

**Joint Liaison Committee**  
**Meeting #117**  
**Wednesday, June 17, 2009**

<b>Attendees:</b>	<b>IPIC</b>	<b>Patent Office</b>
	R. Caldwell	B. de Schneider
	G. Silver	S. MacNeil
	K. Lachaine	L. Giardina
	M. Eisen	D. Campbell
	A. Brett	S. Vasudev
	H. Probert	M. Gillen
	A. Zahl	S. Périard
	D. Schwartz	A. Patry
	S. Beney	L. Roussel
		C. Evans
		S. Tupper
		A. Gélinas

<b>Via Conference Call*</b>	<b>CIPO Observers</b>
K. Sechley	J. Stickley
E. Saffman	N. Gareau
S. Rancourt	A. Reayi
B. Chan	
M.A. Arnaldo	
M. Paton	

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**1. MINUTES OF THE PREVIOUS MEETING**

The minutes of the meeting of February 11, 2009, were approved without amendment.

**2. BUSINESS ARISING**

**4e Rejections Relating to Sound Predictions and Utility**

This item was previously covered in the minutes of the meeting of June 4, 2008.

D. Campbell reported that the Office appreciates the comments received from the profession regarding examiner objections based on Section 84 of the Patent Rules and Sections 2 and 27(3) of the Patent Act. Upon consideration of those comments it has been decided to consult with the profession and the public on a wider basis. Accordingly, a notice of consultation on this issue will be provided on CIPO's web-site in the near future. As this issue is relevant to Chapter 12 of the Manual of Patent Office Practice (MOPOP), a draft of which is currently in a public consultation period ending in mid-August, it is hoped that the consultative process on this issue can occur in parallel and be incorporated into Chapter 12 before the chapter is finalized. If not, MOPOP will be updated later and a Practice Notice will be released by the Office in the meantime.

#### **4f General Authorization**

Based on concerns raised previously by D. Schwartz, the Office agreed to review the concept of conditional reinstatement requests and its implications in terms of responsibility to the Office.

S. Vasudev reported that the Office is currently considering the possibility of expanding the applicability of General Authorization statements under the proviso that administrative burden to the Office does not increase. Feedback provided thus far by the profession on this issue has merit. More definitive information on the Office's plans will be provided at the next meeting. Alternatively, a public consultation period for the issue will be established.

### **3. ON-GOING ITEMS**

#### **3a Inventory/Turn-Around Time Reports**

"*Dashboard Highlights*" for March, 2009, and *Additional Patent Statistics* for March, 2009, were included in the JLC members' information packages.

L. Giardina summarized Patent Examination's "Dashboard Highlights" for the committee. 2008-09 proved to be a very good production year for the Office. Disposals were at 35,200 which represented 98.9% of the yearly goal. As there were only 33,200 inputs to examination last year (requests for examination and reinstatements), a 2000 application reduction to the Office inventory was achieved. Turn around times to reach a first examiner's action for 2009-10 varied by division and were 24 months for Biotechnology, 33 months for Electrical, 18 months for Mechanical and 21 months each for General Chemistry and Organic Chemistry. Recruitment will continue this coming year but will gradually wind down such that hiring based on attrition will be the norm next year. Ten mechanical examiners and nine electrical examiners were

recently hired and a new electrical examiner group will be joining the Office next month, with the possibility of more electrical examiners being recruited in the Fall.

S. Périard discussed turn-around-times in Operations. As of the end of May, 2009, the issuance of filing certificates for patent applications meeting filing requirements stands at 3.4 weeks (surpassing the goal of 4 weeks). The issuance of confirmation notices of national entry for PCT applications meeting entry requirements is now in conformance with the Client Service Standard of 8 weeks. The issuance of ownership registration certificates currently stands at 6 weeks and is also in conformance with the client service standard.

### **3b Corporate Feedback Mechanism Report**

A report summarising feedback received during the period April 1, 2008, to March 31, 2009, was included in the JLC members' information packages.

B. de Schneider noted that complaints peaked in the third quarter of last year and generally related to issues surrounding PCT national entry. Attention to this area has resulted in a significant increase in client satisfaction as demonstrated by the reduction in the complaints received in the fourth quarter. The profession was reminded to utilize the Online Feedback Mechanism whenever possible to resolve specific problems expeditiously. The Office tracks feedback monthly in an effort to satisfy client needs and identify trends that may affect product line processes.

R. Caldwell expressed the profession's appreciation to Johanne Bisson for providing a detailed and complete package to members of the committee ahead of the meeting. This allowed members to consider all the issues and information prior to the meeting.

## **4. NEW BUSINESS**

### **4a Regulations Update**

S. Vasudev provided a regulations update to the committee. Regulation package #1 is currently with the Treasury Board of Canada and may be published in Gazette 1 by July, 2009, which will provide the profession another opportunity to comment. Assuming all goes well, and subject to IT consideration, it is anticipated that package #1 should be in-force by year's end. Regulation package #2 has been updated in view of comments realized during the consultation period and subsequently approved by the Commissioner of Patents. The package is now in the process to seek ministerial approval. A Regulations package #3 is in development and will include changes to regulations relating to the Patent Agent exam as well as Final Action procedures. It is expected that the package will be available for public consultation by the end of July, 2009, on

CIPO's web-site.

K. Ledwell submitted concerns regarding notices of abandonment and CIPO's related obligations. It would be advantageous to the applicant for CIPO to send notification when an attempt is made by the applicant to place a transaction on an abandoned application. An extension of the abandonment period to 15 months and/or the provision of a letter with a 3 month time limit for reinstatement should be considered for the Regulations packages.

S. Vasudev responded that the Office prefers a "pull-type" system that would allow the applicant to download required information on an application's abandonment status directly from the web-site. The profession's concerns regarding the viability and ease of use of such a system has been noted by the Office. It is a priority of the Office that any "pull-type" system developed would be user friendly, useful to clients and would not require the profession to check every file on a frequent basis. With respect to Mr. Ledwell's suggestion that there be available a time extension to current practices regarding abandonment, the Office has no plans to effect such changes.

#### **4b MOPOP Update**

C. Evans provided an update on the progress of revision to the Manual of Patent Office Practice (MOPOP). A public consultation is currently underway (May 11 to August 14, 2009) for draft Chapters 12 (Subject Matter and Utility) and 13 (Examination of Applications). Additional information is available at CIPO's web-site. Work continues on a proposed Chapter 9 (Descriptions), which should be available for public consultation in Fall, 2009. Work should begin this Summer on revisions to Chapters 14 (Utility) and 16 (Computer Inventions).

A. Brett requested that the consultative period for Chapters 12 and 13 of MOPOP be extended for several months into the Fall. Mr. Brett indicated that the issues covered in the chapters are complex and directly affect the rights of applicants. B. de Schneider questioned the profession as to the value of additional consultation time, and brought to their attention that extensions could lead to overlapping consultations later on, causing other problems and pressures to delay. The profession responded that they believe there is significant European case law that must be reviewed and the bulk of the consultative period falls in the Summer months rendering participation less likely. B. de Schneider responded that such concerns would be taken under advisement and that the possibility of an extension would be considered.

#### **4c Section 8 Update**

S. Vasudev reported to the gathered committee that two thirds of all Section 8 requests are now processed within 4 months of the request. There are still approximately thirty older Section 8 requests that require resolution. The Office hopes to resolve the outstanding requests during the Summer months. It has been noted by the Office that Section 8 requests are progressively

becoming less time consuming as requestors appear to be more familiar with what constitutes a basis for a section 8 request. A further update will be provided at the next meeting.

#### **4d Patent Prosecution Highway (PPH) Update**

S. Vasudev provided to the committee an update on the Patent Prosecution Highway (PPH). The PPH agreement between Canada and the United States is going well and is the most voluminous of the PPH agreements. Canada is in negotiations with the offices of Korea, Denmark and Japan to establish PPH agreements between the countries. Pilot programs with these countries may be available by the Fall. The Office is interested in developing ways to publicize the PPH and its advantages and would welcome any suggestions to this end from the profession. There is a push to standardize the PPH procedures and requirements between all countries participating so that applicants will know what to expect when using the service; such as common request forms and improved interoffice access to the file history. The Japanese Patent Office is spearheading the development of a PPH portal to track statistics and other information related to the PPH.

A. Zahl questioned whether examiners were given guidelines on how to utilize the United States examiner's opinion when working on a PPH case.

D. Campbell responded that no specific guidelines have been provided to examiners and that it is up to the examiner to weigh the US examiner's opinion in view of Canadian Law. Advantages to the applicant include that the PPH case prosecution is significantly advanced by virtue of the presence of the allowable United States claims. The examiner must assess whether a further prior art search is required and whether the application conforms with the requirements of the Canadian Patent Act and Rules.

B. de Schneider advised the committee that detailed statistics on Canadian PPH cases would be provided at the next meeting.

#### **4e Searches on CIPO Web-site**

S. Rancourt expressed a desire to perform searches on CIPO's web-site that would permit the population of search fields with patent numbers that contain commas or are free of commas. This allows a cut and paste approach to the searching which helps eliminate transcription errors. As well, it would be desirable to have the option of not including "dead" or "lapsed" applications and patents in the results of a search; particularly for searches related to freedom to operate (clearance) opinions.

G. Silver questioned the possibility of publishing the "allowed date" of an application on CIPO's web-site.

B. de Schneider responded that modifying the IT system is not easy due to higher priorities and

suggested a work around would be to copy and paste the application serial number into an editor, remove the commas and then cut and paste the modified serial number into the search engine. There does not appear to be a ready solution to the problem of excluding “dead” and/or “lapsed” applications and patents from search results. Mr. de Schneider emphasized the need to establish an urgency through multiple complaints if specific modifications to CIPO’s IT system are to receive a higher priority by the Office.

D. Campbell added that it is possible to provide the “allowed” date of an application on the website but that it is a matter of priority and resources to effect the requested changes.

R. Caldwell offered that the profession collect ideas on how to improve the system and establish a priority list. B. de Schneider indicated that this would be helpful.

#### **4f Divisional Patent Applications**

##### **4f(1) Assignments**

G. Silver questioned CIPO’s procedures regarding the requirement to provide Declarations of Entitlement on divisional applications and the need to bring forward an assignment from a parent to a divisional. Ms. Silver received a letter from CIPO stating that she is not permitted to bring the assignment forward.

S. Périard responded that these types of letters are no longer being issued by the Office and that any such letters received should be ignored. Assignments brought forward from a parent to a divisional application are now registered against the divisional as “other document”. There is currently no other way to register the assignment. It is anticipated that a new release of the IT system later this year will rectify the problem.

##### **4f(2) Divisional and Parent Relationship**

S. Rancourt questioned CIPO’s practice of permitting divisional applications to be filed even after the “original” parent application has issued (see Chapter 14.06.03 of MOPOP) in view of Section 36 of the Patent Act which requires that all divisionals be filed before the parent issues.

D. Campbell responded that the Office has always interpreted the phrase “*original application*” in section 36 of the Patent Act as applying to any application that describes more than one invention, including divisional applications. This interpretation finds support in section 36(4). Consequently, divisional applications can be further divided. D. Campbell pointed out that Commissioner’s Decision #350 considered issues other than section 36 related to an application that was a divisional of a divisional application and that this application subsequently proceeded to grant.

### **4f(3) Priority Examination**

D. Schwartz questioned whether a divisional application receives priority of examination when filed since it may be filed well into the term of the parent and whether an examiner is aware that an application in the queue is even a divisional.

S. Zhang questioned the examiner practice of requiring unity of invention and then warning the applicant that any divisionals filed may result in a double patenting objection.

D. Campbell answered that all tasks associated with applications having a filing date before 1996 receive a priority "1" status and automatically appear at the top of an examiner's queue. For divisional applications with a filing date after 1995, a priority "3" is given by the TechSource system to the initial examination task. When the examiner confirms that the application is entitled to divisional status, the examiner has discretion to decide whether to return the application to its routine order in the queue or whether it would be more efficient to examine it immediately. Examiners have been instructed to no longer use the paragraph that suggests an Office mandated divisional application could be subject to a future double patenting objection. Although poorly phrased, the intent of the paragraph was to remind applicants that the claims of a divisional application cannot be directed to the same subject matter as that claimed in a parent application. Irrespectively, it has been clearly established under Canadian Law that an applicant cannot be jeopardized as a result of an Office-directed unity requirement.

D. Campbell further noted for the committee that the number of divisional applications filed with the Office has significantly increased over the last decade. In 1998, seventy two divisional applications were filed whereas 1290 were filed in 2008. A discussion as to why the divisional filings have increased so radically ensued without a definitive conclusion for the reasons.

### **4g Rule 81 - Objections for Failing to Provide a Publication Date**

S. Rancourt questioned the continued requirement by examiners to provide publication dates for published applications when referenced in the description; particularly in view of Chapter 9.04 of MOPOP where it states that such dates are not necessary.

C. Evans responded that it is not necessary to provide publication dates unless it is essential to the retrieval of the referenced document. The standardized paragraphs used by examiners when drafting reports will be updated to reflect the current official practice.

### **4h Maintenance Fee Payments**

S. Périard indicated to the committee that this issue was resolved outside of the meeting and that it resulted in a column being added to the maintenance fee calculation sheet.

#### **4i Dependent Claims**

M. Paton questioned whether it is permissible for examiners to gloss over dependent claims in favor of a more comprehensive examination of the independent claims.

L. Giardina reminded the committee that this issue was previously discussed in the minutes of the meeting of March 23, 2005, and that, in terms of efficiency to the Office, it is sometimes preferred to provide less detail in an examiner's report; particularly when it is apparent the applicant is likely to respond by amending the claims to those issued by either the United States or the European Patent Office.

#### **4j CIPO Templates**

M. Paton complained that letters issued by the Office are inconsistent in format; they sometimes identify the applicant, sometimes the owner and sometimes the applicant is incorrectly identified as the owner.

S. Périard responded that it is planned to review all the correspondence templates to correct inconsistencies and establish a common manner to identify applicants and owners. Ms. Périard suggested that Ms. Paton forward any specific examples to her directly.

#### **4k Final Office Actions**

K. Ledwell questioned whether there has been a change in Office practice with respect to when and under what conditions a Final Action is written by examiners. It has been noted that examiners are threatening final action earlier in the prosecution and don't seem to wait until an impasse is reached.

M. Gillen responded that the Office practice with respect to final actions has not changed and that examiners have not been told to write them sooner. Second actions on the same grounds as the first may be made final, but this rarely happens unless so requested by the applicant. However, it is common for examiners to warn the applicant that a continued impasse may result in a final action.

#### **4l Notices of Reinstatement**

D. Schwartz requested that notices of reinstatement clearly indicate which act of abandonment has been addressed by the reinstatement since applications can go abandoned for multiple simultaneous reasons.

B. de Schneider responded that this is not currently possible since the notices of abandonment are

automatically generated by the system for multiple reasons. A system modification is required to indicate the reason for reinstatement.

#### **4m PCT National Entry Procedure**

D. Schwartz questioned whether it is necessary to file a voluntary amendment after national phase entry to provide the Articles 19 and 34 amendments in situations where the international examiner has disregarded the amendments on the basis that the amendments introduced new subject matter.

S. Vasudev responded that it is not necessary to file a voluntary amendment in this situation because what takes place during the international phase forms part of the application and should be present at national phase entry. If the Canadian examiner considers that new subject matter was included in an Article 19 or 34 amendment, an objection to the amendment is made in a national phase office action.

#### **4n Failure to Issue Requisitions Under Rule 94**

R. Caldwell raised concerns about several instances where the Office issued courtesy letters but failed to issue Rule 94 requisition letters during the period of 2006-07 and the possibility of other unidentified cases.

S. Périard responded that this issue was previously addressed in the minutes of the meeting of November, 2007. When courtesy letters identifying incomplete applications are issued, the applicant may respond by completing the application. In this case no fee is required. When the Office issues Rule 94 letters with a time limit, a completion fee is required. The Office will confirm its practice where a response to a courtesy letter has been received and will be brought forward to the next meeting. S. Périard suggested that R. Caldwell provide to her information on the identified cases and that the situation would be examined in more detail.

#### **4o New Practice Concerning Title of Invention**

A. Zahl expressed concerns about CIPO's recent change in practice regarding the title of the invention wherein, unless advised otherwise, the patent issues with the title that appears on the first page of the description when that title disagrees with the title identified in the initial request. It would be beneficial to the applicant to be warned of the discrepancy in title before the applicant's only remaining option is to pay the Amendment After Allowance fee to rectify the situation.

S. Périard requested that this issue be brought forward to the next agenda.

R. Calwell received a letter from CIPO claiming that the title in TechSource did not match the title on the first page of the description contrary to the applicant's records which showed that an amendment had been submitted for that purpose. Accordingly, she requested clarification on whether the title according to TechSource is the title reflected on Office letters and whether her amendments had actually been entered.

S. Périard responded that all amendments had been entered to TechSource correctly, but that an employee had misunderstood the new practice and had incorrectly issued the letters claiming a discrepancy in titles.

S. Périard also informed the committee that the Office has been identifying the title as shown on page 1 of the description in Notices of Allowance since March 5, 2009.

#### **4p Spirit of Invention**

A. Brett expressed concerns about the increasing occurrences of examiners objecting to standard "spirit of invention" clauses that appear in the description of an application. He feels that such objections are incorrect.

D. Campbell responded that the practice of objecting to "spirit of invention" clauses has stemmed from the requirement to object to such clauses appearing in international applications as well as from a Canadian court decision (FreeWorld) where the court noted that the claims are not interpreted in view of a "spirit of invention". A statement that the claims are not to be limited by the preferred or exemplified embodiments of the invention is permissible.

#### **5. OTHER BUSINESS**

None

#### **6. ITEMS PREVIOUSLY ADDRESSED**

None

#### **7. SPECIFIC ENQUIRIES**

No such items were identified.

**8. NEXT MEETING**

The next meeting is scheduled to take place October 28, 2009 [at 9:30 a.m. in Room D, 24<sup>th</sup> floor, Place du Portage, Phase I, 50 rue Victoria, Gatineau QC K1A 0C9].

The meeting adjourned at 12:20 pm.

Steven Tupper

