

FORECAST 2022: EXPECTED CHANGES TO THE CANADIAN PATENT RULES

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Following a major overhaul in late 2019, further changes to the Canadian Patent Rules are expected this year. The proposed changes are intended, in part, to help Canada meet its obligations under the Canada-United States-Mexico Agreement (CUSMA) by streamlining its patent prosecution procedure. Below is a high-level summary of the substantive proposed changes:

Excess Claim Fees

Canada is expected to impose “excess claim fees”. The table below compares the current rules to the proposed rules:

| | Current rules | Proposed rules |
|-----------------------------------------------------------------------|--------------------------|------------------------|
| Number of claims permitted before excess claim fees are levied | Unlimited ^[1] | 20 |
| Expected cost per excess claim | n/a | CA\$100 ^[2] |

Under the proposed changes, “excess claim fees” are expected to be evaluated at two points during prosecution: (i) at the time that a request for examination is filed; and (ii) at the time that the final fee (*i.e.*, the fee required for issuance of a patent) is due. At the time that the final fee is due, an applicant must pay an excess claim fee for each claim in excess of 20 that had not already been paid for at the time that examination was requested.

Request for continued examination

Canada is expected to adopt a request for continued examination (RCE) procedure. The proposed RCE procedure is also expected to replace the current mechanism for withdrawing an application from allowance and returning it to examination^[3]. The table below compares the current rules to the proposed rules:

| | Current rules | Proposed rules |
|--------------------------------------------------------------|---------------------------------------------------------|----------------|
| Number of office actions after requesting examination | Unlimited, and at the discretion of the patent examiner | up to 3 |

| | | |
|-------------------------------------------------|-----|------------------------|
| Cost for RCE | n/a | CA\$816 ^[4] |
| Additional office actions after each RCE | n/a | up to 2 |
| Option for additional RCE? | n/a | Yes |

Conclusion

While Canada remains a patent-friendly jurisdiction at least in view of its deferred examination process and permissiveness of multiple claim dependencies, patent applicants should nevertheless consider how the above incoming changes may affect their patent strategies. The proposed excess claim fees are expected to be effective for applications for which examination is requested more than 30 days after these changes to the *Patent Rules* come into force. As a result, significant excess claim fees can be avoided by requesting examination before the passing of 30 days after the effective date of these changes. Where applicants have more than 20 claims in applications for which examination has not yet been requested, we strongly encourage considering requesting examination before this period has lapsed.

The proposed changes are expected to come into force in early 2022, and a further bulletin will follow at that time.

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[1] Subject to an additional final fee of \$6.11 (for 2022) for each page of specification/drawings (excluding electronic sequence listing) in excess of 100 pages.

[2] Fees are expected to vary between “small entity” and “large entity” applicants. The fee provided in the table is for “large entity” applicants.

[3] Subsection 86(17) of the Patent Rules.

[4] Fees are expected to vary between “small entity” and “large entity” applicants. The fee provided in the table is for “large entity” applicants.

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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