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IP monitor

The flax and the foreign: US prosecution history in file wrapper estoppel

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Patents

In *Canmar Foods Ltd v TA Foods Ltd*, the Federal Court interpreted the new file wrapper estoppel provision, s 53.1 of the *Patent Act*, for the first time (see IP monitor of November 2018). The court held that foreign prosecution history is admissible in extraordinary circumstances under this provision.

Background

The plaintiff, CanMar Foods Ltd., brought a patent infringement action against the defendant, TA Foods Ltd., regarding Canadian Patent No. 2,582,376 (the 376 Patent). Both parties are competitors in the flax seed product industry. The plaintiff's 376 Patent claims a particular method of roasting flax seeds, and the plaintiff alleged the defendant was producing its roasted flax seeds in a manner that infringed the 376 Patent.

The defendant brought a motion for summary judgment on the basis of non-infringement, arguing that, when properly construed, the only independent claim in the 376 Patent contains two essential elements that the defendant's flax seed roasting process lacks: (1) heating the oil seed in a stream of air and (2) maintaining the heated oil seed in an insulated roasting chamber or tower. The plaintiff argued that (1) the language of the claim is not limited to a particular type or source of heating and (2) further investigation is required to determine whether the defendant's method includes an insulated of partially insulated roasting chamber or tower.

Foreign file wrapper estoppel in "extraordinary circumstances"

Relying on the new file wrapper estoppel provision of s 53.1 of the *Patent Act*, the defendant submitted that these two missing elements were essential in light of the 376 Patent's Canadian prosecution history and the US prosecution history for the corresponding US application 11/576,405 (US 405 application) filed before the United States Patent and Trademark Office.

Justice Manson held that "[t]he language of section 53.1 is limited to communications between the patentee and the Canadian Patent Office, and generally should be applied in that context," but ultimately held that prosecution history in foreign jurisdictions may be considered in "extraordinary circumstances." These extraordinary circumstances arise where, during patent prosecution, (1) the patentee acknowledges it has amended its claims in a substantially similar manner as its claims submitted in another jurisdiction, and (2) the patentee admits the amendments have limited the

scope of the claims to make them novel and non-obvious. In these extraordinary circumstances, the prosecution history "of a foreign application *is made part of the prosecution history of the Canadian patent* [emphasis original]."

The court found that this case is one of extraordinary circumstances, and it therefore admitted the US 405 application's prosecution history into evidence. During the prosecution of the 376 Patent, the plaintiff wrote to the Canadian Patent Office and admitted that the 376 Patent's claims were amended to limit the scope of the previously examined claims so as to encompass novel and non-obvious subject matter.

Claims construction without expert evidence

Justice Manson construed Claim 1 of the 376 Patent without the assistance of expert evidence. In considering the prosecution history, in addition to the claims themselves and the disclosure, the court found that both the elements in question were essential to Claim 1, as argued by the defendant. The court rejected the plaintiff's argument that Claim 1 imposed no limitations on type and source of heating.

Acceptance of affidavit evidence of non-infringement pre-discovery

The defendant filed its motion for summary judgment eight days after filing a defence. The motion was heard before pre-trial discovery had been conducted. The court concluded that the defendant's flax seed roasting method lacked the two essential elements by relying on an affidavit sworn by a co-owner of the defendant. From this affidavit, the court found that the defendant's method did not heat oil seeds in a stream of air nor did this method maintain heated oil seeds in an insulated roasting chamber or tower. Since both elements were missing from the defendant's flax seed roasting method, the court concluded that the defendant had not infringed the 376 Patent.

Alternate non-infringement holding

Regardless of whether the US prosecution history was admissible into evidence under s 53.1, the court concluded that it would have been able to construe Claim 1 such that the elements in question were essential on the basis of the claims themselves and the disclosure. The court also concluded that the affidavit evidence on the motion was sufficient to demonstrate that the defendant's flax seed roasting method was non-infringing.

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