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8 **Chapter 14 - Unity of Invention**
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13 **Working Draft**
14 (for public consultation)
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24 This document is a draft of a revised chapter of the MOPOP. The Commissioner of
25 Patents has authorized that this draft be released for public review until April 7, 2011,
26 subsequent to which the chapter, in its present or an amended form, may be adopted
27 by the Office as expressing official practice.
28

29 Pending formal approval of this chapter by the Commissioner of Patents, readers
30 should bear in mind that to the extent that the content of this document may differ from
31 content found in the current (i.e. official) version of this chapter, or elsewhere in the
32 MOPOP, this document does not reflect the official practice of the Office
33

34 During the review period, the public is invited to submit any comments pertaining to the
35 content of the draft. Comments may be submitted electronically or in writing, using the
36 coordinates available at the MOPOP Updates web site.
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Chapter 14

Unity of Invention

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Chapter 14 Unity of Invention

14.01 Scope of this chapter

The Canadian *Patent Act* and *Patent Rules* are based in part on the simple premise of *one patent for one invention*.¹ The present chapter is concerned with the assessment of whether or not an application, for the purposes of examination, claims more than one invention, and with the procedures for dealing with an application that does.

The concept of unity of invention refers to the requirement that an application claim *one invention only*. This requirement serves, in part, to ensure that the fees paid by applicants are fairly assessed on a per invention basis.

Requiring that a patent relate to *one invention only* also provides a measure of clarity to the patent system, by constraining the scope of individual patents. A patent specification directed to a single invention is clearer and more readily understood than one that attempts to describe and define several.

The present chapter deals with the subject of unity of invention from two perspectives. First, examination practice respecting the identification of a lack of unity of invention by an examiner during prosecution and second, the framework and requirements for the filing of a divisional application to protect an invention other than the invention to which the claims of its parent application are limited.² The term “parent” is used to refer to an application that describes more than one invention, and which served as the basis for the filing of a further application (a “divisional” application) to protect an invention other than the one ultimately claimed in the parent.

Note that throughout the chapter the term “invention” is used to refer to subject-matter that an applicant alleges to be an invention (an “alleged invention”). Where, when assessing unity of invention, an examiner identifies a plurality of inventions in a claim set, this should not be taken as a suggestion that any of the several inventions thus identified are patentable.

14.02 Unity of invention

The basic framework that governs unity of invention is section 36 of the *Patent Act*, which provides that

(1) *A patent shall be granted for one invention only but in an action or*

1 *other proceeding a patent shall not be deemed to be invalid by reason*
2 *only that it has been granted for more than one invention.*

3
4 Unity of invention has been referred to as “essentially a procedural matter”,³ as it does
5 not of itself give rise to issues of validity. Section 36 of the *Patent Act* also sets out
6 provisions whereby the claims are to be limited to one invention only and any additional
7 inventions described (or described and claimed, as the case may be) may be protected
8 by the filing of separate and distinct applications therefor. Thus

9
10 *(2) Where an application (the “original application”) describes more than*
11 *one invention, the applicant may limit the claims to one invention only, and*
12 *any other invention disclosed may be made the subject of a divisional*
13 *application, if the divisional application is filed before the issue of a patent*
14 *on the original application.*

15
16 and

17
18 *(2.1) Where an application (the “original application”) describes and claims*
19 *more than one invention, the applicant shall, on the direction of the*
20 *Commissioner, limit the claims to one invention only, and any other*
21 *invention disclosed may be made the subject of a divisional application, if*
22 *the divisional application is filed before the issue of a patent on the*
23 *original application.*

24
25 It is important to approach the concept of unity of invention bearing in mind its legal
26 context and purpose, and not to confuse it with the determination of whether or not one
27 invention is “the same” as another such as is done, for example, when assessing
28 novelty or double patenting and during re-issue proceedings.

29 **14.03 Meaning of “one invention only”**

30
31
32 In interpreting section 36 of the *Patent Act*, the term “invention” in the expression “one
33 invention only” is best understood as having a broad meaning along the lines of “act of
34 inventing” or “inventive concept”. Claims that flow from a single act of inventing can be
35 viewed as pertaining to “one invention only”.

36
37 This interpretation of the meaning of the term “invention” in section 36 of the *Patent Act*
38 is reflected in section 36 of the *Patent Rules*, which provides that

39
40 *For the purposes of section 36 of the Act or of the Act as it read*
41 *immediately before October 1, 1989, an application does not claim more*
42 *than one invention if the subject-matters defined by the claims are so*
43 *linked as to form a single general inventive concept.*

1 In interpreting the scope of section 36 of the *Patent Act*, the Courts have ascribed to the
2 term “invention” a meaning different than that provided in section 2 of the *Patent Act*.⁴
3 The Courts thus spoke of claims to matter in different categories of invention as being
4 “aspects of a single invention”. A similar, broad interpretation of the meaning of
5 “invention” has been ascribed by the Courts in considering other provisions of the Act.⁵
6 It is clear that the Courts have considered that the legislative intent of section 36 of the
7 *Patent Act* is not fulfilled by interpreting the expression “one invention only” by giving
8 the term “invention” its definition from section 2 of the *Patent Act*. That is, section 36 of
9 the *Patent Act* should not be understood to say *where an application (the “original*
10 *application”) describes and claims more than one new and useful art, process,*
11 *machine, manufacture or composition of matter [...], the applicant shall [...] limit the*
12 *claims to one invention only [...].*

13
14 Thus, as directed by section 36 of the *Patent Rules*, an application will not be
15 considered to claim more than one invention if the subject-matters defined by the
16 claims are so linked as to form a single general inventive concept.

17 **14.04 Canadian unity standard harmonious with PCT standard**

18
19 The 1996 revision of the *Patent Act* and *Patent Rules* had as one of its objects the
20 harmonization of the Canadian patent framework with the *Patent Cooperation Treaty*
21 standards.⁶

22
23 This can be readily appreciated by comparing the language of section 36 of the *Patent*
24 *Rules* with that of section 13.1 of the *Regulations Under the PCT*, which states that

25
26
27 *The international application shall relate to one invention only or to a*
28 *group of inventions so linked as to form a single general inventive concept*
29 *(“requirement of unity of invention”).*

30
31 The phrase “one invention only” in section 36 of the *Patent Act*, when understood in its
32 full context and in view of section 36 of the *Patent Rules* (as discussed in 14.03), has a
33 meaning equivalent to “one invention only or to a group of inventions so linked as to
34 form a single general inventive concept” in section 13.1 of the *Regulations Under the*
35 *PCT*.

36
37 The result is that the Canadian unity of invention requirement is not “different from or
38 additional to” that provided for in the *Patent Cooperation Treaty*. Identifying a defect
39 arising from non-compliance with the requirements of section 36 of the *Patent Act* does
40 not contravene article 27(1) of the *PCT*.⁷

1 **14.05 General inventive concept**

2
3 Assessing whether or not unity of invention exists in a given claim set amounts to
4 determining whether or not a “single general inventive concept” exists to link the claims.

5
6 The inventive concept can be identified by considering the purpose of the invention.
7 The claimed invention should provide a solution to a practical problem, and claims that
8 define that solution or refinements to that solution (or of how it is to be put into
9 operation or manufactured, as the case may be) may all relate to a single inventive
10 concept. Generally, a set of claims will share a general inventive concept if a set of
11 essential elements which, in combination, are new and unobvious in view of the prior art
12 is common to each claim in the set.

13
14 The inventive concept relates to how a result is obtained (i.e. to the inventive aspects of
15 a practical solution to a problem), and not simply to the idea of obtaining the result *per*
16 *se*. The correct standard to consider is that of unity of invention (i.e. unity among the
17 solutions to a problem), rather than “unity of result”. Mutually unobvious means
18 (practical forms) for achieving a given result will generally not share a single general
19 inventive concept.

20
21 The PCT expresses the concept similarly, in section 13.2 of the *Regulations Under the*
22 *PCT*, which states that

23
24 *Where a group of inventions is claimed in one and the same international*
25 *application, the requirement of unity of invention referred to in Rule 13.1*
26 *shall be fulfilled only when there is a technical relationship among those*
27 *inventions involving one or more of the same or corresponding special*
28 *technical features. The expression “special technical features” shall mean*
29 *those technical features that define a contribution which each of the*
30 *claimed inventions, considered as a whole, makes over the prior art.*

31
32 The expression “special technical features” used in the PCT Regulations refers to novel
33 and unobvious essential elements of the claims.

34
35 **14.06 A priori and a posteriori evaluation**

36
37 As noted in 14.05, claims that have in common a set of essential elements which, in
38 combination, are new and unobvious in view of the prior art satisfy the requirement for
39 unity of invention.

40
41 The two aspects of the unity of invention requirement can be considered separately as:
42 1) the need for a common set of essential elements among the claims, and 2) the
43 requirement that the set of elements be new and unobvious (*i.e.* inventive) over the

1 prior art.

2
3 The former can be assessed without regard to the state of the art, and is referred to as
4 an *a priori* evaluation of unity of invention, whereas the latter requires the state of the
5 art to be considered and is referred to as an *a posteriori* evaluation. A lack of unity of
6 invention is a defect in an application regardless of whether it is identified *a priori* or a
7 *posteriori*.

8
9 A typical approach for assessing whether the claims have unity of invention is to identify
10 the claim with the fewest essential elements, and then check to see if those same
11 elements appear in all the other independent claims. The claims may appear to lack
12 unity of invention *a priori* where no claim defines solely those elements that are
13 common to all the claims [see 14.08.02 for additional guidance on this point].

14
15 In assessing whether a common set of essential elements are present, the language of
16 section 13.2 of the *Regulations Under the PCT* should be borne in mind - that the
17 claims must include “the same or corresponding special technical features”. The
18 concept of “corresponding” means that two claims can have unity of invention even if
19 they do not share a set of precisely identical essential elements, but rather share
20 equivalent elements whose roles in the context of the invention correspond.⁸

21
22 Any prior art relevant for a determination of anticipation or obviousness under the
23 *Patent Act* may be considered in assessing whether unity of invention exists.

24
25 *Example 1:*

26
27 An application discloses a paint containing a rust-inhibiting substance X, a process for
28 applying said paint with substance X and an electrode arrangement A for applying
29 paint. The electrode arrangement is useful for applying paint in general, and is not
30 required in order to apply the paint comprising substance X (the benefits of having
31 substance X in the paint are unrelated to how the paint is applied).⁹

32
33 Claims:

- 34 1. A paint comprising a rust-inhibiting substance X.
- 35
- 36 2. An apparatus for electrostatically charging atomized particles, comprising an
37 arrangement of electrodes A.
- 38
- 39 3. An apparatus for electrostatically charging atomized particles, comprising an
40 arrangement of electrodes A, wherein said apparatus is for painting the paint of
41 claim 1.
- 42
- 43 4. A process for painting an article with the paint of claim 1, said process

- 1 comprising the steps of
2 i) atomizing the paint using compressed air;
3 ii) electrostatically charging the atomized paint using a novel electrode
4 arrangement A; and
5 iii) directing the paint to the article.
6

7 Analysis: An *a priori* assessment of the claims reveals two alleged inventions: the paint
8 comprising substance X and the apparatus including electrode arrangement A. The
9 special technical feature of claim 1 is substance X. The special technical feature of
10 claim 2 is electrode arrangement A. Substance X and electrode arrangement A do not
11 cooperate in any way. Claim 4 includes the technical features of both claims 1 and 2.
12 Claim 3 makes reference to the technical features of both claims 1 and 2, but it must be
13 determined whether the reference to the paint of claim 1 implies a practical limitation to
14 the structure of the apparatus. If the apparatus of claim 2 is suitable for painting the
15 paint of claim 1 (as it seems to be, in view of claim 4), then claim 3 does not define a
16 distinct apparatus and would lack unity of invention with claim 1 despite the reference to
17 that claim.
18

19 There is an *a priori* lack of unity between claims 1 and 2, since the two claims do not
20 share a technical feature in common. Unity of invention does exist between claims 1
21 and 4 (on the basis of the paint comprising substance X) and between claims 2, 3 and 4
22 (on the basis of the electrode arrangement A).
23

24 Note that while claim 4 can be included in an application with either claim 1 or claim 2, if
25 it was maintained in the parent and filed in a divisional application the result would be
26 double-patenting. Therefore, the subject-matter of claim 4 may be included in the
27 claims of the parent or of the divisional, but not both.
28

29 *Example 2:*

30 The application describes a computer monitor comprising elements A and B, and
31 further discloses that additional elements C and D lead, respectively, to particular
32 advantages.
33

34 A search of the prior art reveals document D1, which discloses a computer monitor
35 comprising elements A and B.
36

37 Claims:

- 38 1. A computer monitor comprising elements A and B.
39
40 2. A computer monitor according to claim 1, further comprising element C.
41
42 3. A computer monitor according to claim 1, further comprising element D.
43

1 The claims meet the requirement for unity of invention on an *a priori* assessment, since
2 elements A and B are common to each claim. In view of D1, however, these elements
3 do not provide a general inventive concept that links the claims. To the extent that
4 elements C and D have each been disclosed as leading to particular (and mutually
5 unobvious) advantages, claims 2 and 3 are directed to distinct inventions that lack unity
6 of invention *a posteriori*.

7
8 If, on the other hand, it is clear from the description and/or the prior art that features C
9 and D do not provide inventive solutions to any practical problem facing the art, such
10 that D1 renders claims 2 and 3 either anticipated or obvious, then only the consequent
11 defects under sections 28.2 and/or 28.3 of the *Patent Act* should be identified. No
12 defect under section 36 of the *Patent Act* should then be identified, although the
13 examiner may note the potential lack of unity that might exist once the prior art defects
14 are addressed [see 14.07.04].

15 16 **14.07 Examining for unity of invention**

17
18 The Office takes the position that the intent of subsection 36(1) of the *Patent Act* is that
19 where an application describes and claims more than one invention, the claims require
20 amendment so as to define one invention only. A lack of unity of invention among the
21 claims is identified as non-compliance with subsection 36(1) of the *Patent Act* and the
22 applicant is notified of the defect and requisitioned to correct it or to submit arguments
23 as to why the claims do comply with section 36 of the *Patent Act*. This notification is
24 made in an examiner's report issued under subsection 30(2) of the *Patent Rules*.

25
26 Given that, where a lack of unity of invention has been identified, the examiner cannot
27 be certain which invention the applicant will elect, a report identifying non-compliance
28 with section 36 of the *Patent Act* need only identify this defect. This is an exception to
29 the usual requirement that a requisition under subsection 30(2) of the *Patent Rules* be
30 based on a comprehensive examination [see section 13.05 of this manual]. In this
31 sense, addressing a question of unity of invention can be viewed as a procedural matter
32 to be resolved separately from the substantive examination of the application.

33
34 Where the applicant responds to a requisition identifying a lack of unity of invention by
35 amending the claims in such a manner as to overcome the defect, this determines for
36 that application the *one invention only* referred to in subsection 36(2) of the *Patent Act*.
37 Thereafter, *any other invention disclosed may be made the subject of a divisional*
38 *application*. The Office takes the position that, in accordance with subsection 36(2) of
39 the *Patent Act*, the claims of the application under examination may no longer be
40 directed to the matter of any other invention disclosed. In responding to an examiner's
41 report identifying a lack of unity of invention, the applicant effectively has the right to
42 elect, one time only, the identity of the *one invention only* that will be the subject of
43 examination in a given application.

1 To avoid prolonged debate over unity of invention, where an examiner considers that
2 the claims lack unity of invention and the applicant declines to limit their claims to a
3 single invention, the examiner may refer the application to the Commissioner of Patents
4 for a determination of the issue. Typically, such a referral will not occur until the
5 examiner has advised the applicant of the defect in at least two reports.
6

7 This referral will not take the form of a Final Action, since:

8
9 (a) should the applicant limit the claims to one invention only in response
10 to a Final Action, subsection 30(5) of the *Patent Rules* would require the
11 examiner to withdraw the rejection; this should generally result in
12 allowance of the application, but in the case of a lack of unity of invention
13 the claims would generally not have been fully examined; and
14

15 (b) should the Commissioner conclude after a review in accordance with
16 subsection 30(6) of the *Patent Rules* that the application does not comply
17 with subsection 36(1) of the *Patent Act*, no further amendment of the
18 application would be possible in view of section 31 of the *Patent Rules*.
19

20 Where the Commissioner reviews the application and has reason to believe that it
21 complies with section 36 of the *Patent Act*, the examiner will resume prosecution and
22 consider all the claims on file.
23

24 Where the Commissioner reviews the application and has reason to believe that it does
25 not comply with section 36 of the *Patent Act*, a letter will be sent to the applicant
26 directing that the claims be limited to *one invention only*. This direction will be made
27 under authority of subsection 36(2.1) of the *Patent Act*, and is not a requisition under
28 section 30 of the *Patent Rules*.
29

30 Where the applicant's amendments in response to the letter satisfy the Commissioner
31 that the application complies with section 36 of the *Patent Act*, examination of the
32 application will continue. If the applicant's amendments in response to the letter fail to
33 satisfy the Commissioner that the application complies with section 36 of the *Patent*
34 *Act*, the application may be refused under section 40 of the *Patent Act*.
35

36 **14.07.01 Content of the report**

37
38 Whenever a report is written that identifies lack of unity of invention as a defect, an
39 indication must be included in the report as to the extent of the search and examination
40 performed on the application as a whole.
41

42 As noted in 14.07, a report identifying a lack of unity may be limited in scope to address
43 only that defect. This will usually be the case where a lack of unity is identified at the

1 outset of prosecution. Where a lack of unity is identified later in prosecution, the facts
2 of the case may be such that it is more efficient to identify this defect in parallel with a
3 comprehensive examination of some or all of the claims, rather than interrupting the
4 substantive examination in order to deal with the unity of invention defect alone.

5
6 Even where a lack of unity of invention is identified as a defect at the outset of
7 prosecution, if the examiner believes (for example, in view of corresponding patents
8 issued in other jurisdictions) they know which group of claims an applicant will elect for
9 prosecution, they may include in their report an identification of all the defects
10 associated with these claims. The choice of the examiner does not replace the
11 applicant's right to make their one-time election [see 14.07]. If the applicant elects a
12 different group of claims for prosecution from the one the examiner chose to examine,
13 prosecution proceeds on the basis of the claims elected by the applicant.

14
15 Where there are defects in the application that affect the determination of unity of
16 invention, an examiner may refer to these defects in addition to or instead of the lack of
17 unity defect and should set out how the other defects impact the assessment of unity of
18 invention or vice versa. Defects such as lack of clarity in the claims, or prior art that
19 leads to a conclusion of *a posteriori* lack of unity of invention are illustrative of the types
20 of additional defects whose resolution may impact the determination. To avoid
21 confusion as to the necessary response by the applicant, it may be preferable to
22 identify such defects informally (e.g. in the preamble of the report, or by otherwise
23 explicitly indicating that the defect is not being formally identified), solely to explain the
24 impact they had on assessing unity of invention.

25 26 **14.07.02 Explaining a lack of unity defect**

27
28 A report identifying a lack of unity of invention should explain the basis for the
29 conclusion in a manner that will enable the applicant to decide whether and how to limit
30 or divide their claims for further prosecution. This explanation should identify what the
31 examiner considers the various distinct inventions to be, and should provide sufficient
32 detail so that the applicant can understand why the different inventions do not share a
33 single general inventive concept.

34
35 Wherever possible, the individual inventions identified should be related to the claims in
36 which they are defined, so that the applicant can group their claims into sets which
37 would be viewed by the Office as sharing a single general inventive concept. Other
38 than in exceptional cases, the examiner will set out groups of claims that are
39 considered to be directed to "one invention only". When creating such groups, the
40 examiner should clearly indicate to which group each independent claim belongs.
41 Unless an explicit indication has been made by the examiner with respect to a given
42 dependent claim, the applicant may presume that a dependent claim belongs to the
43 group in which the claim it refers to is found.

1 Where a lack of unity exists among the alternatives defined in a single claim, the
2 examiner will, to the extent practical, separate the various inventions into groups. In
3 such a case, unless otherwise indicated by the examiner, a dependent claim belongs to
4 the group in which the alternative it refers to is found.

5
6 As a general rule, if the applicant limits the claims in the application to one group of
7 claims identified by the examiner, the application will be considered to have been made
8 compliant with section 36 of the *Patent Act*. Certain exceptions to this general rule
9 exist, however, such as where a further lack of unity of invention subsequently becomes
10 apparent in view of prior art discovered during a search performed after the applicant
11 has elected a group of claims for prosecution.

12
13 Note that in identifying the various inventions in a claim set, the term “invention” is used
14 as a matter of convenience only, and in no way implies that the subject-matter of any
15 given claim is patentable.

16 17 **14.07.03 When a lack of unity defect can be identified**

18
19 In general, a lack of unity of invention should be identified in the first report written in
20 respect of the claims that lack unity of invention.

21
22 In some cases, an examiner may identify defects in an application that bear on the
23 question of whether the claims have unity of invention (e.g. obviousness, ambiguity,
24 lack of utility or of support). Where the applicant’s response in respect of the other
25 defects is germane to its evaluation, it is permissible for the lack of unity of invention
26 defect to be formally identified in a later report. Whenever possible, the applicant
27 should be advised that the other defects bear on the question of unity of invention.

28
29 Since unity of invention is assessed in view of the claims of the application, a lack of
30 unity of invention may be introduced when amendments are made to the claims.
31 Where a lack of unity of invention is introduced by the applicant with an amendment, an
32 examiner may identify the resultant defect regardless of the length of prior examination
33 of the application.

34
35 Where prior art raises the possibility of a *posteriori* lack of unity, but some of the claims
36 in the application are considered by the examiner to be anticipated or obvious in view of
37 the cited prior art, it may be preferable to not identify the lack of unity of invention as a
38 formal defect until the prior art defect has been addressed by the applicant. The
39 applicant’s response to the prior art defect may advance the examiner’s understanding
40 regarding unity of invention. The examiner may draw the applicant’s attention,
41 informally [see 14.07.02] and depending on the circumstances, to the potential unity
42 defect.

1 If the applicant responds to a prior art objection by amending the claims, and the claims
2 as amended appear to avoid the cited prior art but to lack unity of invention, an
3 examiner may identify the resultant defect.

4 5 **14.07.04 Responding to a requisition**

6
7 As with any requisition sent under subsection 30(2) of the *Patent Rules*, an applicant
8 may respond to the identification of a lack of unity of invention by amending the
9 application in order to comply with subsection 36(1) of the *Patent Act* or by submitting
10 arguments as to why the application already does comply.

11
12 Where the applicant amends the claims by limiting them to claims falling within a single
13 group identified by the examiner, the lack of unity defect identified in the report will be
14 considered to have been overcome in respect of those claims [see 14.07.02].

15
16 Should the applicant agree that there is a lack of unity of invention among the claims,
17 but disagree as to the grouping of claims set out by the examiner, they may respond to
18 the requisition by identifying groups of claims different from those identified by the
19 examiner and electing one of those groups of claims.

20
21 Where the applicant's response to the requisition does not serve to make the claims
22 compliant with the requirement for unity of invention, a further report may be sent.

23 24 **14.07.05 Election of an invention**

25
26 The applicant will be considered to have elected an invention whenever, subsequent to
27 a report in which a lack of unity of invention was identified as a defect, the applicant
28 limits the claims to fewer inventions than were defined in the claim set with respect to
29 which the lack of unity of invention was identified. It is not necessary for the applicant
30 to explicitly state that they have "elected the invention of Group A" when making an
31 election (although this may certainly be done by the applicant, in the interest of greater
32 clarity).

33
34 Where the applicants initial election limits the claims to a single invention, this defines
35 the *one invention only* referred to in subsection 36(2) of the *Patent Act* [see 14.07].

36
37 Where the applicant initially elects more than one group of claims identified by the
38 examiner, or claims belonging to more than one group of claims identified by the
39 examiner, or even submits new claims entirely, any further election that may be
40 necessary (i.e. should the initially elected claims still lack unity of invention) must be
41 made from among the inventions defined in the initially elected claim set.

1 **14.07.06 Referral to the Commissioner of Patents**

2
3 As noted in 14.07, where an examiner considers that the claims lack unity of invention
4 and has notified the applicant of this conclusion, but the applicant declines to limit their
5 claims to a single invention, the application may be forwarded to the Commissioner of
6 Patents for a determination of the issue.

7
8 Resolving questions of unity of invention should be conducted efficiently, since the
9 substantive examination of the application is delayed by this procedure. Consequently,
10 if an applicant has been notified of a lack of unity of invention defect in at least two
11 reports they should expect that a referral to the Commissioner could be made without
12 further notification.

13
14 To ensure consistency and fairness, where an examiner considers that an application
15 should be referred to the Commissioner, they must first submit the application for
16 review by a Unity Review Board (URB). This board will review the application in order
17 to ensure the lack of unity defect was correctly identified and clearly articulated to the
18 applicant, so that the applicant was in a position to successfully respond to the
19 examiner's requisition.

20
21 Where the URB considers that unity of invention exists, the examiner will proceed with
22 the substantive examination of all claims on file.

23
24 Where the URB considers that a lack of unity of invention exists, but that further
25 clarification of the matter is necessary (e.g., further reasons for concluding a defect
26 exists, or additional information regarding the identity of acceptable claim groups), the
27 examiner will issue a further report taking into account the observations of the URB.

28
29 Where the URB considers that a lack of unity of invention exists, and has been clearly
30 communicated to the applicant in an examiner's report such that the applicant could
31 have responded successfully to the examiner's requisition, the application will be
32 forwarded to the Commissioner of Patents for consideration.

33
34 Where the Commissioner considers it appropriate, the applicant will be directed to limit
35 the claims under authority of subsection 36(2.1) of the *Patent Act*. A Notice of Direction
36 will then be sent to the applicant by the Commissioner.

37
38 Where the applicant's response to the Notice of Direction does not satisfy the examiner
39 that the application complies with section 36 of the *Patent Act*, the application will be
40 forwarded to the Patent Appeal Board for a final review. At this stage, the process
41 resembles the review of a Final Action [see chapter 21 of this manual], given that the
42 Patent Appeal Board may recommend that the Commissioner refuse the application
43 under section 40 of the *Patent Act*. In accordance with subsection 30(6) of the *Patent*

1 *Rules*, an application will not be refused without the applicant being given an
2 opportunity to be heard.

3 4 **14.08 Specific guidance**

5
6 The following sections provide more specific guidance on assessing unity of invention.

7 8 **14.08.01 Claims in different categories of *invention***

9
10 In general, it can be presumed when assessing unity of invention *a priori* that claims in
11 the following categories of invention will satisfy the requirements of section 36 of the
12 *Patent Rules* when present in a single application:

- 13
14 (a) a product and a process for making that product;
15 (b) a product and a use (or method of using) that product;
16 (c) a product, a process for making that product, and a use of that product;
17 (d) an apparatus and a process carried out on that apparatus.

18
19 Where the “process for making a product” of (a) or (c) is a “process carried out on an
20 apparatus” within the meaning of (d), claims to the apparatus can be included in a
21 single application with claims to the product, process for making the product and use of
22 the product so long as the product is inventive by reason of properties that arise by
23 virtue of its being prepared using the apparatus.

24
25 Note that it is not required that the scope of the claims to subject-matter in different
26 categories of invention be of similar breadth in order to satisfy the requirement of unity
27 of invention. Where the scopes are equivalent, unity will generally exist *a priori*. Where
28 the scopes are different, unity may still exist.

29
30 For example, a broad process to use products could have unity of invention with a
31 narrow product claim defining only a limited number of the products used in that
32 process (see Example 2, below).

33 34 *Example 1:*

35
36 An application discloses a fuel burner wherein the use of inlets arranged tangentially to
37 the mixing chamber results in better mixing and more efficient combustion.¹⁰

38
39 Claims:

- 40 1. A fuel burner comprising tangential fuel inlets into a mixing chamber.
41
42 2 A process for making a fuel burner, comprising the step of forming tangential
43 fuel inlets into a mixing chamber.

- 1 3. A process for making a fuel burner comprising casting step A.
- 2
- 3 4. An apparatus for carrying out a process for making a fuel burner, comprising
- 4 feature X which causes the formation of tangential fuel inlets.
- 5
- 6 5. An apparatus for carrying out a process for making a fuel burner comprising a
- 7 protective housing B.
- 8
- 9 6. A process of manufacturing carbon black, comprising the step of tangentially
- 10 introducing fuel into a mixing chamber of a fuel burner.
- 11

12 Analysis: Unity of invention exists, *a priori*, among claims 1, 2, 4, and 6. The special
13 technical feature common to these claims is the tangential fuel inlets. Claims 3 and 5
14 lack this feature, or a corresponding feature [see 14.06], and therefore lack unity of
15 invention both with respect to each other and to the remaining claims.

16
17 *Example 2:*

18
19 An application discloses the discovery that certain compounds, some novel and others
20 known, are useful as plant growth regulants. The compounds are disclosed as a genus
21 (a family of molecules) of common formula A, which comprises specific molecules a_1 ,
22 a_2 , a_3 , ..., a_n . Compounds belonging to the sub-genus A' are disclosed as being novel,
23 and a_1 is taught as a particularly preferred embodiment.

24
25 Claims:

- 26 1. A plant growth regulant composition comprising a compound of formula A and
- 27 a carrier.
- 28
- 29 2. A compound of formula A'.
- 30
- 31 3. Compound a_1 .
- 32

33 The claims all define compounds that share a common structure that is responsible for
34 their plant-growth regulant properties. The discovery that this structure results in plant-
35 growth regulant properties (i.e. the new use of compounds A) is the single general
36 inventive concept linking the claims. There is *a priori* unity of invention among claims 1
37 to 3.

38
39 **14.08.02 Unity without a claim to the inventive linking feature**

40
41 Since unity of invention is initially assessed *a priori* in view of the claims and before the
42 prior art is considered, a lack of unity of invention may be identified in a report where
43 the subject-matter of the claims does not appear to share a single general inventive

1 concept.

2
3 As noted in 14.05, a single general inventive concept is identified by finding common
4 essential elements among the various claims. This is generally done by identifying the
5 claim with the fewest essential elements, and then checking to see if those same
6 elements appear in all the other independent claims. The claims may appear to lack
7 unity of invention *a priori* where no claim defines solely those elements that are
8 common to all the claims.

9
10 An applicant is not required to claim the entire scope of their invention, however, so a
11 claim defining only the common essential elements is not required in order to provide a
12 linking inventive concept. In performing an *a priori* assessment of unity of invention, an
13 examiner must consider the teachings of the description and the common general
14 knowledge in the art before concluding that the claims clearly lack a single general
15 inventive concept. If the description clearly identifies a set of essential elements
16 common to all the claims as being the general inventive concept, unity of invention *a*
17 *priori* should be acknowledged.

18
19 Where an examiner identifies a lack unity of invention *a priori*, an applicant may
20 respond to a report identifying this defect by identifying those features which they
21 consider to be the inventive essential elements common to all their claims. The
22 examiner may subsequently verify this assertion by performing a search on the basis of
23 those elements.

24
25 *Example 1:*

26
27 The application as filed discloses a class of compounds of formula X wherein all
28 members of X are aliphatic organothiophosphates, methods for preparing compounds
29 of formula X and uses of compounds of formula X as insecticides. The description
30 does not suggest that the class of compounds forms part of the invention.

31
32 **Claims:**

- 33 1. A method of preparing a compound of formula X by combining a compound
34 of formula A with a compound of formula B.
35
36 2. The use of a compound of formula X as an insecticide.

37
38 **Analysis:** An *a priori* assessment of unity of invention presumes the features defined in
39 the claims are those necessary to render the claims novel and inventive. Independent
40 claims 1 and 2 have compounds of formula X in common, but since such compounds
41 have not been claimed it will be presumed (in view of the description) that they are not
42 an invention in and of themselves. The claims therefore appear to lack unity of
43 invention on an *a priori* basis. Note that no presumption exists that claims to a “method

1 of preparing X” and to a “use of X” share unity of invention [see 14.08.01 for the
2 combinations of claims for which a presumption of unity of invention exists].
3

4 If the applicant considers that the class of compounds of formula X are, in fact, novel
5 and inventive, they could respond to a report identifying the apparent lack of unity of
6 invention by asserting that fact. A search of the prior art on the compounds of formula
7 X would validate this assertion. If such a search failed to disclose any relevant prior art,
8 no further searching in respect of the claims would be necessary. If the search
9 identified relevant prior art, the claims would lack unity of invention *a posteriori*.

10
11 *Example 2:*

12
13 The application as filed discloses that a class of known compounds of formula X,
14 wherein all members of X are 3,4-substituted indoles, are 5HT receptor antagonists and
15 are useful as migraine therapeutics and anti-depressants. The usefulness of 5HT
16 receptor antagonists in treating both migraine and depression is known in the art, but
17 the 5HT-antagonist activity of compounds of formula X had not previously been
18 identified.

19
20 **Claims:**

- 21 1. The use of a compound of formula X as a migraine therapeutic.
- 22
- 23 2. The use of a compound of formula X as an anti-depressant.
- 24

25 **Analysis:** The general inventive concept resident in both claims is the discovery that the
26 compounds of formula X are 5HT receptor antagonists. Although this feature is not
27 explicitly defined in each claim, it is understood in view of the description to be the basis
28 of the invention. When read in light of the description, the claims have unity of
29 invention *a priori*.

30
31 **14.08.03 Unity of invention and utility**

32
33 An invention is something that is, *inter alia*, new, inventive and useful. The utility of
34 claimed subject-matter can be indicative of whether one is dealing with a single
35 invention or multiple inventions.

36
37 An applicant must establish the utility of their invention by either demonstration or
38 sound prediction [see section 12.08.03 of this manual]. In cases where utility is being
39 established by sound prediction, the nature of the prediction can inform the unity of
40 invention inquiry. Where the claims include many embodiments, and the utility of all of
41 these could be soundly predicted using a single line of reasoning founded on a single
42 set of facts, it is likely that unity of invention exists among the claims. In contrast, if
43 different parts of the claimed matter would require significantly different sound

1 predictions to support their utility, it is likely that the claims include multiple inventions
2 and that there is a lack of unity of invention.¹¹

3
4 Where different embodiments within a given category of invention are claimed (e.g.
5 species within an inventive genus), and the embodiments all share a generic utility, they
6 may be viewed as aspects of a single invention. Where one embodiment has a
7 significantly different utility than the others, it may also be viewed as a different
8 invention. Consider a drug of generic formula X for treating asthma and a species A
9 within the genus, where A has significantly different utility from a typical drug X.

10
11 If the substantially different utility exists in addition to the generic utility, the embodiment
12 can be viewed both as an aspect of a single, larger invention and as a separate
13 invention. Such a circumstance arises, for example, in the case of inventions with
14 different levels of preferred embodiments and unity of invention would typically exist in
15 such a case. Consider that species A treats asthma, but without a side-effect common
16 to drug X in general. A is an inventive selection from X, and could either be claimed in
17 a separate application or in the same application as the genus X.

18
19 If the substantially different utility exists in place of the generic utility, however, the one
20 embodiment does not have the same utility as the other embodiments and is, by
21 consequence, a different invention. Unity of invention would typically not exist in such a
22 case. Here, species A turns out to be a very good decongestant but is not useful in
23 treating asthma. It does not share unity of invention with the genus X.¹²

24 25 **14.08.04 Markush groups and lists of alternatives**

26
27 A Markush group must define a list of alternatives that, for the purposes of the claimed
28 invention, can be viewed as technical equivalents that perform the same function in
29 substantially the same way. The person skilled in the art should expect that one
30 member of a Markush group is directly substitutable for another in operable
31 embodiments of the invention. A Markush group is identified by the form “an
32 [alternative] selected from the group consisting of [a₁, a₂, a₃, a_{n-1}], and [a_n]”.

33
34 Markush groups are most common in the chemical arts; a group of chemical
35 compounds may be appropriately defined in a Markush group if each alternative has a
36 common property or activity and either

- 37 (a) shares a common structure with all other alternatives, wherein the shared
38 structure is relevant to the activity of the alternatives in the invention; or
39 (b) belongs to a class of compounds recognised in the art to which the
40 invention pertains and all members of the group would be expected to
41 behave the same way in the context of the invention.

42
43 Where the alternatives defined in a Markush group do not satisfy the requirements of

1 (b), and where unity of invention cannot be established by elements in the claim other
2 than the Markush group, either the shared structure referred to in (a) or its utility in the
3 context of the invention would need to be novel and inventive over the prior art in order
4 to provide unity of invention to the claimed alternatives.
5

6 Where a list of alternatives satisfies the requirements set out above, unity of invention
7 will generally be acknowledged whether the alternatives are claimed in the form of a
8 Markush group or not.¹³
9

10 **14.08.05 Intermediates and final products**

11
12 An intermediate that is physically or chemically transformed to produce a final product
13 may be considered to have unity of invention with the final product, despite that the
14 inventive step and utility that support the patentability of the intermediate and final
15 product may be quite distinct from each other.
16

17 The intermediate must, necessarily, be useful for producing the final product. It may
18 also have the same utility as the final product, although this is not required.
19

20 To have unity of invention with the final product, the intermediate should share with the
21 final product the principal structural elements of the final product or should serve to
22 introduce to the final product a structural element that is essential to its utility. Different
23 intermediates that introduce different structural parts to the final product, however, will
24 generally not be considered to share unity of invention amongst each other.¹⁴
25

26 Furthermore, the intermediate must be a direct precursor to the final product, in the
27 sense of being removed from the final product by only one or a few steps, and must not
28 be a precursor to a subsequent intermediate that is known in the art and that must be
29 produced on the way to the final product.¹⁵
30

31 The concept of “intermediates and final products” is common in chemical synthesis, but
32 could apply in other arts as well.
33

34 Chemical examples of intermediates and final products that could be considered to
35 have unity of invention include:
36

- 37 (i) a biologically inactive compound (the intermediate) that is deprotected to
38 produce an active drug (the final product). The deprotection renders the final
39 product active, but the overall structure of the intermediate and the final product
40 are otherwise almost equivalent;
- 41 (ii) an intermediate in a multi-step synthesis that contains a structure which, upon
42 ring-closing, produces a critical functionality in a final product, where the final
43 product is prepared by reacting the intermediate with a polycyclic aromatic

1 compound and subsequently ring-closing the structure introduced by the
2 intermediate. The intermediate and the final product have very different
3 structures, since the intermediate does not include the polycyclic scaffold of the
4 final product. Nevertheless, the critical element of the final product results
5 directly from the intermediate, and there are no known intermediates produced in
6 the synthetic steps leading from the claimed intermediate to the final product.
7

8 *Example 1:*

9
10 An application discloses an industrially useful triazole compound defined by formula I,
11 and a method for its preparation by ring-closure of a compound of formula II. The
12 critical structure in the triazole product is the combination of the triazole ring (sub-
13 structure A) with proximal substituted aromatic rings (structures B and D). The
14 necessary stereochemistry of the groups A, B and D is provided by a central ring
15 structure C. The description teaches that the ring structure C can be formed by a ring-
16 closing reaction of functional groups E and F, which are present in the immediate
17 precursor to the final product. The only disclosed utility of the intermediate is in the
18 production of the final product.
19

20 Claims:

- 21 1. A compound of formula I comprising sub-structures A-B-C-D.
- 22
- 23 2. A compound of formula II comprising sub-structures A-B-E-F-D.
- 24

25 Analysis: Although the core structures of compound I (final product) and compound II
26 (intermediate) differ considerably, compound II is an open-ring precursor to compound
27 I. Both compounds share common essential structural elements, namely the triazole A
28 and the substituted aromatic rings B and D. The intermediate structure E-F is, from a
29 chemical perspective, a known precursor for rings of type C. The two structures are,
30 overall, technically closely interrelated and unity of invention exists.¹⁶
31

32 *Example 2:*

33
34 An application discloses two structurally related molecules A and B. Molecule A is a
35 compound with analgesic properties. Molecule B results from selective methylation and
36 acylation of two hydroxy groups on A. Compound B is not an effective analgesic, but
37 has significant bioactivity as a sedative.
38

39 Claims:

- 40 1. A compound of structure A.
- 41
- 42 2. A compound of structure B.
- 43

1 3. A method for converting compound A into compound B through sequential
2 selective methylation and acylation, comprising the steps [...].

3
4 4. A use of A as an analgesic.

5
6 5. A use of B as a sedative.

7
8 Analysis: Compound A is an intermediate that is structurally similar to compound B.
9 Claims 1 and 2 share unity of invention, and share unity of invention with claim 3.

10
11 Claim 5 defines the use of compound B, and shares unity of invention with claims 2 and
12 3 (a product, process to produce the product and use of the product - see 14.08.01).
13 Although claim 5 doesn't clearly share unity of invention with claim 1, claims 1, 2, 3 and
14 5 would typically be considered to have unity of invention in a single application
15 (intermediate to produce B, compound B, process to produce B, and use of B).

16
17 Claim 4 lacks unity of invention with claims 2, 3 and 5 as it defines a use of
18 intermediate A other than its use in preparing the final product or an equivalent use to
19 the product's. Claim 4 (use of A) does share unity of invention with claim 1
20 (intermediate A). If desired, claim 3 could be included in an application with claims 1
21 and 4 (considering claim 3 to be a use of A), although in practice it would usually be
22 preferable to include claim 3 in the same application as claims 2 and 5 (considering
23 claim 3 to be a process to produce B).¹⁷ Claim 4 could be claimed in a divisional
24 application.

25 26 **14.08.06 Multi-step methods of preparation**

27
28 Some preparative methods will include more than one step that could be patentable
29 independently of the multi-step preparative method as a whole. This applies particularly
30 to multi-step synthetic methods, although in principle the concepts could apply to any
31 multi-step preparative method (e.g. a method of manufacturing).

32
33 For the purposes of unity of invention, an application can include a claim to a single
34 inventive transformative step in a method and to any larger method involving that step
35 up to the entire multi-step method. The utility of the transformative step arises from it
36 transforming a precursor (which will be a starting material or intermediate in the overall
37 method) into a product (which may be a further intermediate in the method or its final
38 product). The transformative step will also typically share unity of invention with its
39 product, and may share unity of invention with certain of the product's precursors (see
40 14.08.05).

41
42 Other individual steps in the method (or combinations of steps that don't include the
43 inventive transformative step), however, will not have unity of invention with the

1 inventive transformative step. The other step or combinations of steps do not share the
2 general inventive concept of transforming the inventive transformative step's precursor
3 into its product. Products other than those meeting the "intermediate and final product"
4 requirements set out in 14.08.05 will likewise be considered not to share unity of
5 invention with the inventive transformative step and its product.
6

7 Consider a multi-step synthesis involving the following steps:

- 8
9 step A transforming 1 into 2;
10 step B transforming 2 into 3;
11 step C transforming 3 into 4;
12 step D transforming 4 into 5; and
13 step E transforming 5 into 6.
14

15 The applicant considers steps A and D to be inventive, as well as the 5-step method as
16 a whole. Starting material 1 and intermediates 3 and 4 are known, while intermediates
17 2 and 5 and final product 6 are novel.
18

19 The application includes claims to step D, to step E, and to intermediate 5 and the
20 closely structurally-related final product 6. Unity of invention can be acknowledged
21 among these claims as involving an inventive product (5), a method for producing the
22 product (step D), a method of using the product (step E) and by virtue of the
23 "intermediate / final product" relationship between 5 and 6 (see 14.08.05). Unity of
24 invention could not be acknowledged between intermediate 5 and intermediate 2
25 because of the intervening known intermediates 3 and 4 (see 14.08.05), nor could
26 individual steps A, B or C be claimed either alone or in any combination other than one
27 ending with step D (i.e. so that the combination could be viewed as a method for
28 producing 5).
29

30 It is worth noting that other groups of claims could be identified which would meet the
31 requirement for unity of invention. For example, a claim to the 5-step method as a
32 whole would have unity with a claim to product 6, to intermediate 5 and to any
33 combination of steps that includes step E on the basis of the general inventive concept
34 being "the preparation of 6 from 5".
35

36 **14.08.07 Unity and provisos**

37
38 A proviso is a clause added to a claim in order to remove something that would
39 otherwise be encompassed by the language of the claim.
40

41 A proviso may be used, for example, to provide or restore novelty in cases where some
42 part of the claimed subject-matter would otherwise be anticipated.
43

1 Whether a proviso causes a lack of unity of invention must be assessed on the facts of
2 a given case. A proviso can be thought of as making the subject-matter of the claim
3 “discontinuous”, and in that sense can remove the generality of what would otherwise
4 be a “general inventive concept”.

5
6 In assessing whether a proviso will have the effect of removing unity of invention from
7 the claimed subject-matter, the reason for including the proviso must be considered.
8 Where a proviso is used to avoid prior art, for example, the critical question is whether
9 the prior art has simply disclosed an embodiment falling within a claim or has taught the
10 same inventive concept as the application. In the latter case, unity of invention is most
11 likely absent in view of the proviso whereas in the former this may not be the case.

12
13 *Example:*

14
15 An application discloses a genus of compounds (compounds of formula I) useful as
16 antibiotics. The inventors have discovered a structure-function relationship based on a
17 certain functional group in the genus. The same applicants had, several years earlier,
18 obtained a patent on a species (species A) falling within the genus. At the time the
19 previous patent was obtained, the applicants knew the species was a useful antibiotic
20 but did not know what structure led to the activity.

21
22 **Claims:**

- 23 1. A compound having the structure defined by formula I, provided that said
24 compound is not “species A”.
- 25
26 2. A compound according to claim 1, wherein said compound is species B.
- 27
28 3. A compound according to claim 1, wherein said compound is species C.
- 29
30 4. A compound according to claim 1, wherein said compound is species D.

31
32 **Analysis:** The general inventive concept linking the compounds of formula I is the
33 presence of the functional group responsible for their antibiotic activity, coupled with the
34 discovery of the structure-function relationship. The prior patent had not disclosed the
35 structure-function relationship, and although species A would anticipate the broad
36 genus claim in the absence of the proviso, the proviso does not result in a lack of unity
37 of invention among the remaining members of the genus.

38
39 Note that if the earlier patent had identified the structure-function relationship in respect
40 of species A, it would imply a lack of unity of invention *a posteriori* since the role of the
41 functional group in providing antibiotic activity would have been known.

1 **14.08.08 Additional examples**

2
3 As noted in 14.04, the Canadian standard for unity of invention is equivalent to that
4 under the *Patent Cooperation Treaty*.

5
6 Additional examples helpful for understanding unity of invention can be found in
7 sections 10.20 to 10.59 of the *PCT International Search and Preliminary Examination*
8 *Guidelines*, available on the web site of the *World Intellectual Property Organization*.¹⁸
9

10 **14.09 Right to file a divisional application**

11
12 In accordance with subsections 36(2) and 36(2.1) of the *Patent Act*, where an
13 application (the “original application”) describes more than one invention, an applicant
14 may file a divisional application to protect described inventions other than the “one
15 invention only” to which the original application’s claims were directed or, as the case
16 may be, to which the original application’s claims were limited.

17
18 In accordance with subsections 36(2), 36(2.1) and 36(3) of the *Patent Act*, a divisional
19 application must be filed before the original application either grants to patent or, where
20 the original application has been abandoned, the period to reinstate it expires.

21
22 Only an applicant may file a divisional application, and only within the time period
23 provided by statute. Although the term “applicant” is defined in section 2 of the *Patent*
24 *Act* as including “an inventor and the legal representatives of an applicant or inventor”,
25 the Office takes the position that only the current owner of the application can divide it
26 by filing a divisional application.
27

28 **14.10 Filing requirements for a divisional application**

29
30 The filing of a divisional application is largely equivalent to the filing of an original
31 application [see Chapter 5 of this manual].
32

33 When preparing the Petition (Form 3 of Schedule I of the *Patent Rules*), item 2 is
34 completed. The Office will automatically transfer any priority claim and any
35 assignments associated with the original application. In the event the applicant does
36 not wish to claim a priority claimed in the original application, this must be indicated in
37 item 4 of the Petition.
38

39 In accordance with subsection 36(4) of the *Patent Act*,¹⁹ a divisional application is
40 considered to be filed on the same date as the original application. In accordance with
41 subsection 99(2) of the *Patent Rules*, any maintenance fee set out in item 30 of
42 Schedule II of the *Patent Rules* that would have been payable pursuant to subsection
43 27.1(1) of the *Patent Act* had the divisional application been filed on the filing date of

1 the original application shall be paid when the divisional application is actually filed.

2
3 In accordance with subsection 96(2) of the *Patent Rules*, a request for examination of a
4 divisional application shall be made before the later of the five-year period after the
5 filing date of the original application or the six-month period after the date on which the
6 divisional application is actually filed.

7 8 **14.11 Meaning of “original application”**

9
10 In accordance with subsection 36(4) of the *Patent Act*, a divisional application shall be
11 deemed to be a separate and distinct application under the Act, to which the Act’s
12 provisions apply as fully as may be.

13
14 The Office takes the position that a divisional application may itself be considered an
15 original application under section 36 of the *Patent Act* for the purposes of the filing of
16 further divisional applications.

17
18 Thus, if a first application (the “grandparent” application) leads to a first divisional
19 application (the “parent” application), a further divisional application (the “child”
20 application) may be filed on the basis of either the parent application or the grandparent
21 application.

22
23 The Office takes the position that section 36 of the *Patent Act* only requires that either
24 the parent or grandparent be eligible as an “original application”, but not both. If, for
25 example, the grandparent issued to patent or became abandoned and the period to
26 reinstate expired, the parent application could be used to file a divisional in accordance
27 with subsections 36(2), 36(2.1) and 36(3) of the *Patent Act*. This allows the provisions
28 of these subsections to apply “as fully as may be” to the parent application, as provided
29 for in subsection 36(4) of the *Patent Act*.

30 31 **14.12 Time limits**

32
33 In accordance with subsection 36(4) of the *Patent Act*, a divisional application shall
34 have the same filing date as the original application.

35
36 Unless otherwise provided for in the Act or Rules, any time limit that would apply to a
37 regularly filed application applies to a divisional application.

38
39 Where a divisional application is filed after the expiry of the 18 month confidentiality
40 period specified in section 10 of the *Patent Act*, the application and any documents filed
41 in connection with it shall be open to public inspection immediately upon filing. Note
42 that the confidentiality period of a divisional application is calculated based on the
43 earliest filing date of any previously filed application on which a request for priority is

1 made in respect of the divisional application. A divisional application may not have all
2 the priority claim dates that the original application from which it was divided has.

3 4 **14.13 Examination of divisional applications**

5
6 Where a request for examination has been made on a divisional application, a
7 preliminary examination will generally be performed to determine whether the
8 application is entitled to divisional status. The content of the specification and drawings
9 of the purported divisional application are compared to that of the original application to
10 determine if the claims of the divisional application are directed to a different invention
11 than the claims of the parent, and if the divisional application contains any subject-
12 matter that would have contravened subsection 38.2(2) or 38.2(3) of the *Patent Act* had
13 it been added to the original application's specification or drawings by way of
14 amendment.

15
16 Subsections 38.2(2) and 38.2(3) of the *Patent Act* provide that the specification and
17 drawings, respectively, may not be amended to describe matter not reasonably to be
18 inferred from the specification or drawings as originally filed ("new matter"). If the
19 specification or drawings of a purported divisional application contain new matter with
20 respect to the specification or drawings of the original application, the later filed
21 application is not entitled to divisional status.

22
23 Similarly, if the claims in the purported divisional application are not directed to a
24 different invention than those of the original application, the later-filed application is not
25 a divisional application within the meaning of section 36 of the *Patent Act*.

26
27 If the later-filed application is entitled to divisional status, it will generally be returned to
28 its regular order for examination, according to the date on which the parent application's
29 request for examination was made.

30
31 If the later-filed application is not entitled to divisional status, the applicant will be
32 notified of this conclusion and of the examiner's reasons for so concluding. This
33 notification will be provided in a regular examiner's report and, if warranted by the
34 application's order for examination, by way of a courtesy Office letter sent for that
35 purpose.

36
37 Where a purported divisional application is not entitled to divisional status, substantive
38 examination will proceed on the presumption that the application's filing date is the date
39 on which the documents were actually submitted to the Office. Although the filing of an
40 improper divisional is not, of itself, a defect in the application,²⁰ statements in the
41 description or the petition asserting that the application is a divisional application will be
42 considered misleading and be identified as defects under subsection 27(3) of the
43 *Patent Act* and section 77 of the *Patent Rules*, respectively.

1 Depending on the facts of the case, the purported “original application” may also be
2 relevant prior art against the later application in the evaluation of novelty, obviousness
3 or double-patenting. Note that if the filing of a divisional application was “directed by
4 the Patent Office”, the doctrine of double-patenting does not apply between the
5 divisional and any of its parent or sibling applications.²¹
6

1 Endnotes for chapter 14
2
3

1. *Consolboard Inc. v. Macmillan Bloedel (Saskatchewan) Ltd.* [(1981), 56 C.P.R. (2nd), 145 (S.C.C.)] at page 168 referring to “the well-known rule that only one patent may issue for a given invention”.
2. Or of a divisional application to cover several additional inventions disclosed in the parent application, or of one or several divisional applications each to cover one of several additional inventions disclosed in the parent application.
3. *Merck & Co., Inc. v. Apotex Inc.* 2006 FC 524 at paragraph 203. Hughes J. also noted at paragraph 197 that “[d]uring the pendency of an application or several applications, the procedures to be followed are the prerogative of the Patent Office”.
4. *Libby-Owens-Ford Glass Co. v. Ford Motor Co.* [(1970), 62 C.P.R. (1st), 223 (S.C.C.)] at pages 230-231, *Ciba-Geigy AG v. Commissioner of Patents* [(1982), 65 C.P.R. (2nd), 73 (F.C.A.)] at page 79
5. *Société des Usines Chimiques Rhone-Poulenc et al. v. Jules R. Gilbert Ltd.* [1966] Ex. C.R. 59 at paragraphs 6-8
6. In view of this, some content in this chapter mirrors or has been adapted from text found in the *PCT International Search and Preliminary Examination Guidelines* published by the *World Intellectual Property Office* (Geneva, 2004).
7. section 27(1) *PCT* states: No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.
8. For an example of corresponding elements, see section 10.29 of the *PCT International Search and Preliminary Examination Guidelines* (supra at 6).
9. This example is adapted from the example provided in section 10.23 of the *PCT International Search and Preliminary Examination Guidelines* (supra at 6).
10. This example is adapted from the example provided in section 10.26 of the *PCT International Search and Preliminary Examination Guidelines* (supra at 6).
11. The conclusion reached in section 10.43 of the *PCT International Search and Preliminary Examination Guidelines* (supra at 6) can be understood in this light, presuming that a single line of reasoning cannot soundly predict why the various classes of herbicide B work with A to achieve the inventive result.

12. See also the *PCT International Search and Preliminary Examination Guidelines* (supra at 6) at 10.42.
13. The conclusion reached in section 10.58 of the *PCT International Search and Preliminary Examination Guidelines* (supra at 6) can be understood in this light, since compounds X, Y and Z do not share a structural feature responsible for their activity. It must be presumed that X, Y and Z are not members of a recognised class of compounds.
14. Due regard should be given to the nature of the synthesis in performing this evaluation. The relationship of the structure of an intermediate to the final product will be quite different in, for example, a convergent synthesis than in a divergent synthesis, or in a ring-closing or rearrangement reaction than in an addition reaction. See also the *PCT International Search and Preliminary Examination Guidelines* (supra at 6) at 10.18(f).
15. See the *PCT International Search and Preliminary Examination Guidelines* (supra at 6) at 10.18(e).
16. This example is loosely based on the *PCT International Search and Preliminary Examination Guidelines* (supra at 6) at 10.47, which provides specific chemical structures to illustrate the same point.
17. A method for preparing a product would usually be considered to render the product it produces obvious, and there could consequently be an appearance of double-patenting if claims 2 and 3 appeared in different applications.
18. *PCT International Search and Preliminary Examination Guidelines* (supra at 6).
19. An equivalent provision exists for applications filed prior to October 1, 1989, under subsection 36(4) of the *Patent Act* as it read immediately before that date.
20. *Merck* (supra at 3) at paragraph 203
21. *Consolboard* (supra at 1) at page 169