Use Common sense in patents

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We all remember the Reasonable Man on the Clapham Omnibus. But did you ever wonder where he was actually going? Being reasonable, he was surely not on the omnibus just to ride aimlessly around Clapham.

After years of study, I believe I now have the answer: he was going to his job as a "skilled but uninventive technician". This is the hypothetical being who appears in patent cases on obviousness: if the skilled but uninventive technician can figure out how to do something, then it must be obvious, and therefore not patentable.

The "skilled but inventive technician", of whom I will have more to say shortly, was referred to recently by the Federal Court of Appeal in *CFM Inc. et al. v. Wolf Steel*. In another patent case, *Mobil Oil Corporation v. Hercules Canada*, the Court of Appeal put stress on the usefulness of that somewhat related concept "common sense" in patent cases. Both cases remind us that, even in patent law, the man on the Clapham omnibus lives on. (It is my personal belief that he has, however, now moved to Toronto, had a sex change, and become the Reasonable Woman on the Queen Street Streetcar.)

In *CFM*, the appeal court dismissed an appeal of the trial court decision of Mr. Justice Rouleau that a patent for a "Direct Top Venting High Efficiency Fireplace" was invalid as obvious.

The concept of "obviousness" is not found in the *Patent Act*, but arises out of the jurisprudence. In a nutshell, the idea is that if the "invention" disclosed in the patent is so straightforward that even the "skilled but uninventive technician" would have been able to come to it without difficulty, then the patentee should not be entitled to exclusive use of the "invention", and the patent is invalid.

As a practical matter, it is difficult to convince a court that a patent is obvious. Cases where obviousness is established are fairly rare. Courts are anxious to protect useful inventions, particularly if the invention has been a "commercial success", as most inventions worth litigating are. If people buy it, the courts reason, the patented

improvement, however small, must be inventive. Courts are also conscious of the dangers of using hindsight to assess inventions: the wheel seems a straightforward idea now, but was still a big step back when someone came up with it for the first time.

The "skilled but uninventive technician" is such a familar figure in the caselaw that one of the grounds of the appeal in *CFM* seems to have been that there was no reference to him in the trial judge's decision. But Mr. Justice Strayer rejected this argument, after reviewing the authorities: "Those authorities posit the perceptive ability of a skilled but uninventive technician as the standard for obviousness ... The appellants complain, however, that the trial judge did not articulate his conclusions of fact by reference to this mythical creature. I am satisfied that he had the necessary legal criteria in mind ..."

Strayer concluded that the obviousness of the patent was a finding of fact by the trial judge, based primarily on the evidence of the defendants' expert at trial, and that there was no reason to disturb this result.

In *Mobil Oil* the issue was not whether the patent was obvious, but whether it was ambiguous i.e. too badly written to be enforceable. In finding that it was not, the Federal Court of Appeal stressed the importance of common sense in reading patent claims, in effect telling trial judges: don't be bamboozled by experts.

The patent was for a way of making metallized film, that stuff potato chips come in. The defendant Hercules disputed both validity and infringement. Mr. Justice Wetstone of the Federal Court Trial Division found at trial that the patent was infringed, a finding the appeal court called "unassailable". But Wetstone also held that Mobile Oil should lose its case because the patent was invalid for ambiguity and insufficiency of disclosure i.e. no one could possibly understand it.

The Federal Court of Appeal disagreed that the wording of the claim in question was ambiguous: "The learned trial judge permitted the conflict among the experts to outweigh his own interpretation and, moreover a common sense interpretation... [I]t is a well settled principle that, while a judge may seek the assistance of experts in construing a patent, he should never forget that he is the final interpreter of the language," wrote Mr. Justice Marceau of the appeal court.

Patents are generally not models of English prose. Ernest Hemingway would probably not have got far as a patent agent. In another recent patent case, incidently, *Risi Stone v. Groupe Permacon*, Mr. Justice Dube commented dryly on the wordiness of the patent claim he was called on to interpret, "Claim 1 [containing 281 words separated by two commas] does not appear to be a model of concision and limpidity. It is not a literary masterpiece." The claim before the court in *Mobile Oil* was no literary masterpiece either; it was a long and complex sentence, containing at one point in the flow of verbiage the words "said layer".

At trial numerous experts testified as to their different interpretations as to what the patent claim meant. The defendant argued that it was unclear what layer was "said layer", and that therefore the patent claim was ambiguous.

Mr. Justice Wetstone read the claim carefully and concluded that, in fact, "the only reasonable interpretation possible" was that "said layer" had a particular reading, based on the structure of the sentence. The appeal judges agreed with his interpretation. But they parted company with Wetstone when he went on to conclude that, nevertheless, the claim must be ambiguous because the experts disagreed as to what it said.

The appeal court found that the claim was clear, and noted that although the trial judge seemed to have reached the same conclusion, he had unfortunately allowed himself to be convinced that the claim must be ambiguous just because some of the experts had different interpretations. "With respect I think that was an error. The expertise of the witnesses had nothing to do with grammatical and linguistic difficulties and no doubt common sense was not their exclusive perogative," wrote Mr. Justice Marceau.

The appeal court also disagreed with the trial judge with respect to the question of the sufficiency of the disclosure. Patents are a bargain between the state and the inventor, meant to encourage progress. The inventor discloses his invention to the public in the patent document, and in return gets exclusive use of the invention for the term of the patent. The law requires that the disclosure state clearly what the invention is so that anyone skilled in the art can use it. The issue before Wetstone and later the appeal court in *Mobile Oil* was whether the patent disclosure explained how to use the invention adequately.

At trial, Mr. Justice Wetstone had concluded that somewhat skilled in the art would not be able to reproduce the invention from reading the patent disclosure because that that person would have to do experimentation as to how much "slip agent" (or lubricant) to use in order to get the invention to work. Marceau, however, after setting out the relevant passage of the trial judgment, commented somewhat acidly, "I must say with respect I fail to understand". He concluded that effective use of the invention could easily be determined through proper experimentation and testing by a skilled workman, and that the disclosure was not therefore insufficient.

In the result, therefore, *Mobile Oil* won its case, establishing both validity of the patent and infringement.

What conclusions can be drawn from these cases? Patents can be as long winded, verbose, and the subject of much disagreement as to what they mean, but nevertheless not invalid for ambiguity, as long as they convey a meaning to someone using "common sense". However, they must describe an inventive step that that competent but uninspired plodder, that reasonable, mythical user of the Clapham public transit system, the "skilled but uninventive technician" would not be able to come up with on his own.