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Proposed Amendments to the Canadian *Patent Rules*

Changes coming to reinstatement provisions mean that it will be important to adhere to time limits imposed under Canadian law

Canada is in the midst of amending its intellectual property laws in order to make those laws compliant with requirements mandated by its agreeing to enter several international treaties relating to patent, trademark and industrial design law.

The Canadian government released its proposed amendments to the *Patent Rules* for public comment in early August, and the public consultation period ended in early September. The government will now study the submissions that it has received, make any amendments that it considers to be appropriate and then move ahead with bringing the amended *Patent Rules* into force. While it is not believed that the amended *Patent Rules* will be finalized and come into force until next year at the earliest, there are certain proposed changes that should be brought to the attention of all patent owners and applicants.

Presently, Canada has some very generous provisions relating to reinstatement of abandoned applications and lapsed patents – so long as a request for reinstatement is made within twelve months of the abandonment/lapse and is made with a reinstatement/late fee, reinstatement is granted as of right. Canadian law also allows for late Canadian national phase entry up to twelve months after the thirty-month deadline for national phase entry provided for international Patent Cooperation Treaty (PCT) applications at up to forty-two months after the international PCT application's priority date, simply by requesting late entry together with payment of a late fee.

With the proposed amendments, the time limits and requirements for and the consequences of reinstating an abandoned application or lapsed patent will change in some circumstances. The window for late national phase entry (that is, the ability for a PCT international application to enter the Canadian national phase between thirty and forty-two months after the international application's priority date) will continue, but in addition to paying a late fee, an applicant will have to submit a declaration that the failure to meet the thirty month deadline was unintentional and a statement of reasons for failure to meet the deadline. In order for late national phase entry to be permitted, the Commissioner of Patents will have to determine that the failure was unintentional.

Additionally, Canadian law will change to require a notice be sent out to an applicant when the deadline for requesting examination and paying the examination fee is missed, to an applicant when the deadline for paying a maintenance fee on a pending application is missed, or to a patentee when the deadline for paying a maintenance fee on a granted patent is missed. The notice will advise of the missed deadline and set a firm deadline. If the firm deadline is missed, the case shall become abandoned and reinstatement of the case will no longer be granted as of right so long as the request is made in a timely fashion with the required payment of a reinstatement/late fee. A demonstration that the



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deadline was missed despite the applicant/patentee taking due care to meet the deadline will be required if a maintenance fee is missed or if a request for examination is made more than six months after the deadline for doing so. Significantly, third parties may acquire rights to use the invention that is claimed in the application/patent if their use commences during the period of abandonment.

While these provisions are only proposals and have not yet come into force, it is important to note that it is likely that the reinstatement provisions of Canadian patent law will change once the proposed amendments to the *Patent Rules* are finalized and the new Rules come into force. There will be serious consequences for failing to adhere to certain time limits, and it will not be able to cure those consequences merely upon payment of a reinstatement or late fee.

The proposed amended Patent Rules may be found at the following link:

[https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapi/projet_reg_br-proposed_pa_rul-2017.pdf/\\$file/projet_reg_br-proposed_pa_rul-2017.pdf](https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/vwapi/projet_reg_br-proposed_pa_rul-2017.pdf/$file/projet_reg_br-proposed_pa_rul-2017.pdf)

The government's consultation document discussing the proposed amendments may be found at the following link:

<http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04279.html>

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