

## **Chapter 4**

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## **Chapter 4**

### **Petitions and appointment of agents or representatives**

#### **4.01 The petition**

While the abstract, description, claims and drawings of a patent application must be individually, or taken together, wholly in English or wholly in French (subsection 71(3) of the *Patent Rules*), the petition, assignment and other documents may be in either English or French but do not have to be all in the same language or in the same language as the specification (section 71 of the *Patent Rules*). The petition is a statutory requirement under section 27(2) of the *Patent Act* and must follow the format given in Schedule I, Form 3 of the *Patent Rules* (section 77 of the *Patent Rules*). The petition must commence on a new page (section 72 of the *Patent Rules*), must not contain drawings (section 74 of the *Patent Rules*) and must conform to the specific requirements of document presentation set forth in section 68 of the *Patent Rules*.

##### **4.01.01 Amendment to the petition**

The Patent Office will accept amended petitions subject to any other provision in the *Patent Act* and *Patent Rules*. No changes may be made to inventors or applicants unless to comply with sections 31, 49 or 50 of the *Patent Act*. The petition may be amended to correct clerical errors under section 35 of the *Patent Rules*. The Patent Office will not require the applicant to submit an amended petition to supply additional or corrected information. Such corrections or additions may be provided in a separate document. The original petition will be retained in the correspondence file of the application.

The requirement in subsection 27(2) of the *Patent Act* that an application contain a petition does not apply to PCT applications filed under the provisions of the Patent Cooperation Treaty (PCT). These applications are filed with a request in accordance with Article 4 of the PCT.

#### **4.01.02 The title**

In accordance with Form 3, an applicant must include in the petition or the request an appropriate title for the invention described in the application. Under paragraph 80(1)(a) of the *Patent Rules*, the title must be short and precise. The examiner will requisition an amendment of a title which does not conform to paragraph 80(1)(a) of the *Patent Rules*.

#### **4.01.03 Public Servants Inventions Act**

Under section 4 of the Public Servants Inventions Act, a public servant who makes an invention is required to advise the appropriate Minister of the invention and is required to disclose in any Canadian patent application that the applicant is a public servant. Public servants may not file an application for a patent outside Canada without written ministerial permission.

In the case of an invention by a public servant, the petition for patent must indicate that the inventor is a public servant.

#### **4.02 Appointment of agents**

Individual inventors may prosecute their own applications provided they have retained some interest in the invention. This does not extend to successors in title. However, an inventor may choose to be represented by a patent agent whose name appears on the register of patent agents which permits the agent to act on behalf of the inventor. Whenever all rights have been assigned and the assignment has been recorded in the Patent Office, an application must be prosecuted by a registered patent agent (see sections 20, 21, 22, 23 and 24 of the *Patent Rules*).

A patent agent may be appointed in the petition itself or separately by submitting to the Commissioner of Patents, a notice signed by the applicant (subsection 20(2) of the *Patent Rules*). The appointment must clearly identify the application to which it refers and the application serial number should be given, if known. When a change is made in the appointment of an agent, a notice signed by the applicant or agent must be submitted (subsection 20(3) of the *Patent Rules*, see also sections 23, 24 and 40 of the

*Patent Rules*).

#### **4.02.01 Appointment of associate agents**

An agent who does not reside in Canada cannot prosecute applications directly, but must appoint an associate agent who is a resident of Canada (subsection 21(1) of the *Patent Rules*). An agent who resides in Canada may also appoint an associate agent provided the associate agent has a Canadian residence (subsection 21(2) of the *Patent Rules*). Changes in the appointment of agents and associate agents may be effected by the applicant, the agent or associate agent (subsections 6(2), 20(3) and 21(4) of the *Patent Rules*).

#### **4.03 Appointment of representative**

An applicant who is the inventor and who does not appear to reside or carry on business at a specified address in Canada shall, on the filing date of the application appoint as a representative a person who resides or carries on business at a specified address in Canada (subsection 29(1) of the *Patent Act*). The appointee is deemed to be the representative of the applicant for all purposes of the *Patent Act* (subsection 29(2) of the *Patent Act*). However, correspondence from the Patent Office is not sent to the representative but directly to the inventor at the foreign address of the inventor. This includes examiner's reports, correspondence from the Commissioner and the patent grant. A representative may be appointed either in the petition (Schedule I, Form 3 of the *Patent Rules*) or by means of a separate document (section 78 of the *Patent Rules*). If applicant fails to appoint a representative, the application will be considered incomplete (paragraph 94(1)(i) of the *Patent Rules*).

A new representative may be appointed by the applicant or patentee at any time and must be appointed where requested by the Commissioner of Patents in accordance with section 29(3) of the *Patent Act*.

#### **4.04 Status as small entity**

Individual inventors, small businesses and universities may be entitled to reduced fees for filing applications for patents provided that the criteria defining a "small entity" in

Section 2 of the *Patent Rules* are met. Any applicant who desires to claim small entity status must so indicate in the request for obtaining a patent or in paragraph 7 of the formal petition, if one is filed.

#### **4.05 Representative drawing**

A single figure of the drawings is selected by the applicant or alternatively by an officer in the Patent Office to be representative of the drawings illustrating an invention. It is intended that an appropriately reduced version of this figure will be illustrated on the cover page of the opened patent application and the cover page of any patent which may issue from the application. The purpose of this drawing is to assist anyone searching the Canadian patent literature. The applicant is requested to identify what is considered to be the figure most representative of the invention in paragraph 7 of the formal petition.

#### **4.06 Jurisprudence**

The following decisions of the courts are of importance in considering the subject matter of this chapter:

##### petition

|                             |             |     |      |
|-----------------------------|-------------|-----|------|
| Beloit v Valmet             | 78 CPR (2d) | 1   | 1984 |
| Speery v John Deere         | 82 CPR (2d) | 1   | 1984 |
| Rothmans, Benson and Hedges | 35 CPR (3d) | 417 | 1991 |
| Mobil Oil v Hercules        | 63 CPR (3d) | 473 | 1995 |
|                             | 57 CPR (3d) | 488 | 1994 |

##### assignment

|                           |             |     |      |
|---------------------------|-------------|-----|------|
| Speery v John Deere       | 82 CPR (2d) | 1   | 1984 |
| Signalisation v Services  | 46 CPR (3d) | 199 | 1992 |
| Procter Gamble v Kimberly | 40 CPR (3d) | 1   | 1991 |
| Positive Seal v M&I Heat  | 33 CPR (3d) | 417 | 1991 |

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|                          |             |     |      |
|--------------------------|-------------|-----|------|
| Signalisation v Services | 46 CPR (3d) | 199 | 1992 |
| Forget v Specialty       | 62 CPR (3d) | 537 | 1995 |
|                          | 48 CPR (3d) | 323 | 1993 |
| <u>license</u>           |             |     |      |
| Marchand v Peloquin      | 45 CPR (2d) | 45  | 1978 |
| Lubrizol v Imperial Oil  | 33 CPR (3d) | 11  | 1990 |
|                          | 45 CPR (3d) | 449 | 1992 |
| Positive Seal v M&I Heat | 33 CPR (3d) | 417 | 1991 |
| Signalisation v Services | 46 CPR (3d) | 199 | 1992 |
| Forget v Specialty       | 48 CPR (3d) | 323 | 1993 |
|                          | 62 CPR (3d) | 537 | 1995 |