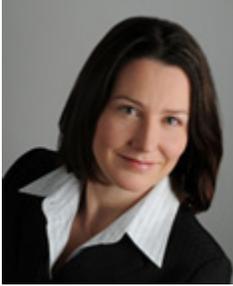




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Proposed Amendments to the Canadian *Patent Rules*

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On July 11, 2009, proposed amendments to the *Patent Rules* were published in the *Canada Gazette*, Part I for public comment. According to the Federal Government, the regulatory amendments, which are scheduled to take effect 30 days after they are registered, are aimed at improving legal certainty, simplifying processes, and ultimately reducing administrative burdens in patent prosecution. Although the majority of the proposed amendments appear to be house-keeping in nature, one substantive change will (if adopted) affect the requirements for completing a Canadian patent application and specifically, the requirement to establish entitlement to file an application.

Evolution of Changes

In recent years, many amendments to the *Patent Rules* have been made with respect to the process by which an Applicant applies for a patent in Canada. Prior to June 2, 2007, the *Patent Rules* specified that an applicant who was not the inventor was required to register evidence (generally in the form of an assignment) to establish that the Applicant was the legal representative of the inventor. Pursuant to the June 2, 2007 amendments, the above requirement was removed and an Applicant is now required, as part of the completion requirements for the filing of an application, to submit a declaration as to the Applicant's entitlement, as of the filing date, to file for and be granted a patent (referred to as "Declaration of Entitlement"). Some of the possible bases/grounds of entitlement include an assignment, an agreement, employment, etc.

Requirement to File "Declaration of Entitlement" Removed

The effect of the July 11, 2009 proposed amendment will be that an Applicant will no longer, for the purposes of "completing" an application, be required to file a "Declaration of Entitlement". The newly proposed rule states that if the inventor is the applicant, the application must simply contain a statement to that effect. When the Applicant is not the inventor, a statement that the applicant is the "legal representative" of the inventor(s) will be sufficient to complete the application. As for the current "Declaration of Entitlement" regime, no further evidence in the form of assignments will be required for completing an application. A "legal representative" of the inventor should include the owner of the rights to the invention, but may, as defined in section 2 of the *Patent Act* include "heirs, executors, administrators, guardians, curators, tutors, assigns and all other persons claiming through or under applicants for patents and patentees of inventions".

Registration of Assignments

It should be noted, however, that although the present requirement to file a "Declaration of Entitlement" and the new proposed amendments do not require the registration of assignments for "completing" an application, the Canadian *Patent Act* suggests that assignments should be registered. Section 49(1) of the *Patent Act*, provides that "a patent may be granted to any person to whom an inventor [...] has assigned in writing his right to obtain it..." [emphasis added]. The

Patent Act also provides that “[e]very assignment of a patent [...] shall be registered in the Patent Office in the manner determined by the Commissioner” (section 50) and that an assignment affecting a Canadian patent is void against a subsequent assignee unless the assignment is registered at the Patent Office (section 51).

Accordingly, Applicants should record at the Canadian Patent Office all chain of title documents from the inventor(s) to the Applicant, as well as any other changes in ownership (e.g. assignments, mergers, name changes, etc.) as soon as possible and no later than at the time of payment of the final issue fee in order to ensure that the patent grants in the proper name and to minimize any issues that may arise with regard to subsequent transfers of title and with regard to a patentee’s rights in cases of enforcement.