

Amendments to Canadian *Patent Act* and *Rules* Late Payment of Patent Maintenance Fees

IN FORCE: 30 October 2019

Changes to the Canada *Patent Act* and *Rules* in force from 30 October 2019 may place increased burdens on patent owners seeking to secure the acceptance of annual patent maintenance fees which are paid late.

Pursuant the amended *Act* and *Rules*, where maintenance fees are not timely paid, the Commissioner will forward a Notice compelling the past due fee payment with a surcharge fee before the later of either: **six (6)** months from the fee due date or two (2) months from the Notice date, to avoid either the abandonment of a pending case or the expiry of an issued patent. The failure to late pay fees within six (6) months of the initial due date may also give rise to claims for third party rights.

Where non-payment of maintenance and surcharge fees results in abandonment, a more restrictive reinstatement or revival mechanism exists. Under the amended *Act* and *Rules*, the revival of rights may be pursued by submitting past due fees, a further fee, and reasons establishing that the failure to pay necessary fees occurred despite due care, either: (i) within twelve (12)* months of the abandonment date in the case of pending applications or (ii) within eighteen (18)* months of the original fee due date for issued patents.

Given the potentially higher burden for obtaining acceptance of maintenance fees which are paid late, if you require our Firm's assistance in either assuming responsibility for annuity docketing and forwarding of maintenance fee notifications, please feel free to contact one of our patent professionals.

**Subject to possible holiday extensions.*