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## PATENT ABANDONMENT, DEATH AND RESURRECTION IN CANADA

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Once a patent application is filed, it must be kept in good standing to preserve the prospect of obtaining patent protection for the invention. Likewise, once a patent is granted it must be kept in good standing to be enforceable.

In Canada, to keep an application or a patent in good standing, certain actions must be taken, such as paying fees, requesting examination and replying to Office Actions within the prescribed time limits. Relatively speaking, the *Patent Act*, R.S.C. 1985, c. P-4 and the *Patent Rules*, S.O.R./96-423 provide strict guidelines and consequences for applications and patents that fall out of good standing.

A patent application is “abandoned” when the applicant does not take action before a prescribed deadline.<sup>1</sup> However, there is a twelve (12) month window to “reinstate” the application. An abandoned application therefore goes through a period of limbo, a kind of patent-purgatory during which it is no longer in good standing but may be reinstated. An application also becomes abandoned for *each failure to act* and thus an application may be *multiply abandoned* if an applicant, for example, does not respond to an Office Action and does not pay a maintenance fee. An application must therefore be reinstated for *each* abandonment. If an application is not reinstated in time, it becomes “dead”.

An “expired patent” is one that has been issued and properly maintained but has run its course. A “lapsed” patent is one which no longer gives any patent rights to the patentee because the required maintenance fees were not paid in time.

It is very difficult to “resurrect” a dead application or a lapsed patent. Canadian courts have used other terms such as “reincarnation” and “resuscitation”, to stress that recovering such lost patent rights is extremely difficult. In the United States, there are clear procedures for reviving patents that are “unintentionally” or “unavoidably” abandoned. This is not the case in Canada. Perhaps the foremost obstacle to resurrection is that the Canadian Intellectual Property Office (CIPO) has no discretion to take into account accidental mishaps resulting in dead applications or lapsed patents.

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<sup>1</sup> See subsections 73(1) and (2) of the *Patent Act*, R.S.C. 1985, c. P-4 and section 97 of the *Patent Rules*, S.O.R./96-423

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Canadian courts have considered the question of resurrection, but the circumstances did not enable them to justify resurrection.<sup>2</sup> In attempting to resurrect patent rights that were accidentally lost, patent holders have argued that the *Patent Act* must be read in light of its purpose and context as well as the Common Law principles of fairness, legitimate expectations, equity and estoppel, albeit to no avail.

The intricacies of Canadian abandonment procedures demand a high degree of care to make sure that valuable patent rights stay in good standing. Patent holders and their patent agents are strongly advised to keep meticulous records and take extreme care in their docketing systems and responses to CIPO's requisitions. It also seems that legislative amendments would be necessary to give Canadian courts or CIPO clear discretion to resurrect applications and patents.



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<sup>2</sup> See *Dutch Industries Ltd. v. The Commissioner of Patents, Barton No-Till Disk Inc and Flexi-Coil Ltd.*, (C.A.) [2003] 4 F.C. 67; *Peter Eiba vs. The Attorney General of Canada*, 2004 C.F. 250, [2004] 3 F.C.R. 416; *Harry O. Wicks vs. The Commissioner of Patents*, 2007 C.F. 222; *Hoffman-La Roche vs. The Commissioner of Patents*, (2003) F.C. 1381; *P.E. Fusion LLC vs. The Attorney General of Canada*, 2004 C.F. 645

