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Business Not As Usual: Adapting to Canada's Streamlined Patent Regime

Introduction

As discussed in our [previous article](#), the Government of Canada is modernizing the Canadian patent regime. One of the goals is to streamline the patent prosecution process. While the prosecution process may become more efficient, applicants may need to adapt to the changes as they seek patent protection in Canada.

In view of the new streamlined patent regime, certain patent prosecution strategies may need to be rethought.

Rethink: Abandon patent application to "extend" deadlines by 12 months

Under the current patent regime, applications that are abandoned may be reinstated as of right within 12 months. Applicants may have leveraged this as-of-right reinstatement to effectively extend deadlines by 12 months, by intentionally abandoning an application, and then reinstating the application.

Under the new patent regime, some reinstatements, such as those in regards to: (1) applications abandoned for failure to pay a maintenance fee, (2) applications abandoned at or after 6 months from the request examination due date for failure to request examination, or (3) patents expired for failure to pay a maintenance fee, will no longer be as of right. Rather, when requesting reinstatement of such applicants or patents, applicants will be required to demonstrate that they took "due care" to avoid missing the deadline. In addition, rights may be afforded to third parties who, while patent rights are uncertain, take actions in good faith that would otherwise constitute an infringement. Accordingly, applicants should pay close attention to deadlines in the patent prosecution process under the new patent regime. In particular, intentionally missing maintenance fee or request examination deadlines should no longer be viewed as a mechanism for extensions of time.

Rethink: Late entry into national phase

The deadline for national phase entry into Canada is 30 months from the priority date of the PCT application. The current patent regime allows for late national phase entry into Canada as of right, up to 42 months from the priority date, by paying a late fee. Applicants may have strategically targeted the later 42-month deadline for late national phase entry into Canada in order to, for example: (1) delay payment of costs, (2) allow patent prosecution in other jurisdictions to proceed forward to inform the prosecution strategy in Canada, or (3) observe market behaviours to drive business decisions.

The new Patent Rules still allows for late national phase entry into Canada up to 42 months from the priority date, if the 30-month deadline is missed. However, for the late entry request to be accepted, the



applicant will have to submit a statement that failure to enter national phase by the 30-month deadline was "unintentional".

Accordingly, late national phase entry into Canada up to 42 months from the priority date is no longer as of right. Applicants should make a decision on national phase entry into Canada at the same time as other 30-month jurisdictions such as the United States.

Rethink: Following the patent prosecution strategy used in the corresponding United States case

The patent prosecution process in the United States tends to be faster than in Canada. Accordingly, for an applicant that is prosecuting a Canadian patent application and a corresponding United States patent application, when an office action is issued against the Canadian application, the prosecution of the United States application may already be complete, e.g. a United States patent may have been granted. As such, the applicant may apply the successful patent prosecution strategy used in the United States case to the Canadian case with some confidence.

This approach may still be viable in the new patent regime. However, the new Patent Rules shorten the time limits of certain steps during the prosecution process, such as requesting examination and responding to office actions. Therefore, the prosecution of the Canadian case may "catch up" to the prosecution of the United States case. In other words, an office action may be issued against the Canadian application before the prosecution of the United States application is complete.

Under the new regime, the applicant may have to prosecute both the Canadian case and the United States case in parallel. Applicants should take a more active interest in the Canadian case rather than waiting to see how foreign patent prosecution plays out.

For more information or for questions on changes to Canada's patent regime, please contact one of our [patent professionals](#).

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