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New Rules relating to Entitlement to File an Application Coming into Force on October 1, 2010

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Proposed amendments to the Canadian *Patent Rules* are moving forward as anticipated (*see September 2009 newsletter*). The amendments were published in Part II of the *Canada Gazette* on December 9, 2009 and are scheduled to come into force on October 1, 2010.

The anticipated amendments 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 affect the requirements for completing a Canadian patent application and specifically, the requirement to establish entitlement to file an application.

Requirement to File “Declarations of Entitlement” Removed

When the proposed changes take effect on October 1, 2010, an applicant will no longer, for the purposes of “completing an application”, be required to file a “Declaration of Entitlement”. Instead, the newly proposed rules state that if the inventor is the applicant, the application must simply contain a statement to that effect. When the applicant is not the inventor, the application must contain a declaration that the applicant is the “legal representative” of the inventor(s) or, in the case of PCT national phase applications, either a declaration that the applicant is the “legal representative” or a declaration in accordance with Rule 4.17 of the Regulations under the PCT. 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”.

The statement that the applicant is the inventor or the declaration that the applicant is the “legal representative” will also no longer be required to “complete” an application. Thus, there will be no prescribed timeline for providing the information to the Canadian Patent Office. Instead, applicants that do not comply with the requirements at the time of filing an application, will be requisitioned by the Commissioner of Patents to do so before the later of 3 months following the date of the requisition and 12 months after the filing date of the application.

The new rules will come into force on October 1, 2010; however, transitional provisions do provide applicants filing directly into Canada (i.e. non PCT national phase applicants) the option of substituting the current requirement of filing a Declaration of Entitlement with the new requirements explained above. Furthermore, applicants filing applications into Canada on or after April 1, 2010 and having difficulties gathering the necessary information/documentation to prepare a declaration of entitlement, may wish to consider withholding from filing a Declaration of Entitlement as it is unlikely that they would have a final deadline to file a declaration of entitlement in advance of October 1, 2010. The same is true of applications entering the national phase on or after April 1, 2010.

Registration of Assignments

Although the new rules do not require the registration of assignments for “completing” an application or evidencing an applicant’s entitlement to file the application, the Canadian *Patent Act* suggests that assignments should be registered. 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, preferably, 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.