[Abstract prepared by the PCT Legal Division (PCT-2013-0002)]

Case Name:

EXCELSIOR MEDICAL CORPORATION V. ATTORNEY GENERAL OF CANADA

Decision Date:

3 November 2011

Jurisdiction:

Canada
Federal Court of Appeal

Abstract:

Canada Federal Court of Appeal upheld the Federal Court's decision that the Commissioner of Patents did not err finding the patent applicant in question abandoned because someone other than the "authorized correspondent" requested the reinstatement and paid the fees. Under Canadian rules, the Commissioner shall not have regard to communications other than from an authorized agent. The applicant paid the reinstatement and the maintenance fees within the grace period through a firm other than the authorized correspondent of record. The Office accepted the fees from the unauthorized agent and communicated the reinstatement to the authorized correspondent of record. The appellate court found the Office's acceptance of fees from a party other than authorized correspondent of record does not reinstate the application and upheld the Federal Court's decision that the application in question cannot be reinstated.

PCT Legal Reference:

Article 27(7)

Federal Court of Appeal

Cour d'appel fédérale

Date: 20110211

Docket: A-65-10

Citation: 2011 FCA 55

CORAM: NOËL J.A.

PELLETIER J.A.

TRUDEL J.A.

BETWEEN:

UNICROP LTD.

Appellant

and

ATTORNEY GENERAL OF CANADA

Respondent

Heard at Toronto, Ontario, on January 11, 2011.

Judgment delivered at Ottawa, Ontario, on February 11, 2011.

REASONS FOR JUDGMENT BY: NOËL J.A.

CONCURRED IN BY:
PELLETIER J.A.

TRUDEL J.A.

Federal Court of Appeal

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REASONS FOR JUDGMENT

NOËL J.A.

[1] This is an appeal by Unicrop Ltd. (the appellant) against a judgment of Boivin J. of the Federal Court (the Applications Judge) wherein he dismissed the application for judicial review brought against a decision of the Commissioner of Patents (the Commissioner) who found the appellant's Canadian Patent Application No. 2,531,185 (the application) completely abandoned as of July 5, 2008, because the maintenance fees required by the Patent Act, R.S.C. 1985, c. P-4 (the Act) had not been paid in time.

[2] The appellant maintains that this decision results from an overly strict interpretation and application of the Act and the Patent Rules, SOR/92-423 (the Rules), and that in any event it is entitled to equitable relief in the form of an order restoring its patent application.

[3] For the reasons which follow, I am of the view that the appeal cannot succeed.

THE FACTS

[4] On January 3, 2006, the appellant, a Finnish corporation, requested National Entry under the Patent Cooperation Treaty for its application. At the same time, it appointed the law firm of Bereskin & Parr as its patent agent. Pursuant to section 27.1 of the Act, the appellant was required to pay annual fees to maintain its application. Bereskin & Parr submitted the annual maintenance fees for the first two years within the time prescribed by the Rules. [This provision and the other relevant provisions of the Act and the Rules are set out in Appendix I to these reasons.] The fees were to be paid annually by July 5.

[5] The third anniversary payment due on July 5, 2007 was not paid in time. The application was consequently deemed abandoned by the Commissioner pursuant to subsection 73(1) of the Act. On June 23, 2008, the law firm of Furman & Kallio submitted, on behalf of the appellant, two letters to the Commissioner. The first requested reinstatement pursuant to subsection 73(3) of the Act and subsection 98(1) of the Rules, and included the reinstatement

fee ($200) and the third anniversary maintenance fee ($100). The second letter submitted the fourth anniversary fee ($100).

[6] In a letter dated July 23, 2008, the Commissioner acknowledged the receipt of the fourth year maintenance fee. However, the letter advised, referring to subsection 6(1) of the Rules, that the fee to maintain the application "may only be paid by the authorized correspondent in regard to that particular application" (appeal book at p. 242).

[7] On August 12, 2008, Furman & Kallio submitted to the Commissioner an executed appointment of agent.

[8] On October 17, 2008, the Commissioner advised Furman & Kallio that the application could not be reinstated as the 12-month reinstatement period had expired and that, by law, the application had been completely abandoned as of July 5, 2008.

[9] The Commissioner acknowledged in a letter dated October 23, 2008, to Furman & Kallio the receipt of the reinstatement and maintenance fees submitted in the first letter sent on June 23, 2008. The Commissioner reiterated that, under the Rules, payment could only be accepted from the authorized correspondent.

[10] Following the Commissioner's refusal to reinstate its application, the appellant sought judicial review of that decision before the Federal Court.

DECISION OF THE FEDERAL COURT

[11] The Applications Judge conducted his review on a standard of correctness as in his view the Commissioner's expertise does not extend to the legal interpretation of statutes (reasons at para. 15). He identified three issues: (i) whether the Commissioner erred in refusing to reinstate the application; (ii) whether subsection 3.1(1) of the Rules provides relief in this case; and (iii) whether the equitable doctrines of relief against forfeiture or promissory estoppel provide a remedy in this case.

[12] Dealing with the first, the Applications Judge noted that paragraph 73(3)(a) of the Act provides that in order to reinstate an application deemed to be abandoned, the applicant must "make a request for reinstatement to the Commissioner within the prescribed period". He further observed that both the Act and the Rules "are silent as to what form the request should take, beyond the general requirement that the request be explicit" (reasons at para. 18).

[13] He then proceeded to dismiss the appellant's argument to the effect that the case was governed by the principle set out in Sarnoff Corp. v. Canada (Attorney General), 2008 FC 712 [Sarnoff], wherein Hughes J. found that the patent application in that case had to be reinstated even if the reinstatement period had expired. The Applications Judge then noted that in Sarnoff, the evidence was unclear as to whether a notice of appointment had been filed with the Commissioner. In this case, he found that the "evidence demonstrates clearly that the law firm of Furman & Kallio did not file a Notice of Appointment of Agent with [the Canadian Intellectual Property Office (CIPO)] as required under the Act, nor were there any clear efforts to establish legal representation prior to the application reaching the deadline for reinstatement" (reasons at para. 25). The Applications Judge also found that there was no history of communication between Furman & Kallio and the Commissioner with respect to the application, and that Bereskin & Parr was recognized as the authorized correspondent (reasons at paras. 23-25).

[14] The Applications Judge did not accept the appellant's submission that there was in this case a gap or an ambiguity of the type referred to in Dutch Industries Ltd. v. Canada (Commissioner of Patents), 2003 FCA 121 [Dutch Industries] that might be resolved in favour of the appellant. In his view, subsection 6(1) could not be any clearer in requiring that all communications with the Commissioner be conducted by the authorized correspondent. The Applications Judge further observed that even though the appellant's intention to appoint Furman & Kallio is undisputable, "the fact of the matter is that CIPO cannot be deemed to have knowledge of the said change and left to decide in each instance whether an applicant's direct communication with CIPO should be considered or not". Otherwise, the definition of "authorized correspondent" would be pointless (reasons at para. 28).

[15] The Applications Judge went on to consider whether subsection 3.1(1) of the Rules – a saving provision which provides an additional two-month delay when a clear but unsuccessful attempt to pay the fees is made within the time prescribed for doing so – was of assistance to the appellant in this case. He held that the argument had been conclusively dealt with in Rendina v. Canada (Attorney General), 2007 FC 914 [Rendina]. In that case, de Montigny J. held that the words "subject to 6(1)" contained in subsection 3.1(1) mean that any attempt to pay the reinstatement and maintenance fees had to be made by the authorized correspondent. As Furman & Kallio was not the authorized correspondent, subsection 3.1(1) of the Rules could not apply (reasons at paras. 32, 33).

[16] Finally, the Applications Judge held that the equitable doctrines of relief against forfeiture and promissory estoppel did not provide a remedy in this case. Contrary to the situation in Sarnoff, the Applications Judge noted that the appellant in this case failed to comply with the statute. Moreover, relying on F. Hoffman-La Roche AG v. Canada (Commissioner of Patents), 2003 FC 1381 [Hoffman-La Roche]; aff'd 2005 FCA 399, the Applications Judge held that granting equitable relief to the appellant in this case would have the effect of countering the time limit imposed by statute (reasons at paras. 37, 38).

ALLEGED ERRORS

[17] Relying on section 3.1 of the Rules, the appellant submits that the Commissioner did receive "a communication in accordance with which a clear but unsuccessful attempt [was] made to pay the fee". Had the Commissioner complied with the spirit of section 3.1, the "July 23, 2008 letter would have been expressly stated to be a Rule 3.1 notice, which would and could have been cured by the August 12, 2008 letter from Furman & Kallio enclosing the appointment of agent" (appellant's memorandum at para. 41). The appellant adds that denying the possibility of a saving provision "where a purely clerical matter (the filing of the appointment of agent) has not been completed" is inconsistent with the intent of section 3.1 (Ibid at para. 42). The appellant also submits that Rendina, upon which the Applications Judge relied, "is incorrect in light of the policies articulated in the later-decided Sarnoff case" (Ibid at para. 43).

[18] Relying on Sarnoff and Dutch Industries, the appellant further submits that there is an ambiguity as to when a Notice of Appointment of Agent has to be submitted, and that this ambiguity should be resolved in its favour. The appellant admits that Furman & Kallio did not send a Notice of Appointment of Agent to the Commissioner, but it submits that it has complied with all the statutory maintenance fee provisions. As such, and in light of the ambiguity as to when a Notice of Appointment of Agent has to be filed, the appellant contends that the Applications Judge erred in denying it the benefit of the ambiguity (appellant's memorandum at paras. 49-51).

[19] On the issue of equitable remedies, the appellant submits that the doctrine of relief against forfeiture "transcends, and is not displaced, by statutory regimes". The appellant further submits that it meets all the requirements set out by the Supreme Court of Canada in Saskatchewan River Bungalows Ltd. v. Maritime Life Assurance Co., [1994] 2 S.C.R. 490 [Saskatchewan River Bungalows], for the application of that doctrine. In any event, the appellant submits that the equitable doctrines of legitimate expectations and promissory estoppel apply in this case because it would be unfair to deny it the right secured by the payments which it made (appellant's memorandum at paras. 54-59).

ANALYSIS AND DECISION

[20] The parties submit, and I agree, that correctness is the applicable standard insofar as the Applications Judge's review of the Commissioner's decision not to reinstate the application is concerned (Dutch Industries at para. 23; Rendina at paras. 10, 11). The question which must be answered is whether the Applications Judge applied this standard correctly in refusing to intervene based on his interpretation of the relevant provisions of the Act and the Rules (Canada Revenue Agency v. Telfer, 2009 FCA 23). Similarly, the question whether equitable relief is excluded by reason of a clear statutory rule turns on the interpretation of the relevant provisions and must be assessed on a standard of correctness.

[21] Before addressing the appellant's arguments, it is useful to briefly review the scheme and operation of the legislation. Under section 27.1 of the Act, an applicant must pay fees to the Commissioner in order to maintain a patent application in effect. If an applicant fails to do so within the time prescribed by the Rules, the application is deemed abandoned pursuant to paragraph 73(1)(c) of the Act.

[22] Subsection 73(3) provides that an application that is deemed abandoned may be reinstated if the applicant "makes a request for reinstatement to the Commissioner within the prescribed period", takes the actions that should have been taken, and pays the prescribed fee before the expiration of the prescribed period. Section 98 of the Rules sets the prescribed period at 12 months. Therefore, in order to reinstate his application, the appellant had to, within the 12-month period following the date on which the application was deemed to be abandoned, make a reinstatement request and submit the reinstatement fee and the unpaid maintenance fees.

[23] In Dutch Industries, this Court identified the purpose of the maintenance fee provisions as follows (Dutch Industries at para. 30):

There is no dispute about the statutory objectives in play in this case. The fees payable under the [Act] and [Rules] are intended to defray part or all of the costs of the Patent Office…. The regime of annual maintenance fees was put in place to discourage the proliferation of deadwood patents and patent applications by requiring patentees and patent applicants, at least on an annual basis, to take steps to keep them in good standing …

[My emphasis]

[24] The Rules also determine who may communicate with the Commissioner. At the core of this appeal is subsection 6(1) of the Rules, which provides that the Commissioner shall only communicate with the authorized correspondent:

6. (1) Except as provided by the Act or these Rules, for the purpose of prosecuting or maintaining an application the Commissioner shall only communicate with, and shall only have regard to communications from, the authorized correspondent.

…

6. (1) Sauf disposition contraire de la Loi ou des présentes règles, dans le cadre de la poursuite ou du maintien d'une demande, le commissaire ne communique qu'avec le correspondant autorisé en ce qui concerne cette demande et ne tient compte que des communications reçues de celui-ci à cet égard.

[…]

[My emphasis]

[25] Of significance for present purposes is the fact that subsection 6(1) does not merely authorize the Commissioner to deal with those who have filed the appropriate notice; it effectively prohibits him from dealing with anyone else.

[26] Section 2 defines "authorized correspondent" as, inter alia, the inventor, an associate patent agent, or a patent agent appointed pursuant to section 20 of the Rules, which provides that the appointment shall be made "in the petition or by submitting to the Commissioner a notice signed by the applicant" (my emphasis). Section 22 of the Rules provides that an act by a patent agent or an associate patent agent has the same effect as an act done by the applicant.

[27] While recognizing that Furman & Kallio did not file a Notice of Appointment with the Commissioner until after the reinstatement period had expired, the appellant submits that there is an ambiguity in the legislation as to when such a notice must be filed. Relying mainly on the decision of Hughes J. in Sarnoff, the appellant suggests that this ambiguity should be resolved in its favour.

[28] In Sarnoff, the applicant had transferred in March 2004 the responsibility for its patent application from one law firm to another. The latter, Dimock Stratton, paid the maintenance fees for the 6th and 7th anniversary maintenance fees on March 2, 2005 and March 8, 2006, respectively. After receiving the 7th anniversary fee and one year after accepting the 6th anniversary fee, the Commissioner advised Dimock Stratton that the CIPO had no record of a change of agent or appointment of associate agent respecting that firm. The fees submitted by Dimock Stratton were therefore discarded and the patent application declared abandoned beyond reinstatement. Hughes J. found the decision of the Commissioner not to reinstate the patent's application unreasonable because the question whether Dimock Stratton was agent of record was unclear (Sarnoff at para. 26):

… [t]he evidence is far from clear as to the Dimock Stratton firm not being in fact the agent of record or associate agent. The [Commissioner] has failed to file any evidence that would assist in determining why it showed the Dimock Stratton firm as agent on its Web site and why, for about two years it communicated with that firm. I find that these circumstances are sufficient to determine that the Patent Office acted unreasonably in the circumstances of this case.

[My emphasis]

[29] On appeal (Attorney General of Canada v. Sarnoff Corporation, 2009 FCA 142) the decision of Hughes J. was upheld in the following terms (para. 1):

… we have not been persuaded that the applications judge's finding of fact that the Patent Office "had to have had an appointment of associate agent" was manifestly or palpably wrong as required by Housen v. Nikolaisen, [2002] 2 S.C.R. 235. There is some evidence in the record to support the factual finding as described in the reasons of the applications judge.

[My emphasis]

[30] In the present case, it is clear that Furman & Kallio were not agent of record since another firm, Bereskin & Parr, were shown as authorized correspondent and no notice of revocation or notice of appointement was filed with the Commissioner. Moreover, besides the communication relating to the two letters of June 23, 2008, there is no history of communication between the Commissioner and Furman & Kallio. As such, the reasoning of Hughes J. in Sarnoff is of no assistance to the appellant.

[31] As stated by the Applications Judge, the appellant's submission that its intention to appoint Furman & Kallio as its agent should nevertheless prevail would require that the definition of "authorized agent" be read out of the Rules. Accepting the appellant's submission would create the very uncertainty which the definition seeks to eliminate as the Commissioner would be left to decide in each case if the communication pertaining to an application should be considered or not. I note in this respect that the provisions relating to the "authorized correspondent" not only provide certainty from the perspective of the Commissioner but also from the perspective of all those interested in a patent. This was echoed by de Montigny J. in Rendina at para. 20:

… Various persons (i.e., inventor, multiple joint inventors, legal representative of inventor or joint inventors, associate patent agent or patent agent) may wish to communicate with and direct communications to the Commissioner of Patents regarding a particular patent application. Having multiple correspondents is an administrative burden for CIPO, creates the potential for conflicting requests, instructions and responses, and the potential for lack of instructions because of uncertainty as to who would act, with the consequence of missed deadlines. I agree with the respondent that subsection 6(1) was designed to prevent that confusion and is a reflection of the need that was felt to delineate who the Commissioner must communicate with and whose communications the Commissioner must have regard to with respect to a particular patent application.

[32] It has also been held that the intention to keep a patent application alive cannot counter the effect of the statutory and regulatory requirements. In Eiba v. Canada (Attorney General), 2004 FC 250, Mosley J. stated at paragraphs 43 and 44 that:

[43] … While the affidavit evidence filed in this proceeding reveals that the application in the present case was not intended to be abandoned, I am satisfied that the maintenance fee provisions of the Act and the Rules must be interpreted strictly by the Commissioner, and also this Court, in order to ensure compliance by applicants through the timely and diligent filing of fees.

[44] It is clear that the Commissioner has no authority pursuant to the Act and the Rules to extend the deadline for payment of maintenance fees: [Pfizer Inc. v. Canada (Commissioner of Patents), [2000] F.C.J. No. 1801 (C.A.)(QL)], and [Dutch Industries].

[My emphasis]

[33] In P.E. Fusion, LLC v. Canada (Attorney General), 2004 FC 645 at paragraph 22, Mosley J. made a similar observation:

… Unfortunate as it is for the applicant, Parliament has devised a legislative scheme for the payment of maintenance fees that does not contain any relief provisions, beyond the allowable one year reinstatement period, and has not vested the Commissioner or the Court with any discretion to correct mistakes, even ones by well-intentioned patentees, from the strict rules related to the payment of the prescribed fees when such payment is neglected past the reinstatement time period.

[My emphasis]

[34] In the present case, the relevant provisions of the Rules could not be clearer. Subsection 6(1) directs that the Commissioner shall not have regard to communications other than those from an authorized correspondent. The wording of section 3.1, which deals with the late payment of fees, makes it clear that this prohibition extends to communications relating to all such payments as it operates "subject to subsection 6(1)".

[35] It follows that there is no ambiguity to be resolved in favour of the appellant. The scheme of the Act contemplates there can only be one authorized correspondent at any given point in time. If, as here, there is an authorized correspondent on record, that correspondent continues in office until its appointment is revoked and another is appointed. Only an appointment or a revocation filed with the Commissioner pursuant to section 20 of the Rules

can operate a change and neither can take effect before being filed with the office of the Commissioner.

[36] The appellant nevertheless invokes the spirit of Rule 3.1. It submits that the benefit of this provision should not be denied where an attempt is made to make the payment within the grace period even if the attempt is made by someone other than the "authorized correspondent". The difficulty with this argument is that the Governor-in-Council has focussed on this very issue and has provided in clear and inescapable language that the Commissioner cannot have regard to "communications" – which includes communications requesting the reinstatement of a patent and the payment of outstanding fees – unless they emanate from an "authorized correspondent".

[37] The appellant maintained throughout that this "strict" reading of the provisions is no longer warranted in light of Sarnoff. In this respect, I note again that Sarnoff involved different facts. Moreover, what Hughes J. said with respect to subsection 6(1) – i.e. that it should not be read too restrictively – is obiter as he had already decided that the Commissioner's decision was unreasonable (Sarnoff at para. 22). Finally, there is nothing "strict" about the reading proposed by the Applications Judge in the present case. The strictness lies in the Rules themselves as the relevant provisions cannot be read otherwise.

[38] This in effect disposes of the appellant's alternative argument based on equity. As was stated by O'Reilly J. in Hoffman-La Roche at paragraphs 40 to 42, equitable relief cannot be invoked in order to counter the application of a clear statutory rule:

[40] It is clear that this Court can grant equitable relief to prevent the forfeiture of property under a private contract, such as a lease: Comtab Ventures Ltd. v. Canada, [1984] F.C.J. No. 922 (QL) (T.D.); Holachten Meadows Mobile Home Park Ltd. v. The Queen in Right of Canada and Lakahahmen Indian Band, [1986] 1 F.C. 238 (QL) (T.D.).

[41] However, the situation is entirely different when the forfeiture results from a statutory rule. Judges must give effect to the statute: Canadian Northern Railway Co. v. Canada (1922), 64 S.C.R. 264; Martin Mine Limited v. British Columbia, [1995] B.C.J. No. 2309; Olympia & York Developments Limited v. Calgary (City), [1983] A.J. No. 808 (QL).

[42] Hoffmann-La Roche concedes the authority of these cases but suggests that the situation should be different when a person loses a property right, in part, because of a government

agency's error. This would be true, perhaps, if there were room for discretion or compromise in the language of the governing statute. However, I cannot see any room for relief in the case before me. The statute is clear. If I were to extend the time for paying the maintenance fee in this case, I would be substituting my own deadline for that enacted by Parliament. As Lord Parmoor stated in the Canadian Northern Railway case, above, "if the power given to the Court to relieve against penalties applied to statutory penalties, this would, in effect be giving an authority to enable the Court to repeal statutes" (R. v. CNR Co., CNR Co. v. R., [1923] 3 DLR 719 (QL) (PC), at p. 725). I decline to recognize such a power.

[My emphasis]

[39] I believe it useful to nevertheless comment briefly on the appellant's further submission, relying on Sarnoff, that Furman & Kallio acted reasonably and therefore the first element of the test for relief against forfeiture, as set out by the Supreme Court in Saskatchewan River at paragraph 34, is met.

[40] In Sarnoff at paragraph 36, Hughes J. said, in obiter, that relief against forfeiture could be an appropriate remedy in that case because the conduct of the applicant could not be criticized since it had paid the required fees and the Commissioner having dealt with Dimock Stratton for over two year "had to have had an appointment of associate agent" (Sarnoff at para. 28). It follows that no blame of any sort could be attributed to the applicant or its agent.

[41] This is not the case here. As found by the Applications Judge, Furman & Kallio failed to file a Notice of Appointment in due time and it is this failure to comply with the Rules which resulted in the Commissioner being prevented from accepting instructions from that firm.

[42] The appellant finally submits that, in any event, the equitable doctrines of legitimate expectations and promissory estoppel apply to the case at bar. According to the appellant, the Commissioner has, by accepting the reinstatement and maintenance fees, "made a promise or assurance which was intended to have legal effect and to be acted on" (appellant's memorandum at para. 59). As such, the appellant submits that it would be unfair to be denied the right secured by the payment of those fees.

[43] I can see no merit to this argument. In two letters to Furman & Kallio dated July 23, 2008 and October 23, 2008, the Commissioner acknowledges receipt of the reinstatement

and maintenance fees and states that they cannot be accepted due to the fact that Furman & Kallio was not the authorized agent. The letters go on to indicate that the fees will be refunded upon request (appeal book at pp. 51 and 242). It cannot therefore be said that the Commissioner made any form of promise capable of giving rise to promissory estoppel.

[44] I would dismiss the appeal with costs.

"Marc Noël"

J.A.

"I agree

J.D. Denis Pelletier J.A."

"I agree

Johanne Trudel J.A."

APPENDIX I

RELEVANT LEGISLATIVE PROVISIONS:

- Patent Act

Maintenance fees

27.1 (1) An applicant for a patent shall, to maintain the application in effect, pay to the Commissioner such fees, in respect of such periods, as may be prescribed.

(2) and (3) [Repealed, 1993, c. 15, s. 32]

Deemed abandonment of applications

73. (1) An application for a patent in Canada shall be deemed to be abandoned if the applicant does not

(a) reply in good faith to any requisition made by an examiner in connection with an examination, within six months after the requisition is made or within any shorter period established by the

Commissioner;

(b) comply with a notice given pursuant to subsection 27(6);

(c) pay the fees payable under section 27.1, within the time provided by the regulations;

(d) make a request for examination or pay the prescribed fee under subsection 35(1) within the time provided by the regulations;

(e) comply with a notice given under subsection 35(2); or

(f) pay the prescribed fees stated to be payable in a notice of allowance of patent within six months after the date of the notice.

Deemed abandonment in prescribed circumstances

(2) An application shall also be deemed to be abandoned in any other circumstances that are prescribed.

Reinstatement

(3) An application deemed to be abandoned under this section shall be reinstated if the applicant

(a) makes a request for reinstatement to the Commissioner within the prescribed period;

(b) takes the action that should have been taken in order to avoid the abandonment; and

(c) pays the prescribed fee before the expiration of the prescribed period.

Amendment and reexamination

(4) An application that has been abandoned pursuant to paragraph (1)(f) and reinstated is subject to amendment and further examination.

Original filing date

(5) An application that is reinstated retains its original filing date.

Taxes périodiques

27.1 (1) Le demandeur est tenu de payer au commissaire, afin de maintenir sa demande en état, les taxes réglementaires pour chaque période réglementaire.

(2) et (3) [Abrogés, 1993, ch.

15, art. 32]

Abandon

73. (1) La demande de brevet est considérée comme abandonnée si le demandeur omet, selon le cas :

a) de répondre de bonne foi, dans le cadre d'un examen, à toute demande de l'examinateur, dans les six mois suivant cette demande ou dans le délai plus court déterminé par le commissaire;

b) de se conformer à l'avis mentionné au paragraphe 27(6);

c) de payer, dans le délai réglementaire, les taxes visées à l'article 27.1;

d) de présenter la requête visée au paragraphe 35(1) ou de payer la taxe réglementaire dans le délai réglementaire;

e) de se conformer à l'avis mentionné au paragraphe 35(2);

f) de payer les taxes réglementaires mentionnées dans l'avis d'acceptation de la demande de brevet dans les six mois suivant celui-ci.

Idem

(2) Elle est aussi considérée comme abandonnée dans les circonstances réglementaires.

Rétablissement

(3) Elle peut être rétablie si le demandeur :

a) présente au commissaire, dans le délai réglementaire, une requête à cet effet;

b) prend les mesures qui s'imposaient pour éviter l'abandon;

c) paie les taxes réglementaires avant l'expiration de la période réglementaire.

Modification et réexamen

(4) La demande abandonnée au titre de l'alinéa (1)f) et rétablie par la suite est sujette à modification et à nouvel

examen.

Date de dépôt originelle

(5) La demande rétablie conserve sa date de dépôt.

- Patent Rules

2. In these Rules,

"authorized correspondent" means, in respect of an application,

(a) where the application was filed by the inventor, where no transfer of the inventor's right to the patent or of the whole interest in the invention has been registered in the Patent Office and where no patent agent has been appointed

(i) the sole inventor,

(ii) one of two or more joint inventors authorized by all such inventors to act on their joint behalf, or

(iii) where there are two or more joint inventors and no inventor has been authorized in accordance with subparagraph (ii), the first inventor named in the petition or, in the case of PCT national phase applications, the first inventor named in the international application,

(b) where an associate patent agent has been appointed or is required to be appointed pursuant to section 21, the associate patent agent, or

(c) where paragraphs (a) and (b) do not apply, a patent agent appointed pursuant to section 20; (correspondant autorisé)

3.1 (1) Subject to subsection 6(1), if, before the expiry of a time limit for paying a fee set out in Schedule II, the Commissioner receives a communication in accordance with which a clear but unsuccessful attempt is made to pay the fee, the fee shall be considered to have been paid before the expiry of the time limit if

(a) the amount of the fee that was missing is paid before the expiry of the time limit;

(b) if a notice is sent in accordance with subsection (2), the amount of the fee that was missing, together with the late payment fee set out in item 22.1 of Schedule II, are paid before the expiry of the two-month period after the date of the notice; or

(c) if a notice is not sent, the amount of the fee that was missing, together with the late payment fee set out in item 22.1 of Schedule II, are paid before the expiry of the two-month period after the day on which the communication was received by the Commissioner.

(2) Subject to subsection 6(1) and unless the person making the communication did not provide information that would allow them to be contacted, if the Commissioner has received a communication in the circumstances referred to in subsection (1), the Commissioner shall, by notice to the person who made the communication, request payment of the amount of the fee that was missing together, if applicable, with the late payment fee referred to in subsection (1).

(3) Subsections (1) and (2) do not apply in respect of the fees set out in items 9 to 9.4 and 22.1 of Schedule II.

6. (1) Except as provided by the Act or these Rules, for the purpose of prosecuting or maintaining an application the Commissioner shall only communicate with, and shall only have regard to communications from, the authorized correspondent.

Appointment of Patent Agents

20. (1) An applicant who is not an inventor shall appoint a patent agent to prosecute the application for the applicant.

(2) The appointment of a patent agent shall be made in the petition or by submitting to the Commissioner a notice signed by the applicant.

(3) The appointment of a patent agent may be revoked by submitting to the Commissioner a notice of revocation signed by the applicant or that patent

agent.

98. (1) For an application deemed to be abandoned under section 73 of the Act to be reinstated, the applicant shall, in respect of each failure to take an action referred to in subsection 73(1) of the Act or section 97, make a request for reinstatement to the Commissioner, take the action that should have been taken in order to avoid the abandonment and pay the fee set out in item 7 of Schedule II, before the expiry of the 12-month period after the date on which the application is deemed to be abandoned as a result of that failure.

(2) For the purposes of subsection (1), if an application is deemed to be abandoned for failure to pay a fee referred to in subsection 3(3), (4) or (7), for the applicant to take the action that should have been taken in order to avoid the abandonment, the applicant shall, before the expiry of the time prescribed by subsection (1), either

(a) pay the applicable standard fee, or

(b) file a small entity declaration in respect of the application in accordance with section 3.01 and pay the applicable small entity fee.

2. Les définitions qui suivent s’appliquent aux présentes règles.

« correspondant autorisé » Pour

une demande :

a) lorsque la demande a été déposée par l’inventeur, qu’aucune cession de son droit au brevet, de son droit sur l’invention ou de son intérêt entier dans l’invention n’a été enregistrée au Bureau des brevets et qu’aucun agent de brevets n’a été nommé :

(i) l’unique inventeur,

(ii) s’il y a deux coïnventeurs ou plus, celui autorisé par ceux-ci à agir en leur nom,

(iii) s’il y a deux coïnventeurs ou plus et qu’aucun de ceux-ci n’a été ainsi autorisé, le premier inventeur nommé dans la pétition ou, dans le cas des demandes PCT à la phase nationale, le premier inventeur nommé dans la demande internationale;

b) lorsqu’un coagent a été nommé ou doit l’être en application de l’article 21, le coagent ainsi nommé;

c) lorsque les alinéas a) et b) ne s’appliquent pas, l’agent de brevets nommé en application de l’article 20. (authorized correspondent)

3.1 (1) Sous réserve du paragraphe 6(1), si, avant l’expiration du délai fixé pour le versement d’une taxe prévue à l’annexe II, le commissaire reçoit une communication dans laquelle une personne fait une tentative manifeste mais infructueuse pour verser la taxe, celle-ci est réputée avoir été reçue avant l’expiration du délai dans les cas suivants :

a) la taxe impayée est versée avant l’expiration du délai;

b) dans le cas où un avis est envoyé conformément au paragraphe (2), la taxe impayée, accompagnée de la surtaxe pour paiement en souffrance prévue à l’article 22.1 de l’annexe II, est versée dans les deux mois suivant la date de l’avis;

c) dans le cas où aucun avis n’est envoyé, la taxe impayée, accompagnée de la surtaxe pour paiement en souffrance prévue à l’article 22.1 de l’annexe II, est versée dans les deux mois suivant la date à laquelle le commissaire a reçu la communication.

(2) Sous réserve du paragraphe 6(1) et à moins que l’auteur de la communication au commissaire ne soumette pas les renseignements permettant de communiquer avec lui, si le

commissaire reçoit la communication dans les circonstances visées au paragraphe (1), il demande, par avis, à la personne qui lui a envoyé la communication de verser la taxe impayée, accompagnée, s'il y a lieu, de la surtaxe pour paiement en souffrance visée au paragraphe (1).

(3) Les paragraphes (1) et (2) ne s'appliquent pas aux taxes prévues aux articles 9 à 9.4 et 22.1 de l'annexe II.

6. (1) Sauf disposition contraire de la Loi ou des présentes règles, dans le cadre de la poursuite ou du maintien d'une demande, le commissaire ne communique qu'avec le correspondant autorisé en ce qui concerne cette demande et ne tient compte que des communications reçues de celui-ci à cet égard.

Nomination des agents de brevets

20. (1) Le demandeur qui n'est pas l'inventeur nomme un agent de brevets chargé de poursuivre la demande en son nom.

(2) L'agent de brevets est nommé dans la pétition ou dans un avis remis au commissaire et signé par le demandeur.

(3) La nomination d'un agent de brevets peut être révoquée par un avis de révocation remis au commissaire et signé par l'agent ou le demandeur.

98. (1) Pour que la demande considérée comme abandonnée en application de l'article 73 de la Loi soit rétablie, le demandeur, à l'égard de chaque omission visée au paragraphe 73(1) de la Loi ou à l'article 97, présente au commissaire une requête à cet effet, prend les mesures qui s'imposaient pour éviter l'abandon et paie la taxe prévue à l'article 7 de l'annexe II, dans les douze mois suivant la date de prise d'effet de l'abandon.

(2) Pour prendre les mesures qui s'imposaient pour éviter l'abandon pour non-paiement de la taxe visée aux paragraphes 3(3), (4) ou (7), le demandeur, avant l'expiration du délai

prévu au paragraphe (1) :

a) soit paie la taxe générale applicable;

b) soit dépose, à l'égard de sa demande, la déclaration du statut de petite entité conformément à l'article 3.01 et paie la taxe applicable aux petites entités.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-65-10

(APPEAL FROM AN ORDER OF THE HONOURABLE Mr. JUSTICE BOIVIN OF THE FEDERAL COURT DATED JANUARY 20, 2010, DOCKET NO. T-1788-08.)

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Trudel J.A.

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