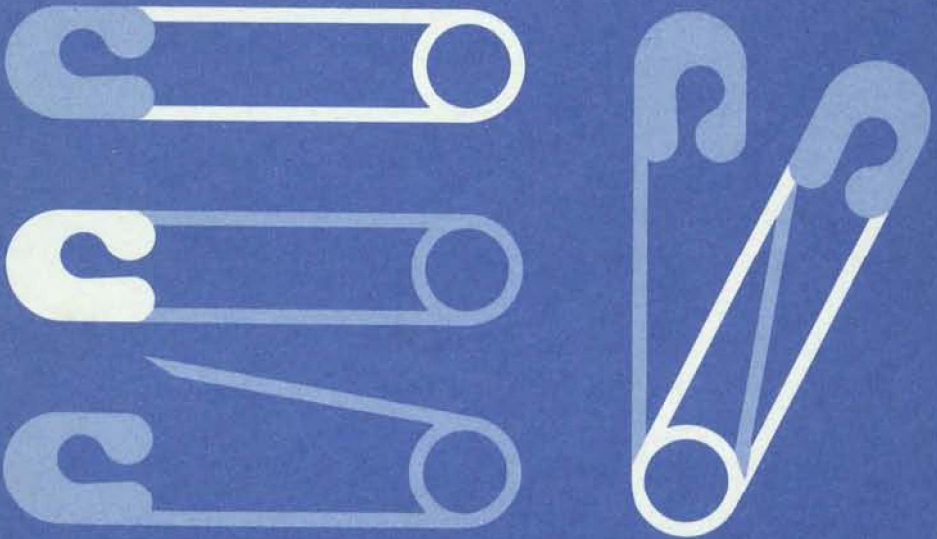


Patents: Questions and Answers



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1986



Consumer and
Corporate Affairs
Canada

Bureau of
Corporate Affairs

Consommation
et Corporations
Canada

Bureau des
corporations

Questions and Answers
about Patents and Inventions

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Table of Contents

PAGE

Definitions/Subject Matter	3
Rights and Benefits	3
Precautions	5
Searching	6
Prosecution	7
Marketing/Licensing	9
Foreign Protection	10
Fees	11
General Enquiries	11
A Wealth of Technological Information	12
Glossary	13

Definitions/Subject Matter

1

Q. What is a Canadian patent?

- A. A Canadian patent is a document by which the government grants an inventor the right to exclude others from making, using or selling an invention within Canada for a period of 17 years. The inventor, for his or her part, must fully describe the invention. This disclosure facilitates the dissemination of technological information and promotes the use of the invention.

2

Q. What types of subject matter are dealt with by copyright, industrial design and trade marks rather than by patents?

- A. Copyright deals with original literary, musical, dramatic and artistic works. The term of a copyright is for the life of the author plus 50 years. Industrial design deals with the appearance or visual design aspects of any article of manufacture. This includes any shape, feature or ornamentation, the object of which is an aesthetic effect. Functional or useful 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 only. A trade mark is a word, symbol or picture, or any combination thereof, used to distinguish the goods or services of a person or organization from the goods or services of others in the marketplace. The term of a trade mark is for 15 years and is renewable every 15 years, indefinitely.

3

Q. What is a patentable invention?

- A. A patentable invention is any new and useful process, machine, method of manufacture or composition of matter, or any

new and useful improvement thereof, which is not obvious to someone skilled in the particular field (i.e., which shows "inventive ingenuity").

4

Q. What subject matter is unpatentable?

- A. Among the things which are not normally patentable are an improvement to a known device which would be obvious to a person skilled in the art, a principle, a recipe, a design, a computer program, an idea or a process (or the product of a process) that depends entirely on a person's skill and leads to an ornamental effect.

Rights and Benefits

5

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.

6

Q. After a patent has expired, has the patentee any exclusive rights with respect to the invention?

- A. No. After a Canadian patent has expired, anyone may exploit the invention in Canada.

7

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

- A. It is used to inform the public that an application for a patent is on file in the Patent Office. There are no exclusive rights associated with the term, nor does it mean that a patent will necessarily be granted. An invention may be exploited by others until a patent is granted.

8

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

A. Based on the evidence submitted by the inventors, the Patent Office determines who is the first inventor and grants the patent accordingly.

9

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.

10

Q. Should a person who supplies all of the ideas to make an invention while employed by another person file a joint application?

A. No. The application can be filed in the name of the inventor, that is, the person who supplied the idea. However, it may also be filed in the name of the employer as the assignee of the inventor if accompanied by evidence of assignment. The employer would, in effect, own the invention if the inventor was hired to make inventions or had agreed in any contract to assign inventions to the employer.

11

Q. May more than one patent be granted, to more than one individual, for two processes which produce the same product?

A. Yes. However, the individual who obtains the first patent will own the patent rights for the product. The second applicant may obtain a patent for the new process but cannot use the new process to make the product without a licence to do so.

12

Q. Does a patent provide protection against charges of infringement?

A. No. A patent only grants the inventor the right to prevent others from making, using or selling his or her invention. As questions of infringement and validity of patents are often complex, the advice of a registered patent agent should be sought.

13

Q. Does the Patent Office help a patentee prosecute infringers of a patent?

A. No. The protection of rights under a patent is the responsibility of the patentee.

14

Q. Is there any government guarantee that a patent is valid?

A. No. However, all patents are legally presumed valid until proven otherwise.

15

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

A. No. All Patent Office personnel have taken an oath not to divulge any information on or contained in a patent application until a patent issues.

16

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

A. Yes. A patent grants the right to exclude others from exploiting an invention in Canada for a period of 17 years.

17

- 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 an abuse of patent rights. Such an abuse would enable others to apply to the Commissioner of Patents for a compulsory licence (see Glossary) to use the patent.

18

- Q. *What are the benefits of a patent?*
- A. (a) A patent provides legal proof of ownership of an invention.
(b) A patent will help the patentee to profit by his or her invention. A patentee can sell the patent rights, license the rights for royalties and use the patent as collateral.
(c) A patent enables a potential licensee to identify and contact the owner of the patent.
(d) A patent increases a patentee's credibility with lenders and prospective partners and, in general, helps the patentee to get the necessary resources to work the invention.
(e) A patent is a tool which helps patentees keep the market for their invention to themselves for 17 years. It can be used to deter and prosecute infringers.
(f) Patents are a unique vehicle for the dissemination of technological information, and thus can help one to keep abreast of developments in any given field of technology.
(g) Patents aid in the search for solutions to technical problems and products to manufacture or market.

Precautions

19

- Q. *If an inventor wrote an article describing his or her invention, and the article was published in a magazine or a newspaper, might the inventor still obtain a patent?*
- A. Yes. A patent may be granted in Canada provided the invention has not been described in any publication, including patent documents, printed anywhere in the world more than two years before an application for a patent is filed. The invention should also not have been in public use or on sale in Canada for more than two years before an application is filed.

20

- Q. *When should the inventor 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. If the invention has not been completed, a caveat may be filed with the Patent Office.

21

- Q. *What is a caveat?*
- A. A caveat is a description of an invention insofar as it has been developed; this document is filed with the Patent Office. The caveator will be informed should anyone else file an application to patent the same invention in the year immediately following the filing of the caveat. (See Glossary.)

Q. How soon should a patents search be done?

- A. A preliminary search of existing patents should be conducted prior to filing for a patent. This will determine if one's invention or a similar one has been patented before.

23

Q. What are the main steps that should be followed to patent an invention?

- A. (a) An invention should be kept confidential. Telling other people about an invention may prevent the inventor from getting a patent, especially if he or she is filing in some foreign countries. In Canada, the inventor has two years to file for a patent after making the invention public.
- (b) Detailed notes should be made which are written, dated and witnessed in confidence.
- (c) It is recommended that an inventor see a registered patent agent to help ensure a sound patent application. One should beware of non-registered agents. (See Question 33.)
- (d) If patent protection in other countries is wanted, it is strongly recommended that one not publicize the invention before filing for a patent.
- (e) If the invention is not yet perfected and the inventor intends to apply for a patent, it is recommended that a caveat be filed. (See Question 21.)

Searching

24

Q. Is it advisable to conduct a search of prior patents before applying for a patent?

- A. Yes. The invention may be disclosed in some prior patent, in which case a patent could not be granted. A search (see Glossary) may save the expense of filing an application which would be rejected.

25

Q. Where are searches conducted?

- A. At the Patent Office, Consumer and Corporate Affairs Canada, Place du Portage, Tower 1, 50 Victoria Street, Hull, Québec.

26

Q. If one makes a search of the Patent Office records and finds no similar patents, can one be certain of obtaining a patent and being able to put one's invention into commercial use without infringing any existing patent?

- A. No. Searching the prior patents is a skilled job requiring experience. It may be that the inventor has failed to recognize the significance of certain prior patents. If the inventor files an application for a patent, the application may be rejected. However, if the inventor intends to put the invention into commercial use without applying for a patent, he or she should first consult a registered patent agent (see Glossary), who will help the inventor avoid patent infringement.

27

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

- A. No. Any individual may make a search in the Patent Office files free of charge.

Q. Can a search of Canadian patents be made without visiting the Patent Office?

A. Yes. There are several ways this can be done.

- (a) A registered patent agent will conduct searches of prior patents. The agent will, of course, charge a fee for this service.
- (b) One can obtain a list of all the patents issued on whatever subject one specifies by writing to the Commissioner of Patents, Ottawa, Ontario K1A 0E1. Using this list one can order duplicates of the actual patents, in either paper or microfiche form, from Micromedia Ltd., 165 Hôtel-de-Ville, Hull, Québec J8X 3X2. A paper or microfiche copy of any patent is available for a nominal fee.

To determine which patent documents to purchase, one may also consult the *Patent Office Record*, a weekly publication which is available in most larger public libraries. The *Patent Office Record* is also available from the Canadian Government Publishing Centre, Ottawa, Ontario K1A 0S9. The Canadian subscription price is \$63.00 a year for 52 issues, or \$1.25 a copy.

- (c) Small and medium-sized Canadian manufacturers may also wish to take advantage of the Patent Information Exploitation (PIE) Program. Following a request for information in a specific field of technology, the Patent Office will provide a selection of the most relevant patents. Requests must be made through a designated organization that deals primarily with small business. A list of these organizations, or "intermediaries" (see Glossary), is available from the Patent Office.

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

A. Yes. The public is welcome to search the Patent Office files of Canadian and foreign patents for any purpose.

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

A. The Patent Office will assist searchers by advising them of which parts of the official records should be searched. It will also conduct a state-of-the-art search upon request from a regional or provincial intermediary. Contact the Patent Office for more details.

Prosecution

Q. What does the term "prosecution" mean with respect to a patent application?

A. The prosecution of a patent application involves all of the actual steps that must be undertaken by an inventor in order to obtain a Canadian patent through the Patent Office.

Q. How does one obtain a Canadian patent?

A. By making a proper application to the Commissioner of Patents, Ottawa, Ontario K1A 0E1. The application will be examined to determine if the invention described 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 registered patent agent. A regional or national list of registered agents may be obtained free of charge by writing to the Commissioner of Patents. One should beware of unregistered patent agents; though they frequently advertise their services, they are not authorized to practice before the Canadian Patent Office and are not subject to Patent Office discipline.

- Q. What papers are required when filing a patent application?*
- A. In addition to payment of the filing fee, a petition, an abstract, a disclosure, a drawing if the invention can be illustrated and claims are required. (See Glossary for details.)

- 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. How soon after an application is filed will a patent be granted?*
- A. That will depend on many factors, including how well the application is prepared, whether there are prior patents for very similar inventions and whether any other person files an application for the same invention. The

average time from the filing of an application to the granting of a patent is about two and a half years. Sometimes a patent is issued within a year. If several inventors have filed applications for the same invention, the patent will not be issued until it is decided who was the first inventor.

- Q. Is there any way to hasten the prosecution of an application?*
- A. Yes. An applicant may, upon payment of a special fee, request a Special Order under Rule 39 of the Patent Rules. The application will be advanced out of routine order for examination if the applicant can satisfy the Commissioner of Patents, by affidavit, that any delay in the granting of a patent would prejudice such applicant's rights or would not be in the public interest.

- Q. Is it necessary to visit the Patent Office to prosecute an application?*
- A. No. Business with the Patent Office is conducted by correspondence. Interviews with examiners can be arranged if necessary, but the prosecution of the patent must be conducted in writing.

- Q. After filing an application, 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.

41

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 (see Glossary) if they are supported by the original description of the invention.

42

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

- A. The applicant may request that the Commissioner of Patents 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.

Marketing/Licensing

43

Q. May the right to a patent or to a patent application be sold or transferred by the inventor?

- A. Yes. Inventors may sell all or part of their interest in their patent or application by assignment (see Glossary).

44

Q. Does the Patent Office assist inventors to develop and market their inventions?

- A. No. However, some provincial agencies and a network of intermediaries may provide marketing assistance. When paying the fee for grant of a patent, if the applicant wishes to make the patent

available for licensing or sale, this will be noted in the *Patent Office Record*, free of charge, when the patent issues.

If the patentee wishes to make the patent available for licensing or sale at any time during the life of the patent, a notice to that effect will be published in the *Patent Office Record* for a fee.

45

Q. May Canadians who own patents in foreign countries obtain assistance in marketing their patents abroad?

- A. Yes. Assistance may be provided by Canadian Trade Commissions in foreign countries to Canadians who wish to license (see Glossary) their foreign patents in those countries. Enquiries should be addressed to the Office of Industrial Innovation, Department of Regional Industrial Expansion, 235 Queen Street, Ottawa, Ontario K1A 0H5.

46

Q. May one license one's patent rights?

- A. Yes. If a patentee wishes to retain the rights to a patent but wants to allow another person to use it, he or she may grant a licence to that person. The terms of the licence can be very flexible, depending on the particular case.

47

Q. How can one sell the rights to one's patent?

- A. A patentee who wishes to sell the rights to his or her patent may do so by assignment. Where only a part interest in the patent is sold, the patentee will have no further interest in that portion.

Foreign Protection

48

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.

49

Q. Do foreign patents protect an invention in Canada?

A. No. Protection in Canada can only be secured by means of a Canadian patent.

50

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

A. No. A patent may be obtained only by the true inventor or the legal assignee.

51

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 for a patent in any country without applying in Canada.

52

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

A. Yes. However, allowing for exceptions, application must be made in Canada before any foreign patent has been granted.

53

Q. Can a Canadian file a patent application through the Patent Cooperation Treaty (PCT)?

A. Since Canada is not yet a member country of that treaty, Canadians cannot file patent applications through it. Only persons living in countries which are PCT members can avail themselves of the filing procedures under the treaty.

54

Q. May Canadian patents owned by foreigners be licensed to Canadian manufacturers?

A. Yes. These agreements must, however, be negotiated between the patent holder and the manufacturer. A registered patent agent should be consulted. The Office of Industrial Innovation, 235 Queen Street, Ottawa, Ontario K1A 0H5, maintains an up-to-date list of patents which can be licensed.

55

Q. How can one obtain the address of a foreign Patent Office?

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

56

Q. Should one disclose one's invention or parts of the invention before obtaining foreign patents?

A. No. In some countries, an inventor who publicly discloses an invention before filing for a patent may be prevented from obtaining a patent.

Fees

57

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

A. The fees are as follows:

1. On filing an application for a patent:
By a small entity \$150.00
By other than a small
entity \$300.00
2. For grant of a patent:
By a small entity \$350.00
By other than a small
entity \$700.00
Payment of additional fees, such as
completion fees, is sometimes re-
quired. See Schedule 2 of the
Patent Rules.

* Effective July 1, 1985. Fees subject to
change without notice.

58

Q. What is a "small entity"?

- A. The term "small entity" is used to
designate an independent inventor or a
small business concern. A small business
concern, in relation to an invention,
means a business whose gross annual
revenue is not more than \$2 million. It
does not include a business concern that
is engaged in:
- (i) manufacturing and employs more
than 100 employees, or
 - (ii) a sector other than manufacturing
and employs more than 50 persons.

General Enquiries

59

*Q. Will the Patent Office advise the inventor
if the invention is patentable and whether
he or she should file an application?*

- A. No. Regulations prohibit the Patent Of-
fice from expressing an opinion on an
invention until a formal application is
filed. A registered patent agent should
be consulted.

60

*Q. How may one contact the Patent Office to
obtain more information?*

- A. The telephone number of the Patent
Office is (819) 997-1936 and the mailing
address is:
The Patent Office
Enquiries Section
Consumer and Corporate Affairs
Canada
Ottawa, Ontario K1A 0E1

61

*Q. How can one 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 Cen-
tre, Mail Order Section, Supply and
Services Canada, Ottawa, Ontario K1A
0S9, or from any bookstore selling gov-
ernment publications. Prices may be
obtained on request.

A Wealth of Technological Information

The Patent Office is Canada's largest source of technological information. It contains over 1.2 million Canadian patents, 4.5 million U.S. patents and most of the patents from most industrialized countries. All issued patents, as well as some foreign patent applications, are open to public inspection.

The information contained in patents not only covers all fields of technology but may very well be the most up-to-date information in any given field. Indeed, it is estimated that about 70 per cent of the information contained in patents, depending on the technology, is unavailable elsewhere.

The technological information is detailed and practical to the point that a person who is skilled in that field of technology can work the invention from the information given. Care must be taken, of course, not to infringe other patents still in force.

Also included in the patent document is information concerning who owns the rights to any particular patent.

Why Use Patent Information

A search of patent documents enables one to:

- ☐ Keep abreast of developments in a given field of technology
- ☐ Avoid duplication
- ☐ Find solutions to technological problems
- ☐ Find products to manufacture or market
- ☐ Identify competitors, suppliers and customers
- ☐ Determine infringement and patentability situations
- ☐ Evaluate different technologies

Glossary

Abstract An abstract is a condensation of the technical content of the disclosure and should include a description of the advance made in the art and the utility of the invention. It should consist of a single paragraph of 50 to 250 words.

Allowance Allowance is the signing of an application by an examiner indicating that the examiner is satisfied that the application meets the requirements of the Patent Act and the Patent Rules.

Assignment An assignment is the vehicle through which the inventor sells all or part of his or her interest in the patent or in the application.

Caveat A caveat is a document filed with the Patent Office describing the invention as far as it has been developed. If the inventor has not yet completed the invention and is concerned others might patent it, this description filed as a caveat will ensure that the Patent Office will advise the inventor if anyone else files an application to patent the same invention within the year following the filing of the caveat. However, the caveat does not give the inventor any right to exclude others from making, using or selling the invention in Canada.

Claims A claim in a patent defines what the patentee has exclusive rights to. 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.

Compulsory Licence If a patent has not been worked in Canada within three years of issue, an application for a compulsory licence may be filed with the Commissioner of Patents. After a hearing is held, the Commissioner decides whether a licence should be given and, accordingly, sets the terms of the licence, including royalties. The compulsory licence thus helps to strike a balance between protecting the interests of inventors and encouraging economic development.

Disclosure The disclosure is a written description of the invention.

Intermediary An intermediary is any organization with which the Directorate of Intellectual Property enters into an agreement to provide assistance to those requesting technological information.

Licence A licence allows another person, other than the inventor, to use the invention, usually in return for payment of royalties. The rights under the patent are retained by the inventor.

Patent Pending This term is used to inform the public that an application for a patent is on file in the Patent Office. There are no exclusive rights associated with the term, nor does it mean that a patent will necessarily be granted.

Petition A petition is a formal written request signed by the inventor(s) or assignee which is submitted to the Commissioner of Patents, asking that a patent be granted for the invention claimed.

Prosecution The prosecution of a patent application involves all of the actual steps that must be undertaken by an inventor in order to obtain a patent through the Patent Office.

Registered Patent Agent A registered patent agent is a person who is trained in the specialized practice of patent law and who is registered to practice before the Canadian Patent Office after passing an examination set by the Commissioner of Patents.

Searching A search of patent documents means looking for any patented invention which may resemble one's invention. The searching is done through the "prior art," which is a collection of all the inventions in a particular class of patents.

Canada