

Chapter 24

Maintenance fees

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Chapter 24

Maintenance fees

24.01 Scope of this chapter

This chapter outlines the Patent Office policy respecting the fees to be paid to maintain patent applications and patents, and the procedures and time limits relating to the payment of maintenance fees.

24.02 Maintenance of patent applications

An applicant who files a patent application in Canada after October 1, 1989 must pay maintenance fees for prescribed periods in order to keep the application in effect (subsection 27.1(1) of the *Patent Act*).

Divisional applications carry their own maintenance fees, separate from the parent application. Since a properly filed divisional application will bear the filing date of the parent application, a divisional application is, at the time of filing, subject to fees to maintain the application in effect. Such fees will be calculated from the filing date of the parent application and are payable upon filing of the divisional application (subsections 99(3), and 154(3) of the *Patent Rules*). For example, if a divisional application is to be filed 40 months after the parent application, maintenance fees for the 2nd and 3rd years have to be paid upon of the divisional application.

Applications filed under the provisions of the Patent Cooperation Treaty and entering the national phase in Canada must pay maintenance fees in accordance with part VI of Schedule 2 of the *Patent Rules*. It should be noted that the international filing date is the date on which the maintenance fee Schedule is based.

Maintenance fees do not have to be paid on an application for reissue of a patent (sections 101, 156 and 182 of the *Patent Rules*). The applicant must continue to pay maintenance fees on the patent being reissued.

24.02.01 Due dates for application maintenance fees

In order to maintain a patent application in effect, an applicant must pay maintenance fees for each one-year period from the second anniversary of the filing date of the application. Whether or not the application issues to patent the maintenance fees will continue to be due on the same schedule until the last payment is made before the nineteenth anniversary, which covers the period from the nineteenth anniversary to the twentieth anniversary, which represents the full term of the patent. The time limit for paying each maintenance fee is given in Item 30, Part VI of Schedule II of the *Patent Rules*. Part VI of Schedule II of the *Patent Rules* is reproduced in section 25.06 of the present manual.

The maintenance fee for an application must be paid before the first day of the one-year period the fee covers. For example, the maintenance fee covering the one-year period ending on the fifth anniversary of the filing of the application must be paid on or before the fourth anniversary of the filing date.

Any or all of the maintenance fees for a particular application or a patent may be paid in advance.

Time limits for payment of maintenance fees cannot be extended.

24.02.02 Responsibility for payment of maintenance fees for applications

Only the applicant or the authorized correspondent shall pay maintenance fees. The amounts are set forth in Item 30, Part VI of Schedule II of the *Patent Rules*. The authorized correspondent is responsible for ensuring the timely payment of maintenance fees. The Patent Office will send a reminder to the authorized correspondent that the payment of the first maintenance fee is approaching. This will be a one time notice mailed approximately three months in advance of the second anniversary of the application's filing date.

24.02.03 Non-payment of application maintenance fees

Non-payment of maintenance fees will result in abandonment of the application under subsection 73(1) of the *Patent Act*. The authorized correspondent will normally be

advised in a notice of abandonment that applicant's application is abandoned for failure to pay the maintenance fee by the due date. For details on the reinstatement procedure for abandoned applications (see section 20.08 of the present manual).

24.03 Maintenance of patents

Maintenance fees for patents issued on the basis of applications filed after October 1, 1989 are payable for each one year period between the second and twentieth anniversaries of the date of filing of the application in Canada.

Maintenance fees for patents issued on or after October 1, 1989 on the basis of an application filed before October 1, 1989 are payable for each one year period between the second and the seventeenth anniversaries of the date on which the patent was issued.

No maintenance fee for a patent is due for any period where a maintenance fee was paid to maintain the patent application in effect.

Maintenance fees for reissue patents are due at the same times and for the same periods as the original patent for the unexpired term of the original patent. No fee to maintain the rights accorded to a reissue patent is payable for any period where a maintenance fee was paid to maintain the original patent or to maintain the application for the original patent (section 101 of the *Patent Rules*).

24.03.01 Due dates for patent maintenance fees

Maintenance fees are due before the first day of each of the one-year periods they cover. For example, payment is due on or before the eleventh anniversary for the one year period ending on the twelfth anniversary. The time limits for maintenance fees for patents are given in Items 31 and 32 of Part VI of Schedule II of the *Patent Rules*, included as Section 25.06 of this manual.

Late payment of the maintenance fees for patents are also accepted by the office if the payment is made within the one year period the fee covers and the prescribed late payment fee is also paid. For example, the maintenance fee for the one year period ending on the seventeenth anniversary of the filing date can be made, with the

additional fee for late payment, on or before the seventeenth anniversary date. Any or all of the maintenance fees for a particular application or a patent resulting from that application may be paid in advance.

The time limits for payment of maintenance fees for patents cannot be extended.

24.03.02 Responsibility for payment of maintenance fees

The patentee is responsible for ensuring the timely payment of maintenance fees. The Patent Office will not send a reminder to the patentee that a date for the payment of a maintenance fee is approaching.

24.03.03 Non-payment of patent maintenance fee

A patent is deemed to have lapsed at the expiration of the time specified in Part VI of Schedule II of the *Patent Rules* (subsection 46(2) of the *Patent Act*) for payment of maintenance fees. A lapsed patent cannot be revived. See also section 20.09 of MOPOP on Lapsed Patent. If the maintenance fee on a patent is not paid on or before the anniversary date the Patent Office will normally inform the patentee that a late payment fee must be paid within one year following the anniversary or the patent will lapse.

24.04 Schedule of maintenance fees

The tariff of the maintenance fees are listed in Part VI of Schedule II (Section 3) of the *Patent Rules*, and in section 25.06 of the present manual.

24.05 Maintenance fee information on the Canadian Patent Database (CPD)

Maintenance fee information is accessible on the administrative status page (“View administrative status”) of the Canadian Patent Database at:

<http://patents1.ic.gc.ca/intro-e.html>).

Maintenance fee information includes the date and amount of the last payment received, the date and amount of the next payment if the applicant or grantee is a small entity type and the date and amount of the next payment if the applicant or grantee is a large entity type.

Expired status is defined as: "In cases where all maintenance fees required by section 46 of the *Patent Act* were paid, the day at the end of which the patent term expired, pursuant to section 44 or 45 of the *Patent Act*."