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## IPIC Practice Update

### Patent Application Multiple Abandonments

In *DBC Marine Safety Systems Ltd. v. The Commissioner of Patents et al.*<sup>1</sup> the Federal Court considered an application for judicial review of a notice issued by CIPO declaring a patent application abandoned for failure to respond to an examiner's requisition by the prescribed deadline.

In responding to an office action, the applicant's agent erred in failing to respond to a requisition under section 29 of the Patent Rules. The response was due on February 10, 2005. Through simple oversight, the response to the office action, which was filed on February 7, 2005, was silent on the s. 29 requisition. However, the effect was deemed abandonment of the application on February 10, 2005, pursuant to s. 73(1)(a) of the *Patent Act*. The one-year reinstatement period expired on February 10, 2006.

CIPO accepted an annual maintenance fee paid in July 2005, without informing the applicant that the application was considered to be abandoned at that time.

On April 10, 2006, unaware of the deemed abandonment and the subsequent expiration of the reinstatement period two months previously, the applicant's agent wrote to CIPO enquiring when the application would next be examined. In response, CIPO returned a copy of the agent's letter bearing a stamp indicating that there was an outstanding office action and that a notice of abandonment had been mailed on February 10, 2005. However, there was no evidence that a notice of abandonment had in fact been mailed. Indeed, it was not disputed by CIPO in the court proceedings that no notice had been provided to the applicant or its agent that the application was deemed to be abandoned.

A subsequent effort by the applicant to reinstate the application and submit the missing Rule 29 information was refused by CIPO on the basis that CIPO has no discretion to reinstate an application after the reinstatement period has expired.

The Federal Court dismissed the application for judicial review, concluding that the application was abandoned by operation of law (i.e. s. 73(1)(a) of the *Patent Act*) and that the Court was unable to provide a remedy. The failure of CIPO to provide timely notice of abandonment, contrary to its usual practices, did not relieve the applicant of its legislated obligations under the *Patent Act*.

While *DBC* may be appealed, this case clearly emphasizes that it is of utmost importance that applicants ensure that responses to office actions adequately address **all** requisitions set forth in the office action.

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<sup>1</sup> 2007 FC 1142 (judgment rendered November 5, 2007)

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For example, an office action may contain a requisition under subsection 30(2) of the Patent Rules concerning defects in the application and, in addition, contain one or more separate requisitions under:

- section 29 of the Patent Rules (regarding information or documents in respect of applications for a patent filed in or for any country describing the same invention in the application being examined);
- section 89 of the Patent Rules (regarding the filing of a certified copy of the previously regularly filed application and a certification of the actual date of its filing); or
- section 104.1 of the Patent Rules (regarding the inclusion of the date of the original deposit of biological material with an international depository authority in the description of the application).

To reinstate an application that has been abandoned as a result of more than one failure to reply to a requisition, the applicant must, in accordance with section 73(3) of the *Patent Act* and section 98 of the *Patent Rules*, in respect of **each** such failure:

- (1) make a request for reinstatement to the Commissioner;
- (2) take the action that should have been taken in order to avoid the deemed abandonment; and
- (3) pay the fee set out in item 7 of Schedule II;

before the expiry of the twelve-month period after the date on which the application is deemed to be abandoned as a result of that failure.

For more information on CIPO practice concerning multiple abandonments, please consult the CIPO Practice Notice of April 2, 2004 entitled *Patent Office Practice Regarding Multiple Examiner's Requisitions*, available on the CIPO website at [http://strategis.gc.ca/sc\\_mrksv/cipo/patents/notice\\_apr2\\_04-e.html](http://strategis.gc.ca/sc_mrksv/cipo/patents/notice_apr2_04-e.html).