

## Further Changes to the *Patent Rules*

While CIPO has expanded the parties that can act in respect of certain activities in the prosecution and maintenance of patent applications, it is nevertheless expected that most applicants will continue to rely on patent counsel for most if not all activities, given the greater complexity of the new Rules and shorter time periods for responding to correspondence from CIPO.

### Representation

During the prosecution of a patent application in Canada, certain actions must be performed by an agent or common representative.

Section 1(1) of the new *Patent Rules* defines a “common representative” as “an applicant or patentee appointed under section 26, 218, 219 or 220”.

New Section 26 of the *Patent Rules* provides that a common representative may be appointed when there are joint applicants or patentees. If one is not appointed, then one will be selected by CIPO in default procedures set out by Sections 26(4)-(11) of the new *Patent Rules*.

Appointing a Patent Agent is mandatory where: (a) the application is filed by a person other than the inventor; (b) there is more than one inventor and the application is not filed jointly by the inventors; or (c) a transfer, in whole or in part, of the rights to the application has been recorded by the Commissioner under Section 49 of the *Patent Act* (new Section 27(2)).

Once a Patent Agent is appointed, a number of prosecution activities require representation by the agent (e.g. replying to a substantive Examiner's Requisition), with subsection 36(2) of the *Patent Rules* providing exceptions when an agent or common representation is not required, including: filing an application; and paying a filing/maintenance fee.

### Reduced Time Periods

Changes to the Timelines for Canadian Patent Prosecution include:

Before October 30 <sup>th</sup> , 2019	After October 30 <sup>th</sup> , 2019
<b>Filing Requirements</b>	
Filing Date (new S 28(2) of the <i>Patent Act</i> )	
Petition and specification in English or French are required to obtain a filing date	A specification in any language or filing by reference to a prior application and a simplified indication regarding the identity of the applicant are required to obtain a filing date, with <b>2 months</b> to meet further filing requirements,
Payment of the Filing Fee (new S66(1) of the <i>Patent Rules</i> )	
Filing fee is required to obtain a filing date	Filing fee may be paid up to <b>3 months</b> after the filing date

Before October 30 <sup>th</sup> , 2019	After October 30 <sup>th</sup> , 2019
<b>Completion Requirements</b>	
The later of <b>3 months</b> from a CIPO notice or <b>12 months</b> from the filing date (S94(1) old <i>Patent Rules</i> )	<b>3 months</b> from a CIPO notice (S65 New <i>Patent Rules</i> ).
<b>Priority Requirements</b>	
Making a request for Priority	
<b>16 months</b> from the earliest filing date of a priority application (S88(1) old <i>Patent Rules</i> )	The later of <b>16 months</b> from the earliest filing date of a priority application <b>or 4 months</b> after filing an application (if NOT open to the public) (S73(1) New <i>Patent Rules</i> ).
Submitting a Copy of the Priority Application	
Not Applicable unless requested by CIPO	For a non-national phase entry application: the latest of: 16 months from the earliest filing date of a priority application or 4 months from the filing date of the application; For a national phase entry application: , the national phase entry date (S74(2) New <i>Patent Rules</i> ).
Responding to Notice to Submit a Priority Application:	
<b>6 months</b> from an Examiner's Requisition (S89 old <i>Patent Rules</i> )	<b>2 months</b> from a CIPO notice (S74(4) New <i>Patent Rules</i> ).
<b>Filing the Request for Examination</b>	
The later of <b>5 years</b> from filing a parent application or <b>6 months</b> from the filing of a divisional application. (S96(2) old <i>Patent Rules</i> )	The later of <b>4 years</b> from filing a parent application or <b>3 months</b> from the filing of a divisional application. (S81(1) New <i>Patent Rules</i> )
<b>Filing a Response to an Examiner's Requisition (Official Action)</b>	
<b>6 months</b> from the Requisition (S30(2) old <i>Patent Rules</i> )	<b>4 months</b> from the Requisition (S86(2) New <i>Patent Rules</i> ); may be extended up to <b>6 months</b>
<b>Return Application to Examination (Amendment after Allowance)</b>	
Not Applicable	<b>4 months</b> from the Notice of Allowance (S86(17) New <i>Patent Rules</i> ).