

Amendments to the *Patent Rules*

Authorized correspondent, Request for examination, Sequence Listings and PLT-like amendments

This package of proposed amendments to the *Patent Rules* comprises changes that should generally be considered “applicant friendly” in nature. The amendments seek to safeguard applicants' rights in situations where their rights would have been expunged due to a failure to meet certain procedural requirements. The package also reduces some operational requirements by providing more flexibility as to who can pay a fee and reinstate an abandoned application. Finally, the package also deals with fees related to sequence listings filed electronically and with the prescribed delay to request examination.

Some of the amendments proposed are directly inspired from the Patent Law Treaty (PLT). The PLT simplifies and harmonizes the formal requirements member states can apply in relation to patent applications. Although Canada has not made any final determination with regards to its accession to the Treaty, these amendments will either make the *Patent Rules* compliant with the PLT in view of a future accession or are made according to the spirit of the PLT in simplifying some formal requirements and preventing the loss of patent rights when those requirements are not fulfilled.

Proposition for change #1 - Communications

The requirement in section 7(c) of the *Patent Rules* which states communications addressed to the Commissioner in relation to an application must include the title of the invention is not consistent with PLT Article 8(5) and Rule 10(1). It is proposed that section 7 of the *Patent Rules* stipulate that it is only preferable to submit the title, but not required. Section 7 would be amended along the following lines:

7. Communications addressed to the Commissioner in relation to an application
 - (a) shall include
 - (i) the name of the applicant or inventor; and
 - (ii) the application number, if one has been assigned by the Patent Office; and
 - (b) shall preferably include the title of the invention.

Proposition for change #2 – Priority Document

Section 89 of the *Patent Rules* is potentially inconsistent with PLT Rule 4(1) in that it does not place any time restriction on when an examiner may requisition an applicant to file a certified copy of a previously filed application. PLT Rule 4(1) specifies that a copy may be required "within a time limit which shall not be less than 16 months from the filing date of that earlier application or, where there is more than one such earlier application, from the earliest filing date of those earlier applications".

It is proposed to add a specific limitation to section 89 of the *Patent Rules* as to when a copy can be required.

Furthermore Section 89 of the *Patent Rules* is potentially inconsistent with PLT Rule 4(3) which would prohibit CIPO from requiring a copy of a priority document if the priority document was available to CIPO from a digital library which was accepted for that purpose [WIPO is currently working on the creation of such a digital library for priority documents].

It is further proposed that these specific limitations be added to section 89 of the *Patent Rules*.

Section 89 of the *Patent Rules* would be amended along the lines of the following:

- 89.** (1) Where a previously regularly filed application on the basis of which a request for priority is based is taken into account by an examiner pursuant to sections 28.1 to 28.4 of the Act, the examiner may requisition the applicant, at the option of the applicant, to either
- (a) file a certified copy of the previously regularly filed application and a certification from the patent office in which the application was filed indicating the actual date of its filing; or
 - (b) make a copy of the previously regularly filed application available to the Patent Office from a digital library which is specified in the Canadian Patent Office Record as being accepted for that purpose and inform the Commissioner that it is so available.
- (2) A requisition pursuant to subsection (1) shall not be made before the expiry of the period of time specified in subsection (3) after,
- (a) if the request for priority is based on one previously filed application, the date of filing of that application; or
 - (b) if the request for priority is based on two or more previously filed applications, the earliest date of filing of those applications.
- (3) The period of time is
- (a) if, in accordance with paragraph 73(1)(a), the Commissioner establishes a period to reply to the requisition that is shorter than six months, 16 months minus the period established by the Commissioner for reply; or
 - (b) in any other case, ten months.

Proposition for change #3 - Change of Names

Section 39 of the *Patent Rules*, which states that no change of name of the owner of a patent shall be recognized unless evidence of the change of name has been registered in the Office, is not consistent with PLT Rule 15(4) which, with respect to requests by the owner of a patent or an application for the recordal of a change in that person's name, states that a "Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the veracity of any indication contained in the request".

It is proposed that section 39 of the *Patent Rules* be amended so that no evidence be required when a change of name is submitted by the applicant. Section 39 would read:

39. If there is no change in the person of the currently recognized owner of a patent or an application but there is a change in the name of that person, the Commissioner shall recognize the change in name upon the request of the owner.

Proposition for change #4 – Representation -- communication with the office

Section 6 of the *Patent Rules* states that for the purpose of prosecuting or maintaining an application, the Commissioner shall only have regard to communications received from the authorized correspondent which, when appointed, is the patent agent.

This may be problematic in circumstances where the Office receives clear instructions from the applicant but cannot give any consideration to the instructions as the communication does not come from the authorized correspondent.

As prescribed time limits are clearly defined in the statutes, communications to the Office that are not recognized could lead to multiple problems including the loss of patent rights.

It is proposed that the *Patent Rules* be amended so that when the office receives instructions with regard to an application from an agent for whom no evidence of the appointment of agent has been recorded in the Office, the Commissioner would advise the patent agent of the need to submit an appointment of agent. Should the applicant or the patent agent provide the office with such an appointment within three months after the date of the notice, the instructions would be deemed received from the authorized correspondent.

Section 22 of the *Patent Rules* would be amended and a new section 22.1 would be added along the lines of the following:

22. An act by or in relation to a patent agent appointed in accordance with subsection 20(2) or an associate patent agent appointed in accordance with subsection 21(3) shall have the effect of an act by or in relation to the applicant.
- 22.1 (1) If a patent agent who resides in Canada but who has not been appointed in accordance with subsection 20(2) or 21(3) submits a communication to the Commissioner on behalf of an applicant and if the communication is one to which the Commissioner cannot have regard unless section 22 applies, the Commissioner shall by notice advise the patent agent that the Commissioner will not have regard to that communication unless the patent agent is appointed in accordance with subsection 20(2) or 21(3) within three months after the date of the notice.
- (2) If the patent agent is appointed in accordance with subsection 20(2) or 21(3) within three months after the date of the notice, the Commissioner shall have regard to the communication and treat the communication as having been submitted by the applicant on the date on which it was submitted by the patent agent.

Proposition for change #5 – Representation -- Payment of maintenance fees

To be fully consistent with PLT Article 7(2)(b), the *Patent Act* would require an amendment to permit maintenance fees to be paid by any person.

In order to give more flexibility to the applicant as to who can pay a maintenance fee, it is proposed to amend section 6 of the *Patent Rules* to permit maintenance fees to be paid by any person authorized by the applicant.

Furthermore, it is proposed that a request for reinstatement and payment of the reinstatement fee could be made by any person authorized by the applicant when the cause of the abandonment is related to the non payment of a maintenance fee.

A new subsection 6(2.1) would be added along the lines of the following:

- (2.1) For the purpose of paying a fee to maintain an application in effect pursuant to subsection 27.1(1) of the Act or taking any of the steps required by paragraphs 73(3)(a) to (c) of the Act to reinstate an application deemed to be abandoned pursuant to paragraph 73(1)(c) of the Act, the Commissioner shall have regard to communications from any of the following:
- (a) if there is a single applicant, the applicant;
 - (b) if there are joint applicants, any of the applicants;
 - (c) the patent agent, if one is appointed;
 - (d) the associate patent agent, if one is appointed; and
 - (e) any other person authorized by the applicant, or if there are joint applicants, by any of the applicants.

Proposition for change #6 – Request for examination

The Office is considering reducing the time limit for requesting examination (hereinafter “RE”) of a patent application, from the current five years to three years.

According to subsection 35(1) of the *Patent Act*, patent applications are examined upon request and payment of the fee set out in item 3 of Schedule II to the *Patent Rules*. Currently, per subsection 96(1) of the *Patent Rules*, the RE must be filed within the time limit of 5 years from the filing date of the application. If one fails to submit an RE within the time limit, the application becomes abandoned.

In accordance with the international trend and in order to reduce the uncertainty linked to a long period where competitors are not sure if the applicant will prosecute its application, it is proposed that the time limit for requesting examination be reduced by changing it from 5 to 3 years.

Subsection 96 of the Patent Rules would be amended along the lines of the following:

96. (1) Subject to subsection (3), if the filing date of an application is on or after the date of coming into force of this section, for the purposes of paragraph 73(1)(d) of the Act, a request for the examination of the application shall be made and the fee set out in item 3 of Schedule II shall be paid before the expiry of the three-year period after the filing date of the application.

(2) Subject to subsection (3), if the filing date of an application is before the date of coming into force of this section, for the purposes of paragraph 73(1)(d) of the Act, a request for the examination of the application shall be made and the fee set out in item 3 of Schedule II shall be paid before the expiry of the five-year period after the filing date of the application.

(3) A request for the examination of a divisional application shall be made and the fee set out in item 3 of Schedule II shall be paid before the expiry of the later of

- (a) either
 - (i) if the filing date of the original application is on or after the date of coming into force of this section, the three-year period after the filing date of the original application; or
 - (ii) if the filing date of the original application is before the date of coming into force of this section, the five-year period after the filing date of the original application; and
- (b) the six-month period after the date on which the divisional application is actually filed in accordance with subsection 36(2) or (2.1) of the Act.

(4) Section 26 does not apply in respect of the times prescribed in subsections (1) to (3).

Proposition for change #7 – Sequence Listings

In June 2007, the *Patent Rules* dealing with sequence listings were amended with the intent of a) clarifying that the sequence listing submitted at the international level would be acceptable in Canada, b) avoiding requesting the same information in two different formats, and c) to receive the sequence listings in electronic format only.

Currently, Item 6 of Schedule II of the Patent Rules specifies that a fee of \$6 must be paid at grant for each page of specification and drawings in excess of 100 pages. At present, the office practice with regards to sequence listings filed electronically is to estimate the equivalent number of sheets for the purpose of the page fee calculation.

Following the changes made in June 2007, it is proposed that Item 6 of Schedule II be amended so that the electronically filed sequence listing (ASCII) would not be taken into account when determining the excess pages fee and therefore, no page fees would be payable for those sequence listings.

At the same time, the office would establish a system ensuring that the electronic versions of sequence listings are made available on its website and will modify its practice at granting by providing the patentee with a CD/DVD-ROM containing the sequence listing as a part of the granted patent.

Subparagraph (a)(ii) of item 6 of Schedule II to the Rules would be replaced by the following:

- (ii) plus, for each page of specification and drawings, other than pages of a sequence listing filed in electronic form, in excess of 100 pages6.00

Proposition for change #8 – Reinstatement period

PLT will require changes to the current Canadian time limits for remedying missed maintenance fee payments. In the same manner, PLT prevents the invalidation of a patent on the basis of the non-payment of a fee in the application stage and provides for different relief mechanisms in respect of time limits.

Although those changes are not possible at this time since they necessitate amendments to the *Patent Act*, the office proposes to amend the *Patent Rules* to provide that in the case of an abandonment under section 73 of the *Patent Act*, the time period for reinstating should be the latest of 12 months after the abandonment of the application or 2 months after the Patent Office made it public, on its website, that the application was abandoned.

Subsections 98(1) and 152(1) of the *Patent Rules* would be amended along the lines of the following:

- 98.** (1) For an application deemed to be abandoned under section 73 of the Act to be reinstated, the applicant shall, in respect of each failure to take an action referred to in subsection 73(1) of the Act or section 97, make a request for reinstatement to the Commissioner, take the action that should have been taken in order to avoid the abandonment and pay the fee set out in item 7 of Schedule II, before the expiry of the later of
- (a) the 12-month period after the date on which the application is deemed to be abandoned as a result of that failure; and
 - (b) two months after the Patent Office posts on its web site an indication that the application is abandoned.
- 152.** (1) For an application deemed to be abandoned under section 73 of the Act to be reinstated, the applicant shall, in respect of each failure to take an action referred to in subsection 73(1) of the Act or section 151, make a request for reinstatement to the Commissioner, take the action that should have been taken in order to avoid the abandonment and pay the fee set out in item 7 of Schedule II, before the expiry of the later of
- (a) the 12-month period after the date on which the application is deemed to be abandoned as a result of that failure; and
 - (b) two months after the Patent Office posts on its web site an indication that the application is abandoned.

Proposition for change #9 – Authorized correspondent and appointment of agent

The following proposals would clarify the definition of authorized correspondent in order to cover the different scenarios before the office and remove the appointment of agent from the completion requirements.

Sections 2, 6 and 20 of the *Patent Rules* would be amended along the lines of the following:

“authorized correspondent” means, in respect of an application,

- (a) if an associate patent agent is appointed or is required to be appointed pursuant to section 21, the associate patent agent;
- (b) if paragraph (a) does not apply and a patent agent is appointed or is required to be appointed

pursuant to section 20, the patent agent;

(c) if paragraphs (a) and (b) do not apply and there is a single applicant, the applicant; or

(d) if paragraphs (a) and (b) do not apply, if there are joint applicants and if

(i) one of the applicants is appointed by the other applicants as their common representative, the common representative; or

(ii) no common representative is appointed, the first applicant named in the petition or, in the case of a PCT national phase application, the first applicant named in the international application; (*correspondant autorisé*)

“transfer” means a change in ownership, including mergers and amalgamations and including by assignment or by inheritance, of a patent, of an application or of an interest in an invention; (*transfert*)

- 6.(1.1) Except as provided by the Act or these Rules, if the authorized correspondent is an applicant, the Commissioner shall only communicate with, and shall only have regard to communications from, the applicant personally.
- 6.(1.2) If the authorized correspondent is an applicant who is deceased, the Commissioner shall communicate with, and shall have regard to communications from the personal representatives of the estate of the deceased.
- 6.(1.3) If the authorized correspondent is an applicant who is bankrupt, the Commissioner shall communicate with, and shall have regard to communications from the trustees in bankruptcy.
- 6.(1.4) If the authorized correspondent is an applicant who is a minor, the Commissioner shall communicate with, and shall have regard to communications from a parent or legal guardian of the minor.
- 6.(1.5) If the authorized correspondent is an applicant who is under any other legal disability, the Commissioner shall communicate with, and shall have regard to communications from any other person legally entitled to act for that person.
- 6.(1.6) If subsection 20(1) requires the applicant to appoint a patent agent but no patent agent is appointed, the Commissioner shall send communications to
 - (a) if there is a single applicant, the applicant; or
 - (b) if there are joint applicants and if
 - (i) one of the applicants is appointed by the other applicants as their common representative, the common representative; or
 - (ii) no common representative is appointed, the first applicant named in the petition or, in the case of a PCT national phase application, the first applicant named in the international application.
- 6.(1.7) If a patent agent who does not reside in Canada is appointed but no associate patent agent is appointed, the Commissioner shall send communications to the non-resident patent agent.

20. (1) An applicant must appoint a patent agent to prosecute the application for the applicant except if
 - (a) the application is filed by the inventor or, if there is more than one inventor, all the inventors jointly; and
 - (b) no transfer of any inventor's right to the patent or the whole interest in the invention has been registered in the Patent Office.

- (2) The appointment of a patent agent shall be made in the petition or by submitting to the Commissioner a notice signed by,
 - (a) if there is a single applicant, the applicant;
 - (b) if there are joint applicants and a common patent agent is appointed, all of the applicants;
 - (c) if there are joint applicants and no common patent agent is appointed,
 - (i) one of the applicants appointed by the other applicants as their common representative; or
 - (ii) if no common representative is appointed, the first applicant named in the petition or, in the case of a PCT national phase application, the first applicant named in the international application.

- (3) The appointment of a patent agent may be revoked by submitting to the Commissioner a notice of revocation signed by that patent agent or by
 - (a) if there is a single applicant, the applicant;
 - (b) if there are joint applicants and the patent agent was appointed as a common patent agent by all of the applicants, any one of the applicants;
 - (c) if there are joint applicants and the patent agent was not appointed as a common patent agent by all of the applicants,
 - (i) one of the applicants appointed by the other applicants as their common representative; or
 - (ii) if no common representative is appointed, the first applicant named in the petition or, in the case of a PCT national phase application, the first applicant named in the international application.

The Rules would be amended by adding, after subsection 21(4), provisions along those lines:

- 21(5) If the appointment of a patent agent made pursuant to subsection 20(2) is revoked, any appointment by that patent agent of an associate patent agent is considered to also be revoked.

- 21.1 The appointment of a patent agent or an associate patent agent must include the complete address of the agent.

- 21.2 Registration of a transfer of a patent application shall not of itself operate as a revocation of an appointment of a patent agent or an associate patent agent in respect of that application.

Section 23 of the *Patent Rules* would be amended along the lines of the following:

23. (1) If subsection 20(1) requires the appointment of a patent agent and no patent agent is appointed, the Commissioner shall by notice to the applicant requisition that, within the three month period after the date of the notice, either the applicant appoint an agent residing in Canada or the applicant appoint a non-resident patent agent and the non-resident patent agent appoint an associate patent agent.
- (2) If the applicant appoints a patent agent who does not reside in Canada and no associate patent agent is appointed in accordance with subsection 21(1), the Commissioner shall by notice to the non-resident patent agent requisition that, within the three-month period after the date of the notice, either the non-resident patent agent appoint an associate patent agent or the applicant revoke the appointment of the non-resident patent agent and appoint a patent agent residing in Canada.
- (3) The Commissioner shall not send a notice pursuant to paragraph (1) or (2) until after the expiry of at least 9 months after the filing date of the application.

Finally, clauses 94(2)(b)(ii)(F) to (I) of the Rules would be replaced by:

- (F) any drawing referred to in the description, and
- (G) an appointment of a representative if required by section 29 of the Act.

and, subparagraphs 94(3)(b)(iii) to (vi) would be replaced by the following:

- (iii) a sequence listing complying with subsection 111(1) if a sequence listing is required by that subsection, and
- (iv) an appointment of a representative if required by section 29 of the Act.