

Canadian Practice Update:

New Prosecution Fees

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Important Date

Coming-into-force date:

Monday, October 3, 2022

Impact On Clients - Excess Claim Fees

- A. When?
 - At request of examination
 - Reassessed at allowance

- B. How many claims?
 - Applicable over 20 claims
 - Multiple dependencies do not count as multiple claims
 - No cap on the number of independent claims

- C. How much?
 - \$100 CAD per excess claim (or \$50 CAD for a small entity)

Impact On Clients - Double-Patenting

- **Background:** Double-patenting in Canada:
 - No terminal disclaimer.
 - Solution in Canada is to present multiple claim sets, urging the Examiner to consider unity of invention between claim sets.
 - Once the Examiner declares that the claim sets lack unity of invention, a divisional application can be securely filed relating to one claim set.
- **Problem:** excess claim fees undermines this claim-intensive strategy.
- **Proposed solution:** file a voluntary amendment with request for examination that prioritizes independent claims.

Impact On Clients

- Request for Continued Examination

- Required after the issuance of the third office action to continue examination.
- Further required after every pair of office actions following the filing of the previous request for continued examination.
- Unitary cost: \$816 CAD (or \$408 CAD for a small entity).

Impact On Clients - Other Costs

- New costs at allowance:
 - Excess page fees (excluding sequence listings): \$6.12 for each page over 100.
 - Excess claim fees are recalculated at allowance to capture any new claims added during examination.

Other Minor Changes

- Ability to correct certain minor errors in filed translation.
- Addition of a conditional notice of allowance
 - similar to an Ex Parte Quayle Action
 - only amend to correct minor defects

How to Lower Costs for Clients?

Benefitting from the transitional provisions:

- A. Particularly for clients with large claim sets with pending applications in Canada:
 - request examination at the latest on **October 2, 2022** (before the coming-into-force date of October 3, 2022).
- B. **Benefit:**
 - no excess claim fees
 - no request for continued examination after first three office actions

How to Lower Costs for Clients?

Once the transitional provisions are no longer available:

- File a voluntary amendment with your request for examination to lower claims below 20,
 - prioritize independent claims.
- File a voluntary amendment after your request for examination, adding extra claims, over 20.
- Warn the client that excess claim fees are recalculated at allowance.

Key Points

- Coming-into-force date: **October 3, 2022**
- Deadline to request examination to avoid new fees: **October 2, 2022**
- Once the new Rules are in force:
 - prioritize independent claims.
 - file voluntary amendments to control costs at the request for examination, and reintroduce claims after.

QUESTIONS?

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