Federal Court  Cour fédérale

Date: 20181213

Docket: T-347-18

Citation: 2018 FC 1264

Ottawa, Ontario, December 13, 2018

PRESENT: The Honourable Mr. Justice Fothergill

BETWEEN:

IGOR STUKANOV

Appellant

and

ATTORNEY GENERAL OF CANADA

Respondent

JUDGMENT AND REASONS

I. Overview

[1] Igor Stukanov appeals a decision of the Commissioner of Patents [Commissioner] to refuse Patent Application 2,792,456 [Application]. The Application is titled "Universal External Drive", and relates to external drives that may be connected to computers using different operating systems without having to install drivers. The Commissioner refused the Application on the ground that all of its claims were obvious.

[2] The Commissioner based her decision on a recommendation of the Patent Appeal Board [PAB]. The PAB is an expert tribunal, and the Commissioner's conclusions are owed deference by this Court. Mr. Stukanov, who represented himself in this appeal, has not persuaded me that the Commissioner's decision was unreasonable. The appeal is therefore dismissed.

II. Background

[3] Mr. Stukanov filed the Application on October 22, 2012. It was laid open to public inspection on April 22, 2014. The patent examiner found the Application to be defective pursuant to s 30(3) of the *Patent Rules*, SOR/96-423, and issued a "final action" on March 4, 2015. The examiner concluded that claims 1 to 14 were obvious, contrary to s 28.3 of the *Patent Act*, RSC, 1985, c P-4; claims 1 and 2 were not supported by the description, contrary to s 84 of the *Patent Rules*; and the specifications were not sufficient, contrary to s 27(3) of the *Patent Act*.

[4] Mr. Stukanov responded to the final action on March 24, 2015, and asserted that the examiner was wrong on all three grounds. The examiner forwarded the Application to the PAB for review under s 30(6)(c) of the *Patent Rules*. The examiner provided the PAB with a summary of reasons that maintained the rejection, while extending the violation of s 84 to all of the Application's claims.

[5] On October 20, 2015, the PAB sent Mr. Stukanov the summary of reasons and requested his submissions. Mr. Stukanov responded on December 29, 2015, but declined the invitation to attend an oral hearing. On April 27, 2017, the PAB informed Mr. Stukanov of its preliminary

opinion that the claims were supported by sufficient description, but were nonetheless obvious. Mr. Stukanov replied on May 15, 2017, asserting that the Application's claims were not obvious.

[6] The PAB recommended that the Commissioner reject the Application on the ground that its claims were obvious, contrary to s 28.3 of the *Patent Act*. The Commissioner accepted this recommendation, and refused the Application under s 40 of the *Patent Act* on September 25, 2017.

III. Issue

[7] The sole issue raised by this appeal is whether the Commissioner's decision to refuse the Application was reasonable.

IV. Analysis

[8] The Commissioner's finding of obviousness is subject to review against the standard of reasonableness (*Blair v Canada (Attorney General)*, 2014 FC 861 at para 71, citing *Scott Paper Limited v Smart & Biggar*, 2008 FCA 129 at para 11). Whether the Commissioner applied the appropriate legal test to determine obviousness is a question of law, and is subject to review against the standard of correctness (*Blair v Canada (Attorney General)*, 2010 FC 227 at para 48).

[9] There is no dispute that the Commissioner applied the correct legal test to determine obviousness. The test was formulated by the Supreme Court of Canada in *Apotex Inc v Sanofi-Synthelabo Canada Inc*, 2008 SCC 61 [*Sanofi*] at paragraph 67:

> 1. (a) Identify the notional "person skilled in the art";
>
> (b) Identify the relevant common general knowledge of that person;
>
> 2. Identify the inventive concept of the claim in question or if that cannot readily be done, construe it;
>
> 3. Identify what, if any, differences exist between the matter cited as forming part of the "state of the art" and the inventive concept of the claim or the claim as construed;
>
> 4. Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

[10] The parties substantially agree with the Commissioner's identification of the person skilled in the art [PSA] and the relevant common general knowledge of the PSA. The central disagreement concerns whether an external drive with multiple built-in memory partitions or devices was within the PSA's common general knowledge at the time the Application was laid open to inspection.

[11] Mr. Stukanov also disputes the Commissioner's assessment of the difference between the "state of the art" and the Application, and whether this difference could be bridged without ingenuity. In addition, Mr. Stukanov alleges that the Commissioner was biased and her reasons are unintelligible.

[12] The Commissioner found the "state of the art" to be embodied in a United States patent application titled "Peripheral Device Usable Without Installing Driver in Computer Beforehand", US2013050734 (A1) [the Canon Patent]. The Canon Patent is for a family of peripherals that can be connected to computers and other electronic devices without the prior installation of drivers. The Application and the Canon Patent accomplish the same thing – universal, driverless connection – using slightly different means.

[13] Both the Application and the Canon Patent describe multiple memory partitions, each of which is formatted differently. When the Application device is connected to a computer, the computer communicates with the partition that has been formatted to correspond to its operating system. A software program on the Application device (the "Synchronizer") ensures that all of the differently-formatted partitions contain the same data. This may be contrasted with the invention described in the Canon Patent. When the Canon device is connected to a computer, the computer communicates with the same partition (the "Working Area") regardless of its operating system. The Working Area does this by loading, from a separate partition, a control program corresponding to the format of the connected computer. The Working Area simultaneously accesses the differently-formatted partitions to ensure the data remain the same across each partition.

[14] In oral argument, Mr. Stukanov placed considerable emphasis on the PAB's alleged failure to consider the "structure" of his invention. However, the PAB clearly considered Mr. Stukanov's attempt to distinguish the Application device from the Canon device:

> [32] The Applicant submitted in his reply letter that the identification of differences between [the Canon Patent] and the

> claimed invention "had missed the most important and critical element – structure".

[15] The PAB rejected Mr. Stukanov's argument as follows:

> [34] In the Panel's view, the software of the [Canon Patent] (that is, the control and capture files) used to manage data operations between the disk image and the connected computer are no different from the claimed element "software to manage operations of data exchange between said external universal drive and a computer or an electronic device."

[16] Mr. Stukanov presented several variations of his argument that the structure or concept of his invention differs from the Canon Patent. He provided the Court with two tables of the claimed differences. I am satisfied that all of these arguments were fully canvassed in the Commissioner's decision. The PAB noted that Mr. Stukanov did not make submissions on many of the positions outlined in its preliminary opinion.

[17] Mr. Stukanov is asking this Court to reconsider the evidence and substitute its view for that of the Commissioner. However, that is not the role of this Court in an appeal of the Commissioner's decision. Mr. Stukanov has not persuaded me that the Commissioner's conclusion that his invention is obvious falls outside the "range of possible, acceptable outcomes which are defensible in respect of the facts and law" (*Dunsmuir v New Brunswick*, 2008 SCC 9 at para 47).

[18] The Commissioner found that the difference between the Application and the "state of the art" could be bridged by steps that would be obvious to the PSA using only the relevant

common general knowledge. Mr. Stukanov argues that the PSA would have no incentive to bridge the difference, because both inventions solve the same problem using different means. In other words, there would be no reason to adapt the Canon device to create the Application device, because the Application device does not claim to be an improvement over the Canon device.

[19] Mr. Stukanov also alleges that the Commissioner misidentified the problems to be solved as including reliability, as well as universality. However, in his replies to the final action and the summary of reasons, Mr. Stukanov himself identified reliability as one of the problems that his invention was capable of solving.

[20] I am satisfied that the Commissioner reasonably found the invention disclosed in the Application to be a combination of components that were within the PSA's common general knowledge. Given the state of the art, as embodied in the Canon Patent, it was open to the Commissioner to conclude that combining these components to address the well-known problem of incompatible external drives in the manner described in the Application would have been obvious to the PSA. By the same token, the Commissioner reasonably concluded that Claim 2, which describes the use of multiple memory devices in lieu of or in addition to multiple memory partitions, would also have been obvious to the PSA.

[21] Mr. Stukanov maintains that the invention described in the Application was not "obvious to try". This is an aspect of the final branch of the *Sanofi* test that, depending on the area of endeavour, may form a part of the obviousness analysis. However, in this case, the

Commissioner did not find it necessary to consider the "obvious to try" test. In *Sanofi*, the Supreme Court of Canada described the circumstances in which the "obvious to try" test may be appropriate (at para 68):

> In areas of endeavour where advances are often won by experimentation, an "obvious to try" test might be appropriate. In such areas, there may be numerous interrelated variables with which to experiment. For example, some inventions in the pharmaceutical industry might warrant an "obvious to try" test since there may be many chemically similar structures that can elicit different biological responses and offer the potential for significant therapeutic advances.

[22] The development of universal peripheral devices for computers is not an area of endeavour similar to those described by the Supreme Court of Canada in *Sanofi*. Furthermore, as noted above, the Commissioner's factual findings are entitled to deference.

[23] Mr. Stukanov advances two further arguments that may be dealt with briefly. He says that the Commissioner was biased against him, based on a number of unproven factual assertions and employing a statistical analysis. His methodology is dubious. Moreover, he did not raise this argument before the Commissioner or in his notice of appeal. I agree with the Respondent that it is improper for Mr. Stukanov to advance this position for the first time in argument (*Gitxaala Nation v Canada*, 2015 FCA 27 at para 7; *Alberta (Information and Privacy Commissioner) v Alberta Teachers' Association*, 2011 SCC 61 at paras 22-29).

[24] Finally, Mr. Stukanov complains that the Commissioner simply adopted the PAB's recommendation, and therefore did not provide her own intelligible reasons for the decision. The Respondent notes that the Commissioner's usual practice is to rely on the expertise of patent

examiners and the PAB in making decisions pursuant to ss 4(2) and 6 of the *Patent Act*. It is well-established that when a decision-maker adopts the reasons provided by a recommendatory panel, the panel's report forms a part of the decision (*Gupta v Canada (Attorney General)*, 2016 FC 1089 at para 17; *Sketchley v Canada (Attorney General)*, 2005 FCA 404 at para 37). The PAB's analysis was clear and thorough, and Mr. Stukanov's argument regarding the intelligibility of the Commissioner's reasons is therefore without merit.

V. Conclusion

[25] For the foregoing reasons, the appeal is dismissed. No costs are awarded.

JUDGMENT

THIS COURT'S JUDGMENT is that the appeal is dismissed without costs.

"Simon Fothergill"
Judge

FEDERAL COURT

SOLICITORS OF RECORD

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