



Innovation, Science and
Economic Development Canada
Canadian Intellectual Property Office

Innovation, Sciences et
Développement économique Canada
Office de la propriété intellectuelle du Canada

Canada

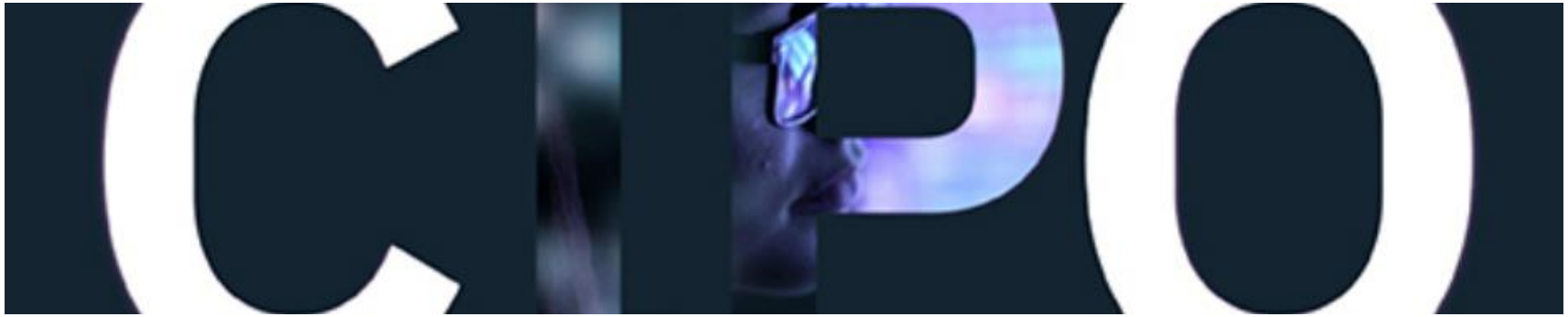
CIPO and the PLT

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Presentation Outline

- Background on CIPO
- Benefits to join PLT
- Timeline for CIPO's ratification to the PLT
- Gap analysis: necessary amendments to the Patent System
- Consulting with stakeholders
- PLT flexibilities and safeguards
- Implementation (IT, Training, Documentation, roadshow)
- Success Factors
- Lessons learned

Background on CIPO



Canadian Intellectual Property Office (CIPO) – Patent Branch

- International Search Authority (ISA) and International Preliminary Examination Authority (IPEA) since 2004

~40,000 national applications filed per year (80% PCT national entry)

~2000 PCT international applications received per year where CIPO acts as ISA/IPEA

~600 employees ~400 examiners

Benefits of joining PLT

- Harmonize and streamline administrative procedures
 - **Filing:** standardize and simplify requirements to obtain a filing date
 - lower cost
 - easier/quicker to get filing date
 - defined timelines for completing application/making corrections after initial filing date is secured
 - **Notification before Abandonment:** no loss of rights without first advising the applicant
 - e.g. maintenance fees – if not paid, notice will be sent for late payment before applications go abandoned
 - **Safeguards:** e.g. restoration of priority, late payments, filing without a description, reference filings, etc.
 - **Corrections:** clear guidelines on what can be corrected and when
 - Easier for both Office and applicants

Benefits of joining PLT

- Alignment with PCT and other Offices
 - Formalities
 - Similar safeguards
- Economic and trade benefits
- WIPO has a useful publication on the PLT which includes a list of benefits to developing countries: [WIPO.E](#)

CIPO's Timeline for Ratification of PLT



- **Ratified October 30, 2019**

Oct 30, 2019
Ratified
New Act and
Rules come
into force

May 2000
Diplomatic
Conference
– adoption
of PLT

May 2001
Canada
signed PLT

2014 Patent Act
amendments

2016-2019 Patent Rule amendments

2018-2019 Implementation

Initial activities

Preparing and Drafting New Patent Legislation Regime Changes

Finalizing New Patent Legislation Regime Changes and internal/external preparations

2002 2008 2013 2015 2016 2017 2018 2019

Stakeholder consultations

Info Sessions

Gap Analysis: Required Amendments to the Patent System

- Analysis to identify the changes that were required to be made to Canadian law and practice in order for Canada to comply with the Patent Law Treaty ([Patent Law Treaty - Changes Required to Canadian Law & Practice \(canada.ca\)](#))
 - Critical step prior to beginning work towards ratification
 - Main purposes
 - planning
 - realistic timelines
 - understanding impact on clients and office
 - Availability of assistance (other offices, WIPO) ([Patent Law Helpdesk for WIPO Member States](#))



Consulting with stakeholders

2000-
2002

- Prior to signing the PLT in 2001 and again following its signature in 2002 in respect of legislative amendments.

2008

- Online consultation on proposed amendments to the Patent Rules.

2013

- Targeted technical consultation with IP community on legislative amendments.

2014-
2015

- Amendments to the Patent Act.

2017

- Targeted technical consultations with IP community on regulatory amendments and user fees.

2019

- Amendments to the Patent Rules with formal public consultations.

Consulting with stakeholders

Result:

Joining the PLT and implementing it were positively received. From the viewpoint of inventors and businesses, the reduction of red tape, standardization and simplification of patent application administrative requirements led to a simpler way of filing, reduced risk of errors and loss of rights as well as lower costs.

Key considerations include:

1. Preparation of consultation documents and guidance (by topic)
2. Draft proposals for amendments to legislation and regulations
3. Capacity for office and stakeholders to implement (e.g. IT work)

Flexibilities in the PLT

- With the significant exception of filing date requirements, the PLT provides the maximum sets of requirements the office of a Contracting Party may apply. A Party is free to provide requirements that are less strict and more favourable to applicants and patent owners.
- When choosing requirements on specific topics, Offices should carefully consider the choices and which options are best for their specific circumstances.

Examples of Flexibilities in the PLT

- Restoration of priority
 - CIPO's choice - unintentional
- Restoration of rights after a failure to pay certain fees
 - CIPO's choice - due care
- Translations (not less than 2 months)
 - CIPO's choice – 2 months
- Paper communication
 - CIPO's choice – accept paper or electronic throughout prosecution

Use of PLT Safeguards

RARELY OR NEVER USED

- Number of reference filings (Act references) – not aware of receiving any since 2019
- Filing in a language other than Eng / Fr – 112 (Translations of description required)
- Missing parts - 60

USED, BUT NOT A LOT

- Restoration of priority 381
 - unintentional

USED MORE OFTEN

- Relief in respect of time limits (use of late period for fee payments)~28,000
- Restoration of rights after a failure to pay certain fees – 862
 - Refused due care – 287
 - Accepted due care – 47

What changed at CIPO?

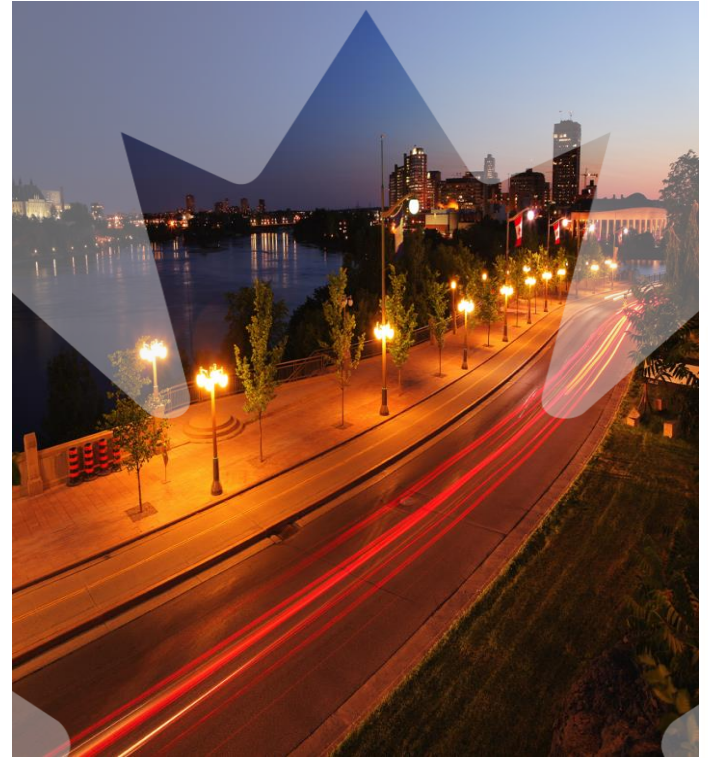
- The *Patent Act and Rules*
- CIPO's IT infrastructure
- Operations and examination procedures to align with the new Act and Rules
- Other tools, including:
 - Mappings & Work Instructions
 - Internal and External Manuals & Practice Notices
 - External Correspondence

Implementation

- Training/documentation/IT
 - Documented process 150+ updated
 - Basic training for examiners
 - Operations more detailed
 - IT – need to time it so that there is confidence in the regulatory changes before starting
 - Took opportunity to redo correspondence

CIPO Roadshow – Oct 2019

- In person information sessions for external stakeholders in 4 major Canadian cities just prior to PLT coming into force
 - Well attended by major Canadian firms
 - Presented every change that was coming, what they meant to stakeholders, took questions



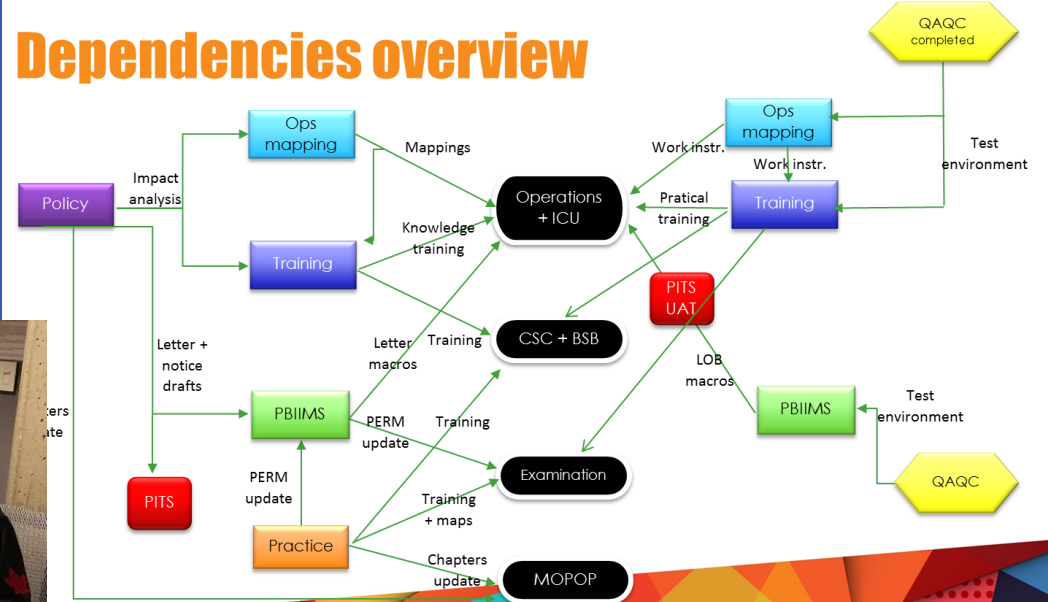
Success factor

Project management within Patents Branch



2020-04-29	Risk Name	Risk Description	Probability	Impact	Severity	Response Category	Risk Response
1	This document list, per team, risks that can block production of the patent	all deliverables/Implementing successfully the patent legislative change. It will also include risk posed by the project to the other activities					
2	Training	Loss of training designer and trainers	Low	High	Medium	Mitigate	1) two persons remaining in the pool of AD-03, 2) Can call expert from Operations to help with delivering of training.
3		Loss of expertise about the legislative change	Low	High	Medium	Mitigate	1) engagement of the Ops ICU WG, or other employees in the sections.
4		Conflicting priorities (other critical training project)	Low	Medium	Low	Accept	1) postpone non-critical training activities 2) engage team leaders and section expert to focus on training related to new issue
5		Lack of access to new IT environment to develop training	Medium	High	High	Mitigate	1) BR manager to follow up with PITS and CIO (meeting on 2019-05-06)
6		Lack of access to a computer training room	Low	Medium	Low	Accept	1) BR manager to follow up with PITS and CIO (update + access) 2) prepare for a plan B (classroom training (screenshot + videos)
7		CIPO only has training room C1288 set up with computers. They will not by default be set up with a training equipment for the new TechSource. Area 1425 is set up only with docking stations + 1 developmental	Medium	High	High	Mitigate	1) PERM coordinator to help with Cisc. letter 2) policy to develop more standard letters
8		CIPO's network infrastructure (switches, KVM, splics work on Ops letter (macro)	Low	Low	Low	Mitigate	1) call for developmental opportunity from within all CIPO
9	PITS	Loss of capacity and expertise	Medium	High	High	Mitigate	1) call for developmental opportunity from within all CIPO
10		Modifications required after Gazette 1	Low	Medium	Low	Accept	
11		Effect of Windows 10, new printers...	Low	Medium	Low	Accept	April: CIO agreed on a Windows 10 rollout

Dependencies overview







Factors of success: project management

- Project management -dedicated manager to PLT implementation (Sept. 2018)
- Overstaffed operations sector to allow employees to be involved in testing and training while not impacting regular workflow
- Impact analysis for all topics affected by PLT
- Timing was well planned
 - Transition of examiners to new Rules weeks before ratification to prevent downtime for examiners' reports
- Risks continuously monitored and mitigated


Success factor

- Change management








    **Brevets Patents** **Modifications législatives PLT implementation**


December 2018
Target implementation date: 2019-09-30

 This is the first monthly newsletter with updates on legislative changes to patents for the Operations Sector.

Why is it no longer referred to simply as the *Patent Law Treaty*? Because the legislative changes include changes for the implementation of the *Treaty*, but also other changes to increase the effectiveness of the patent system.

Image
 We created an image to make it easier to identify communications on this subject. The image consists of four components, each representing one aspect of the business readiness for the legislative changes (see right).

 Contenu des modifications What is changing
 Collaboration Internal actors
 Gestion du changement Change management
 Réalisations Accomplishments

IT Tests
 ISSED's IT Department finished developing the changes in *TechSource* and began tests on November 23, 2018. With regard to patents, the Patent IT Solutions Team is



Factors of the success: change management

- Training plan developed more than 2 years before ratification
- Communication plan developed 1 year before
- Communication and training were continuous
- Monthly internal bulletins beginning Dec. 2018 until after ratification
- Awareness presentations, quiz billboards, posters, etc.
- Training started April 2019 for operations sector

Success factor

- IT management



Factors of the success: IT management

- At ratification, the IT system at CIPO was not modern or easy to modify
- Additional resources were required
 - Consultant, students, examiners, new employees
- Timing was important
- Bugs and watch lists constantly being assessed and reprioritized when changes occurred

Lessons learned

- Carefully consider time required for entire process (planning to implementation)
- Analyse gap between national law and PLT at the outset
- Consider choices PLT flexibilities carefully
- Don't underestimate time required by stakeholders
- IT changes could be significant and may take more time than anticipated
- Have a dedicated program manager for implementation



Thank you

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