Intellectual Property Institute of Canada
Institut de la propriété intellectuelle du Canada

Intellectual Property Institute of Canada (IPIC) Submission on the *Rules Amending the Patent Rules*, Canada Gazette, Part I, Volume 155, Number 27, July 3, 2021

Submission to:

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INTRODUCTION

The Intellectual Property Institute of Canada (IPIC) is the professional association of patent agents, trademark agents and lawyers practising in all areas of intellectual property law. Our membership totals over 1700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g., patents, trademarks, copyrights, and industrial designs) in Canada or elsewhere, as well as foreign companies that hold intellectual property rights in Canada.

This submission focuses on the request for continued examination (RCE) and excess claim fee (ECF) regimes proposed in the draft Rules Amending the Patent Rules, Canada Gazette, Part I, Volume 155, Number 27, published on July 3, 2021.

IPIC has serious concerns with these proposed amendments. We strongly recommend that the proposed RCE and ECF regimes not be implemented in this manner, and preferably not at all without first holding a public pre-consultation and consultation process to determine the best mechanisms to reduce prosecution time and excessive claim sets.

IPIC appreciates the burdens of application size and prolonged examination on CIPO. IPIC also understands that while average patent application pendency in Canada is already less than 3 years[1] and that two-thirds of all patents require no more than two office actions (examination reports) before grant, CIPO is motivated to reduce patent application pendency in outlier cases to reduce any patent term adjustment (PTA) that may be owed to patentees in future.

The proposed RCE and ECF regimes are, in effect, a reversal of long-standing examination policy on very short notice, but in a piecemeal manner that ignores the interplay with other aspects of Canadian patent examination and Canadian patent law. The result is that some other aspects of Canadian patent law and practice will be in competition with these RCE and ECF regimes, generating contrived applicant behaviour and increased administrative burden for both CIPO and applicants, along with potential unintended consequences for PTA. These other aspects of law and practice were not seriously considered in the Regulatory Impact Analysis Statement (RIAS) or the accompanying Cost Benefit Analysis (CBA).[2] Some of these issues are discussed in sections A and B below. On the other hand, it is very possible that the patent pendency problem identified in the RIAS—along with concerns with claim

[1] From request for examination to grant, average turnaround time is 31.1 months: CIPO Annual Report 2019-2020.

[2] CIPO, *Rules Amending the Patent Rules: A Cost Benefit Analysis*, May 2021

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set size, and office action count—could all be solved by legislative and/or other regulatory measures with lower administrative overhead and better control over PTA.

If Canadian patent examination is to be restructured, it is important that all relevant law and practice be considered holistically and changed together so that all these rules complement each other while promoting compact examination and shorter pendency. This includes our double patenting law, rules for filing divisional applications, rules and practice concerning clarity and conciseness of claims, final action practice, the Patent Appeal Board, and the computation of PTA.[3]

To this end, IPIC recommends that in place of the proposed RCE and ECF regime, the *Patent Act* and Rules should be amended to permit applicants to file "continuation" applications—child applications of an original application that are procedurally similar to divisional applications, but that claim patentably indistinct subject matter as long as it is not the identical, same invention—and to permit applicants and patentees to disclaim the additional term of protection of the continuation patent that might accrue over the original patent and maintain common ownership over all such patents. This is discussed in section C.

If some part of the proposed amendments must be implemented now, then implementation of either the proposed RCE or ECF regime must be accompanied by changes, set out in section D, to ensure that CIPO and applicants are not unduly burdened by the additional administrative and substantive tasks required by these proposed amendments.

Additionally, IPIC recommends other changes to these proposed amendments as well as the *Patent Act* and *Patent Rules* generally, discussed in sections E and F. In particular, we urge CIPO to provide a longer transitional period in these proposed amendments to ensure that applicants have sufficient time to become informed of any rule changes and to take steps to request examination before these changes come into force.

A. THE ANALYSIS IN THE RIAS AND CBA IS INCOMPLETE

In the course of preparing this submission, IPIC surveyed its membership for feedback on the proposed RCE and ECF regimes. We received responses from 128 individuals including patent agents working in patent firms and agents, lawyers and/or IP managers working in in-house patent departments or tech transfer offices/universities, and litigators. The vast majority of respondents found the proposed RCE and ECF unsatisfactory, mainly because they failed to address the underlying issues in Canadian patent law and practice giving rise to protracted prosecution and large claim sets. The small minority that

[3] We note that the United States introduced their patent term guarantee and rule-making powers to create their RCE procedure together in the American Inventors Protection Act of 1999 (P.L. 106-113).

supported the proposed amendments reflected the fact that a significant number of applicants already have small claim sets and enjoy minimal prosecution, or could avoid excess claims fees with the contrived behaviour proposed by CIPO; and a general feeling that pendency is indeed too long and that excessively large claim sets are unnecessary.

The majority of respondents generally expressed grave concerns about the effect of the proposed amendments on patent examination, and provided insight on their likely reactions should these amendments come into force as written. Their responses suggest that the regulatory scenario described in the RIAS and CBA does not accurately depict likely applicant behaviour. In fact, we estimate that the proposed amendments will create additional administrative burden for both applicants and CIPO, and additional costs to applicants in patent agent services. We are therefore concerned that the regulatory scenario and cost-benefit analysis set out in the RIAS may be inaccurate.

Additionally, we are concerned that the small business analysis in the RIAS fails to consider all "small businesses", as that term is commonly understood and defined for the purpose of the small business lens.

1. The regulatory scenario does not account for all behavioral changes and their associated transaction costs

While it is indeed likely that some applicants will reduce the claim count in their applications under the regulatory scenario, neither the RIAS nor CBA consider the mechanism required to achieve that reduced claim count. The vast majority of patent applications originate from foreign applicants; they are not drafted by Canadian agents, or specifically with Canadian rules in mind.

In preparing these estimates, we have assumed an average of 28000 requests for examination (REs) per year, which is close to the average number of REs reported by CIPO in recent years[4] and the projected steady state set out in the RIAS.

Applicants will file more voluntary amendments, creating additional administrative burden and increasing applicant cost

The regulatory scenario in the RIAS predicts that applicants would avoid excess claim fees by reducing their claim counts before the request for examination. According to the RIAS, about 46% of all applications for which examination is requested have more than 20 claims; CIPO projects that that only 17% of examined applications will have more than 20 claims by 2026 if the proposed amendments are enacted.

[4] CIPO Annual Report 2019-2020.

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However, there is no discussion in either the RIAS or CBA how applicants will reduce their claim counts to 20 claims or fewer. As noted in the RIAS, approximately 80% of all applications enter the Canadian system from the PCT. It cannot be assumed that applicants will start drafting PCT applications with fewer claims simply because Canada has instituted excess claim fees. Indeed, the United States Patent and Trademark Office (USPTO) and European Patent Office (EPO) have charged excess claim fees for some time; if applicants have not modified their PCT drafting practice for those patent offices, there is no reason to think they will do so for Canada.[5]

If a PCT application entering the Canadian national phase has more than 20 claims, the only way the claim count can be reduced before a RE is by a voluntary amendment. That voluntary amendment would likely be submitted once a decision to request examination has been made, and not immediately at national phase entry. Applicants may defer the RE pending the outcome of examination in other countries, and some applicants may decide to abandon their application before the RE is due; thus, it is most cost-effective to defer the voluntary amendment until the RE is made.

We assume that the processing and review of a voluntary amendment by CIPO would consume both analyst time in processing the incoming amendment, and additional examiner time in the course of preparing the first office action to verify that the amendment does not go beyond the original content of the application. On the applicant's side, we estimate that the formatting of the amended pages and submission of the voluntary amendment would consume about 30 minutes of clerical time and 30 minutes of agent time. This omits the time required to draft the amended claims, which is discussed separately.

Based on these assumptions, applicants will request examination in 22400 PCT national phase entries per year, and more than 10300 will have excess claims. The RIAS projects that the occurrence of excess claims will eventually reduce to 17%; in other words, there will be a change in practice in 29% of all patent applications, either because they will be drafted with fewer claims, or because of voluntary amendment will be filed before the RE. This projection appears to be based on the Australian experience with ECF, but in view of its double patenting law discussed below, Australia may not be an appropriate model for Canada. Regardless, as noted above we consider it less likely that applicants entering Canada via the PCT will alter their drafting practice; so, if 29% of all PCT national phase entries will be amended before the RE, this will result in **about 6500 voluntary amendments per year to reduce claim count**.[6]

In addition, CIPO contemplates in the proposed amendments that applicants may subsequently file a voluntary amendment to increase their claim count after RE, but before examination starts, without

[5] In a random sample of 100 Canadian patents granted in 2018 from national phase entries, 47 had more than 20 claims at the time the application was published. While a sample of 100 is very small (due to the limited time available in this public consultation), the result was surprisingly consistent with the 46% stated in the RIAS.

[6] Some applicants already submit amendments with the national phase entry or RE, but we do not have statistics on this practice.

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paying the excess claim fee. This will enable applicants to obtain much-needed unity objections before filing divisional applications. We contemplate that these voluntary amendments will be used both to trigger unity objections in the first office action, and to add claims to additional embodiments (e.g., corresponding to US continuation claims) which are not necessarily distinct inventions. If this is done in even 10% of cases, this will result in a **further 2800 voluntary amendments per year**.

Neither the RIAS nor the CBA takes this additional administrative burden into account in computing the cost to CIPO or the cost to applicants.

Applicants will incur added costs in having claim amendments prepared for Canada

The RIAS presumes that applicants will simply amend Canadian applications with shorter claim sets already filed in another jurisdiction. However, the claim set filed in either the EPO or the US is not necessarily suitable for use in Canada, due to different practices concerning the recital of alternatives and multiple dependencies. Agents report that European claim sets that start with 15 or fewer claims can more than double in size once written in a manner acceptable in Canadian practice. A 20-claim set written for a software-related invention in the US with independent claims directed to a method, an apparatus, and a computer-readable medium can sometimes be rewritten as 10 claims or fewer in Canada, meaning that claims to additional embodiments could be added without exceeding 20 claims. In addition, claim sets written for a pharma-related invention in the EPO are often amended to add the alternate use style claims that not permitted by the EPO and that can be construed differently by Canadian courts, and claims directed to methods of medical treatment originating from the US must be rewritten to appropriate use claims.

Thus, even when there are shorter claim sets available, it is often the case that additional work is required to bring the claims into conformance with Canadian practice and to optimize claim scope. Currently, these revisions are typically done as part of examination, for example in in response to the first office action. If these amendments come into force as proposed along with the RCE regime, some applicants will make these amendments proactively before examination starts to avoid receiving an office action on clarity objections, and the Canadian agent may be asked to prepare the amended claim set.

The time required to prepare a Canadian claim set for a voluntary amendment would typically range **between 1-3 hours**, depending on complexity. In some cases, this may result in no change to applicant expense overall; it may save a step during examination because the amendment would not be made in response to an office action. However, there would be no time savings in other cases, for example if the voluntary amendment involved a compilation of different claim sets for which a unity objection was sought.

It is possible that considering the added cost to applicants in having voluntary amendments prepared and filed, some applicants will consider it worthwhile to pay for a certain number of excess claims rather than pay for an amendment. Thus, the transaction costs not considered in the RIAS or the CBA may result in a higher average number of claims once a steady state is reached.

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Applicants and agents will initiate more interviews with examiners, creating additional examination burden

An overwhelming majority of patent agents (about 80%) signaled an intention to request more examiner interviews to move prosecution along, likely to avoid the first or a subsequent RCE.

We do not have any data on the usage of patent applicant-initiated interviews before CIPO. The CBA refers only to examiner-initiated interviews as part of the Patent Examiner Interview Service. These interviews are typically directed to minor defects, and are only consistently initiated by about 25% of examiners.[7] Anecdotally, the use of interviews for substantive matters, such as prior art issues, is significantly higher before the USPTO than before CIPO. With an RCE system similar to the US, we do expect that more Canadian agents will adopt this practice in Canada. This would have a noticeable impact on the productivity of Canadian examiners. This would affect all examiners, and not merely those that voluntarily choose to use the Interview Service.

We expect that an interview on substantive subject matter would consume up to an hour of an examiner's time in reviewing the application, reviewing any applicant submissions, attending the interview, and writing the interview summary. Similarly, we project that an interview would consume about an hour of an agent's time in addition to time that would ordinarily be spent on prosecution. If interviews took place in 5-10% of all applications under examination, this would result in an additional **1400 to 2800 hours** of examination time and the same amount of professional time per year, assuming an average of 28000 Res per year. This additional burden was not addressed in the RIAS or the CBA.

Agents have repeatedly requested that email communications and videoconferences with examiners be permitted to facilitate interviews and the discussion of proposed claim amendments, similar to procedures before the USPTO. Currently, the only permitted options for sending documents to an examiner are the prescribed physical and electronic delivery channels. Processing of physical and electronic communications through the Incoming Correspondence Unit potentially adds days of delay.

Some applicants may request an early final action, increasing their eventual PTA

A minority of agents indicated that they may recommend to their clients that they trigger a final action under subsection 86(5) of the *Patent Rules* to bring prosecution to a close and avoid the expense of a first or subsequent RCE. Although few applicants may take this drastic step, even a small increase in the rate of referrals to the Patent Appeal Board (PAB) will significantly impact PAB workload and eventually, PTA.

We do not have any statistics on how many final actions issued under subsection 86(5) are converted to PAB inventory, but presumably an applicant who voluntarily directs their application to the after-final

[7] CBA, page 27.

process has little intention of abandoning their application. Currently, referrals to the PAB are very low compared to the number of applications examined each year—referrals peaked at 101 in FY2018-2019[8]—but even with this low volume, the PAB found it necessary to assign single-member panels instead of three-member panels to review certain rejected applications to help reduce their backlog. In the meantime, the performance target for Commissioner's decisions was increased from 24 to 31 months.[9]

It appears that even an increase of **100 additional PAB referrals** per year—which is less than 0.4% of all Res per year—would have a serious impact on PAB workload.

Without knowing how PTA may be computed, there may turn out to be compelling reasons for an applicant to trigger a final action instead of an RCE. As discussed below, there is a widespread feeling that examiners do not cite the best prior art at the earliest opportunity and that initial examination of dependent claims is incomplete. A final action requires the examiner to identify every outstanding defect. Additionally, the applicant may challenge the examiner's claim construction or definition of the person skilled in the art and common general knowledge, requiring the examiner to provide additional information and evidence. Thus, an early final action will enable the applicant to know the complete case they are required to meet in response—possibly at an earlier stage than if examination had taken its usual course.

CIPO also expressed concern in the RIAS about applicants deliberately delaying examination to maximize PTA. Given that no scheme for computing PTA has been presented, it is premature to assume that applicants could, or would, deliberately act in this manner.[10] On the other hand, applicants cannot be

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[8] CIPO Annual Report 2019-2020.

[9] CIPO Performance Targets 2018-2019 (https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04800.html) and 2021-2022 (https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02948.html).

[10] This is unwarranted speculation, considering no proposed PTA computation has been revealed and the PTA computation would likely include checks on strategic or abusive behaviour. Anecdotally, Canadian agents report that their clients do not inquire as to how they may strategically maximize their PTA in the US; they are more intent on getting a patent issued with desirable claim scope.

The CBA (page 13) states that Canadians who purchase patented goods are impacted by patents granted in Canada. However, the CBA does not discuss the counterbalancing incentive to innovate or introduce new products into the Canadian market. We wonder whether CIPO has the pharmaceutical industry in mind in making this statement and in speculating that applicants may attempt to maximize PTA. The Government of Canada already determined that it was in the public interest to grant extended patent term to patented medicines in certain circumstances, in the form of certificates of supplementary protection, when it ratified the Comprehensive Economic and Trade Agreement with the European Union. Additionally, the Patented Medicine Prices Review Board ensures that Canadians are not charged excessive prices for patented medicines. The United States does not

faulted for the inherent delays in the final action and after-final procedure. Final actions occasionally take longer to issue than a non-final action due to the requirement for supervisory approval. Presumably applicants would not be penalized for that delay, nor any delays incurred by the PAB, whether or not an RCE is filed.[11]

The PAB is also expected to identify any additional defects missed in the final action and to provide the applicant with an opportunity to respond,[12] providing the applicant with another opportunity to submit arguments and/or amendments without an RCE albeit with a shorter deadline, while increasing the workload of the PAB and associated delay. Based on current performance, the final action and PAB review processes would automatically **add at least three years to pendency**. Since the *Rules* only give the PAB one opportunity to identify additional defects, no further defects can be cited against the application while the application awaits final disposition.

Since the proposed RCE regime does not align with final action practice in subsections 86(5) to (13) of the *Rules*, the above scenario is a possibility. It may become an attractive option to complete examination using subsections 86(5) and (9) while protecting any accumulated PTA. This issue could be avoided by a holistic review and revision of all examination processes, including final and after-final action practice.

2. The small business lens analysis is inaccurate

The small business lens in the RIAS appears to be based on the number of applicants self-identifying as "small entities" under the Patent Rules. The "small entity" status is restricted to universities and entities with 50 or fewer employees that are not controlled by an entity with more than 50 employees (other than a university) and not under an obligation to transfer or license an interest in a claimed invention to an entity with more than 50 employees (other than a university).[13]

The Treasury Board of Canada Secretariat defines a "small business" for the purpose of the small business lens analysis as any business, including affiliated businesses, with fewer than 100 employees or

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have a similar mechanism. Neither CIPO nor ISED has established that pharmaceutical patent applicants in Canada would have the same motivation to extend PTA as they might have in the United States.

[11] Delays incurred by the PAB occur during the processing or examination of the application, and are well within the control of the granting authority and are unrelated to an RCE. They should not be excluded from the PTA computation, in accordance with Article 20.44 of the *Canada-United States-Mexico Agreement*.

[12] Patent Rules, s. 86(9).

[13] Patent Rules, s. 44(2).

less than $5M in gross annual revenues.[14] ISED defines a "small business" as one with less than 100 employees; 98% of all businesses with employees in Canada are small businesses under this definition.[15] The 100-employee limit is the common definition used across the Government of Canada. The definition of a "small entity" in the Patent Rules is not a common definition used in industry or by the Government.

The definition of "small business" applied in the RIAS appears to exclude all companies with 51-99 employees, and include universities which generally have more than 100 employees.

CIPO is also aware that there are patent applicants who would qualify as a small entity under the Patent Rules but decline to do so on the advice of legal counsel due to the impact of *Dutch Industries Ltd. v. Canada (Commissioner of Patents)*, 2003 FCA 121, despite the correction mechanism for incorrectly-paid small entity fees that was subsequently introduced. Those applicants nevertheless qualify as "small businesses" as defined for the purpose of the small business lens analysis. We are not aware of any requirement that a small business must expressly identify itself as such to CIPO to be considered in the small business lens analysis.

If the small business lens analysis is indeed based only on self-identified "small entities", then it does not accurately reflect the impact of the proposed RCE and ECF regimes on Canadian small businesses. The new fees proposed in these amendments cannot be avoided by small businesses with 51-99 employees.

3. These proposed amendments may create a disincentive to file in Canada

In the previous section, we illustrated that the RIAS and CBA did not consider all aspects of applicant response to the proposed RCE and ECF regimes or the complete impact on small businesses. These omissions, and other concerns about Canada's appeal as a market for both domestic and international businesses, lead us to believe that these RCE and ECF proposals will further depress patent filing rates in Canada.

CIPO indicates in the RIAS that it does not believe that these new regimes will deter applicants engagement with the Canadian patent system, citing Australia as a model, because it has a comparable market size and comparable excess claims fees system. We infer that CIPO considers that because time-limited examination and excess claims fees did not have a long-term depressive effect on Australian filings, the same will be true in Canada.

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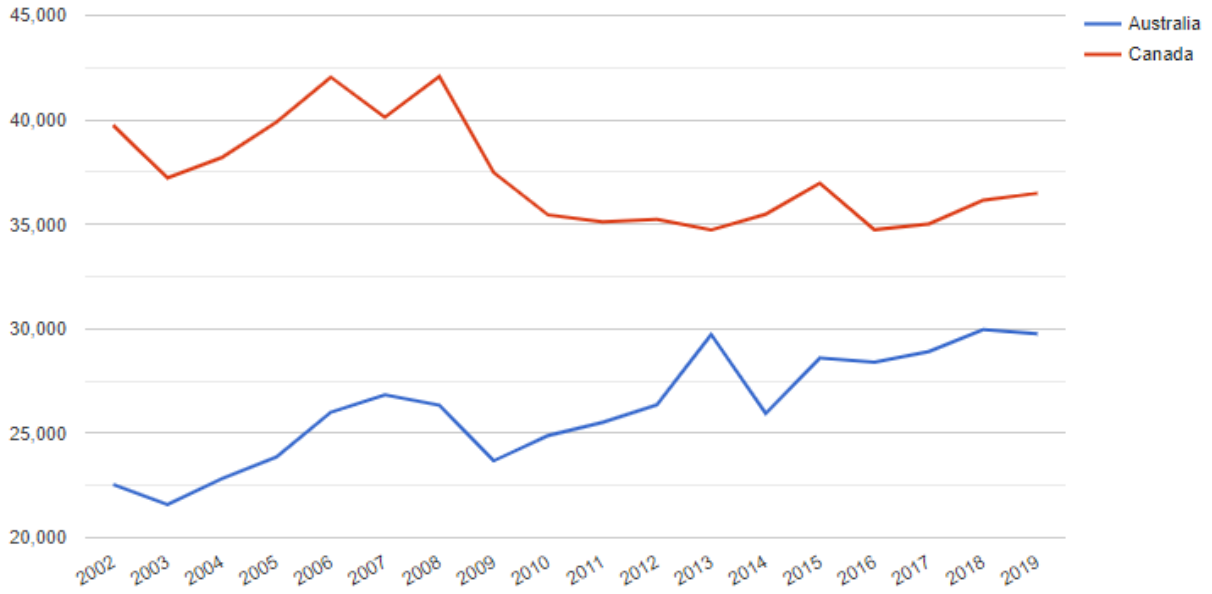
[14] Treasury Board of Canada Secretariat, *Policy on Regulatory Development*, https://www.canada.ca/en/government/system/laws/developing-improving-federal-regulations/requirements-developing-managing-reviewing-regulations/guidelines-tools/policy-regulatory-development.html.

[15] ISED, *SME Research and Statistics*, https://www.ic.gc.ca/eic/site/061.nsf/eng/home.

However, Canada and Australia are not starting in the same position, as can be seen from the chart below.



Total filings (direct and PCT national phase entry) in Australia and Canada, 2002-2019 by calendar year[16]

While Australia's rate of patent filings has gradually increased over the past couple of decades, Canadian patent filings have failed to follow the global trend. The WIPO data in the chart above does not reflect 2020 filing data. We note that there has been an increase in Canadian direct filings and national phase entries in 2020, but unlike Australia, the filing rate has not returned or surpassed the pre-2009 recession level, and we have not yet seen the full impact of COVID-19..

In other words, while the Australian experience suggests there was no deleterious effect on filing rates upon the introduction of excess claims fees (which were introduced around 2002 and significantly increased around 2007), this was against the backdrop of increasing interest in Australia as a market and a patenting destination, as evidenced by the WIPO data. Furthermore, applicants in Australia are not restricted from filing multiple applications with overlapping claims, as in Canada. Australia prohibits only

[16] WIPO IP Statistics Data Center, as of July 29, 2021 https://www3.wipo.int/ipstats/index.htm.

same-invention double patenting[17] and permits overlap in the subject matter claimed in multiple patents by the same applicant.[18]

The factors behind Canada's sluggish filing rate do not include prolonged pendency, because CIPO's efforts at reducing pendency by non-regulatory means over the past several years have been successful. These RCE and ECF measures will not improve the filing rate. Many agents noted that applicants consider Canada's examination process and lack of excess claims fees a selling point for patenting in Canada and questioned whether some applicants will decide against filing in Canada due to the increased cost.

B. THE PROPOSALS DO NOT ADDRESS THE UNDERLYING CAUSES OF PROLONGED EXAMINATION AND EXCESSIVE CLAIMS

The proposed RCE and ECF regimes only address certain perceived symptoms in patent examination, but not the causes. These amendments do not address the underlying issues. In fact, many agents and applicants view large claim sets and prolonged examination as coping mechanisms or consequences of other shortcomings of the Canadian patent regime.

CIPO identified claim count as a factor that tends to prolong examination times, but neither RIAS nor the CBA spend any appreciable time exploring whether there is a causal relationship between claim count and prolonged examination, or why that may be the case. At best, it appears that only 5% of the additional "complex time" allotted for complex examination is directly related to large claim sets, and the proposed ECF regime will only eliminate 3.75% of all complex time.[19] If 95% of complex examination is due to other factors and not specifically a large number of claims, this suggests that the incidence of excessively large claim sets is not so high that the time spent on their examination has a significant effect on overall pendency.

On the other hand, a review of the root causes of large claim sets and prolonged examination suggests that there are other measures that can be taken to reduce pendency while avoiding, or at least reducing, the administrative burden inherent in the proposed RCE and ECF regimes. Three of these

[17] *Patents Act 1990 (Cth)*, s. 64(2).

[18] *Smith Kline Beecham p.l.c.'s Application* [2000] APO 54, cited in the Australian Patent Manual of Practice and Procedure, chapter 2.18.6, https://manuals.ipaustralia.gov.au/patent/2.18.6-same-invention.

[19] CBA, page 23.

causes—repeatedly cited by agents as reasons for excessive pendency and large claim sets—are summarized below.

1. Prolonged examination is sometimes caused by Canada's strict double patenting law

The existing prohibition on double patenting is a judge-made concept intended to prevent a patentee from obtaining a second and later patent for a patentably indistinct invention, thus improperly extending ("evergreening") patent protection beyond the statutory 20-year term. The basic premise is reasonable, but poses difficulties in practice. The strict Canadian rule against double patenting is not aligned with the United States, or even Australia, which is cited as a model in the RIAS and CBA. In the United States, obviousness-type double patenting can be overcome by a terminal disclaimer.[20] As pointed out above, Australia prohibits only same-invention double patenting and permits overlap.[21] This lack of alignment poses a trap for applicants accustomed to different rules in their countries of origin.

Because double patenting is contingent on the construction of the original and divisional claims, it can be difficult for applicants or patentees to know in advance whether CIPO or the courts will consider two inventions to be patentably distinct. To avoid this uncertainty, applicants are consistently advised to advance claims to all possible embodiments or inventions in the original application to trigger an office action identifying a unity defect under subsection 36(1) of the *Patent Act*, so that any divisionals are filed under subsection 36(2.1) and thereby "protected" from double patenting.[22] However, sometimes these claims are not available for the Canadian application until examination is underway; for example, when their source is a later-filed corresponding US continuation application.

The need to add additional claims from corresponding applications in other countries to confirm unity (or lack thereof) is probably responsible for most withdrawals from allowance under subsection 86(17) of the *Patent Rules*, and one of the causes of prolonged pendency. The introduction of additional claims during examination requires a new office action directed to the unity defect, and effectively puts substantive examination on hold until the unity defect is resolved. This can add between 5 and 12 months to pendency, depending on how quickly the applicant addresses the unity defect.

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[20] 35 USC §253(b); 37 CFR §1.321(c), (d).

[21] *Smith Kline Beecham p.l.c.'s Application* [2000] APO 54, cited in the Australian Patent Manual of Practice and Procedure, chapter 2.18.6 at https://manuals.ipaustralia.gov.au/patent/2.18.6-same-invention.

[22] *Consolboard Inc. v. MacMillan Bloedel (Sask.) Ltd.,* [1981] 1 S.C.R. 504 at 537.

2. Prolonged examination is often caused by inadequate examination

In IPIC's survey, several members commented unfavorably on the quality of examination, including reliance on the International Report on Patentability (in the case of unamended PCT national phase entries) in place of the examiner's own search. Indeed, we understand that examiners are instructed to defer their own searches when suitable prior art can be found in the file histories of corresponding foreign applications or PCT application.[23]

This practice sometimes results in prolonged examination due to additional office actions that are not the result of the applicant's action, but rather due to the examiner's postponed search for additional prior art. This suggests that the prior art found in corresponding file histories was not suitable, or the best prior art that could be cited in Canadian examination; yet the proposed RCE regime places the responsibility for the examiner's failure to conduct an earlier search on the applicant.

Several members also observed that examination of dependent claims is often not detailed enough for applicants to understand how to respond to alleged obviousness defects. Dependent claim limitations are often swept into a one-paragraph analysis that dismisses all limitations as obvious in view of the cited state of the art document—often without any mapping of claim limitations to the cited document—and common general knowledge, which is undefined but for the assertion that it fills the gap between the state of the art and the claimed subject matter. It is often evident to applicants and agents that there is no specific reasonable ground for the examiner to believe that all dependent claims have a prior art defect, but it is easier for the examiner to make the sweeping analysis.

On occasion, this style of examination results in an additional office action to flesh out the obviousness defect with enough information about the state of the art and common general knowledge for the applicant to be able to provide a meaningful response.[24] Again, each additional office action can add

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[23] Patent Practice Committee Meeting PB/IPIC Minutes, June 12, 2018, http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04432.html.

[24] Examiners are not required to provide a complete explanation of obviousness defects unless challenged by the applicant: see MOPOP 12.02.02c ("Unless it becomes evident through the applicant's comments that the nature of the common general knowledge is not common ground and is reasonably in dispute, an examiner need not identify documents establishing the common general knowledge") and MOPOP 18.02.02 ("The Sanofi four-step analysis will typically be done intuitively and automatically by an examiner. Where there appears to be a disagreement between the examiner and applicant(s) as to whether or not a claim is obvious, the Sanofi four-step analysis should be set out in a report.") An applicant should not be expected to respond to an examiner's intuition if their intuitive leaps are not evident in the record, or to stipulate to an examiner's assumptions concerning common general knowledge unsupported by explanation or evidence. On occasion, an applicant feels compelled to challenge an obviousness defect by requesting further information, necessitating another office action in which the examiner provides that information.

between 5 and 12 months to pendency, depending on how quickly the applicant responds to the prior office action.

Another cause of prolonged examination for applications or patents studied in the RIAS and CBA is the purposive construction and patentable subject matter examination guidance in place between 2013 and 2020 that was later shown to be wrong in law. Despite repeated warnings from the profession that the purposive construction guidance first promulgated in 2013[25] was improper, CIPO declined to reevaluate its interpretation of the law, and only stopped using this guidance after a Federal Court decision in 2020.[26] In the meantime, applicants were subject to multiple office actions repeating the same defect. While the applicants disputed those office actions, and/or attempted to make compliant amendments in good faith, these instances of prolonged examination are now being used to justify the proposed RCE regime.

We have no estimate how many office actions with patentable subject matter defects under that guidance contributed to prolonged pendency between 2013 and 2020.[27]

3. Large claim sets are often the result of other features in Canadian law and practice

Sometimes, large claim sets are also the result of our double patenting law. An application may be filed with a large number of claims directed to various aspects of the same invention, or amended to include those claims, with the expectation that a lack of unity will be found; but the examiner instead determines that all claims can proceed in the same application.

In other cases, large claim sets are a result of the peculiarities of Canadian law on patentable subject matter. For example, multiple claims to fixed dosage amounts may need to be filed to avoid rejections based on non-statutory methods of medical treatment, or three different types of medical use claims may need to be included to cover the different subject matter coverage that has been ascribed to each type by the courts.

Additionally, claim count can be inflated by the clarity rules imposed in examination. For example, the compact style of claiming alternatives accepted in the EPO in which preferred embodiments are listed or

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[25] CIPO, *Examination Practice Respecting Purposive Construction PN2013-02*, March 8, 2013.

[26] *Choueifaty v. Canada (Attorney General)*, 2020 FC 837.

[27] Additionally, the prosecution of at least one application allowed in FY2019-2020 that received multiple office actions under the 2013 guidance was also stalled by the 2-year delay in examination of applications subject to section 2 defects between 2011 and 2013 while CIPO settled its examination guidance following *Canada (Attorney General) v. Amazon.com, Inc.*, 2011 FCA 328.

nested in a single claim is generally objected to in Canada under subsection 27(4) of the *Patent Act*; writing additional claims to cover the same scope can turn small claim set into a large claim set with 30 or more claims.

C. TERMINAL DISCLAIMERS WOULD ACHIEVE SIMILAR RESULTS WITH LOWER ADMINISTRATIVE OVERHEAD

Amending the *Patent Act* to provide for terminal disclaimers and "continuation"-style filings would eliminate many instances of excessive claim sets and prolonged examination, while avoiding the administrative burden created by the proposed amendments.

IPIC has advocated for terminal disclaimers for several years.

Amending the *Patent Act* and *Rules* to extend divisional filings to inventions that are not the same as, but still patentably indistinct from, the invention of the original application or patent (what would be referred to in the US as a "continuation"), and protecting the public by requiring a terminal disclaimer that stipulates all such patents to be owned by the same person and expire on the same day, would likely solve the problem of excessively large claim sets, eliminate prolonged examination in many cases, and address some PTA concerns:

- Applicants would feel more confident about filing voluntary divisional or continuation applications, knowing that a terminal disclaimer could obviate double patenting issues. In some cases, these applications would be filed sooner, reducing market uncertainty.
- Applicants would not need to interrupt examination or the allowance and grant process to add claims to trigger unity defects, since those claims could be submitted in a voluntary divisional or continuation filing. This will reduce pendency associated with the addition of claims (i.e., one office action).
- Additionally, many applicants may choose to bring prosecution of the original application to a close earlier, on narrower claims, thus minimizing any PTA.
- The terminal disclaimer that would be required for any child patent with patentably indistinct claims could ensure that the child patent would not benefit from additional PTA.
- If the ECF regime proposed in the draft amendments is implemented together with terminal disclaimers, applicants will not need to engage in the administratively burdensome, contrived behaviour of filing voluntary amendments after RE to introduce claims to trigger the unity defect, reducing associated administrative costs.

The cost of administering terminal disclaimers would be significantly less burdensome compared to the RCE and ECF regimes. An applicant who files a divisional or continuation application and terminal disclaimer would require about 15 minutes of professional time in preparing the terminal disclaimer and 15 minutes of clerical time to submit the terminal disclaimer. On the CIPO side, we expect this

procedure would not consume much more than 15 minutes of analyst time, and only about 10 additional minutes of examiner time.

Terminal disclaimers would more closely align Canada's double patenting regime with US practice and avoid burdening applicants in specific fields of technology, notably life sciences and high tech.

D. RECOMMENDATIONS FOR THE PROPOSED RCE AND ECF REGIMES

We do not see a justification in the RIAS or CBA to implement all of the proposed amendments at once, particularly because the interaction of the RCE and ECF regimes with other aspects of Canadian law and practice has not been fully considered. Of all the proposed measures directed to reduction of pendency, the conditional notice of allowance appears to be the most compatible with existing law and practice, and capable of being implemented independently of the RCE or ECF-related amendments.

If the decision is made to go forward with either or both of the RCE and ECF regimes, we strongly recommend that changes be made to minimize tension with the unaddressed aspects of law and practice, reduce the administrative burden on all parties, and avoid penalizing applicants for additional office actions that are not caused by their own actions.

1. Create a separate process for requisitions to divide before the excess claims fee becomes payable – avoiding the "workaround" voluntary amendments

In the absence of any change to our double patenting law, applicants must not be penalized by ECFs or RCEs for simply trying to trigger a divisional under subsection 36(2.1) of the *Patent Act*.

The proposed amendments do permit an applicant to submit a voluntary amendment before or with the RE to reduce the number of claims to avoid excess claims fees, and then file another voluntary amendment after the RE to reintroduce or file additional claims without triggering ECF. CIPO informally acknowledged that the proposed amendments were designed to permit this "workaround" so that applicants could place claims to all desired subject matter on file so the examiner could identify a unity defect and thus trigger a divisional under subsection 36(2.1). This workaround would permit applicants to avoid paying fees on excess claims that were never going to be substantially examined in the original application because they were directed to a separate invention. In the proposed ECF regime, this workaround is necessary to ensure that Canadian patents are not prohibitively expensive.

In canvassing members, we found that it was quite likely that some applicants would not understand the subtle nature of this practice to avoid ECF, and would pay the additional fees when it was avoidable. The *Patent Rules* are exceedingly complex, and the proposed amendments only increase their complexity. The lack of an official description of this mechanism in the *Rules* or RIAS creates the impression that this

is a loophole or exploit, and not a sanctioned procedure. Applicants and courts should not have to "read between the lines" of the regulations to understand how they are intended to work. It would benefit everybody, including foreign applicants who may file patent applications and REs without an agent, to make it clear that the option of reducing claim count before/with the RE followed by increasing claim count after the RE is permitted.

We appreciate that CIPO was cognizant of the need to trigger subsection 36(2.1) divisional applications, but we suggest that it would be preferable to implement an explicit process for unity rulings and obtaining directions to divide from the Commissioner. This would make the process clearer for all applicants, and avoid the administrative burden involved in filing voluntary amendments (and sometimes, two voluntary amendments that cancel each other out). For example, a new process could allow applicants to submit a request for a requisition to divide claims before the RE is due, or before excess fees become payable.

2. Provide an express exemption in subsection 85.1(1) when the first office action comprises a unity defect

Given the current state of examination, it is unfair to applicants to count the first office action towards the limit in subsection 85.1(1) in the proposed amendments when it comprises a unity defect. While we understand that the three office action limit before the first RCE is intended to allow for the first office action to identify any unity defects before substantive examination begins, we believe that all applicants should have the opportunity to have at least two responses to substantive office actions entered and considered by the examiner without having to request continued examination.

As noted above, reliance on search results from other jurisdictions sometimes results in deferral of the examiner's own prior art search. This can result in an office action identifying a new defect (e.g., based on newly-cited prior art) after the applicant had overcome any defects based on the previously-cited prior art. This is not within the applicant's control.

By including office actions on unity defects in the three office action count in subsection 85.1(1), applicants are penalized for the examiner's deferral of a prior art search. To ensure that all applicants are able to respond to that new defect, subsection 85.1(1) should be written to exclude the first office action when it identifies a unity defect.

We also note that in the US, a restriction requirement (requiring the applicant to elect between two or more claimed inventions) is generally delivered separately from an office action on the merits of the application.[28] Since it is not an action on the merits (i.e., a rejection), it does not "count" against the

[28] Examiners may also deliver the restriction requirement by telephone, and obtain an oral election of one invention. If the call does not result in an election, then a written restriction requirement is sent. USPTO, *Manual of Patent Examining Procedure* (MPEP), §810.

applicant when assessing whether a next office action is to be made final. The US restriction requirement also bears a shorter deadline for response than an office action on the merits (two months rather than three, but also extendable).[29]

3. Provide an express exemption in subsections 85.1(1) and (5) when an office action identifies a new defect for a reason other than the applicant's action

The proposed RCE regime also penalizes applicants for the examiner's or CIPO's own errors or oversights:

- As described in point 2 above, an examiner's deferral of their own prior art search can result in a subsequent office action citing a new defect based on newly-cited prior art. That subsequent office action counts towards the limits in subsections 85.1(1) and (5) even though the applicant did not provoke the new defect (e.g., because the applicant did not amend the claims).
- Similarly, if an applicant is successful in overcoming the identified defects in the first office action through argument or evidence that the examiner's position was in error, and the examiner then identifies a new defect in the subsequent office action, that first office action still counts towards the limits in subsections 85.1(1) and (5) even though the applicant did not provoke the new defect (e.g., because the examiner locates new prior art, or because the examiner changes the basis of the defect, for example from a conciseness or indefiniteness defect to a unity defect).
- If a change in examination guidance results in a defect being restated in a subsequent office action with a different legal basis or analysis, that subsequent office action still counts towards the limits in subsections 85.1(1) and (5) even though the applicant was likely correct in arguing against the defect as presented in the first office action, and the examiner was originally in error when formulating first office action.

In these situations at least, the subsequent office action should not count towards the total number of office actions permitted before an RCE is required. If the applicant has acted in good faith and responded to all of the examiner's objections without changing the scope of the claims, there is nothing further that they could have done to move prosecution along. The examiner's decision to find a new defect is beyond the applicant's control. It would be unfair to penalize the Applicant by adding the subsequent office action to the count towards an RCE.

Subsections 85.1(1) and (5) should be revised to exclude any office action that introduces a new defect that is not caused by the applicant's amendment of the application or provision of information under section 85 of the *Rules*.

[29] MPEP, §810.

This recommendation mirrors the regime for compact prosecution in the US, where the examination of an application ceases after the second office action on the merits and requires an RCE to continue, except where:

- the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted by the applicant, or
- the examiner introduces a rejection based on newly cited art other than information submitted by the applicant.[30]

Note that if a US applicant wishes to challenge the finality of an office action, they do not invoke the appeal process; instead, a request is made of the primary examiner,[31] or a petition to the Director of the USPTO is filed.[32] In the meantime, the outstanding deadline to respond to the office action is not tolled. An analogous process can be used here to request reconsideration and withdrawal of a notice under subsection 85.1(2). If the decision is in the applicant's favour, and it turns out that an RCE was made but not required, then a refund should be provided.

As the RIAS notes, the efficient processing of patent applications with a view towards concluding examination is a shared responsibility. If this radical change to Canadian patent examination is instituted, it is only fair to recognize that some cases of prolonged prosecution are not caused by applicants. Since CIPO has suggested that subsequent office actions of this nature are rare, then the addition of this proposed mechanism should not adversely affect overall pendency.

4. Provide detailed examination of all dependent claims in the first action

As discussed above, examination of independent and dependent claims presently involves a detailed analysis of independent claims, with dependent claims often bundled together in a single brief analysis without discussion where each claim limitation may be found in the prior art, or what specific defects may exist in these claims. This can result in prolonged examination in some cases when the applicant must respond by seeking additional information about prior art defects rather than by making useful amendments or arguments that can move examination forward.

If the proposed RCE provisions are unchanged, examiners can, and should, advance prosecution and minimize needless office actions by conducting a detailed examination of all dependent claims the first time the claims are substantively examined. A detailed examination should include specific identification

[30] MPEP, §706.07(a).

[31] MPEP, §706.07(c), (d).

[32] MPEP, §706.07(c); 37 CFR §1.181.

of each defect for each dependent claim and pinpoint mappings to the prior art, just as for independent claims.

5. Fees should differentiate between independent and dependent claims

Several respondents in the IPIC survey proposed that a lower fee should be charged for dependent claims than for independent claims, reflecting the current level of perceived effort in examining dependent claims. If CIPO determines that examination of dependent claims will continue in its current form, then we recommend that the excess claims fee structure be changed to reflect the level of effort. The fee set for a dependent claim should be significantly less than that for independent claims.

We also note that the proposed amendments do not eliminate the excess page fee payable as part of the final fee. Some members questioned why the excess page fee in Schedule 2, item 14 remained, when CIPO no longer issues a printed patent. We do appreciate, however, that time is spent by examiners in reviewing the entire specification.

That being said, the excess page fee is payable for each page of the specification and drawings. Under the ECF regime, applicants are therefore paying twice for the claims pages. If the excess page fee is not eliminated, we suggest that this also justifies a reduction in the fee charged in respect of dependent claims.

6. Allow alternate claim drafting strategies

As noted above, agents have found that they cannot draft claims as compactly as their European counterparts due to examination practice concerning the recital alternatives in a single claim. Practice also varies between examiners depending on their tolerance for expressions such as “and/or” or nested alternatives (e.g., “wherein R^1 is [first set of variables], or wherein R^1 is [narrower selection of first set of variables]”).

We recommend that CIPO revise their practice guidance to permit more compact claim drafting strategies such as the above, as well as recital of preferred embodiments nested in a single claim introduced with terms like “preferably”, “including” and “such as”.

E. MORE TIME IS REQUIRED IN THE TRANSITIONAL PROVISIONS

The draft *Rules* provide a transitional provision so that the RCE and ECF regimes will not apply if the request for examination and accompanying fee (and late fee, if required) are paid before the 30th day

after the day on which the regulation is registered.[33] The provisions implementing the RCE and ECF regimes will then come into force 30 days after registration.[34]

This is not enough time for agents to advise applicants and obtain instructions to request examination in advance of coming into force. We request that these periods be increased to three clear months from registration, or preferably publication.

We do not know what changes may be made to these draft amendments between now and registration of the final regulation. Agents cannot inform clients of any impending changes to examination practice until they see the final regulation, because it would be counterproductive to speculate about its contents. The final regulation will not be publicly available until some days after registration (typically 3 business days). This leaves less than 30 days for agents to learn the new rules, explain the impact of the amendments to their clients, get client instructions to request examination (as well as advance funds, in some cases), and make the request for examination. This is impractical. Additional time is needed.

F. OTHER ISSUES

1. The small entity size limit should be increased

As discussed in the context of the small business lens analysis, the definition of "small entity" in the *Patent Rules* is out of step with the conventional Government of Canada definition of small businesses. If the small entity rule is intended to provide relief for small businesses, then the size limit in subsections 44(2), 112(2), and 122(3) should be increased to 99 or 100 employees, while retaining the exemption for universities.

2. The complete fee schedule should be replaced by amendment

We note that the proposed amendments will only amend those items of Schedule 2 directly impacted by the proposed RCE and ECF regimes. Consequently, those amended items will reflect the changes resulting from the application of the *Service Fees Act*, while the unamended items will retain the original fee amounts from 2019.

As a result, a member of the public consulting the *Patent Rules* as published by the Department of Justice or another publisher must not only be aware of the *Service Fees Act* and the historical Consumer

[33] Draft *Rules Amending the Patent Rules*, ss. 56, 57.

[34] Draft *Rules Amending the Patent Rules*, s. 58(1).

Price Index, but they must also be aware of the coming-into-force date of each individual item in the Schedule 2. This is not a fair burden on the general public.

Ideally, the fee-setting structure should be replaced with a rule that empowers the Commissioner to set fees outside the *Patent Rules*, with public consultation if necessary. In the absence of an overhaul of this aspect of the *Rules*, we recommend that the entire Schedule 2 be replaced with updated fees when any single item is amended.

3. The fee correction and extension of time mechanisms should be simplified

With the advent of PTA and, no doubt, provisions to disallow delays caused by certain extensions of time, we recommend that the extension of time provisions of the *Act* and *Rules* (paragraph 12(1)(j.8) of the *Act* and any extension of time provisions in the *Rules*) be amended to remove the requirement for the exercise of the Commissioner's discretion to grant an extension of time.

With the expected PTA computation (which, again, we do not know), there is no need for the Commissioner to incur the administrative burden of determining whether the circumstances justify an extension of time to respond to an office action since the delay caused by the extension will likely not extend patent term. Current subsection 3(3) and proposed subsection 3(3.1) of the *Rules* itemize the requirements for extensions of time to rectify incorrect fee payments to such a degree that the requirement to satisfy the Commissioner that the circumstances justify the extension is superfluous.

4. Failure to respond and RCE should not result in two reinstatement fees

We appreciate that the amendment to paragraph 132(e) of the *Rules* is necessary to give effect to the RCE mechanism. However, an applicant who fails to both respond to the 3rd (or 5th, 7th, etc.) office action under subsections 86(2) or (5) and RCE under subsection 85.1(2) will be required to pay two reinstatement fees for what is in effect a single failure to timely continue prosecution. We recommend that the proposed amendments discount the reinstatement fees by 50%, or waive one of the reinstatement fees.

We also suggest that subsection 85.1(2) be added to subsection 133(3).

5. Provide an entrenched mechanism for withdrawal of office

Proposed subsection 140(3) of the *Rules* will enable the Commissioner to waive the payment of the fee when an extension of time is sought in the case when an office action under subsection 86(2) or (5) is received more than one month after the date it was deemed sent. The waiver of the fee in these circumstances is welcome, but we are concerned that this may be accompanied by a change in the general administrative policy on withdrawing office actions.

Currently, a narrow policy is set out in section 2.02.09d of MOPOP, in which an applicant may obtain withdrawal of an office action received more than one month after the date it was sent. Subsection 140(3) seems to have been written to replace this policy, since the applicant could obtain a "free" extension of time instead.[35]

However, there remains a six-month limit for responding to an office action in subsection 131(2). If the applicant receives an office action one month after the date of the office action, they can still obtain a full four months to respond with the extension of time. But if the applicant receives the office action more than two months after the date of the office action, there is no way for them to receive a full four months to respond without a deemed abandonment. It is not clear whether the administrative policy will be maintained for these cases.

It would be preferable if the *Rules* included a clear mechanism for withdrawal in the case of late delivery of an office action.

6. Provide a more robust examiner interview system

We understand that CIPO plans to make improvements to their examiner interview policy, although no specific plans have been defined. We urge CIPO to relax its communication policies to permit document exchange by email and videoconferencing.

Permitting applicants to send proposed claim amendments by email directly to examiners will facilitate interview preparation, and will avoid the risk of interview documents being delayed or incorrectly processed if submitted by one of the prescribed correspondence mechanisms. Videoconferences would both enable interview participants to view the same documents at the same time and facilitate remote demonstrations, both of which are important in a time when travel and face-to-face meetings are less frequent.

7. Section 60 of the *Rules* should be amended to remove the clarity and conciseness requirements

Section 60 of the *Rules* imposes a requirement that the claims be clear, concise, and supported by the description independently of any document referred to therein.

[35] Again, since we do not know how PTA will be computed, we are concerned that the applicant's extension of time will be deducted from PTA.

The requirement for clarity is duplicative with subsection 27(4) of the *Act*, under which most "clarity" defects are identified. [36]

If the proposed ECF regime is implemented, then there is no need for a conciseness requirement. This objection typically arises because the examiner is examining a claim set with a large number of independent claims; but the applicant will have paid for each excess claim over 20 and should be entitled to examination of each claim. The criticism that the claims are unclear because the examiner cannot isolate the inventive concept, if that is a valid criticism of the claims, can be raised under subsection 27(4) or 36(1) of the *Act*. In those cases, the alleged defect is not due to a lack of conciseness, but rather a choice of claim wording or a multiplicity of inventions.

8. The *Service Fees Act* fee change date should be reconsidered

We also note that the date selected by CIPO for updating its service fees falls on January 1, a holiday, which poses challenges for agents and applicants. Typically, the programming of docketing and correspondence systems in agent firms does not provide for any "sandbox" for testing changes before they go live. Instituting a fee change during a holiday period when programmers may not be available poses difficulties for some agents.

This date was selected internally by CIPO without any public consultation that we are aware of. We suggest that CIPO conduct a public consultation to determine whether a more appropriate date should be selected.

CONCLUSION

We thank CIPO for the opportunity to informally discuss these proposed amendments during the public consultation period.

We reiterate that we understand that excessively long claim sets create an examination burden for CIPO, and that shorter application pendency benefits the Canadian public as a whole. However, as we have shown above, the imposition of an RCE and ECF regime on the existing framework of Canadian patent law and practice will not solve the underlying problems that gave rise to lengthy claim sets and prolonged prosecution to begin with.

We believe that many of the issues identified above could have been addressed and accommodated in the proposed RCE and ECF regimes, had there been an open consultation before publication of these draft rules in the Canada Gazette. While we appreciate that CIPO took the step of undertaking the closed consultation in 2020, it is clear from the RIAS that no fixed proposal for requests for examination or excess claims fees was presented to the participants. Had the participants been able to consider

[36] *Rijk Zwaan Zaadteelt en Zaahandel B.V. (Re)*, 2021 CACP 5 at para. 24.

these specific proposals, the above feedback could have been provided and considered by CIPO before publishing these draft amendments. As it is, the majority of the public who will be affected by these amendments, including the IPIC membership, had only thirty days to assess and respond to this public consultation.

Applicants, CIPO, and the general public would benefit from an open consultation outside the strict confines of the regulation-making process to explore solutions that would achieve CIPO's objectives of reduced pendency and minimal PTA, while giving applicants a fair and affordable chance to seek useful patent protection.