



June 26, 2006

Mr. David Tobin
Commissioner of Patents,
Registrar of Trade-marks and
Chief Executive Officer
Canadian Intellectual Property Office
Industry Canada
Ottawa, Ontario
K1A 0C9

Dear Mr. Tobin:

Thank you for the opportunity to comment upon the proposed amendments to the *Patent Rules*. The Intellectual Property Section of the Canadian Bar Association (the CBA Section) offers the following points as relevant to the proposal:

- In *Dutch Industries*¹ the Federal Court of Appeal pointed out the uncertain definition of “small entity” under the *Patent Rules*. This problem is not addressed in the proposed amended *Rules*. In addition, there are two new problems introduced. First, the definition of “small entity” in the proposed s.3.01 of the *Rules* is different from the definition in s.3.02. Second, the proposed s. 3.01(3)(b) of the *Rules* excludes an entity from the definition of “small entity,” where “it has transferred or has an obligation, other than a contingent obligation, to transfer any right in the invention to an entity.” This could conceivably be interpreted to include a transfer of a security interest to a bank as part of the entity’s financing. We believe that it is not the intention of the amendment to exclude entities granting such security interests from the definition of “small entity,” and this would not be appropriate in any event. Last, the amended *Rules* do not define “contingent obligation,” leading to further ambiguity;

¹ *Dutch Industries Ltd. v. Canada (Commissioner of Patents)*, [2003] 4 F.C. 67, 2003 FCA 121.

- Proposed subsection 93(e) of the *Rules* requires that a small entity declaration accompany the application to obtain a filing date. This requirement is an onerous one. If an application omits or improperly executes the declaration, then the filing date of the application is at risk. CIPO should therefore reconsider this amendment;
- Proposed subsection 86(3) of the *Rules* establishes the Patent Cooperation Treaty (PCT) sequence listing standard as the required format for Canadian patents. If the *Rules* incorporate the PCT sequence listing standard, defined as that "provided for in the Administrative Instructions under the Patent Cooperation Treaty"² this will make the Canadian procedure dependent on the current state of the PCT standards. The CBA Section recommends that the *Rules* include a notification mechanism to ensure that any changes to the PCT standards are made available to Canadian patent lawyers;
- The amendment to paragraph 80(1)(a) of the *Rules*, which prohibits the title of an invention being "a trade-mark, coined word or personal name," does not appear to be needed and potentially excludes any trade-mark, not just trade-marks related to the subject matter of the application. Even if the trademark or proper name is related to the subject matter, the prohibition can be problematic. For example, is the name of a computer programming language a proper name? "Pascal" is a proper name but it also identifies a computer programming language and may be usefully referred to in the title of an invention; and
- Amended subsections 58(4) and 71(2) refer to the Commission's power to request a statement from "the translator" that the translation of an application or document is complete and faithful. The reference to "the translator" is ambiguous when used relating to a "new translation". In the section, "the translator" could refer to either the original translator or the translator of the new translation. The proposed amendment could avoid potential confusion by including the words "of the new translation" after the word "translator" in paragraphs (b) of the respective subsections.

Thank you once again for permitting us the opportunity to comment upon the change to the *Patent Rules*. I hope our comments have been useful. If you wish to discuss any of our comments above in greater depth, please do not hesitate to contact me or Bruce Stratton, the chair of our Patent Committee.

Sincerely,

(Original signed by Kerri Froc on behalf of Christene Hirschfeld)

Christene Hirschfeld
Chair, National Intellectual Property Section

² Under proposed amendments to section 2.