



Intellectual Property Institute of Canada
Institut de la propriété intellectuelle du Canada

Intellectual Property Institute of Canada (IPIC) Response to *Consultation on amendments to the Patent Rules,* August 7, 2023

Submission to:
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Sector

cipoconsultations-opicconsultations@ised-isde.gc.ca

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INTRODUCTION

The Intellectual Property Institute of Canada (IPIC) is the professional association of patent agents, trademark agents and lawyers practising in all areas of intellectual property law. Our membership totals over 1700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g., patents, trademarks, copyrights, and industrial designs) in Canada or elsewhere, as well as foreign companies that hold intellectual property rights in Canada.

We thank the Canadian Intellectual Property Office and the Strategy and Innovation Policy Sector for holding this consultation to collect feedback on the proposed patent term adjustment (PTA) regime under the Canada-United States-Mexico Agreement (CUSMA).¹

PROPOSED REGULATIONS RELATED TO ADDITIONAL TERM

Applying for additional term

In the consultation document, it is proposed that only the patentee on record at the time of request for additional term, or their appointed agent, if any, may make the request for additional term. Other authorized third parties would not be permitted to do so.

IPIC **agrees** with this proposal. Permitting third parties to make the request for additional term would only create confusion between the patentee, third party, and appointed agent concerning responsibilities for receiving and responding to CIPO correspondence and tracking maintenance fee due dates and consequently patent term.

The consultation document does not suggest a particular amount for the fee accompanying a request for additional term, aside from expressing the intention of taking into account the costs of administration. While the fee requirement is embedded in the *Patent Act* amendments, we recommend that the fee be set to zero, or at least as low as possible. A zero-rated or low fee

¹ Consultation document, <https://ised-isde.canada.ca/site/canadian-intellectual-property-office/en/consultation-amendments-patent-rules/consultation-scene-setter-additional-term-and-miscellaneous-amendments-patent-rules>.

amount reflects the fact that the request for additional term would not be necessary, but for undue delay by CIPO.

Determination of additional term

While the overall framework for determining additional term (e.g., the definition of the “applicable day” and the starting point for additional term calculation) is reasonable, we are seriously concerned by the proposals to deduct potential additional term set out in the Annex to the consultation document. Our comments below address the examples set out in the Annex.

Periods of time to respond to notices requiring response (section 1)

The consultation document suggests that any time taken for an applicant to respond to a notice requiring the applicant to take an action within a prescribed period be deducted from the additional term. For example, if the examiner sends a report requiring response within four months, as set out in subsection 86(2) of the *Patent Rules* and the applicant takes three months to respond, those three months will be deducted from any potential additional term.

IPIC **disagrees** vehemently with this proposal.

Firstly, it is practically impossible for any applicant to respond to a notice without incurring a deduction from potential additional term. Even when an applicant requests email correspondence from CIPO, notices are not necessarily *sent* by CIPO on the same date that the notice bears; and in those instances when notices are sent on the same date indicated on the notice, they are often sent after business hours (e.g., after 10pm Eastern time). Certainly, when an applicant receives CIPO correspondence by regular mail, they will never receive a notice on the date that it bears. Imposing a deduction of this type will penalize all applicants for simply communicating with CIPO, and will disproportionately penalize regular mail correspondents over email correspondents.

Secondly, the patent term guarantee set out in CUSMA already contemplates that examination of an application will take time without being considered unduly delayed.² In the case where

² CUSMA, Article 20.44(4) (“For the purposes of this Article, an unreasonable delay at least shall include a delay in the issuance of a patent of more than five years from the date of filing of the application in the territory of the Party, or three years after a request for examination of the application has been made, whichever is later. A Party may exclude, from the determination of those delays, periods of time that do not occur during the processing of, or the examination of, the patent application by the granting authority; ...”) and footnote 7 (“The Parties recognize the importance of multilateral efforts to promote the sharing and use of search and examination results with a

examination is requested at the time the Canadian patent system is engaged, there is ample time to conclude examination and grant a patent. Given CIPO's current performance targets³—which are being met—five years is more than enough time for a patent to grant even if the applicant responds to all notices on their due dates, or alternatively for a third examiner's report to be mailed and for the applicant to respond with a request for continued examination, at which point no further additional term will be accrued.⁴ There is no need to deduct the time taken to respond to any examiner's report or other notice in such circumstances.

On the other hand, the consultation document clearly indicates that when the request for examination is deferred more than two years, the threshold date will be three years after the request for examination. Under current performance targets, this is insufficient time to reach a third examiner's report triggering the requirement to request continued examination. However, these cases are balanced by the fact that deferred examination is likelier to result in a faster conclusion to examination, due to the fact that the applicant will have likely seen the outcome of examination of corresponding foreign applications and can apply the amendments made in foreign prosecution to the Canadian application. This correlation between deferred examination and faster compliance is in fact supported by the consultation document.⁵ Thus, again, there is no need to deduct time taken to respond to a notice, provided the response is filed within the prescribed deadline.

On that note, the notion of deducting *any* time taken to respond to a notice within the prescribed deadline is strangely contradictory: it is, in a sense, a penalty for simply abiding by the deadlines provided for in the *Act* and *Rules*. By deducting additional term for simply responding within a prescribed deadline, Applicant behavior of filing faster, lower quality responses to maximize potential patent term will be encouraged.

view to improving the quality of search and examination processes and to reducing the costs for both applicants and patent offices"): <https://www.international.gc.ca/trade-commerce/trade-agreements-accords-commerciaux/agr-acc/cusma-aceum/text-texte/toc-tdm.aspx?lang=eng>.

³ <https://ised-isde.canada.ca/site/canadian-intellectual-property-office/en/corporate-information/performance-targets>.

⁴ Paragraph 4(h) of the Annex contemplates that all time after a request for continued examination will be deducted from the additional term.

⁵ *Supra* note 1 ("History has shown that most patent applicants request examination in the final months leading up to the deadline, which indicates an interest in delaying the start of examination. Research has shown that applications with a later request for examination tend to achieve a state of compliance sooner").

Periods of time to respond to notices where a reply is not necessarily required (section 2)

It was also suggested that any time taken to respond to a notice that may not actually require a reply should be deducted. Two very different examples were given: first, in the case where an unauthorized person makes a submission in an application, the time taken to respond to a notice; and secondly, in the case of a rejected application, the time taken to respond to a notice from the Patent Appeal Board.

IPIC **disagrees** with this proposal as well.

The first example is unclear. It appears that in the case where a third party mistakenly files a submission in the wrong application, triggering some Commissioner's notice that the party is not authorized to make the submission, the applicant will be penalized even though there is no need for the applicant to take any step and the original submission was beyond the applicant's control. On the other hand, if this example is intended to capture the case where, i.e. an annuity service attempts to submit a request for reinstatement of an application that was deemed abandoned due to failure to pay a maintenance fee, there would have already been a deduction (in accordance with paragraph 4(c) of the Annex) for the overlapping time period of the abandonment.

The second example, deducting potential additional term for actually *replying* to a notice, penalizes an applicant who attempts to provide clarity. The Patent Appeal Board is obligated to proceed with a review of a rejected application whether or not the applicant makes any submission (assuming the application is not deemed abandoned for non-payment of a maintenance fee). An applicant's response to the Board's initial letter—for example, confirming that it wishes to proceed and requires an oral hearing—provides the Board with useful information concerning scheduling. An applicant's non-response does not absolve the Board of the responsibility of reviewing the application. An applicant's response to a notice under subsection 86(9) of the *Rules* may focus the Board's review of the additional defects found in the application; and again, the applicant's non-response to the notice does not absolve the Board of their duty to address those additional defects during their review. Logically, if any time period before the Board is to be deducted from potential additional term, the deduction should be taken only in cases of non-response and should be equal to the time period set out in the notice.

Periods of time to take actions prior to CIPO notification (section 3)

The consultation document also proposes to deduct potential additional term for periods of time taken to perform certain actions prior to their respective due dates. The examples provided are varied, but generally refer to actions that must be completed within a specific

period of time in order to avoid triggering a Commissioner's notice. The one outlier is the "time to pay required fees after their due date" (paragraph 3(b)): if a due date has already passed, the legal obligation for the Commissioner to send a notice has already been triggered. We assume that this is intended to refer to the case where the applicant takes the action after the prescribed due date, but before the Commissioner's notice is actually generated and sent.

IPIC **disagrees** with the proposal to deduct any potential additional term when an applicant meets a prescribed due date.

With the exception of the time taken to request examination, these examples have little, if any, impact on delaying the grant of a patent since most of the actions listed in this section tend to occur before a request for examination is made, or when the request for examination is made at filing, well before the time an examiner commences examination.

Additionally, the inclusion of priority request and document requirements is problematic. There have been many instances in which the applicant has submitted a correct DAS code, yet CIPO has been unable to retrieve a priority document either due to operator error, or delay on the part of the other patent office. Such errors are completely beyond the applicant's control. Furthermore, most applications enter Canada as national phase entries, and the request for priority and submission of the priority document would have been handled by an International Authority, not CIPO as a domestic patent office. Deducting the time to comply with priority request or document rules would unfairly penalize PCT applicants who were not even subject to Canadian law at the filing date or the time the request for priority was made. A priority request or document-related deduction cannot be fairly applied against both PCT national phase applicants and national filing applicants, or against national filing applicants (who are more likely to be Canadian applicants) alone, so should not be applied at all.

The outlier example of paragraph 3(b) is a case in which the applicant did *not* meet a prescribed due date, in which case it may be appropriate to deduct some time.

With regard to paragraph 3(a) (the time to request examination), this appears to be inconsistent with CUSMA, which contemplates that examination can be requested later. Also, penalizing an applicant for deferring the request for examination incentivizes the applicant to request examination right away, which will result in longer prosecution and more examination resources because (as acknowledged in the consultation document) applications with a later request for examination tend to achieve a state of compliance sooner. Anecdotally, applicants have seen several examples of prosecution of an application being unnecessarily protracted because the Canadian Examiner is monitoring the outcome of the examination of a corresponding foreign application, which happens more often when examination in Canada is

requested immediately. The result is more examination resources expended by CIPO and the applicant.

The consultation includes the following sentence in relation to subtracting days for delaying the request for examination: “Where the threshold date is based on the applicable date, the number of days taken to request examination of the application and to pay the prescribed fee”. This seems to penalize the applicant when they defer examination but defer less than the full four years to request examination, because if they waited four years then the threshold date would likely not be the applicable day. Instead, the threshold date would likely be three years from requesting examination.

Periods of time based on actions taken by the applicant (section 4)

The consultation document also proposes to deduct time from potential additional term for a variety of optional actions. The examples provided have little in common besides the fact that they are taken by an applicant. While some proposed deductions are logical, others are unclear.

Time to act when an extension of time has been granted and allowing an application to become abandoned (paragraphs 4(a) and (c)). We presume that “allowing an application to become abandoned” refers to the period of time between the deemed abandonment and the date of reinstatement. This time period, and the portion of an extension of time actually consumed by the applicant, appear to be reasonable deductions from additional term assuming they are fairly implemented in the *Patent Rules*.

Submitting a voluntary amendment during certain periods and time to make an agreed-upon voluntary amendment after an examiner interview (paragraphs 4(b) and (d)). We disagree that the submission of a voluntary amendment, under any circumstances, should be a source of deduction of potential additional term. It is not clear what the rationale is for penalizing an applicant for submitting a voluntary amendment, or what “certain periods” are of concern.

In the case of an amendment made after an examiner interview, it is unfair to penalize an applicant for taking the proactive step of making the voluntary amendment. An amendment in these circumstances avoids the need for the examiner to send a further report, and reduces pendency.

Time between filing date and supplying missing parts and time to provide a copy of the application when filing by reference (paragraphs 4(e) and (f)). Paragraph 4(e) of the Annex, as written, is unclear. We assume that this was intended to refer to section 28.01 of the *Patent Act* rather than an impermissible amendment to add subject matter not reasonably inferable from

the application on its filing date. These deductions appear to be reasonable, again if they are fairly implemented.

All time after an impermissible amendment after a conditional notice of allowance (paragraph 4(g)). We **disagree** with this proposed deduction because evaluating this condition requires an exercise of discretion on the part of the examiner, unlike other time periods contemplated in the consultation document.

All time after a request for continued examination (RCE) (paragraph 4(h)). Some sort of deduction appears to be reasonable if fairly implemented in the *Rules*. However, to deduct every single day after filing an RCE up until allowance (or final fee payment) is unfair at least because it will incentivize CIPO to delay the examination of all cases for which an RCE has been filed, focussing instead on applications in which an RCE has not yet been filed and in which additional term may accrue. To be equitable, patentees should also be compensated for undue delay in the issuance of individual examiners' reports beyond published performance targets (not client service standards under the *Service Fees Act*).

All time after a third examination report for applications filed before October 3, 2022 (paragraph 4(i)). We **disagree** with this proposed deduction. It is unclear why applications filed prior to October 3, 2022 are being treated differently than other applications. We speculate that the consultation document intended to refer to applications for which a *request for examination* was made before October 3, 2022. Even so, we consider the proposal to deduct "all time after a 3rd examination report" for such applications to be unfair because it does not match the proposal of paragraph 4(h) for applications having a request for examination on or after October 3, 2022.

An amendment is made to bring the application into compliance with Act and Rules after an examiner rejection (paragraph 4(j)). We also **disagree** with this proposed deduction, which essentially proposes to deduct all time once the applicant has responded to a final action with an amendment.

Consider the case where the applicant responds to a final action with an amendment which the examiner does not believe brings the application into compliance, but that the Patent Appeal Board finds *does* make the application compliant with the *Act* and *Rules*. The entire period of time between the applicant's response after final and the Commissioner's decision (and subsequent formal amendment of the application) was *not* the applicant's fault: it was the fault of the examiner that the applicant was compelled to have their rejected application reviewed by the Commissioner. The applicant should not be deprived of additional term because of the examiner's error.

Furthermore, most, if not all, final actions are preceded by at least two examiner's reports. Consequently, for those applications for which the request for examination was made on or after October 3, 2022, a request for continued examination would have already been made, so any additional deductions will overlap the continued examination period and are unnecessary.

Other periods of time (section 5)

The consultation document also proposes that days may be deducted for delayed or lost correspondence, disruption of CIPO operations, appeals from refusals, and judicial reviews.

IPIIC **disagrees** with these proposed deductions as well. Applicants are not responsible for CIPO's failure to deliver correspondence. As CIPO well knows, there have been several instances when their outgoing mail procedures have failed. Generally, applicants are not responsible for their own failed submissions, either. In our members' experience, most instances of delayed or lost correspondence submitted by agents and applicants are seldom the fault of the agent or applicant; rather, they are the fault of CIPO's Incoming Correspondence Unit, or a failure of CIPO's online submission applications.

In the case of Federal Court proceedings, it is patently unfair to reduce additional term when an applicant *successfully* appeals a refusal of their application or is successful in judicial review. An applicant's success in Federal Court indicates that the delay is entirely the fault of the Commissioner or CIPO, and the applicant should not be penalized by the reduction of additional term.

If the applicant is *unsuccessful* in a court proceeding, the result is generally that no patent will issue at all, so additional term is not an issue.

Processing of applications for additional term

Given the constraints imposed by the amendments to the *Patent Act*, which require the patentee to request additional term after issuance and pay the prescribed fee, and the lack of a mechanism for CIPO to increase PTA once a final PTA decision is made, it appears the proposed process for handling requests for additional term is necessary to ensure that patentees have the opportunity to correct an undercalculation by the Commissioner without having to resort to a judicial review in Federal Court.

However, we believe that the process can be somewhat simplified by removing any express steps concerning public notice, as discussed below.

Public notice and certificates of additional term

The consultation document contemplates that the regulatory amendments may include specific public notice procedures, which would require the Commissioner to inform the public of a receipt of a request for additional term or a request for reconsideration.

Assuming the regulations would provide that public-notice requirements are met by uploading request documents to the Canadian Patent Database, IPIC takes no position on this proposal since this procedure would not create additional tasks on the part of CIPO or patentees. However, if the public notice requirements require additional positive steps to be taken by the Commissioner, IPIC would oppose such requirements if they have the potential to create any delay in the PTA application process.

Generally, we do not think that there is any specific information that should be conveyed to the public concerning additional term to be granted to a patentee, beyond the Commissioner's final decision as reflected in the Certificate of Additional Term, which should be included in the documents available in the Canadian Patent Database. Creating specific public notice documents or webpages is highly unlikely to incite public participation in the PTA process. Currently, third parties who engage with an application or patent before CIPO generally do so with the intention of reducing the scope of a patent's claimed exclusive right through protests, submissions of prior art, and re-examinations, all of which can provide needed certainty to the third party. Even so, the level of third-party participation through these mechanisms is extremely low. Participating in the PTA process will not affect claim scope, so we do not expect much, if any, participation by third parties.

Furthermore, we expect that if third parties are concerned about the additional term granted to a patentee, that concern will only arise as the patent approaches its twentieth anniversary. A third party would be more inclined to challenge the additional term computation when the additional term is imminent and likely to be maintained, not at the time the patent is granted several years earlier.

Maintenance fees

The amendments to the *Patent Act* require the collection of maintenance fees for the additional term. However, the amount of these fees is to be set by regulation.

IPIC **disagrees** with the concept of levying maintenance fees for additional term and recommends that the fee be set to **zero**.

If the additional term granted includes a fraction of a year and the maintenance fee is prorated accordingly, we are concerned that the computation of the maintenance fee amount will create too many opportunities for error and additional burden on CIPO, agents, and patentees, since the complete maintenance fee schedule for a patent will not be known at the time of grant, but only potentially months later.

Indeed, in this consultation, ISED has clearly signaled that they expect additional term will be short. In our discussion, it was suggested that additional term would be counted in days, not months or years. Thus, most additional term will be so short that assessing and collecting the maintenance fee would probably cost CIPO—and patentees—more than the value of the fee.

OTHER PROPOSED AMENDMENTS TO THE PATENT RULES

Deferred examination

The consultation document proposes a new extension of time for requesting examination, which would enable applicants to defer the request for examination beyond the current four-year due date. ISED has acknowledged that deferred examination can help conserve resources at CIPO, and that their research has revealed that later requests for examination correlate to faster compliance once examination does begin. These findings are consistent with the experience of IPIC's patent agent members; many applicants defer Canadian examination pending the outcome of foreign prosecution of corresponding applications and use the results of foreign prosecution to inform claim amendments in the Canadian application—or to decide whether to allow the application to go abandoned.

While applicants would generally prefer a longer deferral period in section 81 of the *Patent Rules* rather than an additional deferral procedure, IPIC **agrees** with the concept of permitting applicants to defer the request for examination beyond the current four-year due date. We recommend that applicants be permitted to seek at least an additional two years of deferral.

However, we **disagree** with the proposed implementation of additional deferral. The consultation document proposes to use the current extension of time mechanism, which requires the applicant to provide reasons for the extension sought, and the Commissioner to review these reasons and exercise discretion in granting or refusing the extension. Additionally, the consultation document queries whether the applicant should provide further information, such as a statement of intention to align the Canadian application with a corresponding foreign application once the foreign application is allowed or granted. The process should neither require the applicant to provide reasons justifying the extension of time, nor a statement of

intention. If these requirements are imposed, many applicants will be reluctant to take advantage of deferral.

We understand that CIPO will take any reasons or statements supplied by an applicant at face value, but it is not clear how such reasons or statements will impact later proceedings should the applicant change their mind. For example, an applicant may initially intend to amend their Canadian application to correspond to the claims of the corresponding US application, once allowed; but the US application may ultimately be abandoned due to legal factors that do not exist in Canada (e.g., prior art citable under US law may not be citable under Canadian law). As another example, the applicant may wish to pursue different Canadian claims if they discover a potential infringer operating in Canada whose activities would avoid infringement of the US claims, were they issued in Canada. Still, under section 53.1 of the *Patent Act*, statements made by the applicant concerning their intended claim scope may be admitted into evidence in a later proceeding concerning the patent to rebut the patentee's assertions concerning claim construction. We cannot predict how courts will weigh reasons or statements made when seeking an extension of time, even if the extension of time is not granted or even if the patentee is afforded an opportunity to explain why their actions diverged from their stated intention. This uncertainty is enough for many agents to recommend against seeking an extension of time to request examination.

Clearly, CIPO and ISED are concerned about the reduction of workload. CIPO resources have been taxed repeatedly by amendments to the *Patent Act* and *Rules* in 2019, 2021, and 2022 and COVID-related measures, requiring new policies and training on the one hand, and resulting in surges in incoming correspondence on the other hand. The consultation document expresses concern for the use of CIPO resources several times. CIPO has significantly increased its 2024 fees in order to compensate for a serious budgetary shortfall. It is surprising, then, that the proposed scheme calls for the Commissioner to add to their workload by requiring applicants to submit reasons and statements for review. IPIC recommends instead that the requirement to provide reasons for deferral of the request for examination—or, indeed, for *any* extension of time—be removed.

We recognize that eliminating the requirement for reasons satisfying the Commissioner in granting an extension of time will also require amendment of paragraph 12(1)(j.8) of the *Patent Act*. A simpler solution may be to amend subsection 135(1) of the *Rules* to specify that subparagraph 73(3)(a)(ii) and paragraph 73(3)(b) of the *Act* do not apply to any failure under paragraph 73(1)(d), regardless of when the request for reinstatement is made. This would provide applicants with the option to defer examination through abandonment, while also ensuring that they do not benefit from additional term. An extension of time scheme such as that suggested in the consultation document could then be implemented to permit applicants to extend the time to reinstate the application after a failure to request examination.

IPIC does not take a position on the proposal to create a mechanism for third parties to protest a delay generated by extending the examination deferral.

Suspension of Examination

The consultation document proposes to amend the *Patent Rules* to specify that examination of an application is “suspended” when the application enters a maintenance fee late payment period due to the failure of the applicant to pay the maintenance fee by the anniversary due date. This particular amendment pertains only to the late payment period rather than the abandonment period, since the *Rules* already provide that examination is suspended when an application is abandoned.⁶ The rationale for this amendment expressed in the Consultation materials is the conservation of resources by avoiding unnecessary examination of an application.

IPIC **disagrees** with this proposal. Examination of an application is only “unnecessary” if it turns out that the applicant failed to pay the maintenance fee by the anniversary due date because they wished to abandon the application. Even in that situation, CIPO benefits because CIPO keeps the examination fee without the need to fully complete the examination process.

A delayed payment of maintenance fee, by itself, cannot be relied on as a signal that an applicant has chosen to abandon the application, rendering examination unnecessary. Since the maintenance fee amendments in the *Patent Act* and *Rules* came into force in 2019, agents have found that it is often the case that a missed application maintenance fee was not due to an intention to abandon, but rather a miscommunication between the applicant and a third-party payer (typically, an annuity service), or the applicant’s accidental failure to provide payment instructions in a timely manner. From the due care submissions by applicants seeking to reinstate applications deemed abandoned for non-payment of maintenance fees, CIPO has now seen many examples of missed maintenance fees in applications which applicants *did* wish to maintain and have examined. On the other hand, the consultation document does not provide any insight into the frequency of examiners’ reports or other notices being issued that turned out to be “unnecessary” because the application was subsequently abandoned. Indeed, even when an application is ultimately abandoned, examination is not “unnecessary”: applicants often decide to abandon an application *because* of the defects identified in an examiner’s report.

⁶ *Patent Rules*, s. 86(17).

Furthermore, insofar as PTA is concerned, this amendment is unnecessary if payment of a maintenance fee during the late payment period will incur a deduction against PTA as proposed. The portion of the late payment period consumed by the applicant will already be deducted from any PTA owing; defining such a period as a period of suspension will not change the outcome of the PTA calculation.

We also observe that implementing this proposal would likely net minimal efficiencies while **prolonging prosecution**, creating undue delay in patent issuance.

Currently, the status of the application as being in the late payment period cannot be safely updated until all incoming correspondence for the maintenance fee due date has been processed. To ensure that incoming correspondence is not overlooked, CIPO does not update the status of applications in response to missed due dates until a “grace period” for processing incoming correspondence has expired. If these grace periods continue to be observed, examination of the application cannot be deemed to be suspended until the grace period expires and it is known for certain that the application is in the late payment period. Therefore, examiners must still examine applications that *appear* to be in the late payment period, whether or not the late payment period was actually triggered; some of this examination will be “unnecessary”. On the other hand, if examiners are instructed to defer examination of applications that are in grace until the status has been updated to indicate that the maintenance fee has been paid, some examiners’ reports will be needlessly delayed. This unnecessary delay will contribute to PTA.

Priority requests and requests for early open to public inspection on same day

IPIC **agrees** with the proposal to amend section 73 of the *Patent Rules* to simplify the due dates for requesting priority. We recommend that this amendment be made retroactive so that it applies to all applications, regardless of filing date.

Top-ups of small entity fees paid in category 3 applications

While not directly responsive to this consultation, we again request that section 190 of the *Patent Rules* be amended to permit the applicant of a category 3 application to correct an application fee that was paid in good faith at the small entity rate. While most small entity fees are covered by subsection 190, the application fee under subsection 3(2) of the former *Rules* is not included.

It is not clear that the applicant may avail themselves of section 27 of the *Patent Act* as it read prior to October 30, 2019, in order to pay the correct application fee when correcting other fee payments under section 190 of the *Rules*.

CONCLUSION

Thank you again for the opportunity to comment on contemplated changes to the *Patent Rules* to implement patent term adjustment. We would be pleased to review any of these points in more detail and look forward to future discussions on this initiative.

If we may be of further assistance, please do not hesitate to contact our CEO Adam Kingsley by phone (613-234-0516) or email (akingsley@ipic.ca).