

Pharma in brief - Canada

FCA confirms that inventor should not be held to elevated standard of utility absent a clear and unambiguous promise

Case: *Nova Chemicals Corporation v The Dow Chemical Company*, 2016 FCA 216 (Court File No. A-379-14), aff'g 2014 FC 844
Nature of case: Appeal from infringement action of Canadian Patent 2,160,705 (**705 Patent**)
Successful party: The Dow Company
Date of decision: September 6, 2016

Summary

Justice O'Keefe of the Federal Court (**Trial Judge**) found that Dow's 705 Patent pertaining to fabricated articles made from ethylene polymer blends was valid and infringed by Nova Chemicals Corporation. Nova appealed his construction and validity findings.

The Federal Court of Appeal (**FCA**) dismissed the appeal, holding that Nova failed to show any error in law or misapprehension of the factual and expert evidence adduced at trial. In particular, the FCA dismissed Nova's attack on the Trial Judge's findings that the inventor did not make a promise of a specific result and confirmed several important principles regarding the promise of the patent.

Background

The 705 Patent is directed primarily to polyethylene used to make film products. The patent identifies the need to develop polymers that can form thinner films with improved strength and describes that prior efforts to improve polymer material strength often resulted in a reduction in toughness. The claimed invention allows for source reduction to make thinner film without any strength reduction.

Dow successfully brought an infringement action against Nova. The 705 Patent was also upheld as valid.

On appeal, Nova challenged the construction and validity findings of the Trial Judge. Concerning utility, Nova argued the Trial Judge erred in finding that the patent did not promise compositions having "synergistically enhanced properties." On September 6, 2016, the FCA dismissed Nova's appeal.

Inventor should not be held to higher standard absent clear and unambiguous promise

The FCA confirmed the well-established principle that a "mere scintilla" of utility is sufficient, unless the patent contains an explicit promise of a specific result. The FCA also held that the Trial Judge's approach of looking to the claims first, followed by considering the disclosure (where any statement should be taken as a "mere statement of advantage" unless "clearly and unequivocally" part of the promised utility) in determining the promise, is broadly consistent with recent jurisprudence.

The FCA noted that the claims of the 705 Patent did not contain a statement of utility and that there was only one reference elsewhere in the patent to support enhanced utility. The court was wary of using such a “stray phrase” to define the promise, and confirmed that when validity is challenged on the basis of an alleged unfulfilled promise, the patent will be construed in favour of the patentee where it can reasonably be read to exclude this promise.

The Trial Judge preferred the views of Dow’s expert regarding the interpretation of the patent. In particular, the Trial Judge found that Dow’s expert interpreted the patent as a whole rather than focussing on the isolated passage of the specification mentioning synergistic enhancements. The Trial Judge also noted Dow’s expert concluded that the passages of the patent discussing improved properties should not be read as explicitly promising a specific result, but rather as statements indicating that the 705 Patent improved on the prior art. Given the deference owed to a trial judge’s assessment of the evidence, the FCA held that the Trial Judge did not err in preferring the views of Dow’s expert.

The FCA also rejected Nova’s assertion that the 705 Patent is a selection patent, as there was no evidence a skilled person would have construed it as a selection and the 705 Patent was neither taught nor anticipated by the prior art.

The FCA dismissed Nova’s other grounds of appeal, holding that they failed to establish any palpable and overriding error and amounted to “mere disagreements” with the Trial Judge’s factual findings and assessment of expert evidence.

Links:

[*Nova Chemicals Corporation v The Dow Chemical Company, 2016 FCA 216*](#)

[*The Dow Chemical Company v Nova Chemicals Corporation, 2014 FC 844*](#)

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