

Goodmans^{LLP} Update

Canada's Proposed New Patent Rules - Part 1

Proposed changes to Canada's Patent Rules are expected to come into force in the fall of 2019. The changes will be enacted by replacing the existing Patent Rules with a new set of rules (the "New Rules"). The provisions and precise wording of the proposed New Rules remain subject to change for the next several months.

The New Rules are intended to: 1) accord with amendments made to the *Patent Act* to allow Canada's ratification of the Patent Law Treaty (PLT), and 2) modernize and codify aspects of Canada's patent regime. Many of the New Rules have already been incorporated in practice notes issued by the Canadian Intellectual Property Office (CIPO). For an outline of the more significant proposed changes found in the New Rules, see our December 10, 2018 Update [Significant Changes to the Patent Rules Coming to Canada in 2019](#).

This is the first of two articles in which we elaborate on some of the more important changes. This first article focuses on the filing of patent applications, including regular applications, Patent Cooperation Treaty (PCT) applications, claims to priority, and divisional applications.

Regular Applications

The New Rules, as proposed, will make it easier to obtain a filing date in Canada; an important feature since Canada has a "first to file" system. This change will align Canada's patent regime with the PLT by simplifying the overall filing procedure and reducing the administrative burden on applicants.

A filing date will be accorded when CIPO receives: 1) an indication that a Canadian patent is sought, 2) the applicant's contact information, and 3) a document in any language that appears to describe the invention (*i.e.*, a patent specification). This is a significant change from the current Patent Rules, which require the specification to be in English or French (a potential significant burden for foreign applicants who are required to obtain a translation before filing in Canada). Also of note is that the specification will not need to contain any claims, and the application fee will no longer be required at the time of filing.

If the originally-filed patent specification is not entirely in English or French, the applicant will have to file a translation, likely within two months after the date CIPO issues a notice to this effect, or the application will be deemed abandoned. This translated specification would then replace the originally-filed specification. However, any subsequent amendment made to the specification, including to the claims, must be reasonably inferred from "both" the original specification and the translation. Therefore, it will be important to ensure a correct translation of the original specification is filed.

The PLT also requires safeguards for applicants in cases where parts of the specification may be missing at the time the application is filed. The *Patent Act* will be amended to allow an applicant to add any such missing portions, either by their own initiative or on notification by CIPO, within a short time period after the application is submitted. If this occurs, the filing date accorded the application will be the date when the missing portions are filed, unless the application claims priority and the missing portions are disclosed in the priority application, in which case the filing date will be the date when the original application was submitted.

PCT Applications

The simplified filing requirements for non-PCT applications will not apply to PCT national phase applications. In particular, an applicant will have to continue to file an English or French translation and pay the filing fee at the time of national entry.

There is, however, one important change proposed by the New Rules in respect of when national entry must be made. The current Patent Rules allow an applicant to enter the national phase in Canada as of right up to 42 months from the priority date by simply paying a small late fee if

the entry is made after 30 months. The New Rules will still allow entry up to 42 months, but not as of right. Rather, it is proposed the applicant will have to submit a statement that the failure to enter the national phase by the 30-month deadline was “unintentional”. It is unclear what constitutes an unintentional failure to meet the 30-month deadline, but it is expected that simply changing one’s mind after the deadline has passed may not be considered “unintentional”.

Claiming Priority

Under the current Patent Rules, an application must be filed in Canada within 12 months of the filing date of a priority application. The New Rules will provide the applicant with an extra two months, and thus allow the application to be filed within 14 months of the priority application. However, the applicant will have to file a statement that the failure to meet the 12-month deadline was “unintentional”.

Another important change relates to certified copies of priority applications. Current practice is that certified copies need not be filed unless specifically requested by CIPO. The New Rules will require certified copies of all priority applications to be filed within the later of four months of the filing date or 16 months from the priority date. Alternatively, access to the priority applications may be provided via a digital library (although we understand this option will not be available for some time). If the certified copies are not filed within the prescribed period, the applicant would be notified and given additional time, likely two months.

For PCT national phase applications, certified copies of the priority applications need not be filed if they were already filed during the international phase. If not, then certified copies will have to be filed at the time of national phase entry in Canada.

Completion of Patent Applications

The New Rules will not materially alter the requirements for completing the application after it has been filed. A complete application will include: 1) a petition requesting the grant of a patent; 2) a statement of entitlement; 3) names and addresses of the inventors; 4) an abstract; 5) a specification that includes at least one claim; and 5) a sequence listing (if applicable).

Although the requirement to file a petition remains, the New Rules will eliminate the currently prescribed form for petitions. Instead, the New Rules will require that the petition only contain three things: 1) a request for the grant of a patent, 2) the title of the invention, and 3) the applicant’s name and address. Other information that is currently part of the petition will still be required, however, it may be included in a different document (it can continue to be included in the petition if desired). For example, the application must still include the full names and addresses of all inventors, a “statement of entitlement” that either the applicant is the inventor or that the applicant is entitled to apply for the patent, and the appointment of an agent (if applicable). This information can continue to be included in the petition, or it can be included elsewhere in the application.

The New Rules propose a time limit of three months (after a notice sent by CIPO) to ensure the application is complete. Under the *Patent Act*, if the required parts of the application have not been submitted within this time limit, the application will be deemed abandoned, albeit with a possibility of reinstatement.

Divisional Applications

The New Rules attempt to codify the current procedures used by CIPO when handling divisional applications, but with some new twists. For example, although a properly filed divisional application will continue to be accorded the same filing date as the parent application, a divisional application will also be accorded a “presentation date” when the following is received by CIPO: 1) a petition stating the application is a divisional application, and providing details of the parent application; 2) an indication the applicant was also an applicant of the parent application; 3) a specification (in English or French) with at least one claim.

The “presentation date” will be used to calculate a few important dates, such as the date when examination must be requested (the later of four years from the filing date or three months from the presentation date). As well, all maintenance fees payable up to the presentation date on the parent application would be due with regard to the divisional application.

The New Rules also provide that most actions taken on the parent application, such as making a claim for priority and filing translations, will also apply to the divisional application upon its filing. However, once the divisional application is filed, actions will need to be taken on the parent and divisional applications separately.

Conclusion

The New Rules propose to make a number of significant changes to how patent applications are handled in Canada. However, on the whole, the New Rules are not expected to fundamentally change Canada's patent regime; rather, they are expected to help modernize and align Canada's regime with the PLT.

Our next article will focus on the proposed changes related to examination and amendments to applications, abandonment and reinstatement, and payment of fees.

Please contact any member of our [Intellectual Property Group](#) for more information about the proposed New Rules.

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