Canadian Federal Court Applies File Wrapper Estoppel in Claim Construction

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A patent file wrapper (also known as prosecution history) generally refers to the correspondence between the patent office and an applicant regarding why a patent should be granted and any amendments to the patent application. In December 2018, Canada introduced file wrapper estoppel to the *Patent Act* via a new section 53.1. This section provides a limited exception to the general rule that the file wrapper of a patent is not admissible evidence in a legal action or proceeding in respect of that patent:

53.1 (1) In any action or proceeding respecting a patent, a written communication, or any part of such a communication, may be admitted into evidence to rebut any representation made by the patentee in the action or proceeding as to the construction of a claim in the patent if

(a) it is prepared in respect of
    (i) the prosecution of the application for the patent,
    (ii) a disclaimer made in respect of the patent, or
    (iii) a request for re-examination, or a re-examination proceeding, in respect of the patent; and
(b) it is between
    (i) the applicant for the patent or the patentee; and
    (ii) the Commissioner, an officer or employee of the Patent Office or a member of a re-examination board.

On September 25 2019, the Federal Court of Canada (FC) interpreted section 53.1 for the first time in *Canmar Foods Ltd v TA Foods Ltd*, 2019 FC 1233. Particularly, Manson J considered the scope of admissibility of file wrapper, including the foreign file wrapper, for claim construction.

Background

Canmar Foods (Canmar) sued TA Foods for infringement of its Canadian Patent No. 2,582,376 (376 Patent) concerning a method for roasting oil seed. Claim 1, the only independent claim, recites the steps of "heating the oil seed in a stream of air" and transferring and maintaining the heated oil seed into an insulated or partially insulated roasting chamber or tower" to complete the roasting process.

TA Foods roasted its oil seed by heating oil seed under infrared radiation in a micronizer followed by transferring the heated oil seed into an uninsulated steel hopper and then to an uninsulated steel cooling tower. TA Foods pleaded non-infringement on the basis that it did not heat oil seed "in a stream of air", nor did it maintain the seed in "an insulated or partially roasting chamber or tower". It brought a summary judgment motion.

FC's Decision

Manson J considered the scope of admissibility of file estoppel, particularly foreign file wrapper, for claim construction under section 53.1.

TA Foods relied on both the Canadian file wrapper and the file wrapper in the corresponding US Application No. 11/576,405 for a purposive construction of the 376 Patent claims. During prosecution, Canmar amended the Canadian claims to correspond substantially to the US claims. Elements of "stream of air" and "insulated roasting chamber or tower" were added to the US claims to overcome novelty and obviousness objections. TA Foods therefore argued that because the Canadian prosecution history adopted these limitations by incorporating by reference the US prosecution history, these limitations should apply to limit claim construction. Manson J. agreed.

Manson J held that section 53.1 is specific to using Canadian prosecution histories to rebut any position taken on claim construction (para. 62, emphasis added). He cautioned that foreign prosecution histories should remain inadmissible "absent extraordinary circumstances" (para. 62). However, in this case, he found that extraordinary circumstances arose: the patentee specifically referred to the corresponding US application prosecution history and admitted that the amendments to the Canadian claims were made to make the claims novel and non-obvious. He held that ignoring the reference to the US prosecution history and the claims restrictions made thereto that were then incorporated into the Canadian claims during prosecution "would emasculate the intent and effect of section 53.1" (paras. 70, 71, 74 and 77).

Manson J summarily dismissed the action, concluding that the two essential elements of claim 1, namely heating oil seed "in a stream of air" and an "insulated or partially insulated roasting chamber or tower," are not included in TA Foods' roasting process, and therefore, there could be no infringement.

Canmar can appeal the FC decision as of right.

Final Thoughts

Due to the adoption of file wrapper estoppel in Canada, careful consideration must be heeded when responding to Examiner's objections during prosecution.

An applicant for a patent should think twice when deciding to speed up the prosecution of the Canadian application by relying on the results of corresponding prosecution in foreign jurisdictions (for example, by utilizing patent prosecution highway (PPH)). This is particularly important when restrictions have been made to the foreign claims to overcome novelty and obviousness objections.

Lastly, file wrappers can be a fertile ground when challenging patents and therefore should be carefully reviewed.