

Significant Differences Between Canadian and American Patent Law

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Most patent lawyers, familiar with the American patent prosecution system and substantive patent law, assume that, as its largest trading partner and closest neighbour, Canada has essentially the same patent laws as those of the U.S. In fact, Canada's system diverges quite significantly from the American system. In this article, a few of the significant differences will be briefly canvassed. A much more complete overview of contrasts in the two systems has been prepared and is available from any of the co-authors.

First-to-File

From the drafting, filing and prosecution perspective, the single biggest difference between Canadian and American patent law is that, like the rest of the world (but not the U.S.), Canada uses a first-to-file system. This means that establishing the earliest possible claim date (as it is referred to under Canadian patent law) is paramount. The "claim date" for each claim is the date an application is filed in Canada or the priority date, if such priority is properly asserted and is applicable to the subject matter of the claim. If any amendment of a specification takes place between the filing of a priority application and the filing of the corresponding Canadian application, the safest practice is to file the Canadian application as soon as possible so as to obtain the earliest possible claim date, in the event the asserted priority for a particular claim fails.

Canada has a one-year grace period with respect to disclosure directly or indirectly by the applicant, but this can be dangerous, particularly for U.S. applicants, because the grace period is for one year prior to the Canadian filing date. So, for example, an American applicant who has disclosed an invention five months before filing an American application and who files a Canadian application 10 months after the American application, claiming priority from the American application, will find the Canadian application anticipated by the original disclosure which was more than 12 months before the Canadian filing date. Canada is an absolute novelty jurisdiction in respect of disclosures that do not originate from the applicant.

There are other differences that affect how claims and specifications should be drafted, and are generally not well-known to practitioners outside Canada. While it is typical for foreign patent attorneys to simply file a copy of an application as filed in the U.S. or Europe with the Canadian Patent Office, by doing so, practitioners are not taking advantage of the peculiarities of Canadian patent law and are obtaining less for their clients than is properly available.

Applicants

In Canada, unlike the U.S., both natural and juridical persons may apply for patents. It is a requirement that the applicant make a declaration as to entitlement if it is other than the inventor. Such declaration may claim entitlement on any of a number of grounds, including employer-employee relationship, express assignment, agreement, court order, and so on. The declaration may be executed by the applicant or its patent agent.

Requirements of Patentability

To be patentable in Canada, the invention must relate to allowable subject matter and, like the U.S., must be new, inventive and useful. But unlike the U.S., where "anything under the sun that is made by man" is patentable, allowable subject matter is somewhat narrower in Canada. For example, higher life forms are not patentable, while lower life forms are. Scientific principles and abstract theorems are not patentable and neither are patents that relate to professional skill and judgment. The extent to which pure business methods are patentable is presently unclear.

Canadian Claims Strategy

A substantial difference to bear in mind, when filing a Canadian patent application, is that there is no limit to the total number of claims or the number of independent claims that may be included in an application, and there are no restrictions on the use of multiple dependent claims or multiple dependent claims. Also, there are no surcharges for any of those. The only surcharge that exists is for filing an application that exceeds 100 pages in length.

Each claim in multiple dependent claims is treated as a separate claim. Thus, if one were to convert a typical set of one independent claim and four dependent claims (five claims total) to multiple, multiple dependent claims, one would essentially have 16 separate claims. This effect increases exponentially as the number of original claims increases. Since there is no surcharge for additional claims, there is no obstacle to including any claim that may have been deleted from the original U.S. for cost-savings purposes. So, a Canadian application should maximize both the number of claims and the number of multiple dependent claims.

Types of Claims Permitted in Canada

The Canadian Patent Office accepts multiple types of claims for an invention in the same application. A patent may claim a product, a process for manufacturing the product and a use of the product, all within the same patent. Thus, it may be that the claims of several related foreign applications, all based on the same specification, can be combined into a single Canadian application, saving on filing, examination, maintenance and issue fees.

However, while divided claims have become common in certain types of applications in the U.S., particularly computer and communications systems, they are not permitted in Canada. All of the steps in a method, process or system claim must be performed by the same actor. For example, in a claim to a client-server system, all of the steps claimed must be performed either client-side or server-side. It is not permissible to combine both client-side and server-side steps in the same claim. It may, however, be possible to claim them in the same patent as two separate sets of claims.

Restrictions in the Specification

There are certain common inclusions in American specifications that should be removed prior to filing in Canada. For example, American specifications often incorporate, by reference, other material, particularly earlier patents. This is not permitted in Canadian specifications and should be deleted or rewritten in order to avoid an automatic rejection from an Examiner on that basis. The drawings should also be formalized, preferably before filing but, at the latest, before requesting examination, as formal drawings are a requirement for allowance, rather than issue, and a rejection will result if the application relies on informal drawings.

Language

It is not necessary to convert American or British English to Canadian English. Canadian, British or American spellings of words are acceptable and either metric or imperial measurements are permitted.

And of course, in Canada, applications may be filed in either English or French. However, all parts of the application must be in the same language and there is no requirement to translate an English application into French or vice-versa.

Some Final Remarks

In this abridged and edited version, we have touched upon some of the differences between Canadian and American Patent law. While there are also similarities, the differences justify involving a Canadian patent lawyer or agent to conduct a review of an American application before it is filed as a corresponding Canadian application. Such advice is likely to result in broader claims, fewer rejections and faster approvals during prosecution, and more efficient litigation, thereby saving the applicant time, aggravation and expense.

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This is an edited and abridged version of a much lengthier article that is available, without cost or obligation, by contacting any of the co-authors.

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