

Citation: The Strategic Coach (Re), 2025 CACP 14

Commissioner's Decision #1695

Décision du commissaire n° 1695

Date: 2025-10-14

TOPIC: A11 Application for Patent—Amendment to—New Matter
B00 Claims—Ambiguity or Indefiniteness (incomplete)
J00 Subject Matter of Applications—Meaning of Art
J10 Subject Matter of Applications—Computer Programs
O00 Obviousness

SUJET : A11 Demande de brevet—Modification—Nouvelle matière
B00 Revendications—Caractère ambigu ou indéfini (incomplet)
J00 Objet des demandes—Signification de la technique
J10 Objet des demandes—Programmes d'ordinateur
O00 Évidence

Application No. 2713371
Demande n° 2713371

IN THE CANADIAN PATENT OFFICE

DECISION OF THE COMMISSIONER OF PATENTS

The Commissioner refuses patent application 2713371 based on the Patent Appeal Board's recommendation. The Board reviewed the application under paragraph 199(3)(c) of the *Patent Rules*, SOR/2019-251, following the application's rejection under subsection 30(3) of the former *Patent Rules*, SOR/96-423.

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INTRODUCTION

- [1] The Patent Appeal Board recommends patent application 2713371 be refused for claiming unpatentable subject matter, claiming obvious subject matter, having indefinite claims, improper dependent claims and having new matter.

The application

- [2] The Strategic Coach applied for a patent (2713371) for “Systems and Methods for Providing Information Relating to Professional Growth.” The invention involves software for providing pertinent career management information to clients. There are 36 claims on file.

Prosecution history

- [3] The Examiner sent a Final Action rejecting the application for claiming unpatentable and obvious subject matter. The Applicant responded by proposing a new set of 18 claims and a new description with several page replacements (the first proposed claims and description), and by submitting arguments for their allowance. The Examiner was persuaded by the arguments that the claims on file (and the first proposed claims) were not obvious. They maintained the rejection, however, because they were unconvinced that the claims on file, or the first proposed claims, were directed to patentable subject matter. The rejected application was sent to the Board for review on behalf of the Commissioner of Patents, and the Examiner’s reasons were sent to the Applicant.
- [4] We preliminarily reviewed the application and told the Applicant the results via a preliminary review letter on November 4, 2024. The letter explained that all the claims on file define unpatentable subject matter, and that claims 1 to 17 on file define obvious subject matter. Additional defects were also identified:
- claims 3 to 15 and 17 to 36 on file are indefinite;

- claims 3, 5, 13, 17, 21, 23, 27, 31 and 34 on file are improper dependent claims; and
- claims 1, 12, 16, 18, 30 and 36 on file, and paragraphs 9a to 9f of the description on file, contain impermissible new matter.

[5] The letter also explained why we did not consider the first proposed claims and description to be amendments that would make the application allowable. Finally, the letter invited the Applicant to respond by making written submissions and by participating in a hearing.

[6] The Applicant responded to the preliminary review letter with written submissions on December 28, 2024. Their response to the preliminary review letter included a newly proposed set of 13 claims and a description (the second proposed claims and description), and arguments for their allowance. The Applicant also requested a hearing, which was held on January 23, 2025.

THE ISSUES

[7] We had to determine whether:

- claims 1 to 36 on file define subject matter outside the definition of invention in section 2 of the *Patent Act*, RSC 1985, c P-4, and prohibited by subsection 27(8) of the *Patent Act* (the full text of all cited legislation is included in the Appendix);
- claims 1 to 36 on file define subject matter that would have been obvious in view of cited documents, contravening paragraph 28.3(b) of the *Patent Act*;
- claims 3 to 15 and 17 to 36 on file are unclear, thus making them indefinite, contravening subsection 27(4) of the *Patent Act*;
- claims 3, 5, 13, 17, 21, 23, 27, 31 and 34 on file are improper dependent claims, contravening subsection 63(1) of the *Patent Rules*, SOR/2019-251; and

- claims 1 to 36 on file, and paragraphs 9a to 9f of the description on file, contain impermissibly added new matter, contravening subsection 38.2(2) of the *Patent Act*.

[8] We then also had to consider whether:

- replacing the specification on file with the second proposed claims 1 to 13 and second proposed description would make the application allowable, as required under subsection 86(11) of the *Patent Rules*.

[9] Before determining these issues, we had to purposively construe the claims.

PURPOSIVE CONSTRUCTION

Principles

[10] Claims must be purposively construed before considering validity issues (*Free World Trust v Électro Santé Inc*, 2000 SCC 66 at para 19 [*Free World Trust*]; *Whirlpool Corp v Camco Inc*, 2000 SCC 67 at para 43 [*Whirlpool*]). Claims are purposively construed from the point of view of the person skilled in the art, in light of the relevant common general knowledge as of the publication date (*Free World Trust* at paras 31, 44, 51, 55–57, 66; *Whirlpool* at paras 45, 48, 53, 55; “Patentable Subject-Matter under the *Patent Act*” (CIPO, November 2020) at “Purposive construction” [PN2020–04]). The whole disclosure is considered, including the specification and drawings (*Whirlpool* at paras 48–49, 52–54; PN2020–04).

[11] 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 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. Claimed elements are presumed essential unless it is established otherwise, or unless such presumption is contrary to the claim

language (*Free World Trust* at para 57, *Distrimedic v Dispill Inc*, 2013 FC 1043 at paras 200–01; *PN2020–04* (at “Purposive construction”).

- [12] Both interpretation of term meaning and identification of the essential elements are done in light of the relevant common general knowledge. Therefore, one must first identify the skilled person and determine their common general knowledge.

The skilled person and their common general knowledge

- [13] We characterize the skilled person as a team comprising consultants or professionals in career development and management. The team also comprises programmers and other technologists experienced with developing and providing the software, tools and infrastructure conventionally used to support the activities and designs of such professionals.
- [14] Based on this characterization of the skilled person, we identify the relevant common general knowledge as of the publication date—March 16, 2011—as including:
- conventional strategies and techniques for developing and managing career paths;
 - conventional strategies and techniques for helping achieve self-determined, measurable goals;
 - conventional analyses involving strengths, weaknesses, dangers and opportunities (e.g. SWOT analysis);
 - conventional computer programming techniques; and
 - the design, implementation, operation and maintenance of computer systems, networks and software, including:

- general-purpose and special-purpose computers, computing devices, processors, user interfaces and peripherals;
- database systems (including relational databases) and other data storage systems, plus:
 - associated techniques, protocols and schema for data entry, storage and retrieval; and
- computer network and other data communications systems, and their related protocols.

[15] We also base this identification on what the present application describes as generally known or conventionally done in the field (paras 57–61). This identification is also supported by the disclosures of D1 to D3, D5 and D6. These documents disclose subject matter relevant to the present invention:

D1: US 2007/0203710 August 30, 2007 Habichler et al.

D2: US 5954510 September 21, 1999 Merrill et al.

D3: US 2009/0037241 February 5, 2009 Olsen et al.

D5: Kim Atkinson, “SWOT analysis: a tool for continuing professional development” (August 1998) 5:8 Brit J Therapy & Rehabilitation 433.

D6: Richard W Puyt, Finn Birger Lie & Celeste PM Wilderom, “The origins of SWOT analysis” (June 2023) 56:3 LRP, Article 102304.

[16] Like the present application, D1 (paras 2–4), D2 (columns 1–3) and D3 (paras 5–9) describe computerized systems and methods generally known or conventionally done in the field. D6 traces the origins of the well established and widely used “SWOT analysis” strategy tool to the 1960s (sections 1, 6–8). (“SWOT” is an acronym for “strengths, weakness, opportunities and threats.”) D5 gives an example of SWOT analysis being used to help plan one’s continuing professional development (433–35). D3 also gives an example of SWOT analysis

being used in the context of computerized strategic planning and goal setting for a company (e.g. abstract; paras 4–10, 37, 188, 204–05, 227; figure 73).

- [17] The Applicant did not dispute the relevance of these documents (only our view that they showed the invention to be obvious).
- [18] Above, conventional career management strategies and techniques, and computer infrastructure and technologies, are identified as common general knowledge. Such identification is also supported by the low amount of detail in the application (e.g. paras 18–29, 33–40, 45; 55–63; figures 1–3, 11) concerning the implementation of the invention. Many of the strategies, techniques, concepts and computer technologies used are not described. This limited detail suggests that putting any particular strategy, technique or concept into practice, and to use computer tools to do so, must be within the capabilities of the skilled person.
- [19] The Applicant did not dispute our identification of the skilled person and their relevant common general knowledge.

The claims

- [20] There are 36 claims on file. The independent claims on file are claims 1 and 18 (in the form of methods), claims 12 and 30 (in the form of systems), and claims 16 and 36 (in the form of stored software). Claims 1, 12 and 30 are directed to the provision of information regarding professional growth, claim 18 is directed to assisting a client reach a level of professional growth, and claims 16 and 36 are directed to the management of professional development.
- [21] Claims 16 and 30 are representative:
 - 16. A non-transitory computer-readable storage medium having embodied thereon a program, the program executable by a processor to perform a method for managing professional development, the method comprising:
 - receiving client data regarding professional growth of a client;

determining a current level of professional growth of the client, based on the received client data;

identifying a next level of professional growth for the client, based on the determination of the current level;

generating a plurality of professional growth tools using one or more templates stored in a relational database;

associating each level of professional growth with at least one of the generated professional growth tools;

deriving one or more strategies from associations in the relational database on how to measurably progress from the current level to the next level;

providing the one or more derived strategies to the client;

providing the client with information regarding the next level, based on the identification of the next level; and

providing to the client an interactive professional growth tool configured to perform an evaluation of the professional growth of the client based on the derived strategies and current statistics supplied by the client.

30. A system for providing information regarding professional growth, the system comprising:

a relational database configured to store client data regarding professional growth of a client, the client data comprising associations among data entries regarding professional growth of the client;

a processor configured to execute instructions stored in memory to:

determine a current score for each level of a plurality of levels of professional growth of the client, based on the received data, the plurality of levels of professional growth including monopoly, domination, innovation, differentiation, profitability, productivity and captivity;

develop upcoming strategies for progress to be made for each of the levels of professional growth, based on the received client data; and

identify a next level of professional growth for the client, based on the determination of the current score;

a professional growth tool module configured to:

generate a plurality of professional growth tools using one or more templates and training materials stored in the relational database, each of the plurality of levels of professional growth associated with at least one of the professional growth tools; and

identify which of the available professional growth tools associated with the current level of professional growth should be provided to the client, based on the determination of the current level;

a strategy module configured to:

derive one or more strategies from associations in the relational database on how to measurably progress from the current level to the next level;

provide the one or more derived strategies to the client; and

generate a recommendation for each level of the plurality of levels using a largest check calculator, the recommendation indicating a range of tasks upon which to focus;

an interface module configured to provide the client with information regarding each of the plurality of levels of professional growth, based on the score and client data input for each of the plurality of levels of professional growth; and

a statistical module configured to:

provide the client with a statistical measurement of the client's professional growth based on the current level of professional growth of the client and one or more prior levels of professional growth that were obtained by the client; and

provide to the client the identified professional growth tool associated with the current scores for each level of the plurality of levels of professional growth, the provided professional growth tool including templates and training materials stored in the relational database, the provided professional growth tool configured to perform an evaluation of the professional growth of the client based on current statistics supplied by the client, the statistics representing at least one statistical measurement of the professional growth of the client within a given time period.

[22] Independent claim 1 on file is directed to similar subject matter as claim 16, though in the form of a method. It does not explicitly recite the derivation and provision of strategies for measurably progressing. It also differs by explicitly referring to the use of "training materials" in generating and using the professional growth tools, and to the identification of which professional growth tool associated with the current level to provide.

[23] Independent claim 12 on file is directed to similar subject matter as claim 16, though in the form of a system. It does not explicitly recite the provision of the generated professional growth tool for performing an evaluation. It also differs by referring to the provision of a statistical measurement of growth.

- [24] Independent claim 18 on file is directed to similar subject matter as claim 30, though in the form of a method. It does not explicitly recite the derivation and provision of strategies for measurably progressing from the current level to the next. It recites the generation of professional growth tools for each level using stored templates and training materials, not explicitly the generation of recommendations for each level using the “largest check calculator,” and indicating a range of tasks upon which to focus. Nor does it explicitly recite that information is provided regarding each level, and based on, among other factors, the score. It also differs by explicitly naming types of established details for each level, specifying access to the professional growth tool via the Internet, referring to other “calculators” in addition to the “largest check calculator,” and referring to an “enforcement mechanism.”
- [25] Independent claim 36 on file is effectively directed to the same subject matter as claim 30, but in the form of stored software.
- [26] Dependent claims 2, 6 to 8, 10, 11, 14, 15, 19, 20, 24 to 26, 28, 29 and 32 to 35 on file include additional details regarding the meaning of the information provided to the client, received from the client or simply maintained.
- [27] Dependent claims 3, 17 and 21 on file refer to the professional growth tool being used to assist a client in obtaining the next level of professional growth.
- [28] Dependent claims 4 and 22 on file refer to the measurement of professional growth data for a client using a “calculator” in the professional growth tool.
- [29] Dependent claims 5, 13, 23 and 31 on file specify that the database is coupled to the processor.
- [30] Dependent claims 9 and 27 on file specify that the professional growth tool is online.

The meaning of certain terms

“Professional growth tool” and “professional growth tool module”

- [31] All the independent claims on file refer to “professional growth tools.” The skilled person would take such a “tool” to be a combination of informative material and some sort of script or code, enabling the tool to accept client input and make certain calculations based on it.
- [32] According to the description, “professional growth tools” are provided, supplied or recommended to the client (e.g. via their web browser, or otherwise online), by the “professional growth tool module 220,” which appears to be some sort of software module (paras 6, 17, 22, 25–29, 36–38; figures 1–2).
- [33] The professional growth tool is described as interactive and configured to help the client attain their next level of professional growth. There is at least one professional growth tool associated with each level of professional growth; these tools are provided to the client based on their current levels.
- [34] The professional growth tool module selects templates and training materials from database 130 to assemble, customize or simply provide as the professional growth tool. How the module does so is not discussed.
- [35] A professional growth tool may also include means (e.g. a “calculator”) for collecting further data from the client and updating or redetermining their level of professional growth. It appears that the professional growth tool module may use this resulting data to recommend or provide another professional growth tool to the client.
- [36] The “calculators” are undefined by the application (e.g. paras 28, 36–38), which instead refers the reader to another patent application for their description. That patent application only defines the purpose for their output.
- [37] Independent claims 16 and 36 say a professional growth tool is provided to the client but not which tool or how it is selected. They do say, however, that the

evaluation it is configured to perform is based, in part, on derived strategies for the client to progress from their current level of professional growth. Our view is that the skilled person would interpret claims 16 and 36 as meaning that the selection of the professional growth tool provided to the client is based, at least in part, on the current level of professional growth of the client.

- [38] Regarding the generation of this tool in the claims on file, “templates” are undefined in the application. Our view is that the skilled person would construe the use of templates to simply mean that professional growth tools are not generated from scratch, but are materials selected from the database, potentially customized to reflect the received client data in some way.
- [39] Claims 1, 16, 30 and 36 on file stipulate that the tool is configured to perform an evaluation of the client’s professional growth, based in part on current statistics provided by the client. Claim 18 on file says the tool includes at least one “calculator” configured to calculate client progress in achieving the next level of professional growth, using current statistics provided by the client. Our view is that the skilled person would interpret claims 1, 16, 18, 30 and 36 as meaning that the tool has some sort of (undisclosed) script or code, enabling it to make certain (undisclosed) calculations based on client input.
- [40] The Applicant did not say anything at the hearing, or in their written response to our preliminary review letter, to conflict with this interpretation of the professional growth tool and the professional growth tool module.

“Enforcement mechanism”

- [41] The skilled person would construe the “enforcement mechanism” of claim 18 on file as some sort of means, concept or circumstances for ensuring a client interacts with a recommended professional growth tool.
- [42] Claim 18 states that the professional growth tool includes “an enforcement mechanism such that the client must interact with the” tool. Aside from reproducing the text of the claim in paragraph 9d, the description and drawings

disclose no such mechanism in the tool. The description does, however, refer to a possible enforcement mechanism in the tool module 220 for ensuring clients interact with a recommended tool before advancing to the next level (para 29). Although the enforcement mechanism recited in claim 18 contradicts the description's explanation, it remains an element in the claim needing interpretation. Based on the specification and drawings as a whole, our view is that the skilled person would construe it as a purely functional limitation. That is, it is some sort of means, concept or circumstance, that causes clients to interact with the professional growth tool recommended for their level of growth, to some desired degree, before being able to access professional growth tools for other levels.

- [43] The Applicant did not say anything at the hearing, or in their written response to our preliminary review letter, to conflict with this interpretation of the enforcement mechanism.

The elements are presumed to be essential

- [44] None of the claim language appears to suggest any of the elements are non-essential. Nor has it been established that any of them are non-essential. Accordingly, we presume all the elements of the claims on file to be essential.
- [45] The Applicant made no submissions in response to our preliminary review letter regarding purposive construction. Nor did they dispute this presumption of essentiality at the hearing.

PATENTABILITY: CLAIMS 1 TO 36 ARE UNPATENTABLE

Principles

- [46] A claim must define subject matter fitting within the definition of invention in section 2 of the *Patent Act*. Additionally, patents cannot be granted for any mere scientific principle, abstract theorem or mathematical formula (*Patent Act*,

s 27(8); *Schlumberger Canada Ltd v Commissioner of Patents*, [1982] 1 FC 845 (CA) at 847 [*Schlumberger*]; *Canada (Attorney General) v Benjamin Moore & Co*, 2023 FCA 168 at paras 47, 51, 53, 68, 72 [*Benjamin Moore*]).

- [47] *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.

- [48] The determination of the actual invention is a relevant and necessary question in assessing patentable subject matter (*Canada (Attorney General) v Amazon.com Inc*, 2011 FCA 328 at para 42 [*Amazon.com*]). As stated by the Federal Court of Appeal in *Benjamin Moore* (para 68), this determination is in line with that Court’s statement in *Schlumberger* (page 847) that a patentable subject matter assessment involves determining what, according to the application, has been discovered. The actual invention is identified in the context of the new discovery or knowledge, and must ultimately satisfy the “physicality requirement” that is implicit in the definition of “invention” (*Amazon.com* at paras 65–66).
- [49] During the hearing, the Applicant submitted that the “physicality requirement,” as it is described in *PN2020–04*, is not based on the *Patent Act* or *Patent Rules*, or on jurisprudence. More specifically, the Applicant contended that while there is a need for something to have a physical existence, or to manifest a discernible effect or change, there is no need for a discernible **physical** effect or change. The Applicant referred to an example claim in the *Manual of Patent Office Practice* (CIPO) [*MOPOP*] (at §22.03.03, example 1, revised October 2010) for support. The Applicant characterized this example claim as reciting what would

have been patentable subject matter (if not for the cited prior art) despite a lack of physicality.

- [50] The cited example is of unpatentable subject matter. In any case, since this section of *MOPOP* has been superseded by *PN2020-04*, we do not comment on the Applicant's characterization of the example.
- [51] While it is true that *Amazon.com* (paras 65–66) refers to “a discernible effect or change” without the “physical” adjective, this language is used in the context of discussing the physicality requirement. Our understanding is thus that the “physical” limitation applies to both the criteria for the existence and the criteria for the manifested discernible effect or change (*PN2020-04* at note 11).
- [52] To satisfy this “physicality requirement,” the actual invention must have physical existence, or manifest a discernible physical effect or change. However, the mere presence of a practical application is insufficient to meet this requirement (*Amazon.com* at paras 66, 69). “[A] patent claim may be expressed in language that is deliberately or inadvertently deceptive” and what appears on its face to be an “art” or “process” may in fact be a claim to an unpatentable mathematical formula (*Amazon.com* at para 44). This was the situation in *Schlumberger*. In that case, the claims “were not saved by the fact that they contemplated the use of a physical tool, a computer, to give the novel mathematical formula a practical application” (*Amazon.com* at para 69).
- [53] The patentable-subject-matter concerns regarding the well-known use of a computer to process an algorithm, illustrated by *Schlumberger*, are outlined in the factors set out in *PN2020-04* that may be considered when reviewing computer-implemented inventions, namely:
- the mere fact that a computer is among the essential elements of the claimed invention does not necessarily mean that the claimed invention is patentable subject matter;
 - an algorithm itself is abstract, unpatentable subject matter and prohibited by subsection 27(8) of the *Patent Act*;

- a computer programmed to merely process an abstract algorithm in a well-known manner will not make it patentable subject matter; but
- if processing an algorithm improves the functionality of the computer, the computer and the algorithm together form a patentable single actual invention.

[54] The above factors and the general concerns around the well-known use of a computer to process new abstract algorithms can be seen to involve considerations of novelty or ingenuity. Canadian law does not prohibit considerations of the novelty or ingenuity of elements of a claim in considering patentable subject matter and finds support in situations like that of *Schlumberger* where a known tool, a computer, is used to give an abstract mathematical formula a practical application (*Benjamin Moore* at paras 69–70, referring to *Amazon.com*). These considerations assist in the determination of the discovery or new knowledge, the method of its application and the actual invention (*Benjamin Moore* at para 89) that is ultimately measured against the physicality requirement.

[55] As noted in *Benjamin Moore* at para 94 (and similarly expressed in *Amazon.com* at para 61), the physicality requirement will not likely be satisfied without something more than only a well-known instrument, such as a computer, being used to implement an abstract method. The factors set out above from *PN2020–04* assist in determining whether something more is present.

Analysis

[56] We consider the claims on file to be directed to unpatentable and prohibited subject matter. The claimed subject matter fails to meet the physicality requirement.

[57] Each of the claims recites some sort of physical element or step, be it a computerized step, a component of a computer system or stored software. During the hearing, the Applicant submitted that the claimed invention cannot operate as intended without a computer. That there is no suitable substitution for

the computer that could perform substantially the same function in substantially the same way, to obtain substantially the same result.

- [58] Although this could be relevant to purposive construction and the determination of whether a claimed element is essential, we have already stated that we presume all the claimed elements here to be essential. But the mere inclusion of a computer among the essential elements of a claimed invention does not confer patentability upon it (*PN2020-04* at Computer-implemented inventions; see also *Benjamin Moore FCA* at para 87). The actual invention must be identified and assessed for the physicality requirement. The fact that an element cannot be substituted—or that it is essential—does not mean it must be part of the actual invention.
- [59] The application (title; paras 1–5, 17; figure 3) shows that the invention is intended to provide professional growth information to a client. More specifically, professional growth information regarding the client is received, then used to determine “the current level of professional growth” and the “next level.” Information on the next level is then provided to the client. “Interactive professional growth tools” and strategies may also be provided.
- [60] Claim 16 recites stored software for causing a computer to put such a method of providing professional growth information into practice. Claim 30 recites a computer system programmed to do so. In both cases, professional growth information is provided to a client according to certain rules for receiving input, making determinations based on this input, and selecting output to provide. The claims do not define specific or detailed rules and steps (nor does the remainder of the application disclose them); the focus appears to be on these rules conceptually or generally.
- [61] The Applicant submitted in their written response to the preliminary review letter (pages 4–6), and at the hearing, that the claimed invention is not an abstract set of rules for providing professional growth information. Instead, it constitutes improvements to the functioning of a computer. They submitted that the system pulls client data (and other data) into a relational database, establishes or

determines associations among the data, then combines the data with strategy template information to generate useful custom strategies. They characterized the computer's activity as "machine learning," and the system as getting smarter and better, because the relational database is periodically updated, and because of "the associations determined by the relational database."

- [62] The description does not make any reference to the system pulling in data. It (para 21) does say that the system may include a relational database which "may obtain data entries from a variety of data sources," but does not say how. Claim 16 states only that client data is received, and claim 30 refers only to the relational database being configured to store client data.
- [63] The description (para 21) also says that the relational database may "determine associations of data entries regarding a client," but does not say how, or give any more details. Claim 16 does not refer to these associations, and claim 30 only says that the stored client data comprises associations among data entries. The Applicant remarked at the hearing that relational databases provide links between associated data, and did not describe anything that can be taken as special functioning of the database here. There is no suggestion here of how a database might "determine" any associations between data entries beyond receiving input of data so organized.
- [64] There is no suggestion of "machine learning" in the application. What the Applicant characterizes as the system learning, getting smarter, and getting better over time appears to stem from the periodic updating of the database, or from the system's receipt of new input. In any case, the Applicant remarked at the hearing that their submission was not to be taken as a general statement that "machine learning" forms the basis of why this invention solves a computer problem.
- [65] This invention does not involve the solution of a computer problem, nor the improvement of a computer's functioning. Computers are being used in a well-known manner to put the rules for providing professional growth information into practice. The involved hardware and software, to the extent that they are defined

in these claims, are common general knowledge; this common general knowledge is discussed above. This characterization is also borne out by the lack of detail in the description and drawings regarding computer implementation (e.g. paras 18–25, 31, 56–62; figures 1–2, 11). The lack of detail suggests that the skilled person would know how to use computer technology to put the rules into practice without needing to be told such details.

- [66] The application does not disclose how a computer is used to determine the current and next levels of professional growth of the client. Nor, as discussed above (in the section on the meaning of certain terms), does it disclose how to customize and combine materials into information or tools to provide to the client, or how the “calculators” function, when involved. The application does not suggest any challenges in adapting computer technology to provide the proposed professional growth information and tools. Nor does processing these rules appear to improve the functionality of the involved computers.
- [67] Thus, the actual invention for both claims 16 and 30 on file appears to be the abstract set of rules for providing professional growth information. Such an abstract set of rules or algorithm is unpatentable. The computers are merely processing the rules in a well-known manner; the functionality of the computers is not improved by doing so. Therefore, the computers neither form part of the actual invention nor make the abstract set of rules patentable.
- [68] As explained above during the discussion of the claims, independent claims 1, 12, 18 and 36 on file are directed to similar subject matter as claims 16 and 30, though in different forms. Claims 1, 12 and 18 also vary some details concerning what information is provided as output, or what sources or operations are used to generate or select it. Claim 18 also refers to use of the Internet.
- [69] The use of the Internet in this context represents computer technology being used in a well-known manner to process the abstract rules for providing professional growth information. The other details mentioned pertain to those rules. The actual inventions of claims 1, 12, 18 and 36 appear unpatentable for reasons similar to those provided above for claims 16 and 30.

- [70] The actual inventions of dependent claims 2 to 11, 13 to 15, 17, 19 to 29 and 31 to 35 on file appear unpatentable for reasons similar to those above. Dependent claims 2, 6 to 8, 10, 11, 14, 15, 19, 20, 24 to 26, 28, 29 and 32 to 35 recite additional details regarding the meaning of information. Details of solely intellectual significance do not make the actual invention patentable. Dependent claims 3, 5, 13, 17, 21, 23, 27 and 31 on file do not appear to add any details (as explained below in the section on Indefiniteness and dependent claim wording), thus their actual inventions are the same as those above. Dependent claims 4 and 22 on file add a detail regarding the operations used to generate or select certain information. This detail is limited to the intellectual significance of information and abstract rules for operation; it does not make the actual inventions patentable. Dependent claim 9 specifies that the professional growth tool is “online”; such a detail is part of the computer technology being used in a well-known way.
- [71] Therefore, claims 1 to 36 on file define unpatentable subject matter, falling outside section 2 of the *Patent Act* and prohibited by subsection 27(8) of the *Patent Act*.

OBVIOUSNESS: CLAIMS 1 TO 17 ARE OBVIOUS

Principles

- [72] A claim must define subject matter that would not have been obvious to a skilled person on the claim date (*Patent Act*, s 28.3). Obviousness is assessed having regard to documents that were publicly available before the claim date (*Patent Act*, s 28.3(b)). The following four-step approach is useful for assessing obviousness (*Apotex Inc v Sanofi–Synthelabo Canada Inc*, 2008 SCC 61 at para 67):
- (1) Identify the skilled person and their relevant common general knowledge;

- (2) Identify the inventive concept of the claim or construe it;
- (3) Identify any differences between the matter cited as part of the state of the art and the inventive concept or construed claim;
- (4) Would those differences have been obvious to the skilled person?

The skilled person and their common general knowledge

[73] We identified the skilled person above, and that identification is equally apt for assessing obviousness. For obviousness, the common general knowledge as of the claim date is used. In this case, the claim date is September 16, 2009. We nonetheless consider the above identification of the relevant common general knowledge applicable to assessing obviousness here.

[74] The Applicant did not object to this approach.

The inventive concept or construed claim

[75] We construed the claims on file above. We take the wording of each construed claim as representing its inventive concept.

[76] The Applicant did not object to this approach.

The differences

[77] We consider D1 to come the closest of the cited references to disclosing the present invention. The differences between the disclosure of D1 and the inventive concepts for the claims on file are that D1 does not:

- discuss templates (unlike all the claims on file);

- define the career management action plan (or other tools and materials provided to the client) as being generated from materials stored in the database (unlike all the claims on file); for example, see paragraphs 108 and 130, and figure 14, of D1;
- discuss the automatic evaluation of the client's professional growth based in part on input statistics (unlike claims 1 to 11, 16, 17 and 30 to 36 on file);
- discuss the statistical measurement of the client's professional growth (unlike claims 12 to 15 on file);
- disclose the provision of the specific information recited by claims 7 to 9, 11, 15, 25 to 29, 33 and 35 on file;
- disclose the determination of scores for the same list of concepts ("levels of professional growth" including "monopoly, domination, innovation," etc.) (unlike claims 18 to 29 and 30 to 36 on file);
- discuss the calculation of client progress in achieving the next level of professional growth based on input statistics (unlike claims 18 to 29 on file);
- disclose the identification of levels of professional growth based on a comparative analysis involving the same concepts ("established details of each level") (unlike claims 18 to 29 on file);
- discuss enforcement mechanisms (unlike claims 18 to 29 on file); or
- label the means by which it generates recommendations for each level as "a largest check calculator" (unlike claims 30 to 36 on file).

[78] D1 discloses a computerized system that provides competency-related information for individuals in an organization (abstract; paras 23, 73, 81–82, 85–88, 93–96, 111–12). Individuals may use the system to identify competency gaps and obtain information helping them manage their career paths or professional growth. Also, managers may use the system to identify competencies and competency gaps for their group as a whole, and to create plans for managing

the professional growth of the group (paras 26, 97–102, 107, 113, 133–37). Information regarding various competencies, skills, credentials and current work positions for clients is stored by the system and accessible when needed (paras 72–80, 127–29; figure 6C). Thus, when the system accesses this information for a client, it is able to determine the client's current skill levels and work position, as well as the potential next levels for these skills and potential next work position. Based on the client's current work position and competencies, and on their target position, the system can provide them with information on their target position, make learning recommendations and suggest career paths and career path management action plans (paras 110–12, 130; figure 14). The client may interact (via their Web browser) with the learning recommendation and the career path management components. For example, they may modify their career path management action plans, by selecting goals and setting timelines. A client's progression is measurable, in that new skills, increased skill levels, indication of completed training, new work positions, etc. may be provided to the system and recorded (paras 81–91; figures 5A–5B). In this context, an employee's current set of skills and competencies therein can be considered as "a level of professional growth." Alternatively, a job position itself (figure 6C) can be considered as such a level.

Would those differences have been obvious?

- [79] In our view, the differences between the disclosure of D1 and the inventive concepts for claims 1 to 17 on file would have been obvious to the skilled person, given their common general knowledge and the disclosure of D2.
- [80] The references in the claims on file to templates do not constitute inventive differences. As discussed above, the use of "templates" in this context is construed as simply meaning that the plans and tools are not generated from scratch, but are selected from stored materials, and potentially customized.
- [81] It would have been obvious to generate plans and tools using materials stored in a database. The common general knowledge includes techniques for making

business strategies, plans for managing career paths, and for helping persons set and achieve goals. D1 discloses a system for helping an employee develop, modify and store a career path management plan (paras 95–96, 111, 130, 132; figure 8E). D1 also discloses the storage in the database of information necessary for the creation of the plan (e.g. para 108). The idea of generating a career management plan using stored materials was thus known. Further, the implementation in the claims of that idea must have been obvious. That is, given the lack of details in the present application regarding how the tool is generated, those details must be part of the common general knowledge.

[82] It would also have been obvious to incorporate some sort of automatic evaluation of the client's professional growth based on user input, as in claims 1 to 11, 16, 17 and 30 to 36 on file. Likewise for the statistical measurement of the client's professional growth as in claims 12 to 15 on file. D2 discloses the automatic computation of both how much progress has been made toward a goal based on user input, and the likelihood of the user reaching the goal (column 5, line 40 to 7, line 47; figure 1A). D2 discloses a system very similar to the one disclosed in D1. The advantages of adapting techniques from D2 to the system of D1 would thus have been readily apparent to the skilled person. Accordingly, the idea of incorporating automatic evaluation or measurement of progress based on user input would have been obvious in this context. The implementation in the independent claims of that idea must also have been obvious. That is, how the automatic evaluation or statistical measurement is carried out in the present invention must be part of the common general knowledge, because the application does not disclose those details. They are left to the skilled person to develop. Therefore, our view is that it would have been obvious for the skilled person to select calculations and operations, and to write the script or software to perform them.

[83] Dependent claims 7 to 9 and 25 to 29 on file recite the provision of “a growth ladder display” to the client. These claims define such a display as the provision of certain types of information related to the levels of professional growth. Our view is that the skilled person would not have required ingenuity to choose the

named types of information to display. For example, the name, summary and result of achieving a given level would be obvious information to communicate about the level to a client. Also, it would have been obvious to include such information as strengths, dangers and opportunities associated with the level. It is unclear whether each level of the “growth ladder display” is intended to show SWOT-like information for a company as a whole or for an individual. Figures 4A to 10 and paragraphs 43, 46 and 51 to 54 show the former. On the other hand, paragraphs 4, 5, 30 and 34, suggest a focus on individual professional development. Either way, the use of SWOT analysis in such a context is part of the common general knowledge. As is the output of SWOT analysis information in the context of computerized strategic planning and goal setting.

- [84] Regarding dependent claims 11, 15, 29, 33 and 35, it would have been obvious to provide the statistical measurement of progress within a given time period. D2 provides examples of computing progress-related metrics for given periods of time (column 5, line 63 to column 6, line 67).
- [85] Regarding claims 18 to 29 and 30 to 36 on file specifically, the cited prior art does not appear to suggest determining scores for the concepts (i.e. the specific “levels of professional growth”) listed in these claims.
- [86] Regarding claims 18 to 29 on file, the common general knowledge includes the performance of analyses involving strengths, weaknesses, dangers and opportunities. It does not appear to include the sort of comparative analysis recited by claim 18, though. The cited prior art does not seem to suggest incorporating such a comparison into the identification of a relevant level of professional growth.
- [87] On the other hand, it would have been obvious to employ some sort of “enforcement mechanism” as in claims 18 to 29 on file. That is, some sort of means, technical or otherwise, requiring users to work with the appropriate tool or plan. First, such means are inherent in the act of generating or providing a specific tool, plan or guidance for a user. This material, over other possible material, is being made accessible. D1 also provides another example: when its

users are given recommendations of learning activities, only those for which prerequisites have been fulfilled may be selected (para 88; figure 7A).

- [88] This reasoning also applies to the use of the “largest check calculator”—some sort of script or code for doing some sort of calculations based on input—in claims 30 to 36.

Conclusion: claims 1 to 17 are obvious

- [89] The subject matter of claims 1 to 17 on file would have been obvious to the skilled person in view of D1, D2 and the common general knowledge. Therefore, claims 1 to 17 do not comply with paragraph 28.3(b) of the *Patent Act*.
- [90] The Applicant made no submissions, beyond the second proposed claims, in response to the above obviousness assessment appearing in our preliminary review letter.

INDEFINITENESS AND DEPENDENT CLAIM WORDING

- [91] Claims 3 to 15 and 17 to 36 on file are indefinite. Also, dependent claims 3, 5, 13, 17, 21, 23, 27, 31 and 34 on file fail to recite additional features.

Principles

- [92] A claim must distinctly and explicitly define its subject matter (*Patent Act*, s 27(4)). Its terms “must be free of avoidable ambiguity or obscurity,” and “be clear and precise” (*Minerals Separation North American Corp v Noranda Mines Ltd*, [1947] Ex CR 306 at 352).
- [93] A specific requirement regarding the scope of dependent claims is that they must state additional features (*Patent Rules*, s 63(1)).

Analysis

- [94] Dependent claims 3 and 21 on file recite a step of assisting the client in obtaining the next level of professional growth using the provided professional growth tool. The claims upon which these claims depend already specify that the client is provided with a professional growth tool that is associated with the current level of professional growth of the client. The independent claims also specify that the tool includes training materials and means for evaluating the professional growth of the client based on input they provide to it. It is thus inherent in the name “professional growth tool,” and in the description of the tool and its context, that the tool is intended to help the client obtain their next level of professional growth. By providing the tool to the client, the client has already been assisted in obtaining the next level by using the tool. The claim upon which claim 21 depends goes even further by identifying itself in its preamble as a “method for assisting a client in reaching a level of professional growth.”
- [95] Thus, dependent claims 3 and 21 lack additional features. Furthermore, since each claim is presumed to have a different scope, the wording of each of these dependent claims renders its own scope unclear.
- [96] Dependent claims 5, 13, 23 and 31 on file say that the relational database is coupled to the processor. Claims 23 and 31 also say that client data regarding professional growth is received from the database, or that the database is configured to provide client information regarding professional growth. The claims upon which these claims depend already make it clear that the database is in communication with (or “coupled to”) the processor, and that it provides such information.
- [97] Thus, dependent claims 5, 13, 23 and 31 lack additional features. Furthermore, since each claim is presumed to have a different scope, the wording of each of these dependent claims renders its own scope unclear.
- [98] Claim 12 on file recites a professional growth tool module for generating professional growth tools and associating them with levels of professional

growth, but it is unclear why. The tools are not provided to the client or referenced again in the claim.

- [99] Dependent claim 17 on file is in a similar situation to dependent claims 3 and 21 on file. It states that the interactive professional growth tool is configured to assist the client in obtaining the next level of professional growth. This would already have been clear to the skilled person from the claim upon which it depends, though.
- [100] Thus, dependent claim 17 lacks additional features. Furthermore, since each claim is presumed to have a different scope, the wording of claim 17 renders its own scope unclear.
- [101] Claim 18 on file recites a step of “receiving client data from the client and a relational database, the client data comprising associations among data entries regarding professional growth of the client.” This characterization of the client data is ambiguous and makes the claim unclear. Although the description (paras 21, 30, 34) shows that the relational database can be used to determine, or keep track of, implicit or explicit associations among its data entries, the application does not suggest how the client would provide such “associations among data entries.” It does not provide any additional information to the skilled person enabling them to construe the expression in the claim. It is unclear within claim 18 what is meant by “data entries,” or who is in possession of them, what is meant by “associations among data entries,” or how either the client or the database provides them.
- [102] Dependent method claim 27 on file says that the professional growth tool is online. Claim 18, upon which this claim depends, already recites a step of “providing to the client online access via the Internet to the identified interactive professional growth tool.”
- [103] Thus, dependent claim 27 lacks additional features. Furthermore, since each claim is presumed to have a different scope, the wording of claim 27 renders its own scope unclear.

- [104] An issue with claims 30 and 36 is that it is unclear whether the recited steps of “developing upcoming strategies for progress” and “deriving one or more strategies from associations” are intended to be read as referring to the same thing.
- [105] Further, claim 30 on file refers to “the received data” and “the received client data” without having introduced these expressions, or having indicated from where they were received. This further reduces the clarity of this claim.
- [106] Dependent method claim 34 on file says the system further comprises a strategy module to provide strategies to the client on how to measurably progress from the current level to the next. Claim 30, upon which this claim depends, already recites such a strategy module.
- [107] Thus, dependent claim 34 lacks additional features. Furthermore, since each claim is presumed to have a different scope, the wording of claim 34 renders its own scope unclear.
- [108] Dependent claim 35 on file says the system further comprises “a statistics module” for providing a statistical measurement of the professional growth of the client within a given time period. It is unclear whether this is intended to be the same statistical module introduced in claim 30 (upon which this claim depends) or a different one. If a different one, it is not disclosed in the description and drawings. If the same one, claim 35 would be redundant in view of dependent claim 33. The scope of claim 35 is thus unclear.
- [109] The lack of clarity in the above claims is inherited by the claims that depend upon them. Therefore, claims 3 to 15 and 17 to 36 on file are indefinite and contravene subsection 27(4) of the *Patent Act*. In addition, claims 3, 5, 13, 17, 21, 23, 27, 31 and 34 on file fail to recite additional features and contravene subsection 63(1) of the *Patent Rules*.
- [110] We identified these clarity and wording defects during our preliminary review and notified the Applicant in the preliminary review letter (according to subsection

86(9) of the *Patent Rules*). In response, the Applicant submitted the second proposed claims.

NEW MATTER

[111] Paragraphs 9a to 9f of the description on file, and claims 1 to 36 on file, contain impermissibly added new matter.

Principles

[112] New matter to an application is prohibited; any amended content must be reasonably inferable from the application as filed (*Patent Act*, s 38.2(2)).

Analysis

[113] Paragraphs 9a to 9f reproduce the text of the independent claims on file. This text recites details not found elsewhere in the application, and which contradict other parts of the description and drawings. These details were not in the application when it was filed.

[114] Paragraphs 9a to 9f and the independent claims recite or refer to steps of associating each level of professional growth with at least one of the generated professional growth tools. They say that the current and next level of professional growth are determined for the client, that a plurality of tools are generated, and that “each level of professional growth” is associated with at least one of the generated tools. This wording suggests that each **possible** level of professional growth is associated with one of the generated tools. This, in turn, suggests that all possible tools are generated each time the invention operates, even those not associated with the current and next levels identified. The wording of claim 1 on file even more strongly suggests this interpretation by saying:

- “a current level of a plurality of levels of professional growth” is determined for the client;

- a plurality of tools are generated; and then
- “each of the plurality of levels of professional growth” is associated with at least one of the tools.

[115] Although the text of the independent claims is reproduced in paragraphs 9a to 9f of the description, the remainder of the description and drawings do not suggest such behaviour. There is no suggestion of why the claimed invention would generate unneeded tools each time it operated. When the remainder of the application refers to these parts of the operation, it indicates that first, a current and next level of professional growth are determined for the client (paras 20, 22, 25–29, 33–38; figure 3). Then, the module 220 recommends or generates a tool for the client accordingly.

[116] Paragraph 9d and claim 18 say that the professional growth tool includes an enforcement mechanism. The only reference to an enforcement mechanism in the remainder of the application (para 29) indicates it to be part of module 220, not a professional growth tool.

[117] Paragraphs 9e and 9f, and claims 30 and 36, suggest that once client data is received, strategies are generated for all levels of professional growth. The remainder of the application’s references to the topic (paras 5, 17, 30, 38, 49 and 51) suggest that once client data is received, only the appropriate strategy is generated or customized, then provided.

[118] Paragraphs 9e and 9f, and claims 30 and 36, also say that the software for developing strategies generates each recommendation “using a largest check calculator, the recommendation indicating a range of tasks upon which to focus.” The remainder of the application does not refer to the strategy module software using a largest check calculator, generating any recommendation in addition to the strategy, or indicating a range of tasks upon which to focus.

[119] Paragraphs 9a to 9f of the description on file and the claims on file were added by amendment on October 27, 2017, with the Applicant’s response to a requisition. The identified details were not in the application when it was filed.

Our view is that they also would not have been reasonably inferable from the specification and drawings as filed. Therefore, the addition to the application of paragraphs 9a to 9f, and claims 1 to 36, is not permitted by subsection 38.2(2) of the *Patent Act*.

- [120] We identified this defect during our preliminary review and notified the Applicant in the preliminary review letter. In response, the Applicant submitted the second proposed description and claims.

THE SECOND PROPOSED SPECIFICATION

- [121] The second proposed description and claims cannot be accepted because they would not make the application allowable.
- [122] When a rejection is not withdrawn, the application can only be amended if the Commissioner notifies the Applicant that that amendment is needed to make it allowable (or if the amendment is ordered by the appropriate federal court) (*Patent Rules*, ss 86(11), 199(3), 200).
- [123] In our view, the second proposed specification does not remedy the patentability defect, or all the indefiniteness and new-matter defects.
- [124] The second proposed description differs from the one on file by the excision of paragraphs 9a to 9f. The second proposed claims appear to be based on claims 18 to 20, 22, 24 to 26, 28 to 30, 32, 33 and 36 on file. Second proposed claims 1, 10 and 13 are, respectively, independent method, system and stored-software claims. The chief difference between the second proposed claims and the identified ones on file is that the proposed independent claims include more descriptive text. They also include wording modifications, at least some of which seem directed to addressing the clarity and claim wording defects.
- [125] Regarding patentability, the actual inventions in the second proposed claims appear to remain abstract sets of rules for providing professional growth information. The computers involved still appear to be conventional. Merely

processing such sets of rules on such computers in the claimed manner does not help them fulfil the physicality requirement of section 2. Nor does it avoid the prohibition of subsection 27(8).

- [126] Regarding obviousness, the second proposed claims include at least the features of claims on file already determined not to be obvious in view of the cited prior art.
- [127] Regarding indefiniteness and dependent claim wording, the second proposed claims avoid many, but not all, of the defects identified in the claims on file. Second proposed claim 1, unlike claim 18 on file (the claim upon which it appears to be based), does not include the wording “receiving client data ... comprising associations among data entries regarding professional growth of the client.” Second proposed claims 10 and 13, unlike claims 30 and 36 on file (the claims upon which they appear to be based), do not refer to a step of “developing upcoming strategies for progress.” The wording of second proposed claim 10 regarding received data differs from that of claim 30 on file, but still refers to a step of determining a score “based on the client data received from the relational database.” There is no preceding reference to receiving any client data from the database. The remaining previously identified defects do not appear in the claims on file upon which the second proposed claims are based.
- [128] In addition, as discussed at the hearing, second proposed claim 2 introduces two clarity defects. It says “wherein providing the client with information regarding each of the plurality of levels of professional growth further comprises providing the client with strategies on how to measurably progress from the current level to the next level.” First, it is unclear that second proposed claim 1 (upon which claim 2 depends) has a step of providing such information to the client. So, this clause in claim 2 appears to lack an antecedent. Secondly, claim 1 does include a step of generating custom-tailored strategies; it is unclear whether the strategies of claim 2 are intended to be the same strategies.

[129] Regarding new matter, the second proposed specification avoids some of the previously identified defects. Paragraphs 9a to 9f of the description have been excised. Also, the second proposed claims do not suggest that:

- the professional growth tool itself includes an enforcement mechanism;
- strategies are generated for every level of professional growth;
- the strategy module has a “large check calculator”; or
- the strategy module recommends a range of tasks upon which to focus.

[130] On the other hand, the second proposed independent claims still have wording suggesting that all possible tools are generated each time the invention operates, even those not associated with the current and next levels identified.

[131] As remarked, the second proposed specification does not remedy all the patentability, indefiniteness and new-matter defects in the specification on file. Therefore, it does not make the application allowable. It follows that the second proposed specification cannot be a necessary amendment under subsection 86(11) of the *Patent Rules*.

THE BOARD RECOMMENDS REFUSAL OF THE APPLICATION

[132] In view of the above, we recommend the application be refused on the basis that:

- claims 1 to 36 on file define subject matter outside the definition of invention in section 2 of the *Patent Act* and prohibited by subsection 27(8) of the *Patent Act*;
- claims 1 to 17 on file define obvious subject matter, contravening paragraph 28.3(b) of the *Patent Act*;
- claims 3 to 15 and 17 to 36 on file are indefinite, contravening subsection 27(4) of the *Patent Act*;

- claims 3, 5, 13, 17, 21, 23, 27, 31 and 34 on file are improperly worded dependent claims, contravening subsection 63(1) of the *Patent Rules*; and
- paragraphs 9a to 9f of the description on file, and claims 1 to 36 on file, contain impermissibly added new matter, contravening subsection 38.2(2) of the *Patent Act*.

Leigh Matheson

Stephen MacNeil

Andrew O'Malley

Member

Member

Member

THE COMMISSIONER REFUSES THE APPLICATION

[133] I agree with the Board's findings and its recommendation to refuse the application on the basis that:

- claims 1 to 36 on file define subject matter outside the definition of invention in section 2 of the *Patent Act* and prohibited by subsection 27(8) of the *Patent Act*;
- claims 1 to 17 on file define obvious subject matter, contravening paragraph 28.3(b) of the *Patent Act*;
- claims 3 to 15 and 17 to 36 on file are indefinite, contravening subsection 27(4) of the *Patent Act*;
- claims 3, 5, 13, 17, 21, 23, 27, 31 and 34 on file are improperly worded dependent claims, contravening subsection 63(1) of the *Patent Rules*; and
- paragraphs 9a to 9f of the description on file, and claims 1 to 36 on file, contain impermissibly added new matter, contravening subsection 38.2(2) of the *Patent Act*.

[134] I therefore refuse, under section 40 of the *Patent Act*, to grant a patent for this application. The Applicant has six months from the mailing of my decision to appeal it to the Federal Court of Canada under section 41 of the *Patent Act*.

Konstantinos Georgaras

Commissioner of Patents
Dated at Gatineau, Quebec
this 14th day of October, 2025.

APPENDIX

Relevant provisions of the *Patent Act*, RSC 1985, c P-4

Definitions

2 ...

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.

...

Claims

27(4) 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.

What may not be patented

27(8) No patent shall be granted for any mere scientific principle or abstract theorem.

Invention must not be obvious

- 28.3 The subject-matter defined by a claim in an application for a patent in Canada must be subject-matter that would not have been obvious on the claim date to a person skilled in the art or science to which it pertains, having regard to
- (a) information disclosed 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.

Restriction

- 38.2(2) The specification and drawings contained in an application, other than a divisional application, may not be amended to add matter that cannot reasonably be inferred from the specification or drawings contained in the application on its filing date.

Refusal by Commissioner

- 40 Whenever the Commissioner is satisfied that an applicant is not by law entitled to be granted a patent, he shall refuse the application and, by registered letter addressed to the applicant or his registered agent, notify the applicant of the refusal and of the ground or reason therefor.

Appeal to Federal Court

- 41 Every person who has failed to obtain a patent by reason of a refusal of the Commissioner to grant it may, at any time within six months after notice as provided for in section 40 has been mailed, appeal from the decision of the Commissioner to the Federal Court and that Court has exclusive jurisdiction to hear and determine the appeal.

Relevant provisions of the *Patent Rules*, SOR/2019-251

Dependent claim

- 63(1) Subject to subsection (2), a claim that includes all the features of one or more other claims (referred to in this section as a “dependent claim”) must refer by number to the other claim or claims and must state the additional features claimed.

Additional defects

- 86(9) If, during the review of a rejected application for a patent, the Commissioner has reasonable grounds to believe that the application does not comply with the Act or these Rules in respect of defects other than those indicated in the final action notice, the Commissioner must by notice inform the applicant of those defects and invite the applicant to submit arguments, not later than one month after the date of the notice, as to why the application does comply.

Notice requiring certain amendments

86(11) If, after review of a rejected application for a patent, the Commissioner has reasonable grounds to believe that the application does not comply with the Act or these Rules and certain amendments are necessary in order to make the application allowable, the Commissioner must by notice inform the applicant that those amendments must be made not later than three months after the date of the notice.

Rejection not withdrawn after final action

199(3) If an applicant of a category 3 application replies in good faith to a requisition made under subsection 30(4) of the former Rules on or before the date set out in subsection (4) of this section but the examiner, after that date, still has reasonable grounds to believe that the application does not comply with the Act or these Rules,

- (a) if a notice was not sent under paragraph 30(6)(a) of the former Rules, the Commissioner must by notice inform the applicant that the rejection has not been withdrawn;
- (b) any amendments made to that application during the period beginning on the date of the final action notice and ending on the date set out in subsection (4) of this section are considered never to have been made; and
- (c) the application must be reviewed by the Commissioner.

No amendment after rejection

- 200 If a category 3 application is rejected by an examiner under subsection 199(1) of these Rules or subsection 30(3) of the former Rules, the specification and the drawings contained in the application must not be amended after the date prescribed by subsection 199(4) of these Rules, unless
- (a) a notice is sent to the applicant informing them that the rejection is withdrawn;
 - (b) the amendments are those required in a notice sent under subsection 86(11) of these Rules or subsection 30(6.3) of the former Rules; or
 - (c) the Supreme Court of Canada, the Federal Court of Appeal or the Federal Court orders the amendments to be made.

Relevant provision of the former *Patent Rules*: s 30(3)

This refers to the *Patent Rules* as they read immediately before October 30, 2019 (SOR/96-423).

- 30(3) Where an applicant has replied in good faith to a requisition referred to in subsection (2) within the time provided but the examiner has reasonable grounds to believe that the application still does not comply with the Act or these Rules in respect of one or more of the defects referred to in the requisition and that the applicant will not amend the application to comply with the Act and these Rules, the examiner may reject the application.