



May 27, 2019

By Email: ic.cipo-consultations-opic.ic@canada.ca

Canadian Intellectual Property Office
50 Victoria Street
Place du Portage I
Gatineau, Quebec
K1A 0C9

Re: Draft MOPOP Topics – *Patent Rules*

Dear Colleagues:

This letter is in response to the call for comments of March 26, 2019 in relation to the above draft revisions to MOPOP. FICPI Canada wishes to thank the Canadian Intellectual Property Office (CIPO) for the opportunity to comment on the proposed revisions.

FICPI (the Federation Internationale des Conseils en Propriété Intellectuelle), comprises more than 5000 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trade-mark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

We appreciate that the proposed new/revised sections of MOPOP are intended to provide more information and guidance to Applicants and their representatives in view of the future coming into force of the revised *Patent Rules*.

We have reviewed with interest the consultation document and provide our comments below, in relation to each of the draft topics.

Written communications

This section is a welcome consolidation of the evolution of various procedures in this regard over the years. Regarding particular sections, kindly note the following.

3.2 Facsimile

The following statement should be deleted:

Please note that CIPO strongly discourages the use of a computer facsimile interface of internet-based facsimile services due to technical issues with reception.

Computer facsimile interface of internet-based facsimile services are the norm in terms of modern-day facsimile transmission. The days of manually-fed facsimile machines has long since passed.

Since the electronic transmittal report constitutes acknowledgement of receipt by CIPO, it is imperative that CIPO address any technical issues with reception, rather than encourage the use of outdated and obsolete technologies, such as manual fax machines.

4.0 Electronic forms for submission

In general, this section recites quite complex technical requirements, which may make compliance difficult for some Applicants, particularly in urgent, time-sensitive situations. We appreciate that a standard format is important for file management, we simply wish to note that it may be helpful to allow flexibility in submissions and filing replacement submissions if necessary. For example, the software “Stellent Quick View Plus 8.0.0” may not necessarily be available to all Applicants.

Further, in view of these requirements, it would be helpful if CIPO could provide a (free) tool for Applicants to verify compliance before making a submission.

4.3.1 Electronic Filing of Sequence Listings in the Receiving Office under PCT

As PCT applications are frequently filed via the online filing interface, accompanying sequence listings (and tables, if applicable) are typically submitted by uploading online. It may thus be helpful to note to Applicants that the procedures regarding additional

copies, etc., relate to filing such files on physical media (consistent with the terminology used in the PCT Administrative Instructions).

Time

2.0 Ordinary Business Hours of the Office; 5.1.1. Prescribed Days

As noted in this section, if November 11 falls on a Saturday or Sunday, CIPO will be closed on the following Monday, thus the next day that it will be open for business is the Tuesday. The very last example given at the end of section 5.1.1. (Prescribed Days) appears to be inconsistent with this principle. Specifically, if the four-month deadline to pay a final fee is November 11, and November 11 falls on a Saturday, the deadline to pay the fee would be extended to Tuesday, November 14 (not Monday, November 13 as indicated), as CIPO would be closed on the Monday.

2.1 Unexpected Closures of the Office

This section refers to CIPO as potentially being closed on “part of a day”, but is not entirely clear on how such a partial closure would be handled. This presents a potential challenge for Applicants to determine if something due on that day has been extended to the next day on which CIPO is open for business. It would be helpful to clarify that such partial closure would be extended accordingly.

3.3 Physical Delivery to Designated Establishments - Registered Mail™ and Xpresspost™ services of Canada Post

Given the various delivery options available today, this section appears to be somewhat limiting. Indeed, the MOPOP was only modified to include the Xpresspost™ service following judicial review proceedings at the Federal Court¹, and that service was used by the Applicant in question in those proceedings only because the Registered Mail™ service had certain weight restrictions. Further, presently, Canada Post offers various delivery services, including Registered Mail™, Priority™, Xpresspost™, Flat rate box™ and Regular Parcel™. Given that the spirit of the amendments to the *Act* and *Rules* is in part to better safeguard against a potential loss of rights to Applicants under various scenarios, it would first be helpful if this section could be amended to include any service provided by Canada Post, to include not only the numerous services presently available, but also those that will be available in the future in view of their evolution. Still

¹ *Biogen Idec Ma Inc v Canada (Attorney General)*, 2016 FC 517.

further, it would be helpful to also include common services for document/parcel delivery, such as commercial courier services (e.g., FedEx, UPS, etc.).

5.2 Requests for Extensions of Time

It would be helpful if greater clarity could be provided for Applicants in this regard.

For example, given that extensions of time may be requested right up until the original deadline for which an extension is being requested, how quickly shall such requests be processed? What are the consequences of learning that the request has been rejected after the original deadline has already passed? What types of justification are required to meet the requirements to obtain an extension?

Further, if it is intended that extensions will basically automatically be granted for the two “eligible” scenarios noted, it would be helpful to indicate as such, i.e. that such requests will be granted with no or little justification required (and in the latter case, what such a standard of justification would entail).

Representation

3.0 Patent agents

We suggest that the opening paragraph in this section be amended to read as follows, to better reflect the reality and increased efficiency (for both Applicants and CIPO) of conducting day-to-day business before CIPO with the involvement of a patent agent:

Any applicant, patentee or third party may appoint a patent agent to represent them in their business before the Patent Office, which is required in certain cases as noted below. Further, there are many activities that will benefit from appointing a patent agent, throughout the lifecycle of the patenting process.

5.1.1.6 and 5.1.1.7 Submission of request to record a transfer; name change

Historically, the transferee (or, more likely, their Patent Agent) has also been able to record such a transfer, however such a person is not explicitly indicated amongst those who may submit the request. Perhaps it was intended that the transfer itself implicitly authorizes the transferee to record the transfer, thus the transferee or their Patent Agent would fall under “any authorized person”?

In any event, including the transferee and his/her Patent Agent would be consistent with section 49(2) of the *Patent Act*, which indicates that "...the assignee may register the assignment in the Patent Office...", and is also consistent with the spirit of section 51 of the *Patent Act*, which confers a priority of rights to the first assignee to register his/her rights at the Patent Office, which has been interpreted by the Courts to also include for example an exclusive licensee².

Compliance

5.1 Inventor Information and Establishing entitlement – changes to applicant

It is our understanding of the new practice that an updated declaration of entitlement is to be filed each time a transfer or change of name is recorded. Does such a requirement continue after patent issuance?

Further, is there a preferred mechanism to effect changes in inventorship and/or ownership in view of claim amendments (we assume that this is intended in particular to refer to unity of invention issues)?

5.2 PCT national phase applications – applicant or legal representative

Sometimes there may be a delay in the issuance of a PCT/IB/306 form. In such situations, would it be acceptable to submit a copy of the request made to the PCT authorities in this regard?

Divisionals

The new term "presentation date" is a welcome clarification to divisional practice.

The approach to meeting numerous requirements at the presentation date however appears to be rather rigid, and again, against the intended spirit of better safeguarding Applicants' rights. For example, what would be the consequence of a typographical error in the parent serial number, that could potentially go unnoticed for years? Details of correcting such potential errors are not discussed in this section, nor in the new section relating to corrections. Greater clarity (and flexibility) would be appreciated by Applicants in this regard.

² 3288731 *Canada Inc. vs. Les Poinçons de Waterloo Inc.*, Quebec Superior Court, No. 460-05-000290-960; aff'd Quebec Court of Appeal, No. 500-09-006534-986.

While the option of re-filing the divisional is proposed, this may not be practical in most situations, as divisionals are most frequently filed close to parent issuance, thus issuance of the parent patent in the interim will preclude such divisional re-filing.

Priority

3.0 Copy of Priority Application

Is CIPO presently in a position to provide further details of the “digital library” specified by the Commissioner? The draft MOPOP does not provide any additional information over section 74(1) of the new *Patent Rules*. Such details are critical to Applicants, particularly in view of the harsh consequence (potential loss of priority) which may be incurred. Further, section 74(1) of the new *Patent Rules* does not make any reference to an “access code”, which we believe should be removed from the draft MOPOP as it appears to be an additional requirement going beyond the amended *Rules*.

Transfers

2.0 Recording a transfer

This section provides “that the effective date for the recordal is the date when the Commissioner records the transfer and not when the request is submitted to the Patent Office”.

It is fairly common that transfers are submitted in association with an appointment of agent by transferees. It would be helpful to clarify that while the recordal date is when the Commissioner records the transfer, nevertheless a transfer may be submitted in support of an appointment of agent, which may be recognized upon receipt in order to enable the transferee to attend to imminent deadlines immediately, consistent with current CIPO practice.

2.2 Recordal certificate

This section provides that once the Commissioner has recorded the transfer, a certificate with a unique identification number will be sent to the person who requested the recordal of the transfer.

It would be helpful to provide a copy of the recordal of the transfer to the agent of record on a pending application, particularly in view of the fact that it appears that the ability to

make a non-identity changing correction to the owner name would be time limited (Corrections, s. 2.3).

3.0 Recording a name change

This section provides that changes of name that do not change the identity will be recognized on the request of the applicant or patentee.

It is not unusual for transferees to record changes of name.

As noted in the Introduction section (1.0), it is not necessary to record these changes. If the applicant has not recorded a change of name, a new owner will want to update the record to the current name of the applicant before recording an assignment in their favour.

We suggest that a further section should be added providing that any person may record a change of name by providing official evidence of the change of name, such as an excerpt from a corporate register.

Alternatively, section 4.0 "Registration of related documents" should be amended to clarify that a change of name registered under that section will be sufficient to enable the transferee to record a subsequent step in the chain of title.

Corrections

2.4 Priority filing date

As a preliminary point, while beyond the scope of these submissions, the fact that a decision tree is provided requiring an Applicant to make a number of separate determinations to decide whether it is possible to correct a clerical error in the priority filing date suggests that the underlying rule has introduced unnecessary complexity.

Turning to the decision tree itself, we suggest that the tree may be more user-friendly if presented from the left. Before considering the actual date for making the correction, the applicant will first consider whether it is possible to make the correction i.e. have all deadlines passed? Our understanding of the tree is that the applicant will need to make all of the following determinations to use the tree:

- Is it currently earlier than 16 months from the requested corrected priority date?
- Is it currently earlier than 16 months from the originally submitted priority date?

- Would the application have already been open to Public Inspection based on the corrected priority date?
- Would the application have already been open to Public Inspection based on the originally submitted priority date?
- Is it earlier than 4 months from the application's filing date?

As all five assessments need to be made, it would be clearer to present these at the outset, rather than requiring Applicant to analyze from right to left. The Applicant can then answer each of the questions and work forward.

We also enquire whether it would be possible to simplify the tree by providing that if the corrected priority date is earlier than the submitted filing date, you use the corrected filing date, while if the submitted priority date is earlier you use that date and then answer the three questions to determine the deadline?

Abandonment / Reinstatement and Deemed Expiry / Reversal of Deemed Expiry

First, we note that current MOPOP chapter 20, relating to abandonment/reinstatement, includes a specific section on withdrawal. Will that topic be included in the revised MOPOP?

3.0 Reinstatement of abandoned patent applications

For greater clarity, we propose that an additional bullet could be added to section 3.0, as follows:

Where reinstatement requires a determination of due care (see section 3.1, below), a statement must be provided of the reasons for failure which led to the abandonment.

We propose the following minor amendments in sections 3.1, 3.2 and 4.0:

3.1: *"Therefore, any request ~~of~~ for reinstatement..."*

3.2:

) *Example 1: "...requires a response within four months ~~therefore the~~. Therefore the time limit..." and "A If a response is not provided by May 15, the application is deemed abandoned..."*

) *Example 2: "~~The~~ If the maintenance fee is not paid by February 28 (or February 29 in a leap year) ~~and therefore,~~ the application is deemed abandoned ..."*

-) *Example 3: “A Commissioner’s notice is sent under section 68 of the Rules requiring ...” and “A If a response is not provided by the applicant by June 30, the application is deemed abandoned”*

4.0: “...a notice to the patentee stating ~~at~~ that the...”

Due Care

We appreciate that this concept is a new addition to Canadian reinstatement practice. The draft proposal raises additional questions, as follows:

-) Why is there a distinction between human error by a clerk, vs. the agent/applicant?
-) Is unexpected illness broad enough to cover mental illness - which may not be unexpected or sudden, as implied by the guidance?
-) If an applicant/patentee retains a third party who is not an agent or a patent firm to pay a maintenance fee:
 - What does the applicant/patentee have to establish regarding due care in such a case, given that different parties (applicant/patentee, agent, third party) are potentially connected with different aspects of handling the application?
 - If the applicant/patentee retains a third party to handle maintenance fees, can a showing of the agent’s due care be omitted, since the agent was not retained to pay the maintenance fee?
-) Could the guidance explicitly state that the agent’s due care is discharged on a showing that a late fee notice was forwarded within a reasonable period of time to the usual contact address for the applicant/patentee?

Given the potential grave consequences regarding this new reinstatement practice, and again, the spirit of the amended *Act* and *Rules* to better safeguard Applicants’ rights, it would be helpful to Applicants if the due care standard was applied in such a way as to cover various situations.

We otherwise note a minor typographical error in the first sub-heading below the header “Contents of the request”:

Reinstatement of a Patent Application that is ~~abandonment~~ abandoned due to a failure to pay a maintenance fee and a late fee

Conclusion

To summarize, the spirit and scope of the guidance provided to Applicants by the proposed expanded/modified MOPOP sections will be appreciated by Applicants/Patentees and Patent Agents acting on their behalf, particularly in view of the numerous changes and new additions to Canadian practice being implemented by the amendments to the *Act* and *Rules*. We also welcome any opportunity for further consultation in this regard.

FICPI Canada wishes to thank CIPO for the opportunity to provide these comments and invites CIPO to contact the undersigned should it have questions about them.

Yours truly,

FICPI Canada

per Coleen Morrison, President
and Serge Shahinian, Secretary