

## **Chapter 3**

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## **Chapter 3**

### **Inquiries and information on pending applications**

#### **3.01 Inquiries by applicants**

On occasion applicants, authorized correspondence or persons authorized by an applicant or authorized correspondent may wish to inquire about the status of their applications or ask when they will be acted upon. The procedure for handling such inquiries is outlined below.

##### **3.01.01 Status inquiries**

While applicants may inquire by letter about the status of their application, such inquiries should be kept to a minimum. The letter asking for status information should be restricted to the matter of status and not cover other subjects, since it will be stamped to indicate status only and returned to the applicant. If no examination has been requested on the application, the letter is stamped: "EXAMINATION NOT YET REQUESTED". If examination has been requested and the examination process has been started, the letter is either stamped: "UNDER EXAMINATION - NO OUTSTANDING ACTION - APPLICATION IN GOOD STANDING" or "UNDER EXAMINATION - THERE IS AN OUTSTANDING ACTION ON THIS APPLICATION - SEE ( ) MAILED ( )". The letter is initialled by the clerical staff.

When an inquiry is made by an inventor not represented by a patent agent, the Patent Office does not return the inquiry letter but writes to the inventor, explaining the status of the application.

When it is found that an application is not in good standing (i.e. it is abandoned), the applicant is advised of its present status by letter, and the reason for its abandonment. For example, the applicant will be told that it is abandoned for "failure to reply to the report of...". A letter would also be sent under other special circumstances, for example, if the application is before the courts.

Information about the status of unopened applications is given only to the authorized correspondent for the application, to the applicant or to a person authorized by the

authorized correspondent or the applicant to receive the information.

### **3.01.02 Action inquiries**

Applicants may ask by letter when the next examiner's action may be expected. Normally the applicant's letter will be returned after it has been stamped with the information: "THE EXAMINER EXPECTS TO REACH THIS APPLICATION IN ABOUT ( ) MONTHS". The blank space is filled in by the examiner. In those instances where examination has not yet been requested the applicant will be so informed.

### **3.02 Inquiries on pending applications (Section 11 of the *Patent Act*)**

Under section 11 of the *Patent Act* information may be given to inquirers as to whether there is filed and pending in Canada an application, opened or unopened, that corresponds in subject matter and is related to a foreign patent by common inventors or applicants. No information is released about Canadian applications of different inventors/applicants directed to the same subject matter, nor is any search made to locate corresponding Canadian patents of the same inventors. However, information is supplied when there is at least one inventor or applicant common to both the foreign patent and a Canadian application.

Since the claims in a pending application may be changed at any time prior to issue, an affirmative reply is given to an inquiry under section 11 when there is a corresponding Canadian application disclosing but not necessarily claiming the invention in the foreign patent. The Patent Office looks to the description of the application, as it stands at the time of the inquiry. Matter which may have been deleted from the description is not considered.

Requests under section 11 must be made in writing and accompanied by the fee prescribed in Schedule II item 23 of the *Patent Rules*.

#### **3.02.01 Searches based on foreign patents only**

When an inquirer only makes reference to a foreign patent application or other specification that is not a patent, a search is not carried out under section 11 of the

*Patent Act*. Only foreign patents (including petty patents, utility models and inventors' certificates) may form the basis of an inquiry under section 11. "Design patents" are not included. Therefore, a requester should make certain that a document presented for section 11 search is in fact an issued patent.

### **3.02.02 How the search is conducted**

Normally, an inquirer provides the Patent Office with the number of the foreign patent which includes the name of the inventor and/or the name of the applicant. A search is then made of all Canadian applications filed by the same inventor or by the same applicant.

Failure to indicate the name of the inventor reduces the likelihood of locating a corresponding application. The search covers all pending applications, including allowed applications and applications abandoned for less than 12 months. It also includes reissue applications. Applications filed abroad under the Patent Cooperation Treaty (PCT) and designating Canada will not be included in the search unless they have entered the national phase in Canada. A PCT application designating Canada can enter the national phase in Canada up to 42 months after its international filing date or its priority date, if any (subparagraph 58(3)(b)(ii) of the *Patent Rules*). In assessing pending Canadian applications, the examiner compares the invention claimed in the foreign patent with what could be claimed in the Canadian application. Thus, where the substance of the foreign patent is disclosed in the application as prior art, the pending application is not considered as being a corresponding application. Nor is a Canadian application considered to correspond to a foreign patent when the latter is a selection or improvement of the invention in the application.

Where the Canadian application discloses at least all of the invention of the patent and disclaims none of the subject matter, even tacitly, then the application is considered to correspond to the foreign patent and the inquirer is advised that an application for the same invention is pending in Canada. When the Canadian application discloses only part of the invention of the foreign patent (although other matter may also be described) the inquirer is advised that there is pending an application for part of the same invention but no further details may be supplied. Otherwise, the applicant is advised that a search of the records has failed to reveal a copending application in the name of the inventor (or applicant) that corresponds in subject matter to the identified foreign patent.