

ANNEX

Changes in Filing Patent Applications in Canada

For all intents and purposes, the new *Patent Rules* have removed the 42 month late-entry period for easily entering National Phase in Canada from a PCT International Application by simply paying an additional fee. Late-entry filings may still be possible in certain circumstances, but a higher burden would apply.

No filing fee is required to obtain a filing date for Canadian Patent Application if the filing fee and an additional late fee (\$150) are paid within a non-extendable period of two months from the filing date.

Applications filed in languages other than English or French will receive a filing date in Canada, provided a translation is filed within a non-extendable two month period after the filing date.

Applications must be filed with a certified copy of a priority application, or applicants must make a copy of the priority application available to CIPO from one of the websites approved by CIPO.

The applicant has 3-months to comply with a notice from the Commissioner when defects to the application as filed are noted by the Commissioner. Further fees may be applicable.

Prosecution of Canadian Patent Applications

The time period for filing the Request for Examination of a Canadian Patent Application has been reduced from five years to three years from the filing date of the Application. Therefore, an applicant entering Canada from a PCT International Application will have a maximum of 18 months to file the Request for Examination (and only 6 months in the case of a first-filed PCT international application).

The term for responding to Requisitions from the Examiner has been reduced from six months to four months. These Requisitions include:

Responding to an Official Action;

Responding to a Notice of Allowance (paying the Issue Fee); and

Responding to a Final Action from an Examiner.

After Allowance practice has been clarified, and now requires that a request to withdraw the Notice of Allowance be made, and that a new fee of \$400 is paid within 4 months of the Notice of Allowance. This new procedure will return the application to the Examiner for further examination.

The process for correcting various errors made in the naming of the applicant, name of inventors, and obvious errors made by CIPO, has been simplified.

Late Period and Abandonment Period

CIPO has introduced a new Late Period, after the expiry of certain deadlines. During this Late Period, the outstanding action can be taken within a prescribed time period by simply paying a fee and attending to the overdue action. Following this later period, however, the application/patent will

become abandoned. In certain circumstances, the ability to reinstate an abandoned application may become more difficult.

During this new Abandonment Period, after expiry of the Late Period, an applicant is required to pay a higher fee and , in some cases, to comply with the higher burden imposed by new Section 73 (3) of the Patent Act. This will require the Applicant to convince the Commissioner that the failure (i.e. to take the required action) occurred in spite of the due care required by the circumstances having been taken.

Maintaining an Application or Patent Canada

Maintenance Fees for a pending application will now be able to be paid by an applicant themselves or by any person authorized by the applicant.

Maintenance Fees not paid a required deadline must be paid within a six month Late Period after the deadline (or 2 month from a Notice from CIPO, whichever is longer). However, because correspondence mailed by CIPO could be delayed or has the potential to become lost in transit, we would recommend that if no Notice is received from CIPO concerning the non-payment of a maintenance fee, it should not be assumed that one is forthcoming at the end of the Late period. Presently, CIPO's electronic file wrapper does not include Notices Sent by the Commissioner.

As with other abandonments, there is a proposed 12 month Abandonment Period, following the Late Period, where reinstatement could be requested. However, in the case of missed maintenance fees, reinstatement will only occur if the Commissioner is satisfied that the failure to timely pay the maintenance fee occurred in spite of the due care required by the circumstances having been taken.

Third Party Rights

Third-party intervening rights have been introduced during the above-noted Abandonment Periods, after the expiry of any applicable Late Period, during which a Third Party action will not be considered an infringement.

New Services

CIPO has opened the door to e-mail correspondence directly with the office, however, with the proviso that any such correspondence from CIPO will have the date of the attached notice and not the date of the e-mail.

Further Details

You will find the complete newly proposed *Patent Rules* here:

<http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04281.html>