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Changes to the *Canadian Patent Rules* came into force on October 30th 2019

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The new *Patent Rules*, as well as certain amendments to the *Patent Act*, came into force on October 30, 2019. These changes implement the Patent Law Treaty and reduce the risk to applicants of a loss of rights 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:

A little bit faster…

Under the new system, the deadline to request examination will be reduced to 4 years from the PCT international filing date (currently 5 years). The shortened deadline will apply to cases having a PCT international filing date on or after October 30, 2019. Further, the 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).That means that prosecution shall take less time 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 the priority date, as a matter of right. Under the transitional provisions, the current system shall continue to apply to PCT applications with a PCT international filing date prior to October 30, 2019. Subsequently, for cases with a PCT international filing date on or after October 30, 2019, such “late” national phase entry will only be possible if missing the original 30-

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month deadline was unintentional. A statement must be submitted to that effect.

The Canadian Intellectual Property Office (CIPO) will have the discretion to accept or refuse such declarations. So it will be wise to consider the 30-month deadline a hard deadline for CA national phase entry.

Missing deadlines for requesting examination or paying maintenance fees

Under the current system, if such a deadline is missed, a further 12 months would be available via the abandonment/reinstatement system (for applications) or the late payment system (for 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”.

This new system will apply to any deadline to request examination or pay a maintenance fee that falls on or after October 30, 2019. The prudent approach will be to avoid relying on a showing 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. This 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), and will apply to cases with a PCT international filing date on or after October 30, 2019. Therefore, applicants can rest easy that such a restoration of priority will also be available in Canada.

Certified copies of priority applications

Under the new system, it will become necessary to file a certified copy of any priority applications (or refer to a digital library to access the document). Note that satisfying the PCT certified copy requirements during the international phase will also satisfy the new Canadian requirements for the national phase application.

“Regular” Canadian applications

For Canadian applications directly filed with the 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:

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 such as WIPO-DAS 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 upon filing in Canada.

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Easier to secure a Canadian 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 Canadian 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 can help guide applicants as we transition to this new era of Canadian patent practice. Feel free to contact a member of our team!

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