

New Requirements to Pay Excess Claim and Continuing Examination Fees in Canada

With effect from 03 October 2022, Canada will implement a new requirement to pay excess claim fees for Canadian patent applications. Under the amended *Rules*, applicants will be required to pay a fee of \$100 for each application claim in excess of twenty (20) when requesting examination, and if the number of claims is increased thereafter, on payment of the final fee based on the highest number of claims at any time after the request for examination was made.

Under the amended *Rules*, applicants will also be required to pay additional continuing examination fees on receipt of a third (3rd) Examiner's Requisition on the merits, as well as on every second (2nd) Examiner's Requisition received thereafter.

The amended *Patent Rules* will not apply to patent applications where examination has been requested prior to 3 October 2022. For complex cases, or for cases where larger numbers of claims are of interest, applicants may wish to request examination prior to the new *Rules* coming into force.

Canadian Divisional/Double Patenting Practice

The requirement to pay excess claim fees based on the overall highest number of claims pending at any time following the submission of the examination request presents additional challenges to applicants wishing to avoid proactively filing divisional applications absent an express unity objection, with a view to minimizing double patenting concerns.

Currently Pending Applications

For pending applications which are currently undergoing active examination and which have been subject to a previous unity refusal, applicants will remain entitled to file divisional applications up to the issuance or irrevocable abandonment of the parent case.

For any newly filed divisional application where examination is requested after 03 October 2022, applicants will be liable for excess claim fees under the new *Rules*. As such, where Claims Groups

having larger numbers of claims (i.e. more than thirty (30)) that have been previously cancelled, applicants may wish to consider proactively filing divisional applications and requesting examination prior to 03 October 2022, to secure the prosecution under the current *Patent Rules*.

Future Prosecution Strategies

For new applications, applicants wishing to secure a formal unity assessment to minimize double patenting concerns may wish to consider modified prosecution strategies.

For commercially significant inventions where larger numbers of claims are of interest, to avoid claim costs, applicants may choose to delay introducing multiple claim sets in an initial parent case until after examination is first requested. Thereafter if unity objections are received, applicants may then choose to directly file separate divisional applications to individual Claim Groups identified, and to permit the parent application to become abandoned by not paying required final fees.

Applicants may also wish to consider including multiple independent claims to different aspects of the described application initially following the examination request, and limiting numbers of subsequent dependent claims, until initial unity assessment is received. Following any unity objection, applicants presumably could present a claim set with further dependent claims directed to an individual targeted Claims Group only.

If you have any questions with respect to the propose *Rule* changes, or Canadian patent practice in general, please do not hesitate to contact our office.

If you have any questions regarding Canadian intellectual property matters remain, please do not hesitate to contact our office.

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