

CANADA

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PART 1 PATENTS

§1.01 SUMMARY

[A] Kinds of Patents

- National patent

[B] Duration of Patents

- 20 years from date of filing

[C] Patentable / Not Patentable

- Inventions which are new, non-obvious, useful and constitute patentable subject matter.

- In general, the exceptions of Rule 39 PCT apply. Computer programs as such are not patentable. Business methods may be patentable even when they are an essential element of a novel combination. Computer-implemented inventions may be patentable. Diagnostic methods may be patentable if they do not entail any steps of surgery or treatment.

[D] Novelty

- Absolute novelty is required.
- A grace period of 1 year preceding the filing date applies.

[E] Filing Requirements and Application Procedure

- Filing languages: Any
- Language of translation: English or French
- Time limit for filing translation: 2 months from notification
- A patent is granted after formal and substantive examination of the application.

[F] Specific Aspects of Regional Patents

- Not applicable in this jurisdiction.

[G] Specific Aspects of International Patent Applications (PCT)

- Time limit for entering national phase: 30 months from filing/priority date
- Time limit for filing translation: upon entry with the payment of the basic national fee

[H] Governmental Websites

- <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home> (Canadian Intellectual Property Office)
- <https://www.ic.gc.ca/opic-cipo/cpd/eng/introduction.html> (Register)

§1.02 DETAILED INFORMATION

[A] Conventions and Legislation

On 30 October 2019 a number of significant amendments to Canada's Patent Act and Rules came into force in order to implement Canada's obligation under the Patent Law Treaty (PLT). Many of the provisions of the PLT are intended to make the law and procedure more forgiving, e.g. by reducing the minimum requirements necessary to file a patent application and obtain a filing date, and by ensuring that whenever some action is missed, an applicant or patentee is given some form of notice and/or an opportunity to make a correction. An unfortunate effect of the amendments implementing the PLT is that many of the provisions in the Patent Act and Rules have become more complex. Timelines for making some corrections are shorter, calculation of due dates is more complex, and new concepts of 'due care' and omissions being 'unintentional' have been introduced, with the exact scope of these concepts not yet clear.

In July 2021 the Canadian Intellectual Property Office (CIPO) published in the Canadian Gazette proposed amendments to the Patent Rules with the stated goal of streamlining the examination process. There are three significant proposals that mark a distinct change from current practice before CIPO. The first includes an excess claims fee for any claim over and above 20, the second is the introduction of a Request for Continued Examination (RCE) procedure after three examination reports (office actions) have been issued and a RCE fee in the same amount as the regular examination fee, and the third is a new Conditional Notice of Allowance (CNOA) which will be issued at the end of prosecution when only minor defects need to be corrected. Although the final text of the Rules remain unknown until publication in the Canadian Gazette, the new Rules are expected to come into force sometime in 2022.

[1] Conventions

- Paris Convention (International Union) 1883–1967 (Canada is bound by the substantive provisions (Articles 1 to 12) of the Stockholm text of 1967 as from 26 May 1996);
- International Convention for the Protection of New Varieties of Plants 1961–1978 (UPOV Convention; Canada is a member of this Convention since 4 March 1991 and is bound only by the 1978 Act);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967;
- Patent Cooperation Treaty (PCT) 1970 (with effect from 2 January 1990);
- Patent Law Treaty (PLT) (with effect from 30 October 2019);
- Strasbourg Agreement Concerning the International Patent Classification (IPC Union) 1971 (with effect from 11 January 1996);
- Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure 1977 (with effect from 21 September 1996);
- World Trade Organization (with effect from 1 January 1995);
- Canada-Korea Free Trade Agreement (with effect from 1 January 2015);
- Canada-European Union: Comprehensive Economic and Trade Agreement (CETA) (with effect from 21 September 2017); and
- United States-Mexico-Canada Agreement (CUSMA) (with effect from 1 July 2020).

[2] Laws

- Patent Act R.S.C. 1985, Chapter P-4, as amended 30 October 2019;
- Patent Rules (SOR/2009-319), as amended 30 October 2019;
- Patented Medicines Regulations 1994 (SOR / 94-688), as amended 19 December 2013;

- Patented Medicines (Notice of Compliance) Regulations (SOR / 93-133), as amended 21 September 2017;
- Integrated Circuit Topography Act 1990, Chapter 37 (effective from 1 May 1993);
- Integrated Circuit Topography Regulations (SOR / 93-212), as amended 2 June 2007;
- Plant Breeders' Rights Act 1990 (effective as from 6 November 1991), as amended 17 June 2019;
- Plant Breeders' Rights Regulations (SOR / 91-594), as amended 19 May 2017;
- Use of Patented Products for International Humanitarian Purposes Regulations (SOR / 2005-143) (effective from 14 May 2005), as amended 25 June 2018.

Changes to the legislation were introduced by a 1992 amendment and (effective from 1 January 1994) by the NAFTA Implementation Act. The provisions as to patents of the Intellectual Property Improvement Act 1993 came into force on 1 October 1996. The provisions of the World Trade Organization (WTO) Agreement Implementation Act 1994 came into force on 1 January 1996. The provisions of the Canada European Union Comprehensive Economic and Trade Agreement (CETA) came into force on 21 September 2017. Several changes to the Patent Act and Rules came into force on 30 October 2019, many of which were for ratifying the Patent Law Treaty (PLT) in Canada.

[B] Kinds of Patents

There is only one kind of patent in Canada, namely, patents for inventions. These cover any new and useful art, process, machine, manufacture or composition of matter or any new and useful improvement in any art, process, machine, manufacture or composition of matter.

[C] Duration of Patents

The duration of a patent is twenty years from the date of filing of the application.

Patent Term Adjustment:

According to the Canada-United States-Mexico Agreement (CUSMA) Canadian patent applications filed on or after 1 December 2020, may be eligible for patent term adjustment (PTA) if they have been subjected to unreasonable prosecution delay by CIPO. This is one of the changes resulting from the CUSMA, which entered into force on 1 July 2020. PTAs for unreasonable prosecution delays arising from the CUSMA are distinct from existing extensions available in the form of Certificates of Supplementary Protection (CSP). While Canada has not yet amended its patent statute to provide for PTA for unreasonable prosecution delays, it is required to do so within 4.5 years of the CUSMA entering into force (i.e., no later than 1 January 2025). Until the patent statute is amended, the precise details of PTA for unreasonable prosecution delays in Canada remain unknown.

[1] Patent term extension / Supplementary protection certificate

Canada has introduced a scheme of *sui generis* protection for pharmaceutical products similar to supplementary protection certificates, as part of the Canada-European Union trade agreement known as the Comprehensive Economic and Trade Agreement (CETA).

Canada's take on supplementary protection certificates is domestically referred to as a Certificate of Supplementary Protection (CSP). This scheme is substantially defined in the amendments to the Patent Act in CETA which came into force on 21 September 2017 and in the CSP Regulations.

The term of protection under a CSP begins upon the expiry of the underlying eligible patent, i.e., upon expiry of the original twenty-year term. The term of a CSP varies but is limited to a maximum of two years. Subject to this limit, the duration of a CSP is the difference between (i) the date of filing of the application for the patent and (ii) the date of issuance of the authorization for sale, and further reduced by five years. An authorization for sale is defined as a Notice of Compliance (NOC) issued under the Food and Drug Regulations (FDR).

The CSP regime does not apply retroactively to drugs that have already been approved before the regime came into force. A CSP is only available for drugs authorized for sale after the regime came into force (21 September 2017).

For all drugs approved after the regime came into force, a CSP is only available for new drugs or new combinations of drugs: drugs (or combinations thereof) where no other CSP has been issued with respect to the medicinal ingredient(s) (or the combination thereof). Therefore, the first step is to determine the medicinal ingredient using the pharmaceutical information in the New Drug Submission which resulted in the issuance of a NOC. Chemically different medicinal ingredients may nevertheless be treated as the same if they have similar structures or attributes (e.g., an ester and a salt of the same medicinal ingredient).

To be an eligible patent within the meaning of the CSP regime, it:

- (a) cannot be void;
- (b) must be in force at the time of the application for a CSP and at the time of grant of the CSP; and
- (c) must include at least one claim that pertains to:
 - the same medicinal ingredient(s) (or combination thereof) contained in the drug for which regulatory approval (authorization for sale) is being sought;
 - the same medicinal ingredient(s) (or combination thereof) as produced by a defined process (product by process claims); or
 - any use of the same medicinal ingredient(s) (or combination thereof).

Claims that are directed to a formulation containing the medicinal ingredient, including compositions, preparations or similar claim types, do not make a patent eligible. Similarly, claims directed at processes alone, rather than product by process claims, do not make a patent eligible.

The timing of an application for a CSP depends on whether the patent is granted before or after the drug is approved for sale (i.e., NOC issued):

- (a) for a patent granted on or before the NOC is issued, within the 120-day period that begins on the day on which the NOC is issued; or
- (b) for a patent granted after the NOC is issued, within the 120-day period that begins on the day on which the patent is granted.

Notwithstanding this application deadline, additional deadlines may be imposed to coordinate the Canadian application for authorization for sale (i.e., the NOC application) with international regulatory applications. More particularly, if an application for an authorization for sale for the same medicinal ingredient(s) (or combination thereof) was previously filed in certain countries (the European Union, any country that is a member of the European Union, the United Kingdom, the United States of America, Australia, Switzerland and/or Japan), the Canadian NOC application must have been filed within twelve months. If, however, the application for a CSP was filed during the first year the regime came into force, such a NOC application must have been filed within twenty-four months.

Payment of the CSP fee is required at the time of filing the CSP application.

[D] Requirements for Renewal

Annual maintenance fees in respect of applications and patents are due for the third and following years from filing, and they are to be paid before or on the anniversary of the filing date. That is, the first maintenance fee is to be paid before or on the second anniversary of the filing date, and the further maintenance fees are to be paid yearly thereafter.

If a maintenance fee has not been paid before or on the due date, the Canadian Intellectual Property Office (CIPO) will issue a notice requiring payment of the maintenance fee and an additional fixed late fee within a grace period, being the later of the expiry of 6 months from the due date and 2 months from the date of the notice.

Annual fees in respect of any number of years may be paid in advance. The applicant or patentee or anyone authorized by the applicant or patentee can pay maintenance fees.

Annual maintenance fees for divisional applications are due as if the divisional application had been filed on the filing date of the parent application. If a divisional application is filed after the second anniversary of the filing date of the parent application, the annual maintenance fees due on the divisional application for the third year and any following years that began prior to the filing of the divisional application are to be paid upon filing the divisional application. If not paid upon filing, CIPO will issue a notice requiring payment of the maintenance fee(s) and additional late fee(s) before the later of the expiry of 6 months from the date of filing the divisional application and 2 months from the date of the notice.

As far as the annual maintenance fees are concerned, an application for the reissue of a patent shall be deemed to be an application for a patent and to have been filed on the date the application for the original patent was filed. That is, the maintenance fees for reissue patents are due at the same times and for the same periods as the original patent for the unexpired term of the original patent.

See further ‘Restoration after unintentional lapse’.

[E] Patentable / Not Patentable

To be patentable, an invention must be new, must not be obvious to a person skilled in the art of the relevant field, must have utility (i.e., be functional and operative, and do what the specification promises), and must relate to patentable subject matter.

The requirement of novelty requires that the claimed invention has not been disclosed before the claim date in a manner that enables the person skilled in the relevant art to make or perform the invention without undue burden. The requirement of non-obviousness means that the invention must not have been obvious, as of its claim date, to the person skilled in the relevant art. The test for obviousness, in some cases, permits the skilled person to conduct experiments to arrive at the invention, provided such experiments are not undue, if it is determined that the invention is ‘obvious to try’ based upon the state of the art. Subject to the exceptions discussed below, to be patentable subject matter, the invention must constitute an art, process, machine, manufacture or composition of matter.

In general, the exceptions of Rule 39 PCT apply. However, business methods may be patentable when they are an essential element of a novel combination. Computer-implemented inventions may be patentable. Diagnostic methods may be patentable if they do not entail any steps of surgery or treatment.

Examples of unpatentable subject matter include processes or products relating entirely to artistic, personal or professional skills, or in which the result has only intellectual meaning or aesthetic appeal. Mere schemes, plans, speculations or ideas which otherwise do not meet the criteria discussed above would not be considered patentable. An invention that requires judgment or skill in one of its steps and is therefore not fully reproducible and in which the desired result is not inevitably produced, would not be patentable.

[1] Chemical compositions

Compositions of matter such as chemical compositions are patentable.

[2] Pharmaceuticals

Pharmaceuticals are patentable.

The 1992 amendment of the Patent Act established the Patented Medicine Price Review Board which has the authority to control the prices of patented medicines. Every 'patentee' (except for former owners who have not been entitled to patent rights for at least three years) of a patent relating to a medicine must periodically provide the Board with information on: the price of the medicine and costs of making and marketing it; the licensees, revenues and research and development expenses in Canada; and other relevant information. The Board may order that such information be furnished. The Board may, if it judges the price of a medicine excessive, order a reduction in the price of the medicine or even the price of another patented medicine of the patent owner, and may order the patentee to remit money to the Government. Not providing the Board with information on prices or sales of and expenses relating to medicines, not notifying the Board of the introductory prices of new medicines, and not complying with orders of the Board to reduce prices and/or to remit money to the Government may be punished with imprisonment and/or a fine.

The Patented Medicines Regulations set out the framework by which the Board regulates the prices of patented medicines in Canada. Significant amendments to the Patented Medicines Regulations came into force on 1 July 2020, including new factors that will be used by the Board to determine whether a drug price is excessive. The amendments also introduce new disclosure and reporting requirements and expand the list of pricing comparator countries.

[3] Second use

A second (or subsequent) medical (or non-medical) use of a known medicinal substance is patentable, provided it meets the criteria for patentability.

Claims directed to dosage regimens or prescribed dosage amounts may be considered to be methods of medical treatments. Also with reference to the heading 'Treatment of the human body', an actual invention including one or more essential elements that comprise an active medical treatment step that restrict, prevent, interfere with, or require the exercise of the professional skill and judgment of a medical professional is not patentable, even if the claims involve a fixed dosage and schedule.

The claim is patentable, however, if it is directed to a vendible product (even if that product may only be prescribed by use of skill and judgment). Dosage forms, pharmaceutical packages or kits, which physically embody a dosage regimen or prescribed dosage amount, may not be considered to be methods of medical treatment and may therefore be patentable.

[4] Treatment of the human body

Methods for medically treating living humans or animals are not patentable subject matter. However, methods of carrying out treatments directed at non-medical conditions such as cosmetic treatments may be patented and a patent may claim a 'use' of a product for treating a medical condition. Also, methods directed to treatment of animals for essentially economic purposes distinct from treating a disease are patentable.

Diagnostic methods may be patentable if they do not entail any steps of surgery or treatment.

Revised examination guidelines on patentable subject matter were published by CIPO in November 2020, including specific guidance on determining whether diagnostic methods and medical uses constitute patentable subject matter.

All of the elements set out in a medical use claim are to be presumed essential, unless it is established otherwise or is contrary to the language used in the claim. CIPO has indicated that an actual invention of a medical use claim may consist of a combination of all the essential elements of the claim where those elements cooperate together.

Furthermore, an actual invention that has physical existence or manifests a discernible physical effect or change and does not otherwise fall within a jurisprudential exclusion (e.g., methods of medical treatment) would be patentable subject matter.

Nevertheless, CIPO has indicated that where an actual invention includes one or more essential elements that comprise an active medical treatment step or surgical step or that restrict, prevent, interfere with, or require the exercise of the professional skill and judgment of a medical professional, the actual invention is an excluded method of medical treatment and is not patentable subject matter.

With respect to claims related to the use of a dosage or dosage regimes, this fact alone is not determinative of whether the claim constitutes patentable subject matter, and it is necessary to consider whether the exercise of professional skill and judgment of a medical professional is part of the actual invention.

For example, professional skill and judgment may be involved if a medical professional is expected to monitor or make adjustments to the treatment, or make a selection of a dosage from a claimed range (i.e., in cases where not all dosages in the range will work for all subjects within the treatment group), such that the claims would not be patentable subject matter.

Diagnostic methods that solely claim a correlation between a specific analyte and the result of a medical test to a disease are generally considered an abstract or disembodied idea. However, diagnostic method claims that further include one or more physical steps, such as identifying, detecting, measuring etc. the presence or quantity of an analyte, may qualify as patentable subject matter by virtue of the actual invention either having physical existence or manifesting a discernible physical effect or change.

[5] Biological materials

Microbiological processes and the products obtained thereby may be patented.

Novel ‘higher’ life forms are not patentable, pursuant to several judicial decisions. Higher life forms include complex animals, plants and seeds. Unicellular and other ‘lower’ life forms which are new, useful and inventive are patentable, as are novel genes, cells and tissue cultures of higher life forms.

No decision has been rendered as to where the boundary is between higher and lower life forms for patent law purposes. A patent claiming a novel gene or cell may be infringed by the use or sale of an organism which contains the patented gene or cell (see e.g. *Monsanto Canada Inc v Schmeiser*, 2004 SCC 34).

CIPO considers the following to be lower life forms that are potentially patentable: microscopic algae, unicellular fungi (including moulds and yeasts), bacteria, protozoa, viruses, transformed cell lines, hybridomas and embryonic, multipotent and pluripotent stem cells.

Conversely, CIPO considers the following to be higher life forms that are not patentable: animals, plants, seeds, mushrooms, fertilized eggs and totipotent stem cells.

[6] Plant varieties

Novel higher life forms such as plants may not be patented, whether developed through crossbreeding or direct genetic manipulation. Lower life forms, however, may be patented if novel. The dividing line between higher and lower life forms has not been determined. In

many cases, a genetically modified plant can be protected by patenting the novel genes or cells incorporated in the plant.

Protection for new plant varieties may be obtained under the Plant Breeders' Rights Act 1990, which came into force on 1 August 1990. The holder of plant breeders' rights obtains exclusive rights in relation to the propagating material of his, her, or its variety, with a few exceptions (e.g. acts performed for private and non-commercial purposes, for experimental purposes, for developing new plant varieties, or for farmers' privilege – i.e. farmers may plant on their own land saved seed of harvested protected varieties).

The holder is able to protect the variety from exploitation by others and can take legal action against individuals or companies that are conducting acts, without permission, that are the exclusive rights of the holder.

A variety is eligible for protection if it is new, distinct, uniform and reproductively stable. Protection may be obtained under the Act for both sexually and asexually reproduced varieties belonging to the plant kingdom. As such, the Act does not extend protection to varieties of algae, bacteria and fungi.

An application for plant breeders' rights may be filed by any national or resident of Canada having a registered office in Canada or any other UPOV member country, or his, her, or its legal representative or plant breeders' rights agent. The applicant may be an individual, a company, or an organization.

In the case of a variety for which plant breeders' rights have been granted before 27 February 2015, the rights are granted for a period of up to 18 years, effective from the date of issue of the Certificate of Plant Breeders' Rights.

In the case of a variety for which the rights were granted on or after 27 February 2015, the rights are granted for a period of up to 25 years for the variety of a tree and vine (including their rootstocks), and 20 years for all other varieties of plants (excluding algae, bacteria and fungi), effective from the date of issue of the Certificate of Plant Breeders' Rights.

The duration of the grant is subject to the payment of an annual fee, which is due on the anniversary date of issue of the Certificate of Plant Breeders' Rights.

Before the grant, the applicant may enjoy a protective direction or provisional protection, which serves as a means to protect a candidate variety from the date of filing until the date when the rights are granted. With a protective direction or provisional protection, the applicant is permitted to initiate legal action, once rights are granted, against any infringements which may occur while the application is pending.

[7] Software-related inventions

Computer programs may be protected under copyright law as literary works.

While it is possible to patent software-implemented inventions, Canadian courts have held that computer programs as such cannot be patented. For example, software expressed merely as lines of code or a data model is considered to be merely a mathematical algorithm and, as such, is not patentable.

In general, a computer-implemented invention may be claimed as:

- a method (art, process or method of manufacture);
- a machine (generally, a device that relies on a computer for its operation); or
- a product (an article of manufacture).

However, the following computer-related subject matter may not be claimed:

- computer programs per se;
- data structures; and
- computer-generated signals.

In *Canada (Attorney General) v Amazon.com, Inc.*, 2011 FCA 328, Canada's Federal Court of Appeal affirmed that there cannot be a valid patent claim where the only inventive aspect of the claimed invention is the algorithm or mathematical formula that is programmed into the computer. However, the Court's decision also seemed to indicate that there may be a valid patent claim even where the algorithm or mathematical formula is an essential element of a novel combination.

The presence of a programmed general-purpose computer or a computer program storage medium does not lend to, nor subtract from, the patentability of an apparatus or process.

Revised examination guidelines on patentable subject matter were published by CIPPO in November 2020, including specific guidance on computer-implemented inventions.

CIPPO's position is that the mere fact that a computer is identified to be an essential element of a claimed invention does not necessarily mean that the subject matter defined by the claim is patentable subject matter. Rather, it is necessary to consider whether the computer cooperates together with other elements of the claimed invention and thus is part of a 'single actual invention' and, if so, whether that actual invention has physical existence or manifests a discernible physical effect or change and relates to the manual or productive arts.

If a computer is merely used in a well-known manner, the use of the computer will not be sufficient to render a disembodied idea, scientific principle or abstract theorem patentable subject matter.

For example, if running an algorithm on the computer improves the functioning of the computer, then the computer and the algorithm are considered together by CIPPO to form a single actual invention and the claim would be patentable subject matter.

Computer programs are explicitly listed in the Copyright Act under the items that may be protected by copyright as literary works. A computer program is defined in the Act as 'a set of instructions or statements, expressed, fixed, embodied or stored in any manner, that is to be used directly or indirectly in a computer in order to bring about a specific result'. This definition would cover all forms of computer programs. Copyright for computer programs includes the exclusive right to rent out the computer program. The following are not considered infringement of the copyright in a computer program:

- (1) the making, by the legitimate owner of a computer program, of a simple adaptation of it (including the translation of the program into another language), when this is necessary to enable the use of the program with a particular computer;
- (2) the making, by the legitimate owner of a computer program, of a single backup copy thereof in order to safeguard it.

Copyright protection lasts fifty years after the end of the calendar year of the author's death. Registration in the Register of Copyrights at the Copyright Office is not a requirement for obtaining protection. However, it is strongly recommended to register computer programs, as the burden of proof is thereby shifted to the alleged infringer. It is furthermore recommended to mark published works according to Article III of the Universal Copyright Convention (i.e., using the sign '©' with a mention of the year of first publication and the name of the entitled person). Foreigners may obtain protection on the basis of the International Copyright Conventions (Canada is a member of the Berne Convention as revised at Rome in 1928, and of the Universal Copyright Convention as adopted at Geneva in 1952); furthermore, foreigners from any of the British Commonwealth countries may obtain protection.

[8] Business methods

There is no blanket exclusion from patentability of so-called business methods. To the extent such methods are computer-implemented, see 'Software-related inventions'. In *Canada (Attorney General) v Amazon.com, Inc.*, 2011 FCA 328, the Federal Court of Appeal rejected the categorical exclusion of business methods. The Court held that there may be a valid patent

claim where a business method is not the whole invention, but rather an essential element of a novel combination.

According to CIPO to constitute patentable subject matter, a business method that is an abstract idea must cooperate with other elements of the claimed invention so as to become part of a combination of elements making up an actual invention that relates to the manual or productive arts and that either has physical existence or manifests a discernible physical effect or change.

[9] Immoral inventions or inventions contrary to public order

No prohibitions on immoral inventions or inventions contrary to public order exist in the current Patent Act or Rules. A provision of the Patent Act barring issuance of a patent for an invention that has an illicit object was repealed in 1993.

[10] Semiconductors

Topographies of integrated circuit products receive special protection under the Integrated Circuit Topography Act. Per this Act, topography refers to the design, however expressed, of the disposition of the following:

- the interconnections, if any, and the elements for the making of an integrated circuit product; or
- the elements, if any, and the interconnections for the making of a customization layer or layers to be added to an integrated circuit product in an intermediate form.

An integrated circuit product is defined as a product, in a final or intermediate form, that is intended to perform an electronic function and in which the elements, at least one of which is an active element, and some or all of the interconnections, are integrally formed in or on, or both in and on, a piece of material. The original design of a registered topography is protected whether it has been embodied in an integrated circuit ('IC') product or not. Topographies defining only a part of the structure required to perform an electronic function may be registered (so, for instance, topographies defining generic layers of gate array integrated circuit products, and topographies defining interconnection layers which customize gate array integrated circuit products to perform specific electronic functions, may be registered separately).

To be eligible for protection, a topography must be original (i.e., be the result of an intellectual effort of the creator, and not be a mere reproduction of another topography or any substantial part thereof), and may not, at the time of its creation, be commonplace amongst topography designers or manufacturers of IC products. Protection may be obtained by nationals or residents of Canada, by parties with a real and effective establishment for the creation of topographies or the manufacture of IC products in Canada at the time of creation of the topography, and by foreign parties on the basis of an international treaty with Canada, on the basis of reciprocity, or if they are a national of a WTO member country; furthermore, protection may be obtained for topographies which are first commercially exploited in Canada. The protection lasts from the date of filing of the application up to 31 December of the tenth calendar year after the year in which the topography was first commercially exploited anywhere in the world, or in which the application for registration was filed, whichever is first.

Certain aspects of integrated circuit topographies also may be patentable, for example, the structure and method of operation of electronic circuits embodied in integrated circuit products, or industrial processes used to manufacture integrated circuit products.

[F] Novelty

The subject matter of a patent application must be novel and must not be anticipated by any prior public disclosure. To satisfy the novelty requirement under Canadian patent law, the subject matter of a claim must not have been previously disclosed and enabled by a single prior public disclosure as follows:

- (1) anywhere in the world by a third party before the filing/priority date ('claim date'); or
- (2) by a third party in a Canadian patent application, which is not abandoned before its publication, with a filing/priority date prior to the filing/priority date of applicant's application.

[1] Grace period

A grace period of one year applies in case of the applicant's own disclosure, or disclosure by a person who obtained knowledge directly or indirectly from the applicant. The Canadian filing date must be within one year of such disclosure. As such, even if an application is filed first in a country belonging to the Paris Convention or the WTO within one year of a disclosure and the Canadian application claiming priority to the first-filed application is itself filed more than a year after disclosure, the applicant will not be entitled to a Canadian patent covering the disclosed subject matter.

[G] Ownership and related rights*[1] Applicant*

The applicant would be any inventor or someone entitled to apply for the patent, for example, assignee(s) and, in some cases, employer(s). On 1 October 1989, a first-to-file system was adopted instead of the former first-to-invent system. If there are multiple inventors who have applied for the same invention independently of each other, the right to a patent will belong to the party having the earliest 'claim date'. The claim date is defined as either the Canadian filing date or, if convention priority is claimed, the earliest priority date disclosing the subject matter defined by the claim.

The name and postal address of each inventor must be provided, as well as the name and postal address of the applicant(s).

*[2] Assignment***(A) Documents Required**

An assignment should state that the ownership of the application or the patent is being transferred from the assignor(s) to the assignee(s), signed by the assignor(s), and include the date and preferably the place of signature. If the assignor is a corporation, the name and position of the individual signing on behalf of the corporation must be provided. Notarization is not required. A request to record a transfer must include the name and postal address of the assignee and the prescribed fee. If the assignment is submitted by the applicant or patentee, no additional evidence is required. However, if the assignment is submitted by the assignee receipt of evidence satisfactory to the Commissioner of the transfer must be provided in order for the transfer to be recorded in connection with the patent application or patent. The signature of a witness to the assignor's signature is typically sufficient proof for CIPO to record the assignment. As an alternative, a document showing that the transfer was registered in a patent office of

another country would also generally be considered sufficient evidential proof to record the assignment.

The assignment may identify the invention by a foreign patent application or patent number, or the Canadian patent application or patent number, as the case may be, or if the assignment is executed before filing, in some other suitable way. The assignment must clearly assign Canadian rights to the invention or cover territory which includes Canada. An ordinary, non-certified photocopy of an assignment will be accepted. CIPO will issue a certificate giving the number and date under which the transfer document has been recorded.

While it is generally recommended to record assignment documents with CIPO, the entity that is the currently recognized applicant or patentee may record a transfer to a new owner without providing an assignment document by filing a request, paying the necessary fee and providing the name and the postal address of the new owner. Anyone other than the currently recognized applicant or patentee will need to provide evidence (such as an assignment document) in order to record the transfer to the new owner.

(B) Special Comments

CIPO will grant a patent to the assignee of the entire interest without requiring that the assignor request the Office to so issue the patent.

In the Province of Quebec, special provisions apply with regard to the obligatory use of the French language. These provisions may have an impact on the assignment of industrial property rights, as according to these provisions all contracts, the conditions of which are pre-determined by one party, and contracts containing printed standard clauses and the related documents shall be drawn up in French; only at the express will of the parties may they be drawn up in another language. It is therefore recommended that in contracts that assign intellectual property rights between parties, of which at least one of the parties is situated in the Province of Quebec, a clause be added at the end, in both French and the language of the contract, stating that all parties have agreed upon the drawing up of the contract in that other language.

If an assignment is not recorded with CIPO, the assignee may not be entitled to enforce the patent against any subsequent assignee of the same patent who has not received prior notice of the first assignment. Notably, a transfer of a patent that has not been recorded is void against a subsequent assignee if the transfer to the subsequent assignee has been recorded. Recording the assignment is thus highly recommended to secure the assignee's patent rights.

[3] Licenses

After three years from date of issue of a patent any interested person or the Attorney General may apply to the Commissioner for an order granting a license under the patent, alleging that there has been an abuse of the rights under the patent. Such abuse shall be deemed present if:

- the demand in Canada for the patented article or the article made by the patented process is not being met adequately and on reasonable terms;
- by reason of the refusal of the patentee to grant a licence or licences on reasonable terms, the trade or industry of Canada or the trade of any person or class of persons trading in Canada, or the establishment of any new trade or industry in Canada, is prejudiced, and it is in the public interest that a licence or licences should be granted;
- any trade or industry in Canada, or any person or class of persons engaged therein, is unfairly prejudiced by the conditions attached by the patentee to the purchase, hire, licence or use of the patented article or to the using or working of the patented process; or
- it is shown that the existence of the patent, being a patent for an invention relating to a process involving the use of materials not protected by the patent or for an invention relating to a substance produced by such a process, has been utilized by the patentee so as unfairly to prejudice in Canada the manufacture, use or sale of any materials.

If the Commissioner is not satisfied that a compulsory license would prevent the abuse of the exclusive rights arising from the patent, the Commissioner may revoke the patent. Compulsory licenses are non-exclusive.

The 2004 amendment to the Patent Act introduced compulsory licenses for certain pharmaceuticals to allow the production of generic versions of specified pharmaceutical products for export to specified developing and least-developed countries. Only certain pharmaceutical products that meet the requirements of the Food and Drugs Act are subject to compulsory licensing for production and export to certain countries as determined by the World Trade Organization.

An applicant seeking a compulsory license under the 2004 amendment is required to provide a declaration to the Commissioner of Patents stating that the applicant had at least thirty days prior to filing the application sought a license from the patentee(s) to manufacture and sell the pharmaceutical product to one of the countries specified by the World Trade Organization. The applicant is also required to provide a declaration to the Commissioner of Patents stating that the pharmaceutical product is not patented in the country specified by the World Trade Organization or the applicant has a compulsory license to use the product in that country. The applicant must state the quantity of product to be manufactured and exported and may not manufacture more product than the authorized amount.

The term of each compulsory license is two years from the date of authorization, and may be renewed once for an additional two-year period running from the date the first authorization period ends. The authorization is non-transferable other than if it is an asset of a corporation or enterprise or part of a corporation or enterprise that is bought, sold, assigned or transferred. The royalty rate to be paid to the patentee(s) is described in the Regulations. The Federal Court has jurisdiction to change the royalty rate, provide for a fixed payment, or terminate the compulsory license. Both the Governor in Council and the Federal Court must consider the humanitarian and non-commercial reasons underlying the issuance of the authorization in setting the royalty rate.

Before exporting the product, the authorized licensee must establish a website which discloses the name of the product, the name of the country to which it is to be exported, the quantity that is authorized to be manufactured and sold for export, the distinguishing features of the product and of its label and packaging under the Food and Drugs Act, and all known parties that will handle the product while it is in transit from Canada to its destination country.

The Government of Canada (or of a Province of Canada) may apply to the Commissioner for authorization to non-exclusive use of a patented invention (predominantly to supply the Canadian market), provided it pays the patentee a reasonable compensation, to be fixed by the Commissioner. The scope and duration of the use shall be limited to the purpose for which the use is authorized. Unless the proposed use is public non-profit use, and except in extremely urgent cases, the Government must show to have tried first, without success, to obtain a voluntary license or authorization from patentee on reasonable commercial conditions. For semiconductor technology, only public non-profit use may be authorized. Against decisions of the Commissioner, appeal may be lodged with the Federal Court. The authorization is not transferable.

Exclusive licenses must be registered.

[4] Pledge and Seizure

Patents and patent applications are treated as another object of intangible property in the context of pledge, seizure and as surety. A patent can also be dedicated to the public. A security interest in a patent or patent application can be registered with CIPO; however, doing so merely serves as notice. Registering a document respecting a security interest with CIPO is not a substitute for perfection of a security interest and does not create a preference over any other security interests. CIPO will send a certificate with a unique identification number to the person who requested the registration of the document.

[H] Filing Requirements

All parts of the specification must be on sheets of good quality white paper of the same size (either of A4 size, i.e. 21 cm × 29.7 cm, or of letter size, i.e. 21.6 cm × 27.9 cm), used in an upright (portrait) position, and on one side only (if useful for the presentation, however, drawings, tables and chemical or mathematical formulae may be presented sideways (landscape) with the top of the drawing, table, chemical formulae or mathematical formulae at the left side of the sheet). The minimum margins to be observed in the pages containing the description, claims and abstract are as follows: top 2 cm; left side 2.5 cm; right side 2 cm; and bottom 2 cm. For the minimum margins to be observed in the drawings, see under the heading 'Drawings'. The margins of the sheets must be left completely blank, except that in the top margin, in either corner, an indication of applicant's file reference may be given. The line numbers on the description and claims pages may be set in the left margin. All text matter in documents forming part of the description or claims (except for tables, chemical and mathematical formulae, and sequence listings) must be typed or printed at least 1 ½ line spaced. All text matter must be in characters the capital letters of which are at least 0.21 cm high. The documents must be free from interlineations, cancellations and corrections. All documents must be presented in such manner as to permit direct reproduction by photography, electrostatic processes, photo-offset and microfilming in an unlimited number of copies.

The petition, abstract, description, claims and drawings must each begin on a new page. The pages of the description and claims must be numbered consecutively, the numbers to be placed in the centre at the top or bottom of the sheet, but not in the margin. The petition, abstract, description and claims may not contain drawings. The abstract, description and claims may contain chemical or mathematical formulae or the like. Any trademark mentioned in the application must be identified as such.

The specification does not need to be signed, nor should any certificate or signature appear on the drawings.

Transfer documents, other documents concerning ownership and certified copies of documents may be on sheets of paper not exceeding 21.6 cm × 35.6 cm.

[1] Obligation to file first with national office

There is no obligation to file first with CIPO.

[2] Minimum requirements for obtaining filing date / Provisional applications

At minimum, the following must be submitted to obtain a filing date: (a) an explicit or implicit indication that the granting of a Canadian patent is being sought; (b) information allowing the identity of the applicant to be established; (c) information allowing the Commissioner to contact the applicant; and (d) a document, in any language, that on its face appears to be a description.

Subject to the prescribed requirements, an applicant may submit a statement to the effect that a reference to a specified previously filed application for a patent is being submitted. The referred-to text and/or drawings will be considered to be part of the Canadian patent application only as of the date on which a statement to the effect that the reference is being submitted is received.

There are no provisional patent applications in Canada.

[3] Request for grant

An application is complete only when the filing fee and the completion fee, if applicable, have been paid and the following documents, executed as prescribed, have been filed.

Petition on prescribed form, stating the following: a request for the grant of a patent, the title of the invention and the name and postal address of each applicant; name and postal address of each inventor (if other than applicant); a statement that the applicant(s) are all inventor(s) and the sole inventor(s) or that applicant(s) are entitled to file the application; name and address of the agent, if any (the appointment of an agent may also be made in a separate document); and the figure number(s) of the drawing(s) requested by the applicant to accompany the abstract when it is open to public inspection. If priority is to be claimed, the country, application number and filing date of the application whose priority is claimed must also be provided (a priority claim may also be made in a separate document). If applicable, an indication that the applicant believes to be entitled to claim small entity status in order to be eligible to pay reduced fees. The small entity declaration must be signed by the applicant or agent, but the petition need not be signed by the applicant or agent.

[4] Appointment of Representative

If there are joint applicants or patentees, one applicant or patentee may be appointed by the other applicants or patentees as their common representative or CIPO will appoint a common representative in accordance with the Patent Rules.

If an application is filed by a person who is not an inventor, there is more than one inventor and the application is not filed jointly by all of the inventors, or if an assignment has been recorded in respect of the application a patent agent registered in Canada must be appointed to represent the applicant(s) in any business before the Patent Office. Appointment may be made in the petition, or in a notice signed by the sole applicant or common representative. If a patent agent who does not reside in Canada has been appointed, this agent must appoint as associate agent a patent agent registered in Canada. Such appointment may be made in the petition, or in a notice signed by the patent agent not residing in Canada. If the applicant is not the inventor, and no registered patent agent residing in Canada has been appointed, the Commissioner will requisition that applicant to appoint a registered patent agent in Canada within three months (or, if a patent agent not residing in Canada has been appointed, will requisition that agent to appoint an associate patent agent registered in Canada within three months).

Foreigners enjoy the same rights as nationals of Canada with respect to all substantive and procedural aspects of the patent law. However, applicants not residing or carrying on a business in Canada must appoint a representative in Canada (normally the appointed registered patent agent in Canada) to obtain an address for service in Canada.

[5] Power of Attorney / Designation of inventor / Other documents

A power of attorney is not required.

CIPO requires a statement that the applicant is the sole inventor or, if there are joint applicants, the applicants are all inventors and the sole inventors, or if the applicant(s) are not the inventor(s), that the applicant(s) are entitled to apply for a patent. CIPO will requisition the filing of such a statement within three months from the notice of the deficiency. If the applicant fails to respond within the time period, the application is deemed abandoned. This time limit may not be extended. No oath is required.

[6] Priority

Paris Convention priority may be claimed on filing, or no later than the date the applicant submits approval for the laying open to public inspection before the end of the confidentiality period (i.e. early publication), or the later of sixteen months after the earliest priority date and four months after the filing date. A priority claim must identify the country, the filing date and the filing number of each application whose priority is claimed. The priority claim may be made in the petition for grant or in a separate document. If the number of an application whose priority is claimed is not known, CIPO will accept specific alternatives in accordance with the Patent Rules, for example a copy of the request part of the previously filed application along with the date on which the application was sent to the office of filing.

Priority of patent applications similar to Convention priority may be recognized in respect of applications filed in any country which by treaty, convention or law affords similar privileges to citizens of Canada (viz. Taiwan, India and Pakistan). Furthermore, priority may be claimed in respect of applications filed in a country which is a member of the World Trade Organization (WTO), even if that country is not a member of the Paris Convention. Priority may also be claimed in respect of a prior application filed in or for Canada (e.g., a PCT international application in which Canada is designated).

A copy of each priority application must be submitted to CIPO. A certified copy of the priority application and a certificate from the office of filing showing the filing date can be submitted. For patent applications filed as of 30 October 2019 the WIPO Digital Access Service (DAS) can be used. An applicant requests the office of first filing to deposit the priority document into the WIPO DAS and to provide an access code, and subsequently the applicant requests other offices to obtain direct access to the priority document via this service with the access code.

This submission must be done no later than the later of sixteen months after the earliest priority date and four months after the filing date, or, for a PCT national phase entry, the national phase entry date.

An exception to the requirement that a copy of each priority application must be submitted is available when: the priority document is a Canadian application; the priority document is a PCT application filed with CIPO as a Receiving Office; or the pending application is a PCT national phase application and the applicant has complied with Rule 17.1(a), (b) or (b-bis) of the Regulations under the PCT regarding the filing of a priority document.

If there is an error in the filing date of the priority application submitted to CIPO, the Patent Act and Rules provide a limited timeframe for taking corrective action.

Translation of the priority application and also certification of such a translation are only required upon request of CIPO.

Multiple priorities may be claimed in respect of one patent application, even if the priority rights stem from different countries; multiple priorities may be claimed for any one claim in a patent application. Where multiple priorities are claimed, the twelve-month priority term shall run from the earliest priority date. If one or more priorities are claimed in respect of a patent application, the right of priority shall apply only in respect of those elements of the patent application that are described in the patent application(s) whose priority is claimed.

[7] Allowable language(s) upon filing / Language(s) of procedure

A patent application may initially be filed in any language. If the document is not in English or French, CIPO will send a notice requiring the submission of a translation (not certified) within two months of the date of the notice, failing which the application will be abandoned.

Generally, communications with the Patent Office must be in English or French. With some exceptions, documents filed neither in English nor in French must be accompanied by a translation into one of these languages; the Commissioner may require furnishing a statement from the translator that to the best of their knowledge the translation is complete and faithful.

[8] Description

The description must fully and correctly describe the invention and its operation or use as contemplated by the inventor. It must set out clearly the various steps in a process, or the method of constructing, making, compounding or using a machine, manufacture or composition of matter, in such full, clear, concise and precise terms as to enable any person skilled in the art or science concerned to make, construct, compound or use it. In the case of a machine, the description must explain the principle of the machine and the best mode in which the inventor has contemplated the application of that principle. In the case of a process, the description must explain the necessary sequence (if any) or the various steps, so as to distinguish the invention from other inventions.

The description must be filed in the following manner and order (unless, because of the nature of the invention, a different manner or order would afford a better understanding or a more economical presentation):

- (a) short and precise title of the invention, which does not include a trademark, coined word or personal name;
- (b) indication of the technical field to which the invention belongs;
- (c) description of the background art which, as far as known to applicant, can be regarded as important for the understanding, searching and examination of the invention;
- (d) description of the invention set out in terms that permit the technical problem and its solution to be understood, even if that problem is not expressly stated;
- (e) concise description of the figures in the drawings (if any);
- (f) setting forth of at least one mode contemplated by the inventor for carrying out the invention, where appropriate in terms of examples, and with reference to the drawings (if any);
- (g) a sequence listing where required.

The description should explain at least one use of the invention in sufficient detail to enable a skilled person to use the invention for its intended purpose. A new product should be described in terms of its characteristics; where possible, a chemical formula should be given for a new compound. The description must describe all of the subject matter that the applicant intends to claim as their invention. The description may not incorporate another document by reference. References in the description to a document not forming part of the application are allowed only if the document was available to the public on the application filing date. Any document referred to in the description must be fully identified and references to non-permanent URLs (websites) are not allowed.

The description must describe the utility of the invention which must relate to an area of commercial or industrial utility. The utility cannot be purely aesthetic. In cases where the utility is not inherently evident from the description, sufficient factual information must be provided, usually but not always in the form of working examples, to either demonstrate utility of as of the filing date or to soundly predict the utility of the invention. The Supreme Court of Canada (SCC) rejected the so-called ‘promise doctrine’ in 2017. The SCC decision clarified that no particular level of utility is required and a ‘mere scintilla of utility’ will do. However, the claimed subject matter must be capable of a ‘practical purpose’ or achieve an ‘actual result’.

For inventions in the biological field, a deposit of the biological material concerned may be made before or on the filing date of the application with an International Depositary Authority under the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 1977 (for these International Depositary Authorities, see Part II, International Laws and Regulations, International Conventions, ‘Budapest Treaty’). The applicant must inform the Commissioner of the name of the Authority with which the deposit was made, the date of the original deposit, and the accession number given to the deposit before the application becomes open to public inspection. This information must be included in the specification. Any reference to a deposit of biological material in a specification

does not create a presumption that the deposit is required for the purpose of correctly and fully describing the invention in accordance with the requirements of the Patent Act.

If an application filed on or after 2 June 2007 describes a nucleotide or amino acid sequence not identified as forming part of the prior art, an electronic sequence listing must be filed as part of the specification. The electronic form and the content of the sequence listing must comply with the PCT sequence listing standard. An application must not contain more than one copy of a particular sequence listing regardless of its form of presentation. When submitting an electronic copy in replacement of an existing paper copy of a sequence listing, or an existing non-compliant electronic copy, the applicant must file a statement that the copy of the content of the sequence listing in computer-readable form does not go beyond the disclosure as filed. If, after filing, it becomes apparent that a sequence listing is required and has not been filed or the sequence listing is defective, the applicant will be sent a notice requiring the submission of a compliant sequence listing.

[9] Claims

The specification must end with a claim or claims in which the subject matter of the invention for which protection is claimed is defined distinctly and in explicit terms. The claims must be clear and concise and must be fully supported by the specification independent of any document referred to in the specification. In the case of plurality of claims, these must be numbered consecutively in Arabic numerals starting with ‘1’. There is no limit to the total number of claims that may be included in an application.

If the application contains drawings, the features mentioned in the claims may be followed by the reference characters (placed between parentheses), appearing in the drawings and relating to such features. If the application contains a sequence listing, the claims may refer to a sequence listing identifier number. Claims may not, unless necessary in respect of the features of the invention, rely on references to the description and drawings and, in particular, may not rely on such references as ‘as described in part...of the description’, or ‘as illustrated in figure...of the drawings’. If the description refers to a deposit of biological material, the claims may refer to the deposit by reference number.

Claims may be independent or dependent on other claims. A claim including all the features of one or more other claims is considered a dependent claim. A dependent claim may refer to one or more preceding claims; it must refer by number to the preceding claim or claims of which it includes all the features, and it must state the additional features claimed. A dependent claim is deemed to include all the limitations contained in the claim to which it refers or, if it refers to more than one other claim, all the limitations contained in the particular claim or claims in relation to which it is considered. A multiple dependent claim (i.e., a dependent claim referring to more than one preceding claim) may also refer to another multiple dependent claim. Multiple dependent claims are permitted in Canada without additional fees. There is no formal prohibition against an application presenting multiple independent claims for the same category (such as multiple independent device claims), and additional independent claims fees are not required.

[10] Abstract

The abstract may not contain more than 150 words. The abstract is for providing technical information; it is not intended to be taken into consideration for interpreting the scope of protection. The abstract must contain a concise summary of the matter contained in the application. Where applicable, it must contain the chemical formula that, among all the formulae included in the application, best characterizes the invention. The abstract must specify the technical field to which the invention relates and must be drafted in such manner as to allow a clear understanding of the technical problem concerned, the gist of the solution of that

problem through the invention, and the principal use(s) of the invention. It must be drafted in such a manner that it can efficiently serve as a scanning tool for purposes of searching in the art concerned. Each main technical feature mentioned in the abstract and illustrated by a drawing in the application may be followed by a reference character placed between parentheses.

[11] Drawings

A drawing or drawings must be filed in the case of a machine or in any other case in which the invention can be shown by drawings. The drawing or drawings must clearly show all parts of the invention. The drawings must be filed on sheets of good quality white paper; nothing may appear on the sheets of the drawings other than the drawings, the reference characters and legends pertaining to the drawings. The sheets must be of international size A4 (21 cm × 29.7 cm) or of size 8.5 inches × 11 inches (21.6 cm × 27.9 cm); all sheets must be of the same size. The minimum margins to be observed are as follows: top 2.5 cm, left side 2.5 cm, right side 1.5 cm and bottom 1.0 cm. No frames are permitted. The drawings must be made in black, sufficiently dense and dark, with well-defined lines enabling satisfactory reproduction and without colouring. Cross-sections must be indicated by hatching which may not impede the clear reading of the reference characters and the lead lines. All numbers, letters and lead lines must be simple and clear. Elements of the same figure must be in proportion to each other, except where a difference in proportion is indispensable for the clarity of the figure.

The drawings may not contain text matter except insofar as is required for the understanding of the drawings. Numbers and letters in drawings must be at least 0.32 cm high. Reference characters not mentioned in the specification may not appear in the drawings, and vice versa. The same features, when denoted by reference characters, must be denoted by the same characters throughout the application.

Several figures may be contained on one page of drawings. If figures on two or more pages are intended to constitute a single complete figure, they shall be arranged so that the whole figure can be assembled without concealing any part of the partial figures. The different figures in the drawings must be numbered consecutively.

If an invention cannot be illustrated by means of drawings but can be illustrated by means of photographs, then instead of drawings, photographs or reproductions of photographs illustrating the invention may be filed.

[12] Payment of fees

Fees may be paid in Canadian currency by credit card, money order, cheque, wire transfer or, in some cases, deposit account. Fees may also be paid by cash or debit at CIPO's headquarters. Some fees may be paid online by way of a fee payment form, available on CIPO's website. CIPO recommends using its online fee payment form for all fee payments.

[I] Application Procedure

[1] Filing Authority

Canadian Intellectual Property Office (CIPO).

[2] Online filing

Online filing is available.

[3] Formal examination

After a patent application has received a filing date, or has entered the national phase via the PCT, CIPO will review the application as to formal requirements to determine if all the required parts have been submitted.

If a required part has not been submitted, CIPO will send a notice requiring the applicant to respond in good faith and comply with the prescribed requirements within three months of the date of the notice to avoid abandonment.

[4] Search

CIPO performs searches of national filing and national phase entry applications after a request for examination has been made. In general, Canadian Examiners will consider all available foreign search results.

[5] Obligation to submit prior art, corresponding foreign search results and/or application numbers

There is no such obligation unless specifically requested by the Examiner. The Examiner may request the applicant to furnish any of the following information in respect of corresponding applications filed in or for any country and a copy of any related document:

- an identification of any prior art cited in respect of those applications;
- the filing dates and numbers of those applications and the numbers of any patents granted thereon; and
- particulars relating to interference, opposition, re-examination or similar proceedings.

For documents not in English or French, a translation thereof (or of a part thereof) into English or French may be required.

[6] Substantive examination

Examination as to novelty, obviousness and utility under the present law is not carried out automatically, but only on explicit request. The request for examination must be filed within four years of the filing date for applications filed on or after 30 October 2019. A request for examination may be filed by the applicant or by any interested third party. If the examination request is not filed and/or the examination fee not paid in due time, CIPO will send a notice requiring that the request be filed along with a late fee within two months of the date of the notice or the application will be deemed abandoned. If the patent application is deemed abandoned for failing to respond to the notice, it may be reinstated as of right by making a request for reinstatement, requesting examination and paying the required fees within six months from the original due date (i.e. the expiry of the four-year period of the filing date). See further ‘Restoration after unintentional lapse’.

A patent application is examined as to formal correctness, unity of invention, novelty, obviousness, utility, subject matter and other substantive requirements. If the Examiner during examination finds that the application does not comply with the provisions of the law, they shall inform the applicant of the defects in an office action and requisition the applicant to amend the application and/or to provide arguments as to why the application does comply.

If, in the Examiner's opinion, after the reply of the applicant the application still does not comply with the provisions of the law, and the Examiner has reason to believe the applicant will not further advance the prosecution (i.e., the applicant and the Examiner are at an impasse),

the Examiner may issue a ‘final action’ which indicates the outstanding defects, and will requisition the applicant to amend the application, or to provide arguments as to why the application does comply, within the prescribed time limit. Currently, final actions are relatively rare under Canadian practice. An applicant can typically expect a number of office actions and a written indication that the Examiner may issue a final action in an office action, before a final action is issued. If the applicant then amends the application or provides arguments satisfying the Examiner, the Commissioner will notify the applicant that the rejection is withdrawn. If the rejection is not withdrawn, the application is forwarded to the Patent Appeal Board for further review.

CIPO has launched the Patent Examination Interview Service, a service that is aimed at encouraging patent examiners to contact patent agents over the telephone to inform them about defects in their applications, so that they can initiate immediate steps to resolve them. More importantly, however, the interview process provides patent agents the opportunity to discuss the application directly with the examiner, obtain suggestions or advice from the examiner as to how an identified defect may be overcome, and correct any identified defects through submission of a voluntary amendment within a predetermined timeframe. Any voluntary amendments submitted as a result of a telephone interview are reviewed by the examiner expeditiously and the application is approved for allowance, if the application complies.

The Patent Appeal Board advises the Commissioner, who may then act on this advice. The Board is an administrative body. It is not established pursuant to any Act or Rules but rather by administrative practice within CIPO. The Board reviews the entire prosecution file and may consider any defect in the application. The applicant may prepare further arguments before the Board, and the Board may request further submissions from the applicant or the Examiner on any issue. The Board may require that the applicant makes amendments if the Board believes those amendments will make the application in a suitable condition for allowance. The applicant may be provided with an opportunity to propose claim amendments that the Patent Appeal Board can consider and then require the applicant to make. If, after the review process, the Board believes the application is not in condition for allowance, the applicant will be given the opportunity to make further submissions before the application is formally rejected. The Commissioner may do any of the following: refuse the application if there is no patentable subject matter; return the application to the Examiner for further prosecution if the Examiner's rejection was not justified; or, inform the applicant of any amendments necessary for compliance. Where amendments are requested, the applicant is given three months to submit the changes or the application will be refused.

If it is found that a patent should be granted, the Commissioner will send the applicant a notice of allowance and will requisition payment of the final fee required. After a notice of allowance has been sent, but before the patent has issued, the Commissioner may decide that the application shall be subjected to further examination if the Commissioner has reasonable grounds to believe that the application does not comply with the Patent Act or Rules. The applicant may request limited amendment of the application after allowance. At the Examiner's discretion, the amendment after allowance may be refused if the amendment necessitates a further search.

Actions of the CIPO during examination are termed ‘requisitions’, and more than one requisition may be issued in a given communication or office action. The time limit for replying to a given requisition is typically set at four months. Generally, the time limit may be extended up to a maximum of a total six months if the Commissioner is satisfied that this is justified in the circumstances, provided that extension is requested and the required extension fee paid prior to expiration of the time limit to be extended. CIPO will consider reasonable a detailed explanation as to why the applicant was incapable of fulfilling prescribed requirements within the prescribed time. While CIPO does not offer specific guidelines regarding the content of the explanation, the explanation should be specific to the patent application in question, and should provide sufficient information for the Commissioner to make an informed decision. Exemplary circumstances are given: a recent transfer of the rights to the application; a recent change in the appointed patent agent; any health issues impacting the applicant or patent agent;

specific logistical issues effecting communication between the applicant and the patent agent; specific additional efforts that an applicant must take in order to comply with an outstanding office action; any other unforeseen issues. A request to extend a period of time that does not include a description of the circumstances will be refused, as well as a request that merely includes a simple statement indicating that more time is required to respond to an outstanding office action or to obtain instructions from an applicant etc., but does not include a description of the circumstances.

Failure to respond to multiple objections and requests set out by CIPO may result in multiple deemed abandonments. It is possible to reinstate as of right an application deemed abandoned for failing to respond to an office action within 12 months from the deadline by responding to the office action, requesting reinstatement and paying the prescribed reinstatement fee. A showing of due care in such case is not required. Under the current Patent Act and Rules, third party rights do not arise when a patent application is abandoned for failure to respond to an office action and subsequently reinstated.

[7] Accelerated examination / grant

The Canadian Patent Rules provide for advancing examination of an application relating to environmental (i.e. green) technology. No additional official fee is required for advancing examination of a green technology application. The application must be open to public inspection, and the applicant must make the request for advanced examination, along with a declaration that the application relates to technology, the commercialization of which would help to resolve or mitigate environmental impacts or to conserve the natural environment and resources.

An application may be advanced for examination out of its routine order on request of any person and payment of the required advanced examination fee, if the Commissioner determines that failure to advance the application is likely to prejudice the rights of the requester. Such advanced examination may be desirable in circumstances where enforcement of patent rights would benefit the applicant, for example, if imminent competition is expected. Advanced examination can only be requested provided the application is open to public inspection and a request for examination has been made. The application may, upon request of the applicant, be opened for public inspection earlier than the mandated 18 months. The person requesting advanced examination may simultaneously file a request for examination along with the required standard examination and advanced examination fees. Those advanced examination applications that have been abandoned and reinstated are thereafter deemed to be no longer eligible for advanced examination and, as such, examination will thereafter proceed on a non-expedited basis. No refunds of the advanced examination fee, if one has been submitted, are provided.

Canada has normal PPH agreements with: Australia, Austria, Chile, China, Colombia, Denmark, Estonia, the European Patent Office, Finland, Germany, Hungary, Iceland, Israel, Japan, Mexico, New Zealand, Norway, Peru, Poland, Portugal, Russia, Singapore, South Korea, Spain, Sweden, Taiwan, the United Kingdom and the United States.

Canada has PPH MOTTAINAI agreements with: Australia, Austria, Chile, China, Colombia, Denmark, Estonia, the European Patent Office, Finland, Germany, Hungary, Iceland, Israel, Japan, Mexico, New Zealand, Norway, Peru, Poland, Portugal, Russia, Singapore, South Korea, Spain, Sweden, Taiwan, the United Kingdom and the United States.

Canada has PCT-PPH agreements with: Australia, Austria, Chile, China, Colombia, Denmark, Estonia, the European Patent Office, Finland, Germany, Hungary, Iceland, Israel, Japan, Mexico, New Zealand, Norway, Peru, Poland, Portugal, Russia, Singapore, South Korea, Spain, Sweden, the United Kingdom and the United States, as well as the Nordic Patent Institute and the Visegrad Patent Institute.

[8] Amendments and corrections

Amendments may be made by the applicant on its own initiative or in response to a requisition by an Examiner, provided that the amendments do not add matter that could not reasonably be inferred from the specification or drawings as originally filed, except insofar as it is admitted in the specification that the matter is prior art with respect to the application. Voluntary amendments are not considered for acceptance until a request for examination has been made.

Every amendment shall be accompanied by a written statement explaining the nature and purpose thereof. A reply to an Examiner's objection shall state how it overcomes the objection. Under the Rules, to comply with CIPO's technical reproduction requirements, the amendment must consist of fresh pages containing the desired amendments, regardless of how extensive or minor the amendment may be. The written statement must also provide instructions for inserting and replacing the amended pages in the application. The pages of the description and claims must be numbered consecutively. Page numbering which includes letters is acceptable; for example the sequence 1, 2, 3, 3A, 3B, 4 is acceptable. Amendments to applications originally filed on CD-ROM must also be filed on CD-ROM, in duplicate, including a revised copy of the entire application.

Disclaimers are suitable only for cancelling a claim or definite portion of the subject matter claimed. On an application to attach a disclaimer to a patent, the applicant must pay a fee. The disclaimer must be prepared in accordance with Form 2 of the Patent Rules. A disclaimer may be made at any time during the term of a patent.

Amendments after grant may be accomplished by surrendering the patent and applying for a reissue, or by filing a disclaimer. A reissue may either narrow or broaden the claims or amend the description. It may be granted only if there is a defect in the patent that makes the patent defective or inoperative by result. Such defect must have been caused through inadvertence, mistake or accident, without fraudulent or deceptive intention.

A petition for the reissue of a patent including a surrender of the patent shall set out, in an affidavit, the reasons for which the patent is deemed defective or inoperative, the manner in which the patentee obtained knowledge of any new facts giving rise to the petition and when the patentee obtained that knowledge, and shall set out how the error arose. The petition must be filed within four years of the issue date with the same documents as are required for ordinary applications. If the reissue patent is refused, the surrendered original patent is returned to the patentee. If a reissue patent is granted, it takes the date of the original patent.

[9] Third party observations

At the pre-grant stage, third parties may file a protest against the granting of an application and may file prior art consisting of patents and printed publications, indicating why these are relevant. Protests will be acknowledged by the CIPO and made public, but no information may be given as to the action taken thereon and the third party or parties will not otherwise participate in the procedure.

Any person may file with the Commissioner prior art consisting of patents and publications that they believe to have a bearing on the patentability of any claim in an application for a patent. A person filing prior art under this rule must explain the pertinence of the same. Such procedures are strictly 'ex parte' in that the person submitting such documents has no additional right to communicate with the Commissioner, nor will the Commissioner communicate with the third party.

[10] Grant

If it is decided that a patent may be granted, a notice of allowance will be sent. Within four months of the date of the notice of allowance, a final fee and a fee for each page of the

specification and drawings exceeding a hundred pages must be paid, failing which the application will be deemed abandoned. In the event that an application is deemed abandoned, it may be reinstated as of right within twelve months of the due date on payment of the final fee, the page fee (if required) and the reinstatement fee.

Amendments after allowance are not permitted except to correct an obvious error on or before the day the final fee is paid. CIPO will allow the amendment if it is obvious that something other than what appears in the specification and the drawings was intended and that nothing other than the proposed amendment could have been intended.

An applicant wishing to make an amendment and/or reopen prosecution after receiving a notice of allowance must file a request that the notice of allowance be withdrawn and pay the prescribed fee not later than 4 months from the date of the notice of allowance and before the final fee is paid. An applicant may not request a withdrawal of the notice of allowance when the application has been deemed abandoned for failure to pay the final fee.

If the fees are duly paid, the patent will be granted in the language of the specification (English or French) and will be issued electronically.

The average processing time from filing to grant is six to eight years.

[11] Opposition / Re-examination

Opposition is not provided for.

Re-examination of patents may be requested by any person or may be ordered by the Commissioner. Procedures are strictly ‘ex parte’ in that the person submitting documents, if not the patentee, has no additional right to communicate with the Commissioner, nor will the Commissioner communicate with the third party. Re-examination of any claim of a patent may be requested at any time during the term of the patent by any person (including the patentee). The requester must pay the re-examination fee and file prior art not previously considered during examination consisting only of patents, patent applications open to public inspection, and printed publications. The request for re-examination must set forth the pertinence of the prior art and the manner of applying the prior art to the claim for which re-examination is requested. If re-examination is requested by a person other than the patentee, the request must be filed in duplicate.

After a re-examination request is received, the Commissioner will send a copy of the request to the patentee, unless the patentee is the person who made the request. The Commissioner may then establish a re-examination board to determine the case, consisting of at least three persons (two of whom are to be CIPO employees). Within three months of its establishment, the board will determine whether a substantial new question of patentability affecting any claim of the patent in question is raised by the re-examination request. If the board determines that no such new question has been raised, the requester will be notified thereof.

The decision of the re-examination board is final. If the re-examination board determines that a substantial new question of patentability has been raised, the board will notify the patentee thereof stating the reasons. Within three months of the date of the notice the patentee may submit to the board a reply setting out submissions on the question of the patentability of the claim(s) of the patent in respect of which the notice was given. After receipt of such reply or, if no reply is received within the three-month period, after expiration of that period the board shall forthwith cause a re-examination to be made of the patent claim(s) concerned. In the re-examination procedure, the patentee may propose any amendment to the claims or any new claims in relation thereto, but an amended claim or new claim which would broaden the scope of the patent is not admissible. The re-examination procedure must be completed within twelve months.

On conclusion of a re-examination procedure the re-examination board may issue a certificate as follows:

- (1) cancelling any claim of the patent determined to be unpatentable;

- (2) confirming any claim of the patent determined to be patentable; or
- (3) incorporating in the patent any proposed amendment or new claim determined to be patentable.

Such certificate shall be attached to the patent and made part thereof by reference. If such certificate cancels all claims of the patent, the same is deemed never to have been issued. If the certificate cancels any claim but not all claims of the patent, the patent shall be deemed to have been issued in the corrected form from the date of grant. If the certificate amends any claim of the patent or incorporates any new claim therein, the amended claim or new claim shall be effective from the date of the certificate for the unexpired term of the patent.

[12] Appeal

If a patent application is refused, an appeal may be lodged with the Federal Court within six months of the date the notice of refusal was mailed. The Federal Court has exclusive jurisdiction to hear and determine the appeal.

An appeal may be lodged against the decision of the re-examination board (only) by the patentee with the Federal Court within three months. No appeal can be lodged against the Commissioner's refusal to establish a re-examination board.

[13] Unity of invention

A patent shall be granted for one invention only, but a patent shall not be deemed invalid by reason only that it has been granted for more than one invention. The requirement of unity of invention is met if the subject matters defined by the claims of an application are so linked as to form a single general inventive concept, in accordance with Rule 13 PCT. There is no limit to the number of species which may be claimed, provided the application contains an allowable generic claim. An application shall not be deemed to claim more than one invention by reason only that it claims the following:

- (1) a product and a process for making the product;
- (2) a product and a use of the product;
- (3) a process and an apparatus specially adapted to carry out the process;
- (4) a product, a process for making the product and a use of the product; or
- (5) a product, a process for making the product and an apparatus specially adapted to carry out the process.

[14] Divisional applications / Continuation applications

An applicant is entitled to file a divisional application at any time during the pendency of a parent application. Practically speaking, the pendency of the parent application ends on the day before the date of issue of the parent application. The 'parent' is the application immediately preceding the divisional application; it is not the 'ultimate' or 'original' parent or grandparent etc. in cases of multiple generations of divisional applications. Where the parent application has been abandoned and where a possibility exists for reinstatement as of right, a divisional application must be filed before the period to reinstate the parent application as of right expires.

A voluntary divisional application should be carefully considered as to whether it overlaps its parent or another parent in a chain, as it can be subject to a potential rejection during examination or later invalidation on the basis of 'overlap' or 'double patenting' over the parent. As such, using divisional applications to mimic continuation applications is not reliable in

Canada. A divisional application filed in response to a 'unity' objection has some protection from being later considered to be a double patenting case.

A request for examination of a divisional application, along with payment of the accompanying fee, must be made before the later of the four-year period after the filing date of the parent application and the three-month period after the actual filing date of the divisional application. If the examination request is not filed and/or the examination fee not paid in due time, CIPO will send a notice requiring that the request be filed along with a late fee within two months of the date of the notice or the application will be deemed abandoned. If the application is deemed abandoned for failing to respond to the notice, it may be reinstated as of right by making a request for reinstatement, requesting examination and paying the required fees within 6 months from the original due date (i.e. the expiry of the four-year period after the filing date of the parent application or of the three-month period after the actual filing date of the divisional application).

[15] Conversion

Not applicable in this jurisdiction.

[16] Publication / Public File Inspection

All patent applications will be laid open for public inspection after eighteen months from the filing date or, if priority was claimed, after eighteen months from the (earliest) priority date. The applicant may request that an application be laid open for public inspection at an earlier date (e.g., to obtain a form of provisional protection). Applications that have become open to public inspection are also published.

On the day of grant of a patent, short formal details are published in the Canadian Patent Office Record, which is published weekly.

Published applications and issued patents are available on CIPO's Canadian Patents Database.

If the specification of a Canadian patent, or of an application filed in Canada (or a PCT international application that has duly entered into the national phase in Canada) that is open to public inspection, refers to a deposit of biological material by the applicant, any person may file with the Commissioner a request on prescribed form for the furnishing of a sample of the deposit. The term 'biological material' may include bacteria, bacteriophages, cells in culture, hybridomas, filamentous fungi, yeasts, plant seeds, viruses, purified nucleic acid molecules, plasmids, and replication-defective cells. If a patent has not yet been issued on the application, or the application is not yet refused or irrevocably abandoned and not withdrawn, the person requesting the furnishing of a sample must undertake the following:

- (1) not to make any sample of biological material furnished by the International Depositary Authority concerned or any culture derived from such sample available to any other person before either a patent is issued on the basis of the application or the application is refused, or is abandoned and can no longer be reinstated, or is withdrawn; and
- (2) to use the sample of biological material furnished by the International Depositary Authority concerned and any culture derived from such sample only for the purpose of experiments relating to the subject matter of the application until either a patent is issued on the basis of the application or the application is refused, or is abandoned and can no longer be reinstated, or is withdrawn.

Until an application referring to a deposit of biological material becomes open to public inspection, the applicant may file a notice with the Commissioner stating that until either a patent has been issued on the basis of the application or the application is refused, or is abandoned and can no longer be reinstated, or is withdrawn, they wish that the Commissioner

authorizes the furnishing of a sample of the deposited material only to an independent expert nominated by the Commissioner. One of the Commissioner's tasks is to nominate a person as an independent expert within a reasonable time.

Upon the request of any person who sufficiently identifies a foreign patent (by stating in writing the name of the inventor, if available, the title of the invention, the number and date of the patent and the name of the country concerned) and pays a fee, the CIPO will advise whether an application for a patent for the same invention (either a Canadian national application or a PCT international application which has entered into the national phase in Canada) is or is not pending in Canada, and is or is not yet open to public inspection.

[17] Withdrawal to prevent publication

An application may be withdrawn on written notice from the applicant or authorized correspondent. If the application is withdrawn at least two months before expiration of eighteen months from the filing date or, if priority has been claimed, at least two months before expiration of eighteen months from the earliest priority date, (or even if it is withdrawn later but before expiration of said eighteen-month term, provided the Commissioner is able to stop the technical preparations to open the application to public inspection), the application shall not become open to public inspection.

[J] Nullity and Revocation

The Federal Court may declare a patent or any claim therein invalid or void at the request of any interested person (subject to 'standing' requirements) or the Attorney General.

[K] Use Requirement

There is no requirement for the owner of a patent to work the invention. However, under certain circumstances a compulsory license may be granted after three years from date of issue.

[L] Marking

There is no legal requirement to mark patented articles as such. Marked products have no implications for awarding compensation in case of past infringement.

Marking of IC products embodying a protected topography is recommended, in order to prevent that in an infringement action the defendant could prove that they were not aware of the registration of the topography.

Falsely marking an article as patented or protected under a certificate of supplementary protection, is an indictable offence and guilty persons may be subject to a fine not exceeding CAD 200 or imprisonment for a term not exceeding three months, or both.

[M] Infringement

[1] Infringing acts / Non-infringing acts

Whoever without authority of the patentee makes, constructs, uses or sells any patented invention within Canada during the term of the patent therefore, infringes the patent. In an action for infringement of a patent for a process for obtaining a new product, any product that

is the same as the new product shall, in the absence of proof to the contrary, be deemed to have been produced by the patented process.

A patent's prosecution history may be admissible into evidence in an infringement dispute. Specifically, the Patent Act provides that written communications made between the applicant and CIPO during prosecution, as well as disclaimers and requests for re-examination may be admissible to rebut representation made by the patentee with respect to claim construction.

The following are not considered infringement:

- (1) use of any invention in any ship, vessel, aircraft or land vehicle of any other country, entering Canada only temporarily or accidentally, provided that the invention is employed exclusively for the needs of the ship, vessel, aircraft or land vehicle, and not so used for the manufacture of any goods to be vended within or exported from Canada; and
- (2) making, constructing, using or selling a patented invention solely for uses reasonably related to the development and submission of information required under any law of Canada, a province or a country other than Canada that regulates the manufacture, construction, use or sale of any product.

The Roche-Bolar exemption applies in Canada to a certain extent. The Canadian Patent Act provides that certain activities may not infringe a patent in certain instances, such as acts done privately and on a non-commercial scale or for a non-commercial purpose, or in respect of any use, manufacture, construction or sale of a patented invention solely for the purpose of experiments relating to the subject matter of the patent. There is no general 'research' exemption. However, an act which is done solely for non-commercial purposes, or for conducting research aimed at developing an improvement of a patented invention, may be exempt from infringement.

A patent claiming a novel gene or cell may be infringed by the use or sale of an organism which contains the patented substance.

Any interested person may bring an action in the Federal Court against a patentee for a declaration that any process (proposed to be) used or any article (proposed to be) made, used or sold by such person does not infringe upon the other party's patent(s).

In October 2019 changes to the Patent Act and Rules introduced a new system of third party rights to discourage the late payment of fees or abandonment and reinstatement during prosecution. Third party rights provide an exception to infringement for acts committed in good faith during a period defined by the rules and can be triggered following a failure to pay maintenance fees, to request examination or the deemed abandonment of an application. Third party rights can follow the transfer of a business to a transferee and can also extend to divisional applications and certificates of supplementary protection.

[2] Prior user rights

The Patent Act provides an exception to infringement for anyone who, before the claim date and in good faith, commits an act, or made serious and effective preparations to commit such an act, that would otherwise constitute an infringement of a patent or a certificate of supplementary protection, if such person commits the same act on or after the claim date.

The use or sale of an article is not considered as infringement of a patent or certificate of supplementary protection, if that article was acquired, directly or indirectly, from a person who, at the time that person disposed of it, could sell it without infringing the patent or certificate of supplementary protection due to an existing third party right.

A prior user right may be transferred with the sale of a business, in which case the transferor does not retain the prior user right.

[3] Remedies

Infringement actions are to be brought before a competent Court (Federal Court or a provincial Court). The invalidity of a patent may be asserted as a defence in an infringement suit. Available remedies include: injunction, award of damages, or accounting of profits. Infringement action becomes statute-barred six years after the infringement was committed.

Although infringement action in principle can be taken only in respect of acts committed and for damages sustained by the patentee and the persons claiming under the patentee after grant of the patent, there exists provisional protection as from the date of laying open of the patent application for public inspection. Applications are laid open at eighteen months from the filing or priority date, or earlier if so requested by applicant. After the patent issues, reasonable compensation may be claimed for any damages sustained by the patentee or by any person claiming under the patentee by reason of any act after the application became open for public inspection and before the grant of the patent, that would have constituted an infringement of the patent if the patent had been granted on the day the application became open to public inspection.

It has not been established whether allowing an application to go temporarily abandoned during pendency can affect the patentee's ability to, once the patent is granted, later collect reasonable compensation for infringement occurring between the date of publication and the date of grant.

[4] Penal provisions

There are no explicitly identified penal provisions in the Patent Act or Rules concerning infringement.

[5] Enforcement and Customs

There is no provision whereby goods imported into Canada can be screened or otherwise prevented from entering Canada if they infringe Canadian patents.

[N] Restoration after unintentional lapse

Failure to respond to a requisition or notice under the Patent Act or Rules may result in an application being deemed abandoned or a patent being deemed expired. Generally, a twelve-month reinstatement period from the due date to respond is available. Reinstatement requires that the applicant or patentee files a request for reinstatement, takes the action that should have been taken to avoid deemed abandonment or deemed expiry, and pays a reinstatement fee. The default under the Patent Act and Rules is that reinstatement also requires submission of reasons for the failure to take the action that should have been taken and that CIPO determines that the failure occurred in spite of the due care required by the circumstances having been taken; however, a number of exceptions from the due care requirement are available.

Reinstating an application abandoned for failure to request examination is possible within twelve months of the date of abandonment (i.e. the expiry of 2 months from notification). Reinstatement is possible as of right within a grace period of 6 months of the original deadline (i.e. the expiry of four years from the filing date). Otherwise, the applicant must also state the reasons for the failure to request examination and the application will only be reinstated if the Commissioner determines that the failure occurred in spite of the due care required under the circumstances having been taken. Furthermore, if corrective action is not taken within the grace period of six months of the original deadline, third party rights may arise.

An applicant who fails to enter into the national phase within the 30-month deadline (for PCT applications filed on or after 30 October 2019), may file a request for reinstatement, by submitting a statement that the failure was unintentional within twelve months from the thirty-month deadline and paying a reinstatement fee. For PCT applications filed before 30 October 2019 reinstatement within twelve months from the thirty-month deadline is possible as of right, even if the delay is intentional.

A patent application (patent) that has been abandoned (expired) due to non-payment of the maintenance fee may be reinstated within twelve months of the expiry of the grace period, if the applicant/patentee pays the maintenance and late fees, and also a reinstatement fee. The applicant/patentee must also state the reasons for the failure to pay the maintenance fee. Significantly, the case will only be reinstated if the Commissioner determines that the failure occurred in spite of the due care required under the circumstances having been taken. If the maintenance and late fees are not paid within the grace period, third party rights may arise. Third party rights provide an exception to a finding of infringement and may subsist for the life of the patent.

Restoration of the right of priority for regular national applications must be made within two months from the expiry of the twelve months' priority term, stating that the failure to file the application within twelve months from the priority date was unintentional.

For PCT applications filed on or after 30 October 2019: Provided that a PCT application and a request for restoration is filed at the Receiving Office in this jurisdiction within 14 months from the priority date, restoration of priority right under Rule 26bis.3 in the international phase of the PCT application may be possible. If a priority right for a PCT application was restored by the Receiving Office, this may be recognized under Rule 49ter.1 PCT for the national phase application in this jurisdiction. Also a review of negative decision on the request for restoration by the Receiving Office may be requested in the national phase. Furthermore, if a PCT application was filed within 14 months from the priority date, but no request for restoration of priority right was filed at the Receiving Office, a request for restoration of priority right under Rule 49ter.2 PCT may be filed at the Designated Office within one month from the applicable time limit for the entry into the national phase.

Importantly, the actual priority claim still needs to be made before the earlier of (a) the expiry of the one-month period from the national phase entry in Canada; and (b) the later of sixteen months from the earliest priority date and four months from the filing date which is the PCT filing date for national phase entry applications. Practically, this will mean that a timely priority claim will need to have been included in the PCT application, even if priority restoration is not requested in the international phase.

[O] Specific Aspects of Regional Patents

[1] Filing Authority

Not applicable in this jurisdiction.

[2] Appointment of Representative

Not applicable in this jurisdiction.

[3] Validation

Not applicable in this jurisdiction.

[4] Authentic text

Not applicable in this jurisdiction.

[5] Amendments and corrections

Not applicable in this jurisdiction.

[6] Publication

Not applicable in this jurisdiction.

[7] Provisional protection

Not applicable in this jurisdiction.

[8] Simultaneous protection

Not applicable in this jurisdiction.

[9] Conversion

Not applicable in this jurisdiction.

[10] Payment of fees

Not applicable in this jurisdiction.

[P] Specific Aspects of International Patent Applications (PCT)*[1] Receiving Office*

The CIPO acts as a Receiving Office for nationals and residents of Canada.

[2] International Searching Authority

The CIPO is the competent International Searching Authority for all international applications originating from Canada.

[3] International Preliminary Examining Authority

The CIPO is the competent International Preliminary Examining Authority for all international applications originating from Canada.

[4] National phase / Regional phase

Entering the national phase in Canada must be done within thirty months of the filing/priority date.

For national phase entry applications from PCT applications with an international filing date before 30 October 2019, it is possible to file late up to 42 months from the earliest date, as of right.

For entering the national phase no special form needs to be used.

When entering the national phase, an English or French translation of the international application (if not filed in either English or French) must be filed with CIPO upon entry along with the basic national fee. The translation must contain the description, claims, any text matter of the drawings, and the abstract. If the claims were amended, the translation must contain the claims as amended only, together with any explanatory statement. The Commissioner may require the applicant to furnish a statement by the translator that to the best of their knowledge, the translation is complete and faithful.

Applicants who enter into the national phase based on PCT applications filed on or after 30 October 2019 must file a certified copy of any priority application if not already filed and accepted at the international stage. This can be done either by: (1) providing CIPO with certified copies of the priority applications; or (2) notifying CIPO that the documents are available in an accepted digital library, such as the WIPO Digital Access Service. The deadline for ‘filing’ certified copies of any priority application is the later of:

- (1) 16 months from the earliest priority date of the priority applications;
- (2) 4 months from the filing date of the pending application; and
- (3) the national phase entry date (for PCT national phase applications).

The address for service in Canada will normally be the address of the appointed agent in Canada; the agent may be appointed either in a special form for entering the national phase or by filing a notice signed by the applicant. If the appointed agent does not reside in Canada, they must appoint a patent agent residing in Canada as associate agent by filing a notice signed by the appointed agent.

If the applicant(s) are the inventor(s), a statement that the applicant(s) are all inventor(s) and are the sole inventor(s) is required. If the applicant(s) are not the inventor(s), a statement to the effect that the applicant(s) are entitled to apply for a patent must be filed. Alternatively, a declaration in accordance with Rule 4.17 of the Regulations under the PCT may be filed.

If not already given in the international request, the name and address of the inventor must be provided.

Canada has strict timing rules with respect to corrections of any errors in the identity of the listed applicant(s). Corrections to the applicant’s identity must be requested generally within 3 months of the national phase entry date.

CIPO now obtains biological sequence listings forming part of the description automatically from WIPO in the format submitted during the international phase.

If the national phase is entered into on or after the date of the publication of the application by the International Bureau in English or French, the application will be deemed open to public inspection on and after the date of that publication.

The average processing time from entry into the national phase to grant is four to seven years.

[5] Payment of fees

Upon entry the basic national fee must be paid to the CIPO.

Annual maintenance fees are due for the third and following years from the international filing date. The annual maintenance fee for the third year is to be paid within the later of

twenty-four months of the international filing date or thirty months from the filing/priority date; the subsequent annual fees must be paid each year before or on each subsequent anniversary of the international filing date.

Examination of the application must be requested and the examination fee paid within four years of the international filing date.

[Q] Fees

A two-tier fee system is applicable in Canada, making a distinction between ‘small entities’ and others. With respect to the application fee, the examination fee, the annual maintenance fees, the final (issuance) fee, and the re-examination fee, small entities are entitled to as much as a 50% reduction.

The determination of whether an applicant is a ‘small entity’ is made at the time of filing of each application for non-PCT applications, and for PCT applications as of the date on which the requirements for Canadian national phase entry are completed. Once an applicant is determined to be a ‘small entity’, the applicant and any subsequent owner of the patent may enjoy the benefit of the ‘small entity’ fees throughout the prosecution and the full term of protection of the patent. In order to enjoy the benefit of a reduction in fees as a ‘small entity’, a small entity declaration must be filed with CIPO.

Under the current Patent Rules, a ‘small entity’ is defined as an entity employing fifty or fewer employees or a university, but does not include an entity that:

- (a) is controlled directly or indirectly by an entity, other than a university, that employs more than fifty employees; or
- (b) has transferred or licensed or has an obligation, other than a contingent obligation, to transfer any right or interest in the claimed invention to an entity, other than a university, that has more than fifty employees.

It is important that the agent in Canada be informed of small entity status of applicant in time (so that small entity status can be claimed in the Petition for grant), as otherwise the standard amounts of the fees will have to be paid. There is no refund of any fees already paid if the information that applicant is a small entity is furnished subsequently.

If an applicant has improperly claimed small entity status, and paid fees at this level, the Patent Act permits this situation to be corrected for a limited period of time subject to the direction of the Commissioner. After this period, the application or patent will be considered abandoned.

According to the Service Fees Act, should CIPO fail to meet the service standard for a service on which a fee has been paid on or after 1 April 2021, applicants may be eligible to remissions of up to 50% of the fee. CIPO will inform the authorized correspondent in a notice, setting out details on the remission, including the service standard that is not met, the remission amount, and the procedure for refusing a remission.

[1] Table of official fees

Fees as of 1 January 2022

	CAD
Application fee for patent for a small entity	203.59
Other than a small entity	407.18

On requesting the examination of an application if not subject of an international search by the Commissioner for a small entity	407.18
Other than a small entity	814.37
On requesting the examination of an application if subject of an international search by the Commissioner for a small entity	100.00
Other than a small entity	203.59
On requesting the advancing for examination of an application out of its routine order	508.98
Reinstatement fee	203.59
Final fee (on allowance):	
On an application filed on or after 1 October 1989:	
(a) a small entity	152.69
(b) other than a small entity	305.39
On or additional fee for each page of specification and drawings in excess of 100 pages	6.11
Fee for a notice of allowance to be withdrawn and for an application for a patent to be subject to further examination	407.18
On filing a request for correction of a clerical error in a patent	203.59
On asking to register a document relating to patents or applications, to record a change of name or a transfer:	
Each patent or application to which the document, change of name or transfer relates	100.00
An extension of time	203.59
On filing an application to reissue patent	1,628.74
On making a disclaimer to a patent	100.00
On filing a request for re-examination:	
(a) a small entity	1,017.96
(b) other than a small entity	2,035.92
On filing an application for a compulsory license, for the first patent referred to in the application	2,500.00
Additionally, for each further patent referred to in same application	250.00
Advertising an application for a compulsory license in the CIPO Record	200.00
On requesting information concerning the status of a patent or an application for a patent, for each patent or application for a patent	15.00
On requesting a non-certified copy in paper form of a document, per page (if the Office makes the copy)	1.00
On requesting a non-certified copy in electronic form of a document, for each request	10.00
Plus	
(a) each patent or application to which the request relates	10.00
(b) if the copy is requested on a physical medium, for each physical medium in addition to the first	10.00
On asking for a certified copy of any document in paper form:	
(a) each certification	35.00
(b) plus for each page	1.00
In electronic form:	
(a) each certification	35.00

(b) plus for each patent or application to which the request relates	10.00
(c) plus for each additional ten megabytes or part of them exceeding 7 megabytes	10.00
The amounts of the annual maintenance fees to be paid to maintain a pending patent application, or issued patent based thereon are as follows:	
On or before each of the 2nd, 3rd and 4th anniversaries of the filing date:	
(a) a small entity	50.00
(b) other than a small entity	100.00
On or before each of the 5th, 6th, 7th, 8th and 9th anniversaries of the filing date:	
(a) a small entity	100.00
(b) other than a small entity	203.59
On or before each of the 10th, 11th, 12th, 13th and 14th anniversaries of the filing date:	
(a) a small entity	125.00
(b) other than a small entity	254.49
On or before each of the 15th, 16th, 17th, 18th and 19th anniversaries of the filing date:	
(a) a small entity	229.04
(b) other than a small entity	458.08
Late fee for payment of maintenance fee	150.00
Certificate of Supplementary Protection	9,756.00

[R] Transitional Provisions

A series of transitional provisions are provided in the current Patent Act and Rules. Many of these provisions address the application of specific requirements or deadlines in relation to the coming into force of the amendments to the Patent Act and Rules on 30 October 2019. The transitional provisions are complex and their impact should be determined on a case by case basis in consultation with a Canadian patent agent.

[S] Specific Patent Issues

- (a) Any person who invents any inventions relating to instruments or munitions of war may be required to assign all the benefits of the invention and any patent obtained or to be obtained to the Minister of National Defence. The inventor/assignor is entitled to compensation for the assignment. The invention, patent application and related documents shall be kept secret and under the authority of the Minister of National Defence. The Patent Act and Rules may indirectly attract penal provisions under other legislation. For example, an applicant who is required to assign its application to the Minister of National Defence and covenants to keep such application, assignment or other information secret, is guilty of an indictable offence under the Security of Information Act if that applicant communicates such information to an unauthorized party.
- (b) A patent application which in the Commissioner's opinion relates to the production, application or use of nuclear energy will, before it is dealt with by an Examiner, or opened to inspection by the public, shall be communicated by the Commissioner to the Canadian Nuclear Safety Commission.
- (c) The Patent Act provides that the Commissioner of Patents shall, on the application of the Minister of Health, authorize the Government of Canada and any other person specified in the application to make, construct, use and sell a patented invention to the extent

necessary to respond to a public health emergency. Applications must include, *inter alia*, a description of the public health emergency and a confirmation that the Chief Public Health Officer believes that the emergency is of national concern.

[T] Governmental Websites

- <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home> (Canadian Intellectual Property Office)
- <https://www.ic.gc.ca/opic-cipo/cpd/eng/introduction.html> (Register)

PART 2 TRADEMARKS

§2.01 SUMMARY

[A] Duration of Registration

- 10 years from the date of registration (15 years, if registered prior to 17 June 2019), indefinitely renewable for 10-year periods.

[B] Registrable / Not Registrable

- A registrable mark is a word, sound or design, or a composite mark of word and design, used or intended to be used to distinguish in trade the goods or services of one person or organization from those of others.
- Non-traditional marks may be registered, such as a hologram, moving image, scent, taste, colour, three-dimensional shape, mode of packaging goods, texture, or position of a sign.

[C] Application Procedure

- Examination is conducted as to form, registrability per se and conflict with other existing registered or previously applied for trademarks in good standing.

[D] Governmental Websites

- <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home> (Canadian Intellectual Property Office)
- <http://www.cipo.gc.ca/app/opic-cipo/trdmrks/srch/home> (Register)

§2.02 DETAILED INFORMATION

[A] Conventions and Legislation

[1] Conventions

- Paris Convention (International Union) 1883–1967 (Canada is bound by the substantive articles (Articles I to 12) of the Stockholm text of 1967 as from 26 May 1996);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967;
- North American Free Trade Agreement (NAFTA) (with effect from 1 January 1994);
- Canada-Korea Free Trade Agreement (with effect from 1 January 2015);
- Canada-European Union: Comprehensive Economic and Trade Agreement (CETA) (with effect from 21 September 2017);
- Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (with effect from 17 June 2019);
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (with effect from 17 June 2019); and
- Singapore Treaty on the Law of Trademarks (with effect from 17 June 2019).

[2] Laws

- Trademarks Act, R.S.C. 1985, Chapter T-13, as amended up to 2019;
- Trademarks Regulations (SOR/2018-227);
- Olympic and Paralympic Marks Act, R.S.C. 2007, Chapter C-25, as amended up to 2019;
- Olympic and Paralympic Marks Regulations (SOR/2007-294); and
- Combating Counterfeit Products Act (in force 1 January 2015).

[B] Duration of Registration

Ten years from the date of registration (fifteen years, if registered prior to 17 June 2019), indefinitely renewable for ten-year periods.

[C] Requirements for Renewal

The prescribed period to pay the renewal fee begins six months before the registration expires, and ends on the later of two dates (i.e. whichever gives more time to the trademark owner to renew):

six months after the day on which the registration expires or two months after the date of a notice to renew the trademark is sent by the Registrar. No surcharge is due if payment is made after the expiry date. See further ‘Restoration after unintentional lapse’.

For registrations that issued prior to 17 June 2019, payment may be made at any time before expiration of the running period.

No particular documents are required, a letter requesting renewal with the renewal fee enclosed being sufficient. Alternatively, the renewal fee may be paid electronically.

Renewal of a registration that expires on or after 17 June 2019 requires that the goods and services are grouped according to the Nice Classification. The renewal fee will depend on the number of classes.

Renewal is effective from the day after expiration of the former period.

[D] Registrable / Not Registrable

A trademark is defined as a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by that person from those manufactured, sold, leased, hired or performed by others.

A word, a design, a sound or a composite word and design mark used or intended to be used to distinguish in trade the goods or services of one person or organization from those of others may be registered as a trademark. Colour may be claimed as a feature of a design trademark.

Non-traditional marks may be registered, such as a hologram, moving image, scent, taste, colour, three-dimensional shape, mode of packaging goods, texture, or position of a sign.

A trademark may be registered if it is not:

- (a) a word that is primarily merely the name or surname of a person living or deceased within the preceding thirty years;
- (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in English or French, of the character, quality, conditions of production, persons employed in their production or place of origin of the goods or services in association with which it is used;
- (c) the name in any language of the goods or services in connection with which it is used or proposed to be used;
- (d) confusing with a registered trademark;
- (e) a mark which by ordinary and bona fide commercial usage became recognized in Canada as designating the kind, quality, quantity, destination, value, or place of origin or date of production of the goods or services;
- (f) likely to mislead because of similarity to a plant variety denomination;
- (g) in whole or in part, a protected geographical indication, where the trademark is to be registered in association with a wine, spirit, agricultural product or food not originating in a territory indicated by the geographical indication; and
- (h) a mark that is prohibited by section 9 of the Trademarks Act or a mark that so nearly resembles an Olympic or Paralympic mark as to be likely to be mistaken for it.

A 9 November 2016 Practice Notice issued by the CIPO provides guidelines for the interpretation of the provisions relating to place of origin and geographical names. A trademark is clearly descriptive of the place of origin if the trademark, whether depicted, written or sounded, is a geographical name and the associated goods or services originate from the location of the geographical name. A trademark is misdescriptive if the trademark is a geographical name and the associated goods or services do not originate from the location of the geographical name. If a trademark is misdescriptive, further analysis is required to determine if it is deceptive. A trademark will be determined to be a geographical name if research shows that the trademark has no meaning other than as a geographical name, or if it has a primary or predominant meaning as a geographical name.

A trademark that is not registrable according to items (a) and (b) above may be registered if it has been used in Canada by the applicant or its predecessor in title so as to have become distinctive at the date of filing the application for registration.

A trademark which resembles an Olympic or Paralympic mark, as defined by the Olympic and Paralympic Marks Act, may be adopted, used or registered if such trademark was used before 2 March 2007 for the same goods and services or if the applicant has obtained timely written consent of the relevant Canadian Olympic or Paralympic organizing committee.

A trademark is not registrable if, in relation to the goods or services in association with which it is used or proposed to be used, its features are dictated primarily by a utilitarian function.

Registration and protection as a trademark is prohibited in respect of:

- (1) The Royal Arms, Crest or Standard.
- (2) The arms or crest of any member of the Royal Family.
- (3) The standard, arms or crest of the Governor General.
- (4) Any word or symbol likely to lead to the belief that the goods or services for which it is used have received or are produced, sold or performed under royal, vice-regal or governmental patronage, approval or authority.
- (5) The arms, crest or flag adopted and used at any time by Canada or by any Canadian province or municipal corporation, of which the Registrar has given public notice of its adoption and use.
- (6) The emblem of the Red Cross or the expression 'Red Cross' or 'Geneva Cross'.
- (7) The emblem of the Red Crescent or the third Protocol emblem commonly known as the Red Crystal.
- (8) The sign of the Red Lion and Sun.
- (9) The international distinctive sign of civil defence (consisting of an equilateral blue triangle on an orange ground).
- (10) Any territorial or civic flag, or any national, territorial or civic arms, crest or emblem of a Paris Convention or WTO member country, if on a list communicated under Article 6*ter* of the Paris Convention or pursuant to the WTO TRIPs Agreement, and of which the Registrar has given public notice.
- (11) Any official sign or hallmark indicating control or warranty adopted by a Paris Convention or WTO member country, if on a list communicated under Article 6*ter* of the Paris Convention or pursuant to the WTO TRIPs Agreement, and of which the Registrar has given public notice (note that marks containing such sign or hallmark could be registered for goods not similar to those for which it has been adopted).
- (12) Any national flag of a Paris Convention or WTO member country.
- (13) Any armorial bearings, flag or other emblem, or any abbreviation of the name, of an international intergovernmental organization if on a list communicated under Article 6*ter* of the Paris Convention or pursuant to the obligations under the WTO TRIPs Agreement, and of which the Registrar has given public notice (but marks containing any of these could be registrable if the use thereof is not likely to mislead the public as to a connection between the user and the organization).
- (14) Any scandalous, obscene or immoral word or device.
- (15) Any matter that may falsely suggest a connection with any living individual.
- (16) The portrait or signature of any individual who is living or has died within the preceding thirty years.
- (17) The words 'United Nations' or the official seal or emblem of the United Nations Organization.
- (18) Any badge, crest, emblem or mark (a) adopted or used by the Canadian naval, army or air forces, (b) of any university, or (c) adopted and used by any public authority in Canada as an official mark for goods or services, if the Registrar has given public notice of the adoption and use of the same.
- (19) Any armorial bearings granted, recorded or approved for use by a recipient pursuant to the prerogative powers of Her Majesty as exercised by the Governor General in respect of the granting of armorial bearings, if the Registrar has given public notice of the grant, recording or approval.
- (20) The name 'Royal Canadian Mounted Police' or 'R.C.M.P.' or any other combination of letters relating to said organization or any representation of a uniformed member thereof.

Prohibited marks mentioned in the above paragraph may nevertheless be registered with the consent of the person intended to be protected by the provisions prohibiting the registration.

[1] Colour marks

It is possible to register a single colour or a combination of colours without delineated contours. The application must include a description that provides the common name of the colour(s) and a visual representation consisting of a square swatch of each colour.

[2] Three-dimensional marks

It is possible to register a trademark that consists in whole or in part of a three-dimensional shape or mode of packaging goods. For a trademark containing or consisting of a three-dimensional shape, the application must include a visual representation including only those portions of the shape that form part of the trademark. If the representation includes elements that do not form part of the trademark, they must be shown in dashed lines. For a trademark containing or consisting of a mode of packaging goods, a visual representation must be included. A three-dimensional shape or mode of packaging goods may be registered if it has been used in Canada in such a manner by the applicant or its predecessor as to have become distinctive at the date of filing the application, and provided that the exclusive use by the applicant of the three-dimensional shape or mode of packaging in association with the goods or services with which it has been used is not likely to limit unreasonably the development of any art or industry. (Any interested party may request the Federal Court to expunge the registration on the ground that it has become likely to limit unreasonably the development of any art or industry.) No registration of a three-dimensional shape or mode of packaging goods interferes with the use of any utilitarian feature embodied in the trademark.

[3] Collective marks

Not applicable in this jurisdiction.

[4] Certification / guarantee marks

A certification mark means a mark that is used for the purpose of distinguishing or so as to distinguish goods or services that are of a defined standard with respect to:

- the character or quality of the goods or services;
- the working conditions under which the goods have been produced or the services been performed;
- the class of persons by whom the goods have been produced or the services performed;
- or
- the area within which the goods have been produced or the services performed from goods or services that are not of that defined standard.

A certification mark may only be registered by a person who is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services of the kind in association with which the certification mark is used.

A certification mark being descriptive of the place of origin of goods or services and not confusing with any registered trademark, may be registered if applicant is the administrative authority of a country, state, province or municipality including or forming part of the area indicated by the mark, or is a commercial association having an office or representative in that area. The owner of such mark must permit the use of the mark in association with goods or services produced or performed in the area of which the mark is descriptive.

[5] Associated marks

Not applicable in this jurisdiction.

[6] Series of marks

Not applicable in this jurisdiction.

[7] Other marks

A variety of non-traditional marks can be registered. These include: holograms, moving images, scents, tastes, colours, three-dimensional shapes, a mode of packaging goods, textures, or the positioning of a sign. Certain non-traditional marks may only be registered if used in Canada in such a manner by the applicant or its predecessor as to have become distinctive at the date of filing the application, namely sounds, scents, tastes, colours, three-dimensional shapes, a mode of packaging goods or textures. The contents of an application for registration of a non-traditional mark must conform to specific requirements, as set out in the Trademarks Act and Trademarks Regulations.

Official marks are authorized marks adopted and used by a public authority in Canada for goods and/or services. Official marks are granted a broader scope of protection than that provided to trademarks (i.e. goods and services do not need to be identified and they do not expire). ‘Public authority’ is not defined in the Trademarks Act. Case law has interpreted the ‘public authority’ to be subject to a significant degree of governmental control and to dedicate its profits to the benefit of the public good in Canada.

[E] Ownership and related rights*[1] Applicant*

Any individual, company, partnership, trade union or lawful association is entitled to apply for the registration of a trademark, so long as the entity or person falls under one of the following classes of person:

- (a) A person who has used the trademark in Canada.
- (b) A person who has used the trademark in a Paris Convention or WTO member country and has made it known in Canada.
- (c) A person whose country of origin is a Paris Convention or WTO member country, and who has duly registered the trademark in or for that country or applied for its registration in or for that country and has used the trademark abroad.
- (d) A person who proposes to use the trademark in Canada, by itself or through a licensee, or by itself and through a licensee.

The successor in title of a person as mentioned above may apply for registration of the mark.

Registration of a certification mark may not be applied for by a person making or dealing in the goods or services for which the mark is used according to the applicable standard. There is nothing in the Act which prohibits a person from owning both a trademark and a certification mark, so long as the marks exhibit an appropriate difference, and such person is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services of the kind in association with which the certification mark is used.

An official mark holder is restricted to a ‘public authority’.

As a general rule, there is no requirement to provide the Office with evidence of a change of name. If the name change is a result of a merger/amalgamation or a change in corporate status, the Office will require some evidence that shows the circumstances in which the name changed (e.g. certificate of merger/amalgamation).

[2] Establishment of rights “first-to-file/ first-to-use”

Canada follows a ‘first-to-use’ priority system for trademarks. Any applicant who has filed an application in accordance with the relevant requirements and who (or its predecessor in title) has used or made known the trademark in Canada, is entitled, subject to relevant constraints, to secure registration, unless at the date on which that trademark was first used it was confusing with a trademark that had previously been used, made known or filed in Canada by any other person.

The right to a trademark is effective throughout Canada subject to rights of a concurrent user. First use or making known in Canada is the primary factor in determining the right to a trademark.

In May 2005, a decision of the Federal Court of Appeal changed the examination process in the CIPO. The Examiners will determine who is entitled to a registered trademark in Canada on a first-to-file basis. An Examiner will not consider the date of first use or making known in Canada when determining whether an applicant is entitled to the registration of a trademark that is confusing with another trademark that is the subject of a co-pending application. Thus, at the examination stage, the application with the earlier filing date will be approved and the other co-pending application will be refused. However, the adoption of the first-to-file practice at the examination stage does not alter the fact that the primary right to a trademark is based on use or making known.

[3] Assignment

A trademark, whether registered or not, is transferable and is deemed always to have been transferable with or without the goodwill of the business and in respect of either all or some of the goods or services for which it has been used. The right to use a trademark may be assigned to more than one assignee. When assigning trademark rights to multiple assignees, caution should be taken to avoid an assignee using the trademark in a manner inconsistent with the use of any other assignee or inconsistent with the particulars of the registration. Such inconsistent use may render the registered trademark non-distinctive or not in use, and thus potentially invalidate the registration. An assignment is valid whether or not it is registered with the CIPO. When registering an assignment on behalf of the assignor, no supporting documentation is required. When registering an assignment on behalf of the assignee, the evidence of the transfer (no legalisation) must be provided.

In cases where at least one of the parties to an assignment or transfer is situated in the Province of Quebec, the special provisions on the obligatory use of French might apply. These provisions may have an impact on the assignment of industrial property rights. According to these provisions, all of the following contracts shall be drawn up in French, except when at the express will of the parties they are drawn up in another language:

- contracts the conditions of which are pre-determined by one party; and
- contracts containing printed standard clauses.

It is therefore recommended that in contracts that assign intellectual property rights between parties of which at least one of the parties is situated in the Province of Quebec, a clause be added at the end in both French and the language of the contract stating that all parties have agreed upon the drawing up of the contract in that other language.

[4] Licenses and Registered Users

Both exclusive and non-exclusive licenses of a registered trademark may be granted by the owner to one or more licensees. In order for the licensee's use of the trademark to benefit the owner, the owner must have direct or indirect control over the activities of the licensee in association with the trademark. If the owner of the trademark has direct or indirect control over the character or quality of the goods or services for which the trademark is used by the licensee, the use of the trademark (or of a trade name including the trademark) by the licensee is deemed to have (and to always have had) the same effect as use by the owner. If public notice is given as follows:

- (a) that use of a trademark is licensed use; and
- (b) of the identity of the owner of the trademark;

it will be presumed (subject to proof to the contrary) that the use is licensed and that the goods or services concerned are produced or rendered under the control of the owner of the trademark. As a consequence, proper trademark notations on products, packaging, labelling and in advertisements will be important.

At present, there is no registered user regime in Canada.

[5] Pledge and Seizure

Registered trademarks, trademark applications and common law trademarks are treated as an object of intangible property in the context of pledge, seizure and as surety. Ownership of registered trademarks, trademark applications and common law trademarks cannot be held concurrently by more than one owner. A security interest in a registered trademark or a trademark application can be registered with the CIPO; however, doing so merely serves as notice. Registering a document respecting a security interest with the CIPO is not a substitute for perfection of a security interest and does not create a preference over any other security interests.

[F] Filing Requirements*[1] Request for registration*

The application, which may be executed by the applicant or agent or filed electronically, shall contain the information and material indicated below.

- (1) The full legal name and postal address of the applicant.
- (2) A list of the goods or services in ordinary commercial terms in association with which the mark is used or is proposed to be used in Canada.
- (3) If the mark is other than a word or words not depicted in any special form, a representation of the mark.
- (4) If claiming priority, (i) the name of a country (abroad) where the mark has been used in association with the goods or services listed; together with (ii) particulars of a registration of or application for the registration of the mark in the country (abroad) in respect of the goods or services listed.
- (5) The application fee must be paid before a filing date can be obtained.

Requirements for complete application:

- (1) In every case, the following are the requirements:

- (a) The full legal name and postal address of the applicant; if a partnership, the full names of all partners and also the trading name; if an individual trading under a name other than their own, this trading name also.
 - (b) If the mark is other than a word or words not used in any special form or consists of a three-dimensional shape, hologram, moving image, mode of packaging goods, a sound, scent, taste, texture, colour per se, or the positioning of a sign: a visual representation or sound recording. Any two-dimensional visual representation provided in an application must not exceed 8 cm x 8 cm. The visual representation must be in colour where colour is claimed as a feature of the mark; otherwise, the visual representation must be in black and white. If the trademark consists in whole or in part of a three-dimensional shape, any visual representation provided by the applicant must be two-dimensional. Physical specimens of the mark will not be accepted. If the mark consists in whole or in part of a sound, the representation must include a recording in the form of an MP3 file, the size of which may not be larger than 10MB. Applications filed by paper may include electronic files of sounds on a CD, DVD, or USB stick.
 - (c) A description of the trademark and statement of trademark type, namely, that the trademark consists of standard characters, a three-dimensional shape, hologram, moving image, mode of packaging goods, a sound, scent, taste, texture, colour per se or the positioning of a sign. If colour is claimed as a feature of the trademark, a statement to that effect.
 - (d) Goods and services defined in ordinary commercial terms and grouped according to the Nice Classification.
 - (e) Details of any foreign application relied on for purposes of priority, including country and application date.
 - (f) The following information is also required:
 - an English or French translation of any words in any other language contained in the mark; and/or
 - if the mark contains matter expressed in characters other than Latin characters or in numerals other than Arabic or Roman numerals, a transliteration of the matter concerned in Latin characters and Arabic numerals.
- (2) Additional information in the case of a certification mark is as follows:
- (a) A statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of goods or the performance of services such as those in association with which the certification mark is used.
 - (b) A statement of the standards intended to be indicated by the use of the certification mark.
- (3) Additional requirements in the case priority is to be claimed are as follows:
- (a) Priority may be claimed from an earlier application filed in or for a Paris Convention member country or WTO member country by a party being a citizen or national of or domiciled in or having a real and effective industrial or commercial establishment in such country. The priority term is six months. A claim to priority may be made in one of two ways:
 - it may be included in the application filed in Canada, provided that such application is filed within the six-month priority period; or
 - by amending an already filed Canadian application to include the priority claim, provided that such amendment is made within the six-month priority period.
 - (b) The country of filing and date of filing of the priority application must be provided. Providing the priority application number, while not strictly required, is recommended. Further evidence necessary to establish the applicant's right to priority may be requested by the CIPO.
 - (c) A certified copy of the foreign application on which priority is claimed, together with an English or a French translation, if it is in another language, need not be filed unless called for by the Registrar.

[2] Classification

Classification of goods and services according to the Nice Classification is mandatory. Goods and services are described and listed in their ordinary commercial terms. CIPO publishes a Goods and Services Manual, which can be used as a guide.

Renewal of a registration that expires on or after 17 June 2019 requires that the goods and services are grouped according to the Nice Classification. The renewal fee will depend on the number of classes.

For existing registrations with goods and services that are not grouped according to the Nice Classification, the Registrar may, at any time, issue a notice to the registrant requiring that the goods and services are properly grouped and classed. The registration may be expunged for failure to comply within the prescribed period, as set out in the notice.

[3] Multi-class applications

Multi-class applications are available. Applicants pay a flat filing fee for the first class of goods or services covered by the application, with additional fees for each additional class of goods or services claimed in the application.

[4] Appointment of Representative

Applicants not residing in Canada are not required to appoint a representative for service (a trademark agent) in Canada, and may correspond directly with the CIPO. However, if appointed, the representative for service must reside within Canada.

[5] Power of Attorney

Not required.

[6] Priority

If the applicant wishes to claim a priority date based on an earlier filed application, the applicant must ensure that the application with the priority claim is filed within the six-month period after the filing of the applicant's home application in a Paris Convention or WTO member country. To claim priority, the priority application must be for a trademark that is the same or substantially similar to the applied for trademark in Canada. The priority application must also cover substantially the same goods and services. A certified copy of the priority application need only be filed upon request. The priority claim must include the date and country of filing of the earlier application. Where a priority claim does not include the number of the earlier application, the Office will require the applicant to either provide the Office with the number or submit a certified copy of the earlier application.

[7] Graphical representations

Any visual representation provided in an application must not exceed 8 cm x 8 cm. If colour is claimed as a feature of the mark, the colour of the mark or of its elements shall be described, and the visual representation of the trademark must be in colour. If colour is not claimed as a feature of the trademark, the representation of the trademark must be in black and white. A

visual representation may contain more than one view of the trademark only if the multiple views are necessary for the trademark to be clearly defined.

There are specific application requirements regarding visual representation(s) of non-traditional trademarks:

- For holograms, the visual representation must be in the form of one or more still images, sufficient in number and clarity, to demonstrate the holographic effect in its entirety.
- For moving images, an electronic representation of the trademark in the form of a moving image (animation) clip that demonstrates the full range of the moving image is required.
- For a trademark consisting of a single colour or combination of colours without delineated contours, a visual representation consisting of a square swatch in each colour is required.
- For a three-dimensional shape, the representation must be a two-dimensional graphic or photographic representation and should only include those portions of the shape that form part of the trademark, with any elements that do not form part of the trademark shown in dashed lines.
- Visual representations are also required for trademarks consisting of a mode of packaging goods or the position of a sign.

[G] Application Procedure

[1] Filing Authority

The Canadian Intellectual Property Office ('CIPO').

[2] Online filing

Online filing is permitted in respect of application filings, responses to Examiner's reports issued during examination, registrations of trademark applications and renewals of trademark registrations.

Where permitted, online filing is encouraged by the CIPO. Additional fees apply for applications and renewals that are not filed online.

[3] Search

The CIPO examines each application with regard to whether it conflicts with other existing registered or previously applied for trademarks in good standing, or with official marks under section 9 of the Trademarks Act.

[4] Examination

The CIPO examines each application with regard to its form, registrability per se and whether it conflicts with other existing registered or previously applied for trademarks in good standing, or with official marks under section 9 of the Trademarks Act.

An applicant may make a request for expedited examination, provided that one of the following criteria is met: a) a court action is expected or underway in Canada with respect to the applicant's trademark in association with the goods or services listed in the application; b) the applicant is in the process of combatting counterfeit products at the Canadian border with respect to the applicant's trademark in association with the goods or services listed in the application; c) the applicant requires registration of their trademark in order to protect their intellectual property rights from being severely disadvantaged on online marketplaces; or d)

the applicant requires registration of their trademark in order to preserve their claim to priority within a defined deadline and following a request by a foreign intellectual property office. In addition, applications filed with statements of goods or services entirely comprised of goods or services selected from a pre-approved list will generally be examined faster than their counterparts.

The Examiners will determine who is entitled to a registered trademark in Canada on a first-to-file basis. An Examiner will not consider the date of first use or making known in Canada when determining whether an applicant is entitled to the registration of a trademark that is confusing with another trademark that is the subject of a co-pending application. Thus, at the examination stage, the application with the earlier filing date will be approved and the other co-pending application will be refused.

An applicant is not entitled to registration if, at the earlier of the filing date of the application or the date of first use of the trademark in Canada, the trademark was confusing with: (i) a trademark that had been previously used or made known in Canada by another person, (ii) a trademark in respect of which an application for registration had been previously filed in Canada by another person, or (iii) a trade name that had been previously used in Canada by another person. The determination of whether a person is entitled to register a trademark that is confusing with another trademark based on an earlier date of first use or making known is exclusively determined in opposition proceedings.

The Registrar generally will not require an applicant for the registration of a trademark to disclaim the right to the exclusive use apart from the trademark of such portion of the trademark which is not independently registrable. Voluntary disclaimers will be accepted.

The time limit for replying to office actions is six months, unless otherwise stated. Extensions of time will not be granted in the absence of exceptional circumstances. A practice notice issued by CIPO provides examples of what could amount to an exceptional circumstance justifying a further extension of time: a) a recent change in trademark agent; b) circumstances beyond the control of the applicant; c) a recent assignment of the trademark; d) the cited pending application is the subject of an opposition proceeding or expungement proceeding; e) the applicant is negotiating for consent from the holder of an official mark; f) the applicant has filed a request for division, in respect of Canada, of the international registration and is waiting on the International Bureau for notification that a divisional international registration has been created; g) the applicant requires more time to consider the objections and file a proper response (may only be used where an application has received a substantive objection); and h) the applicant is compiling evidence to show that the trademark was distinctive at the filing date of the application.

An application may not, in any circumstances, be amended as follows:

- to change the identity of the applicant, except after recognition of a transfer by the Registrar;
- to change the trademark, except in respects that do not alter its distinctive character or affect its identity;
- to extend the statement of goods or services in the application as filed, for example, by substituting broader terms to describe the goods or services or by adding goods or services not originally listed; or
- to indicate that it is a divisional application.

After advertisement of the application in the Trademarks Journal, the application may not be amended as follows:

- to change the trademark in any manner whatsoever;
- to change the application from one that claims priority to one that does not; or
- to extend the statement of goods or services as contained in the application at the time of advertisement.

[5] Registration

If there is no opposition or the opposition is rejected or withdrawn, the application is allowed. For applications filed prior to 17 June 2019, the registration fee becomes due on the date indicated on the notice of allowance. After the fee has been paid, the trademark will be registered and a certificate of registration will be issued. A registration fee is not required for applications filed on or after 17 June 2019.

[6] Opposition / Observations

For the purpose of opposition proceedings, the following dates can be relied upon to determine rights to a trademark:

- (a) a person who has used a trademark in Canada may rely upon the date when it was first used;
- (b) a person who has used a trademark in a Paris Convention or WTO member country and has made it known in Canada is entitled to rely upon the date when it first became known in Canada;
- (c) a person who has used a trademark abroad and has registered it in or for the person's Paris Convention or WTO member country of origin, but has neither used it nor made it known in Canada, may rely upon the date of filing of the person's application for registration in Canada (or the priority date if applicable); and
- (d) a person who has filed an application in Canada for registration of a proposed trademark may rely upon the date of filing of that application (or the priority date if applicable).

Within two months of advertisement, any person may oppose the grant of registration on the ground that the application does not comply with the Act, or that the trademark is not registrable or is not distinctive, or that the applicant is not the person entitled to registration. The opponent delivers, along with a fee, the statement of opposition to the Trademarks Opposition Board, which vets it to ensure that it contains substantial issues for decision. If it does, a copy of the statement of opposition will be sent to the applicant, who must, if the opposition is not withdrawn or deemed to be withdrawn, file a counter-statement within two months and serve a copy on the opposing party, failing which the application will be considered abandoned. Evidence may be filed by the parties (in the form of an affidavit, statutory declaration or certified copies from the Register). Cross-examination on any affidavit or declaration may be requested. After completion of the evidence the parties may file written arguments. An oral hearing may be requested. Extensions of time are available for each stage of the proceeding, though sometimes only with the other party's consent. Cooling off periods are available for each party.

[7] Appeal

Final decisions of the Registrar may be appealed to the Federal Court within two months, subject to extension by the Court, and a further appeal may be made to the Federal Court of Appeal and possibly the Supreme Court of Canada (with leave).

[8] Alteration after Registration

A registration may be amended to extend the statement of goods or services (an application for such extension has the effect of an application for registration of the trademark in respect of the goods or services specified in the amendment application), to correct the name or address of a representative for service, to amend the particulars of the defined standard that the use of

a certification mark is intended to indicate, to enter a disclaimer that does not extend the rights given by the existing registration of the trademark, or to merge divisional applications that stem from the same original application.

[9] Publication / Public File Inspection

If the application appears to be acceptable, the Registrar will advertise the particulars of the application in the Trademarks Journal (issued weekly). Published are the particulars of applications advertised for opposition, registrations granted, amendments made, etc.

Published trademarks can also be viewed at the online register of CIPO.

Furthermore, Canadian trademark data are available via TMview.

[H] Nullity and Revocation

A trademark registration can be cancelled, or expunged, in two ways.

First, the CIPO may cancel a registration via a summary cancellation proceeding for non-use.

Second, the Federal Court of Canada may expunge a trademark registration upon application by an interested party if any of the following conditions are met: (a) the trademark was not registrable as of the date of registration, (b) the trademark is not distinctive as of the date of commencement of proceedings, (c) the trademark has been abandoned or (d) the applicant for registration was not the person entitled to registration of the trademark. An applicant is not the person entitled to registration of the trademark if some other person has previously used or made known a confusing trademark or trade name, or has previously applied for registration of a confusing trademark. To be an interested party, the party bringing the application to the Federal Court must be a person whose rights may be restricted by the registration or a person who is affected or reasonably expects to be affected by the registration. The burden lies on the person commencing the proceeding to establish that the Register should be modified. After five years from the date of registration, a registration is incontestable on the ground of previous use or making known, unless the adoption of the trademark occurred with knowledge of such previous use or making known.

[I] Use Requirement

[1] Before registration

Not applicable in this jurisdiction.

[2] After registration

The Registrar may, at any time, send a notice to the registered owner of the trademark requiring them to furnish within three months an affidavit or a statutory declaration showing, with respect to each of the goods or services listed in the registration, whether the trademark was in use in Canada at any time during the three-year period immediately preceding the date of the notice, and, if not, the date when it was last in use and the reason for the absence of such use since that date. The Registrar must also send such a notice at the request of any third party, unless the Registrar sees good reason to the contrary (a fee applies). Such a request may only be made three or more years after the date of registration of the trademark in question. Cross-examination on the evidence submitted by the registered owner is not available. However, each party (the registered owner and the requester, if applicable) may submit written

representations in respect of the evidence submitted, and may request an oral hearing. If, from the evidence furnished (or from the absence of such evidence), it appears to the Registrar that for any of the goods or services the trademark was not used in Canada at any time during the three-year period immediately preceding the date of said notice, and the non-use is not due to special justifying circumstances, the registration may be totally or partially cancelled.

[J] Marking

Marking registered trademarks with ‘Registered Trademark’ or ‘®’ is optional, but recommended; for the Province of Quebec marking registered trademarks with (or also with) ‘Marque Déposée’ is optional, but recommended. Marking with the symbol TM, or MC (meaning ‘marque de commerce’), is possible irrespective of whether the trademark is registered; the symbol ‘®’ should be used only if the trademark is registered.

Marked products have no implications for awarding compensation in case of past infringement. However, misuse of a trademark symbol (e.g. where an entity uses the TM symbol in association with a trademark while knowing that another entity in fact owns the trademark) has been penalized.

[K] Infringement

[1] Infringing acts / Non-infringing acts

The following acts with regard to a registered trademark done without the consent of the owner are deemed infringement: selling, distributing or advertising goods or services in association with a trademark or trade name confusing with the registered trademark.

Trademarks are deemed to be confusing if the use of both marks in the same area would likely lead to the inference that the goods or services associated with the respective marks were manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class. Given that trademark protection granted to registered trademarks is national in scope, geographical separation of trademark use does not play a role in the hypothetical test. All surrounding circumstances will be considered when determining whether a trademark is confusing, including the inherent distinctiveness of the respective marks and the extent they have become known; the length of time they have been in use; the nature of the goods, services or business; the nature of the trademark; and the degree of resemblance between the marks in appearance or sound or the ideas suggested by them.

In addition, no person is entitled to use a trademark registered by another person in a manner likely to depreciate the goodwill attaching thereto. A trademark owner seeking to establish a claim for depreciation of goodwill must show the following: (a) that there has been use of their trademark, as defined by the Trade-marks Act (though not necessarily use ‘as a trademark’), (b) that the trademark owner has sufficient goodwill in the trademark at issue, which goodwill may be depreciated, and (c) that there is a connection between the respective parties’ goods and services or trade. This connection is a lower standard than required for confusion. For example, use of a trademark in association with luggage has been found to depreciate the goodwill in the same mark registered for automobiles.

Registration of a trademark does not prevent a person from making the following:

- (1) any bona fide use of their name as a trade name; or
- (2) any bona fide use, other than as a trademark, as follows: (i) of the geographical name of their place of business, or (ii) of any accurate description of the character or quality of their goods or services;

provided in all cases that this is done in a manner not depreciating the value of the goodwill attaching to the trademark.

[2] Remedies

Remedies available in case of infringement include injunction, award of damages and accounting of profits; the Court may give directions with respect to the disposition of any infringing goods, packages, labels and advertising material. A licensee may ask the owner of the trademark to take infringement proceedings, and if the owner refuses or neglects to take such action within two months, the licensee may take infringement action in their own name, unless otherwise agreed; the owner in such case will be a defendant.

[3] Penal provisions

Not applicable in this jurisdiction.

[4] Enforcement and Customs

Trademark owners who own registered trademarks in Canada may record their rights with the Canada Border Services Agency (CBSA), which will then detain any commercial shipments suspected of containing counterfeit goods bearing the rights holders' trademarks. CBSA officers may share information relating to the detained goods and a sample of the goods with rights owners. Customs officers may detain goods that they suspect to infringe trademark rights for up to 10 days, or, in the case of perishable goods, for up to 5 days, and the rights holder may request that non-perishable goods be held for an additional 10 days. Unless rights owners commence proceedings in court, the goods will be released.

Once recorded, a Request for Assistance (RFA) is valid for two years and may be extended in two-year increments thereafter upon request of the rights holder.

While there is currently no fee for recording rights with the CBSA, the Minister of Public Safety and Emergency Preparedness does have the discretion to require that the RFA applicant furnishes security by way of a bond to cover any costs associated with storage, handling and, if applicable, the destruction of the detained goods.

The trademark owner is liable for the costs to store, handle, and destroy any goods held under these provisions from the day after the day on which a CBSA officer first sends or makes available a sample or information to that owner until the first day either (1) the goods are no longer detained; or (2) the Minister receives notification from the trademark owner either (a) that the goods do not contravene the Act or (b) that the owner will not commence proceedings.

[L] Well-known and Reputed Marks

The fame of a trademark will be considered as one of several factors when assessing whether an allegedly infringing trademark can be confused with the famous mark. The fame of the trademark by itself is not determinative, no matter how famous it may be.

[M] Trademarks and Trade Names

Trade names, defined as 'the name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual', are not registrable under the

Trademarks Act, but can be relied upon to oppose an application or cause the cancellation of a subsequently adopted or applied for trademark that can be confused with the trade name.

[N] Trademarks and Domain Names

Pursuant to Canada's Domain Name Dispute Resolution Policy, one may not register a domain name as follows: (a) that is confusing with a registered trademark in which a complainant had, and continues to have, rights prior to the date of registration of the domain name, (b) in which the domain name registrant has no legitimate interest, and (c) if registrant has registered the domain name in bad faith.

In order to own a '.ca' domain name, the registrant (or successful complainant) must meet the Canadian Presence Requirements.

[O] Trademarks and Appellations of Origin / Trademarks and Geographical Indications

From 21 September 2017, with the coming into force of CETA, Canada implemented changes to trademarks legislation related to the protection of geographical indications.

A geographical indication is an indication that identifies a wine, spirit, agricultural product or food of a category set out in a list maintained by the Registrar of trademarks, as originating in the territory of a WTO member, or a region or a locality of that territory, if the quality, reputation or other characteristic of the wine, spirit, agricultural product or food is essentially attributable to its geographical origin. Applications for entry in the list are reviewed by the trademarks branch of the Canadian Intellectual Property Office.

A trademark may not be registered if it is, in whole or in part, a protected geographical indication, where the trademark is to be registered in association with a wine, spirit, agricultural product or food not originating in a territory indicated by the geographical indication.

It is not allowed, in connection with a business, to adopt or use, as a trademark or otherwise, a protected geographical indication identifying a wine, spirit, agricultural product or food in respect of a wine, spirit, agricultural product or food not originating in the territory indicated by that indication, or to so adopt or use a translation in any language of the geographical indication in respect of that wine, spirit, agricultural product or food. The foregoing does not prevent a person from using, in the course of trade, their name or the name of a predecessor in title (unless the name is used in such manner as to mislead the public), nor from using a protected geographical indication in comparative advertising in respect of a wine, spirit, agricultural product or food (but this does not apply to comparative advertising on labels or packaging associated with a wine, spirit, agricultural product or food). Action against unlawful adoption or use by a person of an indication as referred to becomes statute-barred five years after the use by that person, or their predecessor in title, has become generally known in Canada or after the trademark has been registered by that person in Canada, unless it is shown that the person, or their predecessor in title, first used or adopted the trademark while knowing that it was unlawful.

Canadian citizens, permanent residents of Canada and entities carrying on a business in Canada, which have used a protected geographical indication in a continuous manner in relation to any business or commercial activity in respect of goods or services as follows: (i) in good faith prior to 15 April 1994 or (ii) for at least ten years before 15 April 1994, may continue such use. Adoption, use or registration as a trademark, in connection with a business, of an indication which is identical with a term customary in common language in Canada, as a common name for a wine, spirit, agricultural product or food respectively, or which is identical with a customary name of a grape variety existing in Canada on or before 1 January 1996 or with a customary name of a plant variety or an animal breed existing in Canada on or before the day on which the indication is entered on the list of geographical indications, is allowed.

Certain common names for spirits, agricultural products and food are mentioned in the law, whose adoption, use or registration as a trademark or otherwise, in connection with a business, is allowed; no registration of a trademark prevents a person from making any use of these common names in association with a spirit, agricultural product or food respectively. For spirits these common names are: Marc, Sambuca, Geneva Gin, Genièvre, Hollands Gin, London Gin, Schnapps, Malt Whiskey, Eau-de-vie, Bitters, Anisette, Curacao and Curaçao. For agricultural products or food these common names are: Valencia Orange, Orange Valencia, Valencia, Black Forest Ham, Jambon Forêt Noire, Tiroler Bacon, Bacon Tiroler, Parmesan, St. George Cheese, Fromage St-George and Fromage St-Georges. Other names may be added or names from this enumeration may be deleted by order of the Governor in Council.

[P] Restoration after unintentional lapse

The prescribed period to pay the renewal fee ends on the later of two dates (i.e. whichever gives more time to the trademark owner to renew): six months after the day on which the registration expires or two months after the date of a notice to renew the trademark is sent by the Registrar. There is no possibility of restoration afterwards.

If applicant fails to meet a deadline during examination, such as a deadline to reply to an office action, CIPO may issue a Notice of Default. Restoration is possible prior to the deadline set out in the Notice of Default. The deadline is generally two months from the date of the Notice of Default.

[Q] Specific Aspects of Regional Trademark Registration

Not applicable in this jurisdiction.

[R] Specific Aspects of International Trademark Registration

Canada is member of the Madrid Protocol.

Applicants may request trademark protection in Canada by filing an application for international registration. Upon receipt of the designation notification, CIPO will send a notice to the applicant or their foreign representative requesting that they appoint a Canadian agent to handle the application. In the absence of a Canadian agent, all future correspondence from CIPO will be sent directly to the applicant and not to their foreign representative.

[S] Fees

Small entity fee reduction is not available.

[1] Table of official fees

	CAD
Application fee (paper) for the first class of goods or services to which the application relates	437.73
Application fee (online) for the first class of goods or services to which the application relates	335.93
Application fee for each additional class of goods or services to which the application relates	101.80
Opposition fee	763.47
Extension of time	125.00
Filing a certified copy of home registration	N/A

Renewal fee (paper) for the first class of goods or services to which the request for renewal relates	508.98
Renewal fee (online) for the first class of goods or services to which the request for renewal relates	407.18
Renewal fee for each additional class of goods or services to which the request for renewal relates	127.25
Assignment fee, for each trademark	100.00
On application to amend registration of a trademark by extending statement of goods or services, for the first class of goods or services	437.72
On application to amend registration of a trademark by extending statement of goods or services, for each additional class of goods or services	101.80
On request to send section 45 cancellation notice requiring furnishing of affidavit or statutory declaration of use	407.18
A certified copy in paper form of a document:	
(a) basic fee for each certification	35.00
(b) additional fee for each page	1.00
A certified copy in electronic form of a document:	
(a) basic fee for each certification	35.00
(b) additional fee for each trademark to which the request relates	10.00
A copy in paper form of a document, per page:	
(a) self-service copying	0.50
(b) where the Office makes a copy	1.00
A copy in electronic form of a document:	
(a) each request	10.00
(b) plus, for each trademark to which the request relates	10.00
(c) plus, if the copy is requested on a physical medium, for each physical medium requested in addition to the first	10.00

[T] Transitional Provisions

Not applicable in this jurisdiction.

[U] Specific Trademark Issues

- (a) Registration of a trademark is strongly recommended; registration is prima facie evidence of ownership. Where a quality mark is applied to a precious metal article, a registered or applied for trademark must also be applied to the precious metal article. A registered trademark is highly recommended in connection with franchising a business.
- (b) If a company and the owner of a trademark used by the owner in Canada for a pharmaceutical preparation are related companies, the use by the company of the trademark of a confusingly similar trademark for a pharmaceutical preparation which at the time of that use or at any time thereafter (i) is acquired by a person directly or indirectly from the company, and (ii) is sold, distributed or advertised for sale in Canada in a package bearing the name of the company and the name of that person as the distributor of the same, has the same effect, for all purposes of the Trademarks Act, as a use of the trademark or confusingly similar trademark by the said owner. The foregoing does not apply to any use of a trademark

or confusingly similar trademark by a company as mentioned for a pharmaceutical preparation after the date that that preparation by notice of the Minister of Health in the Canada Gazette is declared to be sufficiently different in its composition from the pharmaceutical preparation for which the trademark is used in Canada by the owner as to be likely to result in a hazard to health.

- (c) The Registrar may at any time, and shall at the request of any person who pays the prescribed fee, require any registered owner of any trademark registered under the Unfair Competition Act or earlier Acts, to furnish information that would have been required on an application under the Trademarks Act, and the Registrar may amend the registration in accordance with the information supplied or, if the information is not furnished, expunge the registration.
- (d) Special provisions on the use of the French language in Quebec are set out in The Charter of French Language. In the Province of Quebec several provisions on the obligatory use of the French language are effective which can have an impact on trademarks. A basic rule is that every inscription on a product, its container or wrapping, or on a leaflet, brochure or card supplied with such product, including the directions for use and the warranty certificates, shall be drafted in French; such inscriptions may be accompanied by translations, but given no more prominence than the French inscriptions.

While registered trademarks need not be translated into French, if there is a registered French equivalent of the trademark, the French equivalent must be used. Also, virtually all other inscriptions appearing on goods in Quebec must be translated into French, or must also appear in French.

The following exceptions to the basic rule exist:

- (1) Inscriptions on a product destined for a market outside Quebec, its container or wrapping, or on a leaflet, brochure or card supplied with it, may be drafted in another language.
- (2) Inscriptions on a case of at least 8 cubic metres used for the transport of merchandise may be drafted in another language if the case was made outside Quebec and contains products from outside Quebec.
- (3) Also such inscriptions may be drafted in another language in the following situations:
 - if the product in question has not yet been commercialized in Quebec, and is exhibited at conventions, exhibitions or fairs;
 - if the product in question is to be incorporated in a finished article or is to be used in a manufacturing, processing or repair operation and is not offered in the retail trade;
 - if the use of the said product is of very little spread and a substitute presented in French is not available in the Quebec market;
 - if the inscriptions are engraved, baked or inlaid on the product itself.
- (4) Inscriptions appearing on publications, records or tape recordings and on their wrappings may be drafted in the language of such publications, records or tape recordings, without having to be translated into French.
- (5) Inscriptions on the container of a product introduced in Quebec for medical, pharmaceutical or scientific purposes may be drafted in another language, provided that: the capacity of the container is less than 5 cubic centimetres or the contents are less than 100 grams in weight, and the instructions given in another language on the container appear in French on the wrapping or on a leaflet, brochure or card supplied with it.

Exempted from the provisions on the obligatory use of the French language are marks registered under the Trademarks Act before the coming into force of these provisions; that would mean that these provisions are valid in respect of trademarks the applications for which were pending as of or filed after 25 August 1977 and in respect of unregistered trademarks irrespective of the time they have been in use already.

Furthermore, the following are expressly exempted:

- (a) firm names and addresses of business firms situated outside the Province of Quebec;
- (b) words and expressions of origin designating a type of product or a foreign specialty for which there are no equivalents in French; and
- (c) proper names.

[V] Governmental Websites

- <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home> (Canadian Intellectual Property Office)
- <http://www.cipo.gc.ca/app/opic-cipo/trdmrks/srch/home> (Register)

PART 3 UTILITY MODELS

§3.01 SUMMARY

[A] Duration of Registration

- No utility model laws applicable in this jurisdiction.

[B] Registrable / Not Registrable

- No utility model laws applicable in this jurisdiction.

[C] Novelty

- No utility model laws applicable in this jurisdiction.

[D] Filing Requirements and Application Procedure

- No utility model laws applicable in this jurisdiction.

[E] Governmental Websites

- No utility model laws applicable in this jurisdiction.

§3.02 DETAILED INFORMATION**[A] Conventions and Legislation***[1] Conventions*

No utility model laws applicable in this jurisdiction.

[2] Laws

No utility model laws applicable in this jurisdiction.

[B] Duration of Registration

No utility model laws applicable in this jurisdiction.

[C] Requirements for Renewal

No utility model laws applicable in this jurisdiction.

[D] Registrable / Not Registrable

No utility model laws applicable in this jurisdiction.

[E] Novelty

No utility model laws applicable in this jurisdiction.

[1] Grace period

No utility model laws applicable in this jurisdiction.

[F] Ownership and related rights*[1] Applicant*

No utility model laws applicable in this jurisdiction.

[2] Assignment

No utility model laws applicable in this jurisdiction.

[3] Licenses

No utility model laws applicable in this jurisdiction.

[4] Pledge and Seizure

No utility model laws applicable in this jurisdiction.

[G] Filing Requirements*[1] Obligation to file first with national office*

No utility model laws applicable in this jurisdiction.

[2] Minimum requirements for obtaining filing date

No utility model laws applicable in this jurisdiction.

[3] Request for registration

No utility model laws applicable in this jurisdiction.

[4] Appointment of Representative

No utility model laws applicable in this jurisdiction.

[5] Power of Attorney / Designation of creator / Other documents

No utility model laws applicable in this jurisdiction.

[6] Priority

No utility model laws applicable in this jurisdiction.

[7] Allowable language(s) upon filing / Language(s) of procedure

No utility model laws applicable in this jurisdiction.

[8] Description

No utility model laws applicable in this jurisdiction.

[9] Claims

No utility model laws applicable in this jurisdiction.

[10] Abstract

No utility model laws applicable in this jurisdiction.

[11] Drawings

No utility model laws applicable in this jurisdiction.

[12] Payment of fees

No utility model laws applicable in this jurisdiction.

[H] Application Procedure*[1] Filing Authority*

No utility model laws applicable in this jurisdiction.

[2] Online filing

No utility model laws applicable in this jurisdiction.

[3] Examination

No utility model laws applicable in this jurisdiction.

[4] Amendments and corrections

No utility model laws applicable in this jurisdiction.

[5] Registration

No utility model laws applicable in this jurisdiction.

[6] Accelerated registration

No utility model laws applicable in this jurisdiction.

[7] Opposition / Re-examination

No utility model laws applicable in this jurisdiction.

[8] Appeal

No utility model laws applicable in this jurisdiction.

[9] Unity of creation

No utility model laws applicable in this jurisdiction.

[10] Divisional applications

No utility model laws applicable in this jurisdiction.

[11] Branched-off applications

No utility model laws applicable in this jurisdiction.

[12] Conversion

No utility model laws applicable in this jurisdiction.

[13] Publication / Public File Inspection

No utility model laws applicable in this jurisdiction.

[14] Withdrawal to prevent publication

No utility model laws applicable in this jurisdiction.

[I] Nullity and Revocation

No utility model laws applicable in this jurisdiction.

[J] Use Requirement

No utility model laws applicable in this jurisdiction.

[K] Marking

No utility model laws applicable in this jurisdiction.

[L] Infringement*[1] Infringing acts / Non-infringing acts*

No utility model laws applicable in this jurisdiction.

[2] Prior user rights

No utility model laws applicable in this jurisdiction.

[3] Remedies

No utility model laws applicable in this jurisdiction.

[4] Penal provisions

No utility model laws applicable in this jurisdiction.

[5] Enforcement and Customs

No utility model laws applicable in this jurisdiction.

[M] Restoration after unintentional lapse

No utility model laws applicable in this jurisdiction.

[N] Utility Model Application Based on International Patent Application (PCT)

No utility model laws applicable in this jurisdiction.

[O] Fees*[1] Table of official fees*

No utility model laws applicable in this jurisdiction.

[P] Transitional Provisions

No utility model laws applicable in this jurisdiction.

[Q] Specific Utility Model Issues

No utility model laws applicable in this jurisdiction.

[R] Governmental Websites

No utility model laws applicable in this jurisdiction.

PART 4 INDUSTRIAL DESIGNS AND MODELS**§4.01 SUMMARY****[A] Duration of Registration**

- 10 years from the date of registration or 15 years from the date of filing, whichever is longer, subject to payment of a maintenance fee before expiration of the initial 5-year period.
- 10 years from the date of registration for applications filed prior to 5 November 2018.

[B] Registrable / Not Registrable

- A protectable design consists of features of colour, shape, configuration, pattern or ornament, and any combination of those features, in a finished article.

[C] Novelty

- Absolute novelty is required.
- A grace period of 1 year preceding the filing/priority date applies.

[D] Application Procedure

- A design is registered after examination as to form, unity and whether the design is identical or confusingly similar to some other design already registered.

[E] Governmental Websites

- <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home> (Canadian Intellectual Property Office)
- <http://www.cipo.ic.gc.ca/app/opic-cipo/id/bscSrch.do?lang=eng> (Register)

§4.02 DETAILED INFORMATION

[A] Conventions and Legislation

[1] Conventions

- Paris Convention (International Union) 1883–1967 (Canada is bound by the substantive articles (Articles 1 to 12) of the Stockholm text of 1967 as from 26 May 1996);
- Convention Establishing the World Intellectual Property Organization (WIPO Convention) 1967;
- World Trade Organization (with effect from 1 January 1995);
- North American Free Trade Agreement (NAFTA) (with effect from 1 January 1994);
- Canada-Korea Free Trade Agreement (with effect from 1 January 2015);
- Canada – European Union: Comprehensive Economic and Trade Agreement (CETA) (with effect from 21 September 2017);
- Hague Agreement Concerning the International Registration of Industrial Designs (with effect from 5 November 2018).

[2] Laws

- Industrial Design Act (R.S.C., 1985, c. I-9) (as amended up to 2018); and
- Industrial Design Regulations (SOR / 2018-120) (as amended up to 2018).

[B] Duration of Registration

Ten years from the date of registration or fifteen years from the date of filing, whichever is longer, subject to payment of a maintenance fee before expiration of the initial five-year period.

For applications filed before 5 November 2018, ten years from the date of registration, subject to payment of a maintenance fee before expiration of the initial five-year period.

[C] Requirements for Renewal

Before expiration of the period of five years from registration the required maintenance fee must be paid to keep the registration in force (maintenance may be requested at any time during the initial five-year period on payment of the maintenance fee). If the maintenance fee is not so paid, the registration may be kept in force on application made to the Commissioner within six months of expiration of the initial five-year period with payment of the maintenance fee and the required fixed supplementary fee, failing which the registration will lapse. See further ‘Restoration after unintentional lapse’.

[D] Registrable / Not Registrable

A protectable design consists of features of colour, shape, configuration, pattern or ornament, and any combination of those features, which in a finished article appeal to and are judged solely by the eye. Features applied to a useful article dictated solely by a utilitarian function thereof, and methods or principles of manufacture or construction cannot be protected as a design. A design is registrable if the design is not contrary to public morality or order.

Note that even if copyright subsists in a design applied to a useful article or in an artistic work from which the design is derived, if the article is reproduced in a quantity of more than fifty (by the copyright holder or with the copyright holder's authorization), it is not an

infringement of such copyright to reproduce the design. Hence in such cases copyright protection does not apply; such designs may be protected by an industrial design registration to be protected at all.

A design may relate to the appearance of the entirety of an article or a portion thereof.

Computer-generated animated industrial designs are registrable. Applications for computer-generated animated designs are considered to be a single design applied to a finished article. Drawings for such a design will be viewed as a sequence of frames.

[E] Novelty

The design application must be filed, or have a priority date, earlier than any third party disclosure of the design to the public anywhere in the world, or earlier than any third party Canadian design application disclosing the design, but which is published after the filing/priority date.

[1] Grace period

A grace period of one year preceding the filing/priority date applies for publication (made public or offered for commercial use) in Canada or elsewhere. A design application must be filed in Canada, or have a priority date, within one year of the first publication of the same design or a design not differing substantially from it, applied to the same or an analogous article, anywhere in the world by the applicant, a predecessor, or a person who obtained knowledge of the design from the applicant or a predecessor.

[F] Ownership and related rights

[1] Applicant

The applicant must be the ‘Proprietor’ of the design. The Proprietor is the author or the person for whom the author created the design for good and valuable consideration, or a subsequent proprietor (e.g., an assignee). If more than one person creates the design, then they may apply as joint proprietors.

[2] Assignment

An assignment of an application or registered design can be recorded upon written request to the Industrial Design Office. A copy of an assignment document or other form of evidence is not required if the request is made by the applicant or the registered proprietor. However, evidence of transfer (not legalized) will be required if the request is made by the assignee.

An assignment that is not registered with the Industrial Design Office is void against a subsequent assignee if the assignment to the subsequent assignee has been registered.

[3] Licenses

An application for the registration of a design or a registered design may be licensed. Any person can provide the Industrial Design Office with copies of a licence, and these documents will be kept on file and made available to the public when the application/registration is made available to the public.

[4] Pledge and Seizure

Industrial designs and industrial design applications are treated as an other object of intangible property in the context of pledge, seizure and as surety. An industrial design can also be dedicated to the public. A security interest in an industrial design or an industrial design application can be registered with CIPO; however, doing so merely serves as notice. Registering a document respecting a security interest with CIPO is not a substitute for perfection of a security interest and does not create a preference over any other security interests.

[G] Filing Requirements*[1] Request for registration*

An application must contain the name and postal address of the applicant, the name of the finished article for which registration of the design is desired and a representation of the design. Furthermore, the examination fee must be paid. An application may contain a priority claim, indicating country, date and number of priority application; the name and address of the agent; a description of the design (not of the article to which the design is applied), describing the original visual features thereof; and a statement of limitation.

[2] Classification

The Canadian Classification Standard for Industrial Designs was updated in 2018 and is based on the Locarno Classification System with additional subclasses.

[3] Appointment of Representative

Applicants may appoint an agent to represent them in all business before the Industrial Design Office.

[4] Power of Attorney

Not required.

[5] Priority

Priority may be claimed from an earlier application filed by applicant or their predecessor in title in or for a Paris Convention member country or a WTO member country or a country granting reciprocity; priority term is six months from first-filed foreign application.

A priority document (copy of the Convention application whose priority is claimed) and a translation thereof in English or French (if not in either language) is to be filed only if requested by the Commissioner. A priority document may be made available to the Industrial Design Office through WIPO's Digital Access Service (DAS).

[6] Description

The application may include a statement describing the representation and/or features of the design. An application is deemed to relate to all of the features of colour, shape, configuration,

pattern and ornament shown in the representation, unless there is a statement limiting the design to one or more features. There is no requirement for an application to include either a descriptive statement or a statement of limitation.

[7] Graphical representations

The representation of a design must be in the form of a photograph, reproduction, or a combination of both, and must include at least one photograph or reproduction that shows the design in isolation or the finished article in isolation. The representation must be sufficient to fully disclose the design and must be of sufficient quality to permit the features of the design to be identified clearly and accurately. One or more environment views may be included to show the article in the context of its surroundings; however, the environment must be shown in stippled (or dashed) lines.

[8] Multiple deposits

An application for registration may relate in principle to one design only. However, an application relating to a set (i.e. a number of articles of the same general character, ordinarily on sale together or intended to be used together, to each of which the same design or variants thereof are applied), or an application relating to variants (i.e., designs not differing substantially from one another and applied to the same article or set) may be accepted. If it is found that the application relates to more than one design, applicant must limit the application to one design, but may file divisional applications for the other design(s) retaining the filing and priority date of the parent application. Divisional applications are subject to specific deadlines, and applicants can delay registration of a design to allow more time to file a divisional application.

[H] Application Procedure

[1] Filing Authority

Canadian Intellectual Property Office (CIPO).

[2] Online filing

Online filing is available.

[3] Search

The searches conducted are based on classification and related classes and includes publicly available published art.

[4] Examination

Applications are examined for both formal and substantive compliance with the Act and Regulations. Examiners can raise objections based on a number of grounds, including: lack of novelty; unregistrable subject matter; lack of unity (i.e. multiple designs that do not qualify

as variants or designs for sets); insufficient quality of the representation; inconsistencies in the views; and/or defects in the description.

Generally, the search for prior art is initiated at six months from the filing date of the application. However, in the interest of reducing examination time, the Office will conduct the prior art search as early as six months from the date of priority when an applicant voluntarily submits certified priority documents that support the priority claim.

If after examination the Examiner has reasonable grounds to believe that a design is not registrable, they will send the applicant a report indicating their objections to registration. The applicant must reply no later than three months after the date of the report, after which the application is deemed to be abandoned. An abandoned application can be reinstated, if within six months a reinstatement request is filed, including a response, in good faith, to the outstanding report, and the reinstatement fee.

Amendment of the application is possible at any time prior to registration, provided that the amendment does not modify the identity of the applicant, add a representation of a design, or result in a substantial change to the design as filed.

[5] Registration

If no objections are made, it is normally approximately twenty-one months for registration of a design to be completed.

[6] Opposition / Re-examination

Currently, there are no opposition proceedings to challenge the grant of a registration, but an order for the cancellation or alteration of a design registration may be requested with the Federal Court by any interested party (or the Attorney General).

[7] Appeal

Currently, an applicant that does not overcome all objections to registration may request review by the Patent Appeal Board. However, CIPO proposes changing the refusal and review process. Under the proposed process, the review is assigned to a subject matter expert from the policy and legislation group of the Trademarks and Industrial Designs Branch.

[8] Publication / Deferred Publication / Public File Inspection

An application will be made available to the public on the earlier of the date of registration or thirty months after the filing date or the earliest priority date.

Published designs are also available on the Canadian Industrial Designs Database. Furthermore, CIPO has integrated its registered design data into DesignView.

[I] Nullity and Revocation

The Federal Court may declare a design or any drawing therein invalid or void at the request of any interested person or the Attorney General.

[J] Use Requirement

Use of a registered design is not obligatory, and there is no provision for compulsory licenses.

[K] Marking

Marked products may have implications for awarding compensation in case of past infringement. The Industrial Design Act provides that no remedy other than an injunction is available for infringement if the defendant was not aware, and had no reasonable grounds to suspect, that the design was registered. It is therefore recommended that articles protected by an industrial design registration and/or labels or packaging associated with such articles be marked (with a capital 'D' inside a circle, followed by the name or the usual abbreviation of the name of the proprietor).

[L] Infringement*[1] Infringing acts / Non-infringing acts*

The following acts committed for commercial purposes with regard to a registered design without the consent of the owner are deemed infringement: making, importing for the purpose of trade or business, or selling, renting, or offering or exposing for sale or rent, any article in respect of which the design is registered and to which the design (or a design not differing substantially from it) has been applied. Any such acts committed in relation to a kit (i.e., a complete or substantially complete number of parts that can be assembled to construct a finished article) which would constitute an infringement if committed with regard to an article assembled from the kit, is also considered infringement.

If an interested person wishes to bring an action against an owner for a declaration that any process (proposed to be) used or any article (proposed to be) made, used or sold by such person does not infringe upon the other party's design(s), such action must be brought in an appropriate provincial court of competent jurisdiction.

[2] Prior user rights

There are no explicitly identified prior user rights in the Industrial Design Act or Rules.

[3] Remedies

Infringement actions are to be brought before the competent Court (Federal Court or a provincial Court). The invalidity of a design may be asserted as a defence in an infringement suit. Available remedies include the following: injunction, award of damages, accounting of profits, punitive damages, and disposal of infringing article or kit. Infringement action becomes statute-barred three years after the specific act of infringement.

[4] Penal provisions

There are no explicitly identified penal provisions in the Industrial Design Act or Rules.

[5] Enforcement and Customs

Goods imported into Canada are not screened to determine if they infringe a registered industrial design.

[M] Restoration after unintentional lapse

Restoration of an abandoned application after the six months time limit for requesting reinstatement, is not possible.

Restoration of a design lapsed due to non-payment of the maintenance fee on or before the expiry of the five-year registration period or within the six-month grace period, is not possible.

Restoration of a priority right is not possible.

[N] Specific Aspects of Regional Design Registration

Not applicable in this jurisdiction.

[O] Specific Aspects of International Design Registration

Since 5 November 2018 international applications filed under the Hague Agreement may designate Canada, and Canadian applicants may file a single application for international registration for protection in countries that are party to the Hague Agreement.

[P] Design and Copyright Protection

The Copyright Act and the Industrial Design Act and Regulations attempt to distinguish what is the proper subject matter as between copyright and industrial design protection. Where a design is capable of being registered as an industrial design, copyright protection is not intended to be available. Amendments were made to the Copyright Act on 8 June 1988 with the effect that copyright in the shape of a functional article, or any design applied to a functional article, would be unenforceable if the more than fifty articles were made anywhere in the world.

Registration of copyright in a design does not prevent or preclude registration as an industrial design; however, it is possible that registration as an industrial design could prevent or preclude a claim to copyright.

[Q] Fees

A small entity fee reduction is not available.

[1] Table of official fees

	CAD
Fee for examining an application to register a design	416.15
Additional fee for each page of the representation in excess of 10 pages	10.40
Fee for requesting accelerated examination of an application	520.18
Fee for recording an assignment, a license or other document affecting a design	100.00
Maintenance fee	364.12

Supplementary fee in 6 months' grace period	50.00
Reinstatement fee	208.07
Provision of a paper copy of a document, for each page	1.00
Provision of an electronic copy of a document	10.00
Certification of copies of documents	35.00
plus, for each page	1.00

[R] Transitional Provisions

The Economic Action Plan 2014 Act, c. 39, amended the Industrial Design Act. The amended provisions apply to applications filed on or after 5 November 2018 (the coming-into-force date). An application filed before this date will be dealt with and disposed of substantially in accordance with the Act as it read before the coming-into-force date, provided the application has a filing date. A matter arising in relation to a design registered before the coming-into-force date or based on an application filed before the coming-into-force date will be dealt with and disposed of substantially in accordance with the Act as it read before the coming-into-force date.

[S] Specific Industrial Design and Model Issues

Not applicable in this jurisdiction.

[T] Governmental Websites

- <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home> (Canadian Intellectual Property Office)
- <http://www.cipo.ic.gc.ca/app/opic-cipo/id/bscSrch.do?lang=eng> (Register)