

CLIENT ALERT - Changes to Patent Examination Procedure in Canada

Recent amendments to the Canadian *Patent Rules* which will affect the cost of examining patent applications in Canada have just been registered and will be in effect before the end of the year.

These requirements can be avoided if a request for examination is filed before October 3, 2022.

Excess claims fees will be required:

when examination is requested:

Effective **October 3, 2022**, if a patent application has more than 20 claims when examination is requested, an additional government fee of \$100 CAD **per additional claim** must be paid. For example, if an application has 25 claims when examination is requested, the government examination fee will be increased by \$500. A 50% reduction of this fee (to \$50 CAD per additional claim) applies if small entity fees are paid for the application.

A voluntary amendment can be filed at the time examination is requested to reduce the number of claims for which excess claims fees must be paid.

when the final issuance fee is paid:

As well, if more claims than were paid for at the time examination was requested are added to the application at any time before the application is allowed, even if they are deleted before allowance, excess claims fees to pay for the further added claims will be included in the final fee which must be paid for grant of the patent. Fees are due for claims which add to the total number of claims on file at any one time, not for claims which simply replace deleted claims without increasing the total number.

Examples of calculations are summarized below:

No. of claims in application when examination requested	Additional examination fee for excess claims	Max. no. of claims presented at any time during examination	No. of claims in application at allowance	Additional final fee for excess claims
20 or fewer	\$0	20 + x	20 + x or fewer	\$100x (\$50x)
20 + x	\$100x (\$50x)	20 + x	20 + x or fewer	\$0
20 + x	\$100x (\$50x)	20 + x + y	20 + x + y or fewer	\$100y (\$50y)

Requests for continued examination will be required if more than two office actions are issued

A further new requirement coming into effect on **October 3, 2022** is related to the number of examination reports issued by the Examiner during examination of the patent application.

If the examiner issues a third report identifying defects in the application that need to be addressed before the patent can be granted, a request for continued examination (RCE) will need to be submitted along with payment of a government fee of over \$800 CAD. Again, a 50% reduction of this fee applies if small entity fees are paid for the application.

If a further two examiner's reports are issued after a request for continued examination has been filed, a further RCE must be filed along with payment of an additional government fee. Issuance of examiner's reports and filing of requests for continued examination can continue until the application is allowed, finally refused or abandoned.

If you wish to proactively file a request for examination for one or more applications before October 3, 2022 to prevent these additional government fees being applied, or if you have any questions or would like more information, please contact us – we are happy to help.