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Canadian Patent Office Shortens the Time Between Payment of the Final (Issue) Fee and Issuance of the Resulting Patent from Ten to Eight Weeks (With a Further Reduction Coming)

What Are the Implications of These Changes?

By Solomon Gold, Partner, Patent and Trade-mark Agent

Over the summer, the Canadian Patent Office announced that it would be amending its process for issuing patents by reducing the time between payment of the final fee in a pending application (sometimes also called the issue fee) and issuance of the resulting Canadian patent. For many years, the delay between payment of the issue fee and issuance of the patent has been about ten weeks. We say "about" because, while the issue fee may be paid on any day, the Canadian Patent Office has adopted the practice of issuing patents only one day a week (Tuesday). As of August 16, 2016, the delay was reduced to eight weeks, and in its announcement, the Patent Office indicated that the delay will be further reduced to six weeks sometime later in the fall.

This "delay-period", however, is not absolute. If maintenance fee payments are not up to date, or if there is a maintenance fee that has a deadline for payment before the issue date (or slightly after it), the Patent Office will not apply a paid final fee until after maintenance fees (and possible late fees) have been paid. It is only after maintenance fees are brought up-to-date that the paid final fee will be applied and the "delay-period" will start to run. So, if an applicant of an allowed application is eager to have a patent issue, not only should the final fee be paid – any maintenance fees that are past due (and still payable with a late fee) or are soon to be due should also be paid.

While it is obviously better for an applicant to get what it has paid for (a patent) sooner rather than later, there is one important implication from the changes in the "delay-period". Many applicants who are interested in filing one or more divisional applications want to delay as long as possible in order to defer costs. If an applicant is interested in filing a divisional application after it has paid the final fee, it must remember that the time limit for filing the divisional has now been shortened too. Under Canadian law, a divisional application can only be filed before a patent issues. If the divisional is filed on the day the patent issues, or later, it does not get the benefit of the filing date of the parent application, so the issued patent will be citable against it.

Additionally, while there may be a cost advantage in filing a divisional application as late as possible, a decision to file a divisional application should be considered as early as possible due to particularities of Canadian law. Double patenting needs to be considered under Canadian law. While double patenting concerns may be addressed in the United States by filing a terminal disclaimer, terminal disclaimers do not exist under Canadian law. While double patenting concerns may be addressed in Europe by ensuring that there is no overlap in subject matter claimed in the parent and in the divisional, the test in Canada is somewhat different. Under Canadian law, what is claimed in a second patent to issue (here, the divisional) must be non-obvious in view of

what is claimed in a first patent to issue (the parent). In Canada, it is safest to claim all subject matter that an applicant is interested in in a single application (the parent) prior to Canadian examination. If a lack of unity of invention objection is raised during Canadian examination, then one invention (as characterized by the Canadian examiner) may be claimed in the parent and one or more divisionals filed claiming the other inventions (as characterized by the Examiner). While the possibility of filing divisionals is considered early, the filing of divisionals may be deferred until just before the parent is about to issue.

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