Navigating new excess claims fees and double patenting risk in Canadian patent prosecution: The devil and the deep blue sea

September 29, 2022

The most significant changes to the Canadian patent system in more than two decades come into effect on October 3, 2022.[1] Several of these changes aim to streamline patent prosecution, thereby setting the stage for a future system of patent term adjustment that Canada is required to implement under the Canada-U.S.-Mexico Agreement. In this insight, we focus on the addition of excess claims fees to the Canadian patent system.

Excess claims fees

The forthcoming changes will bring excess claims fees of CAD$100 for each claim in excess of 20. Independent and dependent claims will incur the same fee, and inclusion of multiple dependencies in the latter will not elicit additional fees.[2] Claims may include lists of alternatives without incurring extra fees.[3]

These fees are payable at the time of the examination request and may be payable again after allowance, with the final fee, if the number of claims increases.[4] The excess claims fee calculation at allowance will be based on the greatest number of claims pending in the application *at any time* after the examination request.

While excess claims are a familiar aspect of many patent systems worldwide, the repercussions of filing an abbreviated claim set in Canada can be unique and unexpected, particularly given Canada's jurisprudence relating to double patenting. 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 for claim reduction

Filing a divisional application is only advisable in Canada in response to an examiner-led unity objection that delineates non-unified subject matter groups. In these circumstances, when division is "forced" by the Canadian Intellectual Property Office (CIPO), the Supreme Court of Canada (SCC) has held that there can be no subsequent

double patenting challenge.[5] In any other circumstance in which a divisional application is filed merely by choice, this safe harbour is not available and double patenting vulnerabilities may arise for both the parent and the divisional application.

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.

In many cases, it would not be prudent simply to delete claims at the time excess claims fees are first due with an expectation of pursuing those claims in a divisional application in future. Rather, the safest course of action would be first to engage the SCC’s safe harbour against double patenting by securing an assessment of unity that considers all subject matter of interest before any deletions or elections are made. The avoidance or reduction of excess claims fees must therefore be balanced against including a sufficient number of claims for the assessment of unity to be comprehensive.

Applicants preparing reduced claim sets to mitigate excess claims fees should consider:

- **Including broad claims to all embodiments of interest.** Since the SCC has stated that there can be no double patenting challenge if division is made at the direction of CIPO, applicants should ensure that claims to all embodiments of long-term interest are included and examined for unity in Canadian prosecution.
- **Adding claims from pending foreign applications and patents.** Applicants should review foreign divisional and continuation applications (and patents granted from those applications) and consider adding their independent claims if coverage for these embodiments is not already present in the Canadian claim set.
- **Consolidating claims of co-pending Canadian applications when appropriate.** Double patenting risk is not restricted to divisional applications and may arise in respect of any co-pending application or granted patent, including those originating from applications filed on the same day. If co-pending applications relate to the same subject matter but include different claims, it may be appropriate to pursue a consolidated claim set in one application to mitigate risk.
- **Including claims to features that may be required for patentability.** 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. While it is clear that SCC’s safe harbour applies to situations in which division is forced, it remains unclear whether the courts will circumscribe the underlying *Consolboard* decision in the future and narrow the safe harbour. Notably, CIPO’s examination manual, the Manual of Patent Office Practice (MOPOP), indicates that a divisional application is *exempt* from examination for double patenting when its claims “are identical to claims identified by the examiner in the parent application as lacking unity.” [6] If the claims of the divisional are not identical, a double patenting objection may arise if the claims “do not correspond” to the subject matter groupings identified in the unity objection.[7]Caution must therefore be exercised if claims are to be amended following election and division. For example, if subject matter groups A and B are elected and divided, examination for double patenting may occur if the

two claim sets are subsequently amended to recite common feature C (for example, in response to a prior art objection) to yield A+C and B+C. It would be preferable to have feature C included in the claim set prior to the unity objection in order to show that the division forced by the unity objection included consideration of this feature.

- **Adding claims before making an election.** There is no need to elect immediately following a unity objection. Applicants may add claims and request reconsideration of unity to secure a more comprehensive assessment. Although payment of excess claims fees may be required after allowance, this expense may be justified. Once an election has been made, CIPO will restrict examination to the scope of the election and it may not be possible to obtain an assessment of unity for subject matter outside this scope. Importantly, any narrowing amendment made after a unity objection risks being interpreted by CIPO as a so-called "implicit election" that has the same restrictive implications for ensuing examination.[8]

Patentees should be aware that, aside from the SCC's safe harbour, Canadian courts are not required to defer to decisions made by CIPO during prosecution. 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 lawyer familiar with its application.

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. As Canada has no mechanism to enter claim amendments at the outset of a post-grant challenge, including claims to specific commercial embodiments can be particularly important.

On this point, the Federal Court of Canada has also indicated that validity can sometimes rise or fall collectively for embodiments claimed in Markush groupings or in lists of alternatives. That is, the presence of a single invalid element within such a group or list has, at times, been sufficient to invalidate an entire claim.[9,10,11] It is therefore highly recommended to claim commercially important embodiments separately and expressly.

A thoughtful cascading claim set that takes into account 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 payable at the time of the examination request. Examination need not be requested in Canada until four years from the filing date.[12] Deferring examination until closer to this deadline allows applicants time to consider the events of counterpart foreign proceedings as well as commercial developments in order to ensure that important features are incorporated into or retained in the Canadian claim set.

Faced with a looming examination request deadline, 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 be possible to expedite examination after abandonment.

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.

Do not prioritize excess claims fees over all else

While excess claims fees will significantly alter Canadian patent prosecution, avoidance of these relatively modest 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.

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 professionals below.

Footnotes

[1] *Patent Rules*, SOR/2019-251, as amended by SOR/2022-120, in force October 3, 2022.

[2] *Ibid.* s 80(1.1) and s 87(1.1).

[3] *Ibid*.

[4] *Ibid.* s 80(2)(*b*) and s87(1)(*b*).

[5] *Consolboard Inc v MacMillan Bloedel (Saskatchewan) Ltd*, [*Consolboard*] (1981) 1 SCR 504 at p. 537-538.

[6] Canadian Intellectual Property Office, *Manual of Patent Office Practice*, [MOPOP]. (Ottawa: Innovation, Science and Economic Development Canada, 2022). s18.06.04.

[7] *Ibid*.

[8] *Ibid.* s21.07.05.

[9] *Abbott Laboratories v Canada (Minister of Health)*, 2005 FC 1095 at paras 27, 32, and 33.

[10] *Abbott Laboratories v Canada (Minister of Health)*, 2005 FC 1332 at paras 52-7.

[11] *Schering-Plough v Pharmascience* 2009 FC 1128 at paras 90-92.

[12] The Canadian filing date is considered to be the international filing date in the case of a PCT national entry application.

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