



Canada and the U.S.:

Differences in Patent Law

General

- A patent may be invalidated if fees are incorrectly paid at the small entity rate. New regulations that are in their final stages of approval will require that small entity payments are accompanied with a small entity declaration. In order to avoid any possible errors associated with an incorrect entity fee payment, it is recommended that entity fees be paid at the large entity rate.
- Voluntary Divisional applications should not be filed with the Canadian Patent Office. A divisional application should be filed following receipt of a unity of invention objection issued by the Examiner. In order to ensure that a unity of invention objection is raised, additional claims directed to any desired subject matter should be filed as early as possible during prosecution. There are no excess claim fees in Canada. However, maintenance fees on the divisional application are due from the date of filing of the parent application.
- Joint Ownership of Patents: In Canada, a patent co-owner cannot dispose of anything less than their entire interest in the patent (e.g. a license) without first obtaining the consent of the other co-owners. Any form of disposition of a partial interest in a patent, which has the effect of diluting the interest of the other co-owners, requires the consent of such co-owners.

Life Science

- Embryonic stem cells are considered patentable subject matter provided they cannot develop into an animal - for example, totipotent stem cells are not allowed. Pluripotent stem cells, multipotent stem cells, or adult stem cells are acceptable subject matter.
- Animals at any stage of development, from fertilized eggs on, are considered higher life forms and not patentable. Plant are also considered higher life forms and not patentable. Claims to an animal cell or a plant cell are acceptable.
- Organs and tissues are not considered compositions of matter and are not patentable. A Patent Office Notice (June 2006) states that “[o]rgans and tissues are created by complex processes, elements of which require no

human intervention, and do not consist of ingredients or substances that have been combined or mixed together by a person.” However, an artificial organ-like or tissue-like structure, generated by the hand-of-man by combining various cellular components and/or inert components, may be considered to be a composition of matter and patentable.

- Methods of medical treatment are not allowed in Canada. Claims directed to a method of medical treatment may be amended to a "use" format which is accepted in Canada.

Information Technology

- Computer programs per se expressed as lines of code or listings are the subject of copyright protection but software that has been integrated with a traditionally patentable subject matter may be patentable if the traditional criteria for patentability are satisfied. The Patent Office's position is that for a method to be considered a patentable art, the method must be: an act or series of acts performed by some physical agent upon some physical object and producing in such object some change either of character or of condition; and it must produce an essentially economic result relating to trade, industry or commerce.
- Business method-related inventions are not automatically excluded from patentability. Rather, such inventions may be allowable in Canada provided they meet the substantive criteria for inventions as established by the Patent Act and Rules and the decisions of Canadian courts. For example, subject matter that relates to the skills of a professional is not considered patentable in Canada. Business methods implemented as computer programs must also meet the patentability requirements for such subject matter.
- Computer-implemented inventions may be claimed using different claim types. The types typically include: 1. art or process claims (e.g. to a method); 2. machine claims (e.g. to an apparatus or system); and 3. manufacture claims (to a computer program product or computer media embodying code or data structures). At present and contrary to published Patent Office policy, computer programs embodied in a signal medium such as a propagated carrier wave are considered not to relate to patentable subject matter. The policy is presently under review and such claims are being rejected.

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