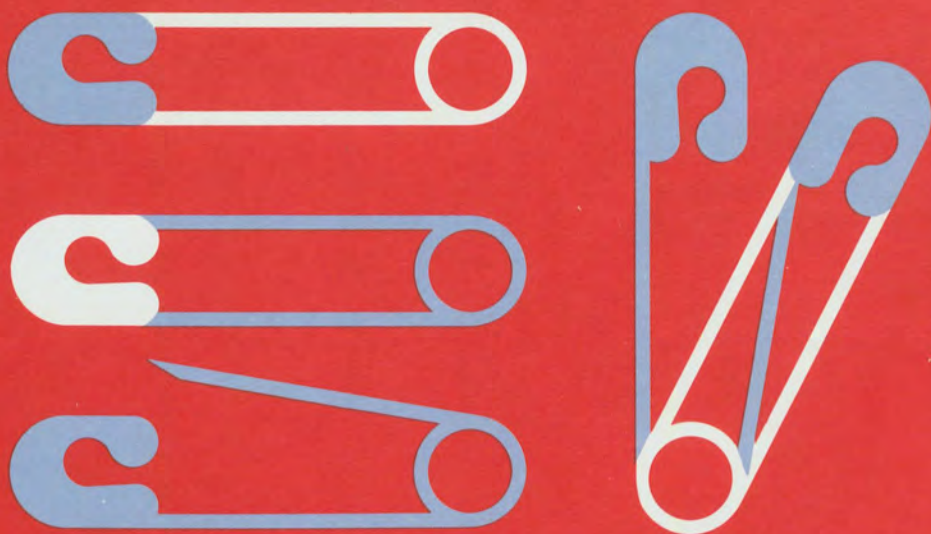


Patents: Questions and Answers



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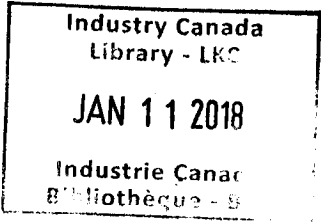
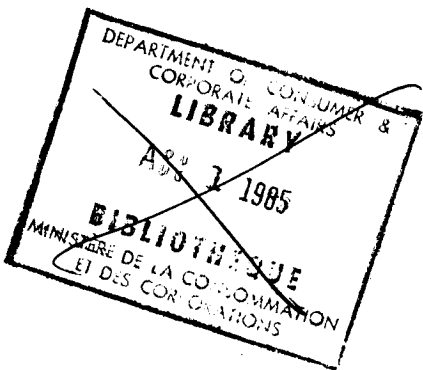
Consumer and
Corporate Affairs
Canada

Bureau of
Corporate Affairs

Consommation
et Corporations
Canada

Bureau des
corporations

Questions and answers
about patents for inventions



To assist inventors and the public, the Canadian Patent Office has assembled answers to the following questions often put to it about patenting inventions in Canada.

1

Q. What is a patent?

- A. A patent is a grant by the Government of Canada giving a patentee the right to exclude others from making, using or selling his or her invention within Canada.

2

Q. What is a patentable invention?

- A. A patentable invention is any new and useful process, machine, manufacture or composition of matter or any new and useful improvement thereof, which shows inventive ingenuity.

3

Q. What subject matters are dealt with by Copyrights, Industrial Designs and Trade-marks rather than by Patents?

- A. Copyrights deal with original literary, musical, dramatic and artistic works. The term of a Copyright is for the life of the author plus 50 years. Industrial Designs deal with ornamentation of any article of manufacture. This includes any shape, feature or ornamentation, the object of which is an aesthetic effect. Functional or utilitarian features may not be the subject of an Industrial Design. The term of an Industrial Design is for five years and is renewable for an additional five years but no longer. Trademarks deal with marks used to distinguish a particular article or service from other similar articles or services. The term of a Trademark is for 15 years and is renewable every 15 years indefinitely.

4

Q. How long is a patent effective?

- A. Seventeen years from the date on which it is issued.

5

Q. Once a patent has been issued, are any further fees required to keep it in force?

- A. No. Once a patent has been issued, it remains in effect for 17 years without the payment of any additional fees.

6

Q. May the term of a patent be extended?

- A. No. There is no provision in the Patent Act to extend patents beyond the 17-year term.

7

Q. After a patent has expired, has the patentee any exclusive rights in the invention?

- A. No. After a Canadian patent has expired, anyone may make, use or sell the invention in Canada provided they do not infringe other patents.

8

Q. Does a Canadian patent protect an invention in foreign countries?

- A. No. Protection in foreign countries can only be secured by obtaining patents in such countries.

9

Q. Do foreign patents protect an invention in Canada?

- A. No. Protection in Canada can only be secured by obtaining a Canadian patent.

10

Q. If I wrote an article that was published in a magazine, and that described my invention, could I still obtain a patent?

- A. A patent may be granted provided the invention has not been described in any patent or publication printed anywhere in the world more than two years before an application for a patent is filed. The invention also should not have been in public use or on sale in Canada more than two years before an application is filed.

11

Q. What subject matter is unpatentable?

- A. Some things which are not normally patentable are:
- (a) an improvement to a known device which improvement would be obvious to a person skilled in the art;
 - (b) a device or material whose only difference from older devices is a mere change in size, shape or degree;
 - (c) a device which has an illicit object in view;
 - (d) a device which has no use;
 - (e) an inoperative device;
 - (f) printed matter (this may be subject to copyright protection);
 - (g) a mere idea or suggestion;
 - (h) a scientific principle;
 - (i) a method of doing business;
 - (j) a new variety of horticultural plant;
 - (k) new works of art;
 - (l) a method of treating patients;
 - (m) trade marks;
 - (n) recipes for dishes or drinks;
 - (o) designs;
 - (p) the discovery of a naturally occurring substance;
 - (q) a computer program per se;
 - (r) a process (or the product of a process) that depends entirely on artistic skill and leads to an ornamental effect.

12

Q. Who may obtain a patent?

- A. Any inventor or any person who derives title in the invention from the inventor may obtain a patent by complying with the requirements of the Patent Act.

13

Q. Who may file an application for a patent?

- A. Any inventor or assignee of an inventor may file an application.

14

Q. When is a representative for service required?

- A. An applicant for patent who is not a resident in Canada, or does not maintain an address in Canada, must, at the time of filing an application, nominate a Canadian resident to act as representative for service. This representative is the person upon whom notice of proceedings will be served when the patent issues. The representative for service does not act as agent for the prosecution of the application before the Patent Office unless such representative is also a Registered Canadian Patent Agent appointed to act as patent agent for the application. If the representative is not the person filing the nomination, there must be a signed statement from the representative accepting the nomination.

15

Q. How does one obtain a Canadian patent?

- A. By making a proper application to the Commissioner of Patents, Ottawa, K1A 0E1 Canada. The application will be examined to determine if it is patentable.

Q. Should one prepare one's own patent application?

- A. As the preparation and prosecution of patent applications is quite complex it is recommended that inventors consult a Patent Agent trained in this specialized practice and registered to practice before the Canadian Patent Office to do this work. A list of Registered Agents living in any particular region in Canada may be obtained free of charge by writing to the Commissioner of Patents. Unregistered agents frequently advertise their services, but they are not authorized to practice before the Canadian Patent Office. They are not subject to Patent Office discipline, and the Office cannot help inventors in dealing with them.

Q. What does the term "patent pending" mean?

- A. It is used to inform the public that an application for patent is on file in the Patent Office. By itself it has no legal significance nor does it mean that a patent will necessarily be granted. Until a patent is granted for it, an invention may be used by others.

Q. What papers are required when filing a patent application?

- A. A petition, an abstract, a disclosure, a drawing if the invention can be illustrated, claims and a filing fee.

Q. What is a petition?

- A. This is the formal request made by the inventor or the inventor's assignee for the grant of a patent. An example of a petition form is shown in form 1 of the Patent Rules.

Q. What is an abstract?

- A. An abstract is a condensation of the technical content of the disclosure and should include the advance made in the art and the utility of the invention. It should consist of a single paragraph of 50 to 250 words. An example of an abstract is shown in form 24 of the Patent Rules.

Q. What is a disclosure?

- A. The disclosure is a written description of the invention. An example of the type of disclosure required is shown in form 24 of the Patent Rules.

Q. What are claims?

- A. A claim in a patent is a distinct and explicit statement of what the invention is. It is not a listing of the advantages and benefits flowing from the invention. The wording of the claims determines the extent of protection granted by the patent. An example of claims is shown in form 24 of the Patent Rules.

Q. How can I get a copy of the Patent Act and the Patent Rules?

- A. Copies of both the Patent Act and the Patent Rules can be purchased from the Canadian Government Publishing Centre, Mail Order Section, Supply and Services Canada, Hull, Québec, K1A 0S9. Prices may be obtained on request.

Q. What are the Patent Office fees for obtaining a patent?

- A. The fees are as follows:
1. On filing an application for patent: \$200.00
 2. For grant of a patent: \$350.00 plus
For each page of specifications and drawings in excess of 100: \$2.00 per page

Sometimes additional fees are required, such as completion fees. See Schedule 2 of the Rules. (Fees subject to change without notice.)

Q. Are drawings necessary?

- A. If the invention can be illustrated in a drawing, a drawing must be filed.

Q. Is a model of the invention necessary?

- A. Models are not to be submitted unless requested by the Patent Office. They are seldom required.

Q. It is advisable to conduct a search of prior patents before applying for a patent?

- A. Yes. It may be found that the invention is claimed in some prior patent. In such case a patent could not be granted. A search may save the expense of filing an application which would be rejected. If an invention is shown (without being claimed) in patents or other publications more than two years before the application for patent, it also would be refused.

Q. Where can a search be made?

- A. At the Patent Office, Consumer and Corporate Affairs Canada, Place du Portage, Tower 1, 50 Victoria St., Hull, Québec. Direction will be given to an inventor as to where a search should be made.

Q. If I make a search of the Patent Office records and find no patents the same as my invention, can I be certain that I will be granted a patent and that I can put my invention into commercial use without infringing any patents?

- A. No. Searching the prior art is a skilled job requiring experience. It may be that you have failed to recognize the significance of certain prior patents. If you file an application for a patent, the worst that can happen is that your application will be rejected. However if you intend to put your invention into commercial use without applying for a patent, you should first consult a Registered Patent Agent in case you infringe existing patents.

Q. Is there a fee required to make a search of the Patent Office records?

- A. No. Any individual may make a search free of charge.

Q. Can I make a search of Canadian patents without visiting the Patent Office?

- A. There are two ways this can be done.
- (a) A Registered Patent Agent will search the prior patents for you. The agent will, of course, charge a fee for this service.
 - (b) By writing to the Commissioner of Patents, you can obtain a list of all the patents issued on whatever subject you specify. Using this list you can order duplicates of the actual patents, as either paper or microfiche copies from Micromedia Ltd., 165 Hotel de Ville, Hull, Québec, J8X 3X2. Paper copies of patents cost \$3.20 each; microfiche copies of any patents cost \$2.00 each plus Province of Québec sales tax.

To help you determine which patents to purchase, you may consult the weekly publication, the Patent Office Record, which up to April 1, 1976, published abstracts of all patents granted the previous week. The Patent Office Record is available in most larger public libraries.

Q. Can anyone make a search of the Patent Office records for research or purposes other than patenting?

- A. Yes. You are welcome to search the Patent Office files of Canadian and foreign patents for any purpose. However, copies of foreign patents that are filed by number rather than subject matter may be inconvenient to search.

Q. How may I purchase copies of the Patent Office Record?

- A. The Patent Office Record is available from the Canadian Government Publishing Centre, Ottawa, K1A 0S9. The Canadian subscription price is \$63.00 a year for 52 issues or \$1.25 a copy.

Q. Does the Patent Office conduct searches at the request of private individuals?

- A. No, but the Patent Office will assist searchers by advising what parts of the official records should be searched.

Q. Will the Patent Office advise me if my invention is patentable and whether I should file an application?

- A. No. Regulations prohibit the Patent Office from expressing an opinion on an invention until a formal application is filed. A Registered Patent Agent should be consulted.

Q. What is a caveat?

- A. If an inventor has not yet completed an invention, and is concerned that others might patent it, a description of the invention insofar as it has been developed, may be filed with the Patent Office. The document filed is known as a caveat. The caveator will be informed should any one else file an application to patent the same invention in the year immediately following the filing of the caveat. The caveat may also have some value in proving when the invention was made. However a caveat does not give the inventor any right to exclude others from using the invention. Entitlement to any exclusive rights to the invention does not take place until the inventor has filed an application for patent and been granted a patent. A caveat is not an application for patent and its value is limited.

37

Q. What happens when two inventors apply separately for a patent for the same invention?

A. The Patent Office will determine who is the earlier inventor, based on evidence submitted by the inventors, and grant the patent to the first inventor.

38

Q. When should I apply for a patent?

A. In view of the possibility of another inventor filing an application for the same invention, application should be made as soon as the invention has been completed. Furthermore, if the invention becomes known, is used, or is described in a publication two years before the application is filed, a patent will not be granted.

39

Q. If two or more inventors work together to make an invention, to whom will the patent be granted?

A. If each had a share in the ideas forming the invention, they are joint inventors and should file a joint application. The patent will be issued to them jointly.

40

Q. If one person, after furnishing all of the ideas to make an invention, is employed by another person or such other person finances the building and testing of the invention, should they file a joint application?

A. No. The application must be filed giving the name of the inventor, that is, the person who furnished the ideas. However it may be filed by the employer as assignee of the inventor if accompanied by evidence of assignment. The employer would own the invention if the inventor was engaged to make inventions, or had agreed in any contract of employment to assign inventions to the employer.

41

Q. If anyone finds out about an invention on sale in a foreign country but which has never been patented, described or offered for sale in Canada, could that person obtain a patent for it?

A. No. A patent may be obtained by the true inventor only or legal assignee, and not by someone who has learned of the invention of another.

42 (A)

Q. Must an inventor who wishes to obtain a patent in a foreign country apply for a patent in Canada first?

A. No. Unless, as in the case of war inventions, disclosure of the invention would contravene the Official Secrets Act, the inventor may apply in any country. Also Public Servants may not file without official consent.

42 (B)

Q. Can an inventor who has applied first in other countries obtain a patent in Canada?

A. Yes. However, application must be made in Canada before any foreign patent has been granted, or, if such patent has been issued, application in Canada must be made within 12 months of the first foreign application.

43

Q. May a patent be granted if the inventor dies before filing an application?

A. Yes. The application may be filed by the inventor's personal representatives, e.g. executors or heirs.

- Q. May the right to a patent application be sold or transferred by the inventor?*
- A. Yes. The inventor may sell all or part of his or her interest in his or her patent or application by assignment. The application must give the name of the inventor and include the document assigning the invention to the new owner. (See Question 41). Examples of assignment forms are shown in forms 25 to 29 of the Patent Rules.

- Q. Does the Patent Office assist inventors to develop and market their inventions?*
- A. No. However some provincial agencies may provide limited marketing assistance. If an applicant states, when paying the fee for grant of a patent, that the applicant wishes to make it available for licence or sale, this fact will be noted in the Patent Office Record, free of charge, when the patent issues.
At any time during the life of the patent, if the patentee wishes to make it available for licence or sale, a notice to that effect will be published in the Patent Office Record for a fee of \$10.00.

- Q. May Canadians who own patents in foreign countries obtain assistance in marketing their patents abroad?*
- A. Assistance may be provided by Canadian Trade Commissions in foreign countries to Canadians who wish to licence their foreign patents in those countries. Enquiries should be addressed to the Business Centre, Department of Industry, Trade and Commerce, 235 Queen St., Level 01, Ottawa, K1A 0H5.

- Q. May Canadian patents owned by foreigners be licenced to Canadian manufacturers?*
- A. Yes. Canadian manufacturers may obtain information on patents available for licence by writing to the Business Centre, Department of Industry, Trade and Commerce, 235 Queen St., Level 01, Ottawa, K1A 0H5 or to the patentee.

- Q. Does a patent provide protection against charges by other persons that the patentee, in making, using or selling the patented invention, is infringing other patents owned by such other persons?*
- A. No. There may be in existence other basic patents over which the new invention is an improvement. In this case the new inventor would infringe the basic patents and could not make, use or sell the new invention without the consent of the owners of the basic patents. Similarly others may not use the new invention without the consent of the patentee even though they make improvements to it. As questions of infringement and validity of patents are often complex, the advice of a Registered Patent Agent should be sought.

- Q. Does the Patent Office help a patentee prosecute others if they infringe the patentee's rights granted by his patent?*
- A. No. If a patent is infringed the owner may sue the infringer in the courts. The protection of rights under a patent is the responsibility of the patentee.

- Q. Is there any government guarantee that a patent is valid?*
- A. No, but all patents are legally presumed valid until proven otherwise.

Q. How soon after an application is filed will a patent be granted?

- A. That will depend on how well the application is prepared, whether there are prior patents for very similar inventions, whether any other person files an application for the same invention, and upon other factors. The average time from the filing of an application to the granting of a patent is about two and a half years. Sometimes applications may issue within a year. If several inventors have filed applications for the same invention, issuance of a patent will be delayed until it is decided who was the first inventor.

Q. Is there any way to hasten the prosecution of an application?

- A. An inventor may request a Special Order under Rule 39 of the Patent Rules. The application will be advanced out of routine order for examination if the patentee can satisfy the Commissioner of Patents, by affidavit, that any delay in the granting of a patent would prejudice such inventor's rights, or would not be in the public interest. Of course there may still be delays in getting a patent if unusual prosecution problems develop. There is a special fee required when requesting a Special Order.

Q. Is it necessary to visit the Patent Office in Ottawa to prosecute an application?

- A. No. Business with the Patent Office is conducted by correspondence. Interviews with examiners can be arranged if necessary, but prosecution must be conducted in writing.

Q. After an applicant files an application in the Patent Office, may the applicant write directly to the Patent Office about the application?

- A. The Patent Office will answer enquiries from an applicant about the status or progress of the application if a Patent Agent has not been employed. If an agent has been employed, all correspondence must be conducted through the agent.

Q. Will the Patent Office disclose an invention to others before a patent issues?

- A. No. All Patent Office personnel are sworn not to divulge any information about patent applications to the public. No information about patent applications is available to the public until a patent issues.

Q. After an application is filed, may changes be made to it?

- A. Errors may be corrected but no new matter may be introduced. The claims may be altered any time before allowance so long as they are supported by the original description of the invention.

Q. What recourse is available if an examiner refuses to grant a patent on an application?

- A. The applicant may request the Commissioner of Patents to review the action of the examiner. If this review also results in a refusal to grant a patent, the applicant may appeal to the Federal Court.

Q. If a patentee has a patent for a new product and a new process for making the product, would this prevent another person who invented a new and different process for making the product from obtaining a patent?

A. No. The other person may obtain a patent for the new process. Such other person will not however obtain a patent for the product and cannot use the new process to make the product without a licence to do so.

Q. Can a patentee who has a patent covering a product prevent another person from importing the product into Canada?

A. Yes. The patent grants the right not only to exclude others from making but also from using and selling the invention in Canada.

Q. Can an invention be withheld from the market by a patentee?

A. While a patentee is not required to market an invention in Canada, failure to do so may constitute abuse of patent rights enabling others to apply to the Commissioner of Patents for a compulsory licence to use the patent, or the patent may, in some circumstances, be revoked. A compulsory licence may be granted to import or sell medicines manufactured abroad, in the production of which the invention has been used. A compulsory licence may also be granted to use a patent for an invention capable of being used in the production or preparation of food.

Q. How can I obtain the addresses of foreign Patent Offices?

A. The Commissioner of Patents will supply available addresses on request.

Q. How may I telephone the Patent Office?

A. The Patent Office telephone number is (819) 997-1936.

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