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## Double Patenting in Canada

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Canadian jurisprudence clearly sets forth a prohibition against double patenting. Double patenting, in Canada, is simply not limited to “same invention double patenting” which applies in situations where the claims are identical or conterminous. There is a second branch of double patenting which is referred to as “obviousness double patenting”. This is a more flexible and less literal test that prohibits the issuance of a second patent with claims that are not “patentably distinct” from those of the earlier patent.

Terminal disclaimers as they exist in the U.S. are not available in Canada, and as such, during prosecution, a double patenting objection can not simply be overcome by filing a terminal disclaimer. Accordingly, when filing voluntary divisional applications, care should be taken to ensure that there is subject matter claimed in the divisional application that is patentably distinct from the claims of the parent application. For example, a double patenting objection may be issued where a specific embodiment is pursued in the parent application and a generic embodiment which encompasses the specific embodiment is pursued in a divisional application. In a recent case, the Federal Court of Appeal (2010 FCA 275) found that the Commissioner of Patents was correct to refuse a patent (divisional) for a compound because a patent (the parent of divisional application) issued for the same compound made by a specific process on the grounds of obviousness type double patenting. Likewise, a double patenting objection may also be issued where a genus is pursued in the parent application and a species is pursued in a divisional application, unless there is a specific advantage in the selection of the species over the genus which has been disclosed in the application.

One option to address any uncertainty regarding whether the claims to be filed on a voluntary divisional application are patentably distinct, is to consider adding the “divisional claims” to the parent application and filing the divisional application in response to a Restriction Requirement from an Examiner. Moreover, Applicants need to be aware of this risk of double patenting when adopting the strategy of withdrawing subject matter in a parent application and filing divisional applications in order to simply expedite allowance of an application. If the subject matter is of particular importance, Applicants should consider continuing prosecution of the subject matter in the parent application.

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