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Double Patenting Under Canadian Patent Law

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Double patenting occurs when the same invention is claimed in more than one patent owned by the same entity. Double patenting is prohibited in most jurisdictions. However, there are unique aspects to double patenting under Canadian practice that may significantly influence patent prosecution strategy in Canada.

Double patenting as shaped by Canadian courts

In Canada, the doctrine of double patenting was raised by Canadian Courts to address situations where two or more patents were issued with claims directed to closely related or identical inventions. Because patents could be staggered in time, double patenting caused an improper extension or "evergreening" of patent term. The underlying public policy of this doctrine is that there can only be one patent for one invention, and that the public should be free to use the invention claimed in the patent, as well as obvious modifications or variants thereof, upon expiration of the patent.

The prohibition against double patenting under Canadian law has two branches [1]:

> "Same invention" double patenting: Whether at least one claim of a second patent is identical or conterminous to at least one claim of a first patent; and
> "Obviousness-type" double patenting: Whether at least one claim of a second patent is obvious or not patentably distinct from at least one claim of a first patent based on common general knowledge in the art at the publication date of the second patent. For example, a claim directed to a composition comprising a drug and an inert pharmaceutical carrier is not considered to be patentably distinct from a claim directed to the drug *per se* [2].

The Federal Court of Appeal recently clarified [the] test for obviousness-type double-patenting [3], emphasizing that contrary to "classical" obviousness analysis, only the claims (i.e. not the entire specification or other pieces of prior art) of the first patent may be applied as "prior art" against the second patent (or application), and any other prior art is only relevant insofar as it contributes to the common general knowledge of the skilled person.

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Although the historical basis for double patenting was often thought to be focused on improper extension of patent term as noted above, the Courts have more recently established that a second patent may be invalidated for double patenting even if it expires on the same day as the first patent, mainly on the basis that the existence of a second patent may still confer some advantages to the patentee, for example the potential listing of multiple patents on the Patent Register of Health Canada under Canada's pharmaceutical patent linkage regime [4]. Therefore, a double patenting issue may still arise between a parent and its divisional case, even though both patents would expire on the same day [5].

Even if a new use or therapeutic indication of a previously patented compound is acceptable under Canadian law [6], double patenting may still occur if the "new" use or indication was considered inherent to the compound, more particularly when a sole utility is taught for the compound in both patents [7].

Similar to the Safe Harbor provision conferred by 35 U.S.C. § 121 under U.S. law, the claims of a divisional patent relating to subject matter that was considered to lack unity of invention by the Canadian Patent Office (CIPO) in the corresponding parent case are shielded from an attack for double patenting, even if it is later determined that the two sets of claims actually do not relate to different inventions [8].

An important point to consider is that Canadian double patenting objections cannot be cured by a "Terminal Disclaimer" procedure, as may be done under U.S. law. Canadian Courts have established that a dedication to the public of certain claims of a patent, a common law-based procedure that allows a patentee to publicly declare that it will not enforce its monopoly, may be an effective way to overcome double patenting attacks if such dedication does not confer any advantage, such as extension of patent term, to the patentee [9].

Practical considerations

It is a relatively common practice in many jurisdictions to voluntarily cancel claims in a parent application to secure allowance of a first patent for claims considered acceptable by the Examiner, and to file a divisional (or continuation) application to pursue the claims cancelled in the parent case. Such a strategy is not recommended in Canada because a double patenting objection will likely be raised against the claims of the "voluntary" filed divisional application. No straightforward strategy exists to overcome such an objection under Canadian practice. In such case, claim amendments and/or arguments are required to convince CIPO that the claims of the divisional application are patentably distinct over the granted parent claims. Thus, the best approach to ensure broad patent protection in Canada in cases where CIPO has not raised a lack of unity of invention objection is to pursue any and all claims of interest in the parent application.

Applicants sometimes file multiple separate applications for highly related subject matter (sometimes with common filing dates). Because of double patenting concerns, this approach is not advisable in Canada. Such Applicants should rather consolidate all claims of interest in a single application and abandon the other applications, whenever possible.

Particular care should be taken when filing requests for accelerated examination under the Patent Prosecution Highway (PPH) based on claims allowed or granted in a foreign jurisdiction, in cases where multiple claim sets are being pursued in multiple related applications in the foreign jurisdiction. In such a case, it may be better to request "regular/special order" (i.e., non-PPH) accelerated examination in Canada, so that all of the foreign claims of interest may be pursued in Canada, not just those that "substantially correspond" to the already allowed or granted foreign claims (a PPH

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requirement).

Ideally, any double patenting issues should be resolved while the two applications in question (*e.g*., parent and divisional) are still pending. However, under certain circumstances, it may be possible to avoid or address double patenting issues by including subject matter rejected in the second application in the claims of the parent patent through reissue proceedings if the parent patent issued less than four years earlier. It is important however to note that the filing of a reissue or disclaimer entails making certain assertions concerning the granted patent (*e.g*., that the patent is somehow defective or too broad) resulting from error, and that the error arose from accident, mistake or inadvertence, which the patentee may find difficult to establish or prefer not to do. Thus, such procedures should only be considered if no other options to address the double patenting issues are available.

Conclusions

Applicants seeking protection in Canada should thus carefully consider the unique aspects of Canadian double patenting practice to avoid being denied otherwise available patent protection.

Please contact us should you require any information regarding Canadian intellectual property matters.

Kindly note that the above commentary is general in nature and cannot be considered to replace legal advice in relation to specific matters.

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1. *Whirlpool Corp. v. Camco Inc*., 2000 SCC 67
2. *Commissioner of Patents* v. *Farbwerke Hoechst A/G.* [1963] S.C.J. No. 66, [1964] S.C.R. 49 at 53; *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.,* [1981] S.C.J. No. 44, [1981] 1 S.C.R. 504 at 536
3. *Mylan Pharmaceuticals ULC v Eli Lilly Canada Inc.*, 2016 FCA 119
4. *GlaxoSmithKline Inc. v. Apotex Inc.* [2003] F.C.J. No. 886, 27 C.P.R. (4th) 114 at paras. 85 to 91
5. i.e. for cases in which the parent application was filed on or after October 1, 1989, which have a patent term that expires 20 years from filing. Thus a parent and its divisional, having the same filing date, expire at the same time under the current system. Pre-October 1989 filed cases expire on the later of 20 years from filing or 17 years from issuance.
6. *Shell Oil Co. v. Canada (Commissioner of Patents)* (1982), 67 C.P.R. (2d) 1 (S.C.C.)
7. Commissioner's Decision No. 1299, 2010
8. *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.,* [1981], *supra*; *Abbott Laboratories v. Canada* (*Minister of Health)* (2009), 77 C.P.R. (4th) 201 at para. 193 (F.C.), revd in part 85 C.P.R. (4th) 279 (C.A.)
9. *Merck & Co. v. Canada* (*Minister of Health)* (2010), 88 C.P.R. (4th) 81 (F.C.); *Abbott Laboratories v. Canada* (*Minister of Health)* (2009), *supra*

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