Excess claims fees vs. double patenting in Canadian prosecution

June 03, 2024

When prosecuting a patent in Canada, it is important to keep in mind the risks of double patenting as compared to the cost of claims over 20. In order to accede to the Canada-U.S.-Mexico Agreement and implement a system of patent term adjustment for delays in the patent office between filing and issuance of a patent, the Canadian Intellectual Property Office has taken steps to try to streamline prosecution and reduce the time to patent issuance. These changes introduce a tension between excess claims fees, which meant to shorten examination time by encouraging submission of more compact claim sets, and the risk to patentees as a result of Canada's strict double patenting prohibition. Filing a divisional patent application without first receiving a unity objection from a Canadian patent examiner is not advised due to the risk of double patenting.

Excess claims fees

Patent applications will incur excess claims fees of C$110 for each claim in excess of 20. The excess claims fee calculation is based on the greatest number of claims pending in the application *at any time* after the examination request. These fees are payable at the time of the examination request if claims number over 20 at that time and may be payable again after allowance, with the final fee, if the number of claims increases.

Independent and dependent claims incur the same fee, and inclusion of multiple dependencies in the latter does not elicit additional fees. Claims may include lists of alternatives without incurring extra fees.

Careful consideration and planning are required both to mitigate the double patenting risk and to ensure that the claim set permits robust enforcement.

Double patenting considerations

Canadian double patenting challenges may arise as objections during examination and in post-grant invalidity proceedings. Canada has both "same invention" and "obviousness-type" double patenting but offers no mechanism, such as terminal

disclaimer, for their straightforward resolution. A detailed discussion of the law relating to double patenting is canvassed here.

Double patenting can arise whenever there is potentially overlapping subject matter claimed in two patents or when the claims of two patents are not patentably distinct in view of one another. The assessment applies to patents arising from entirely separate applications as well as so-called “voluntary division” situations in which an applicant has filed a divisional application at its own discretion. Voluntary divisional applications (and patents arising from them) can be particularly vulnerable to challenge as they necessarily have the same disclosure. Historically, the courts have distinguished between voluntary division and enforced division at the direction of the Commissioner of Patents, stating that a patentee is not to be prejudiced by the latter. Thus, it is a recommended best practice to secure a comprehensive assessment of unity prior to division (see ‘Claim reduction strategies’ below).

Double patenting law in Canada is all judge-made. Navigating what the courts will and will not consider to be double patenting is best done in conjunction with a Canadian lawyer familiar with its application.

Claim reduction strategies

It is not prudent simply to delete claims prior to filing a request for examination with an expectation of pursuing those claims in a divisional application in future. The safest course of action is to attempt to trigger a unity objection. To do this, it is best to file a broad claim set that encompasses all subject matter of interest before the first office action is issued. Examiners typically assess unity in the first office action, which can then assist in decision making before any deletions or elections are made.

This claim set does not need to include all planned or potential dependent claims. However, it should encompass all potentially important aspects and embodiments of the invention. It is recommended to include:

- **claims from foreign applications and patents** if coverage for these embodiments is not already present in the Canadian claim set,
- **claims to features that may be required for patentability, and**
- **claims of co-pending Canadian applications** that may not otherwise be sustainable due to double patenting considerations.

On the second point, the identification of non-unified subject matter groups — often characterized as multiple “inventions” in the text of a unity objection — should *not* be taken as an indication that an examiner accepts any of the groups as inventive. Claim amendments are often required following an election and it is recommended that features salient to patentability be considered in the unity objection forcing division.

When a unity objection is raised, claims may still be added before making an election. There is no need to elect immediately. Applicants may request reconsideration of an amended claim set to secure a more comprehensive assessment of unity.

The avoidance or reduction of excess claims fees must therefore be balanced against including enough claims for the assessment of unity to be comprehensive.

Enforcement considerations for claim reduction

Broad patents claims can help exclude others from entering the claimed territory. However, narrow claims can be easier and more cost-effective to enforce. Canada has no mechanism to enter claim amendments after grant.

Markush groupings and lists of alternatives can also be risky, as the presence of a single invalid element within such a group or list has, at times, been sufficient to invalidate an entire claim. It is therefore recommended to claim commercially important embodiments separately and expressly.

A thoughtful cascading claim set that considers both commercial products and opportunities for competitors to “design around” the claims can help a trial lawyer, should the patent ever need to be enforced in court.

Timing of claim reduction

Excess claims fees are first payable at the time of the examination request and may be payable at allowance if the number of claims increases at any point during proceedings. Applicants can wait to request examination until four years from the filing date. Deferring examination in this manner allows applicants time to consider the events of counterpart foreign proceedings as well as commercial developments to ensure that important features are incorporated into or retained in the Canadian claim set.

An applicant requiring more time to consider claim amendments could use one or both of the following:

- **The late fee period**. If the examination fee (including any excess claims fees) is not paid in a timely manner, a notice will issue permitting corrective action to be taken within two months with a late fee.
- **The reinstatement period**. If corrective action is not taken within the late-fee period, the application will become abandoned. Reinstatement is available as of right up to six months from the original examination deadline, with one caveat being that it is not possible to expedite examination after abandonment.

Features can be rolled together as preferred embodiments to avoid fees payable at examination. However, this is an informal format that will elicit objections and eventually require a decision about whether to claim an embodiment separately and incur a fee at allowance.

The applicant could also simply delete claims to avoid or reduce fees. Filing such amendments would not preclude entry of further claim amendments at a later date to optimize the claim set. However, thought should be given to making further amendments prior to the first office action, as described above, to ensure early consideration of unity.

Do not prioritize excess claims fees over all else

Excess claims fees in Canada are quite modest thus, avoidance of these fees should not be an applicant's sole priority. Reducing expenses must be balanced against double patenting risk and potential enforcement issues. Excess claims fees may be entirely justified when the inclusion of additional claims strengthens a patentee's proprietary position. In addition, it may cost more to have these strategy discussions than it does to simply pay the fees.

For more information on best practices to reduce excess claims and mitigate double patenting risk, or to discuss the details of your particular application, please contact any of our key contacts listed below.

By

Beverley Moore, Graeme Boocock

Expertise

Intellectual Property, Patents, Health Care & Life Sciences, United States

---

BLG | Canada's Law Firm

As the largest, truly full-service Canadian law firm, Borden Ladner Gervais LLP (BLG) delivers practical legal advice for domestic and international clients across more practices and industries than any Canadian firm. With over 800 lawyers, intellectual property agents and other professionals, BLG serves the legal needs of businesses and institutions across Canada and beyond – from M&A and capital markets, to disputes, financing, and trademark & patent registration.

blg.com

BLG Offices

Calgary
Centennial Place, East Tower
520 3rd Avenue S.W.
Calgary, AB, Canada
T2P 0R3

T 403.232.9500
F 403.266.1395

Ottawa
World Exchange Plaza
100 Queen Street
Ottawa, ON, Canada
K1P 1J9

T 613.237.5160
F 613.230.8842

Vancouver
1200 Waterfront Centre
200 Burrard Street
Vancouver, BC, Canada
V7X 1T2

T 604.687.5744
F 604.687.1415

Montréal
1000 De La Gauchetière Street West
Suite 900
Montréal, QC, Canada
H3B 5H4

T 514.954.2555
F 514.879.9015

Toronto
Bay Adelaide Centre, East Tower
22 Adelaide Street West
Toronto, ON, Canada
M5H 4E3

T 416.367.6000
F 416.367.6749

The information contained herein is of a general nature and is not intended to constitute legal advice, a complete statement of the law, or an opinion on any subject. No one should act upon it or refrain from acting without a thorough examination of the law after the facts of a specific situation are considered. You are urged to consult your legal adviser in cases of specific questions or concerns. BLG does not warrant or guarantee the accuracy, currency or completeness of this publication. No part of this publication may be reproduced without prior written

permission of Borden Ladner Gervais LLP. If this publication was sent to you by BLG and you do not wish to receive further publications from BLG, you may ask to remove your contact information from our mailing lists by emailing unsubscribe@blg.com or manage your subscription preferences at blg.com/MyPreferences. If you feel you have received this message in error please contact communications@blg.com. BLG's privacy policy for publications may be found at blg.com/en/privacy.

© 2026 Borden Ladner Gervais LLP. Borden Ladner Gervais LLP is an Ontario Limited Liability Partnership.