



FICPI CANADA Submission to the CIPO

Re: PRE- CONSULTATION NOTICE: CIPO FEE REVIEW

September 6th, 2010

Submission

This submission is provided in response to a call for pre-consultation comments on the subject of CIPO fees. FICPI Canada wishes to thank the CIPO for the opportunity to present this submission.

FICPI Canada is a self-governing national association of FICPI (the Fédération Internationale des Conseils en Propriété Industrielle). FICPI comprises more than 3500 intellectual property professionals in private practice in 86 countries. FICPI Canada, as a local chapter of FICPI, represents the interests of Canadian patent and trade-mark professionals in private practice. Our membership includes senior professional in most major Canadian intellectual property firms. Our clients span all types and sizes of businesses, including local and foreign multi-national corporations, small and medium size enterprises, and individuals.

FICPI Canada is of the view that the current fee structure is adequate. CIPO is urged to carefully consider any fee increase since it may discourage applicants and reduce filings in Canada. Anything other than very modest fee increases, in the current economic climate, may negatively affect CIPO revenues because of reduced filings. Meanwhile, a lowering of some fees may stimulate filings.

The following suggestions are presented for consideration. FICPI Canada reserves the right to present amended or additional comments in due course.

Suggestions for Consideration

Patent Fees

- Introduce fee reductions for e-filing of applications or other documents;
- Do away with small entity rates in view of legal uncertainties which are a disservice to small entity applicants;
- Re-introduce reductions for assignment recordations where multiple applications/patents are dealt with in a single document;

- Provide a “Return to Exam” fee for re-opening prosecution on allowed cases without resorting to abandonment;
- Consider allowing late payment of filing fees, with penalty;

We understand the last two suggestions could require regulatory amendments.

Trade-mark Fees

- Consider lowering the renewal period from 15 to 10 years;
- Consider lowering the fees for launching an opposition;
- Consider a scale of increasing costs of extensions of time to encourage rapid prosecution/opposition/expungement proceedings rather than the current practice of refusing multiple extensions of time;
- Consider imposing fees only on the party requesting a hearing in opposition or expungement proceedings;

Industrial Design Fees

- Introduce reductions for e-filing of applications or other documents;
- Introduce reductions for assignment recordations where multiple designs applications/registrations are dealt with in a single document;

FICPI has presently no suggestions on the subject of Copyright Fees or other fees imposed by the CIPO.

We look forward to providing further feedback in relation to an upcoming CIPO proposal for fee modifications.

Respectfully submitted,

FICPI CANADA per Alain M. Leclerc, vp.