

Chapter 23

Amendments to patents

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Chapter 23 Amendments to patents

23.00 Contents of chapter

This chapter deals with the various statutory methods whereby an issued patent may be amended. The topics covered include disclaimer (23.01 to 23.01.02), re-examination (23.02 to 23.02.10), reissue (23.03 to 23.03.11) and section 8 corrections (23.04 to 23.04.03).

23.01 Disclaimer

Disclaimer is a mechanism whereby a patentee may amend a patent to claim less than that which was claimed in the original patent. A disclaimer is not limited to a whole claim or claims. A part of a claim may be disclaimed, provided that the disclaimer does not extend the scope of this claim or any claims depending on this claim ¹.

Subsection 48(1) of the *Patent Act* entitles a patentee to disclaim anything included in the patent by mistake, accident or inadvertence ² at any time during the term of the patent. Whenever a specification is too broad, claiming more than the inventor invented or subject matter to which the patentee had no lawful right ³, the patentee may, on payment of a prescribed fee, disclaim such parts as the patentee does not claim to own by virtue of the patent (paragraph 48(1)(b) of the *Patent Act* and Schedule 2, Part 3, Item 13 of the *Patent Rules*). A disclaimer cannot be used to broaden the claims of a patent.

23.01.01 Disclaimer form

A disclaimer must follow the form and instructions for its completion as set out in Form 2 of Schedule I of the *Patent Rules* to the extent applicable (section 44 of the *Patent Rules*). In completing [Form 2](#), the patentee must follow the precise form of items 3(1) and 3(2), which specify the subject matter disclaimed. The expression "...with the exception of the following:" in Form 2 indicates elements of the claim(s) remaining after the disclaimer, and is not to be used as a device for reformulating or redefining the

invention disclosed and claimed ⁴.

23.01.02 Effect of a disclaimer

Disclaimers do not normally affect any court action pending at the time they are made (subsection 48(4) of the *Patent Act*). In a court action, the plaintiff has to be a party to the disclaimer to be bound by it ⁵. In a comparable manner, a disclaimer filed after the notice of hearing of the Patented Medicine Prices Review Board does not affect the authority of the Board ⁶.

Following a disclaimer, the remaining claims are deemed to be valid for the matter not disclaimed, i.e. in their disclaimed form ⁷ (subsection 48(6) of the *Patent Act*). The disclaimer is unconditional. The existing claims of the patent are the claims as amended by virtue of the disclaimer, and the only invention protected by the letters patent is that defined by such existing claims ⁸.

23.02 Re-examination

This section describes the practice that is followed when a request for re-examination of a patent is submitted.

23.02.01 Request

Any person, including the patentee, may request re-examination of any claim or claims of a patent issued after October 1, 1989, at any time during the life of the patent on the basis of prior art only. The prior art shall consist of patents, applications for patents open to public inspection and printed publications only (subsection 48.1(1) of the *Patent Act*). The request, including copies of the prior art, must be provided in duplicate if the requester is not the patentee (section 45 of the *Patent Rules*). One copy is for a re-examination board and the other copy is for the patentee. The requester must set forth the pertinency of the prior art and the manner of applying it to the claim(s) for which re-examination is requested. The request must be in writing and be accompanied by the prescribed fee.

23.02.02 Notification procedure

Upon receipt of a request satisfactorily identifying the prior art and the manner of applying it, along with the fee, the Commissioner will appoint a re-examination board (RXB). The patentee will be sent a package that contains a copy of the request including the prior art and a notification identifying the composition of the re-examination board. In the event that the requester is the patentee, only a notification identifying the composition of the RXB will be sent (subsections 48.1(3) and 48.2(1) of the *Patent Act*).

23.02.03 Unacceptable request

If the request does not fulfil all of the requirements of subsections 48.1(1) and (2) of the *Patent Act* and section 45 of the *Patent Rules*, the requester will be so notified. The notification letter will detail the reasons why the request is not acceptable. An example of an unacceptable request is one that does not detail the pertinency of the prior art against the claim or claims to be re-examined. The requester will be informed by the Commissioner that no further steps will be undertaken until the above requirements have been fulfilled.

Any unacceptable requests may be resubmitted in acceptable form without the payment of a further fee.

23.02.04 Completed request

The completed request will become part of a Patent Office initial re-examination file, which will consist of the following:

- a) the Patent Office file copy of the patent, including the description, claim(s), drawings as issued and all prosecution correspondence
- b) a copy of the request
- c) copies of the prior art being relied on
- d) reasons supporting the request for re-examination

This file is open to public inspection.

23.02.05 Re-examination board

The Commissioner will establish a re-examination board consisting of not fewer than three persons, at least two of whom shall be employees of the Patent Office, to which the request shall be referred for determination (subsection 48.2(1) of the *Patent Act*). Within three months following its establishment, the re-examination board shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request for re-examination (subsection 48.2(2) of the *Patent Act*).

23.02.06 Refusal of re-examination

If the board determines that re-examination should not proceed because a substantial new question affecting the patentability of a claim of the patent concerned is not raised, the requester shall be so informed. The determination not to proceed is final and is not subject to appeal, either to the Commissioner or to the courts (subsection 48.2(3) of the *Patent Act*).

23.02.07 Re-examination

The re-examination board, having decided to proceed with re-examination, shall notify the patentee and give the reasons for the decision (subsection 48.2(4) of the *Patent Act*). Within three months of the date of the notice, the patentee may make submissions on the question of the patentability of the claim(s) (subsection 48.2(5) of the *Patent Act*). Re-examination will commence upon receipt of the reply or, in the absence of a reply, within three months of the date of the notice (subsection 48.3(1) of the *Patent Act*). In either case, re-examination shall be completed within 12 months of the commencement of re-examination (subsection 48.3(3) of the *Patent Act*).

The re-examination board will not consider any matter except the claims in question in view of the supplied prior art. Further, the re-examination board will not make any changes to the description part of a patent, in that there is no statutory authority for such changes. During the re-examination period, the patentee may propose amendments to the patent claims (including submission of new claims), but the scope of the claim(s) may not be broadened. Any number of separate proposals from the patentee during this period is permissible (subsection 48.3(2) of the *Patent Act*). The Commissioner will

acknowledge the correspondence from the patentee but will not reply to the proposals.

23.02.08 Certificate of re-examination

Upon conclusion of re-examination, a certificate will be issued in accordance with paragraph 48.4(1)(a), (b) or (c) of the *Patent Act* and attached to the patent. This certificate will affect the original patent by

- a) cancelling any claim of the patent determined to be unpatentable during the re-examination;
- b) confirming any claim of the patent determined to be patentable; or
- c) incorporating in the patent any proposed amended claim determined to be patentable.

The effect of a certificate issued in respect of a patent under subsection 48.4(3) of the *Patent Act* is as follows:

- a) If the conclusion is to cancel any claim but not all claims of the patent, the patent shall be deemed to have been issued, from the date of grant, in the corrected form.
- b) If the conclusion is to cancel all claims of the patent, the patent shall be deemed never to have been issued.
- c) If the conclusion is to amend any claim of the patent or incorporate a new claim or new claims in the patent, the amended claim(s) or new claim(s) shall have effect, from the date of the certificate of re-examination, for the unexpired term of the patent.

The deemed results of paragraphs (a), (b) and (c) above do not take effect until the time for taking an appeal has expired under subsection 48.5(2) of the *Patent Act* and, if an appeal is taken, the above-mentioned deemed results apply only to the extent provided in the final judgment of any appeal (subsection 48.4(4) of the *Patent Act*).

The re-examination board will send a copy of the certificate to the patentee (subsection 48.4(2) of the *Patent Act*). If the requester is not the patentee, the board may also send him or her copies of the correspondence to the patentee generated during the re-examination procedure. A summary of the certificate will appear in the Canadian Patent Office Record.

23.02.09 Termination of re-examination

Upon completion of re-examination, the contents of the re-examination file created under 23.02.04 will be sent to the Patent Office storage files. The Patent Office search file will include a copy of the patent as re-examined.

23.02.10 Appeal period

The patentee receives a copy of the certificate by registered mail and may appeal the decision of the re-examination board to the Federal Court within three months of the date of mailing of the certificate (subsections 48.5(1) and (2) of the *Patent Act*).

23.03 Reissue

Reissue is a mechanism whereby a defective patent can be corrected. It may result in broader or more restricted protection, depending on the nature of the correction.

Section 47(1) of the Patent Act enables the Commissioner to replace a defective or inoperative patent (as defined by section 47(1) of the *Patent Act*) with a new patent. In order to have a patent reissued, the patentee, or “the person for the time being entitled to the benefit of a patent for an invention⁹” must make a request for reissue ([Form 1](#)) in accordance with section 43 of the *Patent Rules*, pay a prescribed fee, and surrender the defective patent on the issue of the new patent. One of the effects of the surrender is the return by the patentee of the official copy bearing the Patent Office seal (also known as the “grant copy”) to the Patent Office.

In accordance with subsection 47(1) of the *Patent Act*, a patentee may apply within four years from the date of issue of a patent for the reissue of a patent that “is deemed defective or inoperative by reason of insufficient description and specification, or by

reason of the patentee's claiming more or less than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake without any fraudulent or deceptive intention¹⁰. The four-year period applies to the date of the application for reissue and not to the grant of the reissued patent¹¹. The reissued patent must be for the same invention as the original.

A reissue must be confined to the invention that was completely conceived and formulated by the inventor before the application for the original patent was filed, and to the invention that the patentee attempted to describe and claim in the original application but, owing to error arising from inadvertence, accident or mistake, failed to do perfectly¹². Further, whenever a reissue contains claims that are broader than the claims in the original patent, they must be directed to what the patentee was attempting to protect in the original patent. The scope of the reissue must not go beyond the invention as disclosed in the original patent¹³.

23.03.01 Division of a reissue application

Under subsection 47(3) of the *Patent Act*, a patentee may file separate applications for reissue in respect of distinct parts of the invention covered by the original patent being reissued. Reissue applications must be filed in the Patent Office within four years from the date of issue of the original patent. The separate reissue applications must all have been filed before the effective date of surrender of the original patent grant, i.e. before the grant of a reissued patent based on any one of them.

The Commissioner will not call for division of a reissue application under subsection 36(2.1) of the *Patent Act* nor will a patentee be permitted to use the provisions of subsection 36(2) of the *Patent Act* during the reissue process under section 47 of the *Patent Act*.

23.03.02 Reissue of a reissued patent

A reissued patent may itself be reissued provided that the application to reissue is filed within four years of the date of the original patent (not of the reissued patent), and provided that the invention is that for which patent protection was sought in the original patent. A reissued patent may not be withdrawn after it has been issued in favour of the original patent.

23.03.03 Reissue and new matter

The patentee must not add new subject matter that was not part of the original invention to the description ¹⁴. Subject matter that is properly inferable from the original specification or drawings and could have been entered under subsection 38.2(2) of the *Patent Act* may be accepted. Under subsection 38.2(3) of the *Patent Act*, drawings may be amended to add matter reasonably inferable from the original specification or drawings ¹⁵ or from matter that is admitted to be prior art or common knowledge ¹⁶. New matter discovered after the date of the filing of the original application may not be added by reissue, as there was no attempt to protect such subject matter in the original patent.

23.03.04 Claims in reissued patent

Not only may a patentee claim less than what was claimed in the original patent, but the patentee may also claim more. In both instances the following conditions must be complied with:

- a) The new claims must be directed to the same invention that the patentee attempted to protect in the original patent ¹⁷.
- b) There must not have been a complete failure to describe in the original patent the invention that is the subject matter of the new claims. The claims presented in the reissue must have support in the specification of the patent ¹⁸.

23.03.05 The petition for reissue

The petition must set out fully the respects in which the patent is defective or inoperative and how the errors arose (see section 43 and Schedule I, Form 1 of the *Patent Rules*).

Reissue applications are subject to examination and are given priority of examination. Examination takes place without a request for examination or the payment of an examination fee; these are included in the reissue fee. The first step, before any other consideration, is to examine the petition for its compliance with section 47 of the *Patent Act*.

- a) If the petition for reissue is acceptable, the reissue specification is subject to examination (see section 23.03.10).
- b) If the petition for reissue is not acceptable, the patentee will be informed by a Commissioner's letter, which will set out the reasons for non-compliance with the *Patent Act*. The Commissioner's letter is written under subsection 47(1) of the *Patent Act* and will specify a three-month time limit for response, after which the Commissioner may refuse the reissue application.

Parts 3, 4 and 5 of Schedule I, Form 1 may not be amended after the petition for reissue is filed, other than to correct simple typographical errors obvious from the document itself. If additional evidence supporting the facts presented in the petition is submitted, it may be put on file but not added to the petition itself. If the facts presented in parts 3, 4 and 5 of the petition subsequently prove to be incorrect, the only way to make corrections is to file a completely new application for reissue (if time still permits) and to pay the reissue fee. Section 47 of the *Patent Act* does not provide for amendments of the petition and submission of additional evidence.

When items 3, 4 and 5 of the petition for reissue are not in accordance with subsection 47(1) of the *Patent Act*, no amendment may be made thereto. However, the patentee may submit a reasoned statement showing how the petition for reissue is in compliance with the *Patent Act* and/or file a new petition along with a further reissue fee provided that the four-year time period has not passed. On receipt of a Commissioner's letter indicating that the petition for reissue is not acceptable and setting a three-month period for reply, any of the following may occur:

- a) If the patentee replies within the time provided, but the Commissioner, after consultation with the Patent Appeal Board (PAB), has reasonable grounds to believe that the petition for reissue still does not comply with the *Patent Act*, the Commissioner will refuse to issue a new patent and the original patent will be returned to the petitioner.
- b) If the patentee replies within the time provided, and the submitted reasoned statement is found persuasive, the reissue specification is examined (see section 23.05.10).
- c) If the patentee files a new petition along with a further reissue fee and submits a

reasoned statement regarding the original reissue application, paragraphs (a) and (b) apply to the original reissue application. Considerations regarding the new reissue application will be addressed on their own merits.

- d) If the patentee does not reply within the time provided, the Commissioner will refuse to issue a new patent and the original patent will be returned to the petitioner.
- e) If the patentee files a new petition along with a further reissue fee and does not reply within the time provided for the original reissue application, the Commissioner will refuse to issue a new patent based on the original reissue application and the original patent will be transferred to the new reissue application for consideration. Considerations regarding the new reissue application will be addressed on their own merits.

23.03.06 Acceptable reasons warranting reissue (Item 3, Form 1)

The fundamental questions to be considered in deciding whether a reissue is warranted are as follows:

- a) whether or not a bona fide mistake was made, resulting in a failure to obtain protection for the invention actually made by the inventor
- b) whether or not there was a complete failure to describe that invention in the original specification, including description and drawings

The answer to the first must be “yes,” and to the second, “no.” It must be apparent from the petition or supporting documents that the inventor intended to protect the invention that he or she seeks to protect by reissue. It must not be apparent that the inventor did not intend to protect that invention.

The following are some examples of situations where a reissue would be in order, assuming that the other requirements for reissue were satisfied.

- a) Failure to claim the invention. The original patent did not accurately put into words what the patentee had intended to protect at the time of issue, because

the patent agent failed to comprehend and claim the invention properly¹⁹. The fact that the original patent disclosed but did not claim the matter covered in the reissue may be a ground to reissue if it can be shown that there was intent to claim the subject matter²⁰.

- b) Failure to claim broadly. The patentee wishes to claim a subcombination that was claimed only as part of a combination. A reissue may be permitted if the subcombination cannot perform in an environment different from that of the combination claimed. The patentee wishes to add claims supported by the original description that are intermediate in scope between the broadest claims cancelled during the prosecution of the original patent, in view of prior art cited by the examiner, and the broadest claim granted on the original patent. Extension of a range may be possible if the extension is fully supported by the specification of the original patent and if the claims of the original patent are unrealistically too limited. Extension must be justifiable, fully supported by the specification of the original patent and based on claims clearly unrealistically too limited²¹.
- c) Claiming too broadly. The patentee wishes to narrow the scope of the invention protected by amending the specification to delete matter the patentee had no right to claim. For instance, he or she may wish to narrow the scope of the claims because of the discovery of prior art after the patent was issued²².
- d) Adding narrower claims. The patentee wishes to add claims that are narrower in scope to those in the original patent while still retaining the broad claims of the original patent. This is permitted provided that the intent to protect the invention defined by the narrower claims in the original patent can be shown. This is treated as a case of "insufficient specification," since "specification" includes both description and claims.
- e) Insufficient description. The patentee wishes to amend the description of an original patent in which the invention had been claimed but not adequately shown or described. New matter that is common knowledge may be added²³.
- f) Claims of a different category. A reissue of the patent may be allowed in order to permit claims of different categories (such as product, process, apparatus and

use of product) to be added, provided that the new claims are for the same invention claimed in the original patent and the subject matters defined by all the claims are so linked as to form a single general inventive concept in accordance with section 36 of the *Patent Rules*. A patent cannot be reissued with claims directed to different categories if the claims define an invention that differs from that disclosed in the original patent ²⁴.

23.03.07 Unacceptable reasons for reissue (Item 3, Form 1)

Reissue is not permitted for the following purposes:

- a) to add newly discovered matter, such as subject matter developed after issuance of the original patent ²⁵ or subject matter which was unknown to the inventor and which he or she had no intention of describing or specifying or claiming in the original patent ²⁶
- b) to reassert claims deliberately cancelled during the prosecution of the original patent in the face of an objection from the examiner, and with full knowledge of the relevant facts ²⁷
- c) to insert claims broader in scope than claims deliberately cancelled during the prosecution of the original patent because of an objection made by the examiner, and with full knowledge of the relevant facts ²⁸
- d) to reassert claims limited during the prosecution of the original patent to clear prior art, ²⁹ to avoid a conflict ³⁰ or to avoid claims broader than these
- e) to insert claims which are of the same scope as the original claims and which provide the same protection as was provided by the original claims
- f) to reassert subject matter that was withdrawn to avoid final action issued by an examiner; in having made the amendment, the application was deemed to have been carefully considered by the patentee ³¹

- g) to reassert claims that were cancelled because of a requirement for division made during the prosecution of the original patent, where the patentee had full knowledge of the relevant facts
- h) to correct matter included in the petition, unless the reissue is made on other acceptable grounds irrespective of when the mistake in the petition was discovered, for example, to correct misjoinder of inventors³² or previously regularly filed application(s) on which priority is requested
- i) to take advantage of intervening legislation (such as amendments to the *Patent Act*) or court judgments
- j) to change the claims because the patent is being circumvented by others (e.g. corrections based on the analysis of a competitor's product³³), unless the patentee can show intent to protect in the original patent what is claimed in the reissue and a failure to do so by reason of error arising from inadvertence, accident or mistake
- k) to combine the subject matters of two existing patents by surrendering each into a single reissue patent, thereby extending the prescribed period of protection for some of the matter³⁴
- l) to correct a patent that was judicially declared fundamentally invalid³⁵

There may well be other reasons advanced for reissue that are not acceptable. An overall consideration is whether the patentee intended to protect subject matter but unintentionally failed to do so.

23.03.08 Intent to claim and error circumstance (Item 4, Form 1)

The patentee must satisfy the Commissioner that there was an intent to protect in the original patent that which is claimed in the reissue; otherwise reissue is not permitted. The onus is on the patentee to demonstrate his or her intent to protect to the Commissioner³⁶. If this is not obvious from the original petition, the examiner requires evidence to that effect. Intent to claim may be established by evidence other than the specification³⁷. The evidence of the inventors at the filing of the reissue petition cannot be used to establish

intent ³⁸. The priority document, the prosecution and the specification of the original application may be used to determine the intent of the patentee ³⁹. Other related applications may be used to establish intent ⁴⁰. The patentee may not make amendments based on facts not set forth in the petition, nor add new facts to the petition for reissue.

The circumstances that transpired and how they resulted in an outcome that was different from the intent must be set out. Assuming that the other requirements for reissue are satisfied, acceptable circumstances for reissue are as follows:

- a) Error of mistake or omission by the agent ⁴¹
- b) Error in understanding by the inventor or the agent leading to filing two applications for subject matters that the examiner later considered to be the same subject matter ⁴²
- c) Error arising from the pressure of meeting deadlines ⁴³
- d) Error due to a mix-up in the agent's office practice or behaviour ⁴⁴
- e) Error due to misunderstanding of the effect of prosecution in a foreign country ⁴⁵
- f) Even though pertinent prior art was brought to the attention of the agent before allowance of the original patent, the agent did not appreciate the significance of this prior art ⁴⁶.
- g) An error that came about by a deliberate act of the patentee but whose consequences were unintentional or not appreciated ⁴⁷. However, a deliberate act can be interpreted as intentional even where the legal implications are not appreciated ⁴⁸.
- h) Error arising from a miscommunication between the agent and the inventor ⁴⁹. The health condition of those involved may be a factor.

A language barrier between the inventor and the agent is acceptable as a contributing factor ⁵⁰.

23.03.09 Discovery of the error (Item 5, Form 1)

The patentee must provide evidence to explain how the error that led to the filing of the reissue was discovered⁵¹. Merely stating that an error was committed is not sufficient. Rather, the manner in which the knowledge of the new facts was obtained must be fully described and must be consistent with the explanation in items 3 and 4 of Form 1. The error must have been discovered after the patent was issued or at least after the final fee was paid⁵².

23.03.10 Examination of the reissue specification

Following the acceptance of the petition for reissue, the amended specification or “reissue specification” is examined. A review of the prosecution history of the original patent is necessary when a reissue application is examined. When new or amended claims are submitted with the reissue, the examiner may conduct further prior art searches. If new prior art is discovered that could have been applied against the original application, it may be applied against the claims of the reissue application. Prior art is considered in view of the original claim dates⁵³ (broader claims may have different claim dates).

- If the reissue specification is acceptable, the reissue is granted.
 - For reissues based on patents issued on applications filed before October 1, 1989, the reissue patent is published and given a new patent number using the main numbering series in use prior to October 1, 1989. The World Intellectual Property Organization (WIPO) Standard Code ST.16 is “E” for this type of document.
 - For reissues based on patents issued on applications filed after October 1, 1989, the reissue patent is published with the same patent number as the original patent. However, the WIPO Standard Code ST.16 “E” indicates that it is a reissue patent.
- When the amended specification does not comply with the *Patent Act* or the *Patent Rules*, the defects are identified in an office letter written under subsection 47(1) of the *Patent Act*; this letter will specify a three-month time limit for response.

- Following the patentee's response, the examiner may
 - allow the reissue application if the amendments in the response overcome the defects and/or the patentee's arguments are found to be persuasive
 - refer the case to the Patent Appeal Board (PAB) if the specification still does not comply with the *Patent Act* and the *Patent Rules*. Following the PAB advice, the Commissioner may refuse the reissue application.
- If the patentee does not respond within the specified three-month time limit, the Commissioner may refuse the reissue application. However, the patentee may argue that the reissue application is in compliance with the *Patent Act* and/or file a new petition along with a further reissue fee provided that the four-year time period has not expired.

23.03.11 Effect of the reissue and maintenance fees

When the reissue is granted, only the reissued patent is then considered, without regard to how any change came to be made in it as a result of the reissue⁵⁴. The reissued patent is entitled to the unexpired term granted to the original patent. Subsection 47(2) of the *Patent Act* clearly describes the effect of a reissue regarding pending action:

47(2) The surrender referred to in subsection (1) takes effect only on the issue of the new patent, and the new patent and the amended description and specification have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the amended description and specification had been originally filed in their corrected form before the issue of the original patent, but, in so far as the claims of the original and reissued patents are identical, the surrender does not affect any action pending at the time of reissue or abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent constitutes a continuation thereof and has effect continuously from the date of the original patent.

This generally applies in a suit for infringement or when the plaintiff in an action can obtain at least part of the remedy claimed ⁵⁵.

No maintenance fees apply to a reissue application (subsection 100(2) of the *Patent Rules*). However, maintenance fees are payable on the reissued patent under the same conditions as the original patent (subsections 101(1) and (2) of the *Patent Rules*), i.e. in accordance with the maintenance fee due dates that apply to the original patent.

23.04 Clerical error corrections

Clerical errors in any instrument of record at the Patent Office may be corrected with the permission of the Commissioner under the provisions of section 8 of the *Patent Act*. No instrument of record at the Patent Office is exempt from correction under section 8 of the *Patent Act*.

Clerical errors originating from the patentee or applicant may be corrected in response to a clerical error request from the patentee or applicant. In this situation, payment of the prescribed fee is required (Schedule II, Part IV, Item 19 of the *Patent Rules*). Third parties willing to point out clerical errors originating from the patentee or applicant should contact the patentee, the applicant or the patent agent of record.

Clerical errors originating from the Patent Office can be discovered during quality control verification, examination or other procedures at the Patent Office, or from observations made by the applicant, the patentee or a third party. Since this type of correction is an internal procedure, no fee is levied. Similarly, no fee is levied for clerical errors originating from mistakes made by foreign patent offices, including international authorities.

The Commissioner will review the request under section 8 of the *Patent Act* and will decide whether or not the correction will be made, based on the nature of the error made. The Commissioner has the discretion and authority to correct clerical errors ⁵⁶. The Commissioner is not obliged to warrant the correction once it has been determined that a clerical error exists ⁵⁷.

During the prosecution of an application, section 35 of the *Patent Rules* provides that the applicant can correct clerical errors in any document relating to an application, other than a specification, a drawing or a document effecting a transfer or a change of name (mainly assignments), that are due to the fact that something other than what was obviously intended was written, under the authority of the Commissioner ⁵⁸.

23.04.01 Content of a clerical error request

There is no clerical error request form. The patentee or applicant requests the correction by

- describing the corrections being sought in a letter to the Commissioner, with reference to the patent or application number, and explaining the circumstances that led to the mistake justifying the correction. An explanation of the circumstances that led to the mistake is important in determining the origin and nature of the mistake.
- if applicable, paying the prescribed fee on requesting correction of a clerical error under section 8 of the Patent Act (Schedule II, Part IV, Item 19 of the *Patent Rules*)
- optionally, attaching the official copy bearing the Patent Office seal (also known as the “grant copy”) to the letter

Refunds of fees paid with a request for clerical error correction are not mandated by section 4 of the *Patent Rules*. The fee is levied for request processing by the Patent Office and does not depend on the acceptance or refusal of the corrections. When a clerical error request is made without the payment of the prescribed fee and the Patent Office determines that this fee is required based on the facts, the Patent Office notifies the patentee or applicant that a fee must be paid to proceed with the consideration under section 8 of the *Patent Act*.

23.04.02 Unacceptable clerical error request

If a request for the correction of a clerical error is refused, the requester will be informed in writing of the reason(s) for its refusal. Since the Commissioner has the discretion to issue a certificate of correction, the court cannot substitute its discretion therefor⁵⁹. The applicant or patentee can seek correction by other means of correction, such as disclaimer or reissue, as applicable given the circumstances.

A first category of unacceptable clerical error requests refers to documents that are not instruments of record at the Patent Office:

- 1) Correction of international patent applications for which Canada is not designated or elected. Such applications are not instruments of record at the Patent Office as they do not represent validly filed applications in the Patent Office⁶⁰.
- 2) An act of omission referring to documents or parts of documents that are not instruments of record at the Patent Office
- 3) The replacement of entire parts of a patent or patent application, such as a complete description or a claim in its entirety, referring to material that is not an instrument of record

A second category of unacceptable clerical error requests refers to mistakes that are not clerical errors by nature:

- 4) Correction of a claim or claims due to lack of antecedence of some terms or expressions
- 5) Correction of translation mistakes (translation mistakes are not transcription mistakes)

A third category of unacceptable clerical error requests refers to corrections negatively affecting the rights of others:

- 6) Modification backdating the priority date ⁶¹, owing to a mistake by the applicant or patentee (Chapter 7 of MOPOP provides information about requesting priority)
- 7) Corrections having the effect of broadening the claims of a patent
- 8) Correction or revocation of a dedication or disclaimer of rights ⁶²

23.04.03 Effect of a clerical error correction

When the decision regarding a request to correct a clerical error is positive and affects a document registered at the Patent Office, the requester is informed by an office letter that the correction has been made and receives a certificate of correction listing all the changes applied to the instrument of record. For a granted patent, the certificate of correction is accompanied by a copy of the cover page, bearing the official stamp “see certificate - Correction - Article 8 voir certificat,” and a copy of all the pages affected by the correction, bearing the official stamp “Section 8 Correction see certificate - Correction - Article 8 voir certificat.” The Patent Office records are corrected accordingly.

The patent or patent application has to be read as it has always been read in its corrected form.

Endnotes for Chapter 23

1. Monsanto Co. v. Commissioner of Patents, [1975] 18 C.P.R. (2d) 170 at 178, reversed on other grounds, [1976] 28 C.P.R. (2d) 118.
2. Trubenizing Process Corp. v. John Forsyth, Ltd., [1942] 2 C.P.R. 89 at 106-107, reversed on other grounds, [1943] 3 C.P.R. 1

3. Standal's Patents Ltd. et al. v. Swecan International Ltd. et al., [1989] 28 C.P.R. (3d) 261 at 276
4. Monsanto Co. v. Commissioner of Patents, [1975] 18 C.P.R. (2d) 170 at 176-177, reversed on other grounds, [1976] 28 C.P.R. (2d) 118.
5. International Vehicular Parking Ltd. v. Mi-Co Meter (Canada) Ltd. and Guelph, [1948] 9 C.P.R. 97 at Sec. II, p. 112
6. ICN Pharmaceuticals, Inc. et al. v. Canada (Patented Medicine Prices Review Board), [1996] 66 C.P.R. (3d) 45, affirmed 68 C.P.R. (3d) 417
7. Cooper & Beatty v. Alpha Graphics Ltd. et al., [1980] 49 C.P.R. (2d) 145 at 164
8. Canadian Celanese Ltd. v. B.V.D. Co. Ltd., [1939] 2 D.L.R. 289 at 294
9. Curl Master Mfg. Co. Ltd. v. Atlas Brush Ltd., [1967] 52 C.P.R. 51 at 72-73, reversing 48 C.P.R. 67 (also indexed as [1967] SCR 514 at 531-533)
10. Northern Electric Co. Ltd. et al. v. Photo Sound Corp. et al., [1936] S.C.R. 649 at 653
11. Curl Master Mfg. Co. Ltd. v. Atlas Brush Ltd., [1967] 52 C.P.R. 51 at 74, reversing 48 C.P.R. 67 (also indexed as [1967] SCR 514)
12. Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 488 at 501, reversed on other grounds, [1995] 63 C.P.R. (3d) 473
Commissioner's Decision No. 326, Application No. 193998, [1976] at 13
13. Farbwerke Hoechst A.G. etc. v. Commissioner of Patents, [1966] 50 C.P.R. 220 at 255-256 & 259 (also indexed as [1966] S.C.R. 604 at 615 & 617)
Fuso Electric Works et al. v. Canadian General Electric Co. Ltd., [1940] SCR 371 at 381 & 385
Bergeon v. De Kermor Electric Heating Co. Ltd., [1927] Ex. C.R. 181 at 191-192
14. Commissioner's Decision No. 1081, Application No. 342,635 (now Patent No. 1,271,356), [1986] at 7
15. Curl Master Mfg. Co. Ltd. v. Atlas Brush Ltd., [1967] 52 C.P.R. 51 at 52 & 70-71, reversing 48 C.P.R. 67 (also indexed as [1967] SCR 514)
16. Commissioner's Decision No. 56, Application No. 40,555 (now Patent No. 872,729), [1971] at 7
17. Apotex Inc. v. Hoffmann La-Roche Ltd., [1987] 15 C.P.R. (3d) 217 at 218 & 242, affirmed 24 C.P.R. (3d) 289
Urea Casale S.A. v. Stamicarbon B.V., [2002] 17 C.P.R. (4th) 377 at 393, rev. 8 C.P.R. (4th) 206
18. Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 489 at 501, reversed on other grounds 63 C.P.R. (3d) 473
In Re: Application for patent of Khallil (now Patent No. 1,147,604), [1983] 2 C.P.R. (3d) 343 at 351
Re: Hewlett-Packard Co. Application, [1989] 31 C.P.R. (3d) 463 at 468
Curl Master Mfg. Co. Ltd. v. Atlas Brush Ltd., [1967] 52 C.P.R. 51 at 52 reversing [1965] 48 C.P.R. 67
Apotex Inc. v. Hoffmann La-Roche Ltd., [1987] 15 C.P.R. (3d) 217 at 218, affirmed [1989] 24 C.P.R. (3d) 289

19. *Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd.*, [1976] 17 CPR (2d) 97, (also indexed as 1 [1976] SCR 555 at 568), reversing 10 C.P.R. (2d) 126, reversing 7 C.P.R. (2d) 198
20. *Leonard v. Commissioner of Patents*, [1913] 14 ExCR 351 at 360
Commissioner's Decision No. 141, Application No. 60,764 (now Patent No. 940,336), [1973] at 9
Northern Electric Company Ltd. v. Photo Sound Corp., [1936] SCR 657 at 659, 660, and 665-666
21. Commissioner's Decision No. 667, Application 271,054 (now Patent No. 1,089,582), [1980] at 5
22. *Flexi-Coil Ltd. v. F.P. Bourgault Industries Air Seeder Division Ltd.*, [1990] 31 C.P.R. (3d) 529 at 536, affirmed [1991] 35 C.P.R. (3d) 154
Rothmans, Benson & Hedges Inc. v. Imperial Tobacco Ltd./Ltée, [1991] 35 C.P.R. (3d) 417 at 430, affirmed on other grounds, [1993] 47 C.P.R. (3d) 188
23. Commissioner's Decision No. 56, Application No. 40,555 (now Patent No. 872,729), [1971] at 6-7
24. *Fuso Electric Works et al. v. Canadian General Electric Co. Ltd.*, [1940] S.C.R. 371 at 385
Farbwerke Hoechst A.G. etc. v. Commissioner of Patents, [1966] 50 C.P.R. 220 at 241 (also indexed as [1966] Ex. C.R. 91 at 109-110, affirmed, [1966] S.C.R. 604)
25. *Fuso Electric Works et al. v. Canadian General Electric Co. Ltd.*, [1940] S.C.R. 371 at 378
Creations 2000 Inc. et al. v. Canper Industrial Products Ltd. et al., [1988] 22 C.P.R. (3d) 389, affirmed, [1990] 34 C.P.R. (3d) 178 at 407
Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 488 at 498 and 499, reversed on other grounds, [1995] 63 C.P.R. (3d) 473
Re: *Hewlett-Packard Co. Application*, [1989] 31 C.P.R. (3d) 463 at 470
26. Commissioner's Decision No. 1034, Application No. 342200, [1984] at 7
27. Re: *Wahpeton Canvas Co. Application Reissue*, [1989] 31 C.P.R. (3d) 434 at 446
Notice by Assistant Commissioner, 10 C.P.R. (2d) 230 at 236
Re: *Application No. 100,628 of Film Corp. of America*, [1972] 11 C.P.R. (2d) 283 at 288
Commissioner's Decision No. 420, Application No. 225,214 (now Patent No. 1,027,403), [1977] at 1
28. Commissioner's Decision No. 906, Application No. 330,333, [1981]
29. Re: *Halbrite Well Services Co. Patent Application No. 616,196*, [1993] 3 C.P.R. (4th) 94 at 95
Commissioner's Decision No. 326, Application No. 193,998, [1976] at 9
Commissioner's Decision No. 134, Application No. 100,628 (now Patent No. 921,743), [1972] at 5
30. Re: *Application of Wahpeton Canvas Co.*, [1989] 31 C.P.R. (3d) 434
31. Re: *Halbrite Well Services Co. Patent Application No. 616,196*, [1993] 3 C.P.R. (4th) 94 at 95
32. Re: *Application of Westinghouse Electric Corp.*, [1980] (now Patent No. 1,101,791), 63 C.P.R. (2d) 153 at 156
33. Re: *Application of Hewlett-Packard Co.*, [1989] 31 C.P.R. (3d) 463 at 470
34. Re: *Application for reissue of Wahpeton Canvas Co.*, [1989] 31 C.P.R. (3d) 434 at 451

35. Creations 2000 Inc. et al. v. Canper Industrial Products Ltd. et al., 22 C.P.R. (3d) 389 at 406, affirmed 34 C.P.R. (3d) 178
36. Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 489 at 498, reversed on other grounds, [1995] 63 C.P.R. (3d) 473 at 499
37. Northern Electric Company Limited v. Photo Sound Corp., [1936] S.C.R. at 659
Fuso Electric Works et al. v. Canadian General Electric Co. Ltd., [1940] S.C.R. 371 at 380
38. Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 489 at 499, reversed on other grounds, [1995] 63 C.P.R. (3d) 473
Commissioner's Decision No. 1095, Application No. 400,496 (now Patent No. 1,220,002), [1986] at 6
39. Northern Electric Company Ltd. v. Photo Sound Corporation, [1936] S.C.R. at 649 and 635
Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 489 at 498 and 499, reversed on other grounds, [1995] 63 C.P.R. (3d) 473
Commissioner's Decision No. 1173, Application No. 615,585 (now Patent No. 1,258,156), [1992] Commissioner's Decision No. 326, Application No. 193,998, [1976] at 10
Commissioner's Decision No. 77, Application No. 9,562 (now Patent No. 930,656), [1971] at 3
Commissioner's Decision No. 134, Application No. 100,628 (now Patent No. 921,743), [1972] at 4
Commissioner's Decision No. 1066, Application No. 379,817 (now Patent No. 1,217,519), [1986] at 9
40. Commissioner's Decision No. 326, Application No. 193,998, [1976] at 11 and 12
41. Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd., [1976] 17 CPR (2d) 97 at 108, (also indexed as 1 [1976] SCR 555 at 568), reversing 10 C.P.R. (2d) 126, reversing 7 C.P.R. (2d) 198
42. Re: Application of Westinghouse Electric Corp., [1980] (now Patent No. 1,101,791), 63 C.P.R. (2d) 153 at 156
43. Cabot Corp. v. 318602 Ontario Ltd., [1988] 20 C.P.R. (3d) 132 at 134
44. Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 489 at 498, reversed on other grounds, [1995] 63 C.P.R. (3d) 473
Burton Parsons Chemicals Inc. v. Hewlett-Packard (Canada) Ltd., [1976] 17 CPR (2d) 97 at 108, (also indexed as 1 [1976] SCR 555 at 568), reversing 10 C.P.R. (2d) 126, reversing 7 C.P.R. (2d) 198
45. Commissioner's Decision No. 56, Application No. 40,555 (now Patent No. 872,729), [1971] at 6-7
46. Commissioner's Decision No. 40, Application No. 1,820 (now Patent No. 866,300), [1970] at 6
47. Mobil Oil Corp. et al. v. Hercules Canada Inc., [1994] 57 C.P.R. (3d) 489 at 500, reversed on other grounds, [1995] 63 C.P.R. (3d) 473
Hydril Patent Application No. 616,666, [1997] 85 C.P.R. (3d) 503 at 509
48. Commissioner's Decision No. 906, Application No. 330,333, [1981] at 10
49. Curl Master Mfg. Co. Ltd. v. Atlas Brush Ltd., [1967] 52 C.P.R. 51 at 69 reversing [1965] 48 C.P.R. 67

50. Commissioner's Decision 1173, Application No. 615,585 (now Patent No. 1,320,323), [1992] at 8-9
Commissioner's Decision 123, Application No. 96,160 (now Patent No. 921,510), [1972] at 2
51. Paul Moore Co. Ltd. v. Commissioner of Patents, [1979] 46 C.P.R. (2d) 5 at 10
Commissioner's Decision No. 104, Application No. 104,168 (now Patent No. 914,704), [1972] at 2
Commissioner's Decision No. 26, Application No. 975,082 (now Patent No. 862,687), [1970]
52. Commissioner's Decision No. 1093, Application No. 371,218 (now Patent No. 1,230,339), [1986] at 6
Commissioner's Decision No. 1173, Application No. 615,585 (now Patent No. 1,258,156), [1992]
53. Energy Absorption Systems Inc. v. 2859-7888 Québec Inc. et al., [1993] 53 C.P.R. (3d) 397 at 399
54. O'Cedar of Canada Ltd. v. Mallory Hardware Products Ltd., [1955], 24 C.P.R. 103 at 132
55. Continental Can Co. of Canada Ltd. v. Wainberg, [1969] 61 C.P.R. 159 at 160
56. Bristol-Myers Squibb Co. v. Canada (Commissioner of Patents), [1998] 82 C.P.R. (3d) 192 at 197,
affirming [1997] 77 C.P.R. (3d) 300. "The current section 8 no longer requires a certificate but
maintains the requirement that the correction be made under the authority of the Commissioner, ..."
57. Bayer Aktiengesellschaft v. Commissioner of Patents, [1980] 53 C.P.R. (2d) 70 at 74. "There is nothing
in the circumstances contemplated by s. 8 that would lead me to conclude that the respondent is
obliged to issue a certificate of correction once he determines that what is sought to be corrected is a
clerical error. It is in his discretion to do so. The Court cannot substitute its discretion for his."
The Upjohn Co. v. Commissioner of Patents et al., [1983] 74 C.P.R. (2d) 228 at 232-233
58. Bristol-Myers Squibb Co. v. Canada (Commissioner of Patents), [1998] 82 C.P.R. (3d) 192 at 197,
affirming [1997] 77 C.P.R. (3d) 300. "... and the current rule 35 provides that the correction is to be
made by the applicant, ostensibly under the authority of the Commissioner."
59. Bayer Aktiengesellschaft v. Commissioner of Patents, [1980] 53 C.P.R. (2d) 70 at 74
60. Celltech Ltd. v. Canada (Commissioner of Patents), [1993] 46 C.P.R. (3d) 424 at 435 & 441,
affirmed [1994] 55 C.P.R. (3d) 59
61. Bristol-Myers Squibb Co. v. Canada (Commissioner of Patents), [1998] 82 C.P.R. (3d) 192 at 199-
200, affirming [1997] 77 C.P.R. (3d) 300
62. Parke Davis, [2001] 14 C.P.R. (4th) 335 para 102 to 107, reversed on other grounds 2002 FCA 454