Legislative provisions delineating double patenting would be beneficial for all

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Introduction

The concept of double patenting in Canada continues to be a challenge for patent applicants, patentees, IP practitioners and the Court. The Supreme Court of Canada (SCC) has repeatedly stated that patent law is entirely statutory.[1] As a result, allegations of, and decisions relating to, double patenting point to section 36(1) of the *Patent Act* as the statutory basis for this ground of invalidity. However, section 36(1) provides no guidance as to how to approach or conduct an analysis for double patenting. For example, this section does not identify the date on which double patenting is to be assessed, nor does it set out the nature of the analysis to be undertaken. Section 36(1) of the *Patent Act* reads as follows:

> a patent shall be granted for one invention only but in an action or other proceeding a patent shall not be deemed to be invalid by reason only that it has been granted for more than one invention.[2]

Compare this section with, for example, the sections relating to novelty/anticipation[3] or inventiveness/obviousness,[4] which set out the specific requirements to be met in respect of each of those concepts.

In fact, section 36(1) discusses “a” or one patent – not the two patents required for an assessment of double patenting. It appears to seek the avoidance of multiple inventions claimed in one patent – not the situation in which more than one patent claims the same or similar inventions. The remainder of section 36 addresses, procedurally, how to limit claims in an application that describes more than one invention.

Assuming that this section was indeed intended to set out the prohibition on double patenting, its brevity means that it is the jurisprudence that has defined double patenting in Canada. Accordingly, interested parties have made arguments, and the Court has issued decisions, in respect of only the specific issue and facts at play in any given case. This approach has resulted in an *ad hoc* development of the jurisprudence relating to double patenting, creating uncertainty for all parties.

The development of the concept of double patenting

It is accepted law that double patenting requires a comparison of the claims, not the disclosure of the patents in question.[5] In *Whirlpool,* the SCC noted previous jurisprudence that distinguished between two types of double patenting: same invention-type and obviousness-type.[6] Same invention-type double patenting requires the claims in the two patents to be conterminous. It is rare for this type of double patenting to be analyzed in detail by a Court. There is, therefore, little relevant case law. Before the patent office, where this type of double patenting arises more frequently, the parties must address the issue without clear guidance from the *Patent Act* or the Courts.

However, obviousness-type double patenting (ODP) has been the subject of litigation, and the Courts have issued decisions relating to various aspects of this challenge to the validity of a patent. In the ODP analysis, the question is whether the two inventions are patentably distinct. Courts have held that this test is distinct from the test for obviousness. However, there is little guidance as to what that distinction is.

The Court of Appeal has held that the question is whether there is an inventive step from the first patent to the second, or whether the claims of the second patent could have been included in the first.[7] However, it must be noted that this case arose in the context of patents that did not expire on the same day; one patent application was filed months before the other. The question arises, as it does with many decisions relating to double patenting, whether the findings of the Court in this factual matrix apply to other factual scenarios, such as applications filed on the same date.

Problems with the case law developing on an *ad hoc* basis

One recent example of the impact of developing jurisprudence based only on the specific issue and facts before the Court relates to the long-held distinction between a divisional application that is “forced” by the Examiner through a unity objection as compared to a “voluntary” divisional made solely at the patentee’s discretion during prosecution. In 1981, the SCC in *Consolboard Inc. v MacMillan Bloedel (Sask.) Ltd.,*[8] held that a divisional that was forced by the Examiner during prosecution of the patent application was safe from an allegation of double patenting as compared to a voluntary divisional, which could be challenged. CIPO’s Manual of Patent Office Practice (MOPOP) references this safe harbour.[9] In the recent decision in *NCS Multistage Inc. v. Kobold Corporation,*[10] the Court considered whether the patentee created a divisional based on the unity objections made by the Patent Office or whether it was a voluntary divisional and not forced by the objection. The Court concluded that a divisional filed following an objection pursuant to section 36(2.1) was a forced divisional, whereas one filed following an objection made under section 36(2) was not.[11] Not surprisingly, this conclusion has caused some discussion and concern amongst practitioners because patent practice, including CIPO’s examination practices, has historically not made this distinction.

A further example relates to the fundamental rationale for the concept of double patenting. The “sin” that double patenting is said to address is the improper extension of the monopoly.[12] In other words, filing a second patent application that expires later than the first application but contains claims that are conterminous (same invention double

patenting) or contains nothing more than “bell and whistles” (obviousness-type double patenting), as compared to the first filed application, is said to be improper because it extends the monopoly that the patentee has without requiring the disclosure of anything new and inventive over the first filed application. Consider, then, how it can be said that a divisional patent, which expires on the same day as the parent patent by operation of the statute, improperly extends the monopoly.

Further, and as noted above, there are decisions rendered in respect of a particular factual situation that give rise to questions as to the wider applicability of any given decision to a different factual scenario. The lack of clear legislative guidance results in uncertainty for applicants and patentees.

Conclusion

It may be that the concept of double patenting has survived despite a lack of clear statutory basis because of the Court’s apparent concern that inventors could misuse the patent prosecution process, noted by the Court in *NCS*.[13] If it is assumed that this is indeed a concern, all stakeholders would benefit from legislative amendments that properly define the prohibition on double patenting. In the absence of a clear provision in the *Patent Act*, patent agents and litigants must try to piece together appropriate advice for their clients on the basis of limited jurisprudence that can be amended or overturned by any given decision without notice, and with retroactive effect due to the nature of common law.

Footnotes

[1] See for example, *Apotex Inc. v Sanofi-Synthelabo Canada Inc.*, 2008 SCC 61 at para 12 [hereinafter *Sanofi*].

[2] *Patent Act*, RSC 1985, c P-4, as am, s 36(1).

[3] *Patent Act*, RSC 1985, c P-4, as am, s 28.2(1).

[4] *Patent Act*, RSC 1985, c P-4, as am, s 28.3.

[5] *Whirlpool Corp. v Camco Inc*, 2000 SCC 67 at para 63 [hereinafter *Whirlpool*]. See also *Sanofi*, at para 108.

[6] *Whirlpool*, at para 63-67.

[7] *Mylan Pharmaceuticals v Eli Lilly Canada*, 2016 FCA 119

[8] *Consolboard Inc. v MacMillan Bloedel (Sask.) Ltd.*, [1981] 1 SCR. 504 at para. 536-537.

[9] MOPOP 18.06.04.

[10] *NCS Multistage Inc. v. Kobold Corporation*, 2023 FC 1486; under appeal as of the date of publication [hereinafter *NCS*].

[11] *Ibid.*, at para 1241-1247.

[12] *Whirlpool*, at para 63.

[13] *NCS,* at para 1239-1240.

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