

CLIENT ALERT

April 7, 2020

1

CANADIAN IP

CIPO PANDEMIC RESPONSE AND CANADA'S NEW COMPULSORY PATENT LICENSING PROVISIONS

by Matthew Powell

The Canadian Government and its operating agencies have provided a number of [responses](#) to the COVID-19 Emergency. The purpose of this alert is to provide information about the responses pertaining to intellectual property in particular.

HEALTH EMERGENCY COMPULSORY PATENT LICENSING

Canada's Parliament, as part of the [COVID-19 Emergency Response Act](#), has now added health emergency compulsory licensing legislation to Canada's Patent Act. The [new legislation](#) requires the Commissioner of Patents, upon application by the Minister of Health, to authorize the Government of Canada and any person to make, construct, use and sell a patented invention to the extent necessary to respond to a public health emergency that is a matter of national concern. Royal Assent for this legislation was received on March 25, 2020.

An authorization under this provision is temporary. In particular, such an authorization ceases to affect the earlier of: the day the Minister of Health notifies the Commissioner that the authorization is no longer necessary, and one year after the day the authorization was granted. In addition, the Commissioner shall not make such an authorization after September 30, 2020.

Pursuant to the new legislation, the use or sale of a patented invention that is made or constructed in accordance with the authorization is not an infringement of the patent. However, the Government of Canada and any person authorized by the Commissioner of Patents must pay the patentee any amount the Commissioner considers adequate remuneration in the circumstances.

The COVID-19 Emergency Response Act did not enact similar compulsory licensing provisions in The Industrial Designs Act.

CANADIAN INTELLECTUAL PROPERTY OFFICE OPERATIONS

Regarding operations of the Canadian Intellectual Property Office (CIPO):

- **For utility patents and applications, deadlines that would have fallen between March 16, 2020 and April 30, 2020 are automatically extended to May 1, 2020.** **CAUTION:** this extension does not apply to any statutory deadlines that the Commissioner of Patents is not authorized to extend, such as statutory deadlines for filing applications after a public disclosure, and certain deadlines for restoration of right of priority;
- **For industrial design registrations and applications, deadlines that would have fallen between March 16, 2020 and April 30, 2020 are automatically extended to May 1, 2020.** **CAUTION:** this extension does not apply to any statutory deadlines that the Minister is not authorized to extend.
- **For trademark registrations and applications, deadlines that would have fallen between March 16, 2020 and April 30, 2020 are automatically extended to May 1, 2020.** In addition, for deadlines falling after May 1, 2020, the Registrar of Trademarks is currently considering the COVID-19 disruption to be sufficient circumstance to justify obtaining an applied-for extension under

Sections 47(1) and 47(2) of the Trademarks Act. **CAUTION:** this extension does not apply to deadlines the Registrar of Trademarks is not authorized to extend.

- **For Trademarks Opposition Board (TMOB)** proceedings, including oppositions, Section 45 proceedings, and objection proceedings, deadlines that would have fallen between March 16, 2020 and April 30, 2020 are automatically extended to **May 1, 2020**.
- **Document Orders:** While CIPO continues to receive orders for IP documents, under the circumstances of COVID-19, these orders will be fulfilled only once services at CIPO resume.

We **strongly recommend** that originally set deadlines should, wherever possible, continue to be met. However, please contact us promptly if there has been a missed deadline, or if there is a concern about missing a future deadline, so that we can assist you with risk mitigation and planning.

MORE INFORMATION

The Canadian Intellectual Property Office has published notices about Service and Website Interruptions here:

- <http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00050.html>

The Department of Justice's website outlining the Government of Canada's response to COVID-19 can be found here:

- <https://www.justice.gc.ca/eng/csj-sjc/covid.html>

We also encourage readers to consult our Toronto Office's [COVID-19: The Essential Need-to-Know Guide for Employers and Employees](#).

Dickinson Wright will continue to provide client alerts as Canada's response to the COVID-19 Emergency progresses.

KEY CONTACTS



Matthew D. Powell is a Senior Patent Agent in Dickinson Wright's Toronto office. He can be reached at 416.646.3841 or mpowell@DickinsonWright.com.



Yuri Chumak is a Partner in Dickinson Wright's Toronto office. He can be reached at 416.646.3843 or yechumak@DickinsonWright.com.



Paul E. Bain is a Member in Dickinson Wright's Toronto office. He can be reached at 416.646.8364 or pbain@DickinsonWright.com.

WWW.DICKINSONWRIGHT.COM

DICKINSON WRIGHT

ARIZONA CALIFORNIA FLORIDA KENTUCKY MICHIGAN NEVADA OHIO TENNESSEE TEXAS WASHINGTON DC TORONTO

Please Note: These materials do not constitute legal or medical advice. Government initiatives, announcements, and regulations in response to the COVID-19 situation continue to evolve and change frequently.