October 18, 2019

Significant changes to Canada's patent legislation will come into force on October 30, 2019 (the CIF date). The changes implement Canada's ratification of the Patent Law Treaty and bring the Canadian regulatory regime into closer conformity with international norms with respect to patent procedure.

The following changes represent those most likely to be of immediate interest to you. The summaries do not present all of the nuances associated with the changes. Please contact us for additional information.

Filing Requirements

The new regulations will require submission or making available of a certified copy of any claimed priority application. This must be done by the later of 16 months of the priority date or four months of the filing date. In the case of a PCT national phase entry, the deadline is the national phase entry date. The requirement can be satisfied by specifying that the application is available in an approved digital library (including the WIPO Digital Access Service), or in the case of a PCT national phase entry, having filed a certified copy during the international phase. The priority document may be in a foreign language (*i.e.* other than English or French), however, the patent examiner may requisition a translation during examination.

Late PCT National Phase Entry and Priority Restoration

In Canada, the PCT national phase entry deadline is 30 months from the earliest priority date. The previous regulations permitted late national phase entry, up to 42 months from the earliest priority date on payment of a relatively modest late fee. Under the transitional provisions, this will continue to be an option for PCT applications having an international filing date before the CIF date. For PCT applications having a filing date on or after the CIF date, however, late entry will additionally require a request for reinstatement of the applicant's rights along with a statement that the failure to enter national phase by the 30-month deadline was "unintentional".

Priority restoration was not available under the previous regulations. It will become available under the new regulations for priority applications dated up to 14 months before the filing date. The priority restoration, however, must be made on or after the CIF date. For PCT national phase applications, this will require either valid restoration during the international phase (on or after the CIF date), or a request within one month of national phase entry. Direct national applications will require a request within two months from the filing date. As in the case with late PCT national phase entry, priority restoration will require a statement that the failure to file the application within 12 months of the priority application was "unintentional".

In both situations, the Patent Office will not review the circumstances to determine if the failure was unintentional, leaving such a review to any litigation of the resulting patent in the Federal Court.

Common Representatives

Where a patent application identifies a plurality of co-applicants, the new regulations will require the identification of a "common representative" with which the Patent Office will correspond in the absence of an appointed patent agent. In the absence of an expressly designated common representative, the new regulations define which applicant or patentee is the common representative, based on the listed order or alphabetical order.

Among other things, the new regulations empower the common representative to appoint or revoke patent agents, record transfers, and generally to act on behalf of all of the applicants or patentees.

The common representative may be appointed at national phase entry of a PCT application or at filing of a direct national application. Appointing the common representative at this time will not require the signatures of the co-applicants. After the filing date or national phase entry date, appointment of a common representative will require all of the other applicants or patentees to sign an appointment notice.

In the case of co-applicants, it will be advisable whenever possible to identify at filing or national phase entry which co-applicant should be the common representative, so that the appointment may be included in the application petition or national phase entry request form, in order to avoid the later need for all of the co-applicants' signatures.

Examination Requests

For applications having a filing date before the CIF date, a request for examination and associated fee must be submitted within five years of the filing date. For applications having a filing date on or after the CIF date, a request for examination and associated fee must be submitted within four years of the filing date.

Office Action Deadlines

Under the current regulations, the response period for office actions (examination reports) is six months for regular examination, with no extension of time available, and three months for advanced (expedited) examination, with a single three-month extension of time available upon request and payment of an extension fee. These response periods will continue to apply after the CIF date with respect to office actions issued before the CIF date.

Under the new regulations, the response period for office actions issued on or after the CIF date will be four months for both regular and advanced examination, with one two-month extension of time available upon request and payment of an extension fee.

In either case, the extension request must be submitted within the original response period; requesting and receiving an extension of time in an advanced application will permanently return it to regular examination.

Abandonment and Reinstatement, and Third Party Rights

Under the previous regulations, in most cases, failure to act by a prescribed deadline resulted in deemed abandonment of the application. Reinstatement as of right was available within 12 months, requiring the payment of a relatively modest additional reinstatement fee.

The new regulations introduce different abandonment-reinstatement schemes depending on whether the missed deadline is set by the filing date or is based instead on some other event.

Deadlines Based On the Filing Date

Deadlines set by the filing date refer to examination requests and maintenance fees. In both cases, failure to act by the original deadline will result in the issuance of a "default notice" requiring performance of the missed act and payment of a late fee.

For examination requests, failure to respond in a timely manner to the default notice will result in deemed abandonment. Reinstatement of an application deemed abandoned will require a due care showing, unless the request is made by six months from the original due date.

For maintenance fees, failure to respond to the notice by the later of two months from the notice or six months from the original deadline will result in deemed abandonment. Reinstatement is possible only if the abandonment occurred despite the exercise of "due care". The Patent Office has indicated that it will adopt a "due care" practice consistent with the PCT guidance for receiving offices.

Regardless of the abandonment deadline established by the default notice, third-party rights will be available during the period starting six months after the missed deadline until the application returns to good standing. These rights are available for any party who commits, in good faith, an otherwise infringing act during this time. Any rights obtained by the party are transferrable to others.

Deadlines Based Otherwise Than On the Filing Date

Deadlines that are not set based on the filing date include office actions. In this case, failure to reply timely to an office action by the deadline (or the extended deadline, as the case may be) will result in abandonment, subject to reinstatement within 12 months as of right (*i.e.*, no statement of "due care" is required).

Allowance and Issue Fee Payment

Under the current regulations, the time-period to pay an issue fee is six months from the date of the notice of allowance, with no extensions of time available. This period will continue to apply after the CIF date with respect to notices of allowance issued before the CIF date.

Under the new regulations, the time-period to pay an issue fee is four months after a notice of allowance is issued, with no extensions of time available.

In either case, missing this deadline will result in deemed abandonment, with reinstatement available as of right within 12 months.

Post-Allowance Options to Continue Prosecution

Once a notice of allowance is issued, it is no longer permitted to make substantive amendments to the claims. Re-opening prosecution may be desirable when the applicant has additional claims they want to pursue in Canada, and the Examiner has not previously been given the opportunity to assess their unity with the allowed claims. As a reminder, divisional applications are protected against double-patenting attacks if they have been filed in response to a lack-of-unity rejection.

Under the current regulations, it is possible to re-open prosecution by refraining from timely payment of the issue fee thereby causing abandonment, which automatically results in withdrawal of the notice of allowance, lifting the prohibition against substantive amendments. The application may then be reinstated and accompanied by any desired amendments.

This maneuver will remain available for cases where the notice of allowance is issued before the CIF date, but not on or after the CIF date. Instead, under the new regulations, prosecution can be re-opened if a request and fee are submitted before the four-month deadline and before the final fee is paid.

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