw the rejection and that the application be allowed.

BACKGROUND

The Application

- [2] The instant application was filed under the *Patent Cooperation Treaty* and has an effective filing date in Canada of May 6, 2013. It was laid open to public inspection on November 7, 2013.
- [3] The instant application relates to a container carrier used to transport multiple containers, such as bottles or cans. In particular, it relates to multipack or six-pack carriers, known also as plastic ring or box carriers. In the present case the carrier is shaped such that the structure of the container carrier represents a product name, shape, or other such material associated with the product to be carried.

Prosecution History

- [4] On January 8, 2019, 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 subject-matter that lies outside of the definition of “invention” in section 2 of the *Patent Act*, in particular, they are directed to printed matter having only intellectual significance or aesthetic appeal;
 - the claims on file lack utility, being therefore non-compliant with section 2 of the *Patent Act*;

- claims 1-8, 10, 11-15 and 16-19 on file lack novelty in view of a prior publication by the Applicant, being therefore non-compliant with paragraph 28.2(1)(a) of the *Patent Act*;
 - the claims on file would have been obvious, being therefore non-compliant with section 28.3 of the *Patent Act*; and
 - claims 1, 4, 6, 8, 9, 11, 15, 16 and 19 on file are indefinite and therefore non-compliant with subsection 27(4) of the *Patent Act*.
- [5] In a July 8, 2019 response to the FA (“R-FA”), the Applicant submitted a proposed claim set 1-11 (“proposed claims”) and submitted arguments in favor of patentability for both the claims on file and the proposed claims.
- [6] As the Examiner considered the application not to comply with the *Patent Act*, pursuant to subsection 30(6) of the *former Rules*, the application was forwarded to the Board for review on October 16, 2019 along with an explanation outlined in a Summary of Reasons (“SOR”). The SOR indicated that the claims on file remained defective for the reasons set out in the FA. With respect to the proposed claims, the SOR indicated that the proposed claims overcome the patentable subject-matter and utility defects, as well as the lack of novelty and indefiniteness defects. However, the proposed claims would not overcome the obviousness defect and reference was made to a new prior art document in support of this position. The SOR also indicated that the proposed claims would introduce a lack of unity defect under subsection 36(1) of the *Patent Act*.
- [7] In a letter dated October 21, 2019, 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 January 14, 2020, the Applicant indicated its desire for the Board to proceed with a review of the application.
- [9] The undersigned panel (“the Panel”) of the Board was assigned to review the instant application under paragraph 199(3)(c) of the *Patent Rules* and to make a recommendation to the Commissioner of Patents as to its disposition.
- [10] The Panel has reviewed the instant application in accordance with paragraph 199(3)(c) of the *Patent Rules* and provide our analysis below.

ISSUES

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

- whether the claims on file are directed to patentable subject-matter;
- whether the claims on file lack utility;
- whether claims 1-8, 10, 11-15 and 16-19 on file lack novelty;
- whether the claims on file would have been obvious to a person skilled in the art; and
- whether claims 1, 4, 6, 8, 9, 11, 15, 16 and 19 are indefinite.

[12] In the present review, given our recommendation in respect of the claims on file, it is not necessary to review the proposed claims to determine if they are considered a necessary amendment under subsection 86(11) of the *Patent Rules*.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Purposive Construction

[13] 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.

[14] “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.

Patentable Subject-Matter

[15] 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.

[16] Subsection 27(8) of the *Patent Act* also prescribes that:

No patent shall be granted for any mere scientific principle or abstract theorem.

[17] *PN2020-04* describes the Patent Office's approach to determining if a claim is patentable subject matter:

To be both patentable subject-matter and not be prohibited under subsection 27(8) of the *Patent Act*, the subject-matter defined by a claim must be limited to or narrower than an actual invention that either has physical existence or manifests a discernible physical effect or change and that relates to the manual or productive arts, meaning those arts involving or concerned with applied and industrial sciences as distinguished in particular from the fine arts or works of art that are inventive only in an artistic or aesthetic sense.

[18] *The Manual of Patent Office Practice [MOPOP]*, revised November 2017 (CIPO) at §17.03.06 sets out the following guidance when assessing the patentability of printed matter:

Printed matter that has purely intellectual or aesthetic significance, such as a literary work, is excluded from patentability for the reasons outlined in 17.03.05. However, where printed matter provides a new functionality to the substrate on which it is printed, a claim to this subject-matter may be considered statutory. For the printed matter and the substrate to be considered to be a practical form of an invention, they must solve a practical problem related to the use of the printed matter in general, and not be based solely on the intellectual or aesthetic content of the printed matter itself.

[some portions removed]

The term "printed matter" should not be restricted to traditional ink-on-paper printing but may include any means of displaying information.

[19] *MOPOP* §17.03.05, referred to in the passage cited above, gives the following general guidance:

Where a claim appears to be directed to subject-matter having solely intellectual or aesthetic significance, the claim is defective under section 2 of the *Patent Act*.
[citation removed]

Utility

[20] Utility is required by 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] In *AstraZeneca Canada Inc v Apotex Inc*, 2017 SCC 36 at para 53, the Supreme Court of Canada stated that the “[u]tility will differ based on the subject-matter of the invention as identified by claims construction” and outlined the approach that should be undertaken to determine whether a patent discloses an invention with sufficient utility under section 2 of the *Patent Act*:

[54] To determine whether a patent discloses an invention with sufficient utility under s. 2, courts should undertake the following analysis. First, courts must identify the subject-matter of the invention as claimed in the patent. Second, courts must ask whether that subject-matter is useful—is it capable of a practical purpose (i.e. an actual result)?

[55] The Act does not prescribe the degree or quantum of usefulness required, or that every potential use be realized—a scintilla of utility will do. A single use related to the nature of the subject-matter is sufficient, and the utility must be established by either demonstration or sound prediction as of the filing date (*AZT*, at para 56).

Lack of Novelty/Anticipation

[22] Subsection 28.2(1) of the *Patent Act* requires claimed subject matter to be new:

The subject-matter defined by a claim in an application for a patent in Canada (the “pending application”) must not have been disclosed

(a) before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;

(b) before the claim date by a person not mentioned in paragraph (a) in such a manner that the subject-matter became available to the public in Canada or elsewhere;

[remainder of subsection omitted]

- [23] There are two separate requirements to show that prior art anticipates a claimed invention: there must be a prior disclosure of the claimed subject-matter and the prior disclosure must enable the claimed subject-matter to be practised by a skilled person (*Apotex Inc v Sanofi–Synthelabo Canada Inc*, 2008 SCC 61 [*Sanofi*] at paras 24–29, 49).

Obviousness

- [24] Section 28.3 of the *Patent Act* requires claimed subject matter to not be obvious:

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 before the one-year period immediately preceding the filing date or, if the claim date is before that period, before the claim 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.

- [25] In *Sanofi*, 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”;
- (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?

Indefiniteness

- [26] 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.

[27] In *Minerals Separation North American Corp v Noranda Mines Ltd*, [1947] Ex CR 306 at 352, 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

Purposive Construction

The person skilled in the art

[28] In the FA at page 3, the person skilled in the art was characterized as:

a team consisting of packaging specialists/engineers, manufacturing specialists/engineers, and marketing and sales specialists.

[29] The Applicant did not dispute the above in the R-FA and we adopt it for the purpose of this review.

The relevant common general knowledge

[30] In the FA at page 3, the relevant CGK was identified as comprising:

- Knowledge of container carriers comprising a planar sheet of a plastic material, the sheet having a plurality of container receiving apertures arranged in longitudinal rows and transverse ranks;
- Knowledge of container carriers having one or more integral handles and/or panels;
- Knowledge of container carriers being produced via die cutting;

- Knowledge of the variety of container carrier configurations (e.g. number of rows and ranks, location of the handle and/or panel, number of container receiving apertures); and
- Knowledge of container carriers having one or more integral panels which are separable from the carrier to release one or more containers.

[31] The Applicant did not dispute the above points in the R-FA and we adopt them for the purpose of this review.

The claims on file

[32] The instant application contains 20 claims of which claims 1, 11 and 16 are independent. We take independent claim 1 on file as representative:

1. A carrier (10) for carrying a plurality of containers (20), the carrier comprising:
 - a planar sheet (15) of a plastic material, the sheet having a plurality of container receiving apertures (25) arranged in longitudinal rows and transverse ranks;
 - a panel (50) integrally formed with the sheet, the panel extending outward from an edge of the sheet (15),
 - characterised in that
 - the panel (50) is die cut to form at least one of a product name, a product shape, a promotional shape, a trademark, a tradename, alpha-numeric characters, symbols and a fanciful design.

[33] We note that there have been no issues raised during the prosecution of the instant application in regard to the meaning or scope of any of the terms used in the claims on file. We proceed below on the basis that the meaning and scope of the claims would have been clear to the skilled person.

The essential elements

[34] The FA presented at page 3 an analysis of the purposive construction of the claims on file in accordance with the guidance set out in *MOPOP* at §12.02. As this approach has now been superseded by *PN2020-04*, we undertake anew the identification of the essential elements of the claims on file.

[35] *PN2020-04* states in respect of the identification of essential/non-essential elements that:

In carrying out this identification of essential and non-essential elements, all elements set out in a claim are presumed essential, unless it is established otherwise or is contrary to the language used in the claim.

- [36] With respect to the claims on file, the person skilled in the art would understand that there is no use of language in any of the claims indicating that the elements in each claim are a preferred embodiment. Some of the claims express alternatives or alternative combinations. However, in our view, when any one of these alternatives is chosen, they are essential for that particular embodiment.
- [37] Therefore, in our view, all the elements of the claims on file are considered to be essential.

Patentable Subject-Matter

- [38] In the FA at page 4, after having construed the claims according to the previous approach to purposive construction set out in *MOPOP*, the essential element of the claims was set out as “the shape of the panel and/or handle.”
- [39] In light of the revised assessment above in line with *PN2020-04* the essential elements of representative claim 1 also include the carrier itself having the plurality of apertures and the panel integrally formed with it, which is shaped to form a product name, shape, etc.
- [40] *PN2020-04* indicates that in assessing patentable subject matter, the actual invention of the particular claim must be identified. Such an actual invention:
- may consist of either a single element that provides a solution to a problem or of a combination of elements that cooperate together to provide a solution to a problem. Where an actual invention consists of a combination of elements cooperating together, all of the elements of the combination must be considered as a whole when considering whether there is patentable subject-matter and whether the prohibition under subsection 27(8) of the *Patent Act* is applicable. [citations omitted]
- [41] Considering the specific guidance in *MOPOP* that where printed matter provides a new functionality to a substrate on which it is printed, a claim to such subject-matter may be considered patentable, the question becomes does the printed matter cooperate with the substrate such that there is some new functionality provided to the substrate. However, this question assumes that there is matter printed on a substrate, that there is e.g., a surface upon which words, images, etc.

are imprinted in some fashion and do those words, images, etc. impart a new functionality to the substrate on which they are imprinted. That scenario of substrate and printed matter is not the case in the instant application and in representative claim 1 on file.

- [42] In claim 1 on file, the product name, shape, etc. that is characterized as non-patentable printed matter in the FA is cut to form part of the container carrier itself. That is, the product name, shape etc. is not printed on a substrate, but is the substrate and represents part of the physical structure of the carrier. In such a case, it is our view that the portion of the carrier that forms the product name, shape etc. of claim 1 on file cooperates with the rest of the structure of the carrier. These are integrally formed portions of the carrier structure.
- [43] Further, given that the product name, shape, etc. forms part of the carrier structure, in our view, this is not a case where there is printed matter “that has purely intellectual or aesthetic significance” (*MOPOP* at §17.03.06, quoted above). Likewise, in our view, the incorporation of the product name, shape etc. into the carrier structure represents more than the mere displaying of information.
- [44] The container carrier and the integral product name, shape, etc. also represent something with physical existence and therefore satisfy the physicality requirement set out in *Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 at paragraph [66].
- [45] Therefore, in our view, claim 1 on file is directed to patentable subject-matter and is compliant with section 2 of the *Patent Act* in that respect.
- [46] As independent claims 11 and 16 on file contain limitations similar to claim 1, they too are directed to patentable subject matter, as are dependent claims 2-10, 12-15 and 17-20.

Utility

- [47] In the FA at page 4, the utility defect was described as follows:

Claims 1-20 encompass subject-matter that lacks utility and do not comply with section 2 of the *Patent Act*. The essential elements of these claims, as determined in the purposive construction analysis above, are not capable of a practical purpose.

[48] However, as set out above, in the FA the essential element of the claims, based on the now superseded purposive construction practice, was limited to the shape of the panel and/or handle. With the revised essential elements of the claims now including the rest of the carrier structure, of which the product name, shape, etc. form an integral part, the combination of essential elements of the claims clearly have a practical purpose and utility (i.e., to retain multiple containers that may be carried together).

[49] As such, it is our view that the claims on file possess utility and comply with section 2 of the *Patent Act* in that respect as well.

Lack of Novelty/Anticipation

[50] In the FA at page 4, it was asserted that claims 1-8, 10, 11-15 and 16-19 lacked novelty in view of the following prior art document:

D1 : US6182821 OLSEN February 6, 2001

[51] To illustrate the lack of novelty of claim 1 on file, the FA at page 5 set out an analysis indicating that D1 disclosed all elements of the claim.

[52] While we agree that D1 discloses a carrier comprising a die cut planar sheet of plastic material with a plurality of apertures arranged as specified in claim 1 on file, as well as the integrally formed panel extending outward from the sheet, we do not agree that D1 discloses a panel formed in the manner claimed, namely, in the form of a product name, shape, etc.

[53] In D1, the panels 55 that are used to display product-related information are provided such that product information may be displayed in that allocated space, much like the description of the prior art provided at page 1 of the instant application. There is no disclosure or suggestion of such panels being formed so as to themselves represent product-related information, rather than imprinting such information or attaching a separate label to the space. D1 also discloses labels 25 that may be attached to the carrier handle portions to indicate pricing information, which again, does not disclose or suggest forming a portion of the carrier structure itself to represent product-related information.

[54] As such, in our view, the subject-matter of claim 1 on file is not disclosed by D1

and therefore is novel in view of this prior art document.

[55] As independent claims 11 and 16 contain similar limitations as those of claim 1, they too are novel in view of D1. Likewise, dependent claims 2-10, 12-15 and 17-20, which depend directly or indirectly on independent claims 1, 11 or 16, are also novel in view of D1.

[56] For completeness of the novelty assessment, we have considered the other prior art document cited in the FA:

D2 : US2003/0080004 OLSEN et al. May 1, 2003

[57] In our view, D2 is very similar to D1 in terms of what it discloses in relation to the subject-matter of the claims on file. Like D1, D2 discloses a panel representing allocated space on the carrier upon which product-related information may be displayed. There is no disclosure or suggestion of forming the carrier itself in a manner that represents product-related information.

[58] Therefore, in our view, claims 1-20 on file are novel in view of prior art document D2 as well.

Obviousness

[59] Below we assess obviousness using the *Sanofi* four-step approach, which was also used in the FA at pages 7-9.

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

[60] The person skilled in the art has been identified above under Purposive Construction. We apply the same characterization here.

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

[61] The relevant CGK has also been identified under Purposive Construction and we apply the same CGK here.

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

[62] In this assessment, we take into account all the essential elements of the claims on file. In our view, the combination of essential elements of each claim represent their inventive concepts as well.

(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

[63] In the FA at page 9, the difference between the claims on file and D1 and D2 was set out as that:

D1 and D2 do not explicitly disclose the panel and/or handle is shaped to form at least one of a product name, a product shape, a promotional shape, a trademark, a tradename, alpha-numeric characters, symbols, a fanciful design and an outline of the container.

[64] As is evident from our novelty assessment above, we agree that neither D1 nor D2 disclose that the carrier (panel and/or handle portion) is shaped to provide any of the product-related information quoted above, as is set out in claim 1 on file. Rather D1 and D2 provide dedicated space upon which product-related information can be imprinted or attached in some manner.

[65] We also note that while the passage quoted above refers to such features not being explicitly disclosed, in our view, neither are they implicitly disclosed in any manner.

(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?

[66] In our view, the present case is not in an area, such as the pharmaceutical industry, where advances are often achieved by experimentation and where the “obvious to try” test might be appropriate (*Allegan Inc v Apotex Inc*, 2022 FC 260 at para 167, citing *Sanofi* at paras 69-71).

[67] The word “obvious” within the approach set out in *Sanofi* refers to an invention having been “very plain” (*Pfizer Canada Inc v Apotex Inc*, 2009 FCA 8 at para 29).

[68] In the present case, neither D1 nor D2 disclose the difference at step 3, set out above. Therefore, the gap between the prior art and the subject-matter of the claim

must be supplied by the relevant CGK. The question is whether that CGK would have led the skilled but un inventive person to come directly and without difficulty to the particular combination of elements (*Bridgeview Manufacturing Inc v 931409 Alberta Ltd (Central Alberta Hay Centre)*, 2010 FCA 188 at para 52).

[69] The FA at page 9 indicates that claims 1-20 on file would have been obvious because:

[t]he shape selection for a panel and/or handle would be considered a design choice available to a person skilled in the art in order to better promote or increase aesthetic appeal of the package.

[70] Though many variations from the prior art may be considered design choices, such a label does not explain why the person skilled in the art would have come directly and without difficulty to the claimed invention or why the claimed invention would have been very plain.

[71] In the present case, the relevant CGK is not sufficient to close the gap between the claimed subject-matter and the prior art. Like D1 and D2 there is no suggestion in the points of CGK set out above to shape the structure of a container carrier such that it represents product-related information. Without any hint or suggestion in the prior art or relevant CGK of such a feature, we are unable to conclude that a person skilled in the art would have come directly and without difficulty to the subject-matter of claim 1 on file or that it would have been very plain. Therefore, we conclude that claim 1 on file would not have been obvious to the person skilled in the art and is therefore compliant with section 28.3 of the *Patent Act*.

[72] As independent claims 11 and 16 contain similar limitations as those of claim 1, they too are compliant with section 28.3 of the *Patent Act*. Likewise, dependent claims 2-10, 12-15 and 17-20, which depend directly or indirectly on independent claims 1, 11 or 16 are also compliant with section 28.3 of the *Patent Act*.

Indefiniteness

[73] The FA at page 9 indicated that claims 1, 4, 6, 8, 9, 11, 15, 16 and 19 on file are indefinite because:

[t]he preamble of these claims introduces a product while the body introduces a process limitation to the product which creates a lack of clarity in the protection of

the subject matter sought. The process of die cutting a panel and/or handle does not clearly limit the carrier and/or package.

[74] The concern as to how the feature of the product name, shape, etc. being die cut affects the carrier structure is one common to the types of claims in which products are sought to be limited by the process by which they are made.

[75] *MOPOP*, revised March 1998 (CIPO) at §16.08.01 states that:

A product-by-process claim, where permitted, must define the product explicitly and distinguish it from all other products. Hence, products that are already known may not be claimed by making them dependent on a new process (*Hoffman-La Roche v. Commissioner of Patents* 23 C.P.R. 1)

[76] In our view, the same reasoning applies to this case. Unless the feature of die cutting the relevant container carrier portion imposes some structural limitation on it, which then must be taken into account in assessing its patentability, the inclusion of die cutting does not change the assessment that is to be made of the elements of the carrier itself. In the present case, it was well-known to form such carriers by means of die cutting, as set out in the identification of the relevant CGK. As such, the person skilled in the art would not perceive any special structural limitations in forming a portion of such a carrier by means of such a process.

[77] In our view, the inclusion of die cutting does not make the subject-matter of the claim indefinite, but also does not impart any structural limitations on the carrier that would need to be taken into account in assessing other aspects of validity.

Proposed Claims

[78] Although the Applicant submitted a set of proposed claims with the R-FA, given that we do not agree with the basis for the rejection of the application and have not identified any further defects, there is no reason to review the proposed claims.

CONCLUSIONS

[79] We have determined that the claims on file are directed to patentable subject-matter and have utility. They are therefore compliant with section 2 of the *Patent Act*. Further, the claims on file are novel and would not have been obvious. They are therefore compliant with subsection 28.2(1) and section 28.3 of the *Patent Act*.

Lastly, claims 1, 4, 6, 8, 9, 11, 15, 16 and 19 on file are not indefinite and are therefore compliant with subsection 27(4) of the *Patent Act*.

RECOMMENDATION OF THE BOARD

[80] In light of the above, we are of the view that the rejection is not justified on the basis of the defects indicated in the Final Action notice and have reasonable grounds to believe that the instant application complies with the *Patent Act* and the *Patent Rules*. We recommend that the Applicant be notified in accordance with subsection 86(10) of the *Patent Rules* that the rejection of the instant application is withdrawn and that the instant application has been found allowable.

Stephen MacNeil
Member

Mara Gravelle
Member

Kurtis Ulicny
Member

DECISION OF THE COMMISSIONER

[81] I concur with the conclusions and recommendation of the Board. In accordance with subsection 86(10) of the *Patent Rules*, I hereby notify the Applicant that the rejection of the instant application is withdrawn, the instant application has been found allowable and I will direct my officials to issue a Notice of Allowance in due course.

Virginie Ethier
Assistant Commissioner of Patents

Dated at Gatineau, Quebec

this 13th day of April, 2022