Canadian Patent Practice Update: Act Now to Avoid Excess Claim Fees

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Excess claim fees on the horizon

As reported earlier, the Canadian government published proposed amendments to the *Patent Rules* on July 3, 2021. A significant component of the proposal is the introduction of excess claim fees 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.

Consider acting now

In anticipation of the likely introduction of such a regime in early 2022 (which may be announced with only 30 days' notice), **Applicants may wish to begin assessment of their Canadian patent matters and consider requesting examination by the end of 2021** to avoid the payment of such excess claim fees and retain the right to present a larger number of claims for examination. Based on the transitional provisions in the proposed *Rules*, taking such action now shall avoid payment of such excess claim fees when requesting examination **and** when paying the final fee upon allowance.

We thus recommend that Applicants consider taking such action this year to retain the benefits of the current regime, particularly for cases with a large number of claims as well as those which were already being considered for requesting examination in the short term.

Stay Tuned!

While the exact details and timing of the upcoming changes remain unknown, the earlier proposal suggests that they will likely be soon and with little advance notice. Please stay tuned for upcoming news in due course, and do not hesitate to contact a member of our patent team for guidance

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