# Further Streamlining of Canadian Patent Examination on the Horizon

July 14, 2021

## Authors

Serge Shahinian

Partner, Patent Agent

Julie Gauvreau

Partner, Lawyer Partner, and Patent Agent Partner, and and Trademark Agent

Canadian Patent Practice has undergone several changes in recent years, in many cases to fulfill the requirements of various international treaties/agreements, including those of the Patent Law Treaty (PLT) and the Comprehensive Economic and Trade Agreement (CETA). On July 3, 2021, the Canadian government published proposed amendments to the *Patent Rules*, primarily to further streamline Canadian patent examination to pave the way for a future patent term adjustment (PTA) system in Canada as per the Canada-United States-Mexico Agreement (CUSMA), as well as to bring Canadian practice in line with upcoming Patent Cooperation Treaty (PCT) sequence listing requirements.

The proposed amendments have been published for a 30-day consultation period and may be subsequently modified. Therefore, it is unknown which of the proposed changes will be retained and in what form, and when the final version of the amended *Rules* will come into force. However, the proposals provide a preview of the types of changes being considered by the Canadian Intellectual Property Office, which notably include the following:

**Excess claim fees**

Like many jurisdictions, Canada is considering the introduction of government fees for excess claims. The proposal is a fee on the order of $100 CAD for each claim beyond 20 claims, which will be payable when requesting examination, and will be re-assessed upon allowance to determine if further claim fees are due when paying the final fee based on changes in the number of claims during examination. It will thus be prudent to voluntarily amend the claims prior to or when requesting examination to control such fees.

**Request for Continued Examination (RCE)**

*Copyright (c) Lavery, de Billy, S.E.N.C.R.L. - L.L.P.*

The objective of the new system is to reduce the pendency of patent applications, with a goal of putting an application in condition for allowance with no more than three Examiner's reports. Continuing examination beyond three reports would require the filing of an RCE, which would entitle the Applicant to up to two further Examiner's reports. The filing of an RCE is also proposed for returning an allowed case to examination, which would replace the current (and relatively recent) mechanism to withdraw an application from allowance. The proposed RCE fee is on the order of $816 CAD.

**Conditional Notice of Allowance (CNOA)**

Rather than issuing further Examiner's reports relating to any outstanding formalities, the Canadian Intellectual Property Office will have a new tool to issue a CNOA, indicating that the application is in condition for allowance as long as certain outstanding minor defects are corrected. This provides a more efficient path for Applicants in such situations to both correct the defects and pay the final fee, following which the case would proceed to grant.

**New PCT Sequence Listing Standard**

In view of the upcoming introduction (on January 1, 2022) of the new PCT "ST.26" sequence listing standard, Canada plans to bring its sequence listing requirements in line with those of the PCT, which will similarly be adopted by patent offices around the world.

**Housekeeping matters**

Otherwise, the proposed amendments aim to provide greater flexibility for Applicants in certain areas such as the correction of various types of errors and fee payments, notably in view of the practical application of recent changes to Canadian patent practice gleaned since they came into force in late 2019.

**Stay Tuned!**

As noted above, the final form and timing of the upcoming changes are unknown. Please stay tuned for upcoming news in due course, and do not hesitate to contact a member of our patent team for guidance through the ultimate transition.

*Copyright (c) Lavery, de Billy, S.E.N.C.R.L. - L.L.P.*