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Discussion on Chinese service invention-creation and rights ownership thereof

Zhongling HAN and Xiaodong WANG of Beijing Sanyou Intellectual Property Agency Ltd. offer advice for determining an “Employer-First” and “Employee-First” dual model as a solution for invention-creation ownership.

An interview with GE

Page 12



New Canadian rules

Page 16



Adaption of the description

Page 21

Patent applicants dash to avoid costly new Canadian Rules

Noel Courage, Partner at Bereskin & Parr, explains the changes to Canadian Rules introduced to improve examination efficiency that may increase prosecution costs.

Résumé

Noel Courage, Partner

Noel is a member of the Life Sciences practice group. Noel's practice focuses on the patenting and licensing of biotechnological, chemical and mechanical inventions.



Noel Courage

The Canadian Intellectual Property Office has been importing patent rules based on those in other jurisdictions, such as the USA and Europe. Sometimes these Canadian updates are due to treaties. For example, Canada implemented the Patent Law Treaty which primarily harmonizes procedural requirements. The Canadian free trade agreement with the US and Mexico requires creation of a system of patent term adjustment. Canada also signed a trade agreement with Europe that led to patent term extension. There is nothing new about treaty obligations leading to updates in Canada's intellectual property laws.

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Other times Canada has imported bits and pieces of patent law on its own initiative, such as the adoption of US-style file wrapper estoppel and the creation of patent agent privilege. These ideas have typically been adopted in a modified form, without meaningful stakeholder consultation. A piecemeal approach to patent law, without broad input from interested parties is not the best way to evolve patent law. There has been a steady flow of change to the Canadian patent system in recent years.

This article will look at a couple of key aspects of the newest Canadian Patent Rules that have caught the attention of patent filers.

Many applicants are currently taking immediate action to avoid the new rules and get grandfathered under the current rules. As explained below, action is required before October 3, 2022 (really before September 30, 2022 in view of CIPO holidays) to avoid the new rules. This article will also comment on steps to take if a patent application is going to be proceeding under the new rules.

The New Rules

Canada has again looked abroad for inspiration for its latest new rules. As of October 3, there will be, for the first time, excess claim fees, and a cap on the number of Office Actions prior to incurring fees to continue the examination process. The new Rules are said to be intended to improve examination efficiency.



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Excess Claim Fees

Under the current rules there are no excess claim fees under any circumstances. There will soon be excess claim fees of CAD\$100/claim for each claim in excess of 20. The fees will be due when requesting examination. The request for examination is due no later than four years from the Canadian filing date (PCT international application filing date). Fees are initially assessed based on the number of pending claims at the time of requesting examination. Additional claim fees will be owed at the time of paying the patent grant fee if the total number of claims increased during prosecution.

RCE

After three Office Actions, a request for continued examination (RCE) will have to be filed and an additional fee paid. This fee will be the same as the usual request for examination fee. If prosecution continues to an additional two Office Actions, an additional RCE fee will have to be paid to proceed further.

The RCE will also become the new mechanism to reopen and continue prosecution after a notice of allowance of claims has been issued. Typically prosecution is only reopened where



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the applicant wishes to add additional claims to a patent application. Due to Canada's strict rules against double patenting, all claims should typically be pursued in a single patent application where possible, which is why applicants sometimes want to go back and add more claims after allowance.

There are other revisions to the rules being implemented, which are less drastic, and will not be discussed here.

Recommended Actions

If you are reading this article before October 3, 2022, any applicant that intends to pursue over 20 claims in Canada should consider the impact of excess claim fees on their patent budget. Likewise, if a complex case could have a long prosecution, the budget may need to be increased. There may be no consequence of going under the new rules if there are 20 or fewer claims and the applicant has a clear, confident position on patentability.

Applicants that wish to avoid the new rules should consider filing their patent applications in Canada and requesting examination prior to October 3, 2022. For example, PCT national phase applications may enter Canadian national

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phase early, prior to October 3. Applicants with applications already pending should consider requesting examination. Taking these steps will avoid the caps on Office Actions, and request for continued examination fees.

If you are reading this article on or after October 3, 2022, Applicants with a lot of claims will have to consider either paying excess claim fees or reducing their claim set to reduce fees. To minimize the likelihood of RCE fees, proactive claim amendments and full arguments early on in examination would be a good way to try to expediently conclude prosecution.

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