Canada’s new excess claims fees vs double patenting

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Navigating the thin line in Canadian patent prosecution

Canada recently introduced significant changes to its patent prosecution system. The main goal is to streamline prosecution as, pursuant to the Canada-U.S.-Mexico Agreement, Canada is required to implement a system of patent term adjustment for delays in the patent office between filing and issuance of a patent. One of the changes, the addition of excess claims fees, is meant to shorten examination time by encouraging submission of more compact claim sets. However, this change also raises risk to patentees as a result of Canada’s strict double patenting prohibition.

Excess claims fees

Patent applications for which examination was requested after Oct. 3, 2022, will incur excess claims fees of C$100 for each claim in excess of 20. 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. The excess claims fee calculation at allowance is based on the greatest number of claims pending in the application *at any time* after the examination request.

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

Canada’s 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.

Double patenting can apply whenever there is potentially overlapping subject matter in two patents. However, divisional patents are particularly concerning. It is not recommended that a divisional application be filed in Canada unless it is 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), there is a safe harbour to a double patenting challenge established by the Supreme Court of Canada. All other divisional applications are vulnerable to double patenting challenges. These vulnerabilities may arise for both the parent and the divisional applications, and patents ensuing therefrom.

However, double patenting risk is not limited to parent-child divisional situations. Any co-pending application that relates to the same or similar subject matter, but includes different claims, could create risk. In these situations, it may be appropriate to pursue a consolidated claim set in one application to mitigate risk.

It also remains unclear whether the courts will narrow the safe harbour in the future.

If the claims of the divisional are not identical to those carved up in the initial unity objection, a double patenting objection may arise if the claims "do not correspond" to the subject matter groupings identified in the unity objection. Caution must be exercised if claims are amended following election and division. For example, if subject matter groups A and B are 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. If this occurs after issuance of one of the claim sets, this will make it more difficult to address in the second application. It would be preferable to have feature C included in the claim set prior to the unity objection (for example, in a multiply dependent claim) in order to show that the initial division between groups A and B forced by the unity objection included consideration of feature C.

Patentees need to be aware that Canadian courts do not 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.

Claim reduction strategies

It is not 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 attempt to engage the SCC's safe harbour against double patenting. 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. This would engage the examiner in an assessment of unity 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** supported by the specification.

- **Adding claims from pending foreign applications and patents** if coverage for these embodiments is not already present in the Canadian claim set.
- **Consolidating claims of co-pending Canadian applications** when appropriate.
- **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.
- **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.

Enforcement considerations for claim reduction

Broad patents claims can help exclude others from entering the claimed territory. However, narrow claims, especially those covering commercial embodiments, can be easier and more cost-effective to enforce. Canada also has no mechanism to enter claim amendments at the outset of a validity challenge.

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. It is therefore highly recommended to claim commercially important embodiments separately and expressly, if possible.

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. Examination need not be requested in Canada until four years from the filing date. Deferring examination until closer to this deadline 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.

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. 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

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. 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.

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