PATENTS

Appeal from Federal Court (F.C.) decision (2015 FC 997) finding that appellant's Canadian Patent No. 2515581 ('581 patent) invalid due to obviousness — '581 patent addressing waste created by mining industry's operations, in particular water-borne stream of dispersed particulate matter — Particulate matter settling out through use of paste thickener, leaving liquid at surface which can be removed, reused — Remaining water (underflow) pumped out to deposition area — '581 patent dealing with treatment of underflow during transfer from its initial treatment to deposition area — Patent no. WO-A-0192167 (Gallagher patent) teaching introduction of particles of water-soluble polymer into tailings feed allowing treated slurry to retain fluidity while being pumped to deposition area but to "rigidify", i.e. solidify upon standing — '581 patent stating that Gallagher patent emphasizing use of water-soluble polymer particles, alleging that use of aqueous solutions of dissolved polymer ineffective — This latter statement basis of claim that '581 patent void because of false, misleading statements in application for patent — '581 patent describing process improving on prior art — Finding, *inter alia*, that addition of aqueous solution of polymer to slurry mixture during transfer not causing instant rigidification (Claim 1) — F.C. concluding, *inter alia*, that skilled person would go directly, without difficulty to solution of adding a minimum dose of polymer to tailings feed, then increasing dosage to achieve desired outcome — Saying that applying effective amount of polymer obvious — Concluding four-step obviousness analysis of *Windsurfing/Pozzoli* framework (framework) established in *Windsurfing International Inc. v. Tabur Marine (Great Britain) Ltd.*, [1985] R.P.C. 59 (C.A.), *Pozzoli SPA v. BDMO SA*, [2007] EWCA Civ. 588, adopted by Supreme Court in *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61, [2008] 3 S.C.R. 265 met — Main issues whether F.C. erring in its determination of inventive concept, in concluding '581 patent invalid for obviousness — F.C. erring in applying wrong legal test to facts of case herein — Misstating, misapplying framework — Not properly identifying proper roles of prior art, common general knowledge — Relying on summary of framework in *Eli Lilly Canada Inc. v. Mylan Pharmaceuticals ULC*, 2015 FC 125 — Formulation therein introducing error in framework when substituting "common general knowledge" for "matter cited as forming part of the 'state of the art'" — Inventive concept not to be compared to common general knowledge but to prior art — Framework bringing forward distinct conceptual steps in assessing obviousness — Obviousness not concerned with novelty as stand-alone ground of invalidity; on other hand, if patent not containing something new, there can be no invention — Step 3 assessing whether patent having novel elements but not answering question of novel relative to what: common general knowledge or prior art? — Novelty should be determined relative to prior art — Common general knowledge merely subset of prior art — Words "state of the art" in step 3 referring to prior art — Given provisions in *Patent Act*, R.S.C., 1985, c. P-4, s. 28.3, Supreme Court taking same view of role of prior art in obviousness analysis as English Courts — S. 28.3 to same effect as legislation in effect in United Kingdom except that it excludes certain elements of prior art, i.e. those elements disclosed or made known by specified persons less than one year from material date — Matter cited as forming part of prior art simply prior art relied upon by person alleging obviousness — F.C.'s paraphrase of step 4 of framework also introducing oversimplification of original statement of that step — Error or ambiguity arising in F.C.'s reference to "self-evident" — F.C. comparing invention to common general knowledge to arrive at inventive step instead of comparing inventive step to common general knowledge — Rather than returning matter to F.C., proper analysis undertaken herein — Much of what is claimed in Claim 1 of '581 patent found in Gallagher patent — Skilled person able to bridge difference between claim as construed, cited prior art in Gallagher patent — As a result, invention claimed in '581 patent obvious — Appeal dismissed — Woods J.A. (concurring reasons): issue regarding effect of s. 28.3 better addressed in appeal where it is

relevant to outcome, where Court having benefit of full submissions from counsel.

CIBA SPECIALTY CHEMICALS WATER TREATMENTS LIMITED V. SNF INC. (A-479-15, 2017 FCA 225, Pelletier and Woods JJ.A., judgment dated November 17, 2017, 33 pp.)