



THE CANADIAN BAR ASSOCIATION
L'ASSOCIATION DU BARREAU CANADIEN

February 27, 2009

Félix Dionne, Programs Manager
Patent Administrative Policy
Classification and International Affairs Division
Industry Canada
50 Victoria Street
Place du Portage II
Gatineau, QC K1A 0C9

Dear Mr. Dionne:

Re: Proposed Changes to the *Patent Rules* – Second Package

On behalf of the National Intellectual Property Section of the Canadian Bar Association (CBA Section), I am pleased to comment on the second package of proposed changes to the *Patent Rules*, dated November 15, 2008 (Second Package). The CBA Section supports the changes in the Second Package, with three exceptions set out below.

Proposition for change #3 – Change of Names

The current Rule 39 requires a patent owner that wishes to change its name to provide evidence of the change of name to the Patent Office in order for it to be registered. The rationale for the proposed amendment is that it is inconsistent with Patent Law Treaty (PLT) Rule 15(4). The proposed change makes it mandatory for the Patent Office to accept the name change without evidence (“the Commissioner shall recognize the change”). However, PLT Rule 15(4) allows some discretion in the Patent Office to require proof of name changes if there is a reasonable doubt as to the veracity of the change. The CBA Section does not see a benefit in preventing the Commissioner of Patents from exercising some discretion in accepting name change requests. This appears reasonable and will track the PLT provision more closely.

Proposition for change #6 – Request for Examination

This proposed change reduces the time to request examination of a patent application from within five years from the date of application to three years before it becomes abandoned. The restriction to three years brings the request for examination deadline closer to the 30-month PCT national-entry date (and makes that deadline earlier than the 42-month deadline for reinstatement).

This change could potentially create difficulties for patent applicants. There will be a relatively short time from national phase entry into Canada until a request for examination must be made, raising practical concerns for Canadian lawyers seeking instructions from foreign applicants. Because of the difficulty in obtaining instructions within the time limits proposed, active patent applications may be deemed abandoned. Further, the move to a three-year period will increase the Patent Office backlog in handling applications, to the detriment of patent applicants and the administration of the Canadian office. If there is a concern that there are significant numbers of “deadwood” applications on the register after three years, then maintenance fees for applications over three years old could be increased to provide a disincentive for doing so.

Proposition for change #8 – Reinstatement Period

The proposal provides additional relief to applicants whose patent applications are deemed abandoned, so that the time frame for reinstatement is twelve months after the abandonment of the application or *two months after the Patent Office posts on its website an indication that the application is abandoned*, whichever is later. The CBA Section agrees with the intention behind the proposed change, namely to provide relief for applicants where a notice of abandonment is not received. However, there are two potential difficulties with the use of the Patent Office website to do so:

- Because websites are not static, it is possible for the Patent Office website to post a notice of abandonment (thereby triggering the two-month period) and then, through an inadvertent IT failure, for the website to revert to a state where the notice is no longer posted. Proving that there was a notice or that the notice has been removed and then potentially reposted may be problematic;
- The status of all applications will need to be double checked on the Patent Office website on a continual basis to ensure their rights are not affected by a notice appearing on the website. This monitoring is potentially onerous for applicants and their lawyers.

The CBA Section suggests that the Patent Office consider a technology that provides notice that is less likely to be inadvertently changed and is more of a “push” technology, for example something akin to an RSS feed.

Conclusion

The CBA Section appreciates the opportunity to provide input on the Second Package. We would be pleased to further discuss any of the above points with you or your staff, or any other matter with which we could assist.

Yours truly,

(Original signed by Kerri Froc for Cynthia L. Tape)

Cynthia L. Tape
Chair, National Intellectual Property Section