



## ASSIGNMENTS, CHANGES OF NAME, SECURITY INTERESTS AND OTHER TRANSFERS

As of October 30, 2019, Canada modernizes its regime regarding registration of ownership of patents and patent applications, as well as simplifying the requirements in order to register a change. Under the new regime, the Patent Act promotes the concept of “transfer”, and which transfers can and should be recorded at the Patent Office.

Importantly, an assignment (transfer) from the current owner to a new owner will **not** require the filing of a document to that effect if the transfer is requested by the current owner. This means that the agent of record, acting on behalf of the current owner, will be able to write in a transfer without submitting supporting evidence. This mechanism also works for a change of name of the applicant or patentee. It is unclear under which provision (transfer or change of name) mergers fall, but we believe that the proper mechanism will be to proceed under the transfer provisions.

However, a transfer that is requested by the **new owner (transferee)** will still be subjected to the requirement of providing satisfactory evidence to the Commissioner of this transfer. In addition, unless it is specifically indicated in the request to record the transfer, the **current agent** is deemed to have been appointed by the transferee.

The formal requirements regarding assignment documents have also been relaxed, and it will no longer be required to have a witness present at the signature of an assignment (or other document) in order to register a document with CIPO.

In all cases, the request for the recordal of a transfer must include at the very least the name and postal address of the transferee.

There is also a new provision to **remove** the recordal of a transfer of an application or patent, if the Commissioner is satisfied, through evidence, that the transfer should not have been recorded. Note that the removal of a recording is not possible because the transferor had previously transferred the patent or application to another person.

Finally, it is not possible to register a transfer of an application after the day on which the final fee is paid, or if the final fee is refunded, after the day on which the final fee is paid again and until the grant of the patent. Of course, once the patent issues, any transfer can be registered.

Any other document can also be **registered** regarding a patent or patent application and can be submitted by anyone. However, the registration of a document will simply place the document on file and will not be treated as a recordal request.

Any document, any transfer or any change of name that is registered requires the payment of the fee of 100\$ per document, transfer or change of name.

The Rules coming into force on October 30, 2019 also introduce the concept of a “**common representative**” where there are multiple applicants, to appoint one of the multiple applicants as the common representative. The common representative will typically be named in the petition on the filing date of a regular application, or in a notice submitted at the time of national phase entry for a PCT application.

When recording a transfer, if the rights of the previous common representative are transferred to a single person, then that person will become the new common representative. However, if the rights of the previous common representative are transferred to more than one person, the common representative becomes the transferee whose name appears first in the request to record the transfer, unless a different common representative is request.

For any questions, please write to us at [plt@robic.com](mailto:plt@robic.com)