



FILING PATENTS IN CANADA

A Practical Guide

miltons ip

No mysteries, no surprises.

We make foreign filings straightforward.

TABLE OF CONTENTS

Table of Contents	1
Summary.....	2
Approximate Costs	3
The cost to file a patent application in Canada.....	3
Generate a quotation online at www.canadian-patent.com	3
Filing Requirements: PCT National phase.....	4
Payment of “year 2” maintenance fee on National Entry.....	4
PCT Deadline: up to month 42	4
Deadlines for filing patents in Canada.....	5
Requirement to appoint a patent agent of record	6
Changing Patent Agents	6
Sample Revocation and appointment of new agent form	7
Powers of Attorney & Declarations of legal representative.....	8
The Declaration of Legal Representative	8
Sample Declaration of Legal Representative	9
Small Entity Status	10
The Definition of a Small Entity in Canada	10
Sample Small Entity Declaration	12
Who is the applicant: Assignments	13
Maintenance fees for Canadian Patents	14
Who can pay the maintenance fees.....	15
Reinstatement for failure to pay maintenance fees	15
Examination.....	15
Deferral of examination	15
The patent prosecution highway & deferred examination.....	16
Accelerated examination	16
The Patent Prosecution Highway Flowchart	18
Comparison: PPH v. Regular Examination.....	19
Exerpt from our schedule of fees	20

No mysteries, no surprises.

We make foreign filings straightforward.

SUMMARY

The Canadian economy is the 11th largest economy in the world and 30,000 patents are filed in Canada each year by non-Canadians.

Canadian patents can usually be secured easily and at modest cost compared to other countries.

\$1100 US

The cost to **file** a patent application in Canada will be \$1100. There are no extra filing fees for length, number of claims, or claim structure, and thus few voluntary amendments required at filing

\$4000 US

The total cost (including filing to allowance) including government fees if you take advantage of the patent prosecution highway.

12, 30 & 42!

The normal deadlines for filing (month 12 for Convention filings, month 30 for PCT national phase), but there is potential to extend the deadline for PCT national entry phase to month 42 for a very modest additional cost

1

Only one simple document must be signed in all cases by the applicant (the Declaration of Legal Representative). A second document, a Small Entity Declaration, is required where applicable.

All of these issues and more are covered in more detail in this guide which provides clear answers to all of the key issues that non-Canadian patent applicants will want to know prior to filing their application in Canada.

Of course, we would be pleased to answer any questions.

Contact us by phone or email at any time.

We look forward to serving you.

No mysteries, no surprises.

We make foreign filings straightforward.

APPROXIMATE COSTS

THE COST TO FILE A PATENT APPLICATION IN CANADA

\$1100

The total cost to file an application in Canada is \$1100, inclusive of our fees and the government fee. The only government fee that must be paid for all Canadian patent applications when they are filed is the filing fee which is \$400 for a large entity, and \$200 for a small entity (see “Small Entity Declaration below).

At filing of the application there are **no** additional fees dependent on the number of claims, or the type of claims, or the length of the application.

At filing of the application there is no requirement to pay search or examination fees.

Additional fees may apply for assignments, maintenance fees and the like.

Note: there are no excess filing fees in Canada for such things as extra pages, number of claims, multiple dependent claims, etc. and thus **voluntary amendments at the time of filing are rarely required.**

GENERATE A QUOTATION ONLINE AT www.canadian-patent.com

We know that clients want clarity and certainty. Our motto is ‘**no mysteries, no surprises**’, and this applies to our fees. On our website, www.canadian-patent.com, you will find a price quotation calculator. By providing information about your specific application, you can use this calculator to generate a price for filing a specific application into Canada.

A copy of the quotation will be immediately emailed to you for your records.

Alternatively, if you contact us directly by email or phone with details of the potential application, we can generate and email you a firm price quotation for a specific application – usually within one business day.

An excerpt from our Schedule of Fees appears at the end of this guide.

FILING REQUIREMENTS: PCT NATIONAL PHASE

The requirements to initiate a PCT National Entry into Canada are:

1. PCT Number;
2. Priority Date;
3. Declaration of Legal Representative (see below);
4. A translation of the specification into English or French in machine readable form when a copy of the specification is not available from WIPO in either of these two languages;
5. Small entity status election (if applicable - see below); and
6. Filing fee.

Note that if the applicant provides item 1 above, then items 2 & 4 can often be retrieved directly from WIPO (assuming, of course, that the PCT application was in English or French).

Unless you require early examination, Canadian patent agent does not need instructions regarding examination when the application is filed.

PAYMENT OF “YEAR 2” MAINTENANCE FEE ON NATIONAL ENTRY

Most PCT national entry phase patents in Canada are filed “at month 30” which is only six (6) months before the “Year 2” maintenance fee (24 months from the ‘filing date’ which is usually the date that the priority PCT application was filed) is due. Accordingly, it is convenient, but not necessary, to pay the Year 2 maintenance fee simultaneous with PCT national phase filing.

PCT DEADLINE: UP TO MONTH 42

PCT to 42

The Deadline for entering National Phase in Canada is 30 months from the earliest priority date, or from the International Filing Date if the PCT application does not claim priority. However, this deadline for PCT national phase filing can often be extended by another 12 months, (i.e. to “month 42” from the earliest priority date), on filing suitable request and payment of a government fee.

DEADLINES FOR FILING PATENTS IN CANADA

Disclosure

Canada is not a pure absolute novelty regime. Like the United States, it has a 12 month grace period for disclosures by the applicant.

However, the rules for triggering disclosure are slightly different in Canada from the US. The public disclosure statutory bar is triggered only by an **enabling** disclosure of the invention to third parties not under a duty of confidence. Canadian law does not automatically deem disclosure to take place when a product which embodies the invention is made available for sale. The disclosure must be 'enabling'. Any enabling disclosure, regardless of how or where in the world it is made triggers the deadline.

No CIPs

Priority follows the Paris Convention.

There is no continuation-in-part practice under Canadian law: published applications of the applicant will be cited against late applications by that applicant.

PCT to 42

The Deadline for entering National Phase in Canada is 30 months from the earliest priority date, or from the International Filing Date if the PCT application does not claim priority.

However, this deadline for PCT national phase filing can often be extended by another 12 months, (i.e. to “month 42” from the earliest priority date), on filing suitable request and payment of a modest government fee.

No mysteries, no surprises.

We make foreign filings straightforward.

REQUIREMENT TO APPOINT A PATENT AGENT OF RECORD

Non-Canadian applicants must designate a registered Canadian patent agent of record, who is the sole person authorized to correspond with CIPO about the pending application. In Canada, there is no 'patent attorney' designation; licensed practitioners are 'patent agents' (some attorneys, of course, are also be patent agents).

CHANGING PATENT AGENTS

An applicant can change agents on a pending application or granted patent at any time.

In order to change agents, the application must 'revoke' its patent agent of record and replace that agent with a new one.

To effect such a change, the applicant must complete and file the appropriate 'revocation and appointment of agent' form. Again, this form is in lieu of a Power of Attorney. A sample form follows. This form can be downloaded from our website, and of course we prepare and send all forms as required for our clients.

No mysteries, no surprises.

We make foreign filings straightforward.

SAMPLE REVOCATION AND APPOINTMENT OF NEW AGENT FORM

BEFORE THE CANADIAN INTELLECTUAL PROPERTY OFFICE

Inventor(s):
Applicant(s):
Title:
Canadian
Application
No.:
Filed:
Our File:

To: Commissioner of Patents,

Canadian Intellectual Property Office
50 Victoria Street, Place du Portage, Phase I
Gatineau, QC K1A 0C9 CANADA

Appointment of Representative and Agent

The undersigned hereby revokes the nomination of any Representative heretofore nominated in this application, and hereby nominates **Miltons IP/p.i.** whose full post office address in Canada is Suite 203, 2255 Carling Avenue, Ottawa, ON, K2B 7Z5, Canada, to be its Representative for all purposes of the said Act, including the service of any proceedings taken thereunder.

The undersigned also hereby revokes the appointment of any Agent heretofore appointed in this application and hereby appoints the said Miltons IP/p.i. as Agents, with full power to appoint an Associate Agent as provided in the Patent Rules and to revoke such appointment; to sign the petition and drawings; to amend the specifications and drawings, to prosecute the application, and to receive the patent granted on the said application. And the undersigned hereby ratifies any act done by the said Agent in respect of the said application.

Dated at _____, this ____ day of _____, 20__.

Signature: _____
(Authorized signatory of the Applicant)

Name: _____

Title: _____

No mysteries, no surprises.

We make foreign filings straightforward.

POWERS OF ATTORNEY & DECLARATIONS OF LEGAL REPRESENTATIVE

There is no requirement in Canada for the applicant to provide the patent agent of record with a Power of Attorney, and no obligation of the patent agent to provide any formal proof of authority to act.

Canadian patent agents frequently seek confirmation from clients of their engagement and authority to represent the client – and thus, frequently use powers of attorney to confirm this engagement.

If the applicant is not the inventor, the applicant must file with CIPO a declaration to the effect that the applicant is entitled to apply because it is the ‘legal representative’ of the inventor. The language is confusing, but the intent is not: the applicant is entitled to apply for a patent if it is the successor in title to the inventor. Accordingly, the Declaration of Legal Representative is the formal document filed with CIPO which confirms the applicant’s authority with respect to the application.

THE DECLARATION OF LEGAL REPRESENTATIVE

The definition of legal representative found in the *Patent Act* is:

“legal representatives” includes heirs, executors, administrators, guardians, curators, tutors, assigns and all other persons claiming through or under applicants for patents and patentees of inventions;

Note that this definition is “inclusive but not exhaustive”.

Formalities:

A simple statement, signed by the applicant (or authorized signing officer of the applicant in the case of a corporation) which identifies the inventor and states that the “applicant is the legal representative of the inventor” will meet the requirements.

Notarization of the Declaration of Legal Representative is **not** required.

We do not require an original of the Declaration of Legal Representative – a PDF or fax is sufficient.

No mysteries, no surprises.

We make foreign filings straightforward.

A sample Declaration of Legal Representative appears below. This form can be downloaded from our website and of course we prepare and send our clients all necessary forms for their applications.

SAMPLE DECLARATION OF LEGAL REPRESENTATIVE

IN THE CANADIAN INTELLECTUAL PROPERTY OFFICE	
Canadian Patent Application No:	_____
National Phase Entry of:	_____
Filed:	_____
Title:	_____
Applicant(s):	_____
Inventor(s):	_____
DECLARATION OF LEGAL REPRESENTATIVE	
The inventor(s) is/are _____, whose full post office address(es) is/are _____, and the applicant is the legal representative of the inventor(s).	
Dated at (place of execution; city/state/country) _____, this _____ day of _____, 20__.	
_____ (Name of Applicant)	Witness:
Signature: _____ (Authorized Signatory of the Applicant)	Signature: _____
Name: _____	Name: _____
Title: _____	

SMALL ENTITY STATUS

All entities are large entities unless they qualify for small entity status.

Small is
<50

Like the United States, Canada charges half fees for small entities. Unlike the United States, there is no ‘micro entity’ status, and, the definition of a small entity really is small (50 or fewer employees, with contractors and part-timers included).

Small is
forever

Unlike in the United States, the rule in Canada is “once a small entity application, always a small entity application” for any given application. Thus, if the applicant qualifies as a small entity when the application is filed, then the application forever remain a small entity application.

Different status may apply to subsequent applications filed by the same applicant.

THE DEFINITION OF A SMALL ENTITY IN CANADA.

Rule 3.01(3) of the *Patent Rules* provides:

“small entity”, in respect of an invention, means an entity that employs 50 or fewer employees or that is a university, but does not include an entity that:

- (a) is controlled directly or indirectly by an entity, other than a university, that employs more than 50 employees; or
- (b) has transferred or licensed or has an obligation, other than a contingent obligation, to transfer or license any right in the invention to an entity, other than a university, that employs more than 50 employees

No mysteries, no surprises.

We make foreign filings straightforward.

Small Entity Status in Canada

The benefit	Approximately \$3000 in savings in government fees over the life of the patent
The risks	When in doubt, you are a large entity. If small entity status is claimed incorrectly, the patent is invalid. Only claim small entity status when you are clearly entitled to do so.
The time	Entity size is determined when the application is first filed in Canada. Subsequent changes in entity size (up or down) do not affect that application.
Our advice	Claim small entity status when you clearly qualify, and do not claim it if there is any doubt.
Our policy	We will only claim Small Entity Status on behalf of an applicant if we have received a signed Small Entity Declaration. If it is not available at the time of filing, we will file as a large entity – it may be filed later to reduce subsequent government fees on that application.
The form	A sample Small Entity Declaration follows. A soft copy may be downloaded from our website. Of course, we prepare and send these to our clients for execution.

No mysteries, no surprises.

We make foreign filings straightforward.

SAMPLE SMALL ENTITY DECLARATION

BEFORE THE CANADIAN PATENT OFFICE

Canadian Patent Application No: _____

National Phase Entry of: _____

Filed: _____

Title: _____

Applicant(s): _____

Inventor(s): _____

SMALL ENTITY DECLARATION

The applicant believes that in accordance with the *Patent Rules* they are entitled to claim status as a small entity and pay fees at the small entity level in respect of this application and in respect of any patent issued on the basis of this application.

Dated at (City/State/Province/Country) _____ this ____ day of _____, 20__.

(Name of Applicant)

Signature: _____
(Authorized Signatory of the Applicant)

Name: _____

Title: _____

Witness:

Signature: _____

Name: _____

WHO IS THE APPLICANT: ASSIGNMENTS

Canadian patent applications always name the owner as applicant. Inventors are only named as the applicant if they are also the owner.

When: If WIPO's records at the time of national entry into Canada properly reflected the correct ownership, then the ownership on the Canadian petition will be sufficient and no additional documentation of assignments will need to be filed. If this not the case, or, if the ownership of the patent subsequently changes after national entry, then it is necessary to register an assignment.

Cost: The cost to register an assignment is \$300.

Date: The assignment must have been entered into prior to the International Priority Date, or, be a confirmatory assignment which expressly has effect before such date.

Formalities: The Canadian an assignment of a patent must be signed by the assignor **and witnessed at the time of execution by another individual.**

Patent assignments in Canada do not require a signature of the assignee, nor do they need to be notarized.

It is **not** necessary to provide the original assignment for registration purposes in Canada. A copy, fax or scan is sufficient.

MAINTENANCE FEES FOR CANADIAN PATENTS

Maintenance fees (known in some other jurisdictions as renewal fees or annuity fees) **are payable in each year**, both before and after grant. In total, maintenance fees for Canadian patents are approximately half the amount for US patents, but applicants should be prepared for this expense being incurred annually.

Annual Maintenance Fees (Government fees)		
Payable each year		
	Government fee	
	Small Entity	Large Entity
Years 2, 3, 4	\$50.00	\$100.00
Years 5, 6, 7, 8, 9	\$100.00	\$200.00
Years 10, 11, 12,13,14	\$125.00	\$250.00
Years 15, 16, 17, 18, 19	\$225.00	\$450.00

These fees are the government fees only and do not include the service fees – of our firm, or anyone else – who pays the maintenance fee on behalf of the applicant.

For example, our current services fees are \$150 per maintenance fee for individual applications. Please consult our schedule of fees for more information, or ask for a quote in advance. **Please contact us to discuss volume discounts.**

No mysteries, no surprises.

We make foreign filings straightforward.

WHO CAN PAY THE MAINTENANCE FEES

Maintenance fees must be paid by the patent agent of record for the application while the application is pending (prior to grant). After the patent has been granted, the annual maintenance fees may be paid by anyone – either the agent of record, the applicant, or a third party.

REINSTATEMENT FOR FAILURE TO PAY MAINTENANCE FEES

If a patent has lapsed for failure to pay an annual maintenance fee on time, the patent can be reinstated upon payment of a modest government fee provided that the request for reinstatement and payment are received by the patent office **within 12 months of the original deadline**.

EXAMINATION

Patent examination in Canada is commenced upon request by the applicant and payment of the applicable fees (\$800 large entity, \$400 small entity)

It is not necessary to pay these fees when the Canadian application is first filed, nor does examination commence automatically when the application is filed.

Examination can be requested at any time from filing until the fifth (5th) anniversary of the filing date (e.g. date the original PCT application is filed).

Accordingly, to defer costs, many applicants **do not** request examination immediately when their Canadian application is filed.

DEFERRAL OF EXAMINATION

Examination of a Canadian patent can be deferred for up to five years without any deferment fee. This deferral is extremely powerful when coupled with the patent prosecution highway and the patent is prosecuted to allowance in another jurisdiction.

No mysteries, no surprises.

We make foreign filings straightforward.

THE PATENT PROSECUTION HIGHWAY & DEFERRED EXAMINATION

The Canadian system of deferred examination without cost fits perfectly with the patent prosecution highway (“PPH”) program, thereby permitting many applicants to defer – and dramatically reduce – the cost of prosecuting their Canadian patent applications.

The patent prosecution highway is the name given to a series of bi-lateral agreements between national patent offices to mutually recognize successful prosecution in their respective offices. Canada is a party to a large, and ever-growing, number of these agreements with ‘corresponding’ patent offices, which currently include the United States, the UK, Denmark, Germany, Korea, Australia and others.

The PPH can be invoked from a positive PCT IPRP/WO.

Canada’s practice of permissive deferred examination without cost fits perfectly with the PPH. We encourage most of our clients to strongly consider ‘defer examination, invoke the PPH later’. Because of the massive increase in prosecution certainty that the PPH provides, and the delay, uncertainty and effort it removes from the conventional prosecution process in Canada, we are able to provide ‘very competitive flat fees’ from application to grant. Please contact us for a detailed price quote.

We have provided a flowchart below on how the PPH operates, a table that outlines usual cost savings, and a simple summary form for most clients. Online, at www.canadian-patent.com we have provided videos that explain how the PPH works, and how it can be helpful for applicants for Canadian patents.

ACCELERATED EXAMINATION

It is relatively straightforward and inexpensive to request accelerated examination of a patent application in Canada.

No formal petition is required, nor is the applicant required to substantiate the request. All that is required is a statement to the effect that the applicant’s rights will be prejudiced if the application is not examined faster than under normal examination, and a request for early publication if the application has not been published already.

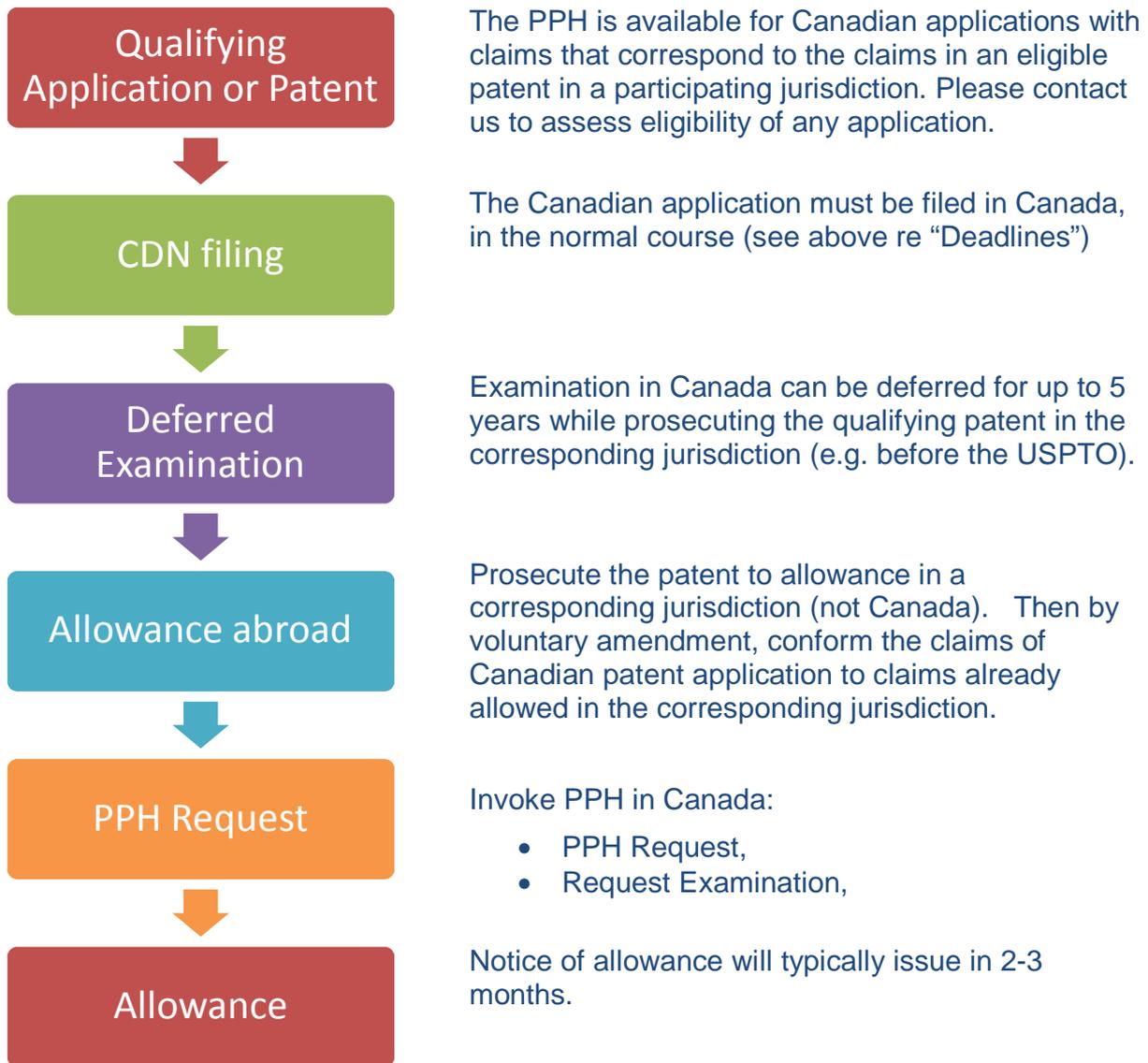
Accordingly, accelerated examination in Canada is readily available to get ‘an allowed Canadian patent ‘faster than normal’ at modest extra cost.

No mysteries, no surprises.

We make foreign filings straightforward.

In addition, accelerated examination in Canada can perhaps be combined with patent prosecution highway treatment in other countries where a corresponding application is pending and that have a PPH agreement with Canada to reduce prosecution costs outside Canada and to expedite examination in jurisdictions beyond Canada.

THE PATENT PROSECUTION HIGHWAY FLOWCHART



To access the PPH, the key step is ensuring that the claims of the Canadian patent correspond to claims in an eligible patent in a participating jurisdiction. Assuming that this criterion is met, the process minimizes prosecution in Canada. The result: an issued Canadian patent with claims equivalent to those allowed in the corresponding jurisdiction.

No mysteries, no surprises.

We make foreign filings straightforward.

COMPARISON: PPH V. REGULAR EXAMINATION

The greatest benefit of the PPH is the certainty it brings to prosecution in Canada. If you can prosecute claims through to allowance in a corresponding jurisdiction, then it is very likely that you will be able to secure exactly the same claims in Canada quickly, efficiently, and economically.

The PPH also reduces **prosecution** costs in Canada.

Item	PPH	Regular Examination
Time Frame	Notice of Allowance within 60 days	First Office Action within 2-3 years
Government Fee	\$400/\$800	\$400/\$800
Firm Fee for Exam	\$700	\$300
Prosecution Fees (including paying final fee and forwarding letters patent)	\$1,100	\$2,000++
TOTAL	\$2,200/\$2,600 (small entity/large entity)	\$2,700-\$3,100++ (small entity/large entity)

The PPH does not reduce other costs: the costs of filing, assignments, issuance (allowance) and annual maintenance are not affected by the PPH program.

In our firm, we are able to provide flat fee prices to ensure that you have complete price transparency and certainty.

Please contact us for details and to confirm your quote.

No mysteries, no surprises.

We make foreign filings straightforward.

EXERPT FROM OUR SCHEDULE OF FEES

	Our Fee	Government Fee (Large entity/small)
Reporting Office Actions without comment	\$0.00	--
Responding to an Office Action	\$275+	--
Filing Declaration of Legal Rep after initial filing	\$200	-
Filing Small Entity Declaration at initial filing	\$150	
Filing Small Entity Declaration after initial filing	\$200	
Requesting examination	\$300	\$800/\$400
Accelerated Examination	\$250	\$500
Patent Prosecution Highway		
Maintenance fees Years 2-4	\$150	\$100/\$50
Allowance	\$550	\$300/\$150