



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

IN FORCE: 30 October 2019

Executive Summary

1) PCT National Phase Entry Deadlines

Patent Cooperation Treaty (PCT) applications which are filed prior to 30 October 2019 will remain entitled to late enter the national phase in Canada up to forty-two (42) months from the earliest priority date by submitting any required translations and necessary filing fees, and on payment of an additional reinstatement fee.

For PCT applications filed on or after 30 October 2019, late entry into the Canada national phase up to forty-two (42) months from the earliest priority date may be possible. For such cases, however, applicants will be required to submit necessary translations and filing fees, pay the additional reinstatement fee, and submit a request for reinstatement of rights, together with a statement that failure to enter national phase within the original thirty (30)-month deadline was “*unintentional*”.

2) Priority Documents

For pending applications where a claim for priority is made prior to 30 October 2019, priority may be validly claimed merely by making a request for priority, indicating the filing date, country of filing and application number of an earlier filed application within sixteen (16) months of the earlier priority application filing date.

Any request for priority made on or after 30 October 2019 will require the submission of the aforementioned information before the later of sixteen (16) months from the priority application and four (4) months from the filing date. It will also be necessary to: a) provide a **certified copy** of the priority application; or b) confirm that a copy of the priority application is available in an acceptable digital library.

For applications which are filed on or after 30 October 2019, it may also be possible to request “*restoration*” of priority to an earlier application filed within the preceding fourteen (14) months, where for example, the failure to file the application within the twelve (12) month priority period was *unintentional*.

3) Deadline for Requesting Examination

For applications filed prior to 30 October 2019, it remains necessary to submit a request for examination and examination fee within five (5) years of the filing date to avoid abandonment.

For applications filed on or after 30 October 2019, the deadline for requesting examination and submitting examination fee will be reduced to four (4) years from the filing date.

Under the new rules, if the examination request deadline is missed, the Commissioner will send a notice, setting a further two (2) month deadline by which to request examination and pay the past due examination fee together with a late fee, to avoid abandonment.

Applications so abandoned may possibly be reinstated by submitting the examination request and past due fees; and a further reinstatement fee within twelve (12) months of the abandonment date. Any request for reinstatement made more than six (6) months following the original examination due date must further be accompanied with reasons establishing that the failure to submit the examination request and required fees occurred despite due care.

Under the new *Rules*, if examination is not requested within six (6) months of the original examination deadline, third parties may be accorded certain rights to practice the claimed invention.

4) Deadlines for Responding to Office Actions and Notices of Allowance

Examiner requisitions or notices of allowances that are sent on or after 30 October 2019 will typically be accorded a reduced deadline of four (4) months from the date of the notice/report by which to respond to avoid abandonment.

The four (4) month deadline to submit final fees in response to a notice of allowance will be non-extendable. Deadlines to respond to Examiner requisitions may be extended by up to two (2) months on payment of a fee, where a request is made prior to the due date, and Commissioner is satisfied that the circumstances justify the extension.

5) New Post-Allowance Amendment Procedures

Applications allowed prior to 30 October 2019 may *not* be amended, other than on payment of a fee to correct clerical errors that are obvious on the face of the application, and only where the amendments would not necessitate a further search by the Examiner, or cause the application not to comply with the *Act* or *Rules*. Where substantive amendments are desired for applications allowed prior to 30 October 2019, it remains possible to permit the application to become abandoned for non-payment of the final fee, and thereafter reinstate the case to cause the application to be subject to further prosecution.

Where a notice of allowance is sent on or after 30 October 2019, the application may be amended to correct “obvious” errors in the specification or drawings prior to payment of the final

fee. If substantive amendments are of interest, and the final fee has not been paid, on payment of a fee it will be possible to request withdrawal of the allowance prior to the final fee due date.

6) Maintenance Fees/Pending Applications

Maintenance fees to maintain pending applications remain due annually, beginning on the second anniversary of the filing date of the application.

The failure to pay the maintenance fee prior to the due date will result in the Commissioner forwarding a maintenance fee notice, compelling the fee payment, together with additional surcharge fees before the later of two (2) months from the notice or six (6) months from the initial due date, to avoid abandonment. Abandoned applications may possibly be reinstated by submitting the past due fees and a further reinstatement fee up to twelve (12) months from the abandonment date. Any request for reinstatement must further be accompanied with reasons establishing that the failure to submit required fees occurred despite due care.

Under the new *Rules*, if a maintenance fee is not paid within six (6) months of the original fee deadline, third parties may be accorded certain rights to practice the claimed invention.

7) Maintenance Fees/Issued Patents

Maintenance fees to maintain issued patents are payable annually, and for 2 million/3 million series patents, on the anniversary of the application filing date.

Where patent maintenance fees due on or after 30 October 2019 are not timely paid, the Commissioner will forward a Notice compelling the submission of the past due fee with a late surcharge fee before the later of six (6) months from the fee due date or two (2) months from the Notice date, to avoid patent expiry.

Patents deemed expired for the failure to submit maintenance and late surcharge fees may possibly be revived up to eighteen (18) months from the initial due date by paying past due fees and a further prescribed fee, and submitting reasons establishing that the failure to pay necessary fees occurred despite due care.

Under the new *Rules*, if a maintenance fee is not paid within six (6) months of the original fee deadline, third parties may be accorded certain rights to practice the claimed invention.

If you have any questions regarding Canadian intellectual property matters, please do not hesitate to contact our office.

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