SLW 2025 GLOBAL SERIES June 10, 2025

Navigating Recent Changes in Canadian Patent Practice

Before We Get Started…

Recording

A link to the recording and slides will be emailed to all registrants.

Questions

Type in the question box and we will answer in real time or during the Q&A.

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Panel

Matt Norwood, J.D.
Patent Attorney at SLW

Maureen Kinsler, Ph.D.
SLW Executive Director, &
Principal at SLW International

Episode Overview

- Divisional Strategies & Excess Claim Fees (2022)
- Patent Term Adjustment (PTA) Rules (2024)
- “Due Care” Standard Post-*Matco Tools* (2025)
- Federal/Provincial IP Funding Programs

Canada vs. U.S. Patent Primer

- No terminal disclaimers
- 12-month grace period
- 4 years to request examination
- Litigation remedies (lower damages, profits available, easier permanent injunctions)
- ~~No excess claim fees~~
- ~~No RCE fees~~
- ~~Reinstatement as of right within 12 months of abandonment~~

Divisional Strategies & Excess Claim Fees

October 2022 Changes

- Excess claim fees
  - ≈USD $70/claim over 20 (applied at examination request and allowance).
- RCE framework
  - Mandatory after 3 office actions (≈USD $400 fee).

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Strategic Response

- File with all desired claims.
- Trim claims to ≤20 before examination request.
    - Can wait up to 4 years from filing date before requesting examination.
- Focus 20 claims on distinct inventions to provoke restriction requirements.
    - If a RR issues, you can expand your elected claim group back up to 20 claims without penalty.

Double Patenting Risks

- Canada vs. U.S. Differences:
  - No terminal disclaimers for obviousness-type double patenting.
  - Divisional apps must address unity objections (cannot extend protection).
- Best Practices:
  - File any U.S. CIPs within 12 months of parent publication (grace period).
  - Ensure non-overlapping claims in parent/divisional applications.
  - Best to file with many claims for later divisional support.

Patent Term Adjustment (PTA) Rules

Eligibility for PTA

- Filed after Dec 1, 2020.
- Issued after “5/3 threshold”:
  - Later of:
    - 5 years from filing, or
    - 3 years from exam request.

Calculating PTA

- Begins accruing after the 5/3 threshold (later of: filing+5 or exam+3)
- Excludes OA response times, applicant delays
- Excludes any period after:
  - First RCE
  - Third OA

Maximizing PTA

- Defer examination requests to minimize applicant delays.
    - PPH may also be available after 4 years.
- Avoid RCEs through early claim amendments.

“Due Care” Standard

Matco Tools Corporation v. Canada Attorney General (2025 FC 118)

- First litigation of "due care" standard for reinstatement of abandoned application.
- Facts:
  - 3rd-party service provider handling maintenance fees.
  - When Matco switched providers, a "data migration error" resulted in the application being omitted from the new provider's system.
  - Maintenance fee was not paid as a result.
  - The Patent Office denied the reinstatement request.

Matco Tools Corporation v. Canada Attorney General (2025 FC 118)

- Holding:
  - Federal Court reversed the Patent Office’s decision for failing to consider the entire chain of events, in particular the proximate cause (the data migration error).
  - 2-stage framework:
    - Due care must be assessed both before and after the missed deadline.
    - If due care was taken at either stage, reinstatement may be warranted.

Matco Tools Corporation v. Canada Attorney General (2025 FC 118)

- Practice lessons:
    - Documentation of good faith efforts make a difference.
    - Use compliance checklists.
    - Document all fee payments and instructions received and sent.
    - Implement redundant docketing systems.

Matco Tools Corporation v. Canada Attorney General (2025 FC 118)

- Practice lessons:
  - If a deadline is missed, promptly and diligently take all reasonable actions to remedy the situation before the application is officially deemed abandoned, e.g.:
    - Correct the issue (pay the fee, respond to the communication).
    - Document the steps taken.
    - Submit a detailed reinstatement request with supporting evidence.

IP Subsidy Programs

Federal IP Funding

- Programs for Canadian SMEs:
  - IP Assist (NRC IRAP): Up to CAD $20k for IP strategy
  - Innovation Asset Collective: Membership credits for filings
  - ElevateIP: Grants for patent/trademark filings via business accelerators
- Eligibility
  - SMEs (<500 employees) with Canadian operations

Ontario (Provincial) IP Funding

- Intellectual Property Ontario (IPON):
  - Funding: Up to $35k (initial) or $100k (future)
  - Coverage: 80% of IP drafting/filing costs
- Eligibility
  - SMEs with Ontario operations (<500 employees)
  - IP rights intended for commercialization in Canada
  - Demonstrate potential benefits to Ontario

Advising Clients on IP Funding

- Use Canada/Ontario based patent agents/attorneys for funded work.
- Maintain clear chains of authority.
- Align funding applications with provincial economic priorities.

Key Takeaways

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- Trim claims early to avoid excess fees.
- Align divisional strategies with Canadian double patenting rules.
- Leverage IPON/federal funding for Canadian operations.
- Document workflows and good faith efforts to meet “due care” standards.

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Thank you for your interest.

Questions?

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