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In this issue: AMENDMENTS TO CANADIAN PATENT RULES

Amendments to the Patent Rules came into force on 2 June 2007. One initiative in amending the Patent Rules was to continue to encourage small entities (i.e., entities employing 50 or fewer employees or a university) to use the patent system while providing a relief mechanism for those who mistakenly pay fees at the small-entity level. The three most important Rules amendments deal with (a) the small entity regime; (b) the harmonization of the Canadian standard for describing sequence listings with the PCT standard; and (c) the type of evidence required when the applicant is not the inventor.

a) Small-entity rules

Under the new Rules, “small entity” in respect of an invention, means an entity that employs 50 or fewer employees or that is a university, but does not include an entity that

- (i) is controlled directly or indirectly by an entity, other than a university, that employs more than 50 employees; or
- (ii) has transferred or licensed or has an obligation, other than a contingent obligation, to transfer or license any right in the invention to an entity, other than a university, that employs more than 50 employees.

The entity status is determined as of the filing of the application, or in the case of the Canadian national phase of a PCT case, the date of national entry.

In order to take advantage of the small entity regime, an applicant must file a small-entity declaration containing a statement to the effect that the applicant or patentee believes that it is entitled to pay fees at the small-entity level in respect of the application or patent. The small-entity declaration may be filed as part of the petition, or as part of the national-phase entry form, or as a separate document. Normally our firm will execute the petition or national-phase entry form on behalf of an applicant, so a pre-filing instruction to us that the applicant qualifies for small-entity status under the Canadian test will enable us to include the small-entity declaration in the filing documents.

If a person pays the small-entity filing fee or other fee, but the applicant or patentee later becomes aware that the standard (large-entity) fee should have been paid, the Commissioner is authorized to grant an extension of time within which to remedy the deficiency if the Commissioner is satisfied that the circumstances justify the extension. The extension may be authorized if

- (a) the applicant or patentee files a statement that, to the best of its knowledge, the small-entity

fee was paid in good faith and the subject application for the extension is being filed without undue delay after the applicant or patentee became aware that the standard (large-entity) fee should have been paid;

(b) the applicant or patentee pays the difference between the amount of the small entity fee that was paid and the standard fee; and

(c) the applicant or patentee pays the requisite government fee for requesting an extension of time. This fee is \$200 at the present time.

b) Sequence Listings

Prior to the present Rules amendments, the Patent Office required a format for describing a nucleotide or amino acid sequence that was different from the sequence-listing format required under the PCT. The current amendments bring the Canadian format for submitting sequence listings in line with the PCT standard by referencing the latter in the *Patent Rules*.

Further, the requirement for submitting a paper copy of the sequence listing is eliminated. The applicant need only provide a sequence listing in electronic form complying with the PCT sequence-listing standard format.

c) Evidence Required When Applicant Is Not the Inventor

An applicant for a patent in Canada must file evidence that the applicant is entitled to apply for and be granted a patent. Formerly, the applicant was required to provide evidence such as assignments, affidavits or statutory declarations and pay the prescribed fee to register such legal documents with the Patent Office. Under the amended Rules, the requirement to provide such evidence is replaced by a requirement to provide the information by way of a simple declaration either in the petition or in a separate form. The declaration is applicable only to those events, such as assignment, merger, acquisition, inheritance, donation, etc., that have occurred before the filing date. The applicant must specify the kind of transfer that has occurred and the date of that transfer. A copy of the transfer document need not be provided as long as the transfer occurred before the filing date.

With regard to the foregoing, please note that the rule is a Patent Office procedural rule only. If a patent is at any time litigated, the patentee may be required to prove its title by furnishing documentary evidence. So we recommend that care be taken (i) to ensure that all applicable documents either have been prepared for Canada or clearly cover Canadian rights; and (ii) to preserve such documents for possible future use.

Transfers occurring after the filing date are treated by the Patent Office in the same way as previously. The applicant is required to provide evidence of the complete chain-of-title such as duly executed and witnessed assignment documentation, certificate from the corporate registry evincing the name change or merger, etc. Such documentary evidence must be forwarded to the Patent Office, and the prescribed recordal fee must be paid.



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