

Chapter 20

Time limits, withdrawal, abandonment and lapse

- 20.01 Scope of this chapter
- 20.02 Time limits
 - 20.02.01 Withdrawal of an application
 - 20.02.02 Request for priority
 - 20.02.03 Filing a divisional application
 - 20.02.04 Completing the application
 - 20.02.05 Appointment of a patent agent
 - 20.02.06 Deposits of biological materials
 - 20.02.07 Request for examination
 - 20.02.08 Response to a requisition of the Commissioner or an examiner
 - 20.02.09 Appeals to the Federal Court
 - 20.02.10 Reinstatement of abandoned applications
 - 20.02.11 Final Fee
 - 20.02.12 Reissue
 - 20.02.13 Maintenance Fees
- 20.04 Time limits expiring on a dies non
- 20.05 Extensions of time
- 20.06 Withdrawal of an application by applicant
- 20.07 Abandonment
- 20.08 Reinstatement
- 20.09 Lapsed patent
- 20.10 Jurisprudence

Chapter 20

Time limits, withdrawal, abandonment and lapse

20.01 Scope of this chapter

This chapter outlines Patent Office policy respecting time limits, extensions of time, withdrawal of applications, abandonment of applications and the lapse of patents. The remedial procedures available to reinstate abandoned applications are also detailed.

20.02 Time limits

The following paragraphs give the time limits prescribed by the *Patent Act* or the *Patent Rules* regarding patent applications and patents.

20.02.01 Withdrawal of an application

A patent application may be withdrawn at any time by written notice from the applicant or the authorized correspondent. An application which is withdrawn more than two months before the expiry of the confidentiality period will not be open to public inspection (subsection 10(5) of the *Patent Act* and section 92 of the *Patent Rules*). Applications withdrawn during the last two months of the confidentiality period will be laid open to public inspection unless there is time to stop the technical preparations to open the application to public inspection (Sections 92 and 146 of the *Patent Rules*).

Applications filed prior to October 1, 1989 may be withdrawn at any time by the applicant or the authorized correspondent and will never be opened to public inspection.

20.02.02 Request for priority

For applications filed after October 1, 1996 a request for priority must be received by the office within four months of the filing date of the application (the subject application). The applicant must provide the Commissioner with the date and country of filing of each previously regularly filed application on which the request for priority is based, before

the expiry of the four- month period after the filing date of the subject application and must also provide the Commissioner with the application number of each previously regularly filed application on which the request for priority is based, before the expiry of the later of the four-month period after the filing date of the subject application and the twelve-month period after the date of filing of the previously regularly filed application (section 88 of the *Patent Rules*).

For applications filed in the period beginning on October 1, 1989 and ending the day before October 1, 1996 a request for priority must be received by the office within six months of the filing date of the application(the subject application). The applicant must also provide the Commissioner with the date and country of filing and the application number of each previously regularly filed application on which the request for priority is based before the expiry of the six-month period after the filing date of the subject application (section 142 of the *Patent Rules*).

The time limit for making a request for priority is not extendable in either of the two situations set forth above.

A request for priority may be withdrawn at any time before a patent is issued. If the applicant withdraws a request for priority before the expiry of the confidentiality period it may be possible to delay the laying open of the application to public inspection (subsection 10(4) of the *Patent Act*). The withdrawal must be made within sixteen months of the filing date of the priority application, or a later date if the technical preparations to open the application to public inspection can be stopped (sections 91 and 145 of the *Patent Rules*). The application will be laid open to public inspection at the end of the new confidentiality period (eighteen months from the Canadian filing or eighteen months from the earliest date of the next earliest previously regularly filed application on which a request for priority is based). See chapter 7 on priority for more information.

Applicants of applications filed prior to October 1, 1989 may request priority at any time.

20.02.03 Filing a divisional application

A divisional application must be filed before issue of the original application (parent application) according to Subsection 36(2) of the *Patent Act*. If the parent application

becomes abandoned, the divisional application must be filed before the expiration of the time limit for reinstatement of the parent (Subsection 36(3) of the *Patent Act*).

Time limits for filing a divisional application are not extendable.

20.02.04 Completing the application

Non-PCT applications filed on or after October 1, 1996, which do not meet the requirements of subsection 27(2) of the *Patent Act* at the date of filing, are deemed to be incomplete and the office will make every effort to inform the applicant of the reasons for noncompliance by means of a courtesy letter. The letter will specify a time limit prior to which the application can be completed free. The time limit will be a date fifteen months from the filing date, or from the date of the earliest previously regularly filed application on which a request for priority is based, if any. The purpose of not requiring a fee for completing an application during the above period is to encourage applicants to provide the Patent Office with electronically scannable pages for TECHSOURCE and to ensure that all documents listed in (a) to (i) in the previous paragraph arrive at the Patent Office in a timely manner for laying open to public inspection under section 10 of the *Patent Act*.

If at the expiration of a time period of fifteen months from the filing date, or the priority date, if any, the application is still not complete, a Commissioner's Notice will be sent under subsection 94(1) of the *Patent Rules*. The Notice will requisition the applicant to complete the application within a period ending the later of three months after the date of the notice and twelve months after the filing date of the application. Completing the application after the notice has been received will require the payment of the completion fee specified in Item 2 of Schedule II of the *Patent Rules*. Failure to complete the application or to pay the fee within the time period specified in the notice will result in abandonment of the application.

Non-PCT applications filed before October 1, 1996, that are not complete at filing must meet the completion requirements of subsection 148(1) of the *Patent Rules* and pay the completion fee within twelve months of filing in order to avoid abandonment(see chapter 5 for more information on completion requirements).

Completion requirements and time limits for PCT applications depend on whether

Canada was designated or designated and elected on the international application (sections 58 and 62 of the *Patent Rules* and Section 16 of the Canadian Patent Cooperation Treaty Regulations as they read immediately before October 1, 1996). Chapter 22 of this manual details all the requirements and time limits for PCT applications including national phase entry.

The time limits for completing an application are not extendable (subsections 62(3), 94(3), and 148(2) of the *Patent Rules*).

20.02.05 Appointment of a patent agent

Whenever a patent agent must be appointed pursuant to Section 23 of the *Patent Rules*, the Patent Office sends a notice to the applicant. A patent agent must be appointed within three months from the date of the notice. The three-month time limit may be extended under Section 26 of the *Patent Rules*.

20.02.06 Deposits of biological materials

Where the applicant wishes to supplement the description of the invention with a deposit of biological material under Section 38.1 of the *Patent Act*, the deposit must be made with an International Depositary Authority (IDA). For applications filed on or after October 1, 1996, the deposit with an IDA must be made on or before the Canadian filing date. The name of the IDA, the date of the deposit, and the accession number given by the IDA, if not already part of the description at the time of filing, must be provided before the application is open to public inspection under Section 10 of the *Patent Act* (Subsections 104(1) and (2) of the *Patent Rules*). For applications filed before October 1, 1996, the deposit must have been made on or before the filing date of the application either in an IDA or in some other depositary from which samples of the deposit can be obtained by the public. If the deposit was not made with an IDA, the applicant must deposit a sample with an IDA on or before October 1, 1997. Where an application filed before October 1, 1996 (or a patent which may have issued on the basis of such an application) does not already contain the following information, it must be provided on or before January 1, 1998, or before the expiry of the 18 months confidentiality period for the application, whichever is the later: the name of the IDA, the date of the original IDA deposit, the accession number given by the IDA, the name of any non-IDA depositary (if a deposit made before the filing date was not in an IDA) and

the date of the deposit in the non-IDA depository (Section 160 of the *Patent Rules*).

An applicant may file a notice with the Commissioner that a sample of a deposit referred to in an application be furnished only to an independent expert nominated by the Commissioner. This "expert solution" applies until either a patent has issued on the basis of the application or until the application is withdrawn, refused or abandoned and no longer subject to reinstatement. For an application filed on or after October 1, 1996, a notice requesting that access be restricted must be filed before the application is open to public inspection. For an application filed before October 1, 1996, the notice must be filed on or before January 1, 1998, or before the expiry of the confidentiality period for the application, whichever is the later (subsections 104(4) and 160(4) of the *Patent Rules*).

The time limits for deposits are not extendable (subsections 104(5) and 160(5) of the *Patent Rules*).

For full details on deposits of biological materials, see Chapter 17 of this manual.

20.02.07 Request for examination

For applications filed on or after October 1, 1996 an applicant must request examination and pay the prescribed fee pursuant to subsection 35(1) and paragraph 73(1)(d) of the *Patent Act* within five years of filing the application (subsection 96(1) of the *Patent Rules*). The time limit for requesting examination on a divisional application with a filing date (parent's filing date) on or after October 1, 1996 is either five years from the filing date of the parent or six months after the date on which the divisional application was actually filed, whichever date is later (subsection 96(2) of the *Patent Rules*).

For applications filed before October 1, 1996, an applicant must request examination and pay the fee within seven years of filing (subsection 150(1) of the *Patent Rules*). The time limit for requesting examination on a divisional application with a filing date (parent's filing date) before October 1, 1996 is seven years from the filing date of the parent or six months after the date on which the divisional application was actually filed, whichever date is later (subsection 150(2) of the *Patent Rules*).

The time limits for requesting examination set out above are not extendable (subsections 96(3) and 150(3) of the *Patent Rules*).

Where the Commissioner requires the applicant to make a request for examination under subsection 35(2) of the *Patent Act*, a notice will be sent specifying a three month time limit (sections 25, 97 or 151 of the *Patent Rules*). The time limit of that notice may be extended according to section 26 of the *Patent Rules*, but cannot extend beyond the five-year or seven-year time limit for requesting examination under section 96 or 150 of the *Patent Rules*.

20.02.08 Response to a requisition of the Commissioner or an examiner

Where the Commissioner makes a requisition of an applicant pursuant to section 25, section 97 or section 151 of the *Patent Rules* the time limit for a response is three months from the date of the notice. The three-month time limit may be extended under section 26 of the *Patent Rules*.

An examiner's requisition will specify a six month or shorter time limit (paragraph 73(1)(a) of the *Patent Act* and subsection 30(2) of the *Patent Rules*). The six-month time limit cannot be extended. A shorter time limit may be extended under section 26 of the *Patent Rules*, but cannot be extended beyond six months.

20.02.09 Appeals to the Federal Court

An appeal of a Commissioner's Decision to the Federal Court must be taken within three months of the date of mailing of the Commissioner's Decision to the applicant (subsection 18(2) of the *Patent Act*). The time limit for appeal may be extended under section 27 of the *Patent Rules*.

Where an application has been refused by the Commissioner pursuant to section 40 of the *Patent Act*, an appeal to the Federal Court must be initiated within six months of the mailing of the Commissioner's Decision to the applicant (section 41 of the *Patent Act*). This time limit cannot be extended.

20.02.10 Reinstatement of abandoned applications

Applications which have become abandoned under subsections 73(1) or (2) of the

Patent Act may be reinstated within the twelve-month period from the date of abandonment (sections 98 and 152 of the *Patent Rules*). Occasionally applications may become abandoned for more than one reason. Where an application is abandoned for more than one failure to act, the applicant must comply with section 98 or 152 of the *Patent Rules* for each failure to act within twelve months of the date the application was deemed to be abandoned for that failure (sections 98 and 152 of the *Patent Rules*).

The time limit for reinstatement may be extended under section 26 of the *Patent Rules* provided that the request for the extension of time is made before the period for reinstatement expires. If the applicant takes no action prior to the expiry of the twelve-month reinstatement period, the application cannot be reinstated. No retroactive extensions are available.

20.02.11 Final Fee

Where an applicant receives a notice of allowance, the time limit for the payment of the final fee is set out in the notice and shall be six months from the date of the notice (paragraph 73(1)(f) of the *Patent Act* and subsection 30(6) of the *Patent Rules*). The time limit for payment of the final fee is not extendable.

20.02.12 Reissue

A patentee may apply for a reissue of a patent within four years from the issue of the original patent (subsection 47(1) of the *Patent Act*). This time limit is not extendable.

20.02.13 Maintenance Fees

The maintenance fees due and the time limits for their payments for patent applications are given in Item 30, Part VI of Schedule II of the *Patent Rules* (sections 99 and 154 of the *Patent Rules*).

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

The maintenance fees for divisional applications are due on the same dates as for the

parent application. Where maintenance fees are owing at the time of filing a divisional application, all of the fees which would have been due had the divisional application been filed on the filing date of the parent application must be paid at the time of filing of the divisional to avoid immediate abandonment (subsections 99(3) and 154(3) of the *Patent Rules*).

Maintenance fees for patents depend on the filing date of the applications from which they issued. For patents issued on the basis of an application filed after October 1, 1989, the maintenance fees and time limits are set out in Item 31, Part VI of Schedule II of the *Patent Rules* (sections 100, 101, 155 and 156 of the *Patent Rules*). Maintenance fees and time limits for patents issued after October 1, 1989 on the basis of an application filed before October 1, 1989 are given in Item 32, Part VI of Schedule II of the *Patent Rules* (subsections 182(1) and (3) of the *Patent Rules*).

Time limits for payment of maintenance fees are not extendable.

20.03 Time limits expressed in "months"

Applications become abandoned or reinstated if certain actions are taken or not taken within definite time limits usually expressed in a certain number of months. When a requisition is made for an action to be taken within a fixed number of months and the final month has no date the same as the date of the requisition, then the last day of such month is the date the action must be completed. Thus an examiner's requisition with a time limit of six months which is issued on August 29, 30, or 31 must be replied to by February 28 (or February 29 in leap years). Similarly a requisition issued on March 31 setting three months for reply requires a response by June 30.

20.04 Time limits expiring on a dies non

When the last day upon which an applicant or a patentee may act on an application or patent falls on a day when the Patent Office is closed for business the action may be taken on the next day the Patent Office is open (section 78 of the *Patent Act*). If the failure to act sets up new time limits (such as a reinstatement period), the new period starts to run from the extended date, rather than from the original date when the action

was due. For example, if a notice of allowance is issued on June 25, 1996 the final fee is due on December 27, 1996 (the Patent Office being closed December 25 and 26). If the final fee is not paid on or before December 27, 1996 the application is deemed to be abandoned on December 27, 1996 and can be reinstated by requesting reinstatement and paying the appropriate fees on or before December 29, 1997 (December 27, 1997 being a Saturday).

The Patent Office is closed for business on all Saturdays and Sundays as well as on the following designated holidays or, if these designated holidays fall on a weekend, the first normal working day following the weekend:

- New Year's Day
- Good Friday
- Easter Monday
- Victoria Day
- St-Jean Baptiste Day
- Canada Day
- Labour Day
- Thanksgiving
- Remembrance Day
- Christmas Day
- Boxing Day

It should be noted that the Patent Office is not closed on the 1st Monday in August.

20.05 Extensions of time

The time limits discussed in Section 20.02, above, which are indicated as extendable may be extended by the Commissioner (subsection 26(1) and subsection 27(1) of the *Patent Rules*). **The applicant must apply for the extension of time before the expiry of original time limit** and pay the extension fee set out in Item 22, Part IV of Schedule II of the *Patent Rules*. Where the Commissioner is satisfied that the circumstances justify the extension, an extension will be granted, and the applicant notified by letter. The applicant will also receive an office letter if the extension of time is refused. While no affidavit is required, the Commissioner requires reasons why the

applicant is unable to complete the required actions within the time period originally set. Unreasonable numbers of extensions or unreasonable lengths of extensions will not be granted by the Commissioner.

20.06 Withdrawal of an application by applicant

An application may be withdrawn at any time. If an application which has never been opened to public inspection is withdrawn more than two months before expiry of the confidentiality period, it will not be opened to public inspection (subsection 10(5) of the *Patent Act* and sections 92 and 146 of the *Patent Rules*). Where an application is withdrawn during the last two months of the confidentiality period, the application will be laid open to public inspection unless there is sufficient time to stop the technical preparations to open the application to public inspection. A request for withdrawal must be in writing. Any fee which has been paid prior to the date of withdrawal is not refundable except under subsections 4(3) and (4) of the *Patent Rules*. An application which is withdrawn after being opened to public inspection, will remain in the search files of the Patent Office.

20.07 Abandonment

An application is deemed to be abandoned under section 73 of the *Patent Act* if the applicant does not

- (a) reply in good faith to any requisition of an examiner within the time limit specified;
- (b) complete the application and pay the completion fee within the time limit specified;
- (c) pay the prescribed maintenance fees within the time limit specified;
- (d) make a request for examination and pay the prescribed fee within the time limit specified;

- (e) make a request for examination and pay the prescribed fee, when required to do so by the Commissioner, within the time limit specified;
- (f) pay the final fee within the time limit specified; or
- (g) comply with any requisition of the Commissioner within the time limit specified (section 25 of the *Patent Rules*).

The time limits (or extended time limits) specified for the above actions are given in Section 20.02 of this manual.

An application may become abandoned for more than one failure to act as above (e.g. an application may become abandoned for failure to respond to an examiner's requisition and also be deemed abandoned for failure to pay a maintenance fee at a later date during the abandoned period for failure to respond to the examiner's requisition).

A notice of abandonment will normally be sent by the Office when an application is deemed abandoned. However, although a notice of abandonment (notice that the patent is about to lapse) has been sent in a particular case, it should not be assumed that notice will be sent in every case. Such notices are sent as a courtesy only and the Patent Office takes no responsibility for failure to send a notice in a particular situation. If an application is abandoned for more than one failure to act, additional notices will be sent for each failure during the time period within which the applicant can reinstate the application.

20.08 Reinstatement

Where an application becomes abandoned under subsection 73(1) or (2) of the *Patent Act*, the applicant may reinstate the application according to section 73(3) of the *Patent Act* and section 98 or 152 of the *Patent Rules* within twelve months of the date the application was deemed abandoned by;

- i) making a request for reinstatement,
- ii) taking the action that should have been taken in order to avoid the

- abandonment, and
- iii) paying the fee set out in Item 7, Part I of Schedule II of the *Patent Rules*.

Where an application is abandoned for more than one failure to act, the applicant must take the above actions for each failure to act within twelve months of each failure (sections 98 and 152 of the *Patent Rules*).

For example, an application may become abandoned on two grounds if applicant fails to respond to an examiner's requisition within the six month time limit and also fails to pay a maintenance fee that falls due during the time when the application was abandoned; for that the application to be reinstated, the applicant must request reinstatement, respond to the examiner's requisition, submit the maintenance fee and submit two reinstatement fees within twelve months of the abandonment for failing to respond to the examiner's requisition. If the applicant attempts to reinstate without paying the maintenance fee and the second reinstatement fee, the application will remain abandoned (for failure to pay the maintenance fee) but the time limit for reinstatement will be extended to the end of the twelve-month period from the date the maintenance fee was due. If the period for reinstatement has expired before payment of the reinstatement fee or before a request for an extension of the reinstatement period is made, the application can never be reinstated.

20.09 Lapsed patent

A lapsed patent is one which no longer confers any patent rights to the patentee because the appropriate maintenance fees have not been paid.

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 (sections 100, 101, 155, and 156 of the *Patent Rules* and Item 31, Part VI of Schedule II of the *Patent Rules*).

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.

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

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. The time limits for payment of maintenance fees for patents cannot be extended (sections 102 and 157 of the *Patent Rules*).

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. Section 182 of the *Patent Rules* and Item 32, Part VI of Schedule II of the *Patent Rules* specify the maintenance fees payable and the dates on which the payments are due. Payments are due before the first day of the one-year period the fee covers, or on or before the last day of the one-year period the fee covers if the late payment fee is also paid.

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 specified in Part VI of Schedule II of the *Patent Rules* cannot be extended (section 182(7) of the *Patent Rules*).

A patent is deemed to have lapsed at the expiration of the time specified in Schedule II of the *Patent Rules* (subsection 46(2) of the *Patent Act*). **A lapsed patent cannot be revived.**

Notification of lapsed patents will be published in the Canadian Patent Office Record.

20.10 Jurisprudence

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

lapse

Zeneca v Canada

66 CPR (3d) 169 1996