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**By Email:** krista.pearce@ic.gc.ca

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Canadian Intellectual Property Office  
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Dear Ms. Pearce:

**Re: Proposed Amendments to the Patent Rules –  
Post Final Action Procedures**

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FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to comment on the proposed amendments to the Post Final Action Procedures which were released for public review on August 25, 2009.

As you may know, FICPI (the Federation Internationale des Conseils en Propriété Industrielle), comprises more than 3500 intellectual property attorneys in private practice in 86 countries. FICPI Canada is a self-governing national association of FICPI and represents the interests of Canadian patent and trade mark professionals. Our membership includes senior professionals at most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including multi-national corporations, small and medium size enterprises, and individuals.

In general, FICPI Canada understands CIPO's need to provide a mechanism for addressing issues which come to light during review of a patent application by the Patent Appeal Board (PAB), following issuance of a Final Action. However, FICPI Canada believes that any amendment of the *Patent Rules* to provide such a mechanism should not interfere in any way with "... the scheme of the Act and subsection 30(4) of the *Patent Rules*, which make it clear that a final action

is to dispose of a patent application” (per Simpson J., in *Belzberg v. Commissioner of Patents*, 2009 FC 657 at paragraph 44).

Thus, while FICPI Canada agrees that a mechanism should be provided for effecting amendments to correct defects identified by the PAB that were not raised in the Final Action but that are necessary for compliance with the Act and Rules, we do not agree that a patent application should be remanded to the examiner for further examination in situations of “incomplete examination”. As stated by Simpson J. in *Belzberg*: “I do not find that a requirement that final actions detail “all” outstanding defects is unduly onerous or contrary to the spirit and intent of the patent regime”. The provision of any mechanism that would permit an application to be remanded to the examiner following review by the PAB gives rise to the possibility of piecemeal examination and abuse of process. Examination on the merits must identify “all outstanding defects” (per subsection 30(4) of the *Patent Rules*).

With the foregoing in mind, we provide the following specific comments on the proposed amendments:

2.1 FICPI Canada agrees with proposed subsection 30(6) of the *Patent Rules*.

2.2 FICPI Canada agrees with proposed subsection 30(6.1) of the *Patent Rules*.

2.3 FICPI Canada agrees with proposed subsection 30(6.2) of the *Patent Rules*.

2.4 FICPI Canada does not agree with proposed subsection 30(6.3) of the *Patent Rules*. As discussed above, FICPI Canada believes that such a provision gives rise to the possibility of piecemeal examination and abuse of process. CIPO refers to examples of “incomplete examination” such as rejections based solely on new matter being added or unity of invention objections resulting in substantive examination being “halted”, a change in the law, or the submission of a protest. Taking each such case in turn:

a) It is not clear why resolution of a new matter rejection by the PAB should require further examination. If an applicant adds subject matter that an examiner deems to be new, the applicant can also retain claims that do not recite the new subject matter. Should the PAB determine that the examiner’s new matter rejection is justified, the PAB can inform the applicant that amendment is necessary to cancel the rejected claims (proposed subsection 6.4 of the *Patent Rules*).

b) It is also not clear why resolution of a unity objection by the PAB should require further examination. CIPO examiners routinely search the first or a group of claims in a patent application so that all issues of

novelty, obviousness and indefiniteness of the searched claims will have been addressed as of the Final Action. However, it is respectfully submitted that section 35(1) of the *Patent Act* requires the Commissioner to cause an application for a patent to be examined. If the application claims more than one invention, section 35(1) requires that all claims be examined. Should the PAB determine that the examiner's unity objection is justified, the PAB can inform the applicant that amendment is necessary to cancel all but one group of claims (proposed subsection 6.4 of the *Patent Rules*), and the applicant can file one or more divisional patent applications prior to issuance.

c) It is unclear why a change in the law should result in examination of a patent application being halted. FICPI Canada respectfully submits that occasions where there has been a change in the law after issuance of a Final Action but before the application has been reviewed by the PAB would be quite rare. In such rare circumstances, if the PAB determines the outstanding issues in favour of the applicant and issues a notice of allowance under subsection (6.1), (6.2) or (6.4) the Commissioner is already empowered to withdraw the notice of allowance and return the application for further examination (proposed subsection 30(7) of the *Patent Rules*).

d) Similarly, it is unclear why the filing of a protest should result in examination of a patent application being halted. In the event that a protest is filed after issuance of a Final Action but before the application has been reviewed by the PAB, and if the PAB determines the outstanding issues in favour of the applicant and issues a notice of allowance under subsection (6.1), (6.2) or (6.4) the Commissioner is empowered to withdraw the notice of allowance and return the application for further examination (proposed subsection 30(7) of the *Patent Rules*).

2.5 FICPI Canada agrees with proposed subsection 30(6.4) of the *Patent Rules*.

2.6 FICPI Canada does not agree with proposed subsection 30(6.5) of the *Patent Rules*, for the reasons discussed above in connection with proposed subsection 30(6.3). Furthermore, it is unclear why remand of the case would be necessary where the PAB recognizes that amendment would be possible to overcome the examiner's rejection. It would appear that proposed subsection 30(6.4) should be sufficient to deal with this situation. If the sole reason for this provision is to accommodate the possibility of an application being refused solely on the basis that an amendment requisitioned under proposed subsection 30(6.4) is not made, FICPI Canada believes that it would not be unreasonable for an applicant to face the consequences of refusal for failing to respond to such a requisition from the PAB.

2.7 FICPI Canada agrees with proposed subsection 30(6.6) of the *Patent Rules*.

2.8 FICPI Canada agrees with proposed subsection 30(7) of the *Patent Rules*.

2.9 FICPI Canada agrees with the proposed amendment to section 31 of the *Patent Rules*, subject to our comments with respect to subsections 30 (6.3) and 30 (6.5). Therefore, we suggest that the proposed amendment to section 31 be revised to delete subsection (b). Also, FICPI Canada notes CIPO's observation that subsections 30(7), 30(9), 30(10), 30(11) and sections 32, 33 and 44 as well as items 5 and 6 of Schedule II would also be slightly modified to reflect the proposed changes. FICPI Canada respectfully requests an opportunity to review and provide comments on the proposed modifications.

3 FICPI Canada agrees with the proposed amendment to section 45 of the *Patent Rules*, and the addition of new section 45.1.

In conclusion, we submit that the Commissioner has an obligation under Section 35(1) of the Patent Act to "cause an application for a patent to be examined by competent examiners..." Accordingly, we submit that the final office action should recite all of the perceived defects in the application. The Patent Office may want to implement an internal policy of having an internal review before issuing a final office action, but any final action should set out the finite set of things the examiner believes do not comply with the Patent Act and Patent Rules. In our view, examiners have an obligation to get it right before they issue an official action.

The review by the PAB should be limited to the finite set of issues identified by the examiner and should allow for suggestions by the PAB to improve the application, but should not include an opportunity to re-open examination. This could lead examiners into piecemeal examination of the type referred to in the Belzberg case and would protract examination leading to delay and additional unnecessary costs to applicants. Time for the applicant to make amendments following the suggestions of the PAB can be part of the review process before and/or after a hearing, but once the time has expired, whether or not amendments have been made in accordance with the suggestions, the PAB should issue its decision under Section 40 of the Patent Act.

We suggest that it may also be helpful to have a "continuation" practice whereby, if an application has been refused under Section 40, an applicant would have a reasonable period to appeal under Section 41 of the Patent Act, or to pay another examination fee to permit further examination on claims other than those that were refused under Section 40.

FICPI Canada wishes to thank the Canadian Intellectual Property Office for the opportunity to provide comments. If CIPO has any comments about our submissions, please do not hesitate to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'RBS', with a long horizontal stroke extending to the right.

Robert B. Storey, President - FICPI Canada  
Stephen Perry, Member of Council