



Chapter 3 The Application Process

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The Three Prerequisites

To get a patent, you need three things:

1. An [The Applicant](#), and in most cases, a [Patent Agent](#) (someone acting on behalf of the Applicant).
2. An [Invention](#), as described in an Application.
3. [Money](#), to pay the person who prepares the patent application and the Government.

3.1 The Inventor/Applicant

3.1.1 The Applicant

The person or persons applying for the issuance of a patent is the "Applicant". You cannot be an Applicant for a patent unless you are the inventor, or have obtained title to the invention from the inventor.¹ The definition of "Applicant" includes an inventor and the legal representatives of an applicant or inventor".²

3.1.1.1 The Inventor

Ironically, the term "inventor" is not defined in the [Patent Act](#).

From the definition of "invention" in s. 2, we infer that the inventor is the person or persons who conceived of the "new and useful" art, process, machine, manufacture or composition of matter, or any "new and useful" improvement thereto.³ The ultimate question must therefore be: who is responsible for the inventive concept?⁴ In the case of a combination, the question is not who contributed what elements to the combination, but rather, who was responsible for the combination.⁵

¹ [Patent Act s. 27](#)

² [Patent Act s. 2](#)

³ *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] 4 S.C.R. 153, 2002 SCC 77 (S.C.C. per Binnie J.) at para. 96.

⁴ *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] 4 S.C.R. 153, 2002 SCC 77 (S.C.C. per Binnie J.) at para. 96.

⁵ *Henry Brothers (Magherafelt) Ltd. v. Ministry of Defence and the Northern Ireland Office*, [1997] R.P.C. 693 (Pat. Ct. per Jacob J.), at p. 706 quoted in *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] 4 S.C.R. 153, 2002 SCC 77 (S.C.C. per Binnie J.) at para. 98.

In order for there to be an inventor, there must be an invention. Since the patent specification when filed as part of the patent application must “correctly and fully describe the invention . . . to enable any person skilled in the art or science to which it appertains . . . to . . . use it”,⁶ it is not enough to have a good idea (or, as was said in *Christiani*,⁷ “for a man to say that an idea floated through his brain”); the ingenious idea must be “reduced . . . to a definite and practical shape”.⁸

An inventor is that person (or those persons) whose conception or discovery gives rise to the invention for which a patent is sought. A person who does not conceive the idea or discover the thing is not an inventor.⁹

For a person to be considered an inventor, the invention must have originated in the inventor's own mind.¹⁰ A true inventor “must not have borrowed it [the idea] from anyone else.”¹¹

The inventor is the person who provides the inventive ingenuity, not the person who merely provides the impetus for the development of a solution.¹² By merely putting forward an idea, or suggestion, in terms of an objective or an end result, one has not thereby invented anything which is necessarily validly patentable.¹³

3.1.1.2 Merely carrying out implementation or testing

If a person merely verifies another's previous predictions, the person is not an inventor.¹⁴

⁶ *Patent Act*, [s. 34\(1\)](#).

⁷ *Christiani & Nielsen v. Rice* [1930] S.C.R. 443 (S.C.C.) at p. 454.

⁸ *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] 4 S.C.R. 153, 2002 SCC 77 (S.C.C. per Binnie J.) at para. 97.

⁹ *Apotex Inc. v. Wellcome Foundation Ltd.* (2000) 10 C.P.R. (4th) 65 (F.C.A. per Sexton J.A., Rothstein and Malone JJ.A.) at para. 33.

¹⁰ *Apotex Inc. v. Wellcome Foundation Ltd.* (2000) 10 C.P.R. (4th) 65 (F.C.A. per Sexton J.A., Rothstein and Malone JJ.A.) at para. 33 quoting Robert B. Frost's textbook *Treatise on the Law and Practice Relating to Letters Patent for Inventions*, Vol. 1, 4th ed. (London: Stevens and Haynes, 1912): “a person will not be considered the true and first inventor if he himself did not make the invention, or if the idea of it did not originate in his own mind.”

¹¹ *Gerrard Wire Tying Machine Co. v. The Cary Mfg. Co.* [1926] Ex. C.R. 170 (Ex. Ct. per Maclean P.) quoted in *Apotex Inc. v. Wellcome Foundation Ltd.* (2000) 10 C.P.R. (4th) 65 (F.C.A. per Sexton J.A., Rothstein and Malone JJ.A.) at para. 33.

¹² *671905 Alberta Inc. et al v. Q'Max Solutions Inc.*, 2001 FCT 888 (F.C. per Gibson J.) at paras. 23-25, aff'd 2003 FCA 241 (F.C.A. per Stone J.A., Noël & Sexton JJ.A. concurring).

¹³ *Comstock Canada v. Electec Limited* (1991) 38 C.P.R. (3d) 29 (F.C.T.D. per Muldoon J.) at para. 71.

¹⁴ *Apotex Inc. v. Wellcome Foundation Ltd.* (2000) 10 C.P.R. (4th) 65 (F.C.A. per Sexton J.A., Rothstein and Malone JJ.A.) at [para. 33](#) citing *Re May & Baker Ltd. and Ciba Ltd.* (1948), 65 R.P.C. 255 (High Court per Jenkins J.) at [p. 281](#).

Where a concept is fully formed and/or soundly predicted, the verification of that sound prediction by testing does not entitle those who do the tests to be considered to be inventors. The owners of a patent on an invention for testing do not, by virtue of executing tests using that invention, become co-inventors of every sound idea that is so tested.¹⁵

In the steps leading from conception to patentability, the inventor(s) may utilize the services of others, who may be highly skilled, but those others will not be co-inventors unless they participated in the conception as opposed to (merely) its verification. As Jenkins J. noted in *May & Baker Ltd. v. Ciba Ltd.*, the requisite “useful qualities” of an invention, “must be the inventor’s own discovery as opposed to mere verification by him of previous predictions”.¹⁶

People who only carry out what they were instructed to do by others, are not inventors. When determining inventorship, the inventors are the people who came up with the invention; the tradespeople who machined it, or the technician who first operated it, are not inventors. For example, corn flakes cereal was invented by scientists and engineers at Kelloggs and not by the technicians who first operated the machine that made corn flakes, following the designer’s instructions.¹⁷

3.1.1.3 Effect of naming the wrong inventor

Section 53(1) provides:

“A patent is void if any material allegation in the petition of the applicant in respect of the patent is untrue, or if the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, and the omission or addition is wilfully made for the purpose of misleading.”

The section would appear to have two parts:

A patent is void:

1. if any material allegation in the petition of the applicant in respect of the patent is untrue, or

¹⁵ *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] 4 S.C.R. 153, 2002 SCC 77 (S.C.C. per Binnie J.) at paras. 100-102.

¹⁶ (1948), 65 R.P.C. 255 (Ch. D.), at p. 281.

¹⁷ *Kellogg Company v. Helen L. Kellogg*, [1942] Ex. C.R. 87, at p. 97 related to whether Kellogg Jr. was an inventor. He operated the machine designed by others [at p. 97]:

“His [Kellogg Jr.’s] operation of the gun with Swartz, which they were directed to do, was purely a mechanical act, with an instrumentality purchased by the Kellogg company to do the very thing that was done by it. It seems to me utterly untenable to say that this of itself was invention, or was an element contributed by Kellogg Jr. in making the invention. It might well have happened that Kellogg Jr. would have been off duty at the important lunch hour in question here and replaced by some other of the Experimental Department staff, and there would not seem to be any reason why any one else could not have achieved the same result with the same gun. I can conceive of no ground whatever for suggesting that anything Kellogg Jr. did had any of the elements of invention in it.”

2. if the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, and the omission or addition is wilfully made for the purpose of misleading.

The plain reading of the section would lead one to conclude that the material allegation in the petition need merely be untrue for the patent to be void and there be no need that it was made "wilfully made for the purpose of misleading" and the earlier case law held so.¹⁸

Nevertheless, Canadian courts have most recently held that:

1. The allegation must be "material", and the mis-naming of inventors in the petition may not be not "material"; and

Thurlow J. had suggested in *Gilbert v. Sandoz*¹⁹ that "allegations in the petition respecting anything other than the subject-matter of the claims in the patent as granted are not material". In the context of leaving out a co-inventor, in *Procter & Gamble v. Bristol-Myers*, Addy J. said that "it is really immaterial to the public whether the applicant is the inventor or one of two joint inventors as this does not got [sic] to the term or to the substance of the invention nor even to the entitlement".²⁰

In the AZT case, Justice Binnie cautioned that it may be that the identity of the inventor is immaterial to the public in most instances, but that this is not necessarily true in all cases.²¹

2. The allegation must have been made "wilfully made for the purpose of misleading".²²

In the AZT case, although the court found that Drs. Broder and Mitsuya were not co-inventors of the patent at issue, Justice Binnie stated at para. 109 that there

¹⁸ As is the case for the second part of s. 53(1) with respect to "the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made". See *Beloit Canada Ltd. v. Valmet Oy* (1984), 78 C.P.R. (2d) 1 (F.C.T.D per Walsh J.)

¹⁹ *Jules R. Gilbert Ltd. v. Sandoz Patents Ltd.* (1970), 64 C.P.R. 14 (Ex. Ct.), at p. 74, rev'd (on other grounds) [1974] S.C.R. 1336 (sub nom. *Sandoz Patents Ltd. v. Gilcross Ltd.*).

²⁰ *Procter & Gamble Co. v. Bristol-Myers Canada Ltd.* (1978), 39 C.P.R. (2d) 145 (F.C.T.D. per Addy J.) at p. 157; aff'd (1979), 42 C.P.R. (2d) 33 (F.C.A.). See also *Comstock Canada v. Electec Limited* (1991) 38 C.P.R. (3d) 29 (F.C.T.D. per Muldoon J.) at para. 70.

²¹ *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] 4 S.C.R. 153, 2002 SCC 77 (S.C.C. per Binnie J.) at para. 108:

"If indeed the NIH researchers had been "co-inventors", and the NIH or the U.S. government had therefore held an ownership interest in the patent, there potentially could have been a significant effect on both the access to and the cost of the drug AZT across the world."

²² *Apotex Inc. v. Wellcome Foundation Ltd.* [2002] 4 S.C.R. 153, 2002 SCC 77 (S.C.C. per Binnie J.)

was no need to consider the issue of materiality further because there was "... no evidence whatsoever that the omission to name them was "wilfully made for the purpose of misleading", words found at the end of s. 53(1)."²³ Thus the highest court in the land appears to have held, indirectly in *obiter*, that wilfulness is necessary to meet the first part of s. 53(1).

In *Q'Max*, the Federal Court of Appeal held that "...the position today is that an untrue "material allegation" that consists of a failure to name co-inventors in a petition for a patent will not render the patent void if the allegation was not "wilfully made for the purpose of misleading".²⁴ In *Q'Max*, where two non-inventors were named as inventors and the true inventor was not named, but where there was no evidence that the mis-naming was done wilfully for the purpose of misleading, the patent was not held to be void under s. 53(1).²⁵

3.1.1.4 Remedies for mis-naming inventors

Where the principal dispute between two parties is which of them is the true inventor of the invention disclosed in an issued patent, the Court, in making those findings of fact and law, may grant any appropriate remedy including:

1. a declaration of invalidity under the patent legislation;²⁶
2. a declaration of inventorship and ownership; or
3. any other appropriate remedy known to the common law or equity.²⁷

The Federal Court has jurisdiction pursuant to s. 52 [formerly 54] of the *Patent Act*,²⁸ to order that any entry in the records of the Patent Office relating to the title to a patent be varied so as

²³ *Apotex Inc. v Wellcome Foundation Ltd.* 2002 SCC 77, 21 C.P.R. (4th) 499 (S.C.C. per Binnie, J.) at para. 94:

"The appellants contend that Drs. Broder and Mitsuya were "co-inventors" and ought to have been so identified in the patent. For this argument to benefit the appellants (as opposed to Drs. Broder and Mitsuya), the appellants must further establish that this omission was a "material" misstatement that was "wilfully made for the purpose of misleading". If so, the patent would be void pursuant to s. 53(1) of the Patent Act."

²⁴ *671905 Alberta Inc. et al v. Q'Max Solutions Inc.*, 2003 FCA 241 (F.C.A per Stone J.A., Noël and Sexton JJ.A. concurring) at para. 31.

²⁵ See also *Dec International, Inc. v. A.L. LaCombe & Associates Ltd.* (1989), 26 C.P.R. (3d) 193 (F.C.T.D.), where it was held that a patent should not be declared invalid where the corporate employer, in good faith, named an employee who was found at trial not to be the inventor rather than the employee who was the true inventor. This case was referred to in *Q'Max* at para. 31

²⁶ As discussed in the immediately preceding section of the Chapter, post-AZT, this may no longer be the case unless the mis-naming was done wilfully for the purpose of misleading.

²⁷ *McCracken and Concrete Pipe Ltd. v. Watson*, [1932] Ex. C.R. 83 at 88 cited in *Comstock Canada v. Electec Limited* (1991) 38 C.P.R. (3d) 29 (F.C.T.D. per Muldoon J.) at para. 63.

²⁸ R.S.C. 1988, Chap. P-4.

to name the proper inventor and owner. The section confers very wide powers on the Court to rectify the Patent Office's records.²⁹

In *Comstock*,³⁰ it was declared that Gordon Douglas Hyde was the sole inventor of the invention entitled "Modular Interconnecting Wiring System With Moulded Mating Components" and that Electec Limited was the exclusive owner thereof. The successful party had claimed in the alternative: for an order directing that patent 1,219,307 be varied as a consequence of the above stated declaration, or alternatively, that the said patent be declared invalid and void, "as the Plaintiffs [Electec and Hyde] may later elect". The Court allowed the successful party to make an election.³¹

3.1.2 **Legal representatives**

"[Legal representatives](#)", as defined in s. 2 of the *Patent Act*, includes:

"heirs, executors, administrators, guardians, curators, tutors, assigns and all other persons claiming through or under applicants...".

The patent will be granted to the inventor, or to the assignee or testator of the inventor.³²

In the United States, only the inventors can apply for a patent.

Depending on the facts, the Applicant may be:

- the inventor
- joint inventors
- the company who employed the inventor

See also:

- adding or subtracting applicants
- Patent Assignments
- Patent Agents

²⁹ *Pitney Bowes Inc. v. Yale Security (Canada) Inc.*, February 24, 1987 (T-2100-86 unreported); *Clopay Corporation and Canadian General Tower Limited v. Metalix Limited*, (1980) 20 Fox P.C. 110 (Ex. Ct.) cited in *Comstock Canada v. Electec Limited* (1991) 38 C.P.R. (3d) 29 (F.C.T.D. per Muldoon J.) at para. 64.

³⁰ *Comstock Canada v. Electec Limited* (1991) 38 C.P.R. (3d) 29 (F.C.T.D. per Muldoon J.) at para. 98.

³¹ Note however that this case preceded the AZT case and the patent may not be invalid as a result of mis-naming inventors.

³² [Patent Act s.49](#)

- Small entity

3.1.3 Patent Assignments

Patent applications can be assigned or bequeathed, in whole or in part.³³ Once assigned, the application cannot be withdrawn without the permission of the assignee.³⁴

Patents can be assigned in law, in whole or in part, by a written document (*Patent Act* s. 50(1)). The co-owner of a patent cannot divide his part ownership into two or more parts without the concurrence of all owners of the patent (*Forget v. Specialty Tools*).

Every assignment, of a patent³⁵ or patent application³⁶, must have an affidavit of a subscribing witness or other proof that the assignment was executed by the assignor and everyone else who signed it.³⁷

The inventor can assign the invention, but for the assignment to have any effect on a patent application or patent, the assignment must be filed in the Patent Office.³⁸

There is something like a "first-to-file" system for assignments. If the rights to a patent are assigned (or if an exclusive licence is granted - something analogous to an assignment), the assignment (or exclusive licence) must be filed in the Patent Office.³⁹ If there are two assignments affecting a patent, it is the first assignment to be filed in the Patent Office that governs.⁴⁰

In the United States, where the Applicant is always the inventor(s), if the rights to the invention have been assigned to someone else, the patent will issue to the assignee.

The Federal Court of Canada has jurisdiction to change the records of the Patent Office respecting title to a patent to vary or expunge an entry.⁴¹

³³ *Patent Act* [s. 49\(1\)](#) & [s. 49\(2\)](#)

³⁴ *Patent Act* [s. 49\(2\)](#)

³⁵ *Patent Act* [s. 50\(1\)](#)

³⁶ *Patent Act* [s. 49\(3\)](#)

³⁷ *Patent Act* [s. 49\(3\)](#) & [50\(3\)](#)

³⁸ *Patent Act* [s. 50\(2\)](#), [51](#)

³⁹ *Patent Act* [s. 50\(2\)](#)

⁴⁰ *Patent Act* [s. 51](#)

⁴¹ *Patent Act* [s. 52](#)

3.1.4 Patent Agents

Communications with the Patent Office are addressed to the Commissioner of Patents⁴² and, for the purpose of prosecuting or maintaining an application, are communicated to and received from, the authorized correspondent.⁴³

3.1.4.1 General

A patent application is usually prosecuted by a registered Patent Agent.

Any act by a Patent Agent has the same effect as an act by the Applicant.

The only exception is where the inventor owns the invention, in which case, he or she can prosecute the application by him or herself.

3.1.4.2 The Patent Agent

Where the Applicant is not an Inventor, the Applicant must appoint a Patent Agent to prosecute the application.⁴⁴

A Patent Agent is appointed either in the Petition or by separate Notice signed by the Applicant.⁴⁵ Ironically, a Patent Agent can be self-appointing where the appointment is made in a Petition.⁴⁶ The Commissioner shall require an Applicant who is not the Inventor to execute and file an Appointment of a Patent Agent or an Associate Patent Agent within three months of issuing a Notice that the appointment be made.⁴⁷

Any revocation or appointment of another Patent Agent may be done by the Applicant or the existing Patent Agent.⁴⁸

3.1.4.3 Authorized Correspondent

The Authorized Correspondent is usually the Patent Agent⁴⁹ but in some cases can be one or more of the inventors.⁵⁰

⁴² [Patent Rules 5\(1\)](#)

⁴³ [Patent Rules 6\(1\)](#)

⁴⁴ *Patent Rules*, s. 20(1)

⁴⁵ *Patent Rules*, s. 20(2)

⁴⁶ *Patent Rules*, s. 6(2) & 20(2)

⁴⁷ *Patent Rules*, s. 23

⁴⁸ *Patent Rules*, s. 6(2) & 20(3)

⁴⁹ *Patent Rules*, s. 2(c)

⁵⁰ *Patent Rules*, s. 2(a)

If the application was filed by the Inventor, and the transfer of the rights to the invention has not been registered in the Patent Office, and no Patent Agent has been appointed, the sole inventor, or one or more of the inventors authorized by all inventors to act on their behalf can be the Authorized Correspondent. In the case of a national phase PCT application, where there are two or more Applicants, and where no Inventor has been authorized, the first named Inventor in the International Application becomes the "authorized correspondent".

The Authorized Correspondent can be the Associate Agent where one has been appointed or has to be appointed.⁵¹

3.1.4.4 Associate Patent Agent

If the Patent Agent prosecuting the application does not reside in Canada, the Patent Agent must appoint an Associate Agent who resides in Canada.⁵²

The Applicant's Patent Agent, if residing in Canada, can appoint an Associate Patent Agent who may prosecute the application.⁵³

Any act by an Associate Patent Agent has the same effect as an act by the Applicant⁵⁴.

The Associate Patent Agent is appointed either in the Petition or in a Notice signed by the Patent Agent who appointed the Associate Patent Agent.⁵⁵

The appointment of the Associate Patent Agent may be revoked by a Notice signed by the Associate Patent Agent or by the Patent Agent who appointed the Associate Patent Agent.⁵⁶

3.1.4.5 Representative

An Applicant who does not reside in Canada or carry on business at a specified address in Canada, must nominate a Representative residing or carrying on business at a specified address in Canada.⁵⁷ The Representative is the representative for all purposes under the *Patent Act* including: the service of any proceedings, of the Applicant and of any foreign patentee.⁵⁸ For example, if someone wants to impeach an issued patent, they can serve the patentee by service of the originating documents on the Representative.

⁵¹ *Patent Rules*, s. 2, 21

⁵² *Patent Rules*, s. 21(1)

⁵³ *Patent Rules*, s. 21(2)

⁵⁴ *Patent Rules*, s. 22

⁵⁵ *Patent Rules*, s. 21(3)

⁵⁶ *Patent Rules*, s. 21(3)

⁵⁷ [Patent Act s. 29\(1\)](#)

⁵⁸ [Patent Act s. 29\(2\)](#)

The Applicant or patentee can appoint a new representative by providing a letter to the Commissioner of Patents.⁵⁹

3.1.5 Small entity

3.1.5.1 Patent Rules, s. 2

For patent applications filed on or after October 1, 1996, a "[small entity](#)" is either:

- an entity with 50 or fewer employees;
- or a university;

so long as it has not, directly or indirectly: transferred; licensed; or contracted with or is otherwise legally obliged to transfer or license; to an entity having more than 50 employees (other than a university).⁶⁰

3.1.5.2 Comments

An Applicant cannot use a [small entity](#) as a "front" for a large entity to avoid paying large entity fees.

Universities receive special treatment: they are by definition, small entities, unless they have assigned or licensed the invention to a large entity.

3.2 The Invention/Application

3.2.1 The Timing of Filing a Patent Application

You are too late to apply for a patent in Canada if :

1. **You waited more than a year to apply after you and your disclosees made the invention available to the public in Canada or elsewhere,**⁶¹ or
2. **Someone else made it public before your [claim date](#).** "Claim date" means the date of a claim in an application for a patent in Canada, as determined in accordance with [section 28.1](#). [[Patent Act, s. 2](#)]. Generally, it is first filing date for the claim anywhere. It became "available to the public in Canada or elsewhere";⁶² or
3. **They filed first.** In other words:

⁵⁹ [Patent Act s. 29\(3\)](#)

⁶⁰ *Patent Rules*, s. 2(a) "small entity"

⁶¹ [Patent Act, s. 28.2\(1\)\(a\)](#)

⁶² [Patent Act, s. 28.2\(1\)\(b\)](#)

someone else filed a patent application in Canada for the same invention that has a filing date before your [claim date](#).^{63 64} or

someone else filed in Canada after you did, but filed an application for the same invention in Canada or in another country before your [claim date](#), and filed the new application in Canada within a year of the earlier filing and made a priority request in respect of the other application. In other words - they filed for the invention first.^{65 66}

3.2.2 *The Paris Convention*

Canada is a signatory of the International Convention for the Protection of Industrial Property ("the **Paris Convention**"), a union with many other countries.

A national (citizen or company resident in one of the Union member countries) who applies for a patent in one Union member country, can wait up to a year to file applications in other member countries and can rely on the first application date (**the priority date**) to effectively backdate the later filed applications to the first filing date.

For example, if you are a Canadian, and you filed your first application in Canada on December 1, 1997, then you can file applications in other convention countries on or before December 1, 1998, claim the benefit of **convention priority**, and your application is entitled to be treated as if it had been filed in those other countries on the date you filed the application in Canada. In our **first-to-file** system, the entitlement to obtain a patent is based upon [claim dates](#), where they exist.^{67 68}

You must claim the benefit of convention priority by requesting priority⁶⁹ within four months of filing your application.^{70 71}

⁶³ Generally, the date of a claim in an application for a patent in Canada (the "pending application") is the filing date of the application [[Patent Act, s. 28.1](#)].

⁶⁴ [Patent Act, s. 28.2\(1\)\(c\)](#)

⁶⁵ If however, there is a previously regularly filed application for the same invention in Canada [[Patent Act, s. 28.1\(a\)\(i\)](#)] or in another country from where a priority claim may be made for a Canadian application [[Patent Act, s. 28.1\(a\)\(ii\)](#)] and the previously filed application was filed less than 12 months before the current application [[Patent Act, s. 28.1\(b\)](#)] and a request for priority has been claimed [[Patent Act, s. 28.1\(c\)](#)], then the [claim date](#) is the filing date of the previously regularly filed application [[Patent Act, s. 28.1\(2\)](#)].

⁶⁶ [Patent Act, s. 28.2\(1\)\(d\)](#)

⁶⁷ The convention priority date **is** taken into account with respect to **prior public disclosure** by **third parties** [[Patent Act, s. 28.2\(1\)\(b\)](#)]. In other words, you must get a patent application on file *somewhere*, before other inventors make the invention public.

⁶⁸ [Patent Act, s. 28.1](#)

⁶⁹ [Patent Act, s. 28.4\(2\)](#)

The Patent Office may require an Applicant to file a certified copy of the foreign application upon which convention priority is claimed.⁷²

3.2.3 *Preparing and Filing a Patent Application*

The **invention** is described and claimed in a **patent application**, which looks like the patent that the Applicant wishes to have issued.

The patent application is accompanied by documentation requesting the grant of a patent (called the Petition) and evidencing the authority of the person applying for the patent.

3.2.4 *Preparing the Application*

In the usual course of things, a patent agent has his or her client help write the patent application by answering questions which give flesh to the "skeleton" of the patent application.

3.2.5 *Inventor's Questionnaire*

Have the inventor provide answers to the following information:

1. A brief description of the problem which the invention is intended to solve;
2. A brief description of previous approaches to solving the problem;
3. A brief description of the disadvantages and shortcomings of the previous approaches;
4. A brief description of the aspects of the invention which solve the problem and overcome the disadvantages and shortcomings of the previous approaches;
5. A **detailed** description of the invention, including the operation, construction and use of the invention, with reference to drawings, schematic diagrams, etc.;
6. A brief discussion of other embodiments of the invention.

Since the patent application will be tailored to include as much as possible beyond what exists in the prior art, the Patent Agent must have a good idea of the state of the prior art.

⁷⁰ The convention priority date is **not** taken into account with respect to **prior public disclosure** by the **inventor or his disclosees** [[Patent Act, s. 28.2\(1\)\(a\)](#)]. In other words, you must get your patent application on file *in Canada*, within one year from making your invention available to the public.

⁷¹ *Patent Rules*, s. 88(1)(b)

⁷² *Patent Rules*, s. 89

3.2.6 Patentability Searches

Usually a search is done in the Canadian or U.S. Patent Office to find relevant prior art in the area.

Manual searches can be conducted within Patent Offices or they can be done on computer either from commercial services or free on the Internet:

- Canadian patents are available online at the [Canadian Patents Database](#);
- American patents are available from the [US Patent and Trademark Office](#).

After the search is done, the Patent Agent gives the client an idea of the scope of protection likely available since the patentability search mimics the search that will be done later by the Examiner of the Patent Office, during the prosecution stage (See below).

Section 27 of the *Patent Act* sets out the requirements for the disclosure and the claims:

27. (3) The specification of an invention must:

- (a) correctly and fully describe the invention and its operation or use as contemplated by the inventor;
- (b) set out clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most closely connected, to make, construct, compound or use it;
- (c) in the case of a machine, explain the principle of the machine and the best mode in which the inventor has contemplated the application of that principle; and
- (d) in the case of a process, explain the necessary sequence, if any, of the various steps, so as to distinguish the invention from other inventions.

27. (4) The specification must end with a claim or claims defining distinctly and in explicit terms the subject-matter of the invention for which an exclusive privilege or property is claimed.

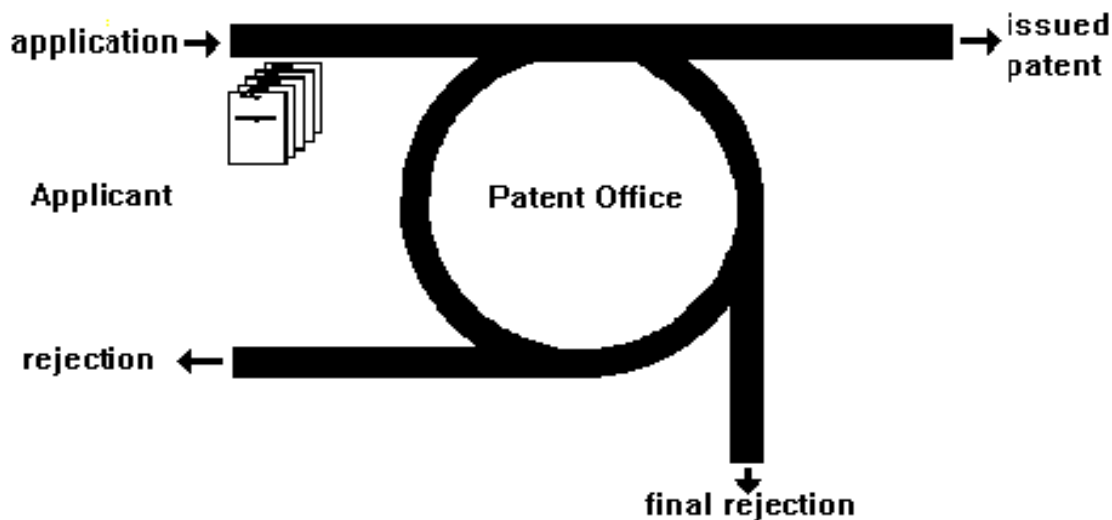
The patent application itself must meet certain prescribed standards of format.⁷³

⁷³

Patent Rules, s. 68 ff

3.2.7 *Filing the Application*

A model for the application process is a circular path: the applicant submits the application in the form in which it is desired that the patent be issued; the application is examined and compared to the prior art, and the application is either rejected and required to be amended and returned to the applicant, allowed or finally rejected.



For patent applications filed on or after October 1, 1996, in order to obtain a filing date for a patent application (other than a PCT National Phase application), the Patent Office must receive [Patent Rule 93]:

- an indication in English or French that the grant of a Canadian patent is sought.
- the name of the Applicant.
- the address of the Applicant or the Applicant's patent agent
- a document in English or French that appears to describe an invention, and
- the application fee (\$150 for a [small entity](#); \$300 for a large entity).⁷⁴

Note that claims are no longer required, nor a petition.

3.2.8 *A Complete Application*

To file a **complete** patent application, you need the following⁷⁵:

⁷⁴ [Patent Rules, Schedule II, Part I, Item 1](#)

⁷⁵ *Patent Rules*, s. 94(1)

1. Documentation requesting the grant of a patent and establishing the identity of the Applicant(s) and that the person filing the application has the authority to do so.

A **Petition**⁷⁶ which identifies:

the name of the Applicant

the name(s) and address(es) of the Inventor(s)

whether the Applicant is a [small](#) or large entity.

A request for priority (if applicable)⁷⁷

An appointment of a [Representative](#), where the Applicant does not reside or carry on business in Canada.⁷⁸

An appointment of a [Patent Agent](#) (if needed).

An appointment of an Associate Agent (if needed).⁷⁹

An [assignment](#) or other documentation where the applicant is not the inventor, to prove that the Applicant is the legal representative of the Inventor.

A "[small entity](#)" declaration, if applicable

2. A specification (including claims, drawings (if referred to in the Description) and an Abstract.
3. The filing fee (\$150 for a [small entity](#); \$300 for others).

A patent application must be completed (and all the documents must comply with the Rules) within 15 months from its priority or filing date or else it is deemed to have been abandoned.⁸⁰ If it goes [abandoned](#), it may be [reinstated](#) within 12 months by making a request for reinstatement to the Commissioner, completing the application, and paying the fee set out in Item 7 of Schedule II (\$200.00)⁸¹.

⁷⁶ [Form 3](#) Schedule I of the *Patent Rules*

⁷⁷ See [Paris Convention](#)

⁷⁸ [Patent Act, s. 29\(1\)](#)

⁷⁹ [Patent Rules, s. 21](#)

⁸⁰ [Patent Act, s. 73](#) and *Patent Rules* s. 97

⁸¹ *Patent Rules*, s. 98

If any of the documents needed for the application do not comply with the *Rules*, the Patent Office will advise the Applicant of the informality and require the objections to be overcome within 15 months from the date of filing or the priority date. The Applicant will have until the later of three months from the notice and 12 months after the filing to comply⁸² and will have to pay a government fee of \$200.00 (Schedule II, item 8).

3.2.9 Examination of the Patent Application

Examination is the process by which the Patent Office examines the application to determine the patentability of the invention. It is neither free nor automatic.

3.2.9.1 The Request for Examination

Examination is initiated by filing with the Patent Office a Request for Examination together with the necessary fee.⁸³ The government fee for requesting examination is \$200.00 for a [small entity](#); \$400.00 for a large entity.⁸⁴

Examination must be requested within a certain time period:

- for October 1, 1989 to September 30, 1996 filed applications, within seven (7) years of the Canadian filing date.⁸⁵
- for applications filed on or after October 1, 1996, within five (5) years of the Canadian filing date.⁸⁶

or else the application will be treated as abandoned.

If the application was divided from a parent application, examination must be requested within the same time period as the parent application, or within 6 months of filing the divisional, whichever is later.⁸⁷ The Commissioner may notify the Applicant to require the filing of a request for examination.⁸⁸

⁸² [Patent Rules, s. 94\(1\)](#)

⁸³ [Patent Act, s. 35\(1\)](#)

⁸⁴ Tariff of Fees, Schedule II, Part I, item 3

⁸⁵ *Patent Rules*, s. 50

⁸⁶ *Patent Rules*, s. 96

⁸⁷ *Patent Rules*, [s. 150\(2\)](#) and [96\(2\)](#)

⁸⁸ [Patent Act, s. 35\(2\)](#)

The Request for Examination can be made by the Applicant or by any other party and must contain the necessary information for the Patent Office to recognize what application is being requested to be examined.⁸⁹

Where a timely Request is not filed, and the application goes abandoned⁹⁰, the Patent Office may reinstate the application upon Request for Reinstatement, Request for Examination and payment of the prescribed fee of \$200.00.⁹¹

3.2.9.2 The Examination Process

The application is usually referred to Examiners who are familiar with the particular technology of the invention.

The invention described and claimed in the invention is compared by the Examiner in the Patent Office, to the prior art.

The prior art comes from a search done by the Examiner, prior art cited in foreign Patent Offices during examination of corresponding applications and/or documentary materials supplied by anyone to the Patent Office under a Protest.⁹² In the United States, the Applicant has the obligation to disclose relevant prior art to the U.S. Patent Office.

To obtain his or her own prior art, the Examiner reviews patents or patent applications on file in the same or related areas. There is an international classification system for categories of inventions which aids in searching.

There are computerized databases of issued patents and technical and scientific articles which can be searched using "keywords". Caution must be exercised when selecting the appropriate keywords since different words may be used to describe the same kind of invention.

3.2.9.3 Disclosure of Information to the Examiner

An Examiner can formally ask an Applicant to provide copies of prior art cited in foreign corresponding applications.⁹³ Where, for example, the United States Patent Office has already done a prior art search and cited prior art against the corresponding U.S. patent application, the job of the Canadian Examiner is made easier by invoking [Patent Rule s.29](#): the Canadian Examiner gets the benefit of the search done by the U.S. Patent Offices. The Examiner can also ask for particulars of interference proceedings.⁹⁴

⁸⁹ [Patent Rules, s. 149](#) and [95](#)

⁹⁰ [Patent Act, s. 73\(1\)\(d\)](#) and [73\(1\)\(e\)](#)

⁹¹ [Patent Act, s. 73\(3\), Tariff, Schedule II, Part I, item 7](#).

⁹² [Patent Act, s. 34.1](#)

⁹³ [Patent Rules, s. 29](#)

⁹⁴ [Patent Rules, s. 29\(1\)\(c\)](#)

The Examiner can also ask for information concerning the first publication of the invention or the first patent for the invention.⁹⁵ It is usually in the Applicant's interest to report the successful issuance of a corresponding patent as it may encourage the Patent Office to issue a patent of similar scope.

If the Applicant cannot supply the information requested, the Applicant must state why the information is not forthcoming.⁹⁶

3.2.9.4 Advancement of the Application

Normally, an application will proceed along with the other applications, in order of its receipt at the Patent Office.

The queue can be "jumped" by requesting in writing **advanced examination** on the ground that a failure to advance the application will likely prejudice the rights of that person.⁹⁷ Evidence must be supplied setting out the facts upon which the request for advancement is based. A government fee of \$100.00 is charged.⁹⁸

The request for advancement must be preceded by, or accompanied by, a request for examination of the application. The application must be complete, open to public inspection and have met the formalities.⁹⁹

3.2.9.5 The "Requisition"

After reviewing the application, the Examiner may conclude that the Applicant is required under the *Patent Act* or *Patent Rules* to amend the application and will issue a letter to the Applicant setting out the requirements. The letter is referred to as an **Office Action**.¹⁰⁰

⁹⁵ [Patent Rules, s. 29\(2\)](#)].

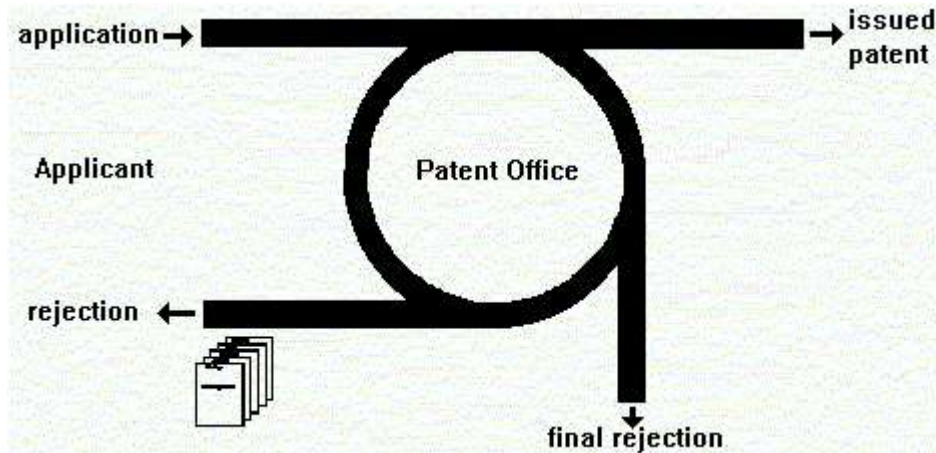
⁹⁶ [Patent Rules, s. 29\(3\)](#)

⁹⁷ [Patent Rules, s. 28](#)

⁹⁸ [Patent Rules, Schedule II, Part I, Item 4.](#)

⁹⁹ *Manual of Patent Office Procedure* ("MPOP"), s. 13.03

¹⁰⁰ [Patent Rules, s. 30\(2\)](#)



3.2.9.6 Responses to Requisitions

Applicants are obliged to reply to an Requisition within 6 months to avoid [abandonment](#) of the application. They must reply in good faith in an attempt to answer the objection to advance the application to allowance.¹⁰¹ This obligation is usually performed by making the change requested by the Examiner or by arguing with the Examiner that the requirement is not necessary and the objection should be withdrawn.

3.2.9.7 Amendments to the Application

a) Introduction

An application may be amended before it issues either voluntarily or to overcome an objection made by an Examiner in a Requisition.¹⁰²

No amendment can be made to the specification that describes matter not reasonably to be inferred from the specification or drawings.¹⁰³

Every amendment must be accompanied by a statement explaining the nature and purpose of the amendment so as to satisfy the Examiner that it is permissible.¹⁰⁴

Amendments must be made by providing new pages replacing those altered by the amendment.¹⁰⁵

¹⁰¹ [Patent Act, s. 73\(1\)\(a\)](#)

¹⁰² [Patent Act, s. 38.2](#)

¹⁰³ [Patent Act, s. 38.2\(2\)](#).

¹⁰⁴ [Patent Rules, s. 34](#).

¹⁰⁵ [Patent Rules, s. 34](#)

b) Adding or Subtracting Applicants

Where there are two or more inventors, and one refuses to assist in the prosecution of the application, or cannot be found, the remaining inventors can proceed without the reluctant or missing inventor. They must satisfy the Commissioner as to the facts, usually by affidavit. The patent will issue to the remaining inventors.¹⁰⁶

The situation is similar where too many Applicants were named. The "superfluous" inventor/Applicant can retire and the application will proceed with the remaining Applicants. Affidavit evidence must be submitted to the Commissioner.¹⁰⁷

Where not enough Applicants were named, the further Applicants can be joined by satisfying the Commissioner that they should be joined and that their omission was due to inadvertence or mistake and not for the purpose of delay.¹⁰⁸

Where joint Applicants cannot agree on how to proceed with an application, or where someone has agreed to assign a patent, when granted, and has not proceeded with the application, the Commissioner can allow the other person to proceed with the application and can grant the patent to that other person.¹⁰⁹

There are no provisions for the replacement of a sole applicant.

c) Amendments to drawings

No amendment can be made to the drawings that adds matter not reasonably to be inferred from the specification or drawings as originally filed, except in so far as it is admitted in the specification that the matter is prior art.¹¹⁰

d) Dividing Subject Matter

A patent is supposed to protect one invention. In Canada, a patent can contain apparatus and method claims. No division is required where a patent application claims:

1. a product and a process for making the product;
2. a product and a use of the product;
3. a product, a process for making the product and a use of the product;
4. a process and an apparatus specially adapted to carry out the process;

¹⁰⁶ [Patent Act, s. 31\(1\)](#)

¹⁰⁷ [Patent Act, s. 31\(3\).](#)

¹⁰⁸ [Patent Act, s. 31\(4\)](#)

¹⁰⁹ [Patent Act, s. 31\(2\)](#)

¹¹⁰ [Patent Act, s. 38.2\(3\)](#)

5. a product, a process for making the product and an apparatus specially adapted to carry out the process; or
6. a product, a process for making the product and an apparatus specially adapted to carry out the process and a use of the product [MPOP, s. 14.02].

In the United States, separate patents are often obtained for devices and methods.

Where a patent application discloses and claims more than one invention, the application must be limited to one invention and the applicant may **divide** out the other invention.

Both the original application and the **divisional application**, share a common filing date, but the Patent Office requires a second set of fees in respect of the divisional application.¹¹¹

3.2.9.8 Adding Subject Matter: Supplementary Disclosures - Pre-October 1, 1989 applications only¹¹²

New matter, which is intimately associated with the matter described in the existing disclosure, can be made the subject of a **Supplementary Disclosure**¹¹³ (so long as the application has not yet been allowed¹¹⁴). Only one supplementary disclosure is allowed per application¹¹⁵

The supplementary disclosure forms part of the patent as issued and is taken as having been filed on the date the amendment was applied for.¹¹⁶

If there are claims in an application that are fully supported only by the supplementary disclosure, then they are identified as such and are separated from other claims in the application.¹¹⁷ There must be other claims supported by the original disclosure.¹¹⁸

3.2.9.9 Amendments after allowance

Amendments (other than clerical errors¹¹⁹) cannot be made after allowance unless:

- the amended application complies with the Act and Rules

¹¹¹ [Patent Act, s. 36\(4\)](#)

¹¹² Pre-Oct. 1, 1989 *Patent Rules*, s. 57.1

¹¹³ Pre Oct.1, 1989 *Patent Rules*, s. 53

¹¹⁴ Pre Oct.1, 1989 *Patent Rules*, s. 55

¹¹⁵ Pre Oct.1, 1989 *Patent Rules*, s. 56

¹¹⁶ Pre Oct.1, 1989 *Patent Rules*, s. 53

¹¹⁷ Pre Oct.1, 1989 *Patent Rules*, s. 54

¹¹⁸ Pre Oct.1, 1989 *Patent Rules*, s. 57

- the amendment does not require a further search by the Examiner; and
- a fee of \$200 is paid.¹¹⁹

3.2.9.10 Laying Open of the Application

The patent application is laid open for public inspection on the earliest of the following dates:

- (a) 18 months from its Canadian filing date;
- (b) 18 months from its priority date (if it has one); or
- (c) earlier when requested by the Applicant.¹²⁰

A request for priority may be withdrawn to create a later laying-open date.

3.2.10 Abandonment and Reinstatement¹²¹

3.2.10.1 Abandonment

Failure to reply in good faith to a requisition by an Examiner within the required time limit also results in abandonment of the application.¹²²

3.2.10.2 Reinstatement

To bring an abandoned patent application back to life, the application must be "reinstated".¹²³

An application is reinstated if, within 12 months of the date the Application was deemed to be abandoned, with respect to the event that triggered the abandonment, the Applicant:

- Makes a Request for Reinstatement to the Commissioner;
- Takes the action that should have been taken to avoid the abandonment; and
- Pays the Reinstatement fee of \$200.¹²⁴

¹¹⁹ [Schedule II, Part I, Item 5 Patent Rules, s. 32](#)

¹²⁰ [Patent Act, s. 10\(2\)](#)

¹²¹ [Patent Act, s. 73](#) *Patent Rules, s. 97, 98 (1996-); 151 [89-96 appns.]*

¹²² [Patent Act, s. 73.1\(a\)](#)

¹²³ [Patent Act s. 73\(3\)](#)

¹²⁴ [Schedule II Part I, Item 7 Patent Act s. 73\(3\)](#)

Affidavits are no longer required.

3.2.10.3 Protests

Third parties can object to the grant of a patent by means of a **protest**. The third party files prior art and explains its pertinence to the application.¹²⁵

The third party's protest is acknowledged by the Patent Office, but it is not given information as to the action taken on it.¹²⁶

3.2.10.4 Conflict Proceedings - Old Patent Rules 66-74

Under the "old" *Patent Act*, (prior to October 1, 1989) the patent was to be granted to the Applicant who was the **first-to-invent**. Where there were two applications for the same invention, or overlapping inventions:

where each application contained one or more claims defining substantially the same invention; or

where one or more claims from one application described the invention disclosed in the other application,

the Commissioner of Patents would declare that a conflict existed. A mini-trial within the Patent Office would follow, to determine who was the first inventor.¹²⁷

The current **first-to-file** system awards the patent to the first person to apply to patent the invention, thus doing away with the need for conflict proceedings.

3.2.10.5 Final Rejection and Rights of Appeal

If the Applicant does not satisfy the Examiner's objection, then the Examiner can issue a second Requisition on the same ground.

If the Examiner makes the action a **Final Action**, and the Applicant amends the application or provides acceptable arguments that the application should be allowed, the rejection is withdrawn.¹²⁸

If the rejection is not withdrawn, then the application is forwarded to the Patent Appeal Board and the Applicant is given an opportunity to be heard.¹²⁹

¹²⁵ [Patent Act, s. 34.1](#)

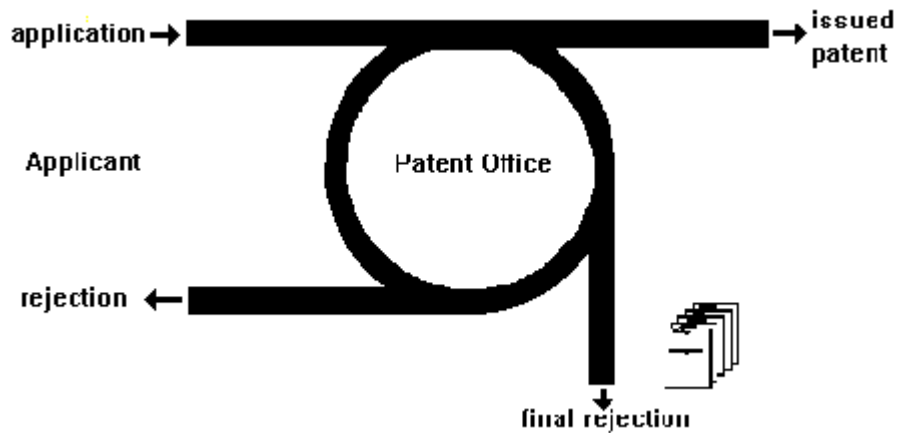
¹²⁶ [Patent Rules, s. 10](#)

¹²⁷ Pre-Oct. 1, 1989 *Patent Act* s. 43

¹²⁸ [Patent Rules, s. 30\(5\)](#)

¹²⁹ [Patent Rules, s. 30\(6\)](#), MPOP 21.04

The Patent Appeal Board's findings are given to the Commissioner for consideration [*MPOP*, s. 21.06].



After the Applicant has received a **Final Action**, the application cannot be amended other than:

- by amending as required by the Examiner in the Final Action,
- where the Commissioner withdraws the rejection after review,
- where the Commissioner informs the Applicant of a required amendment or
- by order of the Federal Court or Supreme Court of Canada.¹³⁰

3.2.10.6 The approval of the patent application

When the application is found to be allowable, a notice of allowance is given to the Applicant together with notice of the deadline for paying the **final fee**¹³¹.

If after allowance, the Commissioner finds that the application should not be allowed, he will withdraw the notice of allowance and notify the Applicant, returning any final fee.¹³²

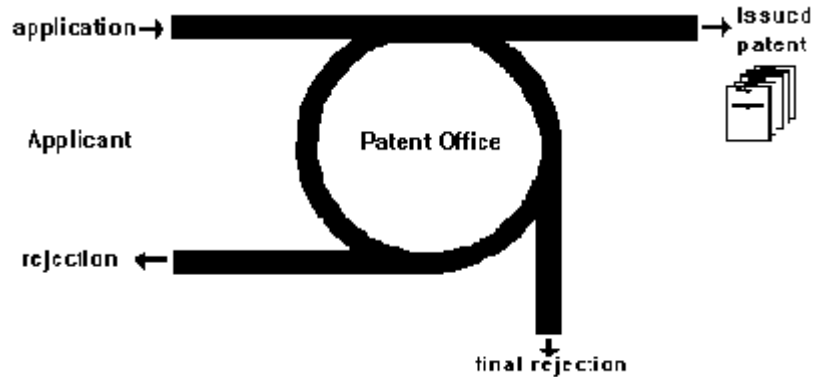
3.2.10.7 Issuance of the Patent

The patent will issue between approximately 6 and 12 weeks from the date of payment of the final fee.

¹³⁰ [Patent Rules, s. 31](#)

¹³¹ [Patent Rules, s. 30\(1\)](#)

¹³² [Patent Rules, s. 30\(7\) & 4\(10\)\(a\)](#)



All documents evidencing the title to the invention should be filed on or before the day the final fee is paid so that the patent issues to the proper owner.¹³³ The patent will issue to the inventor and his legal representative (in other words the party having title to the patent) according to their interests as evidenced in documents filed (and acceptable for registration) as of the day the final fee is paid. In the case of joint Applicants, the patent is granted in the name of all the Applicants.¹³⁴ The person to whom the patent issues is referred to as the **Grantee** or **Patentee**.

3.2.10.8 Re-examination

The examination process can be re-visited by a procedure called re-examination. Re-examination is limited to providing the Patent Office with:

- prior art in the form of patents, applications for patents open to the public and printed publications;¹³⁵
- one set of submissions with respect to the pertinence of the prior art and the manner of applying the prior art to the claim for which re-examination is requested;¹³⁶ and
- the necessary fee (\$1000.00 where requested by a [small entity](#); \$2000.00 for a large entity).

Unless the re-examination is requested by the Patentee, the request for re-examination and the prior art must be submitted in duplicate.¹³⁷

After receiving a request for re-examination from a third party, the Commissioner sends a copy of it to the Patentee.¹³⁸

¹³³ [Patent Rules, s. 41](#)

¹³⁴ [Patent Act, s. 31\(5\)](#)

¹³⁵ [Patent Act, s. 48.1\(1\)](#)

¹³⁶ [Patent Act, s. 48.1\(2\)](#)

¹³⁷ [Patent Rules, s. 45](#)

a) step 1: raising a question

The Commissioner establishes a Re-examination Board (with at least three members, at least two of whom are Patent Office employees) who will determine the re-examination¹³⁹ within three months of the request.¹⁴⁰ The Board must determine whether the request raises "a substantial new question of patentability affecting any claim of the patent".¹⁴¹

If the Board finds that there is **no** substantial new question raised, they advise the person who requested re-examination. The decision of the Board is final and is not subject to appeal or review by any Court.¹⁴²

b) step 2. the re-examination

If the Board finds that there **is** a substantial new question raised by the request, the Board so notifies the Patentee together with their reasons.¹⁴³ The Patentee may, within 3 months of the Board's notice submit to the Board a Reply setting out submissions as to the patentability of the claim of the patent in issue [Patent Act, s. 48.2(5)]. The Patentee may propose an amendment to the patent or any new claims, so long as nothing is done to enlarge the scope of a claim.¹⁴⁴

Upon receiving the Reply (or after 3 months, if no Reply is received), a Re-examination Board will commence a re-examination.¹⁴⁵

The re-examination proceeding must be completed within 12 months of the commencement of the re-examination.¹⁴⁶

c) step 3. the certificate of re-examination

The final decision of the Re-examination Board takes the form of a certificate. The certificate:

- confirms the claim to be patentable;
- cancels the claim if it is "unpatentable"; or

138 [Patent Act, s. 48.1\(3\)](#)

139 [Patent Act, s. 48.2\(1\)](#)

140 [Patent Act, s. 48.2\(2\)](#)

141 *Patent Act*, s. 48.2(1)

142 [Patent Act, s. 48.2\(3\)](#)

143 [Patent Act, s. 48.2\(4\)](#)

144 [Patent Act, s. 48.3\(2\)](#)

145 [Patent Act, s. 48.3\(1\)](#)

146 [Patent Act, s. 48.3\(3\)](#)

- incorporates into the patent the proposed amended or new claim.¹⁴⁷

A copy of the certificate is attached to the patent and made part of it by reference. A copy is also mailed to the Patentee.¹⁴⁸

The decision of the Re-examination Board can be appealed to the Federal Court¹⁴⁹ within 3 months from the date the certificate is mailed to the Patentee.¹⁵⁰

The certificate gives the change retroactive effect. Where the claim is cancelled, the claim is to be treated as if it had never been granted. Other claims remain unaffected. New or amended claims are to be treated as if they issued on the date of the certificate, for the unexpired term of the patent.¹⁵¹

3.2.10.9 Reissue of Patents

The Reissue procedure is used to fix certain types of mistakes in issued patents. The Reissuance must be sought within 4 years from the date of issuance of the patent.¹⁵² The Patentee must surrender the patent to the Commissioner and pay a fee¹⁵³ of \$800.00.¹⁵⁴ The Commissioner will cause a new patent to issue, with an amended description and specification, which will last for the unexpired term of the original patent¹⁵⁵.

To be entitled to a reissuance, the Patentee must show that the patent is defective or inoperative by reason of:

- insufficient description and specification, or
- the Patentee having claimed more or less than he had a right to claim as new; and
- the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention.

¹⁴⁷ [Patent Act, s. 48.4](#)

¹⁴⁸ [Patent Act, s. 48.4\(2\)](#)

¹⁴⁹ [Patent Act, s. 48.5\(1\)\]](#)

¹⁵⁰ [Patent Act, s. 48.5\(2\)](#)

¹⁵¹ [Patent Act, s. 48.4\(3\)](#)

¹⁵² [Patent Act, s. 47\(1\)](#)

¹⁵³ [Patent Act, s. 47\(1\)](#)

¹⁵⁴ [Patent Rules, Schedule II, Item 12](#)

¹⁵⁵ [Patent Act, s. 47\(1\)](#)

When the reissue patent issues, the original patent is surrendered. A revised claim of the reissue patent has the effect as if they had been originally filed in that form before the issuance of the earlier patent¹⁵⁶. The reissuance has no effect on claims which were not amended - they constitute a continuation and have effect from the date of the original patent¹⁵⁷.

The mistake can be that of the patent agent where he failed to make the Canadian patent application the same as the corresponding American application.¹⁵⁸ A patent cannot be reissued merely to broaden the scope of the claims in order to catch subsequent infringers.¹⁵⁹

3.2.10.10 Disclaimers

Whenever, by any mistake, accident or inadvertence, and without any wilful intent to defraud or mislead the public, a Patentee has a patent that:

- claims more than what the inventor invented;¹⁶⁰ or
- claimed that someone was an inventor of a material or substantial part of the invention patented, but the Patentee has no lawful right to that material or substantial part¹⁶¹

The Patentee may **make a disclaimer** of such parts that the Patentee does not claim to hold.¹⁶²

The disclaimer is made by submitting a completed copy of Form 2, Schedule I¹⁶³ accompanied by the fee¹⁶⁴ of \$100.00.¹⁶⁵

Following the making of a disclaimer, the patent is valid for such material and substantial part of the invention as is not disclaimed.¹⁶⁶ The disclaimer does not affect any pending action.¹⁶⁷

¹⁵⁶ [Patent Act, s. 47\(2\)](#)

¹⁵⁷ [Patent Act, s. 47\(2\)](#)

¹⁵⁸ [Mobil Oil at p. 10](#); *Curl-Master Manufacturing Co. v. Atlas Brush Ltd.*; (1967) 36 Fox Pat. C. 84, [1967] S.C.R. 514, 52 C.P.R. 51 at para. 34.

¹⁵⁹ *Re: Halbrite Well Services Co. Patent Application No. 616,196*, [1993] 3 C.P.R. (4th) 94 at para. 25.

¹⁶⁰ [Patent Act, s. 48\(1\)\(a\)](#)

¹⁶¹ [Patent Act, s. 48\(1\)\(b\)](#)

¹⁶² [Patent Act, s. 48\(1\)](#)

¹⁶³ [Patent Rules, s. 44](#)

¹⁶⁴ [Patent Act, s. 48\(1\)](#)

¹⁶⁵ [Patent Rules, Schedule II, item 13](#)

¹⁶⁶ [Patent Act, s. 48\(6\)](#)

3.3 Money

There are government fees to pay at every turn of the application process.

The Fees required to be paid are set out in Schedule II to the *Patent Rules*.¹⁶⁸

If more than the required fee is paid, refunds are made in accordance with *Patent Rule 4*.

The quantum of fees is often double for "large entities" over "[small entities](#)".

A "[small entity](#)" is either: an entity with 50 or fewer employees; or a university; so long as it has not, directly or indirectly: transferred; licensed; or contracted with or is otherwise legally obliged to transfer or license; to an entity having more than 50 employees (other than a university) [*Patent Rules*, s. 2]

A "large entity" is not defined but presumably is an entity having more than 50 employees.

The fees payable are:

- [Filing Fees](#)
- [Examination Fees](#)
- [Maintenance Fees for Patent Applications](#)
- [Final Fees](#)
- [Maintenance Fees for Issued Patents](#)

3.3.1 Maintenance Fees

3.3.1.1 Maintenance Fees on Patent Applications

a) For all applications filed after October 1, 1989

To keep an application pending, the Applicant must pay maintenance fees every year, or else the patent application will be deemed to be abandoned.

b) When due

The first maintenance fee is due before the second anniversary of the filing date of the application. So as not to miss the first payment, it is good practice to pay the first annuity when an application based on convention priority is first filed in Canada.

The maintenance fees can be paid at any time before each anniversary of the filing date.¹⁶⁹ Advanced payments would reduce service charges charges by processing a cheque each year, but require an immediate disbursement.

¹⁶⁷ [Patent Act, s. 48\(4\)](#)

¹⁶⁸ *Patent Rules*, s. 3

¹⁶⁹ *Patent Rules*, s. 99(1), (post Oct.1, 1996 appns.); s. 154 [Oct 89-96 appns.

c) How much

The maintenance fees are set out in of Schedule II to the *Patent Rules*, Item 30.

The maintenance fees ramp up as the application matures.

d) Failure to pay Maintenance Fee on time

If an application goes abandoned by failure to pay maintenance fees, the application can be re-instated within twelve months after the application was deemed to have been [abandoned](#) [If the application was abandoned before April 1, 1996, then a six month period applies (*Patent Rules*, s. 153(3), '89 Act, Rule 76.1(4))]. All back payments of maintenance fees are due on [reinstatement](#) together with a reinstatement fee of \$200.

Maintenance Fees on Issued Patents

In order for a Canadian patent that issued after October 1, 1989 to remain in effect, an annual maintenance fee must be paid to the Commissioner of Patents.¹⁷⁰

e) When due

The maintenance fees can be paid at any time before each anniversary of the filing date. Like a car licence plate, the fee should be paid in advance of the time period. [i.e. payment before the second anniversary for the one-year period ending on the third anniversary]

f) How much

The maintenance fees payable are set out in:

- item 31 of Schedule II for patents issuing from applications filed after October 1, 1989 on the anniversary of the date the patent issued.¹⁷¹
- item 32 of Schedule II for patents issuing from applications filed before October 1, 1989 which issued to a patent after October 1, 1989.¹⁷²

g) Failure to pay Maintenance Fee on time

If a maintenance fee for an issued patent is not paid within the prescribed time period [before the one-year period], the fee can be paid during the one-year period together with an additional fee for late payment of \$200.

If the maintenance fee is not paid during the one-year period, then the patent expires.¹⁷³

¹⁷⁰ [Patent Act, s. 46](#)

¹⁷¹ *Patent Rules*, s. 100(1), 155(1)

¹⁷² *Patent Rules* 182(1)

¹⁷³ [Patent Act, s. 46\(2\)](#)