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Chapter 13

Examination of applications

13.01 Scope of the chapter

This chapter presents an overview of the procedures followed during the examination of a patent application. Generally, an application is examined in order depending on the date on which the request for examination is made. Special order status may be given under the circumstances described in Section 13.03.

The examiner searches the prior art, including any art supplied by the applicant under section 29 of the *Patent Rules* to determine that the invention is novel and unobviousness. The application is also examined for conformance with all sections of the *Patent Act* and the *Patent Rules*.

When an examiner determines that an application complies with the *Patent Act* and Rules, a Notice of Allowance is issued to the applicant.

Where the examiner finds that the application does not comply with the *Patent Act* and Rules, an examiner's report is issued requisitioning amendment of the application to comply. Where an impasse between the examiner and the applicant is reached a Final Action is issued by the examiner refusing the application. The prosecution before the examiner is terminated unless the applicant amends to comply with the requisition of the examiner. The Patent Appeal Board and the Commissioner of Patents then determine whether the application is allowed or refused.

An application that is refused by the Commissioner cannot issue to patent unless so dictated by an appeal to the courts.

After a Notice of Allowance is issued on an application, the applicant must pay the final fee within six months of the notice.

An application may be withdrawn from allowance by the Office, before it issues to patent, if the Commissioner has reason to believe that the application does not comply with the *Patent Act* or the Rules.

Upon payment of the final fee, the application is processed through to issue.

13.02 Request for Examination

Applications are not examined automatically (see subsection 35(1) of the *Patent Act*). The applicant (or any other party) must first make a written request for examination, and pay the prescribed fee. Subsections 95 and 96 of the *Patent Rules* sets forth the details required with such a request.

The request for examination shall contain:

- a) the name and address of the person making the request;
- b) if the person making the request is not the applicant, the name of the applicant; and
- c) information, such as the application number, sufficient to identify the application.

A request for examination must be made within five years from the date of filing in Canada (subsection 96(1) of the *Patent Rules*) to avoid abandonment. In the case of a divisional application, the request must be made within five years of the filing of the original application in Canada, or within six months of the filing of the divisional in Canada, whichever occurs later (subsection 96(2) of the *Patent Rules*).

NOTE: For applications filed in the period beginning on October 1, 1989 and ending on the day before October 1, 1996, requests for examination must be made within 7 years from the date of filing in Canada (subsection 150(1) of the *Patent Rules*).

The Commissioner may by notice require an applicant to make a request for examination (subsection 35(2) of the *Patent Act*) within three months of the notice (sections 25, 97, and 151 of the *Patent Rules*). Failure to comply with the Commissioner's notice will result in abandonment of the application pursuant to paragraph 73(1)(e) of the *Patent Act*.

Any person other than the applicant may request examination of an application by submitting a request and paying the required fee (subsection 35(1) of the *Patent Act*). The Patent Office will inform the applicant by letter that a third party has requested examination of the application.

The fee payable on requesting examination of an application is not refundable or transferable.

Failure to request examination within the specified time period will result in abandonment of the application (paragraph 73 (1)(d) of the *Patent Act*). The application may be reinstated upon request and upon payment of the prescribed fee(s) within 12 months from the date of abandonment (section 98 of the *Patent Rules*).

13.03 Requests for advanced examination (Special order)

Applications are generally examined in order according to the date on which the request for examination is made. Under section 28 of the *Patent Rules*, the applicant or any other person may request advanced examination of an application. To obtain advanced examination the requester must make a written request establishing that failure to advance the application is likely to prejudice that person's rights and must pay the prescribed fee (Item 4 of Schedule II of the *Patent Rules*). The request must also be accompanied by, or preceded by a request for examination under subsection 35(1) of the *Patent Act* and by the fee as set out in Item 3 Schedule II of the *Patent Rules*.

An application must be open to public inspection under section 10 of the *Patent Act* in order for a request for advanced examination to be granted (subsection 28(2) of the *Patent Rules*). The applicant may request early opening of the application (subsection 10(2) of the *Patent Act*) simultaneously with the request for advanced examination. There is no additional fee required for early opening. A third party cannot request early opening of another party's application and must therefore, wait until the application is opened under the provisions of subsection 10(2) of the *Patent Act*.

Where a third party requests advanced examination of an application, the Patent Office will inform the applicant by letter that a third party has requested advanced examination.

Verbal requests for advanced examination are not granted.

The Commissioner does not grant advanced examination status to an incomplete application. Any person requesting advanced examination on such an application is informed, by office letter, that the request will be considered when the application is in proper order.

A divisional application, once it has been completed and an examination request and fee has been received, may be accorded advanced examination status upon request and upon payment of the advanced examination fee.

The advanced examination status remains in effect until disposal of the application or withdrawal by the requester. An application under advanced examination is given immediate action whenever it is in proper condition for examination.

13.04 Prior art citations from foreign prosecution

The applicant may be asked to provide information and copies of any documents related to the prosecution of corresponding applications in other countries including details of;

- (a) any prior art cited against those applications,
- (b) application numbers, filing dates and patent numbers,
- (c) conflict, opposition, re-examination or similar proceedings, and
- (d) translations of documents not in English or French.

Generally, at the time that the office acknowledges the receipt of a request for examination on an application, the applicant is asked to consider providing particulars of the prior art cited in the prosecution of corresponding foreign applications when such information becomes available. The above information may also be requisitioned by the examiner according to section 29 of the *Patent Rules* during the prosecution of the application. Failure to respond to an examiner's requisition will result in abandonment of the application (paragraph 73(1)(a) of the *Patent Act*).

All prior art information and other information provided under section 29 of the *Patent*

Rules will be taken into account by the examiner at the time of examination.

13.05 Examination

A careful examination of each patent application is made by competent examiners employed in the Patent Office in accordance with subsection 35(1) of the *Patent Act*. A patent, granting an exclusive property in the invention, is only obtained providing the applicant complies with all requirements of the *Patent Act*. It is the role of the examiner to ensure that all the relevant sections of the *Patent Act* and the *Patent Rules* are met before issue of the patent.

After careful study of the specification by the examiner to ascertain the scope of the invention described and claimed in the application, the examiner performs a thorough search of the prior art related to the technical area of the invention. The examiner also examines the abstract, description, drawings, photographs, sequence listings, and claims for conformance to the relevant sections of the *Patent Act* and *Patent Rules*.

13.05.01 Search of the prior art

A search of the prior art of the technical area of the invention is carried out to establish that the invention claimed in the patent application is novel (section 2, and subsection 28.2 (1) of the *Patent Act*) and is not obvious to a person skilled in the art or science to which it pertains (section 28.3 of the *Patent Act*).

A classification examiner determines the main International Patent Classification (IPC) class, subclass, group and subgroup for the subject matter of the claims of the application as well as cross reference classifications and the Canadian Patent Classification (CPC) class and subclass. These classifications are used by the examiner to conduct a search of the prior art patents.

For the search, the examiner has access to patent documents from the following countries; Australia, Austria, Belgium, Bulgaria, Czechoslovakia, Canada, France, Germany, Great Britain, Hungary, Japan, Netherlands, Norway, Poland, Spain, Sweden, Switzerland, Romania and the United States as well as patent documents from the European Patent Office and Patent Cooperation Treaty publications. The

examiner also has access to on-line search services such as INPADOC, ORBIT and STN for keyword searching. Printed publications can also be obtained through the Departmental Library.

Prior art citations provided by the applicant regarding prosecution of corresponding foreign applications are also scrutinized by the examiner.

Prior art references which have a bearing on the novelty or obviousness of the invention claimed in the application are cited against the application in an examiner's report. Details of art citation for lack of novelty and obviousness are presented in Chapter 15 of this manual. The examiner requisitions the applicant to amend the application to overcome the art citations.

13.05.02 Defects in the application

In addition to the search of the prior art, the examiner inspects various parts of the patent application for compliance with the applicable sections of the *Patent Act* and the Rules. In particular, the abstract, description, claims, drawings, photographs, and sequence listings are each reviewed.

The purpose of the abstract is to provide a brief description of and utility for the invention disclosed in the patent specification so as to enable the reader to determine quickly if the entire patent specification would be of interest to him. A full discussion of the requirements of the *Patent Act* and Rules regarding abstracts is presented in Chapter 8 of this manual.

The description must correctly and fully describe the invention and its operation or use as contemplated by the inventor. It must clearly set out the invention in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected to put the invention into practice. The invention should be described in such a manner as to distinguish it from other inventions. The office practice and the relevant sections of the *Patent Act* and *Patent Rules* which apply to the description are given in Chapter 9 of this manual.

Drawings or photographs are necessary in an application for a machine or an invention which admits of illustration by means of drawings or photographs. The drawings must

clearly show all the parts of the invention and must include references corresponding with the description. Chapter 10 of this manual deals with the requirements of the *Patent Act* and Rules for drawings and photographs.

The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed. The criteria that must be met for acceptable claims in a patent application are discussed in detail in Chapter 11 of this manual.

Any defects found in the application are reported to the applicant in an examiner's report. An application which is found to fully comply with all of the relevant sections of the *Patent Act* and the *Patent Rules* is allowed by the examiner and a Notice of Allowance is issued to the applicant.

13.06 Examiner's Report

Where an examiner finds that an application does not comply with the *Patent Act* or the Rules, an examiner's report is issued to the applicant, in accordance with subsection 30(2) of the *Patent Rules*, objecting to the defects found.

In the report the examiner also requisitions the applicant to amend the application in order to comply with those sections of the *Patent Act* or Rules identified in the report, or to provide arguments as to why the application does comply.

The time limit for responding to an examiner's requisition is the six-month period after the requisition is made or within any shorter period established by the Commissioner, in accordance with paragraph 73(1)(a) of the *Patent Act* .

The examiner's report generally includes the following;

a statement of the authority for issuing the report (section 30(2) of the *Patent Rules*),

the time limit for response to the examiner's requisition (paragraph 73(1)(a) of the *Patent Act*),

a statement of the status of the application at the time of examination (as filed, as amended on specified date, subject to the Commissioner's Decision, correspondence received and reviewed),

an indication of the number of claims on file,

the results of the prior art search, or limitations made to the prior art search and reasons for the limitations,

objections to the defects found in the application, including a reference to the applicable sections of the *Patent Act* or Rules with which the application fails to comply, and

a requisition for amendment of the application to comply with the cited sections of the *Patent Act* and Rules.

Failure to respond to an examiner's requisition within the time limit specified in the report will result in abandonment of the application as per paragraph 73(1)(a) of the *Patent Act*. An abandoned application can be reinstated upon applying for reinstatement, paying the reinstatement fee, and taking the action which was necessary to avoid the abandonment originally (in this case respond to the examiner's requisition).

13.06.01 Withdrawal of Examiner's Report

If an outstanding examiner's report is no longer applicable in view of correspondence which renders the action inapplicable or unnecessary the examiner directs the examination assistant to cancel the report and notify the applicant of the cancellation by Office letter, and, as a courtesy, also by telephone, if practical. The application file will indicate that the report has been withdrawn and the time limit that was set for response does not apply.

13.07 Amendment of the application

Amendments to applications are permitted under section 38.2 of the *Patent Act*. Applicants may amend their applications either on their own initiative or in response to

an examiner's requisition. The amendment must comprise new pages for any changes to the application made by the amendment, and a supporting explanation. Under section 34 of the *Patent Rules* every amendment must be accompanied by a written statement explaining the nature of the amendment and its purpose. If the amendment is in response to an examiner's requisition, the written statement must explain the manner in which the amendment overcomes each of the objections made by the examiner.

Section 38.2 of the *Patent Act* restricts the contents of amendments. The restriction is that no new subject matter may be introduced. Only matter reasonably to be inferred from the specification and drawings as originally filed may be added to either the specification or drawings.

All applications that have been amended are subject to further examination. Any defects introduced by an amendment, will be addressed in a subsequent examiner's report. Amended applications, except those amended after allowance, are also subject to a further search of the prior art.

A detailed discussion of the restrictions and office procedures regarding amendments to patent applications is given in Chapter 19 of this manual.

13.08 Final Action

Occasionally, during the prosecution of an application, an impasse is reached between the examiner and the applicant on a particular defect of the application. Where the applicant does not comply with a requisition of the examiner to amend the application, and the examiner still believes that the application is defective for not conforming to the applicable section of the *Patent Act* or Rules, the examiner may reject the application in a Final Action (subsection 30(3) and (4) of the *Patent Rules*). The Final Action terminates the prosecution of the application before the examiner unless the applicant submits an amendment that satisfies the requisition of the examiner (subsection 30(5) of the *Patent Rules*).

Chapter 21 of this manual provides a detailed discussion of the office procedures for Final Action.

13.09 Refusal to grant a patent

Whenever the Commissioner is satisfied that the applicant is not by law entitled to be granted a patent, the Commissioner refuses the application in accordance with section 40 of the *Patent Act*.

The refusal is generally preceded by a Final Action issued by the examiner responsible for the substantive examination of the application. The reason for the Commissioner's refusal must be based on non-compliance with one or more sections of the *Patent Act* or the *Patent Rules*.

The Commissioner must notify the applicant by registered letter of the refusal and the ground or reason therefor. The notification generally bears the notation "Decision of the Commissioner of Patents" and provides a justification for the refusal based on the *Patent Act*, *Patent Rules* and pertinent jurisprudence.

An applicant whose application for patent has been refused by the Commissioner pursuant to section 40 of the *Patent Act* may appeal the decision of the Commissioner to the Federal Court. The time limit for taking the appeal is the six-month period after the notice of the Commissioner's Decision is mailed.

13.10 Allowance and Notice of Allowance

Where the examiner, after substantive examination of the application, finds that it is in compliance with all requirements of the *Patent Act* and the *Patent Rules*, the examiner issues a Notice of Allowance in accordance with subsection 30(1) of the *Patent Rules*.

The Notice of Allowance advises that the patent application has been found allowable by the examiner and may issue to Letters Patent upon payment of the final fee. The notice also requisitions the payment of the final fee (item 6 of Schedule II of the *Patent Rules*) within six months of the date the notice was mailed (paragraph 73(1)(f) of the *Patent Act*).

Where the final fee is not paid within six months from the date of the notice, the application for patent is abandoned in accordance with paragraph 73(1)(f) of the *Patent*

Act. An abandoned application may be reinstated upon applying for reinstatement, paying the reinstatement fee and taking the action which was necessary to avoid the abandonment (in this case paying the final fee). A reinstated application is subject to amendment and further examination and search of the prior art before a new Notice of Allowance is issued.

After a Notice of Allowance has been issued, the applicant has no right to amend the application, but the Commissioner may at his discretion permit the entry of an amendment presented before payment of the final fee, if the entry does not necessitate a further search by the examiner in respect of the application.

13.11 Withdrawal from allowance

If, after an application is found by the examiner to be allowable and the applicant has received a Notice of Allowance, the Commissioner subsequently finds that the application is not allowable, the Commissioner, either before or after payment of the final fee, notifies the applicant that the Notice of Allowance is withdrawn (subsection 30(7) of the *Patent Rules*).

If the final fee has been paid at the time that the Commissioner withdraws the Notice of Allowance, the fee is refunded to the applicant (subsections 4(10) and 30(7) of the *Patent Rules*).

A withdrawal from allowance may be precipitated by the filing of a protest or prior art under section 34.1 of the *Patent Act*.

An application which has been withdrawn from allowance is returned to the examiner for further examination. The normal restrictions regarding amendments after allowance (section 32 of the *Patent Rules*) and amendments after payment of the final fee (section 33 of the *Patent Rules*) do not apply to applications where the Notice of Allowance has been withdrawn by the Commissioner (subsection 30(8) of the *Patent Rules*). When the application is found by the examiner to be in compliance with all requirements of the *Patent Act* and Rules, a new Notice of Allowance is issued to the applicant.

13.12 Issue of the patent

Upon payment of the final fee, the application is generally automatically processed through to issue. No amendments may be entered in the application, except in the circumstance where the Notice of Allowance is withdrawn by the Commissioner.

The application will issue in the name of the inventor or the legal representative as their interest appear from assignments previously recorded. Assignments which are received in the Patent Office no later than the day on which the final fee is paid, may be relied upon to provide the appropriate names in which the patent will issue (section 41 of the *Patent Rules*).

The patent generally will issue on a Tuesday, approximately nine weeks after the office receives the payment of the final fee. The payment of the final fee may be withdrawn if a request for its return is made by the applicant before the start of technical preparations for issue of the patent.

A list of the patents issued by the Patent Office each week is published in the Patent Office Record. Information listed in the CPOR for each patent includes the number, the title in French and English, inventor name(s), patentee, number of claims and the classification of the patent. Patents issued on applications filed before October 1, 1989 bear a unique patent number less than two million. Applications filed on or after October 1, 1989 issue to patent with the same number as the application (greater than 2,000,000).