

MODULE 3 - APPLYING FOR A PATENT



UNIVERSITY OF
TORONTO

This presentation is adapted from the IP foundation series on the Canadian Intellectual Property Office (CIPO) website.



Does it matter when I decide to
file a patent?

I created a new invention that
will be patent protected, do I
also own the IP rights?

In this module, we will explore the patent application process
and important factors to consider along the way.

LEARNING OBJECTIVES FOR APPLYING FOR A PATENT

By the end of this module, you will be able to:

- Explain the importance of a patent filing date
- Distinguish between inventorship and ownership
- Explain strategies to be aware of prior to filing a patent application
- Outline the basic steps involved in obtaining a patent in Canada
- Identify common jurisdictions in which patent applications are typically filed

APPLYING FOR A PATENT IN CANADA

WHAT IS “A PATENT FILING DATE” AND WHY IS IT IMPORTANT?

The date that a patent is filed, the patent filing date, is an important aspect of patenting.

If there are multiple patent applications for the same invention, a patent will be granted to **the first applicant to file an application**, i.e. the application with the earlier filing date.

The applicant should file as soon as possible in the case when someone else is on a similar track.



APPLYING FOR A PATENT IN CANADA

INVENTORSHIP AND OWNERSHIP

The applicant may be the inventor but not always.

An **inventor** is someone who has made an inventive contribution to the invention.

The inventor owns the IP rights *unless* there is an Agreement that assigns the **ownership rights** to another party (the assignee).

IP ownership clauses can be found in founder, employment, contractor, collaboration, and non-disclosure agreements.

Different Canadian Universities have different IP ownership policies.



APPLYING FOR A PATENT IN CANADA

KEEP YOUR INVENTION SECRET BEFORE APPLYING

Keeping secrecy before filing is crucial to prevent others from filing for the same invention before you and destroying the novelty of your own invention.

Even internal presentations (e.g. academic departmental presentations) may amount to **public disclosure**. It's important to verify with your organization's legal office whether your presentation would constitute a public disclosure prior to giving it.

Consider confidentiality and non-disclosure agreements if you must reveal your invention to anyone before you file your patent application.

If you publicly disclose your invention before filing, it may be impossible to obtain a patent because the invention will no longer be considered novel.

However, you could benefit from Canada's 12-month grace period, which allows applicants to file after disclosing the invention.

APPLYING FOR A PATENT IN CANADA

PRIOR ART SEARCH

Before you file, search for existing patents, patent applications and all forms of public disclosure to determine whether your invention is new and non-obvious. This is generally referred to as a **prior art search**.

Start with the [Canadian Patents Database](#) on the CIPO website.

Search using key words, the name of the inventor, the owner or the applicant, or any other relevant terms. You should also search international databases to see what has been patented across the world.

[United States Patent and Trademark Office website](#)

[European Patent Office website](#)

[WIPO PATENTSCOPE database](#)

[Google Patents](#) (accessible but only for cursory searches)



APPLYING FOR A PATENT IN CANADA

SUBMISSION OF YOUR APPLICATION

You should consider hiring a registered patent agent to help prepare and file a patent application. Electronic services can be used to file the application and pay fees online, or the application and payment can be mailed to CIPO.

CIPO will only accept applications in English or French.

To receive an official filing date in Canada, you must include in your application:

a statement that a patent
is sought

a document describing
your invention

the filing fee

your name and address

APPLYING FOR A PATENT IN CANADA

UNDERSTAND THE APPLICATION PROCESS

Obtaining a patent can take many years and steps. The following are the 7 key steps for a Canadian application, which are described further in subsequent slides:

1. **Filing of the application** – the application is submitted and a **filing date** is received
2. **Application available online** – published 18 months after the earliest filing date or earlier if requested
3. **Request examination** – request examination of the application within a set amount of time

APPLYING FOR A PATENT IN CANADA

UNDERSTAND THE APPLICATION PROCESS

4. **Examination and Office Action** – a patent examiner reviews the application and sends an Office Action report rejecting or allowing the application
5. **Responding to Office Action** – the applicant responds to the examiner by making changes to the application and/or presenting arguments
6. **Allowance or additional Office Action** – an application may be allowed or an additional Office Action (which may be final) sent by the patent examiner
7. **Granting of patent** – if the application is allowed and fees are paid, the patent is granted

APPLYING FOR A PATENT IN CANADA

PUBLICATION OF YOUR PATENT APPLICATION

Your complete application will be **published** in the Canadian Patents Database **generally 18 months after filing** unless early publication is requested. Your patent application will not be examined unless published.

This ensures that the public may become aware of the patent application. The patent application will be available for anyone to read.



APPLYING FOR A PATENT IN CANADA

REQUEST EXAMINATION

Patent applications are *not* automatically examined simply because they have been filed.

You must request that your patent application be examined **within four years of the Canadian filing date** and pay the examination fee. Otherwise, your application will be considered abandoned.

The examination process could take up to a few years to complete because CIPO annually receives a large number of patent applications.



APPLYING FOR A PATENT IN CANADA

WHAT HAPPENS DURING EXAMINATION

A patent examiner will review your application and decide whether your invention is new, useful and non-obvious, as per patent law.

Objections and rejections by the examiners are common practice. If your application is not acceptable, the examiner will explain why, and you will have a chance to make changes to it. This may take several iterations.

A **final Office Action Rejection** may be received but the rejection can be appealed or the applicant may choose to abandon the application.



APPLYING FOR A PATENT IN CANADA

OBTAIN YOUR PATENT

If everything is in order, you will receive a **Notice of Allowance** by mail, and you will then have six months to pay your final fee.

CIPO will mail the patent grant to you within a few months of receiving the final fee.



APPLYING FOR A PATENT

PATENT PROTECTION IS JURISDICTIONAL

A granted Canadian patent protects your inventions only in Canada. IP rights are jurisdictional, you must **apply for a patent in each national/regional office where you want protection.**

Each patent office will have different laws, requirements and extent of rights for patent filing and protection. Seek professional advice from a registered Canadian patent agent for filing domestically and internationally.



APPLYING FOR A PATENT

PATENT PROTECTION INTERNATIONALLY

Patent applications are commonly filed in the following national and regional patent offices:

- United States Patent and Trademark Office (**USPTO**)
- European Patent Office (**EPO** is a regional patent office covering most of Europe)
- China (**CNIPA**)
- Japan Patent Office (**JPO**)

International or **PCT** (Patent Cooperation Treaty) application – a single (“placeholder”) application to delay filing applications in multiple countries/regions, **it does not give you an international patent!** There is no world patent.



CHECK FOR UNDERSTANDING

TRUE OR FALSE: An inventor on a patent may not automatically be the owner.



CHECK FOR UNDERSTANDING

TRUE OR FALSE: An inventor on a patent may not automatically be the owner.

ANSWER: True. Agreements can assign ownership rights from the inventor to another party, for example employment agreements and contract work agreements.



CHECK FOR UNDERSTANDING

TRUE OR FALSE: Patent applications are automatically examined once they are filed.



CHECK FOR UNDERSTANDING

TRUE OR FALSE: Patent applications are automatically examined once they are filed.

ANSWER: **False:** For many reasons patent applications are not automatically examined, it may take several years and considered patent pending during this stage



SUMMARY OF LEARNING OBJECTIVES FOR APPLYING FOR A PATENT

You should now be able to:

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