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Changes to the Canadian Patent Rules

Please note that amendments made to the *Canadian Patent Rules* came into force on **June 2, 2007**. The following is a summary of the most important changes:

1. ASSIGNMENTS

Applicants are no longer required by the amended regulations to file evidence of their entitlement to file an application or that they are the legal representative of the inventor. With the changes, applicants are now only required to file a Declaration establishing their entitlement to apply for and be granted a patent.

The Declaration may be submitted in the Petition when filing the application or in a separate document before a period of 15 months from the filing date or, if priority is claimed, from the earliest priority date. For a PCT application, the Declaration is due three months from the national phase entry date. The Declaration is not a requirement for obtaining a filing date, but is necessary to complete the application, and a completion fee will be payable if these deadlines are not met.

Declarations are applicable only to those events that occurred before the filing date or the national entry date, and must address the entire chain of title from the inventor(s). It will still be necessary to record assignments or other transfer documents that relate to changes in ownership that occur after the filing or national entry date.

It should be noted that Declarations are not proof of title. If the applicant wants proof of title recorded in the records of the Canadian Intellectual Property Office, or that a searchable chain of title be available in the event the patent rights are eventually assigned or licensed, it is recommended that the assignment be recorded.

2. SEQUENCE LISTINGS

Canadian Rules for submitting sequence listings for PCT and non-PCT applications are now the same. All sequences listings submitted to the Patent Office should follow the PCT *Standard for the Presentation of Nucleotide and Amino Acid Sequence Listings*.

Here also, to avoid payment of completion fees, the sequences listings must be filed with the application or before a period of 15 months from filing date or, if priority is claimed, from the earliest priority date. For a PCT application, the sequence listing is due three months from the national phase entry date.

¹ Certified by the Law Society as a Specialist in Intellectual Property (Patents, Trademarks, Copyright) Law.

² Certified by the Law Society as a Specialist in Intellectual Property (Patents) Law.

With the new changes, only sequence listings in electronic form are required, dispensing with the need to file a paper copy of the sequence listing.

Sequences listings are also not a requirement for obtaining a filing date, but are necessary to complete the application, and a completion fee will be payable if these deadlines are not met.

3. SMALL ENTITY STATUS

If the applicant qualifies as a Small Entity on the Canadian filing date or, for PCT applications, on the date of national phase entry into Canada, Small Entity status may be claimed to provide the applicant with the right to pay reduced fees.

Small Entity status so claimed will be maintained throughout the lifetime of the application and any patent to issue therefrom. However, in cases where an error has been made by claiming and incorrectly paying fees at the Small Entity rate, the new Rules provide a remedy. Extensions of time, at the discretion of the Patent Office, are now available to top-up payments incorrectly made at the Small Entity rate.

The Small Entity status definition remains roughly the same as under the old Rules, that is, an entity that employs 50 or fewer people or that is a university, but with some minor modifications. An entity controlled directly or indirectly by another entity, other than a university, that has more than 50 employees, is now excluded from the definition of a small entity. An entity that has an obligation to transfer or license the invention to an entity that employs more than 50 employees, other than a university, may still claim small entity status if the obligation is “contingent”. No guidance is provided for determining when an obligation is merely contingent.

The new complete definition of Small Entity status reads as follows:

(3) For the purposes of subsection (2), "**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

(a) is **controlled** directly or indirectly by an entity, other than a university, that employs more than 50 employees; or

(b) 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.

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