

## Changes to the Canadian *Patent Act and Rules*

**IN FORCE: 30 October 2019**

### 1) PCT National Phase Entry Deadlines

	PCT Filing Date <i>before 30 October 2019</i>	PCT Filing Date <i>on or after 30 October 2019</i>
<b>National Phase Entry Deadline</b>	<b>30 months</b> from the priority date	<b>30 months</b> from the priority date
<b>Late Entry Deadline</b>	<b>42 months</b> from the priority date on payment of a <b>reinstatement fee</b> as of right	<b>42 months</b> from the priority date by: 1) requesting reinstatement; 2) submitting <b>statement</b> that failure to enter by original deadline was <i>unintentional</i> <sup>1</sup> ; and 3) payment of a <b>reinstatement fee</b>

<sup>1</sup> It is possible statement of *unintentional* could be reviewed in future.



## 2) Changes to Priority Requirements

	Request for Priority made <i>before 30 October 2019</i>	Request for Priority made <i>on or after 30 October 2019</i>
<b>Deadline</b>	<b>16 months</b> from previously filed (priority) application	Later of: <b>16 months</b> from previously filed (priority) application and <b>4 months</b> from filing date **
<b>Requirements for Obtaining Valid Priority Date</b>	Request priority, indicating the filing date, country of filing and application number of previously filed application(s).	<ol style="list-style-type: none"> <li>1) Request priority, indicating the filing date, country or office of filing and application number of previously filed application(s).</li> <li>2) <u>Additional requirement</u><sup>2</sup> to either: <ol style="list-style-type: none"> <li>a) submit a <b>certified copy</b> of the priority application with the Office; or</li> <li>b) make available a copy of the priority application in a digital library and inform the Office of the availability.<sup>3</sup></li> </ol> </li> </ol>

<sup>2</sup> Failure to comply may result in the priority claim being *considered withdrawn*.

<sup>3</sup> Presently, the Office has not indicated which digital libraries will be accepted.

**\*\* Restoration of Priority:** For applications filed *on or after 30 October 2019*, it may be possible to request *restoration* of priority to an earlier application filed within the preceding fourteen (14) months. A request for restoration of priority must include a statement indicating that the failure to file the application within twelve (12) months was *unintentional*.<sup>4</sup>

<sup>4</sup> It is possible statement of *unintentional* could be reviewed in future.

### 3) Due Date to Request Examination

	Applications having a Filing Date <i>before 30 October 2019</i>	Applications having a Filing Date <i>on or after 30 October 2019</i>
<b>Deadline</b>	<b>5 years</b> from the filing date	<b>4 years</b> from the filing date
<b>“Default” Period</b>	If 5-year deadline missed <i>on or after</i> 30 October 2019, Commissioner will send a <b>Notice</b> setting a further <b>2 month deadline from date of the Notice</b> by which to request examination and pay past due examination fee, as well as a <b>late fee</b> , to avoid abandonment	If 4-year deadline missed, Commissioner will send a <b>Notice</b> setting a further <b>2 month deadline from date of the Notice</b> by which to request examination and pay past due examination fee, as well as a <b>late fee</b> , to avoid abandonment
<b>Abandonment and Reinstatement</b>	<p>If 5-year deadline missed <i>before</i> 30 October 2019, application is deemed abandoned and may be reinstated <b>within 12 months of abandonment</b> by submitting request for reinstatement, together with: a) past due request for examination and examination fee, and b) additional reinstatement fee.</p> <p>If 2-month deadline set in <b>Notice</b> missed, application is deemed abandoned, and:</p> <ol style="list-style-type: none"> <li>1. may be reinstated <i>õas of rightõ</i> <b>within 6 months of original 5 year deadline</b><sup>5</sup> by submitting request for reinstatement, together with: a) past due request for examination and examination fee, b) past due late fee, and c) additional reinstatement fee.</li> <li>2. may be reinstated <b>within 12 months of 2 month deadline set in Notice</b> by submitting request for reinstatement, together with a), b), c), and d) a statement of reasons establishing that failure to take necessary actions <i>occurred in spite of “due care”</i>.</li> </ol>	<p>If 2-month deadline set in <b>Notice</b> missed, application is deemed abandoned, and:</p> <ol style="list-style-type: none"> <li>1. may be reinstated <i>õas of rightõ</i> <b>within 6 months of original 4 year deadline</b><sup>6</sup> by submitting request for reinstatement, together with: a) past due request for examination and examination fee, b) past due late fee, and c) additional reinstatement fee.</li> <li>2. may be reinstated <b>within 12 months of 2 month deadline set in Notice</b> by submitting request for reinstatement, together with a), b), c), and d) a statement of reasons establishing that failure to take necessary actions occurred in spite of <b>“due care”</b>.</li> </ol>

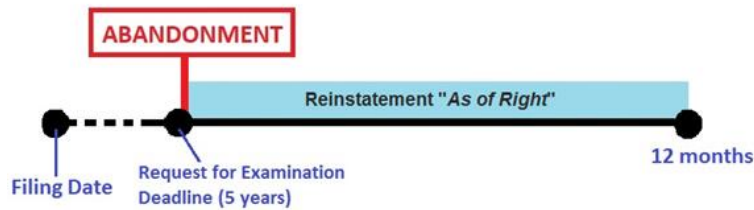
<sup>5</sup> If six (6) month reinstatement deadline missed, **third parties** may be exempt from infringement for certain acts.

<sup>6</sup> If six (6) month reinstatement deadline missed, **third parties** may be exempt from infringement for certain acts.

	Application Filing Date <i>before</i> 30 October 2019	Application Filing Date <i>on or after</i> 30 October 2019
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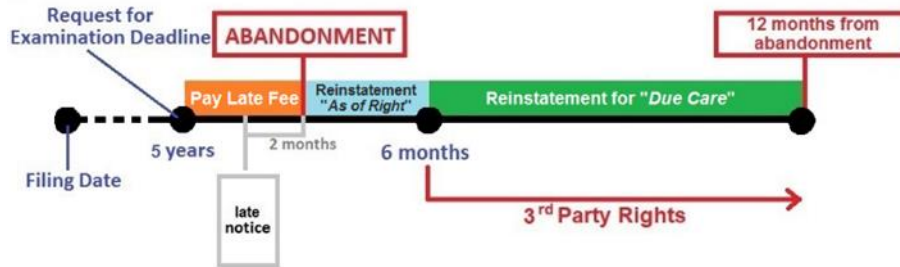
**Scenario A**

5-Year Examination Deadline Missed before 30 October 2019



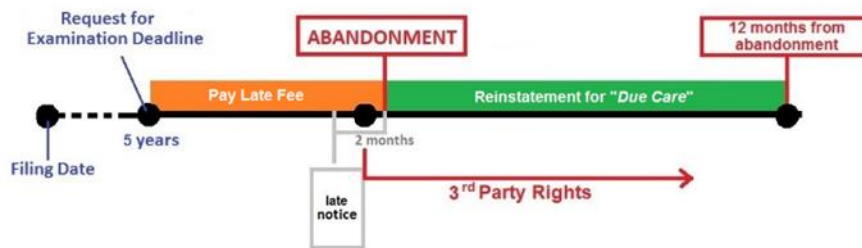
**Scenario B**

5-Year Examination Deadline Missed on or after 30 October 2019 & timely Notice:



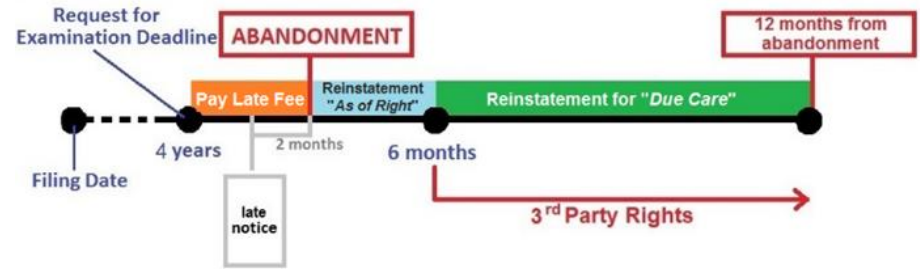
**Scenario C**

5-Year Examination Deadline Missed on or after 30 October 2019 & late Notice:



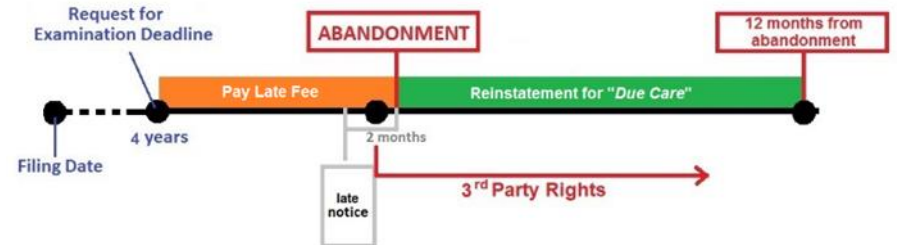
**Scenario A**

4-Year Examination Deadline Missed and timely Notice



**Scenario B**

4-Year Examination Deadline Missed and late Notice

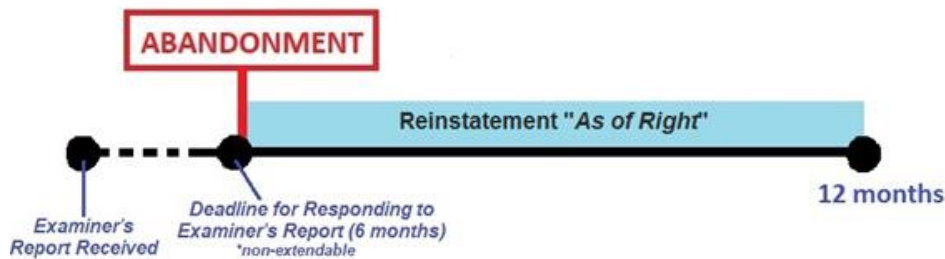


#### 4) Examiner Requisition Deadlines

	Requisitions sent <i>before 30 October 2019</i>	Requisitions sent <i>on or after 30 October 2019</i>
<b>Deadline</b>	<b>6 months</b> from date of requisition <sup>7</sup>	<b>4 months</b> from date of requisition <sup>8</sup>
<b>Reinstatement "As of Right"</b>	<b>within 12 months of abandonment</b>  Must submit: a) past due requisitioned information, arguments and/or amendments, and b) additional reinstatement fee.	<b>within 12 months of abandonment</b>  Must submit: a) past due requisitioned information, arguments and/or amendments, and b) additional reinstatement fee.

<sup>7</sup> No extensions available. Deemed **abandonment** upon missing deadline

<sup>8</sup> Extensions of **maximum two (2) months** available on request and on payment of a fee, where Commissioner is satisfied *circumstances justify the extension*. Deemed **abandonment** upon missing deadline.

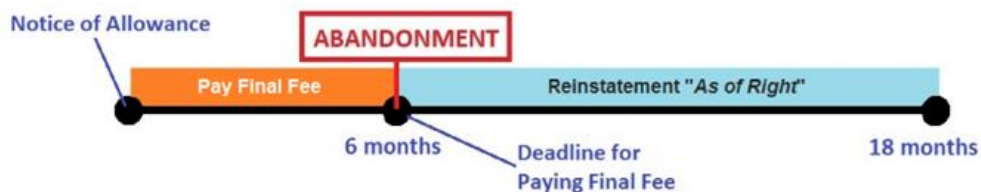


## 5) Final Fee Deadlines

	Notices of Allowance sent <i>before 30 October 2019</i>	Notices of Allowance sent <i>on or after 30 October 2019</i>
<b>Deadline</b>	Final Fee due <b>6 months</b> from date of Notice of Allowance to avoid abandonment <sup>9</sup>	Final Fee due <b>4 months</b> from date of Notice of Allowance to avoid abandonment <sup>10</sup>  If Final Fee not paid, request <i>withdrawal</i> of Notice of Allowance before end of the 4 months (in order to submit application to further amendment/examination)
<b>Reinstatement "As of Right"</b>	<b>within 12 months of abandonment</b>  Must submit: a) past due final fee, and b) additional reinstatement fee.  Application subject to further amendment/examination on reinstatement.	<b>within 12 months of abandonment</b>  Must submit: a) past due final fee, and b) additional reinstatement fee.  <u>No</u> further amendments permitted on reinstatement.

<sup>9</sup>No extensions available. Deemed **abandonment** upon missing deadline

<sup>10</sup>No extensions available. Deemed **abandonment** upon missing deadline



## 6) Maintenance Fee Deadlines - Pending Applications\*\*

\*\* Different Procedures and Due Dates than for Issued Patents

	Maintenance Fee Due Date falls <i>before 30 October 2019</i>	Maintenance Fee Due Date falls <i>on or after 30 October 2019</i>
<b>Deadlines</b>	Due <b>annually</b> beginning on 2nd anniversary of filing date, to avoid deemed abandonment	Due <b>annually</b> beginning on 2nd anniversary of filing date
<b>“Default” Period</b>	-----	If maintenance fee not timely paid, Commissioner will send a <b>Notice</b> setting a <b>further deadline</b> of <u>later of</u> : 2 months from the Notice date and 6 months from the original deadline, by which to pay past due maintenance fee together with a <b>late fee</b> , to avoid abandonment <sup>11</sup>
<b>Reinstatement</b>	<b>Reinstatement “as of right” within 12 months of abandonment</b> Must submit request together with: a) past due maintenance fee, and b) additional reinstatement fee.	<b>Reinstatement for “due care” within 12 months of abandonment</b> Must request reinstatement and submit: a) past due maintenance fee, b) late fee, c) additional reinstatement fee, and d) reasons establishing that failure to take necessary actions occurred in spite of “ <i>due care</i> ”

<sup>11</sup> If six month deadline from original maintenance fee deadline missed, **third parties** may be exempt from infringement for certain acts.

**Scenario A – timely Notice:**



**Scenario B – late Notice:**



7) **Maintenance Fee Deadlines - Issued Patents** \*\*

\*\*Different Procedures and Due Dates than for Pending Patent Applications

	Maintenance Fee Due Date falls <i>before 30 October 2019</i>	Maintenance Fee Due Date falls <i>on or after 30 October 2019</i>
<b>Deadlines</b>	Due <b>annually</b> beginning on 2nd anniversary of filing date	Due <b>annually</b> beginning on 2nd anniversary of filing date
<b>“Default” Period</b>	-----	If maintenance fee not timely paid, the Commissioner will send a <b>Notice</b> setting a <b>further deadline</b> of <u>later of</u> : 2 months from the Notice date and 6 months from the original fee deadline, by which to pay past due maintenance fee together with a <b>late fee</b> , to avoid expiry <sup>12</sup>
<b>Avoiding Lapse / Expiry</b>	Maintenance fee and additional fee must be late paid within twelve (12) months of original fee deadline to avoid irrevocable lapse of patent rights.	If a response to the <b>Notice</b> not timely filed, must <b>within 18 months of the <u>original fee deadline</u></b> : request that the patent never have been deemed expired, and submit: a) the past due maintenance fee, b) the late fee, c) an additional fee, and d) reasons establishing that failure to take the necessary action occurred in spite of <b>“due care”</b>

<sup>12</sup> If six (6) month deadline from original maintenance fee deadline missed, **third parties** may be exempt from infringement for certain acts, even where patent expiry later deemed never to have occurred.



**Maintenance Fee Due *before* 30 October 2019**

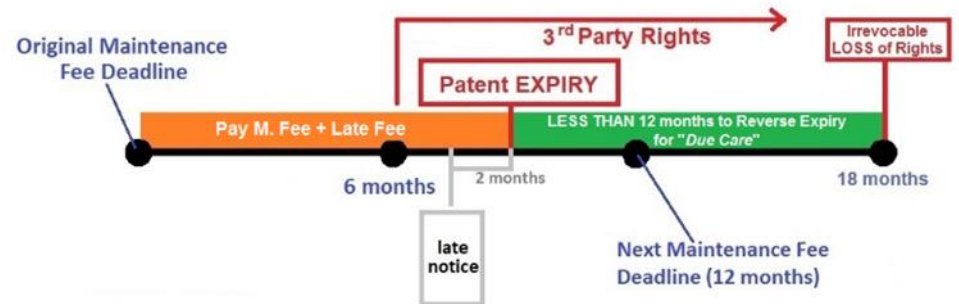
**Maintenance Fee Due *on or after* 30 October 2019**



**Scenario A**  
timely Notice



**Scenario B**  
late Notice



**Scenario C**  
very late Notice



**NOTE: Canadian due dates are generally subject to short extensions when they fall on weekends or national holidays.**

CIPO's offices are closed for business on the following days:

Reason	Date
Every Saturday and Sunday	Weekend
New Year's Day	January 1
Good Friday	Two days before Easter
Easter Monday	Day after Easter
Victoria Day	Last Monday preceding May 25
Fête nationale du Québec	June 24
Canada Day	July 1
Labour Day	First Monday in September
Thanksgiving Day	Second Monday in October
Remembrance Day	November 11
Christmas Day	December 25
Boxing Day	December 26

**Holidays that fall on a Saturday or Sunday**

CIPO's offices will be closed on the following Mondays.

**When December 26 falls on a Saturday**

CIPO's offices will be closed on the following Monday.

**When December 26 falls on a Sunday or Monday**

CIPO's offices will be closed on the following Tuesday.