

No Problem, No Solution! Federal Court Clearly Rebukes CIPPO's "Problem-Solution" Approach to Assessing Patentability

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In welcome news, the Federal Court has admonished the Canadian Intellectual Property Office ("CIPO") for its improper approach in assessing the patentability of computer-implemented inventions. In a decision issued on June 17, 2022 (*Benjamin Moore & Co. v. A.G. (Canada)*, 2022 FC 923), the Court clearly stated that the "problem-solution" approach followed by the CIPO in assessing patentability is incorrect and directed the CIPO to follow a three-part test that is more in keeping with earlier decisions by the Supreme Court.

Background

For several years the CIPO has provided guidance to examiners for assessing the patentability of claims, particularly those directed to computer-implemented inventions. The guidance, provided to examiners through Practice Notices and through the Manual of Patent Office Practice, stipulates that a "problem-solution" approach must be taken for analyzing claims. This approach requires examiners to first identify the "problem" being addressed by the application and to then identify the proposed inventive "solution". Very often, this analysis results in the refusal of patent applications relating to computer-implemented inventions.

This approach to assessing patentability was found to be improper by the Federal Court in its decision in *Yves Choueifat v Attorney General of Canada*, 2020 FC 837, which we reported [here](#). Although the *Choueifat* decision prompted the CIPO to revise its guidance to examiners, it still maintained that a "problem-solution" analysis must be adhered to. In particular, under the revised guidance, Examiners were instructed that "An actual invention may consist of either a single element that provides a solution to a problem or of a combination of elements that cooperate together to provide a solution to a problem."

That's not the right test!

In *Benjamin Moore*, the Federal Court considered the '130 and '146 patent applications, which relate to a computer-implemented paint colour selection method that uses experimentally derived relationships for colour harmony and colour emotion to model human reactions to colour combinations. The applications were refused by the Commissioner of Patents following a "problem-solution" analysis that found the claims to be directed to non-patentable subject matter. The refusals were appealed to the Court.

The Appellant, Benjamin Moore, requested that the Court overturn the refusal of the applications and return them to the Commissioner for reconsideration under the test for patentability that is more in line with decisions of the Supreme Court. The Appellant also requested the Court to specifically direct the Commissioner not to use the "problem-solution" approach. At trial, the Commissioner, represented by the Attorney General of Canada, agreed that the analysis used during the examination of the '130 and '146 applications was flawed, but argued that the applications should be returned to the Commissioner for reconsideration under the post-*Choueifat* guidance given to examiners.

In its decision, the Court clearly stated that a "problem-solution" test for determining patentability is incorrect and should not be followed. The Court then directed the Commissioner to reconsider the applications with the stipulation that the following procedure should be followed for assessing patentability:

- a) Purposively construe the claim;

- b) Ask whether the construed claim as a whole consists of only a mere scientific principle or abstract theorem, or whether it comprises a practical application that employs a scientific principle or abstract theorem; and
- c) If the construed claim comprises a practical application, assess the construed claim for the remaining patentability criteria: statutory categories and judicial exclusions, as well as novelty, obviousness, and utility.

It should be noted that this framework was proposed to the Court by the Intellectual Property Institute of Canada, which was granted leave to intervene.

Takeaways

In the absence of a successful appeal by the Commissioner, the *Benjamin Moore* decision quite clearly sets aside the “problem-solution” test that the CIPO has been applying to patent applications. The new test that the CIPO is directed by the Court to follow should add more clarity for applicants, especially for applications directed to computer-implemented inventions. In particular, the test requires an assessment of patentability, including an assessment of patentable subject matter, to be made on a claim “as a whole”, as opposed to a construed “solution”.

Applicants with applications that have been objected to under the “problem-solution” analysis should consider reasserting their cases for consideration under the new framework outlined by the Court.

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