

# MACRAE & CO.

326 Somerset St. W., Ottawa, Ontario, K2P 0J9

TELEPHONE: (613) 234-3559

FACSIMILE: (613) 234-3563

EMAIL: [mail@macrae.ca](mailto:mail@macrae.ca)

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## Information Bulletin New Rule Changes October 3, 2022

On June 2, 2022 the Canadian Intellectual Property Office (CIPO) published a finalized set of rule changes related to the Canada-United States-Mexico Agreement (CUSMA), which replaced the North American Free Trade Agreement (NAFTA), which become effective October 3, 2022. The primary changes relate to excess claim fees, mandatory request for continued examination, conditional notice of allowance and sequence listing submission format summarized below.

### Excess Claim Fees

A government excess claim fee in the amount of CAD\$100 will apply for each claim in excess of 20. This fee is payable at the time of requesting examination.

In addition, at the time of payment of the final fee, an excess claim fee of CAD\$100 will be payable for each claim in excess of 20 claims that existed in the application at any time during the period from the date of submission of the request for examination to the date of payment of the final fee and for which fees were not already paid at the time of requesting examination.

The amount of government excess claim fees due will be assessed based on the total number of claims only, with no extra fees for multiple-dependent claims or for extra independent claims.

In addition, the excess claim fees may be avoided through submission of a voluntary amendment to reduce the claim count concurrently with or prior to the request for examination.

If any divisional applications are being contemplated, the new excess claim fees rules will apply to divisional applications filed after September 29, 2022.

**Should an applicant desire to avoid any of the new excess claim fees rules without a voluntary amendment, a request for examination must be submitted on or before September 29, 2022.** Please let us know should you desire to request examination prior to this date in order to avoid the possibility of paying excess claim fees.

### Request for Continued Examination (RCE)

For applications in which a request for examination is submitted after September 29, 2022, CIPO will provide up to two Office Actions after which a request for continued examination must be submitted in order to continue examination for a response to a third Office Action and for every second Office Action afterwards. The government RCE fee is \$816 for a standard entity and \$408 for a small entity.

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**Should an applicant desire to avoid the new RCE procedure, a request for examination must be submitted on or before September 29, 2022.** Please let us know should you desire to request examination prior to this date.

Under the new rules, it will be necessary to submit a voluntary RCE in order to continue prosecution after a Notice of Allowance, rather than withdrawing the Notice of Allowance as per the current practice. If a voluntary RCE is submitted, the application will then follow the new RCE rules, including the requirement to submit an RCE for every second Office Action received after submission of the voluntary RCE.

## Conditional Notice of Allowance

If an Examiner determines that an application is allowable except for certain “minor defects”, the Examiner will issue a conditional Notice of Allowance requiring the applicant to respond by making certain amendments and/or submitting arguments along with payment of the final fee. This rule change applies to all applications.

## Sequence Listing Submissions

For regular patent applications having a filing date of July 1, 2022 and national entry applications from PCT applications having an International Filing Date of July 1, 2022 or later, sequence listing submissions must be in XML format.

We welcome any questions you might have.

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[mail@macrae.ca](mailto:mail@macrae.ca)

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