

## Federal Court Admits Foreign File Wrapper in Canadian Claim Construction

Amrita V. Singh, Associate, Bereskin & Parr LLP

To get a Canadian patent for an invention, a patentee must “prosecute” a patent application before the Canadian Patent Office. In so doing, a prosecution file – also known as a file wrapper – is generated, which comprises communications between the patentee’s patent agent representative and the Office.

In the United States, prosecution history estoppel is intended “to hold the inventor to the representations made during the application process... by amending [the patent claims during prosecution], the inventor is deemed to concede the patent does not extend as far as the original claim”.<sup>1</sup> In contrast in Canada, file wrappers have been irrelevant and inadmissible in Canadian patent construction, which allowed Courts to focus on the actual language of the claims in the issued patent when construing a patent, while avoiding “opening the Pandora’s box of file wrapper estoppel”.<sup>2</sup>

### Opening Pandora’s Box: The introduction of file wrapper estoppel in Canada

In late 2018, the Canadian *Patent Act* was amended to add that a file wrapper may be admitted into evidence in Canadian patent litigation for claim construction. On September 25, 2019, in *Canmar Foods Ltd v. TA Foods Ltd.*,<sup>3</sup> the Federal Court of Canada admitted such evidence for the first time since its introduction into the Canadian patent litigation regime.

### Federal Court applies file wrapper estoppel in claim construction

In *Canmar*, the patentee Canmar Foods brought a patent infringement action against TA Foods for alleged infringement of Canmar Foods’ patent, which claimed a method for roasting oil seed. In construing the patent claims and identifying the essential elements, TA Foods claimed that the American file wrapper of a related patent application was relevant and incorporated into the Canadian file wrapper by reference because the patentee had acknowledged in correspondence with the Canadian Patent Office that the claim amendments in the U.S. had been to overcome novelty and obviousness objections.

In the Canadian patent prosecution, Canmar Foods had acknowledged before the Canadian Patent Office that the amended claims “correspond substantially to those submitted during prosecution of a related United States application”,<sup>4</sup> and explained the newly submitted claims were “much narrower in scope than the previously examined claims in view of the introduction

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<sup>1</sup> *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 535 US 722 (2002) at 737-738.

<sup>2</sup> *Free World Trust v. Électro-Santé Inc.*, [2000] 2 S.C.R. 1024 at para. 66.

<sup>3</sup> 2019 FC 1233

<sup>4</sup> Office Action Response to CIPO dated August 24, 2012 at page 2, for Canmar Foods’ Canadian Patent Application No. 2,582,376.

of significant limitations derived from the description and previous dependent claims” and “encompass[ed] both novel and non-obvious subject matter”.<sup>5</sup>

### **Canadian file wrapper estoppel includes foreign file wrapper in “extraordinary circumstances”**

The Court held that with the addition of file wrapper estoppel to the Canadian *Patent Act*, claim construction in Canada now requires an assessment of (i) the claims; (ii) the disclosure; and (iii) the [Canadian] prosecution history. Justice Manson noted that while ordinarily only Canadian prosecution history is admissible for claim construction (the *Patent Act* language allowing file wrapper estoppel makes no reference to foreign prosecution histories), in extraordinary circumstances, foreign prosecution histories may also be admissible. He held that the intended effect of the new provision is to allow the Court to consider “the substance behind intentional amendments to the claims”.

### **Define “extraordinary”**

Justice Manson observed of the extraordinary circumstances that justify considering foreign file wrappers, the Court should be able to consider foreign file wrappers only to purposively construe the Canadian patent claims where “the patentee acknowledges that the claims have been amended to be substantially the same as claims submitted in another jurisdiction, *and* the patentee admits that the amendments have limited the scope of the claims in order to make the claims novel and non-obvious” (emphasis in the original).<sup>6</sup>

This exception, he noted, is necessary because if foreign file wrappers could not be considered even where limitations are made to overcome novelty and obviousness objections, Canadian patentees would be incentivised to refrain from explaining those amendments to the Canadian Patent Office, relying instead on corresponding co-pending foreign applications. Because Canmar Foods had specifically referenced its corresponding U.S. patent application in the Canadian file wrapper, he found the U.S. prosecution history admissible for claim construction.

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<sup>5</sup> *Canmar* at para. 86.

<sup>6</sup> *Canmar* at para. 74