



Brion Raffoul
Intellectual Property Law

291 Olmstead Street
Ottawa, Ontario
Canada
K1L 7J9

Dominique Lambert, B.Sc., M.Sc.
Telephone: (613) 521-8844
Fax: (613) 249-7207
dlambert@bripgroup.com

May 26, 2019

BY EMAIL ONLY

Canadian Intellectual Property Office
Place du Portage I
50 Victoria Street, room C-114
Gatineau, QC K1A 0C9

RE: Public consultation on draft topics for the new Patent Rules in the Manual of Patent Office Practice

The present document is being submitted in response to the Public Consultation on draft topics for the new Patent Rules in the Manual of Patent Office Practice (“MOPOP”) launched on March 26, 2019. As MOPOP is the primary resource for Examiners in their interpretation and application of the *Patent Rules*, the proposed changes to MOPOP has given rise to the present submission expressing concerns of the professionals from the Patent Agency of Brion Raffoul (“the Firm”). In the draft topics, CIPO outlines “the new processes and procedures that will apply when the new Patent Act and the new Patent Rules come into force”. As such, the Firm submits that the new processes and procedures must be unambiguous and consistent.

The Firm hereby submits the following concerns and questions and respectfully requests that CIPO considers corrections and/or clarifications accordingly.

WRITTEN COMMUNICATIONS PROCEDURES

5.1 – Exceptions

Any written communications sent to the removed or refused agent in the four-month period preceding the removal or refusal that has not been responded to, is deemed not sent (section 11 of the Patent Rules).

In practical terms, the applicant will be advised of the removal or refusal of their agent and any written communications sent in the preceding four months will be resent to the applicant. The applicant may also receive a notice requiring an appointment of agent if an agent is required.

The wording “any written communications sent in the preceding four months will be *resent to the applicant*” is ambiguous as it may imply that the same communication, bearing the same deadline, will be merely resent. Section 11 of the proposed *Patent Rules* provides that the correspondence is deemed not sent. As such, said correspondence should be reissued, with a new deadline, and sent to the Applicant. The Firm submits that the wording should at least be changed to “any written communications sent in the preceding four months will be reissued with a reset deadline and sent to the applicant”.

TIME

5.2 – Requests for extensions

The Commissioner has the authority to extend time limits for certain actions under the Patent Rules if the Commissioner is satisfied that the circumstances justify the extension and the other administrative conditions are met.

The Firm submits that guidance must be provided to Applicants and Practitioners as to what will be considered satisfactory evidence to justify the extension.

The applicant/patentee will be notified by letter of the Commissioner's decision regarding any request for an extension of time for time periods which can be extended.

A letter outlining the Commissioner's decision that the circumstances do not justify an extension may arrive to the Applicant after the original deadline has passed. The

proposed document is unclear as to what happens in such circumstances. The Firm submits that a clear definition of what will be considered satisfactory evidence should be provided to ensure the Applicant's rights are not jeopardized by a refusal of extension.

REPRESENTATION

2.3 – Common representative by defaults - applications

Exception: Where no common representative has been explicitly appointed and one has been deemed appointed and there has been a correction to the name of a joint applicant under section 104 or subsection 155(6) of the Patent Rules, the joint applicant whose name appears first in alphabetical order is deemed to be appointed as the common representative (subparagraph 26(4)(a)(iii) and paragraph 26(4)(b) of the Patent Rules).

This exception creates ambiguity. Why would the rules for determination of a common representative change from determination based on original order listed to determination based on alphabetical ordering when there is a correction? Does the exception apply to corrections to any of the joint applicants such as the last applicant? We recommend that this exception be removed and that the deemed appointed common representative does not change upon a mere correction in the name of a joint applicant when there is no intent to change the original order listed.

5.0 – Representation Requirements

5.1.1 Representation by Others

Note: Some actions with respect to applications are permitted by "persons authorized" by an applicant, patentee, or common representative. In these cases, the Office does not require evidence or proof of that authorization and will implicitly assume that the person is authorized.

The Firm submits that the threshold for a "person authorized" is very low. Will the appointed agent be notified that such actions have been taken? The Firm is concerned that unauthorized persons will take actions. For example, the following actions can be taken by a "person authorized":

- Rule 16(c): CIPO can provide information in respect of an application that is not open to public inspection to a person authorized; and
- Rules 36(3) and (4): a person authorized can submit a request to record a transfer or change of name, respectively.

Such actions by an unauthorized person could prejudice the Applicant's rights.

FILING REQUIREMENTS

1.3.1 – Reference statement

b. ii. make a copy of the previously filed application available to the Commissioner in a digital library that is specified by the Commissioner as being accepted for that purpose, and inform the Commissioner that it is so available.

The Firm requests that CIPO specifies what digital library are being accepted.

1.4 – Addition to specification or addition of drawing

1.4.2 – Effect on filing date

Where the parts being added are not contained in a prior application on which priority has been requested, and the request is not withdrawn before the prescribed date, the missing parts will be added to the application and the filing date will be the later of the date on which the addition is received and the filing date (where other filing requirements have not been met before the addition of the missing part is requested). Consequence is an amended filing certificate.

The Firm is concerned as to how the above is substantively assessed. Who at CIPO will be responsible for making the critical assessment that the parts being added are not contained in a prior application? As the result of this substantive assessment may be a new filing date, and thus has important consequences on the Applicant's rights, the Firm requests that the assessment be made by a highly qualified employee, such as an Examiner, a Section Head, or a Board for making such assessment. The Firm is concerned that the assessment may be made by inadequately trained formality clerks or the like.

Considering the short timelines, the Office will expedite the assessment of whether or not the parts being added are contained in the priority application. The Office will do its best to inform applicants rapidly if they are not to give the applicant the opportunity to withdraw the addition and maintain the original filing date.

Similarly, due to the important implications of such a refusal, the Office must inform the Applicant and the Applicant must have an opportunity to withdraw the addition. Notification of the assessment should not be an optional ambiguous goal of “best effort”, rather the process should be clearly defined. The Firm further submits that the opportunity to withdraw the addition should include a prescribed deadline to withdraw the addition and thus maintain the original filing date. Finally, what is the Applicant’s recourse if an amended filing date is received and the prescribed time to withdraw has expired? Is the Applicant entitled to Judicial Review? Again, considering the important implications of irrevocably receiving a later filing date, the Firm submits that the process regarding a refusal of adding parts should be significantly clarified to avoid any ambiguity.

COMPLIANCE

1.0– Compliant Patent Applications

This document relates to the assessment of patent application requirements specific to submitting parts or statements, as well as to how and when they are assessed.

The Firm submits that the proposed document is not clear as to “how and when” the requirements are assessed. What employee of CIPO conducts the assessment and at what time during prosecution? Is this assessment conducted by clerical staff or by an Examiner? For example, section 4.0 – Drawings provides that “*a determination as to whether drawings are required under section 27(5.1) of the Patent Act may be made*”. The Firm submits that the person making this assessment and the timeline for making

such an assessment should be specified.

5.1 Inventor Information and Establishing entitlement – changes to Applicant
When amendments are made such that the subject-matter of the invention for which an exclusive privilege or property is claimed changes, applicants are advised to update inventorship and entitlement as needed so that they remain compliant with the Patent Rules.

The extent of the changes in the subject-matter of the invention is not specified; accordingly, one may argue that any amendments to the claims results in a change to the subject-matter of the invention as claimed. This section implies that the Applicant/Agent will need to resubmit a statement of entitlement every time the claims are amended. This obligation places an undue burden on the Applicant/Agent.

Clarifications in regard to the extent of “amendments” and “as needed” are respectfully requested.

It may also need to be updated when applicant information on record in the Patent Office changes, such as after a transfer is recorded or after a change in identity results from a correction.

The above section states that any transfer or correction may need a new statement of entitlement. Is it needed or not? Does an updated statement need to be submitted with every transfer or correction? Clarification is requested.

TRANSFERS

According to section 2.1.1., a request to record a transfer by Applicant or Patentee may be made without additional required evidence. As such, how would third parties verify that the rights have been properly transferred? More so, section 2.3 states that a transfer recording may be removed by the Commissioner upon satisfactory evidence. The above introduce uncertainties around the transfer of rights.

2.3 – Removal of transfer recording

The Commissioner will remove the recording of the transfer of an application or a patent upon receipt of evidence satisfactory to the Commissioner that the transfer should not have been recorded.

In addition to concerns expressed above regarding uncertainties on transfers, section 2.3 is unclear as to what would be considered satisfactory evidence. Also, in view of sections 49(4) (transfer not recorded is void against a subsequently recorded transfer) and 49(6) (CIPO may not remove a transfer recording only because transferor had previously transferred the patent to another person) of the new *Patent Act*, under what circumstances (clerical/substantive/etc.) would a removal may be requested? What is the mechanism under such request for removal of transfer recording? Is there any prescribed fee? Clarifications are respectfully requested.

4.0 – Registration of related documents

Any person may submit a request to the Commissioner to register a document relating to a patent application or patent (section 125 of the Patent Rules). Note that the registration of a document is a separate mechanism than the recordal of a transfer. Registration of a document which effects a transfer or which documents a change of name will simply put that document on file at the Patent Office. It will not be treated as a recordal request.

The above section states that recordal of a transfer and registration of a document are separate mechanisms. As such, if the entity recording a transfer without required evidence according to 2.1.1. nevertheless wishes to register the transfer document, the above section suggests that two fees will be required:

- a) Request to record a transfer; and
- b) Request for Registration of document.

In view of the above, the Office is respectfully requested to provide clarifications and revise the language of the appropriate sections accordingly.

CORRECTIONS

2.4 – Priority filing date

The provided table for determining the deadline to submit a correction to the priority filing date is confusing in its entirety. The section further implies that no correction is possible on a PCT national phase if the entry is made after said deadline to submit a correction. Clarification is respectfully requested.

ABANDONMENT/REINSTATEMENT

3.1 – Reinstatements requiring determination of due care

This section currently reads:

The following requests for reinstatement of applications deemed abandoned require a positive determination of due care:

- *failure to pay the maintenance fee (73(1)(d) of the Patent Act); and*
- *failure to request examination, pay the fee (73(1)(e) of the Patent Act), when more than six months has elapsed after the due date to have made the request for examination under 35(2) of the Patent Act.*

Correction should be made to the sections of the Act as follows:

The following requests for reinstatement of applications deemed abandoned require a positive determination of due care:

failure to pay the maintenance fee (~~73(1)(d)~~ 73(1)(c) of the Patent Act); and
failure to request examination, pay the fee (~~73(1)(e)~~ 73(1)(d) of the Patent Act), when more than six months has elapsed after the due date to have made the request for examination under 35(2) of the Patent Act.

3.2 – Time period for reinstatement

Corrections should be made as follows to Example 3:

*Example 3: A Commissioner's notice sent under section 68 of the Rules requiring the applicant to comply within **three** months of the notice is sent on March 31. The applicant is required to respond by June 30. A response ~~is not provided~~ by the applicant is not provided by June 30 and therefore the application is deemed abandoned on June 30. The reinstatement period ends on June 30 of the following year.*

Also, the proposed document is unclear as to what the three-month period is

referring to. The Firm submits that the use of “three months” appears to be a typo and

the correct deadline should be two months. Correction is respectfully requested.

DUE CARE

As any “person authorized” may now pay the maintenance fee, the agent of record will not be able to establish that due care has been taken by a third party. Is establishing due care of all involved parties: agent, Applicant, and third parties, a requirement? This section requires clarification, especially as the “due care” standard is a newly introduced concept in Canadian Patent Law.

Determination

The Firm questions the distinction between human error by an assistant, and by the agent/applicant. The distinction should be regarding the *nature* of the error, as opposed to the job title of the human committing the error. An isolated human error may be made equally by an assistant, agent, or Applicant. As such, we propose the following correction to differentiate on the *nature* of the error rather than discriminating on the person committing the error:

Considered due care:

Isolated human error ~~by assistant~~: ~~Where an assistant makes~~ An isolated error in the docketing, monitoring, preparation or filing of the application or patent.

Due care was not taken:

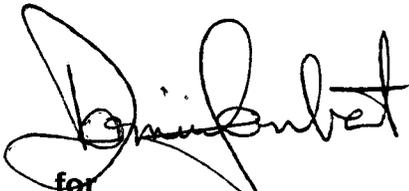
Human error ~~by applicant or agent~~: Where a human error results from an increase in workload, a lost file, or other lack of organization or diligence when dealing with files.

Conclusion

As Examiners utilize MOPOP as their primary resource for interpretation and application of the *Patent Rules*, the new processes and procedures that will apply when the new *Patent Act* and the new *Patent Rules* come into force must be unambiguous

and consistent. In view of the above, the Firm respectfully requests that appropriate corrections and/or clarifications be considered and made.

Respectfully submitted,



for
BRION RAFFOUL