Jordana Sanft
416-596-1083
jsanft@litigate.com

Jim Lepore
416-865-2881
jlepore@litigate.com

Natalie Workewych
416-865-2908
nworkewych@litigate.com

March 23, 2026

Making a Splash in Patent Law: The Federal Court of Appeal Clarifies Overbreadth and Utility

ProSlide Technology and WhiteWater West Industries are the two largest competitors in the global water slide market. That competitive pressure has, perhaps inevitably, spilled into the courtroom.

At the centre of this dispute were three related patents (the 552 Patent Family) owned by ProSlide, collectively entitled “Water Ride.” These patents all name ProSlide’s President and CEO as inventor and share a March 3, 2015 filing date. The patents claim various slide features relating to orientation, geometry, and physical characteristics of sliding surfaces and walls. As is common, most of the independent claims were drafted broadly (e.g., referring to “amusement rides” generally rather than water slides specifically).

The Federal Court in *ProSlide Technology v WhiteWater West Industries* addressed many issues related to the 552 Patent Family, including claim construction and various grounds of invalidity, while the appeal, discussed below, was focussed on three main issues. At first instance, the Federal Court found the asserted claims invalid for overbreadth and not infringed.

The trial decision was notable for being among very few Canadian cases invalidating a patent for being “broader than the invention made” as distinct from the more commonly invoked “broader than the invention disclosed” branch of the overbreadth doctrine. In coming to this conclusion, the trial judge relied on testimony from the inventor about what he had in mind during development, along with expert evidence interpreting internal design review minutes, specifications, and correspondence regarding the inventor’s work. In considering his testimony, the Federal Court found that the inventor had in fact contemplated an invention narrower than that covered by the asserted claims. The Federal Court concluded that there were four key aspects of the invention made, and one or more was omitted from each of the asserted claims. Because the asserted claims were not limited to these key aspects, the Federal Court concluded that the asserted claims were invalid for being broader than the invention made.

ProSlide appealed and WhiteWater cross-appealed on the

question of utility. Accordingly, three issues were live on appeal: overbreadth, infringement and utility. The Federal Court of Appeal's decision was released on March 20, 2026.

The Federal Court of Appeal's Decision

1) Overbreadth: Confirmed As Doctrine, Reversed on the Facts. ProSlide argued that claiming more broadly than the invention made should not be a valid ground of invalidity at law. The Federal Court of Appeal declined to make that finding, stating that it had "twice recently confirmed the doctrine" in *Western Oilfield* and *Seedlings*, and that ProSlide had not met the high bar for overturning precedent.

However, the Federal Court of Appeal went on to find the trial judge erred in *applying* the doctrine. The Federal Court of Appeal clarified that the invention made should be determined with reference to the patent specification. As Justice Locke, writing for the Federal Court of Appeal, concisely summarized:

> [I]n most cases, it is difficult to imagine a more reliable (and more timely) indication of what the inventor contemplated than the patent specification. The relevant date for assessing the issue of overclaiming is the filing date of the patent application, and that patent application is an explicit and carefully written statement on that date of what the inventor had in mind.

The Federal Court of Appeal then turned to the specifications of the 552 Patent Family and found that each of the four "key aspects" of the invention that the trial judge had identified was expressly indicated in the specification as not being essential. Their exclusion from the asserted claims – and from the inventor's contemplated invention as articulated during his testimony – should not have resulted in a finding of overbreadth. As the Federal Court of Appeal observed, "neither the Federal Court nor WhiteWater has explained why the above-cited statements in the patent specification as to variations that were contemplated should be ignored in favour of evidence as to what the inventor had in mind during a time prior to the filing of the patent application."

The Federal Court of Appeal reversed the overbreadth finding and restored the validity of the asserted claims. Their analysis is a powerful reminder that a well-drafted specification (one that explicitly contemplates variations beyond the preferred embodiment) can be determinative in defending claims against an overbreadth challenge.

2) Infringement: Designs and Drawings Are Insufficient Where a Product Is Claimed. At trial, WhiteWater's non-infringement defence was premised on evidence that none of

the allegedly infringing products were physically manufactured, assembled, or used in Canada – everything was built by subcontractors abroad and exclusively used abroad. ProSlide countered that nearly all design, development, electronic testing, and validation occurred in Canada, and that this was sufficient to establish infringement.

The Federal Court of Appeal did not agree. Relying on its recent decision in *Steelhead*, which we previously discussed here, the Court held that where a patent claims a physical object, the exclusive rights extend only to that physical object, not to designs and drawings of it. ProSlide tried to distinguish *Steelhead* on the basis that WhiteWater's design process was far more advanced, but the principle held regardless of how sophisticated the digital work had become. WhiteWater's activities in Canada did not extend to physically using the claimed invention of slide features for amusement rides, and, as articulated in *Steelhead*, use must be of the claimed invention – not its goal, purpose or advantage, however these might be defined. The Federal Court of Appeal stated that "it would be for Parliament (not the courts) to move the threshold for patent infringement, as it has done for copyright infringement."

As it stands, for patents claiming a physical object alone, infringement requires physical instantiation in Canada.

3) Utility: Sound Prediction Survives. WhiteWater's cross-appeal argued that the trial judge applied too lenient a disclosure standard for sound prediction of utility. As it was no longer in issue, the Federal Court of Appeal declined to consider whether a heightened disclosure requirement applies to sound prediction, however offered other important commentary. In upholding the Federal Court's conclusion, the Federal Court of Appeal stated that the threshold for soundness of the prediction is "not high," and the utility at issue was simply that a rider could enter, traverse, and exit the slide feature. The Court also stated that patentees are not required to disclose every testing methodology they used, observing that "the claimed inventions concern slide features, not testing methodologies."

Key Takeaways

The Test for Overbreadth Must Be Rooted in the Specification. While the Federal Court of Appeal confirmed that claiming more broadly than the invention made remains a distinct ground of invalidity, it made clear that the analysis cannot lean on the inventor's pre-filing thoughts and internal correspondence while ignoring the patent specification. Rather, this approach favours the specification as the carefully written

statement of what the inventor had in mind on the patent's filing date. Practitioners should ensure that specifications clearly signal the intended breadth of the invention, especially where claims are drafted to cover a genus rather than a single species.

Patents That Claim Products Require More Than Design. Even sophisticated digital design, CAD modeling, and electronic testing activities conducted are not sufficient to constitute "making" or "using" a patented physical object. For patentees, this underscores the importance of obtaining protection in jurisdictions where physical manufacturing and use are likely to occur. Justice Locke expressly stated that, although a remedy was not available in Canada, remedies "may be available based on corresponding patents that may be obtained in other jurisdictions."

Sound Prediction Disclosure Remains Pragmatic. The Federal Court of Appeal confirmed that the threshold for soundness of prediction is not high. Further, patentees are not required to disclose every test or simulation underlying the prediction of utility, provided the specification is not "fanciful, inoperable, or speculative."

Potential Impact on AI-generated Designs. The decision may have implications for AI-generated designs in two respects:

- First, the Federal Court of Appeal's conclusions on the limits of use may support a non-infringement finding that AI-generated designs, without physical manifestation, are insufficient to trigger liability for a claimed product.
- Second, given the Federal Court of Appeal's reiteration of the low threshold for sound prediction, this decision may lay a foundation for using AI-generated designs in patent specifications to support disclosure.