Ready, set go! Changes to Canadian patent practice coming into force later this year

July 10, 2019

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The Government of Canada has just announced that the new *Patent Rules*, as well as certain amendments to the *Patent Act*, will come into force on October 30, 2019. These changes implement the Patent Law Treaty and reduce the risk of a loss of rights to Applicants but also bring about practice changes worthy of mention:

Canadian national phase of a PCT application

For applications filed in Canada via PCT national phase entry:

Things will be getting faster

Under the new system, the deadline to request examination will be reduced to 4 years from the PCT filing date (currently 5 years) and the typical deadline to respond to an Office Action will be reduced to 4 months with possible fee-based extension to 6 months (currently 6 months with no extension). Therefore, CA prosecution shall be shorter overall.

“Late” national phase entry

It is currently possible to enter the CA national phase past the 30-month deadline and up to 42 months from priority, as a matter of right. Under the new rules, such “late” national phase entry will only be possible if missing the original 30-month deadline was unintentional (a statement must be submitted to that effect). The Canadian Intellectual Property Office (CIPO) will exercise its discretion to accept or refuse such declarations. Therefore, it would be prudent to consider the 30-month deadline as a hard deadline for CA national phase entry.

New system for dealing with missed deadlines to request

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examination or pay maintenance fees

Under the current system, if such a deadline is missed, a further 12 months would be available via the abandonment/reinstatement system (applications) or late payment system (patents), as a matter of right. The new system will provide an additional safeguard to Applicants, as missing such deadlines will trigger the issuance of a CIPO notice requesting that the required action be taken within a new deadline. However, missing the new deadline will result in a new category of abandonment requiring reinstatement under a “due care” standard (a statement must be submitted to show “due care”). Once again CIPO will have discretion to accept or refuse declarations of “due care”. The prudent approach will be to avoid relying on showings of due care by meeting all deadlines.

Restoration of priority

Canadian practice will come into line with the restoration of priority provisions of the PCT. Such a procedure extends the usual 12-month priority period by a further 2 months if missing the original 12-month deadline was unintentional (the standard to be used in CA). Therefore, Applicants can rest easy that such a restoration of priority will also be available in Canada.

Sequence listing page fees

While sequence listings have been submitted in electronic form for a number of years, they were nonetheless included in the calculation of CIPO excess page fees payable with the issue fee. Under the new practice, a sequence listing submitted in electronic form will no longer be considered in such calculations. This will greatly benefit Applicants who file cases with large sequence listings.

“Regular” Canadian applications

For Canadian applications directly filed at CIPO (i.e., not via the PCT), equivalent changes to those noted above (with the exception of “late” national phase entry, which is not applicable) will be implemented by comparable provisions. The following additional changes are also noteworthy:

Filing certified copies of priority applications

For Canadian applications claiming priority under the Paris Convention, it will become necessary to file a certified copy of any priority applications (or refer CIPO to a digital library to access the document). The deadline will be the later of 4 months from filing and 16 months from priority. It will of course be good practice to have such certified copies available at CA filing.

Fewer requirements to secure a CA filing date

It will be easier to obtain a filing date for such direct-filed applications, as various requirements may be fulfilled shortly after filing. Notably, a translation into English or French, if applicable, may be submitted post-filing (in contrast to CA national phase applications filed via the PCT). It will nonetheless be good practice to have all documents and information ready at filing.

We can show you the way!

We are here to help guide Applicants as we transition to this new era of Canadian patent practice!

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