



Newsflash | January 27, 2010

Form Triumphs Over Substance

Strict compliance with the formal requirements specified under Canadian Patent legislation has been confirmed. In *Unicrop Ltd. v. Canada (Attorney General)* 2010 FC 61, a decision of the Federal Court released January 20, 2010, the Court once again emphasized the importance of having only the authorized correspondent (usually the Canadian patent agent) pay maintenance fees for a patent application. The Courts have confirmed that there is no discretion to vary or grant equitable relief for failure to meet the formal requirements specified under the Patent Act. Any failure to comply with these mandatory requirements will lead to deemed abandonment of the patent application. This follows on an earlier decision by the Federal Court in *Rendina v. Canada (Attorney General)*, 2007 FC 914, [2008] 3 F.C.R. 3. In *Redina*, the Canadian Intellectual Property Office refused to accept a fee payment by the patentee/owner as a patent agent had been appointed.

In *Unicrop* the application was initially prosecuted by one law firm, but the file was subsequently transferred to a second without notice to the Canadian Intellectual Property Office. The second firm submitted the maintenance payments but did not file their appointment as agent and revocation of the previous agent until after the payments had been made.

The Commissioner of Patents initially accepted the payment, but ultimately, after the time limit to make the payment had lapsed, advised the patentee that the fees were rejected. The Commissioner held that the fees were not made by an authorized correspondent as defined by the *Patent Act*. The Patent was subsequently declared irrevocably abandoned for failing to pay the maintenance fee within the time required.

On appeal to the Federal Court Justice Boivin upheld the Commissioner's decision, and also rejected the patentee's appeal for equitable relief:

[27] Since subsection 6(1) of the Rules requires that all communication with the Commissioner be conducted by the authorized correspondent, the Commissioner did not err in refusing payment of the fees by Furman & Kallio, as they were not the authorized correspondent for the Application at the time the payments were made. The Applicant does not contest that the Notice of Appointment of Agent was not received by CIPO by July 5, 2008 [after the fees had been paid] and, as such, it was reasonable for the Commissioner to refuse the payment of the fees and the reinstatement of the Application.

[38] In the case at bar, although the required fees were paid, they were not paid by the authorized correspondent as required by the legislation and thus, Furman & Kallio was not recognized as the appropriate agent by CIPO. The Court cannot find that the decision by the Commissioner not to reinstate the Application is contrary to equity (...)