



It's Not a Question of Why – But Why Not File for a Patent in Canada?

As we look back at 2020, we can all agree that it presented constantly moving challenges for businesses. Unsurprisingly, at **Aird & McBurney LP**, we are seeing tech companies seizing opportunities to develop technologies aimed at solving real-time global problems in a variety of industries such as healthcare, biosciences, manufacturing, education, finance, retail and transportation. Tech companies continue to obtain and protect intellectual property rights as a strategic necessity for business. Patent portfolios are viewed as essential, regardless of whether vigorous enforcement is planned.

Of note, patent filings for technologies concerning smart connected objects and spanning the Internet of Things, big data, 5G and artificial intelligence (AI) have grown much faster than the average of all technology fields. With such rapid innovation, companies have been filing and obtaining patents as quickly as possible to maintain a competitive advantage.

Several big tech companies are situated in the United States and their numbers continue to grow. By virtue of sharing our southern border with the United States, Canada is the natural extension for filing corresponding Canadian patent applications for U.S.-based company technologies. There are several reasons that make this a good business choice.

Canada's infrastructure, laws and social attitudes embrace technology and patent protection of technology. We have a robust Canadian patent system. It is a **flexible system** where the filing and obtaining of a Canadian patent can be advantageously and cost-effectively filed and prosecuted, coordinating with corresponding foreign prosecution, for example with U.S. prosecution.

Flexibility begins with **subject matter**. Technologies in the fields of artificial intelligence, other computer-implemented inventions, medical diagnostic methods and medical uses are obtainable. Recent Patent Office guidance provides a clearer path for patentable subject matter in the newest technological trending inventions. Flexibility continues with filing. Canada offers a **one-year grace period** for an Applicant's own public disclosure. Canada has **no secret on-sale bar**.

Automatic **late national phase filing** is still possible for any international application filed before October 30, 2019. Should the 30-month national phase filing date be unintentionally missed for an international application filed on or after October 30, 2019, you can still late file within 42 months of the earliest priority date by making such statement along with the payment of a requisite fee.

Flexibility applies to convention filings. **Restoration of priority** is available if an application is filed within 14 months of the priority application date if the applicant's failure to file by the priority deadline was *unintentional* and the applicant requests restoration of priority within a prescribed period of one month from national phase entry for a PCT national phase application or within two months of the filing date for a direct filing.



Examination can be deferred for up to 4 or 5 years from the Canadian filing date. Alternatively, **examination can be revved up** by requesting accelerated examination, filing a request to enter the Patent Prosecution Highway or requesting advanced examination for a green technology. While response times to office actions is 4 months, **abandonment and reinstatement** is readily available, providing 12 months for reinstatement.

Canadian patent fees are comparatively inexpensive and reduced small entity fee rates are available. There are no excess claim patent fees.

A corresponding Canadian patent application filed from a U.S. application offers an economical and business value covering the North American market. Whether or not a significant business is present in Canada, the 20-year patent term provides licensing opportunities in return for royalties or licensing fees. A Canadian patent is a valuable asset to obtain financing.

Canadian **patent litigation** costs are typically much lower than in the United States and resolution is much faster. Generally, Canadian courts are pro-patentee. A Canadian patent may deter others from suing.

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As part of an effective business strategy, we at [Aird & McBurney](#) encourage the filing of Canadian patent applications. We have several highly-experienced patent agents in all of the technology sectors. Our firm is a leading Canadian IP boutique firm with an internationally-renowned reputation that works in union with [Aird & Berlis](#) to secure Canadian and worldwide protection and provide IP rights enforcement. We integrate intellectual property and legal services within a single, full-service legal organization.

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Lola is a registered patent agent in Canada and the United States, with a PhD in clinical biochemistry from the University of Toronto. Dedicated to her clients, she quickly grasps the nuances of their inventions. Her direct and focused approach leads to positive results for her clients. Lola's practice specialises in patent drafting and prosecution, strategic portfolio management, patentability and freedom-to-operate opinions and due diligence reviews.

Lola is an active member of the American Intellectual Property Law Association, the Intellectual Property Owners Association (IPO) and the IPO Women in IP Committee. Locally, she is a member of the Ontario Bioscience Innovation Organisation and Life Sciences Ontario. Lola is recognized in *IAM Patent 1000 – The World's Leading Patent Professionals*.



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Fiona is known for her commitment to outstanding client service. Fiona's practice focuses on advising clients with respect to employment issues related to compliance with employment standards, human rights, pay equity and occupational health and safety requirements. She also coordinates a team of lawyers to assist her clients in corporate commercial matters, litigation, intellectual property, and other areas. Fiona's responsiveness, dedication to clear communication, and hands-on approach show that she is personally invested in the success of her clients.

Fiona frequently advises international clients expanding into Canada. She is a practical lawyer who enjoys working with clients to develop workable business solutions.

This communication offers general comments on legal developments of concern to business organizations and individuals and is not intended to provide legal advice. Readers should seek professional legal advice on the particular issues that concern them.