

# PATENT LAW REGIME IN CANADA V/S UNITED STATES

It is not an unspoken fact that Canada and US laws on Intellectual Property run on similar lines yet there are significant differences between laws of both the nations. For the purpose of this paper, I will restrict myself with comparative analysis of Canadian patent law regime and US patent law.

## 1. Eligibility Requirements

Both the countries have distinct eligibilities to file for Patents. In the US, patentability requirement is much simpler and broader as compared to Canada. Canada has narrow spectrum of what can be patented than the US.

- **US patentability requirements:** The invention must be statutory, useful, new and non-obvious.<sup>1</sup>
- **Canada patentability requirement:** The invention should be non-obvious, the first of its kind, it should be a completely new development or an improvement of an existing technology. It can be a product, a composition, a machine, a process or an improvement of any of these.<sup>2</sup>
- **For example,** higher life forms are not patentable in Canada contrary to the situation in the United States. Further, contrary to the United States, it is very difficult and sometimes impossible to patent business methods in Canada unless one uses a great deal of strategy in crafting an application. U.S.-style claims will not necessarily work.

## 2. First-To-File System

Canada is a signatory of Paris Convention and the Patent Corporation Treaty. Under the Canadian Patent regime there exists first-to-file patent system which means that it is integral to have an earliest possible claim date. The claim date is either the filing date of the patent application or the priority date of the patent application. The U.S. has a first inventor to file system that is very similar to Canada. It is possible to file a U.S. provisional application if one wants an early filing date.

As such, Canadian patent applications are laid open for public inspection eighteen (18) months after the application date or earlier if requested in certain situations. Contrary to the United States therefore, there is no way to keep a Canadian patent application confidential.<sup>3</sup> While in the US, non-provisional patent applications are published after 18-months from their earliest priority date for public inspections, whereas provisional patent applications are not published unless converted into a non-provisional application and, hence not available through a public search.

## 3. Grace Period Time Limit

S. 28.2 and 28.3 of Canada's *Patent Act*<sup>4</sup> talks about grace period provided for pre-filing disclosures. These sections cite the disclosure that had occurred “more than one year before the filing date”. The filing date under Canadian application system is different from Convention

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<sup>1</sup> See S. 101-103, *Patent Laws and Regulations*, Title 35, Parts I to IV, United States Code.

<sup>2</sup> S. 2, *Patent Act* (R.S.C., 1985, c. P-4).

<sup>3</sup> Bob H. Sotiriadis, “Differences Between U.S. And Canadian Law Regarding Intellectual Property”, (notes for conference on MCLE Doing Business in Canada. Publication 345, 2006-03-29).

<sup>4</sup> *Supra* note 2.

priority date. However, International patent applications under PCT are Canadian applications if the said national phase is entered within domestic limits of Canada.

Although a Canadian patent application (or PCT application) may also benefit from a priority claim under the Paris convention back to one or more earlier filed applications in other countries, the grace period protecting against self-disclosure in Canada does not benefit from Paris priority. This differs from the grace period in the United States, which does benefit from Paris priority because the US grace period extends backward one year from the effective filing date of the US application (i.e., the earliest priority date).<sup>5</sup>

#### **4. Claiming Patent**

Unlike Canada, in the US patent claim is limited to twenty (20) claims, which means a patentee can have as many as twenty claims on patent, including 3 independent claims.<sup>6</sup> A patentee can file additional claims, but it is subject to their willingness to pay for such claim. However, under Canadian patent law there is no such limitation. An applicant file as many claims as they want without any additional fee payable. The US also offers patentees the option of filing continuation, continuation-in-part and provisional applications which are not available in Canada.

#### **5. Double Patenting**

Canada has rule of issuing single patent for any given invention and when an inventor attempts to obtain more than one patent on the same invention, they said to have attempting to obtain double patent, which is not allowed. When such situation arises Canada patent office will accept only one of such applications. The inventor does not get discretion to decide which application should be accepted. However, in most cases the first application prevents any future applications from issuing. The US has different perspective towards double patenting. Under US patent law terminal disclaimers are placed to limit the expiration period of patents that are alleged to be double patenting. All of the double patented patents share an expiry date so that the 20-year exclusive rights to the invention cannot be extended through the filing of new patent applications related to the same invention.

#### **6. Examination – Only Upon Request**

The Canadian Intellectual Property Office (CIPO) will only examine a patent application in Canada in response to a specific request for examination. The examination fee is payable upon request, and the request can be deferred up to four (4) years from the Canadian application's filing date for applications filed on or after Oct. 30, 2019, and for up to five (5) years for applications filed prior to Oct. 30, 2019. This differs from US practice where US provisional applications only preserve rights for one (1) year, and examination of US non-provisional applications is automatic, and the examination fees are due upon filing or national entry into the US.<sup>7</sup>

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<sup>5</sup> "Patenting In Canada Vs. The United States" (07 November 2019) online: *ATMAC Patent Services*. <<https://atmac.ca/patenting-canada-vs-united-states>>

<sup>6</sup> *Supra* note 1, S. 41.

<sup>7</sup> *Supra* note 5.

## **7. Maintenance Fees**

Annual maintenance fees requirement varies on both nations. In the US maintenance fees are due in 4<sup>th</sup>, 8<sup>th</sup>, and 12<sup>th</sup> year after the patent issue date. On the flip side, maintenance fees for all applications and issued patents is due from the 2<sup>nd</sup> anniversary of the Canadian filing date.

### **Conclusion:**

In broader spectrum it seems that United States' law on patent has wider scope than the Canadian patent law. We saw that patent is defined more broadly under US law. Though filing system is similar in both countries but US maintains confidentiality of patent application if filed through provincial application system and the grace period runs on earliest possible date provision benefitting from Paris provision unlike Canada. While Canada doesn't allow double patenting US do provide for that by granting same expiring date (20-years) to all such patented applications. Even though Canadian patent law seems to be more rigid and narrower than US patent regime but there are certain areas where Canadian law is more flexible when it comes to claiming patent Canada doesn't have any cap on the number of claims, an applicant can file as many number of claims without any additional payments unlike the US where claims are limited to 20 claims only.