

SURVEY OF THE AMENDMENTS TO THE CANADIAN INTELLECTUAL PROPERTY STATUTES AND REGULATIONS (1996)

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PART I - IMPLEMENTATION OF "TRIPS" IN CANADA

By
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The intellectual property provisions of the *World Trade Organization Agreement Implementation Act* (S.C. 1994, c. 47) came into force on 1996.01.01 in order to give effect to some of Canada's obligations under Annex 1C (Agreement on Trade-Related Aspects of Intellectual Property Rights or "TRIPs") of the Agreement Establishing the World Trade Organization (Final Act embodying The Results Of The Uruguay Round of Multilateral Trade Negotiations. signed at Marrakesh on April 15, 1994).

Even though most of TRIPs' requirements were already satisfied by Canada's existing intellectual property statute provisions, together with the Common Law and the Quebec Civil Code, some modifications were nevertheless required and are hereinbelow summarized.

COPYRIGHT

Copyright protection is extended to citizens or ordinary residents of countries member of the World Trade Organization (WTO), in addition to those of the Berne Convention (1886, or any of its revisions) and the Universal Copyright Convention (1952 or 1971 versions) (s.2, ss.5(1)). These will be known as treaty countries. Where a country joins the Berne Convention or the WTO after the

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date of making or of publication of a work, such membership is deemed retroactive to that date of making or publication, provided that copyright protection of the work has not already expired at the actual date of joining Berne or WTO (ss.5(1.01), ss.5(1.02)).

Live performances of pre-existing artistic, dramatic, musical or literary works, and live improvisations of such types of works become subject to performers' rights. The performer has the sole right to fix (by means of a record or other sound reproducing contrivance) such a performance or any substantial part thereof, to reproduce the fixation and to communicate it or any reproduction thereof in whole or in substantial part, to the public by telecommunication, and to authorize any such acts (s.14.01). However, the performance must take place in a WTO member country, on or after the day at which section 14.01 comes into effect (1/1/96) and the day on which that country joins the WTO. Pre-WTO performances are given protection with respect to reproductions of the fixed performance (ss.14.01(4)). The period of protection is 50 years following the end of the calendar year in which the performance takes place (ss.14.01(5)).

This recognition of performers' rights is accompanied by new provisions on their infringement, with exceptions such as fair dealing for the purposes of private study or review, etc., the making of a temporary fixation of the performance for purposes of newspaper reporting of a public lecture, the reproduction of a fixation for national archives and the like (s.28.02). In addition to civil recourses, criminal liability is incurred for the infringement of performers' rights (s.43.1). Related amendments provide for the protection of rights and the possibility of compensation where a person has, before a country becomes a treaty country, incurred expenditures or liabilities in connection with an act which will constitute infringement once the country acquires the status of treaty country (s.28.03, s.29). The Canadian Copyright Board will have power to determine the amount of compensation for restoration of copyright or of performers' rights under such circumstances (s.70.8).

To round out the new scheme of protection for performances, unlawful fixations or reproductions about to be imported into Canada are included in the works for which interim government custody may be obtained.

The provisions on compulsory licences still remaining in the *Copyright Act* are repealed.

TRADE-MARKS

A new definition of "country of the Union", in section 2, now extends to WTO members the benefits (e.g. priority, right to registration on the basis of home registration and use, protection of flags or emblems) previously given to applicants from countries of the Union for the Protection of Industrial Property constituted under the Paris Convention.

In keeping with TRIPS, amendments to the *Trade-marks Act* provide a comprehensive code for protecting geographical indications in Canada. These are defined in section 2 as indications for wines and spirits which identify these products as originating in the territory or region or locality of a WTO member, where a quality, reputation or other characteristic of the wine or spirit is essentially attributable to its origin, and where it is protected by the laws applicable to that WTO member.

The Registrar of Trade-marks will keep the list of geographical indications. These will have been published in the *Canada Gazette* (not in the *Trade Marks Journal*), with relevant information (s.11.12). It will be possible to file a statement of objection to entry of the indication on the Registrar's list, within three months of publication. However, the only possible ground for objection is that the indication is not a geographical indication, presumably in accordance with the definition of section 2 (s.11.13). Subsequent steps in the objection proceedings follow *grosso modo* those provided in trade-mark oppositions.

The adoption and use of a protected geographical indication for wines and spirits, or of a translation thereof in any language, are prohibited (s.11.14, s.11.15). Exceptions are provided in the case of personal names, comparative advertising, prior use by a Canadian with respect to wares or services in a continuous manner in good faith since April 15, 1994 or for at least 10 years before that date (s.11.16, s.11.17). Other exceptions are the falling into disuse of the indication or the cessation of protection under the WTO country's laws, as well as an identity between the indication and a customary term used in Canada, or the customary name of a grape variety (s.11.18). A further and important exception relates to the generic names for wines (e.g. champagne, port, chablis, claret) and spirits (e.g. ouzo, sambuca, schnapps, bitters) listed in section 11.18; this list may from time to time be amended by the Governor in Council.

The protection conferred to geographical indications may no longer be enforced if no proceedings are taken against use or adoption thereof by a person in contravention to the Act, within five years of such adoption or use becoming generally known in Canada or five years of registration in Canada of the trade-mark by that person, unless it is proven that the person knew such adoption or use to be contrary to sections 11.14 or 11.15 (ss.11.19(1)).

In trade-mark administrative cancellation proceedings for reason of non-use, the relevant period to be considered will be extended from two to three years. Thus the owner must show that his trade-mark was used in Canada at any time during the three years preceding the Registrar's notice requiring him to furnish evidence of use, or provide suitable justification for the absence of use (ss.45(1)).

PATENTS

A definition of the term "country" is added to section 2 of the *Patent Act* (R.S.C. 1985, c. P-4), providing that the term includes a Member of the World Trade Organization. This amendment widens the scope of "country" with respect to the priority filing date for instance.

Sections 19 and 19.1 of the *Patent Act* presently provide a mechanism for the Commissioner of Patents to authorize the government of Canada or the government of a Canadian province to use a patented invention under certain conditions. A new subsection 19.1(4) states that the Commissioner may not, however, authorize any use of semi-conductor technology other than a public non-commercial use.

While adherence to the WTO will cause, in the United States, an extension of the term of patent protection to twenty years from the earliest U.S. filing date for filings made after June 7, 1995, the Canadian *Patent Act* already provides for such a twenty-year term (s. 44).

INDUSTRIAL DESIGNS

A new subsection 29(2) in the *Industrial Design Act* (R.S.C. 1985, c. I-9) gives a definition of the expression "foreign country", meaning a country that by treaty, convention or law affords a priority privilege to citizens of Canada with respect to the effective date of an application for registration of an industrial design, and includes a WTO Member. As well, an amendment to subsection 29(1) effectively enlarges the basis of a priority claim to applications filed not only in a foreign country, but also for a foreign country, thereby including applications made through the international registration system of the Hague Convention (1925).

INTEGRATED CIRCUIT TOPOGRAPHIES

A new section 2.1 subjects the Canadian federal and provincial governments to the *Integrated Circuit Topography Act* (R.S.C. 1985, c. I-14.6). In addition,

protection is granted to nationals of WTO Members without necessity of a particular agreement or of publication of a notice of reciprocity in the Canada Gazette (subsection 4(1)(c)(iv)).

The amendments also provide a code for governmental use of topographies. In accordance with subsection 7.1(1), the Commissioner of Patents (rather than the Registrar of Topographies) may, upon application by the government of Canada or the government of a province, authorize the public non-commercial use of a registered topography by that government.

The Commissioner must set the period and other terms of such use in accordance with the following principles: (a) the scope and duration of use will be limited to the purpose for which the use is authorized; (b) the authorized use will be non-exclusive; and (c) any use will be authorized predominantly to supply the domestic market (ss.7.1(2)). In accordance with subsection 7.1(3), the Commissioner must notify the topography owner of any such permitted use and the owner will be paid adequate remuneration set by the Commissioner. The authorized use may be terminated upon application by the owner and after all parties have had the opportunity of being heard, if the Commissioner is satisfied that the circumstances that led to the granting of the authorization have of the authorized user's legitimate interests (ss. 7.1(5)). Any decision made by the Commissioner under sections 7.1 and 7.2 is subject to appeal to the Federal Court under the *Patent Act*.

MISCELLANEOUS

The *Pest Control Products Act*, *Fertilizers Act* and *Food and Drugs Act* were also amended to allow a regulation-making authority in respect of undisclosed test data with respect to pharmaceutical and agricultural chemical products submitted for marketing approval.

The *Defense Production Act* was also amended to allow the Minister of National Defence to deal with the infringing use of any registered topography in the performance of a defence contract, as it was already the case with respect to patent and registered industrial designs.

PART II - AN OVERVIEW OF THE TRADE-MARKS REGULATIONS (1996)

by

Laurent Carrière and Hugues G. Richard

The *Trade-Marks Regulations* (1996) were published in the 1996.05.01 edition of the *Canada Gazette - Part II* (vol. 130, No 9, pp. 1306 - 1326) and came into force on 1996.04.16 (DORS/96 - 195 P.C. 1996-490). Here is a brief overview of these regulations.

GENERAL PROVISIONS AND CORRESPONDENCE: RULES 1 - 17

One may now correspond with the Registrar by facsimile for all matters, other than for an application for the registration of a trade-mark (r. 3). Communication can be made (except for the Opposition Board) with the general number for the mail room at, (819) 997-3671. A facsimile is deemed to be received by the Registrar on the day it is transmitted, where the transmission takes place before midnight, at Hull time. Transmission by facsimile does not require a copy of confirmation. The following, however, can not be transmitted by facsimile: whatever requires to be accompanied by payment and whatever is required to be signed on the original (for example, evidence in opposition matters or in a section 45 proceedings).

The general rule pertaining to correspondence is that in order to cancel the registration of a trade-mark, or, to appoint a representative for service (section 41(1)), each communication addressed to the Registrar shall deal with only one application or one registration of a trade-mark (r. 5). This is not the case however for the transfer of rights, (section 48) and for the change of name or address of an applicant or of a registered owner.

If the trade-mark application is pending, the correspondence must indicate the name of the applicant, as well as the application number (if available) and the trade-mark itself. If the trade-mark is registered however, one must indicate the registration number, the application number and the trade-mark itself (r. 7). If an address needs to be furnished it should include the street name and number (if it exists) and the postal code (r. 6).

All documents filed with the Office of the Registrar of Trade-marks shall be presented on white paper. The document does not necessarily have to be typed, however it must be presented clearly and legibly. It should measure (r. 13) a minimum of 8 1/2" x 11" (21 cm x 28 cm) and a maximum of 8 1/2" x 14" (22 cm x 35 cm). Left and upper margins should measure at least 1" (2.5 cm). (Theoretically, these dimensions should also apply to evidence that is filed).

The regulations no longer include forms in Schedule II. Moreover, there is no longer the requirement that the seal of the Trade-Mark Office be appended on certificates issued by the Registrar. The prescribed fees are now payable to the Receiver General, in Canadian currency, and must be forwarded to the Registrar (r. 12).

Finally, the French translation of the Trade-Marks Journal has become the *Journal des Marques de Commerce* (r. 2).

TRADE-MARK AGENTS: RULES 18-23

To be eligible to sit for a qualifying examination, one must meet one of the following conditions. Either be a barrister or solicitor entitled to practise as such in a province, or, a notary entitled to practise as such in the province of Quebec. Otherwise, one must have worked in Canada in the area of Canadian trade-mark law and practice including the preparation and prosecution of applications for the registrations of trade-marks, for a period of not less than 24 months. The rules do not specify if the work necessarily has to be on a continuous basis nor if it necessarily has to be under the supervision of a registered agent. Furthermore, the previous "proof of good reputation" requirement no longer exists (r. 18).

The following persons may be entered on a list of trade-mark agents:

- (a) A Canadian resident who has passed the qualifying examination;
- (b) A barrister solicitor, or notary entitled to practice as such in the province of Quebec, who has submitted an affidavit declaring that he has worked for at least 24 months in the area of trade-mark law including the preparation and prosecution of applications for registration of trade-marks (the rules do not specify if it has to be Canadian trade-mark law nor if the years of work necessarily have to have been on a continuous basis in Canada).
- (c) A resident of any other country who is entitled to practise before the Trade-Marks Office of that country. If he does not reside in Canada, however, he shall appoint an associate agent who is a resident of Canada (r. 9);
- (d) Any firm having the name of at least one of its members entered on the list as a trade-mark agent (r. 21).

As to the Examining Board, its members are appointed by the Registrar. The Registrar is no longer a member of the Examining Board (r. 19). With regards to the renewal of one's registration as trade-mark agent, the Registrar will in the future send only one notice of renewal (r. 22).

APPLICATIONS FOR REGISTRATION: RULES 24 - 29

The previous requirement to file a specimen of the trade-mark no longer exists. Rather, the Registrar may require that a specimen of the trade-mark as used be furnished if he deems it to be appropriate. This policy applies retroactively for all pending applications (r. 29).

Applications for the registration of trade-marks no longer require to be signed. This may predict future filing by electronic mail (r. 25). The Registrar requires that only one drawing of a trade-mark be included with the application (r. 25). The drawing shall be in black and white and in the following format (r. 27):

- (a) It shall be no larger than 2 3/4" by 2 3/4" (7cm x 7cm).
- (b) It may be reproduced on paper that satisfies the requirements of r.13.
- (c) The Registrar may require an applicant to file a new drawing if it is not suitable for reproduction in the journal.

However, rule 28 provides that if in an application for trade-mark registration a colour is claimed as a feature, the colour shall be described. If the description is not clear, the Registrar may require the applicant to file a drawing lined for colour in accordance with the colour chart found at r. 28(2)

Rule 29 provides that the Registrar can require the translation in either French or English of what is not in either of these two languages. Furthermore, he may also require a transliteration of the material where the trade-mark contains material expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals.

Rule 25 was harmonized with section 34 of the *Act*, so that the date of the filing of an application is deemed to be the priority date claimed.

Note that rule 25 a)(iii)(B) does not take into consideration the new wording of paragraphs 16(2) of the *Act* (*i.e.*, in or for the country of origin) and 30 d) of the *Act* (*i.e.*, in or for another country of the Union). An amendment should be expected.

AMENDMENTS OF APPLICATIONS: RULES 30 - 34

Applications for the registration of a trade-mark can still be amended (r. 30). However, it is now clear that when a trade-mark application based on use or making known, has been advertised, it cannot be amended into an application for a proposed trade-mark.

It is now possible for the Registrar to correct clerical errors in any instrument of record, whether the error is discovered by the Registrar or a request is made by the applicant, registered owner or trade-mark agent of the applicant or registered owner. The certificate of correction no longer exists.

STATEMENT OF OPPOSITION: RULES 35 - 47

The statement of opposition must still be filed with the Registrar in duplicate (r. 38). All correspondence in respect of an opposition must clearly state that it relates to the opposition proceeding (r. 35).

A copy of all correspondence in an opposition proceeding must be forwarded to the other party involved. This requirement does not apply, however, to the initial statement of opposition nor does it apply to written arguments (r. 36 and section 38(5) of the Act). Every exhibit to an affidavit or declaration filed in an opposition has to be filed with the affidavit or declaration (r. 45).

Documents are served either by registered mail, or, served personally. Priority mail, messenger services or facsimile are not accepted means of service. One may however correspond with the Registrar by facsimile. The number for the Opposition Board is: (819) 997-5092 (r. 3).

Former rules 40 to 49 have been re-numbered 38 to 47. Rule 39 pertains to the filing and service of the counter-statement of opposition; rule 41 pertains to the filing with the Registrar and service on the applicant of the evidence of the opponent by way of affidavit, or statutory declaration, or the statement that the opponent does not wish to submit evidence.

Rule 42 pertains to the evidence of the applicant and rule 43 covers evidence in reply. Cross-examinations and the admissibility of additional evidence are dealt with at rule 44. Additional evidence may be adduced at any time until a decision is rendered with leave of the Registrar and on such terms as the Registrar determines to be appropriate. Cross-examinations, however, are only possible before the Registrar gives notice that the parties may file written argument.

Hereinbelow is a table of those steps and related rules::

Statement of opposition	r. 38 et ss. 38(1)	
Counter-statement	r. 39 et ss. 38(6)	default ss. 38(7.2)
Evidence of the opponent	r. 41 et ss. 38(7)	default ss. 38(7.1) and r. 41(2)
Evidence of the applicant	r. 42 et ss. 38(7)	default ss. 38(7.2) and r. 42(1)
Reply evidence	r. 43 et ss. 38(7)	
Request for cross-examination	r. 44(2)	
Filing of the transcript	r. 44(4)	
Withdrawal of affidavit	r. 44(5)	
Filing of written arguments	r. 46(2)	
Request for hearing	r. 46(4)	

The Registrar's practise of withdrawing evidence from the file for failure to attend a cross-examination is now official (r. 44(5)). The party who proceeds with a cross-examination is responsible for the filing of transcripts, supporting documents and answers to undertakings (r. 44(4)). (However, the question concerning the filing of a part of the cross-examination or a part of the re-examination still remains unclear).

The amendment to a statement of opposition or to a counter-statement is possible with leave (r. 40). Moreover, where in an opposition proceeding any extension of time is granted to a party, rule 47 provides that the Registrar may thereafter grant a reasonable extension of time to the other party for the taking of any subsequent step.

TRANSFER: RULES 48 - 50

The Registrar no longer requires the original instrument of transfer or a certified copy therefor, rather, evidence of the transfer alone is now sufficient (r. 48); photocopies or facsimiles are accepted.

The partial transfer of a trade-mark that is registered or is the object of an application for registration can be recognized by the Registrar. If it concerns an application for registration (r. 49), the Registrar may recognize the transfer; each owner must file an amendment of that application restricted to those wares or services for use in respect of which the person owns the trade-mark. Each said amended application will be considered as a continuation of the original application for the purposes of preserving the benefit of the date of filing of the original application, but each amended application will otherwise be treated in subsequent proceedings as a separate application. If the transfer pertains to a trade-mark that is already registered (r. 50), each owner is deemed to be a separate registered owner, and for the purposes of

sections 43 to 46 of the Act, is deemed to have a separate registration of the trade-mark.

REGISTER: RULES 51 - 52

The kind of information that the Registrar must keep on the register of trade-marks has been revised in order to take into consideration the amendments to the Act.

OBJECTION TO AN INDICATION OF ORIGIN: RULES 53 - 61

Section 11.13 of the Act provides that an interested person may file a statement of objection within three months after the publication in the Canada Gazette of a statement by the Minister in respect of a geographical indication. The new rules, concerning objection proceedings are similar to those for opposition proceedings.

Hereinbelow is a table of those steps and related rules::

Statement of opposition	ss. 11.13(1)	
Counter-statement	ss. 11.13(4)	default ss. 11.13(4) <i>in fine</i>
Evidence of the opponent	ss. 11.13(5) and r. 55(1)	default ss. 11.13(5)
Evidence of the authority	ss. 11.13(5) and r. 56	
Reply evidence	ss. 11.13(5) and r. 57	
Request for cross-examination	ss. 11.13(5) and r. 58(2)	
Filing of the transcript	r. 58(4)	
Withdrawal of evidence	r. 58(5)	
Filing of written arguments	r. 60(3)	
Request for hearing	r. 60(4)	

The service of proceedings and evidence thereto are effected by registered mail or by personal service (r. 53). The person objecting must file the statement of objection with the Registrar and serve it on the responsible authority (subsection 11.13(1) of the Act). An amendment of a statement of objection or counter-statement is possible with leave from the Registrar (r. 54).

Where in an objection proceeding any extension of time is granted to a party, the Registrar may thereafter grant a reasonable extension of time to the other party for the taking of any subsequent step (r. 61). Moreover, additional evidence may be adduced where leave is granted by the Registrar (r. 58(1)).

However, the sole reason for an objection is that the indication is not a geographical indication (subsection 11.13(2) of the Act).

TRADE-MARKS: SUGGESTED FORMS

Paragraph 65 b) of the Act permits the Governor in Council to make regulations for carrying into effect the purposes and provisions of this Act, namely on the form of applications to the Registrar. In virtue of rule 15 of the previous Trade-Marks Regulations, one had to use the forms mentioned in schedule II of those regulations. Such forms are no longer mentioned in the Trade-Marks Regulations (1996). However, rule 14 of these regulations foresees that the Registrar may publish forms in the Trade-Marks Journal.

In fact, in the 1996.05.29 edition of the Trade-Marks Journal (vol. 43, No 2170, p. 152), the Registrar did publish suggested forms. These are nearly the same as those mentioned in the schedule II of the previous regulations.

It is of interest to remember that section 32 of the Interpretation Act R.S.C. 1985, c. I-21 is to the effect that once a form is prescribed, variations that do not modify the substance nor are of the type to induce error, do not invalidate the form used: see *Houde v. Commission des Ecoles Catholiques du Québec*(1977), (1978) 1 S.C.R. 937 Dickson J. at page 944. In any case, the non compulsory character of the forms proposed by the Registrar is recognized in his practice notice.

PART III - AMENDMENTS TO THE CANADIAN PATENT ACT AND PATENT RULES

by
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The Canadian *Patent Act* and *Patent Rules* have been amended and the new amendments have come into force on October 1st, 1996.

Here are the main points which might be of interest in the preparation, filing and the prosecution of a patent application in Canada after October 1st, 1996.

FILING REQUIREMENT (novelty)

The "first to file" system which Canada had adopted on October 1st, 1989 along with the "grace period" of one (1) year continue. The "grace period" provides to an inventor the opportunity of filing an application in Canada even if the invention has been disclosed by himself or by a person who has obtained knowledge, directly or indirectly, from him in such a manner that the invention had become available to the public in Canada or elsewhere.

The requirement that an application be filed in Canada before issue of a patent to the inventor or his legal representative for the same invention in any other country is repealed. Therefore, if the "grace period" and the other requirements of the Canadian Patent Act are respected, an applicant can validly file a patent application in Canada even though a patent has already issued on the same invention in another country of the world.

CONVENTION DATE (priority)

If a request for priority is not made when filing an application in Canada, it has to be made before the expiry of a period of four (4) months from the filing date of the application in Canada. The applicant should submit to the Canadian Patent Office, within this period of four (4) months, the date and the country of each priority application. The number of each priority application should be submitted to the Canadian Patent Office before the expiry of the later of a four (4) month period after the filing date of the application in Canada and a twelve (12) month period after the date of filing of each priority application.

After this period, there will be no possibility of claiming a priority date. Formerly, such period was six (6) months.

REQUEST FOR EXAMINATION

A request for examination should be filed before the expiry of a period of five (5) years after the filing of an application in Canada. Formerly, such period was seven (7) years.

Here are some practical examples how this new rule applies.

For an application filed in Canada after October 1st, 1996, the request for examination should be filed within a period of five (5) years from the date of filing of the application at the Canadian Patent Office.

For an application filed in Canada before October 1st, 1996, the request for examination should be filed within a period of seven (7) years from the date of filing of the application at the Canadian Patent Office.

For a PCT national phase application in Canada, the request for examination should be filed within a period of seven (7) years from the international filing date of the PCT application, if such international filing date is before October 1st, 1996, and within a period of five (5) years from the international filing date of the PCT application if such international filing date is after October 1st, 1996.

A PCT international filing date is considered to be a Canadian filing date if the national phase in Canada is filed.

If the request for examination is not filed in due time, namely within one of the above-mentioned periods, the application becomes abandoned. It is possible to have it reinstated within a period of one (1) year from the date of the abandonment. The one (1) year period for reinstatement is retroactive and applies as well to applications abandoned under the former Act and Rules as to applications abandoned under the amended Act and Rules in force on October 1st, 1996. For example, an application filed in Canada on October 1st, 1989, is considered to have been abandoned if the request for examination was not filed therein on October 1st, 1996. It can be reinstated within a period of one (1) year from the date of abandonment, namely up to October 1st, 1997. Under the former Act and Rules, it could have been reinstated within a period of only six (6) months from the date of abandonment, namely up to April 1st, 1997.

OBVIOUSNESS

The subject-matter defined by a claim in an application for a patent in Canada must not have been obvious to a person skilled in the art or science to which the invention pertains before the "claim date" of an application. This new section in the Patent Act introduces a requirement of non-obviousness which was not formerly specifically found in the Act.

The "claim date" is defined as being the date of filing of an application in Canada or the priority date, if any.

MAINTENANCE FEES (annuities)

For any patent application filed after October 1st, 1989, maintenance fees (annuities) are to be paid in order to maintain an application in effect or a patent in force.

APPLICATIONS

If the maintenance fee (annuity) is not paid on time in an application, the latter becomes abandoned. It is possible to have it reinstated within a period of one (1) year from the date of the abandonment. The one (1) year period for reinstatement is retroactive and applies as well to applications abandoned under the former Act and Rules as to those abandoned under the new amended Act and Rules in force on October 1st, 1996.

Example:

An application abandoned on April 1st, 1996 by failure to pay the maintenance fee (annuity) therein can be reinstated within one (1) year of the date of abandonment, namely up to April 1st, 1997. After that date the application becomes irrevocably abandoned. Under the former Act and Rules, it could have been reinstated within a period of only six (6) months of the date of abandonment, namely up to October 1st, 1996.

PATENTS

If the maintenance fee (annuity) is not paid on time in a patent, there is a "grace period" of one (1) year for paying it along with an additional fee for late payment. The one-year (1) "grace period" for late payment is retroactive and applies as well to patents falling under the former Act and Rules as those which are due to be granted under the amended Act and Rules. The one-year (1) "grace period" applied to a patent corresponds to the one-year (1) period for reinstating an application.

Example:

A maintenance fee which was due in a patent on April 1st, 1996 and which has not been paid on time could be paid within a "grace period" of one-year (1) ending on April 1st, 1997, accompanied by an additional fee for late payment. After that date, the patent irrevocably lapses and cannot be revived. Under the former Act and Rules, it was possible to pay the maintenance fee, along with the additional fee, only within a period of six (6) months from the date on which the maintenance fee was due, namely up to October 1st, 1996.

There is the possibility of paying together and in advance several maintenance fees (annuities).

RECORDAL OF TRANSFER (assignment, licence) AND OF CHANGE OF NAME

For the recordal of an assignment, a licence or a change of name, it is now possible to submit copies of documents attesting of such transfer or change unless for some other reasons the Canadian Patent Office request further official proofs. Formerly, originals or certified copies of documents were necessary.

NUCLEOTIDES OR AMINO ACIDS

Where an application describes a nucleotide or an amino acid sequence, the description should contain in respect of the sequence, a sequence listing on a separate sheet of the description entitled "Sequence listing". Each sequence should be established according to symbols and a mode of presentation recognized at the international level and set forth in the Rules. Furthermore, the applicant should furnish sequence listings on a computer-readable form diskette of the PATENTIN type. The object of the sequence listing in computer-readable form diskette is to facilitate the search that the Patent Office might have to carry out concerning any information on the nucleotides or amino acid sequences.

BIOLOGICAL MATTER

When an application refers to a deposit of biological material, the applicant may in order to complete the description of the invention in the application, submit with an international depository authority on or before the filing date of the application a deposit of the biological material. The applicant should inform the Commissioner of the name of the international depository authority, the date of the original deposit and the accession number given by the international depository authority to the deposit, before the application is open to public inspection.

An application filed before the coming into force of the present amended Act and Rules can take advantage of the provisions of the present amended Rules concerning any deposit of biological material. This means that the amended Rules are retroactive for former applications and patents under specified conditions.

SMALL ENTITY DEFINITION

The Small Entity provisions have been amended. In the amended Rules, a "Small Entity" in respect of an invention means:

an Entity that employs fifty (50) or fewer employees or that is a University, but does not include an Entity that:

a) has transferred or licensed, or is under a contractual or other legal obligation to transfer or license, any right in the invention to an entity, other than a University, that employs more than fifty (50) employees, or

b) has transferred or licensed, or is under a contractual or other legal obligation to transfer or licence, any right in the invention to an entity that employs 50 or fewer employees or that is a University, and has knowledge of any subsequent transfer or licence of, or of any subsisting contractual or other legal obligation to transfer or licence, any right in the invention to an entity, other than a university, that employs more than 50 employees.

According to the new Rules, an applicant or patentee can qualify as a Small Entity if it satisfies the requirements set forth above. In particular, a University can now qualify as a Small Entity if it satisfies the above requirements.

The notion of Small Entity is "dynamic" and not "static". This means that an applicant or patentee can change its status from time to time.

The Small Entity provisions have come into force in Canada on July 1st, 1985 and till now they have not been interpreted by a Canadian tribunal and no court decision has been rendered concerning the non-observance of the correct status of an applicant or patentee. It is therefore difficult to anticipate the decision of a Canadian tribunal against a patent for which an application was filed claiming the status of Small Entity, despite the fact that the applicant was not entitled to claim such status.

It is highly recommendable to furnish to the Canadian Patent Office the correct status of an applicant or patentee in order to avoid any eventual unfavorable Court decision if the matter goes before a Canadian tribunal. Furthermore, if during the pendency of an application or the life of a patent the status of an applicant or patentee changes to become a "Large Entity", it is highly advisable to inform the Canadian Patent Office of this fact and to pay the necessary fees accordingly.

LIMITATION PERIOD

No remedy may now be awarded for an act of infringement committed more than six (6) years before the commencement of the action for infringement.

SIZE AND FORM OF SHEETS

The size and the form of the sheets of an application filed at the Canadian Patent Office should respect specific requirements set forth by the Canadian Patent Office. The main elements of these requirements are the following:

1.- Margins:

	<u>Recommended</u>	<u>Minimum</u>
Top:	2 cm (app. 7/8 in.)	2.5 cm (1 in.)
Left side:	2.5 cm (app. 1 in.)	3 cm (1 1/4 in.)
Right side:	2 cm (app. 7/8 in.)	2.5 cm (1 in.)
Bottom:	2 cm (app. 7/8 in.)	2.5 cm (1 in.)

It is recommendable to leave slightly more margins than the required minimum in order to take into consideration the fact that when copies are made some portions of the margins are "taken off".

2.- The typing should preferably be made with double spaced lines (the minimum required is 1 1/2 lines).

3.- The text should be typed with characters the capital letters of which are not less than 0.21 cm high. Do not type more than 12 characters per inch or 2 1/2 cm.

4.- The lines of each page of the description and of the claims may be numbered in the left margin. We recommend you to number them every fifth (5th) or tenth (10th) line.

5.- The pages of the description and the claims shall be numbered consecutively. The page numbers should be centred at the top or bottom of a sheet but should not be placed in the margins.

6.- The title of the invention must appear on the first page of the description, while respecting the required margin, and should preferably also appear on the page containing the abstract.

For PCT applications, the Canadian Patent Office considers that the above requirements are already satisfied at the international level.

ROBIC + LAW
+ BUSINESS
+ SCIENCE
+ ART

ROBIC + DROIT
+ AFFAIRES
+ SCIENCES
+ ARTS

