**From:** Martin M. [mailto:mjmarcus@rogers.com]
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**To:** AB98 Comments
**Subject:**

Sirs:

This is not really a comment on the proposed Interim Examination etc but is a comment on the differences between Canadian established patent law and the decision in Bilski. I am interested in this topic as a Canadian patent agent who is also registered to practice before the USPTO ( # 18823)

Under Canadian law, as set forth by the Supreme Court of Canada in the case of COMMISSIONER OF PATENTS v. CIBA LTD on Feb 29,1950 and reported in CANADIAN PATENT REPORTER [VOL. 30-SEC. II] on page 136.

In that case it was held:

> "To constitute an invention within the definition in our Act, the process must be new and useful. There is no question , as to the process here being useful as it produces compounds which have been admitted to be both new and useful.
>
> 'Is it a new process? Is the element of novelty precluded because it consists of a standard. classical reaction used to react known compounds? In my opinion the process in question here is novel because the conception of reacting those particular compounds to achieve a useful product was new. A process implies the application of a method to a material or materials. The method may be known and the materials may be known, but the idea or making the application of the one to the other to produce a new and useful compound may be new, and in this case I think It was."

It appears form the Interim Examination Instructions for Evaluating Subject matter Eligibility Under 35 USC 101, that your courts have defined Process as ( as it appears on page 1) requiring an act or a series of acts or steps THAT ARE TIED TO A PARTICULAR MACHINE OR APPARATUS.. This seems to exclude a chemical reaction that is not TIED TO A PARTICULAR MACHINE OR APPARATUS. Is this truly US patent jurisprudence?

Then in the section headed B. Processes (methods) it is stated that , to be statutory under sec 101 a process must pass the M-or T test WHICH ENSURES THAT THE PROCESS IS LIMITED TO A PARTICULAR PRACTICAL APPLICATION. Is the M-or-T test the only determining factor that ENSURES THAT THE PROCESS IS LIMITED TO A PARTICULAR PRACTICAL APPLICATION.

From a Canadian point of view, it is much simpler. A method is defined as the manipulative steps carried out to give a new and useful result. A process is defined as the application of a method to material to provide a new and useful product.

I hope that this summary of Canadian patent law vis-a- vis “method” and “process” will be thought provoking to you.

Martin J Marcus