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The Promise Doctrine is Struck Down by the Supreme Court of Canada

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On June 30th, 2017, in a landmark decision, the Supreme Court of Canada rejected the relatively new so-called “promise doctrine”. The lower courts had found the patent invalid based on this doctrine in that the patent specification attributed certain advantages to the invention that were not soundly predicted at the Canadian filing date. The Trial Division of the Federal Court had even termed the “promise of the patent” as “the yardstick against which utility is measured”.

Canadian patent 2,139,653 claimed the gastric acid lowering drug (proton pump inhibitor) esomeprazole sold under the Nexium® brand. Two so-called promises were identified by the lower court: 1) that the drug would work as a proton pump inhibitor in that it would reduce gastric acid; and 2) that the drug would yield improved pharmacokinetics with less inter-patient variability. The first promise was not in dispute but the second one was deemed unfulfilled and directly led to a finding of invalidity. The lower court felt bound to rule that the patent was invalid because one of the two identified promises was not soundly predicted. The Federal Court of Appeal affirmed.

The Supreme Court unequivocally rejected the “promise doctrine” and reversed the findings of the lower courts. The “promise doctrine” was deemed to be the wrong approach, being unsound and risking to deprive an otherwise useful invention of patent protection. Moreover, the “promise doctrine” was found to be antagonistic to the bargain on which patent law is based wherein inventors are asked to give fulsome disclosure in exchange for a limited monopoly.

The Supreme Court ruled that a patent providing at least one credible use related to the subject-matter of the invention was sufficient to establish utility. Credible utility is established by either demonstration or sound prediction as of the filing date.

This decision is of profound significance to understanding the utility requirement for obtaining a valid Canadian patent.

Goudreau Gage Dubuc LLP acted as intervener in this case on behalf of FICPI (Fédération internationale des conseils en propriété intellectuelle). FICPI was jointly represented on a *pro-*

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bono basis by Fasken Martineau DuMoulin LLP, attorneys Julie Desrosiers, Marie Lafleur and Kang Lee and by Goudreau Gage Dubuc LLP, attorney Alain M. Leclerc.

A link to the decision can be found here: AstraZeneca Canada Inc. v. Apotex Inc.

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