

Potential Amendments to Canadian Practice on Patentable Subject-Matter for Computer-Implemented Inventions

Mark Davis, Stephen I. Selznick, Eleanor Wilson, Madison Skoblo

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The Canadian Intellectual Property Office (CIPO) has [proposed amendments to the Manual of Patent Office Practice \(MOPOP\) relating to patentable subject-matter](#). MOPOP is intended to be a comprehensive guide to CIPO's patent practices. The proposed amendments are intended to reflect the evolution in Canadian patent law and examination practices for computer-implemented inventions following two landmark decisions: *Canada (Attorney General) v. Benjamin Moore & Co.* [2023 FCA 168](#) (*Benjamin Moore*) and *Choueifaty v. Canada (Attorney General)* [2020 FC 837](#) (*Choueifaty*). Below we outline the historical context that led to this update and summarize the proposed amendments.

Recent History Shaping the Assessment of Patentable Subject-Matter

Choueifaty. In August 2020, the Federal Court rejected the “problem-solution approach” set out in the then current version of MOPOP as the approach for determining essential elements of a claim. In applying the “problem-solution approach,” CIPO had been excluding computer elements from the essential elements on the basis that they were not necessary to achieve the disclosed solution to an identified problem. The Federal Court found that the “problem-solution approach” was fundamentally inconsistent with established purposive construction principles from the leading Supreme Court decisions as it focused only on functional considerations while ignoring the inventor's intention. The Federal Court clarified that while identifying the problem and solution may be relevant to understanding an invention's purpose, it cannot be the sole or overriding factor in determining essential elements.

PN2020-04. Following *Choueifaty*, CIPO issued [Practice Notice PN2020-04](#), which superseded portions of the MOPOP, stating that the references in MOPOP chapters 12, 17, 18, 22 and 23, to the “contribution” of a claim, to a “technological solution to a technological problem” and to the “problem and solution” approach in the identification of essential elements during purposive construction should no longer be applied. PN2020-04 provided guidance on the patentable subject-matter analysis, which involves (i) identifying the essential elements of a claim as part of the purposive construction, and (ii) determining an “actual invention” that may consist of either a single element or a combination of elements that provide(s) a solution to a problem.

Benjamin Moore. In August 2023, as we [previously reported](#), the Federal Court of Appeal rejected an attempt to impose a rigid test for assessing the patentability of computer-implemented inventions,

emphasizing judicial restraint and the need for fact-specific determinations. In the decision below, the Federal Court had instructed the Commissioner of Patents to:

- purposively construe the claim;
- determine whether it consists of a practical application rather than a mere scientific principle; and
- assess the construed claim for the remaining patentability criteria in a prescribed order.

The Federal Court of Appeal agreed that claims must be purposively construed but rejected the balance of the test proposed by the Federal Court, finding that it was not supported by the current jurisprudence, including *Amazon.com, Inc. v. Canada (AG)*, 2011 FCA 328, and dealt with issues that have yet to be properly considered by a Canadian court. Instead, the Federal Court of Appeal ordered that the patentability of the two applications at issue be redetermined in light of the current guidance in the MOPOP including PN2020-04. The decision reinforced that patentability assessment is “a highly fact specific exercise” requiring consideration of the full circumstances and the nature of the invention.

CIPO’s Proposed Amendments to MOPOP

CIPO is now proposing comprehensive updates to four chapters of the MOPOP:

- Chapter 12 – Fundamentals of Examination
- Chapter 17 – Subject-Matter
- Chapter 22 – Computer-Implemented Inventions
- Chapter 23 – Biotechnology and Medicinal Inventions

In general, the proposed amendments represent CIPO’s efforts to implement some of the guidance in PN2020-04 and align examination practices with the leading jurisprudence, focusing on patentable subject-matter of computer-implemented inventions, biotechnology and medical inventions. Some of the proposed revisions include:

Chapter 12 – Fundamentals of Examination

- Implementing the “actual invention” approach and removing references to the problem/solution approach to assessing patentable subject-matter (see, for example, s. 12.02; 12.02.01; removal of current s. 12.02.02d and 12.02.02e; addition of new s. 12.02.02d; 12.02.03; 17.01.05; 17.02).
- Providing updated examples of situations where elements may be found to be non-essential when purposively construing the subject-matter of a claim (s. 12.02.04).

Chapter 17 – Subject-Matter

- Explaining the assessment of patentable subject-matter and clarifying terms used in the legislation, focusing on the concept of actual invention and the extent to which the actual invention has physicality (s. 17.01, 17.01.06, 17.02, 17.02.01).
- Clarifying and providing updated examples of how the subject-matter requirement impacts certain fields (s. 17.02.02).

Chapter 22 – Computer-Implemented Inventions

- Clarifying what is considered a computer-implemented invention and how certain computer-related terms in claims are generally construed and considered with respect to patentable-subject matter (s. 22.01, 22.02).
- Explaining what is considered patentable subject when the invention involves an algorithm (including where the processing of an algorithm improves the functioning of the computer, and where there are claimed cooperating physical inputs or outputs which are not generic computer components) (s. 22.03), and providing guidance on what factors may indicate that an algorithm improves the functioning of a computer (s. 22.03.01) and how it is determined whether or not a computer and associated inputs or outputs are generic (s. 22.03.02).
- Providing detailed examples of how patentable-subject matter is assessed in practice for different types of inventions (e.g., artificial intelligence (AI)-related inventions, commercial and financial operations) (s. 22.03.03).
- Providing guidance on how validity requirements are assessed in the context of computer-implemented inventions, including commentary on anticipation by prior use, obviousness, utility and sufficiency (including commentary on enablement in AI machine-learning inventions and common general knowledge in programming) (s. 22.04-22.07).

Chapter 23 – Biotechnology and Medicinal Inventions

- Providing detailed examples of purposive construction and assessing patentable-subject matter for life forms (s. 23.02.01).
- Adding guidance on and examples of claiming a cell of a higher life form (s. 23.02.01a).
- Providing guidance on and examples of claiming processes to produce life forms (s. 23.02.03).
- Clarifying how patentable subject-matter is assessed and providing updated examples for medical diagnostic methods (s. 23.03.04).
- Providing updated and concise guidance on defining a product by its structure (s. 23.05.01) and defining a biological product by a biological deposit number (s. 23.06.02).

Artificial Intelligence. The proposed amendments regarding the sufficiency of disclosure requirement (s. 27(3) of the *Patent Act*) acknowledge that for inventions involving use of AI and machine learning, “there is a particular issue with regard to enablement.” With these types of inventions, the training methodology or training data must be adequately disclosed by the specification so as to enable the person of ordinary skill in

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the art (POSITA) to realize the utility of the invention. A machine-learning algorithm which requires undue experimentation by the POSITA to train the algorithm will lack sufficiency of disclosure (s. 22.07.02). Additionally, the proposed amendments confirm that when it comes to assessing patentable subject-matter, computerized inventions involving the use of AI are treated like any other computerized algorithms (s. 22.03.03c).

Looking Forward

Given the impact these changes may have on how examiners will assess patentable subject-matter, those practicing in or innovating in the affected areas of technology may wish to participate in the consultation process. If you have questions or would like to submit comments, please contact a member of our [Intellectual Property Group](#)'s patent litigation team. Comments can be submitted by July 11, 2025 by email to cipoconsultations-opicconsultations@ised-isde.gc.ca. More information on this process can be found here: [Consultation on MOPOP update relating to patentable subject-matter](#).

This publication is a general summary of the law. It does not replace legal advice tailored to your specific circumstances.