



FILING PATENTS IN CANADA

A Practical Guide

miltons ip

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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.

\$1305 CAD

The cost to **file** a patent application in Canada will be \$1305 CAD. There are no extra filing fees for length, number of claims, or claim structure, and thus few voluntary amendments required at filing

\$3010 CAD

The approximate 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) apply. Filing up to month 42 is possible if the month 30 deadline was missed unintentionally.

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.

APPROXIMATE COSTS

THE COST TO FILE A PATENT APPLICATION IN CANADA

**\$1305
CAD**

The total cost to file an application in Canada is \$1305 CAD, 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 \$555 CAD for a large entity, and \$225 CAD 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. Statement of Entitlement (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);
6. Filing fee; and
7. A certified copy of the priority documents or access to them via an acceptable digital library. For PCT applications, if this was done at the International Stage, no separate certified copy required for Canada

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, the 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, filing up to month 42 is possible if missing month 30 deadline was unintentional.

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, filing up to month 42 is possible if missing month 30 deadline was unintentional.

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 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.

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: _____

POWERS OF ATTORNEY & THE STATEMENT OF ENTITLEMENT

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.

THE STATEMENT OF ENTITLEMENT

Each applicant must file with CIPO a statement of entitlement.

The statement of entitlement which is a formal document which confirms the applicant's entitlement to apply for the patent.

However, minimal formalities apply to the statement of entitlement. It is a simple statement -

Signed by the applicant (or authorized signing officer of the applicant in the case of a corporation) which states that the Applicant is entitled to file the application will meet the requirements.

The signature should be witnessed. Any adult can serve as the witness.

Notarization of the Statement of Entitlement is **not** required.

An original of the Statement of Entitlement is **not** required – a scan or good quality photo sent by email is sufficient.

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A sample Statement of Entitlement appears below.

This form can be downloaded from our website however you do not need to. We prepare and send our clients all necessary forms for their applications.

SAMPLE STATEMENT OF ENTITLEMENT

BEFORE THE CANADIAN INTELLECTUAL PROPERTY OFFICE	
Applicant(s):	_____
Inventor(s):	_____
Title:	_____
PCT No.:	_____
PCT Filing Date:	_____
Priority::	_____
Statement of Entitlement	
The applicant(s) is/are _____, whose full post office address(es) is/are _____, and the applicant is entitled to apply for a patent for the subject invention.	
Dated at (place of execution; city/state/country) _____,	
this _____ day of _____, 20__.	
Signature: _____	
(Authorized Signatory of the Applicant)	
Name: _____	Witness:
Title: _____	Signature: _____
	Name: _____

SMALL ENTITY STATUS

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

Small is
<100

Canada charges very reduced fees for small entities. Unlike the United States, there is no 'micro entity' status and the definition of a small entity is 100 or fewer employees, with contractors and part-timers included.

Small is
forever

In Canada "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, that application will remain a small entity application.

Large can
become
small

If the applicant has 51-99 employees and previously filed as a large entity, a small entity declaration can now be filed which will apply to all subsequent fees.

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 100 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 100 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 100 employees

Small Entity Status in Canada

The benefit	Approximately \$4000 CAD 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.

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 \$355 CAD.

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.

Update amounts below

Annual Maintenance Fees (Government fees)		
Payable each year		
	Government fee	
	Small Entity	Large Entity
Years 2, 3, 4	\$50.00	\$125.00
Years 5, 6, 7, 8, 9	\$100.00	\$277.00
Years 10, 11, 12,13,14	\$125.00	\$347.00
Years 15, 16, 17, 18, 19	\$253.00	\$624.00

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 \$220 CAD 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.**

WHO CAN PAY THE MAINTENANCE FEES

Maintenance fees before and after grant may be paid by anyone – the patent agent of record for the application, the applicant, or a third party.

It is very important to pay maintenance fees in full on time. A good docketing and reminder system to track deadlines and amounts is crucial to avoid abandonment.

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**.

However we strongly recommend paying maintenance fees on time.

If a maintenance fee deadline is missed, the Patent Office sends out a Notice requesting payment of the maintenance fee with a late fee. If the late fee deadline is missed, the application goes abandoned and must be reinstated, which requires a showing that the late fee deadline was missed although due care was exercised. This is a difficult standard to meet and the costs are significant.

EXAMINATION

EXAMINATION STARTS WHEN REQUESTED

Patent examination in Canada does not start automatically. It is commenced upon request by the applicant and payment of the applicable fees (\$1110 CAD large entity, \$450 CAD small entity).

It is not necessary to pay these fees when the Canadian application is first filed.

Examination can be requested at any time from filing until the fourth (4th) anniversary of the filing date (e.g. date the original PCT application is filed). It must be requested within 4 years of the filing date.

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

EXCESS CLAIMS FEES

Excess claim fees are payable when examination is requested for any claims above 20 (\$110 CAD large entity, \$55 CAD small entity for each claim in excess of 20).

Note that these excess claims fees are not payable when the application is first filed. Thus it may be possible to reduce costs by reducing the number of claims, long after the application is first filed in Canada.

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.

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.

CONTINUED EXAMINATION AFTER THE 2ND OFFICE ACTION

Additional fees must be paid to extend prosecution of an application beyond the second examiner's report.

The applicant may respond to the first two Examiner's Reports without paying an additional a government fee. However, to respond to a third Examiner's Report, the applicant must make a **request for continued examination** (RCE) and pay the request for continuation examination fee.

In 2024 this fee is \$450.00 CAD for small entities and \$1,110.00 CAD in 2024 for standard entities.

A request for continued examination allows the applicant to respond to an additional two Examiner's Reports.

(Note: RCE fees do not apply to applications for which examination was first requested prior to October 3, 2022).

CONTINUED EXAMINATION AFTER ALLOWANCE

An applicant can request continued examination if the applicant wishes to set aside a notice of allowance or conditional notice of allowance to further amend the application.

Note however, that the applicant cannot request continued examination to set aside the notice of allowance or conditional notice of allowance if the application has been abandoned for failure to pay the final fee.

DEFERRAL OF EXAMINATION

Examination of a Canadian patent can be deferred for up to four years without any deferment fee. No request is necessary – the applicant simply does not request examination.

This deferral is extremely powerful when coupled with the patent prosecution highway and the patent is prosecuted to allowance in another jurisdiction.

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 European Patent Office, the UK, Denmark, Germany, Korea, Australia and others.

The PPH can also 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.

THE PATENT PROSECUTION HIGHWAY FLOWCHART

Qualifying
Application or Patent



CDN filing



Deferred
Examination



Allowance abroad



PPH Request



Allowance

The PPH is available for Canadian applications with claims that correspond to the claims in an eligible patent in a participating jurisdiction. Please contact us to assess eligibility of any application.

The Canadian application must be filed in Canada, in the normal course (see above re “Deadlines”)

Examination in Canada can be deferred for up to 4 years while prosecuting the qualifying patent in the corresponding jurisdiction (e.g. before the USPTO).

Prosecute the patent to allowance in a corresponding jurisdiction (not Canada). Then by voluntary amendment, conform the claims of Canadian patent application to claims already allowed in the corresponding jurisdiction.

Invoke PPH in Canada:

- PPH Request,
- Request Examination,

Application is examined within 2-3 months. If any defects/objections are raised, they are typically minor in nature. If no defects/objections are raised, application goes straight to allowance.

To access the PPH, the key steps are: (i) ensuring that the claims of the Canadian patent correspond to claims in an eligible patent in a participating jurisdiction; and (ii) that the request for accelerated examination under the PPH is submitted prior to the Canadian Examiner issues a first Examiner’s Report.

Assuming that these criteria are met, the process minimizes prosecution in Canada. The result: an issued Canadian patent with claims equivalent to those allowed in the corresponding jurisdiction.

COMPARISON: PPH V. REGULAR EXAMINATION

Item	PPH	Regular Examination
Time Frame	Notice of Allowance within 60 days	First Office Action within 2-3 years
Government Fee	\$450/\$1110	\$450/\$1110
Firm Fee for Exam	\$700	\$340
Prosecution Fees (including paying final fee and forwarding letters patent)	\$1200	\$2,000++
TOTAL	\$2350/\$3010 (small entity/large entity)	\$2790-\$3450++ (small entity/large entity)

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.

No mysteries, no surprises.

We make Canadian patents straightforward.

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.

EXERPT FROM OUR SCHEDULE OF FEES

	Our Fee (CAD)	Government Fee (CAD) (Large entity/small)
Reporting Office Actions without comment	\$0.00	--
Responding to an Office Action	\$350+	--
Filing Statement of Entitlement after initial filing	\$230	-
Filing Small Entity Declaration at initial filing	\$165	
Filing Small Entity Declaration after initial filing	\$230	
Requesting examination	\$340	\$1110/\$450
Accelerated Examination	\$350	\$694
Patent Prosecution Highway		
Maintenance fees Years 2-4	\$220	\$125/\$50
Allowance	\$550	\$416/\$169