

The Associate's Guide to Pitfalls in the Canadian Patent Database

Last year, the Canadian Intellectual Property Office provided online file history access for the first time via the Canadian Patent Database (CPD). Gone are the days of having an agent on the ground in Ottawa who could run over to the patent office to view file histories or case status reports using the on-site computers; or otherwise ordering patent documents and reports over the phone at a turnaround time that approached a week in many cases.

However, there are some pitfalls and limitations to the current incarnation of the CPD that associates in other jurisdictions need to be aware of when relying on the CPD to determine the current status of a case or when looking for recent correspondence.

First and foremost, there is no positive indication given on the CPD that a patent application has been abandoned, with the possibility of reinstatement. A status indicator is only present if the application is "Dead", meaning that its period of reinstatement has passed and the application is irrevocably abandoned.

One cannot thus assume or necessarily tell from the CPD that a patent application is in good standing. In order to make such a determination, one has to inspect the files in the file history, determine whether any deadlines have been set by correspondence going out from the Canadian Patent Office and whether a response is present in the file history, which is both fully responsive and was filed in good time. Even this approach has some dangers, as will be evident below.

Next, the types of documents available in the CPD are not exhaustive. For example, while most patent office requisitions having a deadline are available online, some items, such as the Notice of Allowance, are not. In this case, it is impossible to tell from the CPD that a case has been allowed, but the applicant has yet to pay the issue fees.

Other documents which are not available online as of the date this article is being written include the Notice of Abandonment for many causes of abandonment, certain assignment documents, filing certificates, third party protests and related prior art, and certain reinstatement confirmations.

The CPD is most useful for reviewing Examiner-initiated correspondence such as Office Actions, responses and viewing a history of amendments to the application. It is not as of yet reliable in determining the status of an application or gauging whether there is an outstanding requisition to which the applicant must respond.

Of particular relevance to due diligence review, the full assignment history is not readily available on the CPD, nor are security agreements made of record against a patent or application.

While the coming on-line of file history access at the CPD has been welcome news and is a very useful tool for viewing the prosecution history, including currently pending claims, associates in other jurisdictions should be cautioned against an over reliance on the CPD, particularly for accurately determining the status of an application or for identifying whether there are outstanding requisitions to which an applicant must still respond.

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