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Chapter 19

Amendments to patent applications

19.01 Submission of amendments by the applicant

Applicants may amend their applications either on their own initiative or in response to an examiner's requisition. The amendment must comprise new or replacement pages for any changes made to the application and a supporting explanation as described in sections 19.02.02 and 19.02.03, below. It is strongly recommended that the template, as outlined in section 19.02.04 below, be followed.

19.01.01 Signature on the amendment

Under subsection 6(1) of the *Patent Rules*, an amendment must be signed by the authorized correspondent. In this regard, please refer to sections 4.02 and 4.03 of MOPOP regarding the appointment of agents and representatives.

The patent agent's signature, the firm's seal or stamp, a covering letter with the official letterhead or a mark recognized by the Patent Office to identify the firm will be accepted as a signature for an authorized correspondent who is a patent agent or an associate patent agent practitioner in a firm listed in the patent agent register. For other authorized correspondents (that is, an inventor, assignee, representative), the paper copy of the amendment must be signed, although a copy or an image of the signature on a fax or an electronic image is acceptable.

When an amendment is filed by a person or firm other than by the authorized correspondent on file at the Patent Office, this person or firm will be notified by office letter to request an appointment or revocation of agent or representative properly signed by the applicant. The amendment will be entered only after such an appointment or revocation is received. If the amendment follows an examiner's report or an office letter, this appointment or revocation must be submitted prior the due date in order to avoid abandonment of the application.

When an amendment is submitted along with, or following, a recent appointment or revocation of agent or representative, an opening sentence should be incorporated on

the first page of the amendment to indicate that an appointment or revocation form is being concurrently filed, or has been recently filed.

19.02 Form of amendments

Under subsection 8(1) of the *Patent Rules*, communications addressed to the Commissioner in relation to a patent application must relate to one application only; however, several actions with respect to one application can be combined in the same communication. Communications regarding amendments, the appointment or revocation of agents and the payment of fees should be incorporated in the same letter using uppercase headings to introduce each action (see section 19.02.04 on Suggested Templates for Amendments).

Amendments to the application are made by inserting new pages or replacing existing pages altered by the amendments (section 34 of the *Patent Rules*). New pages must be supplied for all affected pages, irrespective of whether the changes are for adding or deleting matter.

For applications filed after October 1, 1996, all pages altered by the amendment must meet the criteria of sections 68 to 70 of the *Patent Rules* with respect to documentation presentation, section 73 of the *Patent Rules*, with respect to the numbering of pages and section 85 of the *Patent Rules*, with respect to the numbering of claims. It should be noted that while claims must be numbered consecutively in Arabic numerals, page numbers may take any form provided that they are consecutive. For example, the sequence 1, 2, 3, 3A, 3B, 4 would be acceptable for page numbering, especially when pages are inserted. If pages are deleted, the applicant can renumber the description to keep the numbering in sequence. Alternatively, the applicant may submit obliterated pages by an oblique line, which are appropriately numbered, to replace the deleted pages.

For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, all pages altered by the amendment must meet the criteria set out in sections 133 and 135 of the *Patent Rules*.

For applications filed before October 1, 1989, all pages altered by the amendment must meet the criteria of sections 169 and 171 of the *Patent Rules*.

Under subsections 71(3), 136(3) and 172(3) of the *Patent Rules*, the text matter of the abstract, the description, the drawings and the claims shall be wholly in English or wholly in French. However, the response can be filed in the other Canada official language provided that the text matter of the application and the amendments are wholly in English or wholly in French. The Patent Office will communicate with the applicant using the official language of the application, unless the applicant indicates in the response that he or she prefers to receive future communications in the other official language.

Amendments requested to take effect at some time in the future (delayed amendment), are not permitted by the Patent Office.

19.02.01 Supporting explanation

Under section 34 of the *Patent Rules*, every amendment made to an application must be accompanied by a written statement in a covering letter explaining the nature and purpose of the amendment.

If the amendment is in response to an examiner's requisition identifying defects in the application, the written statement must explain the manner in which the amendment overcomes the defects. If this statement is not provided, the Patent Office enters the amendment (except as described in 19.07 below) and the applicant is requisitioned by the examiner to provide the necessary information within a specified time limit. Where possible, the Patent Office indicates the type of information which, if it were supplied, would satisfy the requirements of section 34 of the *Patent Rules*.

The written statement must also provide complete instructions for entering the amendment into the application by specifying how pages are to be cancelled, inserted or replaced. If the instructions are vague or incomplete, the amendment will not be entered into the application file and the Patent Office will requisition clearer instructions by office letter within a specified time limit.

19.02.02 Entry of new pages into the application file

Generally, when an amendment is received in the Patent Office, it is entered into the application file before an examiner determines its acceptability. New pages submitted

by the applicant are substituted in place of the pages altered by the amendment and the covering letter with the supporting explanation for the amendment is attached to the file.

It should be noted that the entry of new pages into the application file does not denote acceptance of the amendment by the examiner.

19.02.03 Amendments to very large applications

Applications containing more than 1000 pages are considered to be very large applications.

The Patent Office requires that amendments regarding an application which was originally filed on CD-ROM has to be submitted on CD-ROM in duplicate. The CD-ROM must include a revised copy of the entire application with instructions in the covering letter filed in conjunction with the amendment describing the changes that were made.

The acceptable formats for graphic images are listed in section 5.03.02 of MOPOP and in the CPOR Notice dated December 28, 1999 (CPOR Vol. 127 No. 52, Notice No. 20).

19.02.04 Suggested templates for amendments

Under section 7 of the *Patent Rules*, communications addressed to the Commissioner in relation to an application must include:

- the name of the applicant or inventor;
- the application number, if one has been assigned by the Patent Office; and
- the title of the invention.

Further, it is recommended that the filing date and the classification, if known, be identified on the amendment. This information is useful to validate the application number.

It is also recommended that one of the following headers in uppercase be used to

identify the nature of the amendment, as applicable:

- VOLUNTARY AMENDMENT
- VOLUNTARY AMENDMENT FOLLOWING PCT NATIONAL ENTRY
- AMENDMENT/REMARKS AFTER EXAMINER'S REPORT
- AMENDMENT/REMARKS AFTER OFFICE LETTER
- VOLUNTARY SUBMISSION

The response should begin with all the instructions for entering the amendment(s) into the application, followed by any remarks. The instructions should be divided by clear headings representing each section of the patent application addressed such as the abstract, description, claims and drawings for each section of the patent application. Since the applicant may need to address several requisitions, distinct headings in the remarks for each requisition are advisable.

When an amendment is combined with other matters in the same letter, a heading for each matter in uppercase should introduce the matter, and all the different matters should be listed in uppercase on the first page of the letter, such as:

Voluntary Amendment
Appointment and Revocation of Agent
Request for Examination
Maintenance Fee

For applications filed after October 1st, 1996, according to paragraph 68(1)(a) of the *Patent Rules*, documents filed in connection with the patent application, including amendments, must be on sheets of good quality white paper that are free of creases and folds and that are in letter format (21.6 cm x 27.9 cm) or in A4 format (21 cm x 29.7 cm).

For applications filed before October 1st, 1996, according to sections 133 or 169, amendments must be presented clearly and legibly on sheets of good quality white paper, which shall not be more than 21.6 cm by 33 cm (8½ inches by 13 inches).

However, letter format and A4 format are preferred. Images attached to an electronic filing of amendments/remarks must be submitted in letter or A4 format.

19.03 Types of Amendments

Amendments may be submitted by the applicant either voluntarily or in response to an examiner's requisition. The procedures followed by the Patent Office to process an amendment depend on the status of the application file, for example, whether:

- an examination request has been made;
- the application was filed via the PCT;
- a Final Action has been sent;
- a notice of allowance has issued; or
- the Final Fee has been paid.

Subsections 19.03.01 through 19.03.08 describe the procedures and the criteria for acceptance for the different types of amendments that may be made to a patent application.

The amendment must meet the criteria for subject matter and completeness as set forth in sections 19.04, 19.05 and 19.07, to be acceptable to the examiner.

19.03.01 Voluntary amendments before the Request for Examination

Voluntary amendments may be made to a patent application before a request for examination has been submitted. However, the application voluntary amendments filed will not be considered by the examiner at the time of submission. Consideration for acceptance is an examination procedure which is only carried out after an examination request has been made. Voluntary amendments will also be available to public inspection when the application is open to public inspection. Consequently, public disclosure of any new subject matter in a voluntary amendment will occur at the date of opening of the application to public inspection. This could preclude the applicant from filing a new application in respect of that new subject matter at a date later than the one-year anniversary of the date of opening to the public inspection or of the date of the submission of the amendment.

19.03.02 Voluntary amendments after the Request for Examination

The acceptability of voluntary amendments that are filed after a request for examination has been submitted will be considered upon receipt.

When an applicant files a Request for Advanced Examination (Special Order) subsequent to or with an amendment, the cover page to the Request should state, preferably with a clear heading, that a Voluntary Amendment has been recently submitted and indicate the total number of claims to confirm which are to be examined (see section 13.03 for more details regarding Request for Advanced Examination).

19.03.03 Amendments on PCT applications

Amendments made to PCT applications during the international phase under Articles 19 and 34 of the Patent Cooperation Treaty form an integral part of the application at the time of entry into the national phase in Canada. The Canadian national phase application is then subject to the same amendment restrictions as all other Canadian patent applications. Further details on amending PCT applications are given in Chapter 22.

19.03.04 Amendments in response to an examiner's requisition

All amendments received in response to an examiner's requisition will be considered with respect to admissibility upon receipt.

19.03.05 Amendments in response to a Final Action

Amendments received in response to a Final Action issued by an examiner are only accepted by the examiner if the amendment(s) or persuasive argument is sufficient to overcome the Examiner's rejection. For amendments in response to Final Actions which are not acceptable to the Patent Office, see section 21.08.

19.03.06 Amendments after Notice of Allowance

Subsection 30(1) of the *Patent Rules* specifies that: where an examiner, after

examining an application, has reasonable grounds to believe that the application complies with the *Patent Act* and *Rules*, the Commissioner shall notify the applicant that the application has been found allowable and shall requisition the payment of the applicable Final Fee set out in paragraph 6(a) or (b) of Schedule II within the six-month period after the date of the notice.

Further, subsection 32(1) and (2) of the *Patent Rules* specify that:

- (1) except as otherwise provided by the *Patent Act* or *Rules*, after the applicant is sent a notice pursuant to subsection 30(1), no amendment, other than an amendment to correct a clerical error that is obvious on the face of the application, may be made to the application unless the fee set out in item 5 of Schedule II is paid; and
- (2) except as otherwise provided by the *Patent Act* or *Rules*, after the applicant is sent a notice pursuant to subsection 30(1), no amendment may be made to the application that would necessitate a further search by the examiner in respect of the application or that would make the application not comply with the *Patent Act* or *Rules*.

An amendment after allowance that broadens the scope of the claims or changes the point of invention (or characterization) so that something additional or different is claimed, will be refused where the change would necessitate further consideration of the art on record or a new search. This applies not only to changes to the claims, but also to additions to or deletions from the description or drawings which have the effect of broadening the scope of the claims or shifting the point of invention (subsection 32(2) of the *Patent Rules*).

Further, subsections 38.2(2) and (3) of the *Patent Act* must be satisfied. Only matter that can reasonably be inferred from the specification as originally filed or shown in the drawings as originally filed may be entered into the specification and drawings.

The examiner rules on the acceptability of each amendment after allowance and, subject to the approval by the Section Head, the amendment is either refused, or accepted and entered into the application file. Procedures for refusal of an amendment after allowance are discussed in section 19.07.04 below.

A fee for considering an amendment after allowance is required (see subsection 32(1) of the *Patent Rules* and paragraph 5 of Schedule II of the *Patent Rules*). However, no fee is required for mere correction of obvious clerical errors and to changes in the title.

Provided an amendment after allowance fee was paid with an original amendment after allowance which was refused, no further fee is required upon resubmission of the same amendment with further argument as to why the amendment should be accepted. If, however, in resubmitting the amendment, significant alterations are made, the new submission is treated as a separate amendment after allowance requiring its own amendment after allowance fee.

19.03.07 Commissioner's withdrawal of Notice of Allowance

In the case where, after a Notice of Allowance has been sent to the applicant but prior to the patent being issued, the Commissioner has reasonable grounds to believe that the application does not comply with the *Patent Act* or *Rules*, the Commissioner will notify the applicant accordingly and returns the application to the examiner for further examination. The Notice will indicate why the application is not allowable. If the Final Fee has been paid, the Commissioner will refund it (subsection 30(7) of the *Patent Rules*). In this circumstance, prosecution of the application will continue and the application may be amended by the applicant.

19.03.08 Amendment after payment of the Final Fee

Generally, applications may not be amended by the applicant after the Final Fee has been paid (section 33 of the *Patent Rules*), although clerical errors may be corrected as provided by section 8 of the *Patent Act*.

19.03.09 Amendments after failure to pay the Final Fee

If an applicant fails to pay the Final Fee within the six-month period after the date of the Notice of allowance, the application will be deemed abandoned (see paragraph 73(1)(f) of the *Patent Act*).

Subsequent to abandonment, the applicant has 12 months within which the application

may be reinstated under subsection 73(3) of the *Patent Act*. In order to reinstate the application, the applicant must file a request for reinstatement along with the payment of the reinstatement fee and payment of the Final Fee. Should the applicant wish to amend the application at this stage, the amendment request must be made together with the request for reinstatement. The amendment will be considered with respect to acceptability upon receipt, and the application is subject to examination, pursuant to subsection 73(4) of the *Patent Act*. If the application is found to be allowable, it will advance directly to issuance since the Final Fee has already been paid.

19.03.10 Correction of minor errors

The Patent Office does not generally require correction of minor errors in the specification, such as obvious spelling errors, punctuation and letter inversions. If not corrected, such errors will appear in the printed copy of the patent. However, if the examiner is identifying other defects, minor errors may be pointed out at the same time in the examiner's report. Errors that are in any way deemed to be critical are objectionable, and must be corrected.

19.04 Acceptable Subject Matter

Section 38.2 of the *Patent Act* restricts amendments to the specification or drawings to matter reasonably to be inferred from the specification and the drawings as originally filed¹, no new subject matter may be introduced.

Matter pertaining to prior art with respect to the invention of the application may be added to the specification and the drawings. However, the applicant must acknowledge in the specification that any such matter is prior art, well-known or common general knowledge.

19.04.01 Petitions

Please refer to section 4.01.01 regarding restrictions on amendments to petitions.

19.05 Incomplete and Unsatisfactory Responses

Paragraph 73(1)(a) of the *Patent Act* provides for the abandonment of an application if the applicant does not reply in good faith to any requisition made by an examiner. An amendment that fails to address the defects in the application identified by the examiner, or any other requisition by the examiner, will result in the abandonment of the application (see chapter 20 on abandonment).

The Patent Office may consider that an applicant has failed to reply in good faith to an examiner's requisition if the applicant purposely attempts to mislead or to delay prosecution by:

- (a) failing to provide a response to a requisition to correct all the defects identified under subsection 30(2) of the *Patent Rules* by the examiner, or by failing to make satisfactory amendments to avoid those objections;
- (b) reintroducing claims to subject matter previously removed to overcome objections made by the examiner; unless the previously removed claims have since become permissible as a result of change of law or practice;
- (c) adding informal or other obviously objectionable claims;
- (d) failing to provide a response to a requisition for information under section 29 of the *Patent Rules*;
- (e) failing to provide a certified copy and proper certification of a previously regularly filed application following a requisition under section 89 of the *Patent Rules*; or
- (f) failing to include in the description the date of the original deposit within the International Depositary Authority (IDA) following a requisition under subsection 104.1 of the *Patent Rules*.

Under (a) above, a response does not have to present an amendment to overcome each identified defect but, where it does not, the response should specifically address each identified defect for which an amendment is not presented, indicating why

amendment is not necessary.

The procedures for the rejection of an amendment by the examiner are detailed in section 19.07 below.

19.06 Further Examination of Amended Applications

All applications that have been amended are subject to further examination. Any matter introduced by an amendment that is objectionable under the *Patent Act* or the *Patent Rules* will be identified to in an examiner's further requisition. Amended applications may also be subject to a further search of the prior art.

The above does not apply to amendments after the notice of allowance has been sent, since such amendments are refused on receipt if they are found to be unacceptable.

19.07 Unacceptable Amendments

Amendments to applications under examination will not be accepted in the following circumstances:

- (a) The amendment introduces new subject matter into the specification or drawings which is not reasonably to be inferred from the specification and drawings as originally filed (subsections 38.2(2) and (3) of the *Patent Act*).
- (b) The response to an examiner's requisition is not an attempt in good faith to advance the application to allowance and is therefore contrary to paragraph 73(1)(a) of the *Patent Act*.
- (c) After a notice of allowance has issued, if an amendment after allowance fee is required and has not been paid (subsection 32(1) of the *Patent Rules*), or if the amendment adds new matter (subsections 38.2(2) and (3) of the *Patent Act*), necessitates a further search, or if the amendment causes the application in any way to not comply with the *Patent Act* or *Rules* (subsection 32(2) of the *Patent*

Rules).

- (d) After the Final Fee has been paid (section 33 of the *Patent Rules*), unless the application has been withdrawn from issue or has been reinstated after abandonment due to non-payment of the Final Fee (subsection 73(4) of the *Patent Act*).
- (e) After the expiry of the time for responding to a Final Action except where:
 - 1. the rejection is withdrawn in accordance with subsection 30(5) of the *Patent Rules*;
 - 2. the Commissioner is satisfied after review that the rejection is not justified and the applicant has been so informed;
 - 3. the Commissioner has informed the applicant that the amendment is necessary for compliance with the *Patent Act and Rules*; or
 - 4. by order of the Federal Court or the Supreme Court of Canada.
- (f) The amendment introduces claims that are not patentable in view of lost conflict matter following a conflict procedure in accordance with section 43 of the *Patent Act*, as it read immediately before October 1, 1989².

19.07.01 Procedure for rejecting new subject matter

When an amendment introduces new subject matter to an application contrary to subsections 38.2(2) and (3) of the *Patent Act*, the examiner will requisition the applicant to remove the new subject matter therefrom, and inform the applicant that the amendment is part of the application file and therefore has or will be open to public inspection with the application.

19.07.02 Procedure for replies not in good faith following a requisition to correct all the defects or to include the date of the International Depository Authority (IDA) in the description

When an examiner considers that a response to an action is not made in good faith following a requisition to correct all the defects under subsection 30(2) of the *Patent Rules*, or to include the date of the International Depository Authority (IDA) in the description under section 104.1 of the *Patent Rules*, the amendment is not accepted. The examiner, at the expiry of the time limit for the response, refers the file and the applicant's response to the Director of Patent Branch. An office letter will remind to the applicant that he or she has the opportunity to present a written argument to explain why the response should be considered a good faith attempt to respond to the examiner's requisition.

- If the argument is not convincing, the application will be deemed abandoned under paragraph 73(1)(a) of the *Patent Act* because of the applicant's failure to reply in good faith to the requisition within the required time ³.
- If the argument is convincing, normal prosecution is resumed, and applicant's response is considered by the examiner. The amendment may still not be accepted if new matter is present (section 19.07(a) of MOPOP).

19.07.03 Procedure for replies not in good faith following a requisition to provide a certified copy or information regarding prior art

A response is considered incomplete under the following circumstances::

- (a) information requisitioned under subsections 29(1) and (2) of the *Patent Rules* dealing with the provision of prior art or the first publication of a foreign patent is not supplied, and the response is silent in respect to reasons for its absence as required by subsection 29(3) of the *Patent Rules*; or
- (b) a certified copy or certification of the actual date of filing of a previously regularly filed application following a requisition under section 89 of the *Patent Rules* has not been provided.

the applicant will be notified by:

- a courtesy communication, requesting the information or reasons why the information is not available before the action due date, if there is still time to respond before the action due date, or
- a notice of abandonment under section 73(1)(a) of the *Patent Act* if the action due date has already passed.

If a response is incomplete because information requisitioned under subsections 29(1) and (2) of the *Patent Rules* dealing with the provision of prior art or the first publication of a foreign patent is not supplied or incomplete, but the explanation for its absence refers to a subsequent or additional submission, the examiner will normally issue another report only to requisition to comply fully with section 29 of the *Patent Rules*. The applicant must then provide the information or state why it is not available as required by subsection 29(3) of the *Patent Rules*.

19.07.04 Procedures for unacceptable amendments after the Notice of Allowance

If the amendment after allowance fee is required but is not submitted with the amendment, the Patent Office will notify the applicant that the required fee must be submitted before the amendment can be considered.

When the examiner decides that an amendment after allowance does not comply (see section 19.03.06 of MOPOP), the applicant will be so advised by the examiner by letter. The letter will indicate to the applicant those parts of the amendment that are objectionable. At this point the applicant may:

- Pay the Final Fee to proceed to issuance with the application in its version before the amendment after allowance, or;
- Resubmit a new amendment after allowance (with a second amendment after allowance fee) absent of the objectionable matter, or;
- Not pay the Final Fee and reinstate the patent application as explained in section 19.03.08 of MOPOP.

19.07.05 Procedure for refusal of amendment after the Final Fee is paid

The Patent Office will notify the applicant that the application is scheduled to issue and cannot be amended.

Endnotes for Chapter 19

- 1 Re: Application No. 139,723 (Patent No. 1,029,723) [1977] 51 C.P.R. (2d) 95 at 103
Commissioner's Decision No. 145, Application No. 47327 (Patent No. 944,370) [1973]
Commissioner's Decision No. 904, Application No. 315073 (Patent No. 1,149,093) [1981]
Commissioner's Decision No. 938, Application No. 245193 (Patent No. 1,156,966) [1982]
- 2 Re: Application No. 100,575, [1975] 36 C.P.R. (2d) 283 at 284
- 3 Commissioner's Decision No. 589, Application 211,920 (Patent No. 1,075,521) [1979]