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TOPIC: F00 Novelty
O00 Obviousness

SUJET: F00 Nouveauté
O00 Évidence

Application No. : 2,970,031

Demande n° 2 970 031

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

Patent application number 2,970,031, having been rejected under subsection 86(3) of the *Patent Rules* (SOR/2019-251) ("*Patent Rules*") has consequently been reviewed in accordance with paragraph 86(7)(c) of the *Patent Rules*. The recommendation of the Patent Appeal Board and the decision of the Commissioner are to refuse the application.

Applicant:

Ivan L. Nakamoto

3429 Fenwick Cres

MISSISSAUGA Ontario

L5L 5N7

Ivann246@gmail.com

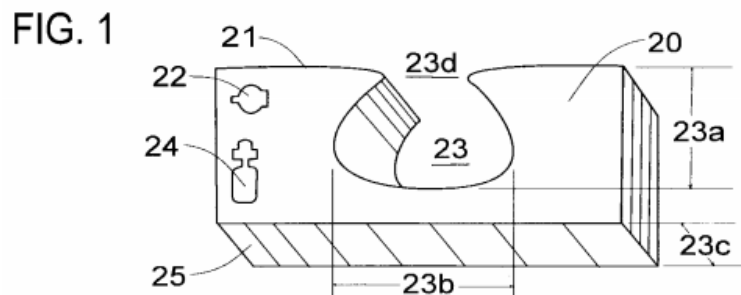
INTRODUCTION

- [1] This recommendation concerns the review of rejected Canadian patent application number 2,970,031 (“the instant application”), which is entitled “INFLATABLE WATER SELF-RESCUE AND CARRYING DEVICE” and is owned by Ivan L. Nakamoto (“the Applicant”). A review of the rejected application has been conducted by the Patent Appeal Board (“the Board”) pursuant to paragraph 86(7)(c) of the *Patent Rules* (SOR/2019-251) (“*Patent Rules*”). As explained in more detail below, the Board’s recommendation is that the Commissioner of Patents refuse the application.
- [2] This recommendation and Commissioner’s Decision are being released concurrently with the recommendation and Commissioner’s Decision for co-pending Canadian patent application number 2,972,289 (“the ‘289 Application”), also owned by the Applicant.

BACKGROUND

The Application

- [3] The instant application was filed on June 9, 2017. It was laid open to public inspection on August 16, 2017.
- [4] The instant application relates to an inflatable device for use in association with a person’s lower extremities so as to aid in performing a water self-rescue maneuver. The inflatable device provides increased buoyancy to the lower extremities such that a person may more easily propel themselves into a nearby watercraft or swim to safety. Figure 1 of the instant application, reproduced below, shows an embodiment of the inflatable device.



Prosecution History

- [5] On January 15, 2020, a Final Action (“FA”) was written pursuant to subsection 86(5) of the *Patent 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 lacked novelty and would have been obvious to a person skilled in the art at the relevant date. The defects were based on a prior art document published by the Applicant more than one year before the Canadian filing date and therefore outside of the grace period provided by paragraphs 28.2(1)(a) and 28.3(a) of the *Patent Act*.
- [6] In an April 6, 2020 response to the FA (“R-FA”), the Applicant provided extensive arguments in favor of the patentability of the claims on file, as well as certain allegations in relation to the manner in which prosecution of the instant application occurred. No amendments were proposed.
- [7] As the Examiner considered the application not to comply with the *Patent Act*, pursuant to subsection 86(7) of the *Patent Rules*, the application was forwarded to the Board for review on August 5, 2020 along with an explanation outlined in a Summary of Reasons (“SOR”). The SOR indicated that the claims on file remained defective for lack of novelty and obviousness as set out in the FA.
- [8] In a letter dated August 13, 2020, the Board forwarded to the Applicant a copy of the SOR and requested that the Applicant confirm their continued interest in having the application reviewed.
- [9] In a response dated October 20, 2020, the Applicant indicated his desire for the Board to proceed with a review of the application. The Applicant included further submissions consistent with those submitted in the R-FA.
- [10] The Applicant also provided supplemental submissions dated August 2, 2021 and May 9, 2022 that reiterated many of the arguments set out in the R-FA.
- [11] The undersigned panel (“the Panel”) of the Board was assigned to review the instant application and to make a recommendation to the Commissioner of Patents as to its disposition.
- [12] The Panel issued a first Preliminary Review letter dated September 20, 2022 setting out a preliminary analysis of the lack of novelty and obviousness issues.

However, as the Applicant was notified in an email communication dated November 7, 2022, the Panel withdrew this letter due to reference in it to an incorrect version of the claims.

- [13] A revised preliminary analysis was presented in a second Preliminary Review letter (“PR letter”) dated November 18, 2022. The Panel set out its preliminary analysis of the lack of novelty and obviousness issues with respect to the claims on file as last amended on February 18, 2019 (“claims on file”). The Panel was of the preliminary view that claims 1-20 on file lacked novelty and would have been obvious to the person skilled in the art in view of the Applicant’s own prior published US patent document. The PR letter took into account the Applicant’s submissions dated October 17, 2022 made in response to the September 20, 2022 Preliminary Review letter.
- [14] The PR letter provided the Applicant with an opportunity to make oral and/or written submissions.
- [15] In a response dated December 1, 2022, the Applicant declined the opportunity for an oral hearing.
- [16] On December 15, 2022, the Applicant provided written submissions (“R-PR”) in response to the preliminary opinion set out in the PR letter.
- [17] The Panel has reviewed the instant application and provide our final analysis below.
- [18] During the review of the instant application, the Applicant made additional submissions to the Commissioner of Patents, the Patent Appeal Board Chair and the Ministers of the Innovation, Science and Economic Development portfolio. These submissions have been considered by the Commissioner of Patents in making a final decision.

ISSUE

- [19] The issues to be addressed by the present review are whether the claims on file lack novelty/are anticipated and whether they would have been obvious to the person skilled in the art.

LEGAL PRINCIPLES AND OFFICE PRACTICE

Purposive Construction

- [20] In accordance with *Free World Trust v Électro Santé Inc*, 2000 SCC 66 [*FreeWorldTrust*] and *Whirlpool Corp v Camco Inc*, 2000 SCC 67 [*Whirlpool*], 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.
- [21] All elements set out in a claim are presumed essential unless it is established otherwise or such presumption is contrary to the claim language.

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?

ANALYSIS

Purposive Construction

The person skilled in the art

[26] In the PR letter at pages 4-6, we reviewed the characterization of the person skilled in the art in the FA, as well as the Applicant’s submissions in respect of that characterization. We also took into account the Applicant’s submissions dated October 17, 2022 in response to the first Preliminary Review letter of September

20, 2022, in which the Applicant withdrew previous characterizations of the person skilled in the art in favor of a new characterization. We proposed a slight modification of this new characterization:

In the FA at page 3, under the *Sanofi* assessment of obviousness, the person skilled in the art was set out:

The person skilled in the art is a team comprising a lifeguard experienced in a wide variety of natural, environment conditions; an experienced swimmer; an operator of a small, personal, pleasure craft; and one or more engineers or related technologists in the field of manufacturing and/or design.

In the R-FA at page 82, the Applicant repeated his comments on the person skilled in the art made in response to a previous Office Action dated April 15, 2019:

Additionally, respectfully, Applicant does not agree with Examiner's provided identification of "the notional 'person skilled in the art'", explained as follows.

Applicant does not agree with "*a lifeguard*". Applicant submits that the lifeguard must have "*experience*" in a wide variety of natural, environment conditions (e.g., including rough water, and strong winds), not just "*a lifeguard*" at a local, indoor, community swimming pool, where lessons are provided for 'moms and tots'.

Applicant does not agree with "*one or more of a kayaker, an experienced swimmer and/ or a sailor*", which includes just "*a sailor*", such as of ships, e.g., of cruise lines, oil tankers, and ocean-going freighters. Applicant submits that "*a sailor*" be of small, personal, pleasure crafts, such as those that accommodate one or two people. Applicant submits that "*a kayaker*" and "*a sailor*"—not just "*swimmer*"—be "*experienced*". Furthermore, Applicant submits that "*a kayaker*", "*an experienced swimmer*", and "*a sailor*" must be "*experienced*" in a wide variety of natural, environmental conditions (e.g., including rough water, and strong winds), and in large bodies of water (e.g., lakes and rivers), under which the water self-rescue apparatus will be operated. For example, Examiner's "*experienced swimmer*" must have "*experience*" "*swimming*" in natural environmental conditions, not just in indoor swimming pools, with 'moms and tots'.

Applicant submits that operators of small, personal, pleasure crafts such as canoes, paddle boards, and wind surfers, with experience operating them in a wide variety of natural environmental conditions, should be included in Examiner's team (e.g., instead of "*a sailor*" of cruise ships).

Applicant submits, regarding Examiner's "*engineers or related technologists in the field of manufacturing*", that the field of design of apparatus, is more relevant.

Applicant submits that Examiner's selection of her team, is additional proof of her errors, of: (i) a Fact, i.e., "accommodate" vs. "secure"; and (ii) the alleged Lack of Inventive Step defect, the alleged "obviousness". Additionally, Examiner's errors for the "person skilled in the art", is also proof of her error for the "Lack of Novelty" defect."

Comparing these prior submissions to the person skilled in the art set out in the FA, it is our preliminary view that the FA version seems to have mostly accommodated the Applicant's points set out above.

However, in the submissions dated October 17, 2022 at page 27, the Applicant withdrew all previous statements concerning the persons skilled in the art and contended that the team of persons skilled in the art should comprise one or more engineers or technologists experienced in the design of water self-rescue devices. We preliminarily agree that this would be an appropriate characterization of the skilled person, with the qualification that, in our preliminary view, such persons would be experienced in both the design and manufacture of water self-rescue devices.

In light of the above, it is our preliminary view that the person skilled in the art would then be:

A team comprising one or more engineers or technologists experienced in the design and manufacture of water self-rescue devices.

[27] The Applicant did not make any further submissions in the R-PR in respect of the person skilled in the art. We proceed on the basis of the person skilled in the art as set out in the PR letter.

The relevant common general knowledge

[28] In the PR letter at pages 6-7, after reviewing the FA and the submissions of the Applicant in the R-FA, we set out our preliminary view as to the content of the relevant CGK:

In the FA at page 3, the relevant CGK was set out:

The person skilled in the art is familiar with water self-rescue techniques in natural bodies of water of various sizes and a variety of environmental conditions, as well as conventional devices used for water self-rescue.

As was the case for the person skilled in the art, the Applicant in the R-FA reiterated his submissions in respect of the relevant CGK made in response to a previous Office Action dated April 15, 2019, which submissions are set out below:

Respectfully, Applicant does not agree with Examiner. However, Applicant agrees that the relevant common general knowledge must include—“experience”—such as Examiner specified for her “*experienced swimmer*”.

Applicant submits that the relevant common general knowledge must include —“experience”—of the conditions under which the inflatable water self-rescue apparatus will be operated, the impact the conditions will have on the operation of the apparatus (e.g., “accommodate” vs. “secure”), and the resulting impact on the operator (i.e., death or survival).

Applicant submits that the conditions under which the inflatable water self-rescue apparatus will be operated, is uncontrollable (i.e., the natural environment), unpredictable (i.e., the weather can change quickly and without warning), and varies greatly (i.e., the apparatus is not operated in one controllable, static, condition, e.g., an indoor, heated swimming pool); and the requirement to operate the apparatus increases, as the environmental conditions worsen (e.g., stronger winds and higher wave height).

Therefore, the relevant common general knowledge must include “experience”, of rescuing oneself (i.e., alone), while immersed in natural bodies of water of various sizes, in a variety of environmental conditions.

Respectfully, it can not be limited to “water self-rescue techniques and conventional devices” in an indoor swimming pool, with “moms and tots”, where, arguably, a very significant number of “*lifeguards*” and “*swimmers*” obtain their training, knowledge and experience.

Thus, more specifically, the relevant common general knowledge must include to —“secure”—(not just “accommodate”, in an indoor swimming pool) an inflatable water self-rescue apparatus to one or two lower extremities of a human, operated under a variety of environmental conditions, under which water self-rescue would be required—which was “unobvious” to Examiner—as evidenced by the results of her analysis, provided in her Notice of Requisition dated 12 March 2019, which was her—third (3rd)—Notice for said current application, i.e., proof of the great extent, of how “unobvious” it was to Examiner.

Therefore, the results of Examiner’s analysis included in Step (I)(b), is also, additional proof of her errors, of: (i) a Fact, i.e., “accommodate” vs. “secure”; (ii) her alleged Lack of Inventive Step defect; and (iii) her alleged Lack of Novelty defect.

In our preliminary view, the relevant CGK set out in the FA takes into account the Applicant's points in relation to "experience" set out in the R-FA. In relation to the issue of knowledge of securing an inflatable water self-rescue apparatus to one or two lower extremities of a human, operated under a variety of environmental conditions, under which water self-rescue would be required, we accept this to have been part of the relevant CGK as well.

Further, due to the nature of the person skilled in the art identified above, we also preliminarily add that the relevant CGK would include knowledge of water rescue device design and manufacture.

[29] The Applicant made no further submissions in respect of the relevant CGK in the submissions of October 17, 2022 or in the R-PR. We proceed on the basis of the relevant CGK as set out in the PR letter.

The claims on file

[30] The instant application contains independent claims 1 and 19, both directed to a water self-rescue apparatus. The subject-matter of the dependent claims is reviewed in detail later during the analysis of lack of novelty/anticipation and obviousness. We reproduce claims 1 and 19 below:

1. A water self-rescue apparatus, comprising: (a) a one or more than one inflatable; (b) said one or more than one inflatable having a shape; (c) said shape having an open side having an opening and an opposite closed side; (d) said opening having a depth, a width, and a length sized to a human having a one or two lower extremities; (e) said depth of at least a part of said opening, as considered from a top of said opening orthogonally straight down toward said opposite closed side, is about a depth of said one or two lower extremities, as considered from an anterior to posterior of said one or two lower extremities at a greatest distance; (f) said width of at least a part of said opening, as considered traversing said opening, is about a width of said one or two lower extremities, as considered transversely from side to side of said one or two lower extremities at a greatest distance, and above said width of at least a part of said opening is about the width of said one or two lower extremities said width is of lesser distance than the width of said one or two lower extremities; (g) said length of said opening, as considered longitudinally, having a distance of a part of a length of said one or two lower extremities, as considered longitudinally along said one or two lower extremities; and (h) said one or more than one inflatable having a buoyancy to support said one or two lower extremities at or near a surface of a body of water.

19. A water self-rescue apparatus, comprising: (a) a one or more than one inflatable; (b) said one or more than one inflatable having a shape; (c) said shape having an open side having an opening and an opposite closed side; (d) said opening having a depth, a width, and a length sized to a human having a one or two lower extremities;

(e) said depth of at least a part of said opening, as considered from a top of said opening orthogonally straight down toward said opposite closed side, is about a depth of said one or two lower extremities, as considered from an anterior to posterior of said one or two lower extremities at a greatest distance; (f) said width of at least a part of said opening, as considered traversing said opening, is about a width of said one or two lower extremities, as considered transversely from side to side of said one or two lower extremities at a greatest distance, and above said width of at least a part of said opening is about the width of said one or two lower extremities said width is of lesser distance than the width of said one or two lower extremities; (g) said length of said opening, as considered longitudinally, having a distance of a part of a length of said one or two lower extremities, as considered longitudinally along said one or two lower extremities; (h) said opening having an incurvate shape with a curvature of about 240 to 300 degrees; (i) said shape of said one or more than one inflatable is streamlined; and (j) said one or more than one inflatable having a buoyancy to support said one or two lower extremities at or near a surface of a body of water.

[31] As we stated in the PR letter at page 8, 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.

The essential elements

[32] As stated in the PR letter at page 8, the FA did not provide a purposive construction of the claims on file. Given that 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 optional, alternatives or a preferred embodiment, in our view, all the elements of the claims on file are considered to be essential and are taken into account in our analysis below.

[33] The Applicant asserted in the submissions of October 17, 2022 at pages 4-5 that the Panel did not “define” the “subject-matter defined by a claim” in performing the assessments of novelty and obviousness. Similar arguments were made at page 38 of the R-PR.

[34] It is not the Panel that defines the subject-matter of the claims. That is defined by the language of the claims themselves as drafted by the Applicant. The Panel can only construe them from the point of view of the person skilled in the art.

[35] We note that in the R-PR at page 10, the Applicant refers to a “subject-matter defined by a claim” that was used in the FA, both as a summary of the invention of

the instant application and as the inventive concept for the obviousness analysis under *Sanofi*. Neither of these characterizations is applicable to the analysis that has been performed by the present Panel.

[36] At page 28 and 38 of the R-PR, the Applicant asserts that the Panel has not conducted a purposive construction of the claims. However, in the present case, since the meaning of the terms used in the claims would have been clear to the person skilled in the art, which the Applicant has not disputed, and all elements are presumed to be essential, which also has not been disputed by the Applicant, we proceed based on all the elements of the claims on file. As discussed below, we do not agree that a special advantage should be read into the claims on file as a possible distinguishing feature in relation to the prior art.

Special Advantage

[37] In prior submissions and in the R-PR, the Applicant alleged that a “special advantage” should have been taken into account in the assessments of lack of novelty and obviousness. We indicated our preliminary view in the PR letter that no such special advantage was a limitation of the claimed subject-matter and that the present case was not like that of *Sanofi*, where what differentiated a bare chemical compound from a previously disclosed genus was not evident from the claim itself, making reference to the rest of the specification necessary to determine whether a “special advantage” was present:

In the R-FA, for example at pages 33-35, the Applicant further alleges that the Office has violated the principles set out in *Sanofi*, in particular by not taking into account the “special advantage” of the claims, namely securement of the inflatable water self-rescue apparatus to one or two lower extremities of a human.

Although, as discussed below, in our preliminary view, such a feature need not have been considered, the FA did take into account the securement of the inflatable to the lower extremities. In particular, at page 2 of the FA it is stated that for the apparatus of D1:

It is taught that the apparatus further includes a strap (28) for releasably fastening one of said one or more than one inflatable to one of said one or two lower extremities which in combination with one of said one or more than one inflatable surrounds one of said one or two lower extremities to secure one of said one or more than one inflatable to one of said one or two lower extremities (Fig. 4).

As such, even if there was a special advantage outside the subject-matter set out in the claims that needs to be taken into account in the novelty assessment, it seems to have been taken into account in the FA.

However, it is also our preliminary view that the present case is not like that of *Sanofi*, where what differentiated a bare chemical compound from a previously disclosed genus was not evident from the claim itself. In such cases, it is permissible to look to the description to find the advantage of the claimed invention that may be used to differentiate it for the purposes of a novelty and obviousness assessment.

In the present case, claim 1, for example, is directed to an apparatus for water-self rescue with a combination of certain characteristics. While claim 1 on file specifies various structural characteristics that would allow the water self-rescue apparatus to fit about the lower extremities, no means of “securement of the inflatable water self-rescue apparatus to one or two lower extremities of a human” (as alleged in the R-FA at page 35) is found in the subject-matter of claim 1 on file, and no link between the structural characteristics and securement is made in the claim. In the present case, the inventive concept of claim 1 is defined by its combination of elements, unlike the situation in *Sanofi* where no inventive concept was readily identifiable from the claims.

We also note that a “means for releasably fastening” the inflatable(s) of claim 1 to the lower extremities to “secure one of said one or more than one inflatable to one of said one or two lower extremities” is only specified in the dependent claims (e.g., claim 2 on file). This suggests, by the principle of claim differentiation, that claim 1 on file is not limited to an embodiment that includes a means of securing the inflatable to the lower extremities.

- [38] Unlike *Sanofi*, the present situation is not one in which it is necessary to look to the rest of the specification to find a special advantage that may differentiate the claimed invention from the prior art. The claimed invention is a combination of elements and not a bare chemical formula (*Sanofi* at paragraph 77).
- [39] In the R-PR at pages 42 and 48, the Applicant asserted that it is the shape of the inflatable water-self rescue device that is the means by which it is secured to one or two lower extremities of a user and that this is a “special advantage” that should be used to differentiate the claimed invention from the prior art.
- [40] While there are passages in the rest of the specification of the instant application that support the idea that the shape itself is the means of securing the inflatable to the lower extremities (see e.g., page 16, “FIG. 1 depicts inflatable 20 open side 21 having an incurvate shape opening 23 which is sufficiently curved to secure to, when the incurvate surface is in contact with, one or two lower extremities of the self-rescuer for water self-rescue”), independent claims 1 and 19 on file are not so

limited. Likewise, there is no language in the dependent claims that sets out the shape of the inflatable itself as the means of securing the inflatable to the user's lower extremities.

Further Allegations in respect of Construction

- [41] In the R-PR at page 42, the Applicant asserted that the Panel decided that securement by means of a strap is the same as securement by means of the shape of the inflatable. The Panel made no such statement in the PR letter. Rather, the Panel pointed out that claim 1 on file contains no limitation as to a means of securing the inflatable to the lower extremities of a user and that it is only in the dependent claims that such a means is introduced (which may be a strap), which means works in combination with the inflatable to secure it to the user's lower extremities. Again, the introduction of such a means in the dependent claims implies that claim 1 contains no limitations as to a means of securement.
- [42] We also note that contrary to the Applicant's statements at page 28 of the R-PR, the Panel has not assessed the claims on file as means claims. The claims have been assessed based on the combination of elements that make up each of them.
- [43] We proceed on the basis of the subject-matter as set out in the claims on file, considering the combination of elements of each claim.

References to prior practice

- [44] At pages 21-24, 35 and 46-48 of the R-PR, the Applicant has made references to portions of the *Manual of Patent Office Practice* (CIPO) that describe the purposive construction that is to be undertaken in examining a patent application.
- [45] We note that while most of the principles set out therein are applicable in accordance with *FreeWorldTrust* and *Whirlpool*, some portions referred to are no longer in effect due to more recent updates to Patent Office practice.

Lack of Novelty/Anticipation

- [46] For a claim to be found to have lacked novelty, the claimed subject-matter must be disclosed and enabled in a single prior art document.

[47] In the PR letter at pages 8, we set out the premise of the lack of novelty/anticipation defect, namely that the combinations of elements of the claims on file were previously disclosed and enabled by the Applicant's own prior US patent document. This prior art document was published more than one year before the Canadian filing date and is therefore a bar to obtaining claims to the same subject-matter in Canada:

In the FA at page 2, it is indicated that all of the claims on file lack novelty under paragraph 28.2(1)(a) of the *Patent Act* in view of the following prior art document:

D1: US20150259055 Nakamoto Published: September 17, 2015

We note that D1 is a US published patent application owned by the same applicant as the instant application. In accordance with paragraph 28.2(1)(a) of the *Patent Act*, D1 was published more than one year before the filing date of the instant Canadian patent application and therefore is citable for lack of novelty/anticipation against it.

Having reviewed D1 in its entirety, it is our preliminary view that D1 discloses and enables all of the subject-matter of the claims on file and therefore anticipates them, in compliance with the requirements set out in *Sanofi*. We note that the description of D1 is substantially the same as that of the instant application, with the exception of some additional material in the instant application focussed on certain details of the water self-rescue apparatus. However, the additional material of the instant application is based on the drawings, which show the same subject-matter as the drawings of D1.

[48] As part of our analysis in the PR letter, we provided a breakdown of the features of the claims on file and the corresponding features of the prior art document D1 in the form of the following table:

Claims of the instant application	Corresponding features of D1
1. A water self-rescue apparatus, comprising: (a) a one or more than one inflatable; (b) said one or more than one inflatable having a shape; (c) said shape having an open side having an opening and an opposite closed side;	(a) See Figures 1, 2A and 2B showing a water self-rescue apparatus that may comprise one or two inflatables positioned about the lower extremities. See also paragraphs [0062], [0063] describing inflatables having an incurvate shape side which is sufficiently curved to secure to a lower extremity of a self-rescuer, as well as that one inflatable may be secured to each lower extremity. (b) see above points from D1 describing the inflatable has having an incurvate

<p>(d) said opening having a depth, a width, and a length sized to a human having a one or two lower extremities;</p> <p>(e) said depth of at least a part of said opening, as considered from a top of said opening orthogonally straight down toward said opposite closed side, is about a depth of said one or two lower extremities, as considered from an anterior to posterior of said one or two lower extremities at a greatest distance;</p> <p>(f) said width of at least a part of said opening, as considered traversing said opening, is about a width of said one or two lower extremities, as considered transversely from side to side of said one or two lower extremities at a greatest distance, and above said width of at least a part of said opening is about the width of said one or two lower extremities said width is of lesser distance than the width of said one or two lower extremities;</p> <p>(g) said length of said opening, as considered longitudinally, having a distance of a part of a length of said one or two lower extremities, as considered longitudinally along said one or two lower extremities; and (h) said one or more than one inflatable having a buoyancy to support said one or two lower extremities at or near a surface of a body of water.</p>	<p>shape on one side. Figure 1 of D1 shows the incurvate side as well as the opposite closed side. See also paragraph [0084] discussing the incurvate shape and opposite closed side of Figures 2A and 2B.</p> <p>(c) See above points on the incurvate shape side and opposite closed side.</p> <p>(d) Figures 2A and 2B of D1 illustrate the inflatables as being sized such that they fit about a person's lower extremities. See also discussion at paragraphs [0078] "Inflatable 20 has a substantial size to secure to one or both lower extremities of the self-rescuer without preventing the performance of the standard or a similar self-rescue maneuver."</p> <p>(e) See Figures 2A and 2B showing the inflatables 20 positioned about the lower extremities, with Figure 2A showing a back of the leg view where the incurvate opening allows the inflatable 20 to fit about the lower leg, therefore the depth of the opening is about the depth of the extremity. See also paragraph [0085] "whereby the incurvate surface of inflatable 20 is in contact with and substantially conforms to the shape of lower extremity 42."</p> <p>(f) See above discussion for point (e) where Figures 2A and 2B show the inflatable fitted to the lower extremities. Also, paragraph [0085] discusses the inflatable substantially conforming to the shape of the lower extremity. Reading D1, the person skilled in the art would be informed that when fitted about the lower extremity, the inflatable would be deformed somewhat in order to fit snugly, with its initial width being less than the width of the extremity in order to do so.</p>
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	<p>(g) As shown in Figures 2A and 2B of D1, the longitudinal length of the inflatables along the length of the lower extremity is part of the length of the lower extremity, extending from about the ankle to about the lower calf.</p> <p>(h) See discussion at paragraph [0084] of D1 where Figures 2A and 2B are described as illustrating the use of the inflatables to position a self-rescuer “substantially horizontal at the surface of the water and facing downward, whereby the back of the lower extremities are at the surface of the water.” Paragraph [0081] discusses the buoyancy of the inflatable 20 and that it is to support the self-rescuer when immersed in water.</p>
<p>2. The apparatus as defined in claim 1, further including a first means for releasably fastening one of said one or more than one inflatable to one of said one or two lower extremities which in combination with one of said one or more than one inflatable surrounds one of said one or two lower extremities to secure one of said one or more than one inflatable to one of said one or two lower extremities.</p>	<p>See Figure 4 and the accompanying discussion in paragraph [0103] “FIG. 4 is a perspective front view of another embodiment depicting a strap 28, of which there are one or more, for releasably fastening inflatable 20 to the lower extremity (not shown) which in combination with inflatable 20 surrounds the lower extremity to secure inflatable 20 to the lower extremity.”</p>
<p>3. The apparatus as defined in claim 1, further including a one or more than one non-rigid, water-resistant strap, comprising: a length to at least extend transversely across one of said one or two lower extremities; and said one or more than one non-rigid, water resistant strap is releasably fastened to one of said one or more than one inflatable.</p>	<p>See Figure 4 and the accompanying discussion at paragraphs [0104] and [0105]</p> <p>[0104] “Strap 28 is comprised of non-rigid, water-resistant material generally used for outdoor applications in or around water such as nylon webbing; having an end, of which there are two opposite; a substantial length to at least extend transversely across one lower extremity of the self-rescuer; and a substantial width and a substantial strength to support at least in</p>

	<p>part the self-rescuer when immersed in water.”</p> <p>[0105] “I contemplate one embodiment in which both ends of strap 28 are fastened to inflatable 20 and at least one end is releasably fastened such as by a conventional hook and loop fastening system (not shown).”</p>
<p>4. The apparatus as defined in claim 1, further including a one or more than one elastic, water-resistant strap, comprising: a length to at least extend transversely across one of said one or two lower extremities; and an end, of which there are two opposite, with both ends fastened to one of said one or more than one inflatable.</p>	<p>See discussion in D1 at paragraphs [0104], discussing the strap 28 extending transversely across the lower extremity and [0108] “I contemplate another embodiment in which strap 28 is comprised of an elastic, water-resistant material, and having two ends which are permanently or semi-permanently fastened to inflatable 20.”</p>
<p>5. The apparatus as defined in claim 1, further including a one or more than one elastic, water-resistant strap, comprising: a length to extend at least transversely across one of said one or two lower-extremities; and an end, of which there are two opposite, with both ends fastened to one of said one or more than one inflatable with at least one end releasably fastened.</p>	<p>See Figure 4 of D1 and paragraphs [0104] discussing the non-rigid, water resistant strap 28, paragraph [0105] discussing the strap having “at least one end is releasably fastened such as by a conventional hook and loop fastening system (not shown).” Paragraph [0108] describes the strap as in one embodiment “comprised of an elastic, water-resistant material, and having two ends which are permanently or semi-permanently fastened to inflatable 20.”</p>
<p>6. The apparatus as defined in claim 2, further including a second means for releasably fastening two or more than two of said one or more than one inflatable to said one or two lower extremities which in combination with two or more than two of said one or more than one inflatable surrounds said one or two lower extremities to secure two or more than two of said one or more than one inflatable to said one or two lower extremities.</p>	<p>See discussion at paragraph [0103] referring to Figure 4 “FIG. 4 is a perspective front view of another embodiment depicting a strap 28, of which there are one or more, for releasably fastening inflatable 20 to the lower extremity (not shown) which in combination with inflatable 20 surrounds the lower extremity to secure inflatable 20 to the lower extremity.” As is clear from Figures 2A and 2B there can be more than one inflatable and therefore a means for releasably fastening each one in</p>

	combination with the inflatable to surround a lower extremity.
7. The apparatus as defined in claim 1, further including an extremity strap having a length to extend at least transversely across one of said one or two lower extremities, and said extremity strap is releasably fastened to two or more than two of said one or more than one inflatable.	See Figure 6 and accompanying discussion at paragraphs [0114] “an extremity strap 32, of which there are one or more, comprised of non-rigid, water-resistant material generally used for outdoor applications in or around water such as nylon webbing, having a substantial length to extend at least transversely across one lower extremity 42, a substantial width and a substantial strength to support at least in part the self-rescuer when immersed in water” and [0115] “Extremity strap 32 releasably fastens two or more inflatables 20 to one or both lower extremities 42 which in combination with inflatables 20 surrounds one or both lower extremities 42 to secure inflatables 20 to lower extremities 42.”
8. The apparatus as defined in claim 1, wherein said opening having an incurvate shape.	See Figure 1 of D1 and discussion at paragraph [0077] “FIG. 1 is a front perspective view of one embodiment of the water self-rescuer depicting inflatable 20 having an incurvate shape side which is sufficiently curved to secure to, when the incurvate surface is in contact with, one or both lower extremities of the self-rescuer for water self-rescue.” The incurvate shape of Figure 1 serves as the basis for the other embodiments of the inflatables shown in Figures 2A, 2B, 3, 4, 5 and 6.
9. The apparatus as defined in claim 8, further including a first means for releasably fastening one of said one or more than one inflatable to one of said one or two lower extremities which in combination with one of said one or more than one inflatable surrounds one of said one or two lower extremities to secure one of said one or more than	See Figure 4 and the accompanying discussion in paragraph [0103] “FIG. 4 is a perspective front view of another embodiment depicting a strap 28, of which there are one or more, for releasably fastening inflatable 20 to the lower extremity (not shown) which in combination with inflatable 20 surrounds

<p>one inflatable to one of said one or two lower extremities.</p>	<p>the lower extremity to secure inflatable 20 to the lower extremity.”</p>
<p>10. The apparatus as defined in claim 8, further including a one or more than one non-rigid, water-resistant strap, comprising: a length to at least extend transversely across one of said one or two lower extremities; and said one or more than one non-rigid, water resistant strap is releasably fastened to one of said one or more than one inflatable.</p>	<p>See Figure 4 and the accompanying discussion at paragraphs [0104] and [0105]</p> <p>[0104] “Strap 28 is comprised of non-rigid, water-resistant material generally used for outdoor applications in or around water such as nylon webbing; having an end, of which there are two opposite; a substantial length to at least extend transversely across one lower extremity of the self-rescuer; and a substantial width and a substantial strength to support at least in part the self-rescuer when immersed in water.”</p> <p>[0105] “I contemplate one embodiment in which both ends of strap 28 are fastened to inflatable 20 and at least one end is releasably fastened such as by a conventional hook and loop fastening system (not shown).”</p>
<p>11. The apparatus as defined in claim 8, further including a one or more than one elastic, water-resistant strap, comprising: a length to at least extend transversely across one of said one or two lower extremities; and an end, of which there are two opposite, with both ends fastened to one of said one or more than one inflatable.</p>	<p>See discussion in D1 at paragraphs [0104], discussing the strap 28 extending transversely across the lower extremity and [0108] “I contemplate another embodiment in which strap 28 is comprised of an elastic, water-resistant material, and having two ends which are permanently or semi-permanently fastened to inflatable 20.”</p>
<p>12. The apparatus as defined in claim 8, further including a one or more than one elastic, water-resistant strap, comprising: a length to extend at least transversely across one of said one or two lower-extremities; and an end, of which there are two opposite, with both ends fastened to one of said one or</p>	<p>See Figure 4 of D1 and paragraphs [0104] discussing the non-rigid, water resistant strap 28, paragraph [0105] discussing the strap having “at least one end is releasably fastened such as by a conventional hook and loop fastening system (not shown).” Paragraph [0108] describes the strap as in one embodiment “comprised of an elastic, water-resistant material, and having two ends which are</p>

<p>more than one inflatable with at least one end releasably fastened.</p>	<p>permanently or semi-permanently fastened to inflatable 20.”</p>
<p>13. The apparatus as defined in claim 1, wherein said shape of said one or more than one inflatable is streamlined.</p>	<p>See Figure 7 of D1 and discussion at paragraph [0123] “FIG. 7 is a side view of the water self-rescuer depicting inflatable 20b having a substantially streamlined shape as secured to lower extremity 42 of the self-rescuer, which is another embodiment I contemplate.”</p>
<p>14. The apparatus as defined in claim 13, further including a first means for releasably fastening one of said one or more than one inflatable to one of said one or two lower extremities which in combination with one of said one or more than one inflatable surrounds one of said one or two lower extremities to secure one of said one or more than one inflatable to one of said one or two lower extremities.</p>	<p>See discussion at D1 paragraph [0125] “I contemplate another embodiment of the water self-rescuer comprising streamline shaped inflatable 20b and first means for releasable fastening 26 (not shown). An additional embodiment I contemplate comprises streamline shaped inflatable 20h and strap 28 (not shown).</p> <p>See also Figure 4 and the accompanying discussion in paragraph [0103] for an example of a means for releasably fastening using the same strap 28 referred to in paragraph [0125] above “FIG. 4 is a perspective front view of another embodiment depicting a strap 28, of which there are one or more, for releasably fastening inflatable 20 to the lower extremity (not shown) which in combination with inflatable 20 surrounds the lower extremity to secure inflatable 20 to the lower extremity.”</p>
<p>15. The apparatus as defined in claim 13, further including a one or more than one non-rigid, water-resistant strap, comprising: a length to at least extend transversely across one of said one or two lower extremities; and said one or more than one non-rigid, water resistant strap is releasably fastened to one of said one or more than one inflatable.</p>	<p>See discussion at D1 paragraph [0125] “I contemplate another embodiment of the water self-rescuer comprising streamline shaped inflatable 20b and first means for releasable fastening 26 (not shown). An additional embodiment I contemplate comprises streamline shaped inflatable 20h and strap 28 (not shown).</p> <p>See Figure 4 and the accompanying discussion at paragraphs [0104] and [0105] for an example of a non-rigid,</p>

	<p>water-resistant strap using the same strap 28 referred to in paragraph [0125] above:</p> <p>[0104] “Strap 28 is comprised of non-rigid, water-resistant material generally used for outdoor applications in or around water such as nylon webbing; having an end, of which there are two opposite; a substantial length to at least extend transversely across one lower extremity of the self-rescuer; and a substantial width and a substantial strength to support at least in part the self-rescuer when immersed in water.”</p> <p>[0105] “I contemplate one embodiment in which both ends of strap 28 are fastened to inflatable 20 and at least one end is releasably fastened such as by a conventional hook and loop fastening system (not shown).”</p>
<p>16. The apparatus as defined in claim 13, further including a one or more than one elastic, water-resistant strap, comprising: a length to at least extend transversely across one of said one or two lower extremities; and an end, of which there are two opposite, with both ends fastened to one of said one or more than one inflatable.</p>	<p>See discussion at D1 paragraph [0125] “I contemplate another embodiment of the water self-rescuer comprising streamline shaped inflatable 20b and first means for releasable fastening 26 (not shown). An additional embodiment I contemplate comprises streamline shaped inflatable 20h and strap 28 (not shown).</p> <p>For an example of an elastic, water-resistant strap using the same strap 28 referred to in paragraph [0125] above, see discussion in D1 at paragraphs [0104], discussing the strap 28 extending transversely across the lower extremity and [0108] “I contemplate another embodiment in which strap 28 is comprised of an elastic, water-resistant material, and having two ends which are permanently or semi-permanently fastened to inflatable 20.”</p>
<p>17. The apparatus as defined in claim 1, wherein said one or more than one</p>	<p>See Figures 2A and 2B of D1 showing the inflatables 20 surrounding and enclosing a</p>

<p>inflatable surrounds and encloses a portion of said one or two lower extremities.</p>	<p>portion of the lower extremities with the open incurvate side at the back of the extremity as shown in Figure 2A.</p>
<p>18. The apparatus as defined in claim 8, wherein said incurvate shape having a curvature of about 240 to about 300 degrees.</p>	<p>See discussion in D1 at paragraph [0077] "I presently contemplate that the incurvate curvature is 240 to 300 degrees."</p>
<p>19. A water self-rescue apparatus, comprising:</p> <p>(a) a one or more than one inflatable;</p> <p>(b) said one or more than one inflatable having a shape;</p> <p>(c) said shape having an open side having an opening and an opposite closed side;</p> <p>(d) said opening having a depth, a width, and a length sized to a human having a one or two lower extremities;</p> <p>(e) said depth of at least a part of said opening, as considered from a top of said opening orthogonally straight down toward said opposite closed side, is about a depth of said one or two lower extremities, as considered from an anterior to posterior of said one or two lower extremities at a greatest distance;</p> <p>(f) said width of at least a part of said opening, as considered traversing said opening, is about a width of said one or two lower extremities, as considered transversely from side to side of said one or two lower extremities at a greatest distance, and above said width of at least a part of said opening is about the width of said one or two lower extremities said width is of lesser</p>	<p>19. (a) See Figures 1, 2A and 2B showing a water self-rescue apparatus that may comprise one or two inflatables positioned about the lower extremities. See also paragraphs [0062], [0063] describing inflatables having an incurvate shape side which is sufficiently curved to secure to a lower extremity of a self-rescuer, as well as that one inflatable may be secured to each lower extremity.</p> <p>(b) See above points from D1 describing the inflatable has having an incurvate shape on one side. Figure 1 of D1 shows the incurvate side as well as the opposite closed side. See also paragraph [0084] discussing the incurvate shape and opposite closed side of Figures 2A and 2B.</p> <p>(c) See above points on the incurvate shape side and opposite closed side.</p> <p>(d) Figures 2A and 2B of D1 illustrate the inflatables as being sized such that they fit about a person's lower extremities. See also discussion at paragraphs [0078] "Inflatable 20 has a substantial size to secure to one or both lower extremities of the self-rescuer without preventing the performance of the standard or a similar self-rescue maneuver."</p> <p>(e) See Figures 2A and 2B showing the inflatables 20 positioned about the lower extremities, with Figure 2A showing a back of the leg view where the incurvate</p>

<p>distance than the width of said one or two lower extremities;</p> <p>(g) said length of said opening, as considered longitudinally, having a distance of a part of a length of said one or two lower extremities, as considered longitudinally along said one or two lower extremities;</p> <p>(h) said opening having an incurvate shape with a curvature of about 240 to 300 degrees; (i) said shape of said one or more than one inflatable is streamlined; and</p> <p>(j) said one or more than one inflatable having a buoyancy to support said one or two lower extremities at or near a surface of a body of water.</p>	<p>opening allows the inflatable 20 to fit about the lower leg, therefore the depth of the opening is about the depth of the extremity. See also paragraph [0085] “whereby the incurvate surface of inflatable 20 is in contact with and substantially conforms to the shape of lower extremity 42.”</p> <p>(f) See above discussion for point (e) where Figures 2A and 2B show the inflatable fitted to the lower extremities. Also, paragraph [0085] discusses the inflatable substantially conforming to the shape of the lower extremity. Reading D1, the person skilled in the art would be informed that when fitted about the lower extremity, the inflatable would be deformed somewhat in order to fit snugly, with its initial width being less than the width of the extremity in order to do so.</p> <p>(g) As shown in Figures 2A and 2B of D1, the longitudinal length of the inflatables along the length of the lower extremity is part of the length of the lower extremity, extending from about the ankle to about the lower calf.</p> <p>(h) See Figure 1 of D1 and discussion at paragraph [0077] “FIG. 1 is a front perspective view of one embodiment of the water self-rescuer depicting inflatable 20 having an incurvate shape side which is sufficiently curved to secure to, when the incurvate surface is in contact with, one or both lower extremities of the self-rescuer for water self-rescue.” The incurvate shape of Figure 1 serves as the basis for the other embodiments of the inflatables shown in Figures 2A, 2B, 3, 4, 5 and 6.</p> <p>See also discussion in D1 at paragraph [0077] “I presently contemplate that the</p>
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	<p>incurvate curvature is 240 to 300 degrees.”</p> <p>(i) See Figure 7 of D1 and discussion at paragraph [0123] “FIG. 7 is a side view of the water self-rescuer depicting inflatable 20b having a substantially streamlined shape as secured to lower extremity 42 of the self-rescuer, which is another embodiment I contemplate.”</p> <p>(j) See discussion at paragraph [0084] of D1 where Figures 2A and 2B are described as illustrating the use of the inflatables to position a self-rescuer “substantially horizontal at the surface of the water and facing downward, whereby the back of the lower extremities are at the surface of the water.” Paragraph [0081] discusses the buoyancy of the inflatable 20 and that it is to support the self-rescuer when immersed in water.</p>
<p>20. The apparatus as defined in claim 19, further including a one or more than one non-rigid, water-resistant strap, comprising: a length to at least extend transversely across one of said one or two lower extremities and said one or more than one non-rigid, water resistant strap is releasably fastened to one of said one or more than one inflatable.</p>	<p>See Figure 4 and the accompanying discussion at paragraphs [0104] and [0105]</p> <p>[0104] “Strap 28 is comprised of non-rigid, water-resistant material generally used for outdoor applications in or around water such as nylon webbing; having an end, of which there are two opposite; a substantial length to at least extend transversely across one lower extremity of the self-rescuer; and a substantial width and a substantial strength to support at least in part the self-rescuer when immersed in water.”</p> <p>[0105] “I contemplate one embodiment in which both ends of strap 28 are fastened to inflatable 20 and at least one end is releasably fastened such as by a conventional hook and loop fastening system (not shown).”</p>

[49] It is evident from the above table and from a simple comparison of the instant application with the Applicant's own prior US published patent application D1, that the subject-matter of the claims on file was disclosed and enabled by D1.

Applicant's submissions in relation to Sanofi/special advantage

[50] In the PR letter at page 17, we addressed the Applicant's submissions in the R-FA in relation to how the *Sanofi* assessment was made in the FA, as well as the Applicant's characterization of the assessment throughout prosecution:

We note several statements in the R-FA (e.g., pages 18, 19, 22, 52 and 78) that suggest that a claim must be anticipated or made obvious by a person such as an examiner. However, whether a claim lacks novelty/was anticipated or would have been obvious is measured against the content of the prior art and the common general knowledge of a person skilled in the art, rather than against the knowledge of an examiner. For lack of novelty/anticipation, the claimed subject-matter must be found in a single prior art document, while for obviousness a combination of prior art documents may be used, taking into account as well the common general knowledge of the person skilled in the art.

We also note that the Applicant appears to characterize the repeated defect of lack of novelty during prosecution as a matter of "trial and error" that is not permitted by Sanofi (see e.g., R-FA at page 52). However, the reference to the impermissibility of "trial and error" in Sanofi was in relation to determining whether the subject-matter of a claim was disclosed in a single prior art document rather than the repeated identification of a lack of novelty defect during prosecution of a patent application.

[51] No further submissions on the above points were made in the R-PR.

[52] With respect to the relevance of a "special advantage" in the novelty assessment, we indicated in the PR letter at page 18 that no such special advantage was present or should be read into the claims, and that even if it had been, D1 would have disclosed and enabled any such feature:

In the submissions of October 17, 2022 at page 22, the Applicant further submitted that the shape of the inflatable apparatus is the means by which the apparatus is secured to one or two lower extremities and represents an essential element/feature. Claim 1 on file does specify the shape of the inflatable as being sized to a human having one or two lower extremities and other structural limitations, but does not specify that this is how the inflatable is secured. While it may be true that the shape is such that it secures the inflatable to a lower extremity, the shape and other characteristics have been preliminarily found to be anticipated

by document D1 and as such any securement based on such a shape and characteristics would necessarily follow.

We note in addition to the above comments that the drawings of D1 are the same as those of the instant application. Further, despite the fact that there is some minor additional passages in the instant application referring to those same drawings, D1 discloses the same subject-matter as that of the instant application. D1 disclosed and enabled everything set out in the claims on file and everything disclosed and enabled by the rest of the instant specification. Therefore, even if a further “special advantage” from the description or essential element/feature could be taken into account, D1 discloses and enables all such subject-matter.

- [53] We noted above under Purposive Construction that the specification of the instant application does suggest that the shape of the inflatable can itself be the means by which it is secured to the lower extremities of a user, while the claims on file are not limited as such. We also note that D1 suggests the same shaping such that the inflatable is secured to a user’s lower extremities (D1 at paragraphs [0062], [0077] and [0085]). Therefore, even if claim 1 on file, for example, were to be interpreted such that the shape itself was the means of securing the inflatable, such a feature is clearly disclosed and enabled in D1 as well, in combination with the other claimed features.

Summary of Novelty Assessment

- [54] In summary, we are of the view that claims 1-20 on file lacked novelty in view of prior art document D1 and are therefore non-compliant with paragraph 28.2(1)(a) of the *Patent Act*.

Obviousness

- [55] For a finding of obviousness, one prior art document may be used to show that the subject-matter of a claim would have been obvious to the person skilled in the art, or a combination of prior art documents may be used. The common general knowledge of the person skilled in the art may be taken into account as well.
- [56] The FA at pages 2-3 indicated that all of the claims on file would have been obvious having regard to D1.
- [57] The obviousness analysis in the FA was set out using the *Sanofi* four-step approach. We do the same below.

[58] In the submissions of October 17, 2022 at pages 10-11, the Applicant appears to have taken issue with the use of the *Sanofi* four-step approach, commenting that its use is not mandatory and that if used, it is possible to assess the words of the claims themselves without going beyond the claim.

[59] We agree that the use of *Sanofi* is not mandatory, but it is generally applied by both the Patent Office and the Courts. In addition, we have not gone beyond the language of the claims themselves.

[60] We also note that at page 34 of the submissions of October 17, 2022, the Applicant alleges that the FA dismissed *Sanofi* as not relevant. While the principles set out in *Sanofi* regarding the assessment of obviousness (and novelty) are to be generally applied, the particular facts of that case and the particular outcome are not determinative of other cases. The general principles are to be applied to each set of facts for each case in determining an outcome.

[61] Similar arguments regarding the use of *Sanofi* were made in the R-PR at pages 6-8.

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

[62] 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

[63] 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

[64] In the PR letter at pages 19-20, we addressed the prior debate surrounding the identification of an inventive concept. We clarified that for the purposes of the obviousness assessment we have taken into account all the elements of the claims:

In the FA at page 3, the inventive concept was set out as follows;

The inventive concept of these claims pertains to an inflatable water self-rescue apparatus comprising an opening on one side of the apparatus for one or two lower extremities of a human.

As was the case for the assessment of novelty, the Applicant contended that the identification of the inventive concept did not take into account the “special advantage” of the invention, namely “securement of an inflatable water self-rescue apparatus to one or two lower extremities of a human” (see e.g., R-FA at page 98, see also submissions of October 17, 2022).

We have already addressed this issue above under the novelty assessment. In our preliminary view, this is not the type of case where recourse to the description is needed to identify an alleged special advantage of the invention beyond the language of the claims.

The Applicant also asserts that the FA identified an opening as part of the inventive concept, but did not associate a use with the opening.

Given that in this assessment we take into account all the elements of the claims on file, the prior characterizations of the inventive concept are not applicable. In our preliminary view, the combination of essential elements of each claim represent their inventive concepts.

We note that in the submissions of October 17, 2022 at pages 26-27, the Applicant appears to suggest that the Panel has used a “common sense meaning of the word construe” in relation to *Sanofi* step 2. As set out above, we have taken all the elements of the claims to be essential in our assessment, which we take as reflecting their inventive concepts.

- [65] In the R-PR at page 34, the Applicant alleged that the Panel identified the inventive concept as “an inflatable water self-rescue apparatus comprising an opening on one side of the apparatus for one or two lower extremities of a human.” The Applicant made a similar allegation in relation to the “subject-matter defined by a claim” arguments at page 35.
- [66] However, the Panel made no such identification. As set out above from the PR letter, the Panel takes all the elements of the claims as essential and takes the claimed combination of elements to reflect their inventive concepts.
- [67] The Applicant also contends at page 34 of the R-PR that the inventive concept should be identified in relation to the state of the art, such as the prior art identified by the US patent examiner during prosecution of the Applicant’s related US application.
- [68] Firstly, the inventive concept that is part of the *Sanofi* assessment is identified

independent of the prior art. If it was not then the third step of *Sanofi*, which seeks to compare the inventive concept to the state of the art, would be redundant.

[69] Secondly, as we have said before, the US prosecution cannot be compared with the prosecution before the Canadian Patent Office. The US prosecution did not use the same prior art document, namely Applicant's own prior published patent application D1 that was published more than one year before the filing date of the instant application, making it citable for both lack of novelty and obviousness.

[70] At page 55-56 of the R-PR, the Applicant set out his own characterization of the inventive concept of claim 1. However, this characterization includes several elements that are not found in claim 1 on file, while omitting many other features that are present in claim 1.

(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

[71] In the PR letter at page 20, it was our preliminary view that since:

prior art document D1 completely anticipates the subject-matter of all of claims 1-20 on file, there are no differences between the state of the art and the inventive concepts or the claims as construed.

[72] The only submissions in the R-PR that would relate to a possible difference over the state of the art represented by D1, was the issue of the "special advantage" that the Applicant alleged needed to be considered in the lack of novelty and obviousness assessments. This issue has been addressed above, our conclusion being that no such "special advantage" is to be considered and even if it were, it was disclosed and enabled by prior art document D1.

[73] In the R-PR at page 56, the Applicant alleged that the Panel characterized the state of the art as represented by D1 as "[A]n inflatable water self-rescue apparatus comprising an opening on one side of the apparatus for one or two lower extremities of a human." The Panel made no such characterization.

[74] In light of the above, it is our view that there are no differences between the state of the art represented by D1 and the subject-matter of the claims on file.

(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?

[75] In the R-PR at page 56, the Applicant alleges that the claimed subject-matter represents a solution to a new problem that has not been identified in the prior art, namely that the prior art required at least two elements to secure an inflatable to the lower extremities of a user, the inflatable and a strap.

[76] The identification of a problem can supply the inventive ingenuity necessary to support a patent. However, in this case, in identifying the problem, the Applicant referred to the prior art document that was used in the corresponding US prosecution, not the prior art document D1 applied here. Prior art document D1 already disclosed and enabled an inflatable self-rescue device that may be secured to a user's lower extremities by means of its shape alone. Therefore the problem alleged to have been present by the Applicant had already been addressed.

[77] Having considered the Applicant's submissions and there being no differences between the subject-matter of the claims on file and what was disclosed by D1, the claims on file would have been obvious to the person skilled in the art.

Summary of Obviousness Assessment

[78] In summary, we are of the view that claims 1-20 on file would have been obvious in view of prior art document D1 and are therefore non-compliant with paragraph 28.3(a) of the *Patent Act*.

Applicant's further submissions

[79] As we noted in the PR letter at page 21, the Applicant made various other allegations in the R-FA and in the submissions of October 17, 2022 in relation to the past prosecution of the instant application. Much of these allegations were repeated in the R-PR. We address them below.

Relevance of US prosecution

[80] In the PR letter at page 21, we addressed the Applicant's prior submissions regarding the influence of the prosecution of his US patent application on that of the instant application:

The Applicant asserted that evidence regarding the US prosecution was dismissed in the FA and in previous office actions. In particular, the Applicant asserted that "the person skilled in the art" has been limited to only Canadians (see e.g., R-FA at pages 42-44) and that the actions of the US examiner as a person skilled in the art in prosecuting D1 should be taken into account.

The "person skilled in the art" from whose point of view purposive construction is performed and assessments such as novelty and obviousness are made, is a fictitious individual or team created to enable a decision maker to put themselves in the shoes of someone in the relevant field at the relevant time. One may then use this person or team and their characteristics and knowledge to determine how such a person or team would have interpreted a document in the past or what this person or team would have done in light of past knowledge.

The US examiner, like the Canadian examiner or a member of the present Panel, are not "persons skilled in the art". Each must however use the point of view of this fictitious person (as set out above under Purposive Construction), in understanding claims and in assessing their validity.

In the submissions of October 17, 2022 at pages 32-33, the Applicant appears to contend that because the USPTO considered his US patent application to be new and non-obvious, the Canadian Patent Office should not arrive at a different result. However, the actions taken by a US examiner during the prosecution of a corresponding case are not limiting on the actions that may be taken in the Canadian Patent Office. Further, the grant of a US Patent does not necessarily mean that one will be granted in Canada. Canadian legislation and jurisprudence relating to patents is very different from that of the US.

Most importantly, we note in particular that the US prosecution involved consideration of a different prior art document that was not a prior disclosure by the Applicant of the same invention, as is the case here.

[81] In the R-PR at pages 8-10, 41 and 59-60, the Applicant again alluded to the idea that because the USPTO examiner found a corresponding US patent application to be novel and non-obvious, that this should influence the assessment of his Canadian application. We note again that the prior art document used against the US patent application was not the same as that before the present Panel. In the present case, the Applicant's own US patent application corresponding to the same disclosed and enabled subject-matter is citable against the instant application due to the publication of the US patent application more than one year before the Canadian filing date of the instant application.

The number of reports

[82] In the PR letter at page 22, we addressed the Applicant's submissions in the R-FA and in the submissions of October 17, 2022 relating to the relationship between the number of reports during examination and the strength of the arguments for lack of novelty and obviousness:

In the R-FA, for example at pages 53, 64 and 74, the Applicant seems to suggest that the case for lack of novelty and obviousness was invalid due to the number of reports that had been written prior to the application being forwarded to the Board.

In the submissions of October 17, 2022 at page 13, the Applicant contends that he did not suggest the above, but instead that the number of attempts at making a case for lack of novelty or obviousness was indicative of the strength of that case and that based on the "balance of probabilities" the claims are patentable.

During prosecution it is common for a number of office actions to be issued before an impasse is reached under subsection 86(3) of the Patent Rules, after which a Final Action may be issued. The number of office actions does not affect the validity of an identified defect. The Panel independently reviewed the prior art document D1 and assessed its content against the claims of the instant application. The number of past office actions identifying a lack of novelty or obviousness defect does not influence our assessment.

[83] In the R-PR at pages 11-12 and 60-61 , the Applicant contended that the number of attempts at making a case for lack of novelty or obviousness during examination was indicative of the strength of that case and that based on the "balance of probabilities" the claims are patentable.

[84] As part of the complete review of the rejected instant application, the Panel has independently reviewed the prior art document D1 and assessed its content against the claims of the instant application. The number of past office actions identifying a lack of novelty or obviousness defect does not influence our assessment of this case.

Other allegations

[85] In the PR letter at page 22, we addressed other allegations made by the Applicant in relation to the prosecution of the instant application:

The Applicant has made various other allegations including violation of the *Charter of Rights and Freedoms* in the way the application has been prosecuted and violation of the *Criminal Code* in doing the same.

Having reviewed the office actions during the prosecution, we see no grounds for such allegations. While arguments may have varied from office action to office action, this is expected as the reasons for a defect are refined in response to an Applicant's submissions.

Further, the introduction of an obviousness defect in the second office action is not improper, nor does it somehow indicate that a claimed invention would not have been obvious (as contended by the Applicant in the October 17, 2022 submissions at page 32). It is not unusual that such a defect is introduced in addition to a novelty defect to cover a situation where the novelty defect is not sustained during review by the Commissioner of Patents, but nevertheless, the claims may have been obvious.

In our preliminary view, all of the defects are appropriately based on the provisions of the *Patent Act*.

[86] In the R-PR at pages 61-62, the Applicant contended that he did not allege that the introduction of an obviousness defect was improper, but rather that the fact that it was not introduced sooner during prosecution was indicative that the claims on file were not obvious.

[87] As we stated in the PR letter and is quoted above, the introduction of an obviousness defect, even though it is felt that the lack of novelty defect is valid, is not unusual. If, upon review, the Board disagrees with the lack of novelty defect, the record still includes for the Board's consideration the alternative arguments relating to why the claimed subject-matter may nonetheless have been obvious.

Proposed Claims

[88] No amendments to the application were proposed in the R-FA, the submissions of October 17, 2022 or the R-PR.

CONCLUSIONS

[89] We conclude that the claims on file lacked novelty in view of prior art document D1 and are therefore non-compliant with paragraph 28.2(1)(a) of the *Patent Act*. Further, we conclude that the claims on file would have been obvious in view of prior art document D1 and are therefore non-compliant with paragraph 28.3(a) of the *Patent Act*.

RECOMMENDATION OF THE BOARD

[90] In view of the above, the undersigned recommend that the application be refused on the grounds that:

- Claims 1-20 on file lacked novelty and are therefore non-compliant with paragraph 28.2(1)(a) of the *Patent Act*, and
- Claims 1-20 on file would have been obvious and are therefore non-compliant with paragraph 28.3(a) of the *Patent Act*.

Stephen MacNeil
Member

Mara Gravelle
Member

Andrew Pothier
Member

DECISION OF THE COMMISSIONER

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

- Claims 1-20 on file lacked novelty and are therefore non-compliant with paragraph 28.2(1)(a) of the *Patent Act*; and
- Claims 1-20 on file would have been obvious and are therefore non-compliant with paragraph 28.3(a) of the *Patent Act*.

[92] In reaching this conclusion I have considered the additional submissions made by the Applicant to myself, the Patent Appeal Board Chair and the Ministers of the Innovation, Science and Economic Development portfolio and find them to be consistent with submissions made to the Board. I completely agree with the Board's conclusions and have made my decision taking into account all the correspondence on file at the Patent Office.

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

Konstantinos Georganas
Commissioner of Patents

Dated at Gatineau, Quebec

this 9th day of February, 2023