

Submission to the Canadian Intellectual Property Office

Consultation: Fee-For-Service Proposal — Patents

July 4, 2016



**INTELLECTUAL PROPERTY INSTITUTE OF CANADA
INSTITUT DE LA PROPRIÉTÉ INTELLECTUELLE DU CANADA**

The Intellectual Property Institute of Canada (IPIC) is the professional association of trademark agents, patent agents and lawyers practising in all areas of intellectual property law. Our membership totals over 1,700 individuals, consisting of practitioners in law firms and agencies of all sizes, sole practitioners, in-house corporate intellectual property professionals, government personnel, and academics. Our members' clients include virtually all Canadian businesses, universities and other institutions that have an interest in intellectual property (e.g. trademarks, patents, copyright and industrial designs) in Canada or elsewhere, and also foreign companies who hold intellectual property rights in Canada.

IPIC is pleased to respond to the request by the Canadian Intellectual Property Office (CIPO) for comments on the consultation entitled "Fee-For-Service Proposal — Patents". This submission was prepared by IPIC's Patent Practice Committee and approved by IPIC's governing Council.

Comments regarding specific fees proposed

Extension of time limits

The changes to the *Patent Act* brought about by the 2015 Economic Action Plan will allow the filing of a patent application without fee payment and without losing the filing date. The new regime will include an extension of up to two months to pay the filing fee from a CIPO notification.

In the case of a missed maintenance fee, the new regime will include an extension of 6 months over the present regime.

In the case of a missed Request for Examination, the new regime will include an extension of up to two months from a CIPO notification.

Accordingly, new late payment fees are being proposed:

- for failing to pay the filing fee upon filing an application;
- for failing to timely pay a maintenance fee; and
- for failing to timely pay the request for examination fee.

Each of these new fees has been set by CIPO at \$150.

IPIC believes these fees are reasonable.

Correction of errors and Amendment after allowance

The Economic Action Plan 2015 (EAP 2015) is meant to provide a more flexible approach to the correction of errors made by the applicant and the office and to amendment-after-allowance practice. Implementing the resulting changes will result in changes to two CIPO service fees.

The proposed fee for processing a request for a correction of an error will be at the current level of \$200 (the same as the current s. 8 clerical correction fee). IPIC believes this fee is reasonable.

The proposed fee for filing an amendment after allowance is \$400. IPIC generally agrees that this fee is appropriate given the possibility of a further search.

In addition, it is noted that Footnote 8 of the Technical Consultation Paper proposes that the required \$6.00 for each page of the specification and drawings in excess of 100 pages at issuance be eliminated for biological sequence listings in the proposed new regime. IPIC welcomes and agrees with the removal of this additional fee.

Summary

IPIC supports CIPO's proposed fee changes relating to patent services.