The good, the bad, and the complicated: Upcoming changes to filing requirements for Canadian patent applications

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This article provides highlights of the upcoming changes that impact patent filing or national phase entry.

Changes to the Canadian Patent Rules mandated by Bill-C43 (the new rules), will be implemented on October 30, 2019. The precise wording of the new rules will be available on July 10, 2019. Certain amendments to the *Patent Act* supported by the new rules will also come into force on October 30, 2019. This changes will align Canadian patent practice with our international obligations under the Patent Law Treaty.

This article provides highlights of the upcoming changes that impact patent filing or national phase entry.

While the new rules will permit greater flexibility at filing, relatively short and notice-dependent deadlines will be set to remedy most filing deficiencies. A complex aftermath is envisioned for patent filings with multiple deficiencies. Unpredictable timing for the receipt of notices with short response periods of two or three months means that applicants and agents alike must respond to notices swiftly to avoid last-minute urgency and potential loss of rights. The timing with which a notice can be expected to arrive will depend on the preparedness and efficiency of the systems in place at the Canadian Intellectual Property Office (CIPO).

Late PCT National Phase Entry at 42 months is no longer available as of right

One popular feature of filing in Canada will be lost under the new rules: strategic use of late national phase entry. Canada will continue to observe a 30-month deadline for national phase entry, but late entry up to 42 months from the earliest (priority) filing date of a PCT application (currently permitted as a matter of right) will require a statement indicating that the failure to meet the 30-month deadline was “unintentional”.1 Prudent applicants that diligently track the 30-month national phase entry deadline will no longer be able to depend on the 42-month late entry as part of an *intentional* cost deferral strategy. Transitional rules will permit PCT applications filed before the new rules come into force to access 42-month late entry as a matter of right, whether intentional or not.2

Restoration of a missed priority claim is possible outside of the 12-month priority period

Two extra months of restored priority will be available, whether an application is a PCT national phase entry or a direct Canadian filing, if the application was filed after the 12-month priority period of an earlier-filed application, and provided that failure to file within the 12-month priority period was unintentional (*i.e.*, if the filing date is within 14 months of the earlier-filed priority application).3 The time periods in which to request restoration of priority are short: within one month of PCT national phase entry4 or within two months of the filing date of a non-PCT application.5

Filing date can be established without an English or French language application

The new rules will relax the requirement for an application to be entirely in English or French at filing, in order to permit applicants to secure a Canadian filing date with a specification in another language.6 The specification must be later replaced by an English or French translation,7 once requisitioned by a notice bearing a two-month deadline.8 Notably, the submission of an inaccurate translation containing new matter can result in other problems, such as a loss of the earlier filing date in favour of the later date on which the translation was submitted.9 No such rule change applies to PCT national phase applications, which still require an English or French translation at national phase entry.

Filing date can be established without a filing fee

When filing an application directly in Canada the filing fee can be paid later, with the filing date still being secured, provided the fee is paid within a three-month late fee period set by a requisition.10 If the filing fee is not paid together with a late fee within the deadline set by the notice, the application is deemed irrevocably withdrawn without opportunity for reinstatement.11 This does not apply to PCT national phase applications, which require fee payment at national phase entry (with certain exceptions if a bona fide attempt to pay was unsuccessful).12

Filing-by-reference can establish a filing date without submitting a specification

Establishing a filing date by making reference to a previously filed application that was filed in Canada or elsewhere (such as a priority application) is permitted. The previously filed application must be adequately identified, and a copy must be provided (or access granted to the document via an accepted digital library) within a two-month time period.13

Information left out of a newly filed application can be adopted from a priority document

If information is not present in an application at filing, but is contained in the priority document, this information can be added if action is taken within a time period that may range from two to six months from the filing date.14

Certified copies or access to priority applications will be required

This is a new requirement. For direct filings in Canada, the deadline to provide a certified copy of a priority document or official access to a digital library containing such a document will be four months from filing or 16 months from priority, or two months following receipt of a notice, with a possible two-month extension available. For PCT national phase applications, the requirement can be averted if the priority document is submitted during the international phase,15 but – importantly – may be due at national phase entry.16 Hopefully, digital library access (permitted in lieu of a certified copy)17will become the standard of most Patent Offices of the world.

Appointing a patent agent is not required for filing

Canadian patent agents are typically involved in filing and national phase entry processes, but the new rules permit agent appointment after an application is filed, and specify the conditions under which a patent agent is to be appointed or revoked.18

Sequence Listings will not be a completion requirement

Currently considered a completion requirement, under the new rules, sequence listings will still be requisitioned within three months if absent from an application, but no completion fee will be due.19

Sequence Listings will not be considered in the excess page count

Although unrelated to filing requirements, it bears noting here that the sequence listing will be expressly excluded from the page count for the purposes of calculating the Final Fee.20 This change will provide welcome reprieve from surprisingly high fee calculations for applications in the life sciences containing lengthy sequence listings.

[1] Proposed Patent Rule 155(3), Canada Gazette Part 1, Vol. 152, No. 48.

[2] Proposed Patent Rule 209, Canada Gazette Part 1, Vol. 152, No. 48.

[3] *Patent Act* section 28.4(6).

[4] Proposed Patent Rule 77(1)(b), Canada Gazette Part 1, Vol. 152, No. 48.

[5] Proposed Patent Rule 77(1)(a), Canada Gazette Part 1, Vol. 152, No. 48.

[6] Proposed Patent Rule 71(d), Canada Gazette Part 1, Vol. 152, No. 48.

[7] Proposed Patent Rule 46, Canada Gazette Part 1, Vol. 152, No. 48.

[8] Proposed Patent Rule 15(4), Canada Gazette Part 1, Vol. 152, No. 48.

[9] *Patent Act* sections 28(1), 28.01(1), and 28.01(2).

[10] Proposed Patent Rule 66(1), Canada Gazette Part 1, Vol. 152, No. 48.

[11] Proposed Patent Rule 66(2), Canada Gazette Part 1, Vol. 152, No. 48.

[12] Proposed Patent Rule 155(4), Canada Gazette Part 1, Vol. 152, No. 48.

[13] *Patent Act* section 27.01 and Proposed Patent Rule 67, Canada Gazette Part 1, Vol. 152, No. 48.

[14] *Patent Act* section 28.01 and Proposed Patent Rule 72, Canada Gazette Part 1, Vol. 152, No. 48.

[15] Proposed Patent Rule 157(1)(b), Canada Gazette Part 1, Vol. 152, No. 48.

[16] Proposed Patent Rule 74(2)(c), Canada Gazette Part 1, Vol. 152, No. 48.

[17] Proposed Patent Rule 74(1)(b), Canada Gazette Part 1, Vol. 152, No. 48.

[18] Proposed Patent Rules 27-32, Canada Gazette Part 1, Vol. 152, No. 48.

[19] Proposed Patent Rules 58 and 65, Canada Gazette Part 1, Vol. 152, No. 48.

[20] Proposed Patent Rules Schedule 2, Item 13(b), Canada Gazette Part 1, Vol. 152, No. 48.

By

Kathleen Marsman, Zosia Zielinski

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Calgary
Centennial Place, East Tower
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Calgary, AB, Canada
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T 403.232.9500
F 403.266.1395

Ottawa
World Exchange Plaza
100 Queen Street
Ottawa, ON, Canada
K1P 1J9

T 613.237.5160
F 613.230.8842

Vancouver
1200 Waterfront Centre
200 Burrard Street
Vancouver, BC, Canada
V7X 1T2

T 604.687.5744
F 604.687.1415

Montréal

1000 De La Gauchetière Street West
Suite 900
Montréal, QC, Canada
H3B 5H4

T 514.954.2555
F 514.879.9015

Toronto

Bay Adelaide Centre, East Tower
22 Adelaide Street West
Toronto, ON, Canada
M5H 4E3

T 416.367.6000
F 416.367.6749

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