

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>
National Phase Entry Deadline	30 months from the priority date	30 months from the priority date
Late Entry Deadline	42 months from the priority date on payment of a reinstatement fee as of right	42 months from the priority date by: 1) requesting reinstatement; 2) submitting statement that failure to enter by original deadline was ' <i>unintentional</i> ' ¹ ; and 3) payment of a reinstatement fee

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

² Failure to comply may result in the priority claim being *considered withdrawn*.

³ 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*”.⁴

⁴ 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>
Deadline	5 years from the filing date	4 years from the filing date
“Default” Period	If 5-year deadline missed <i>on or after</i> 30 October 2019, Commissioner will send a Notice setting a further 2 month deadline from date of the Notice by which to request examination and pay past due examination fee, as well as a late fee , to avoid abandonment	If 4-year deadline missed, Commissioner will send a Notice setting a further 2 month deadline from date of the Notice by which to request examination and pay past due examination fee, as well as a late fee , to avoid abandonment
Abandonment and Reinstatement	<p>If 5-year deadline missed <i>before</i> 30 October 2019, application is deemed abandoned and may be reinstated within 12 months of abandonment 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 Notice missed, application is deemed abandoned, and:</p> <ol style="list-style-type: none"> may be reinstated “<i>as of right</i>” within 6 months of original 5 year deadline⁵ 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. may be reinstated within 12 months of 2 month deadline set in Notice 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>. 	<p>If 2-month deadline set in Notice missed, application is deemed abandoned, and:</p> <ol style="list-style-type: none"> may be reinstated “<i>as of right</i>” within 6 months of original 4 year deadline⁶ 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. may be reinstated within 12 months of 2 month deadline set in Notice 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 “<i>due care</i>”.

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

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

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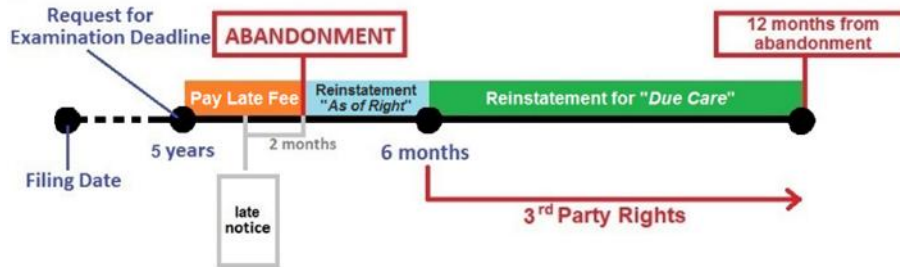
Scenario A

5-Year Examination Deadline Missed before 30 October 2019



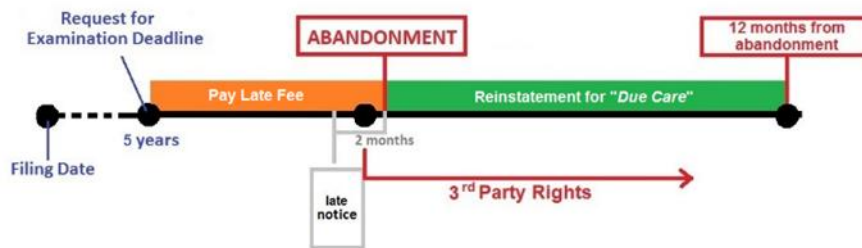
Scenario B

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



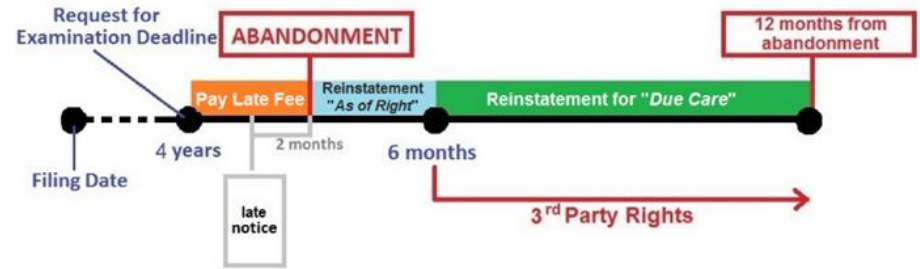
Scenario C

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



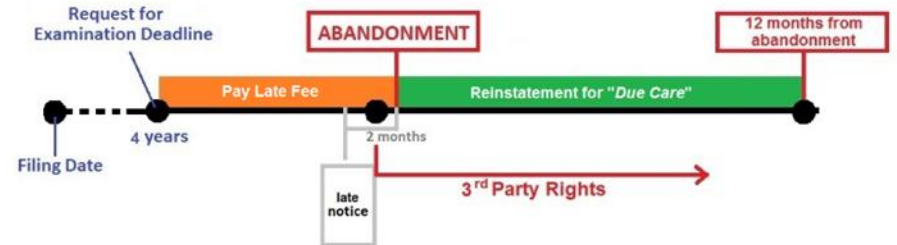
Scenario A

4-Year Examination Deadline Missed and timely Notice



Scenario B

4-Year Examination Deadline Missed and late Notice

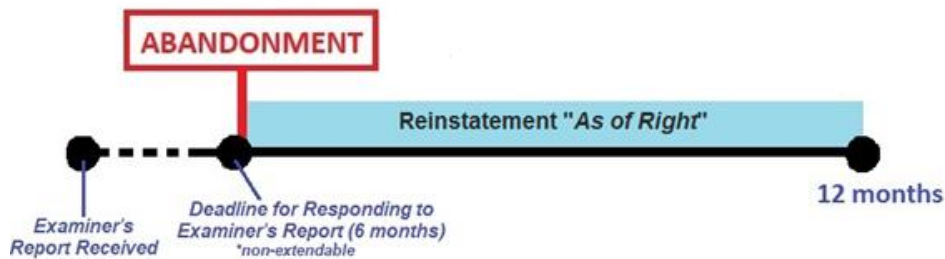


4) Examiner Requisition Deadlines

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

⁷ No extensions available. Deemed **abandonment** upon missing deadline

⁸ 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.

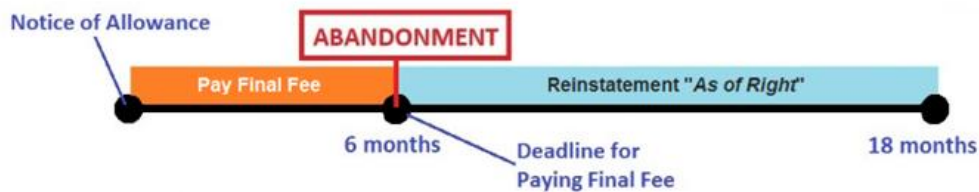


5) Final Fee Deadlines

	Notices of Allowance sent <i>before 30 October 2019</i>	Notices of Allowance sent <i>on or after 30 October 2019</i>
Deadline	Final Fee due 6 months from date of Notice of Allowance to avoid abandonment ⁹	Final Fee due 4 months from date of Notice of Allowance to avoid abandonment ¹⁰ 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)
Reinstatement <i>“As of Right”</i>	within 12 months of abandonment Must submit: a) past due final fee, and b) additional reinstatement fee. Application subject to further amendment/examination on reinstatement.	within 12 months of abandonment Must submit: a) past due final fee, and b) additional reinstatement fee. <u>No</u> further amendments permitted on reinstatement.

⁹No extensions available. Deemed **abandonment** upon missing deadline

¹⁰No 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>
Deadlines	Due annually beginning on 2nd anniversary of filing date, to avoid deemed abandonment	Due annually beginning on 2nd anniversary of filing date
“Default” Period	-----	If maintenance fee not timely paid, Commissioner will send a Notice setting a further deadline 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 late fee , to avoid abandonment ¹¹
Reinstatement	Reinstatement “as of right” within 12 months of abandonment Must submit request together with: a) past due maintenance fee, and b) additional reinstatement fee.	Reinstatement for “due care” within 12 months of abandonment 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> ”

¹¹ 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>
Deadlines	Due annually beginning on 2nd anniversary of filing date	Due annually beginning on 2nd anniversary of filing date
“Default” Period	-----	If maintenance fee not timely paid, the Commissioner will send a Notice setting a further deadline 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 late fee , to avoid expiry ¹²
Avoiding Lapse / Expiry	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 Notice not timely filed, must within 18 months of the <u>original fee deadline</u> : 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 “ <i>due care</i> ”

¹² 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

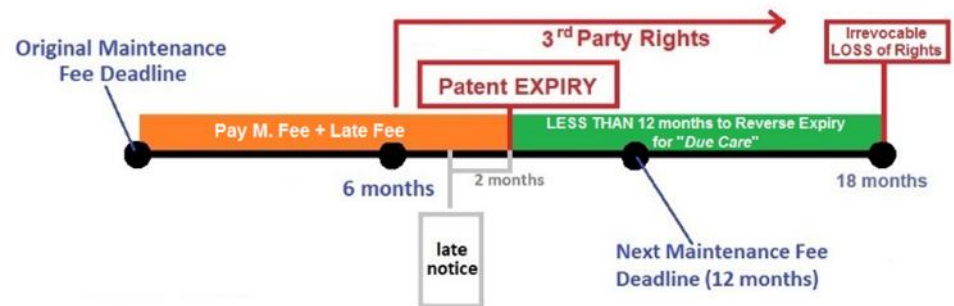
Maintenance Fee Due *on or after* 30 October 2019



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.