

2002, September

PATENT LAW TREATY
CHANGES REQUIRED TO CANADIAN LAW & PRACTICE

Prepared for the Canadian Intellectual Property Office (CIPO)
by Alan Troicuk, Counsel to CIPO, Department of Justice

CONTENTS

ARTICLE 5 & RULE 2 (FILING DATE).....	1
ARTICLE 6 & RULES 3, 4 & 6 (APPLICATION).....	4
ARTICLE 7 AND RULE 7 (REPRESENTATION).....	8
ARTICLE 8 AND RULES 8, 9 & 10 (COMMUNICATIONS; ADDRESSES).....	9
ARTICLE 10 (VALIDITY OF PATENT; REVOCATION).....	10
ARTICLE 11 AND RULE 12 (RELIEF IN RESPECT OF TIME LIMITS).....	10
ARTICLE 12 AND RULE 13 (REINSTATEMENT OF RIGHTS).....	11
ARTICLE 13 AND RULE 14 (PRIORITY).....	11
RULE 15 (RECORDATION OF CHANGE IN NAME).....	12
RULE 16 (RECORDATION OF CHANGE IN APPLICANT OR OWNER).....	12
RULE 18 (CORRECTION OF A MISTAKE).....	12
RULE 19 (IDENTIFICATION OF APPLICATION WITHOUT NUMBER).....	13

The following analysis seeks to identify the changes that will be required to be made to Canadian law and practice in order for Canada to comply with the Patent Law Treaty. Headings for PLT Articles and Rules are included below only where requirements for change have been identified.

The following abbreviations are used throughout this document: CPA for Canadian Patent Act; CPR for Canadian Patent Rules; CPO for Canadian Patent Office; PCT for Patent Cooperation Treaty and PLT for Patent Law Treaty.

ARTICLE 5 & RULE 2 (FILING DATE)

Indication that patent sought

The filing date requirement in s.93(a) CPR [i.e. "an indication in English or French that the granting of a Canadian patent is sought"] must be changed to conform to the requirement set out in PLT A.5(1)(a)(i) [i.e. "an express or implicit indication to the effect that the elements are intended to be an application"]. PLT A.1(ii) defines "application" to mean "an application for the grant of a patent, as referred to in Article 3". PLT A.5(2)(a) would permit Canada to require the PLT A.5(1)(a)(i) indication to be in English or French.

Name and address

The filing date requirements in s.93(b) and (c) CPR [i.e. "the name of the applicant" and "the address of the applicant or of a patent agent"] must be changed to conform to the requirement set out in PLT A.5(1)(a)(ii) [i.e. "indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office"]. Some flexibility in implementing the PLT A.5(1)(a)(ii) requirement is given in PLT A. 5(1)(c) which provides: "For the purposes of the filing date, a Contracting Party may require both information allowing the identity of the applicant to be established and information allowing the applicant to be contacted by the Office, or it may accept evidence allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office, as the element referred to in subparagraph (a)(ii)." PLT A.5(2)(a) would permit Canada to require the PLT A.5(1)(a)(ii) indication to be in English or French.

Description

The filing date requirement in s.93(d) CPR [i.e. "a document, in English or French, that on its face appears to be a description of an invention"] must be changed to conform to the requirement set out in PLT A.5(1)(a)(iii) [i.e. "a part which on the face of it appears to be a description"]. PLT A.5(1)(b) provides that a "Contracting Party may, for the purposes of the filing date, accept a drawing as the element referred to in subparagraph (a)(iii)". In accordance with PLT A.5(2)(b), the "part referred to in paragraph (1)(a)(iii) may, for the purposes of the filing date, be filed in any language".

Fee

The filing date requirement in s.93(e) CPR [i.e. "the application fee set out in item 1 of Schedule II"] must be deleted since PLT A.5(1) does not permit fees to be a filing date requirement. The reference to "fees" in s.28(1) CPA, and s.28(2) CPA in its entirety, should also be deleted. In accordance with PLT A.6(4),(7)&(8) Canada will be able to require, where the filing fee has not been paid at the time of filing, that the fee be paid within a specified time thereafter failing which the application could be considered to be abandoned (but the filing date would be maintained). PLT A.12 would require any such abandoned application to be subject

to reinstatement under certain conditions. The PLT leaves Contracting Parties free to establish the amount of any fees to be paid and Canada could thus require a penalty fee to be paid whenever a filing fee is paid subsequent to the filing date.

The PLT provides two options that Canada could follow in setting time limits for the payment of filing fees:

i) in accordance with PLT A.6(7)&(8) and R.6(1), Canada could, at any time after filing, send a notification requiring the applicant to pay the filing fee (together with any penalty fee) within not less than two months from the date of the notification (If notification is not possible because indications allowing the applicant to be contacted by the office have not been filed, PLT Rule 6(2) provides for a time limit of not less than three months from the initial filing.); and

ii) in accordance with PLT A.6(4) and R.6(3), Canada could specify that the initial time limit for payment of the filing fee was one month after the filing of the application and then, at any time after the expiration of that one month period, send a notification requiring the applicant to pay the filing fee (together with any penalty fee) within one month from the date of the notification.

Non-compliance with minimum filing date requirements

PLT A.5(3)&(4) will require the CPO to notify any applicant whose application does not comply with the minimum filing date requirements and to give the applicant at least two months from the date of the notification to comply and obtain a filing date without any need to re-file and pay new fees. The filing date would be the date on which the last required element for a filing date was received. Although the CPA and CPR do not currently require the CPO to act in this way, the CPO does comply as a matter of practice and this would be sufficient for Canada to be in compliance with these PLT obligations. Consideration could, however, be given to amending the CPR to make such a procedure mandatory.

Missing part of description of drawing

PLT A.5(5) obliges an office, where it, in establishing the filing date, finds that a part of the description or a referenced drawing appears to be missing, to promptly notify the applicant. This provision does not require an office, in establishing the filing date, to make a check of whether a part of the description or a drawing is missing. As a matter of practice, the CPO already complies with the notification requirement under PLT A.5(5). The CPR could be amended to make such notification mandatory but this is unnecessary.

PLT A.5(6) sets out mandatory rules to be followed in establishing the filing date when a missing part of the description or drawing is filed. This will require amendment of s.93 CPR and probably also s.28(1) CPA.

For the purposes of PLT A.5(6)(a), Canada will have to establish a time limit for filing a missing part of the description or drawing which in view of PLT R. 2(3) must be at least two months from notification or, if no notification, two months from the date on which any element of the application was filed. If a missing part of the description or drawing is filed during this period, it appears that it must not be treated according to the usual amendment rules (i.e. accepted if no new matter) but rather in accordance with paragraphs (a), (b) and (c) of PLT A.5(6). Paragraph (a) states that, subject to paragraphs (b) and (c), the filing date shall be the later of the date on which

the missing part of the description or drawing is received and the date on which all filing date requirements are satisfied. Paragraph (b) provides that (subject to certain conditions that a contracting party may impose as discussed below in the following paragraph) the missing part of the description or drawing must be included in the application without loss of filing date if the missing part or drawing is contained in a priority document and priority based on that document was claimed at the earliest date on which any element of the application was filed. Paragraph (c) permits an applicant to withdraw a later filed missing part of the description or missing drawing in order to avoid the date of receipt of that part or that drawing being accorded as the filing date under subparagraph (a).

Although PLT A.5(6)(b) is mandatory in requiring contracting parties to establish a regime allowing a missing part of the description or drawing to be included without loss of filing date where they are contained in a priority document, that paragraph and PLT R.2(4) allow contracting parties, at their option, to make this subject to a number of requirements and Canada will thus need to decide which if any of these it wishes to impose. PLT R.2(4) provides:

"Any Contracting Party may, subject to Rule 4(3), require that, for the filing date to be determined under Article 5(6)(b):

- (i) a copy of the earlier application be filed within the time limit applicable under paragraph (3);
- (ii) a copy of the earlier application, and the date of filing of the earlier application, certified as correct by the Office with which the earlier application was filed, be filed upon invitation by the Office, within a time limit which shall be not less than four months from the date of that invitation, or the time limit applicable under Rule 4(1), whichever expires earlier;
- (iii) where the earlier application is not in a language accepted by the Office, a translation of the earlier application be filed within the time limit applicable under paragraph (3);
- (iv) the missing part of the description or missing drawing be completely contained in the earlier application;
- (v) the application, at the date on which one or more elements referred to in Article 5(1)(a) were first received by the Office, contained an indication that the contents of the earlier application were incorporated by reference in the application;
- (vi) an indication be filed within the time limit applicable under paragraph (3) as to where, in the earlier application or in the translation referred to in item (iii), the missing part of the description or the missing drawing is contained."

Although technically, as noted above, it would not appear that the normal amendment procedure can be applied when a missing part of the description or drawing containing no new matter is filed within the time limit established under PLT A.5(6)(a), in practice the same effective result could be obtained if the office advised an applicant filing a missing part or drawing within that period that it has two choices: 1) accept the date of filing of the missing part or description as being the filing date (as long as all other filing date requirements have been satisfied and unless PLT A.5(6)(b) applies); or 2) withdraw the missing part or drawing, as allowed under PLT A.5(6)(c) and resubmit the missing part or description after the time limit as part of a voluntary amendment. Because of the complicated nature of PLT A.5(6) and its interface with the amendment procedure, it would appear desirable for Canada to prescribe as the time limit for PLT A.5(6)(a) the shortest time limit permitted by PLT R.2(3).

Reference filings

S.28 CPA will require amendment to accommodate the requirement in PLT A.5(7)(a) that contracting parties accept, at the time of filing, the replacement of the description and any drawings

in an application by a reference to a previously filed application subject to compliance with the requirements of PLT R.2(5). PLT R.2(5)(a) requires the reference to indicate that, for the purposes of the filing date, the description and any drawings are replaced by the reference to the previously filed application and that the reference also indicate the number of that application and the office with which that application was filed. A contracting party, if it wishes, may also require that the reference indicate the filing date of the previously filed application. PLT R.2(5)(b) permits a contracting party to require a copy, or a certified copy, or where appropriate, a translation of the previously filed application. PLT R.2(5)(c) permits a contracting party to permit references to be made only to a previously filed application that had been filed by the applicant or his predecessor or successor in title.

Amendment procedures

The implementation of PLT A.5(6) and (7), relating to the handling of missing parts of the description or drawings and to reference filings, may require consequential amendments to s.38.2(2) and (3) CPA e.g. to allow amendments to be based on missing parts that are contained in a priority application and that are submitted in accordance with PLT A.5(6)(b).

Provisional protection

As a result of changes to Canadian law required by various PLT provisions (such as the requirement to accept foreign language documents for filing date purposes; the requirement to accept reference filings; the requirement to provide restoration of the priority right; and the requirement to provide for reinstatement of rights for missed time limits), there may be rare cases where an application consisting only of a foreign language specification or a reference number becomes open to public inspection under s.10 CPA. As a result, it may be desirable to amend s.55(2) CPA to provide that liability to pay reasonable compensation begins only after an English or French copy of the specification becomes open to public inspection under s.10 CPA.

ARTICLE 6 & RULES 3, 4 & 6 (APPLICATION)

Evidence of entitlement to file application

S.37 CPR requires amendment to comply with PCT R.51*bis*.2(a)(ii) which is incorporated into the PLT by PLT A.6(1) and which prohibits an office, unless it may reasonably doubt the veracity of the indications or declaration concerned, from requiring any document or evidence relating to the applicant's entitlement to apply for and be granted a patent, if a declaration as to that matter, in accordance with PCT R.4.17(ii), has been submitted.

Priority claims

S.28.4(2) CPA; ss.88(1)(b) and (c)(ii) CPR and Item 4 of Form 3 of Schedule I CPR are inconsistent with PLT Article 6(1) insofar as they make informing the Commissioner of the **number** of the previously regularly filed application a mandatory requirement for making a valid request for priority. PLT A.6(1) makes applicable the restriction set out in PCT R.26*bis* that "a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application ... is missing".

In accordance with PCT R.4.10(a)(iv) and (v) and 4.10(b) which are incorporated by PLT A.6(1), ss.88(3) and (4) CPR need to be amended to be applicable to both PCT and non-PCT filed applications.

S.89 CPR is potentially inconsistent with PLT Rule 4(1) in that it does not place any time restriction on when an examiner may requisition an applicant to file a certified copy of a previously filed application. PLT Rule 4(1) specifies that a copy may be required "within a time limit which shall not be less than 16 months from the filing date of that earlier application or, where there is more than one such earlier application, from the earliest filing date of those earlier applications". This limitation on when a copy can be required could be implemented administratively or a specific limitation could be added to s.89 CPR.

S.89 CPR is potentially inconsistent with PLT Rule 4(3) which would prohibit the CPO from requiring a copy of a priority document if the priority document had been filed with the CPO or if the priority document was available to the CPO from a digital library which was accepted by the CPO for that purpose [WIPO is currently planning the creation of such a digital library for priority documents]. These limitations on when a copy can be required could be implemented administratively or specific limitations could be added to s.89 CPR.

Models and specimens

S.38 CPA, which authorizes the Commissioner to require models and specimens, is not consistent with PLT A.6(1).

Petition

S.27(2) CPA requires an application to contain a petition and s.77 CPR requires the petition to "follow the form and the instructions for its completion set out in Form 3 of Schedule I to the extent that the provisions of the form and the instructions are applicable." These provisions will require amendment in order to comply with PLT A.6(2) and R.3(2).

PLT A.6(2)(a) limits the contents of an application that can be required to be presented on a request form to: 1) contents that correspond to the contents of a PCT request form; 2) contents that can be required in the national phase for a PCT application; and 3) some limited additional contents that are prescribed pursuant to PLT A.6(1)(iii) including notably certain specified indications where the application wishes the application to be treated as a divisional application. PLT A.6(2)(b) obliges a contracting party to accept the presentation of the required contents on a request form, as prescribed in Rule 3(2). PLT R.20(2) provides, once the PLT enters into force, for the PCT Assembly to establish modifications of the PCT request form referred to in PLT 3(2)(i); until such modifications have been established, there will be some uncertainty as to the changes that will be required to Form 3 of Schedule I CPR.

i) Paragraph 1 of Form 3 of Schedule I CPR reads:

"1. The applicant, _____, whose complete address is _____, requests the grant of a patent for an invention, entitled _____, which is described and claimed in the accompanying specification."

Although Canada will not be able to require that the same wording be used, it will be able to require that the request form contain the applicant's name and address and a title, since these are optional or mandatory contents of a PCT request form [PCT R.4.1(a)(ii), 4.1(a)(iii) and 4.5]. Requiring a "request for the grant of a patent" appears equivalent to the "indication to the effect that

the applicant wishes the application to be treated as a national or regional application" as may be required under PLT Rules 3(2)(ii) and (iii); presumably this indication will be included in the modifications referred to in PLT Rule 3(2)(i). The requirement in paragraph 1 of Form 3 CPR to include the words "which is described and claimed in the accompanying specification" does not appear consistent with PLT A.6(2) and R. 3(2).

ii) Paragraph 2 of Form 3 of Schedule I CPR reads:

"2. This application is a division of application number _____, filed in Canada on _____."

The substance of this requirement is permitted in accordance with PLT A.6(1)(iii), A.6(2)(a) and R.3(1)(b). As to presentation requirements, what could be required to be included in the request form would appear to be dependent upon what modifications the PLT Assembly decides to establish under PLT R.20(2) for the purposes of PLT R.3(2)(i) and on whether the current PCT request form is (as has been proposed) modified to permit an applicant to indicate that the application is to be treated as a divisional application. Paragraph R3.02 of the PLT Explanatory Notes states that the modifications established by the Assembly under Rule 20(2) could include "the addition of the indications for a request that the application be treated as a divisional application". It is not clear how PLT R.3(2)(ii) and (iii) would currently apply to divisional applications since the current PCT request form does not include any provision for divisional applications.

iii) Paragraph 3 of Form 3 of Schedule I CPR reads:

"3.(1) The applicant is the sole inventor.
(2) The inventor is _____, whose complete address is _____, and the applicant owns in Canada the whole interest in the invention."

The Instructions to Form 3 state: "The applicant shall include in the petition either subsection 3(1) or (2)."

Although Canada will not be able to require that the same wording be used, it will be able to require that the substance be included in the request form. In particular, Canada will be able to require that the request form contain: 1) the inventor's name and address, since these are optional or mandatory contents of a PCT request form [PCT R.4.6, 4.17(i) or 4.17(ii)], and 2) a declaration as to the applicant's entitlement to apply for and be granted a patent, since this is part of the optional contents of the PCT request form [PCT R.4.17(ii)].

iv) Paragraph 4 of Form 3 of Schedule I CPR reads:

"4. The applicant requests priority in respect of the application on the basis of the following previously regularly filed application:

Country of filing	Application number	Filing date
_____	_____	_____
_____	_____	_____

The Instructions to Form 3 state: "Requests for priority may be done in section 4 of the petition or in a separate document."

In view of the Instructions to Form 3, inclusion of priority information in the petition is optional and there is therefore no issue of consistency with PLT A.6(2). There would not appear to be any reason to require priority information to be included in the request form; for the sake of completeness it is nevertheless pointed out that, if it wished, Canada would, consistent with PLT A.6(2)(a), be able to require that the request form contain the details of any priority claim, since these are contents of a PCT request form [PCT R.4.10]. As discussed above under the heading "Priority claims", the inclusion of the priority number cannot however be made a mandatory requirement. In view of PLT A.13, it would not be possible to require a priority claim to be made at the time of filing but it would be possible to require an amended request form to be filed where a priority claim was made after the filing date.

v) Paragraph 5 of Form 3 of Schedule I CPR reads:

"5. The applicant appoints _____, whose complete address in Canada is _____, as the applicant's representative in Canada, pursuant to section 29 of the Patent Act."

S.78 CPR provides: "For the purposes of section 29 of the Act, an appointment of a representative in Canada shall be included in the petition in accordance with item 5 of Form 3 of Schedule I or in a separate document."

The Instructions to Form 3 state: "In section ... 5 ..., appointment of representatives ... may also be done in a separate document."

In view of s.78 CPR and the Instructions to Form 3, inclusion of an appointment of representative in the petition is optional. Since PLT A.6(2) only places limitations on what can be required to be included in request Forms and not on what can be included at the option of the applicant, paragraph 5 of Form 3 is consistent with PLT A.6(2). [Amendments to s.29 CPA will however be required for compliance with PLT A.8(6) and R.10(4) and those amendment requirements are discussed below under the heading "Representative for service".]

vi) Paragraph 6 of Form 3 of Schedule I CPR reads:

"6. The applicant appoints _____, whose complete address is _____, as the applicant's patent agent."

The Instructions to Form 3 state: "In section ... 6 ..., appointment of patent agents ... may also be done in a separate document."

In view of s.78 CPR and the Instructions to Form 3, inclusion of an appointment of patent agent in the petition is optional and there is therefore no issue of consistency with PLT A.6(2). Canada could however, if it wished, require, in accordance with PLT A.6(2), any appointment of agent, including an indication of the agents name and address, to be made in the request since these are contents of a PCT request form [PCT R.4.7].

vi) Paragraph 7 of Form 3 of Schedule I CPR reads:

"7. The applicant believes that the applicant is entitled to claim status as a "small entity" as defined under section 2 of the Patent Rules."

Paragraph 7 will need to be deleted as a requirement (in those situations where it applies) for inclusion in Form 3. The contents of paragraph 7 do not correspond to the contents of the PCT request form and PLT A.6(2)(a) therefore precludes a requirement that they be presented on a request form.

vii) Paragraph 8 of Form 3 of Schedule I CPR reads:

"The applicant requests that Figure No. _____ of the drawings accompany the abstract when it is open to public inspection under section 10 of the Patent Act or published."

The contents of paragraph 8 do not correspond to the contents of the PCT request form and PLT A.6(2)(a) therefore precludes a requirement that they be presented on a request form. In substance, paragraph 8 is clearly intended to be an optional element for inclusion in the petition at the option of the applicant and it would therefore be consistent with PLT A.6(2) to maintain this paragraph (although it may be desirable to amend the Rules of the Instructions to clarify the optional nature of this paragraph).

Non-compliance with requirements relating to form or contents

PLT Article 6(7) & (8) and Rule 6(2) & (3) provide that, in respect of the non-compliance with a requirement relating to form or contents of an application, a contracting party may, with one exception, only apply a sanction after the expiry of a period of at least two months from the date of notification. The one exception applies in cases where notification is not possible because indications allowing the applicant to be contacted have not been filed, in which case a sanction can be applied without notification at any time after three months from the date on which one or more elements referred to in PLT Article 5(1)(a) were first received by the Office (i.e. meaning in most situations other than with respect to divisional applications, at any time after three months from the filing date). Under the CPA and CPR, no sanctions are applied because of the non-compliance with any requirement relating to form or contents of an application until after a requisition requesting compliance has been sent either by the Patent Office operations (e.g. formalities) section in the name of the Commissioner or by a patent examiner. In accordance with s.25 CPR, requisitions sent by the operations section have a time limit for reply of three months from the date of the requisition, which would thus be fully compliant with PLT Article 6(7) & (8). In accordance with s.73(1)(a) CPA, requisitions sent by an examiner must be replied to within a time limit of six months after the requisition is made or within any shorter period established by the Commissioner; these time limits would be consistent with PLT Article 6(7) & (8) as long as the Commissioner did not establish a period shorter than two months. Although current practice is to never establish a period of less than three months to reply to an examiner's requisition (and maintaining such a practice would be sufficient for compliance with the PLT) consideration might still however be given to amending s.73(1)(a) to prohibit the Commissioner from establishing a time limit of less than two months in order to ensure that PLT requirements are always met in the future.

ARTICLE 7 AND RULE 7 (REPRESENTATION)

To comply with PLT A.7(2)(b), s.6 CPR will require amendment to permit maintenance fees to be paid by any person. With respect to fees other than maintenance fees, s.6 CPR will also have to be amended to comply with PLT A.7(2)(ii) but Canada could choose between one of the following two options: 1) permit the fee to be paid by any person; or 2) require the fee to be paid, at the choice of the applicant, by either the applicant or the applicant's representative.

ARTICLE 8 AND RULES 8, 9 and 10 (COMMUNICATIONS; ADDRESSES)

Electronic filing

PLT Rule 8(2)(a) will (under certain conditions that are likely to apply in the future) require the CPO to accept the electronic filing of communications in accordance with the PCT electronic filing requirements prescribed under PCT Rules 89*bis* and 92.4. This will require changes to current CPO practice.

Model International Forms

PLT A.8(3) will require the CPO to accept communications filed on the Model International Forms which PLT Rule 20(1) will require the PLT Assembly to establish in respect of: (i) a power of attorney; (ii) a request for recordation of change in name or address; (iii) a request for recordation of change in applicant or owner; (iv) a certificate of transfer; (v) a request for recordation, or cancellation of recordation, of a license; (vi) a request for recordation, or cancellation of recordation, of a security interest; (vii) a request for correction of a mistake. PLT A.8(3) by itself would not appear likely to require any changes to the CPA or CPR; however, the work of the PLT Assembly in establishing the Model International Forms will need to be monitored to see whether the forms that are ultimately established will require any changes.

Signatures

Under the CPA and CPR, signatures are only required in a few situations (i.e. for assignments under ss.49 and 50 CPA and for the statements and notices referred to in ss.16, 20 and 21 CPR). For those situations, PLT Rule 9(5)(b) will (under certain conditions that are likely to apply in the future) require the acceptance of signatures in electronic form that comply with PCT requirements for signatures in electronic form.

PLT A.8(4)(b) and Rule 9(6) provide that no contracting party may require the attestation, notarization, authentication, legalization or other certification of any signature which is communicated to its office, except in respect of any quasi-judicial proceedings or to confirm certain signatures in electronic form. This will require modification, and perhaps deletion of, ss.49(3) and 50(3) CPA.

Indications in communications

The requirement in s.7(c) CPR that communications addressed to the Commissioner in relation to an application must include the title of the invention is not consistent with PLT A.8(5) and R.10(1).

Representative for service

PLT Rule 10(4) will require s.29 CPA to be amended so that, where an agent has been appointed and in the absence of a contrary indication from the applicant, the agent's address be considered to be the address required for the purposes of s.29 CPA. Apart from this difficulty, it would appear that the requirement in s.29 CPA to "appoint as a representative a person or firm residing or carrying on business at a specified address in Canada" can be justified as being in substance a requirement for an address of the type that can be required in accordance with PLT A.6(1), by reason of its incorporation of PCT A.27(7), and in accordance with PLT A.8(6) and

R.10(2). Nevertheless, it may be preferable to overhaul s.29 CPA to match more closely what is explicitly permitted under the PLT and PCT.

ARTICLE 10 (VALIDITY OF PATENT; REVOCATION)

PLT A.10(1) notably prohibits, in the absence of fraud, the invalidation of a patent on the basis of the non-payment of a fee in the application stage. This will require changes to the CPA particularly having regard to the decision of the Federal Court Trial Division in *Dutch Industries Ltd. v. Commissioner of Patents et al.* (2001), 14 C.P.R.(4th) 499. It would probably be desirable to include the substance of PLT A.10(1) in its entirety directly in the CPA, both to cover the non-payment of fees situation and also to avoid any doubt with respect to non-compliance with any of the other formal requirements referred to in PLT A.10(1).

ARTICLE 11 AND RULE 12 (RELIEF IN RESPECT OF TIME LIMITS)

PLT Article 11 only applies to time limits fixed by the Office and does not apply to time limits set by statute or regulation. The term "Office" is defined in PLT A.1(i) as meaning "the authority of a Contracting Party entrusted with the granting of patents or other matters covered by this Treaty", which under the Canadian Patent Act is the Commissioner of Patents. In the Canadian context, the only time limit that would appear to be affected is the time limit under s.73(1)(a) CPA for responding to a requisition by an examiner when the Commissioner has established a period shorter than six months for reply. When the Commissioner does not exercise his discretion to establish a shorter period under s.73(1)(a) CPA, the default six month period for reply would not appear to be a time limit set by the Office and thus would not be covered by PLT A.11.

The relief currently available under the CPA and CPR for missed shorter time limits established by the Commissioner under s.73(1)(a) CPA does not comply with PLT A.11 and R.12. The following are three options for amending the CPA and/or CPR in order to comply:

- (i) Amend s.73(1)(a) to remove the discretion of the Commissioner to set a shorter period for reply. S.73(1)(a) could then either itself specify a fixed period or provide for this period to be prescribed by regulation.
- (ii) Amend s.12(1)(j.8) CPA and the CPR to provide, upon request in respect of missed shorter time limits set by the Commissioner under s.73(1)(a) CPA, for an automatic retroactive extension of time of at least two months [in accordance with PLT A.11(1)(ii) and R.12(1) and (2)].
- (iii) Amend s.98 CPR to provide that in the case of an abandonment due to a failure to reply within a shorter period established under s.73(1)(a) CPA, the time period for reinstating shall not expire until at least two months after the Office has **notified** the applicant of its failure to timely reply [in accordance with PLT A.11(2)(ii) and R.12(4)].

Options (ii) and (iii) above may not be desirable in that they would appear to necessitate the establishment of relatively complex legal and operational procedures. Option (i) may also be considered undesirable if the period for reply was to be fixed at six months for all cases. One approach that might be considered and that would be consistent with the PLT would be to fix

a standard four months for reply subject to the possibility of a single two-month extension of time being granted where the Commissioner was satisfied that the circumstances justify the extension. Such an approach would also ensure compliance with PLT A.6(7) and (8) in accordance with which, as discussed above in relation to PLT A.6, it would not be possible to set a time limit of less than two months from the date of a requisition to comply with a form or contents requirement.

ARTICLE 12 AND RULE 13 (REINSTATEMENT OF RIGHTS)

PLT A.12 and R.13 will require changes to the current Canadian time limits for remedying missed maintenance fee payments. Current Canadian law in substance permits missed maintenance fee payments for both applications and patents to be remedied within a period of twelve months after the missed due date: i) for missed maintenance fee payments in respect of an application, s.98 CPR permits a request for reinstatement to be made before the expiry of the twelve-month period after the missed due date; ii) for missed maintenance fee payments in respect of a patent, Items 31 and 32 permit a missed payment to be made, together with an additional fee for late payment, within a period of grace of one year following the missed due date. In accordance with PLT R.13(2), the time limit for remedying a missed maintenance fee payment must be "the earlier to expire of the following: (i) not less than two months from the date of the removal of the cause of the failure to comply with the time limit for the action in question; (ii) ... not less than 12 months from the date of expiration of the period of grace provided under Article 5*bis* of the Paris Convention."

ARTICLE 13 AND RULE 14 (PRIORITY)

Delayed filing of the subsequent application

PLT A.13(2) and R.14(4)(a) will require the CPA to be amended to provide for the restoration of the priority right where a subsequent application is filed within two months after the expiration of the priority period and the failure to file in time occurred in spite of due care required by the circumstances having been taken or, at the option of Canada, was unintentional.

Failure to timely file copy of priority application

As explained in Note 13.09 of the Explanatory Notes on the Patent Law Treaty and Regulations, PLT A.13(3) "provides a remedy for the applicant where a right of priority is lost because of the failure, on the part of the Office with which the earlier application was filed to provide a copy of that application in time, to comply with the time limit applicable under Article 6(5), despite a timely request for that copy having been made." In practice, this remedy is very unlikely to ever be required in Canada since, in accordance with s.89 CPR, copies of priority applications are only required in very limited circumstances and only at the examination stage. However, to ensure full compliance with the PLT, it would appear preferable to amend the CPA and/or CPR to include such a remedy.

RULE 15 (RECORDATION OF CHANGE IN NAME)

S.39 CPR will require amendment to comply with PLT R.15(4) which, with respect to requests for the recordal of a change in the name of the owner of a patent or an application, states that a "Contracting Party may require that evidence be filed with the Office only where the Office may reasonably doubt the veracity of any indication contained in the request".

RULE 16 (RECORDATION OF CHANGE IN APPLICANT OR OWNER)

Ss.49 and 50 CPA and s.38 CPR will require amendment to comply with the simplified permissible requirements set out in PLT R.16 for requesting the recordal of assignments. PLT R.16(2)(a) notably, where the change in applicant or owner results from a contract, limits the documentation that an office can require to, at the option of the requesting party, one of the following [As per PLT R.16(5), further evidence may only be required where the office may reasonably doubt the veracity of an indication]:

"(i) a copy of the contract, which copy may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being in conformity with the original contract;

(ii) an extract of the contract showing the change, which extract may be required to be certified, at the option of the requesting party, by a notary public or any other competent public authority or, where permitted under the applicable law, by a representative having the right to practice before the Office, as being a true extract of the contract;

(iii) an uncertified certificate of transfer of ownership by contract drawn up with the content as prescribed in the Model International Form in respect of a certificate of transfer and

signed by both the applicant and the new applicant, or by both the owner and the new owner."

RULE 18 (CORRECTION OF A MISTAKE)

PLT R.18 regulates the formal requirements and procedures concerning the request for correction, by the office, of a mistake not related to search or substantive examination but does not regulate the substantive requirements which a contracting party may apply in determining the allowability of a correction. PLT R.18 would not appear to require any changes to the CPA or CPR but it may be desirable to establish internal office guidelines to ensure that anything required by the CPO in the application of s.8 CPA or s.35 CPR is consistent with that rule.

RULE 19 (IDENTIFICATION OF APPLICATION WITHOUT NUMBER)

PLT R.19 sets out some alternate means that an office must accept as identifying an application in circumstances where the application number is required to be filed but that number has not been issued or is not known. This will require some minor changes to the CPR such as in relation to the requirements to provide an application number in Items 2 and 4 of Form 3 of Schedule I CPR.