

# A Goose-Eye View of the New Canadian Patent Rules

Coming into force on October 30, 2019

## Purpose:

- **Compliance with the Patent Law Treaty**
- **Harmonization with US & EP**
- **Modernization & Simplification of Procedures**



## Key Changes for Foreign Applicants

### **National phase entry due at 30 months.**

National entry can no longer be delayed until 42 months from priority, unless the Applicant satisfies the Patent Office that the failure to meet the 30-month deadline was unintentional. This change rules out late entry for most cases. Applicants should now assume that they must enter Canada by the 30-month deadline. This change will apply for all PCT applications filed **on or after October 30, 2019**.

### **Restoration of priority now available under the unintentional standard.**

If priority was restored during the PCT phase, this will now be accepted for the Canadian national entry. Deadline for restoration is 14 months from priority or 1 month after national entry. It is strongly recommended to restore priority during the PCT phase whenever possible.

### **Office action responses now due at 4 months.**

A 2-month extension of time is available at the Patent Office's discretion, with a fee. The extension of time must be requested before expiration of the 4-month deadline, and a reason must be provided. However, if the deadline is missed, the application can be reinstated as a matter of right within 1-year.

### **Request for Examination now due 4 years after Canadian/PCT filing date** (previously 5 years).

### **Reinstatement of abandoned patent applications no longer "as a matter of right" in every case.**

Reinstatement deadlines and requirements will vary depending on the deadline missed and on the cause of abandonment. A showing of "due care" may be required for reinstatement. Applicants should avoid missing deadlines, particularly for maintenance fee and examination fee payments.

### **Introduction of third party rights.**

Third party rights may now be triggered by abandonment/expiry of patent applications/patents and used as a defence to infringement, even where patent applications/patents are subsequently reinstated. Temporary abandonment during prosecution should be avoided in most cases to avoid triggering third party rights.

### **Maintenance fees for pending patent applications can now be paid by any party (not only the agent of record).**

Applicants will have more flexibility in paying fees. However, there are some risks associated with using a third party, since the Patent Office will only notify one designated party of a missed payment or abandonment. Clear guidelines for Patent Office communications will need to be followed to avoid accidental abandonment.

**Simplified procedures** for making amendments after allowance and for recording changes in Inventor names and Applicant names will be put in place.

**Sequence listings will no longer incur excess page fees.**

## What Stays the Same

- **Fees remain largely unchanged** (except no more fees for sequence listings)
- **No claims fees**  
Put all claims in one patent  
Use multiple dependencies
- **Flexibility:** claim amendments can be made at any time.
- **Patent Prosecution Highway:** about 37% of PCT-PPH applications and 26% of PPH applications are allowed without an office action. No fee.
- **Patent term extension for pharmaceuticals** (max. 2 years), and other CETA-based provisions are unchanged.
- **Problematic Voluntary Divisional Practice**
- **No Continuation-Type Practice**
- **1-year grace period for disclosures by Applicant (based on the Canadian/PCT filing date)**

## Questions?

For more information, please contact us.



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