Federal Court of Appeal  Cour d'appel fédérale

Date: 20191107

Docket: A-413-18

Citation: 2019 FCA 278

CORAM: **NADON J.A.**
RIVOALEN J.A.
LOCKE J.A.

BETWEEN:

IGOR STUKANOV

Appellant

and

ATTORNEY GENERAL OF CANADA

Respondent

Heard at Toronto, Ontario, on October 30, 2019.

Judgment delivered at Ottawa, Ontario, on November 7, 2019.

REASONS FOR JUDGMENT BY: LOCKE J.A.

CONCURRED IN BY: NADON J.A.
RIVOALEN J.A.

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REASONS FOR JUDGMENT

LOCKE J.A.

[1] This is an appeal by Igor Stukanov from a decision of Mr. Justice Fothergill of the Federal Court (2018 FC 1264), dated December 13, 2018 which dismissed an earlier appeal from a decision of the Commissioner of Patents (the Commissioner) refusing Mr. Stukanov's Patent Application No. 2,792,456 (the Application). The basis for the refusal of the Application was that the alleged invention defined therein was obvious contrary to section 28.3 of the *Patent Act*,

R.S.C. 1985, c. P-4. The Federal Court found that the legal test applicable to the determination of obviousness was not in dispute, and that the Commissioner made no error in applying that test.

[2] Before this Court, Mr. Stukanov raises a number of issues. Principally, he argues that the Federal Court erred in failing to find that the Commissioner's conclusion of obviousness was unreasonable. Mr. Stukanov also argues that the process leading to the Commissioner's decision was unfair in several respects. He also raises a number of other arguments that do not fit neatly into either of the preceding categories of alleged errors.

[3] The standard of review is not in dispute. This Court's task is to determine whether the Federal Court identified the appropriate standard of review of the Commissioner's decision, and applied that standard correctly: *Agraira v. Canada (Public Safety and Emergency Preparedness)*, 2013 SCC 36, [2013] 2 S.C.R. 559, at para. 45. The Federal Court applied the standard of correctness to whether the Commissioner identified the appropriate legal test to determine obviousness, and the standard of reasonableness to the Commissioner's findings on obviousness. I agree with the Federal Court in respect of both standards: see *Halford v. Seed Hawk Inc.*, 2006 FCA 275, 54 C.P.R. (4th) 130 at para. 39, and *Scott Paper Ltd v. Canada (Attorney General)*, 2008 FCA 129, 65 C.P.R. (4th) 303 at para. 11, both cited in *Blair v. Canada (Attorney General)*, 2010 FC 227 at paras. 48-51. The identification of the correct legal test for obviousness is a question of law subject to the standard of correctness. The application of the test to the facts is a question of mixed fact and law and, because of the Commissioner's expertise, is subject to the standard of reasonableness.

[4] On the principal issue of whether the Commissioner's conclusion of obviousness was reasonable, Mr. Stukanov raises many alleged errors. For example, Mr. Stukanov argues that the reasons that accompanied the Commissioner's decision (the Reasons) demonstrated a misunderstanding of the prior art reference that was cited for obviousness (U.S. Patent Application No. 2011/0125937 (Canon)). Specifically, Mr. Stukanov argues that adapting Canon to include the elements of the invention defined in the Application would yield a non-functional device, and hence Canon cannot be a proper basis for a conclusion of obviousness. Mr. Stukanov also argues that, to make such a device functional, one would have to add another feature, thereby making the device inventive in its own right. Moreover, Mr. Stukanov argues that the Commissioner failed to appreciate the distinction between "elements" of an invention and "structures" or "concepts" defined therein.

[5] I am not convinced that the Commissioner's conclusion of obviousness was unreasonable. The last of the arguments identified in the previous paragraph was addressed directly and in detail by both the Commissioner and the Federal Court, and I see no reason to intervene. Further, I am not convinced that the Commissioner misunderstood the prior art or the difference between it and the invention defined in the Application. The Federal Court did not err in refusing to intervene in the Commissioner's conclusion on obviousness.

[6] Mr. Stukanov also argues that the Commissioner erred in failing to consider the "obvious to try" test as defined in paragraphs 68 and following of *Apotex Inc. v. Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61, [2008] 3 S.C.R. 265. I agree with the statements of the Federal Court that (i) the Supreme Court of Canada indicated that this test applies "in areas of endeavour where

advances are often won by experimentation," and (ii) this test is not applicable to the invention defined in the Application. Moreover, it is not clear to me how an invention that has been reasonably found to be obvious could be saved by considering the obviousness to try test.

[7] I turn now to the issue of procedural fairness raised by Mr. Stukanov. He argues that it was unfair that he was not given an opportunity to respond to the Commissioner's Reasons before her decision was issued. However, he was invited to, and did, comment on a preliminary letter that provided proposed reasons. Moreover, the final Reasons addressed his comments. Mr. Stukanov did not direct the Court to any new issues that were raised in the Reasons that had not been raised before. It appears that there is no finding or reasoning by the Commissioner on which Mr. Stukanov was denied the opportunity to comment. This process was fair.

[8] Mr. Stukanov also complains that the Commissioner unfairly failed to address his argument on the distinction between elements and structures, and failed to explain her decision. I disagree on both counts. The Reasons clearly addressed the elements/structures issue, albeit not to Mr. Stukanov's satisfaction. Similarly, the Reasons explain the Commissioner's decision, though not to Mr. Stukanov's satisfaction.

[9] Mr. Stukanov made several other arguments not specifically addressed herein. Some of these are closely linked to the issues discussed above and can be dismissed for the same reasons. Others are distinct but clearly lack merit. One such distinct argument is that the refusal of the Application (naming a Canadian inventor), and the grant of another patent application naming U.S.-based inventors (he cites Patent Application No. 2,693,691), establishes a *prima facie* case

of discrimination by the Commissioner on the prohibited grounds of country of origin, citizenship and ethnic origin. Suffice it to say that these facts are clearly insufficient to establish even a *prima facie* case of discrimination.

[10] In conclusion, I see no errors in the Federal Court's decision. I would dismiss the appeal with costs in the all-inclusive amount of $1000.

"George R. Locke"
J.A.

"I agree.
M. Nadon J.A."

"I agree.
Marianne Rivoalen J.A."

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET:	A-413-18

APPEAL FROM A DECISION OF THE HONOURABLE MR. JUSTICE FOTHERGILL OF THE FEDERAL COURT, DATED DECEMBER 13, 2018, DOCKET NO. T-347-18

STYLE OF CAUSE:	IGOR STUKANOV v. ATTORNEY GENERAL OF CANADA
PLACE OF HEARING:	TORONTO, ONTARIO
DATE OF HEARING:	OCTOBER 30, 2019
REASONS FOR JUDGMENT BY:	LOCKE J.A.
CONCURRED IN BY:	NADON J.A. RIVOALEN J.A.
DATED:	NOVEMBER 7, 2019

APPEARANCES:

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