

# Canadian patent law – adjusting to new practice

Janice Kelland of Moffat & Co. explains recent developments in Canadian patent law.

**T**he 30th of October 2019 was a red-letter day for Canadian patent law. Amendments made to the Canadian Patent Act in 2014 and 2015, and the completely re-drafted Canadian Patent Rules registered in July 2019, came into force on that day, bringing substantial change to Canadian patent practice.

The amendments are intended to modernize Canadian patent law and to implement the Patent Law Treaty (PLT), thereby better harmonizing Canadian patent practice with that of other PLT members, including major trading partners such as the US, Australia, France and the UK. The amendments to the Act and the new Rules allowed the Canadian government to formally ratify the PLT on 30 July 2019, having initially signed the PLT on 21 May 2001.

## Some requirements are relaxed...

The new law brings many benefits to applicants and patentees, including the relaxation of some procedural requirements.

### RELAXED FILING REQUIREMENTS

Under the new law, when filing an application directly in Canada, a filing date can be obtained by filing a specification in a language other than English or French, and without paying the application fee. The application fee (plus an additional late fee) can be paid within a non-extendable deadline of 3 months from the date of a notice issued by the Canadian Patent Office requiring the payment, and the translation of the specification into English or French can be provided within a non-extendable deadline of 2 months from the date of a notice issued by the Canadian Patent Office requiring the translation.

In addition, it is now possible to obtain a filing date for an application filed directly in Canada with a statement of reference to a previously filed patent application in place of a specification. A copy of the previously filed application must be provided within a non-extendable deadline of 2 months from the date on which the statement was filed. It is also possible under the new law to file an addition or correction to the specification or drawings of a directly-filed application within 2 months of the filing date, if



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priority is requested and the added material is completely contained in the priority application.

However, these provisions do not apply to national entry of a PCT application. Therefore, payment of the required national entry fees and a translation of the specification into English or French, if the PCT application was filed in a different language, are still required to enter the national phase.

### WEEKEND AND HOLIDAY FILING DATES AVAILABLE WHEN FILING ELECTRONICALLY

Documents and information filed electronically, including by fax or online, will now receive the filing date of the day on which they are filed, including days when the Canadian Patent Office is closed, such as weekends and holidays. Due dates falling on days when the Canadian Patent Office is closed are still deemed extended to the next day when the Office is open.

### RESTORATION OF PRIORITY NOW AVAILABLE

It is now possible to request restoration of Paris Convention priority to a previously filed application if the 12-month deadline from the filing date of the previously filed application is unintentionally missed. The Canadian application must be filed within 2 months of the missed 12-month deadline, and the request for restoration of priority and a statement that missing the 12-month deadline was unintentional must be filed within 2 months of the Canadian filing date.

For national entry applications with an international filing date on or after 30 October 2019, priority restored by the PCT receiving office under the “due care” or “unintentional” criteria will be recognized in Canada. Thus, the new law allows Canada to withdraw its notification of incompatibility with portions of PCT Rule 49ter.1. If priority was not restored during the international phase, for example, because the international application was filed at a receiving office which did not accept requests for restoration of priority, a request for restoration can be filed within one month of national entry.

### RECORDAL OF TRANSFERS OF RIGHTS EASIER

If a request to record a transfer of rights with respect to an application or patent is made by the applicant

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or patentee currently of record at the Canadian Patent Office, documentation is no longer needed to support the request. A recordal certificate will be issued for the transfer and any documentation filed along with the request will be put on file at the Canadian Patent Office. However, as was the case under the former law, requests to record transfers of rights made by a transferee (the new owner of the rights) will require providing acceptable evidence of the transfer, such as a signed, witnessed assignment.

#### LESS RESTRICTIVE PAYMENT OF MAINTENANCE FEES FOR APPLICATIONS

Maintenance fees can now be paid by anyone authorized by the applicant or patentee, whereas under the former Rules, maintenance fee payments for pending applications would only be accepted from appointed agents or self-represented applicants who are inventors.

#### NO LOSS OF RIGHTS WITHOUT NOTIFICATION

Applicants and patentees will now receive a notice from the Canadian Patent Office (CIPO) before any loss of rights occurs for administrative reasons such as failure to pay maintenance fees or file a request for examination. Response to the notice as required will prevent the loss of rights. Thus, the possibility of inadvertent loss of patent rights for reasons unrelated to the patentability of the invention is reduced.

Providing this additional notification in some

cases results in increased periods of time during which administrative requirements have not been met but the application or patent in question is not yet irreversibly abandoned or lapsed. These increased periods of uncertainty for third parties are now balanced by the introduction of new third-party rights provisions stipulating that otherwise infringing acts committed during defined periods do not infringe the patent or any patent that would issue from the application, even if the patent or application is later returned to good standing.

#### PROCEDURE FOR AMENDMENTS AFTER ALLOWANCE CLARIFIED

Under the new Rules, an application cannot be amended after a notice of allowance is issued, except to correct an obvious error; i.e., when it is obvious that something other than what appears in the specification or drawings was intended and nothing other than the proposed amendment could have been intended.

However, if more extensive amendments are desired, it is now possible to request, upon payment of a fee, that the notice of allowance be withdrawn, and the application returned to examination. This new procedure is much simpler and faster than the procedure under the previous law which required that the application be abandoned for failure to pay the final issue fee and reinstated before an amendment requiring substantial consideration by an examiner could be filed. Under the new procedure, it is advised to make any desired amendments to the application at the time of, or shortly after, filing the request to withdraw allowance, so that the application is not promptly re-allowed by the examiner.

#### ...but there are also extra requirements...

While applicants and patentees will enjoy relaxed requirements in many areas under the new Rules, in other areas, the new law imposes additional or stricter requirements over those required under previous practice.

#### CERTIFIED COPIES OF PRIORITY DOCUMENTS NOW REQUIRED

Certified copies of priority documents must now be

## Résumé

### Janice Kelland

Janice is a registered Canadian patent agent with a background in chemistry and information science and over twelve years of experience in the pharmaceutical industry. Her work focuses on providing searches and opinions, and drafting and prosecuting patent applications in the chemical, biotech, agricultural, pharmaceutical and mechanical areas. Prior to joining Moffat & Co. in 2009, Janice held positions in the IP groups of two major pharmaceutical companies and served for several years on the faculty of the Chemistry department at a Canadian university.

provided for Canadian direct filings and national entries of PCT applications. Failure to provide the copy within the required time will result in withdrawal of the priority request. Fortunately, if the priority document is available in the WIPO Digital Access Service (DAS), the Canadian Patent Office will be able to access the document electronically on provision of the access code. As well, if the priority document was filed in the Canadian Patent Office or was provided during the international phase of the corresponding PCT application, no further copy is needed.

#### APPOINTMENT OF A COMMON REPRESENTATIVE OF JOINT APPLICANTS NOW REQUIRED

When an application is filed by more than one applicant, one of the applicants must now be appointed as the common representative. The common representative has the authorization to sign certain documents on behalf of the remaining applicants, most notably appointment and revocation of the appointment of agents. If a common representative is not appointed in the petition or national entry request, or in a document signed by all the applicants, one of the applicants will be deemed appointed, using arbitrary criteria such as order of listing on the petition or national entry request, or alphabetical order of names. It is recommended that the common representative be appointed at the time of filing or national entry.

#### LATE NATIONAL ENTRY NO LONGER AS OF RIGHT

If the deadline is unintentionally missed for entering a PCT application into national phase in Canada (30 months from the earliest priority date), it will still be possible to enter national phase within 12 months after the missed deadline upon payment of an additional government fee.

However, for applications with an international filing date after 30 October 2019, it will also be necessary to request reinstatement of rights with respect to the international application and make a statement that failure to enter national phase before the deadline was unintentional.

#### DEADLINES SHORTENED

Due dates for responding to office actions and for payment of the final fee for issue of a patent have been shortened from 6 months to 4 months from the date of issue of the office action or notice of allowance. The deadline for filing a response to an office action can be extended to 6 months upon request and payment of an extension fee; however, if an application goes abandoned for failure to respond to an office action, it can still be reinstated as of right within 12 months of the date of abandonment.

The due date for filing a request for examination has been shortened from 5 years to 4 years from the filing date for applications with a filing date on or after 30 October 2019.



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#### PROCEDURES FOR CORRECTION OF ERRORS CLARIFIED

The new Rules provide clarification of the procedures needed to make corrections to applications or patents, including specifying time limits, sometimes quite short, within which corrections can be made. Procedures are now specified regarding correction of errors in the identity or name of applicants and inventors, errors in priority requests, and obvious errors in issued patents made by the Canadian Patent Office or by the patentee.

#### ...and some potentially severe new consequences

##### FAILURE TO PAY MAINTENANCE FEES OR REQUEST EXAMINATION

The new law provides new defined “late fee periods” during which an applicant or patentee can rectify a missed maintenance fee payment or a failure to request examination on time by paying an additional late fee. However, if the late fee period ends without payment of the maintenance fee or the examination request being filed, the application or patent in question will go abandoned or be deemed expired.

If six months have passed since the missed original due date for paying the maintenance fee or requesting examination, reinstatement of the abandoned application or reversal of the deemed expiry of the patent will require a detailed explanation of the circumstances leading to the failure to pay the maintenance fee or request examination by the end of the late fee period, in addition to a determination by the Canadian Patent Office that the failure occurred in spite of the due care required by the circumstances having been taken. As well, the period during which otherwise infringing acts committed by third parties will be considered not to infringe will start at six months after the missed original due date.

It is expected that preparing a request for reinstatement or reversal of expiry including arguments that due care was taken will be costly and the request is likely to be unsuccessful unless the circumstances were unavoidable and clearly documented. Therefore, in practice, the time available to safely rectify a missed maintenance fee payment or a failure to request examination on time is in most cases six months from the missed due date.

#### For further information...

If you would like further information about these or any other aspects of Canadian patent law, please feel free to contact us. This article is provided for general information purposes only and should not be considered to be legal advice.

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