

FORECAST 2022: EXPECTED CHANGES TO THE CANADIAN PATENT RULES (PART 2)

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Changes to the Canadian patent rules are set to largely come into force on October 3, 2022^[1]. As discussed in an earlier [bulletin](#) of ours, these changes follow a major overhaul introduced in late 2019 and will include (i) the introduction of excess claim fees, and (ii) an adoption of a request for continued examination ("RCE") procedure. While the Canadian patent system continues to offer patent-friendly features such as [deferred examination](#) and [multiple claim dependencies](#), applicants for patents in Canada should nevertheless consider how the upcoming changes may affect their patent strategies.

Excess Claim Fees

Canada's new patent rules will include provisions related to "excess claim fees". Per the incoming changes, "each claim in excess of 20 that is included in the application at [any time](#) during the period beginning on the day after the day on which the request for examination is made" will be taken into account in the calculation of excess claim fees^[2]. The table below compares the current rules to the incoming rules:

	Current rules	New rules
Number of claims permitted before excess claim fees are levied	Unlimited	20
Cost per excess claim	n/a	CA\$100 ^[3]

Note that a multiple dependent claim counts as a single claim for the purposes of calculating excess claim fees^[4].

Excess claim fees will apply to applications for which examination is requested on or after October 3, 2022. As a result, significant excess claim fees can be avoided by requesting examination before October 3, 2022. Notably, for an application that is subject to excess claim fees, applicants should exercise caution before introducing new claims during prosecution, as such introduction could affect the calculation of the excess claim fee even if such claims are withdrawn later.

Request for Continued Examination

Canada will be adopting a request for continued examination (RCE) procedure. The table below compares the current rules to the incoming rules:

	Current rules	New rules
Number of office actions or examiner's reports, after requesting examination	Unlimited, and at the discretion of the patent examiner	up to 3
Cost for RCE	n/a	CA\$816 ^[5]
Additional office actions after each RCE	n/a	up to 2
Option for additional RCE?	n/a	Yes

The new rules regarding RCE do not apply to applications for which examination is requested and applicable fees have been paid before October 3, 2022. As such, applicants may consider requesting examination of their applications before the rules related to the incoming RCE procedure come into force.

In addition, the incoming RCE procedure will also change the manner in which prosecution may be re-opened after a Notice of Allowance has been issued. Under the current system, an applicant may re-open prosecution after issuance of a Notice of Allowance by requesting that the Notice of Allowance be withdrawn. Once the incoming RCE procedure comes into force, prosecution may be re-opened by filing an RCE and paying the applicable fees^[6].

Conclusion

Patent applicants in Canada should carefully consider how the incoming changes to the Canadian Patent Rules might affect their patent strategies. In particular, for Canadian patent applications containing more than 20 claims for which examination has not yet been requested, consider requesting examination before October 3, 2022.

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[1] Canada Gazette, Part II, Vol. 156, No. 13, pp. 2097 to 2641: [Notice to Readers](#).

[2] See §80(1)(a), §80(1)(b), §87(1)(a)(iii) and §87(1)(b)(iii) of the new rules.

[3] The fee provided in the table is for "large entity" applicants. As expected, the "small entity" fee is half of the fee for "large entity" applicants.

[4] See §80(1.1) of the new rules.

[5] Fees vary between "small entity" and "large entity" applicants. The fee provided in the table is for "large entity" applicants.

[6] See §85.1(4) of the new rules.

A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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