

Canada and the Patent Prosecution Highway

The Patent Prosecution Highway (PPH) is an international framework in which patent prosecution may be accelerated in one jurisdiction if the claims in a corresponding application are allowed by a second jurisdiction. The two jurisdictions must have a bilateral PPH agreement.

In an earlier version of the PPH, an application filed at a first patent office (“Office of First Filing” or OFF) whose claims were allowed, could serve as the basis for accelerated examination of a corresponding application subsequently filed at a second patent office (“Office of Second Filing” or OSF), provided that examination at the OSF had not yet commenced. This framework fit nicely with Canadian patent practice, since examination of an application could be delayed up to five years from the filing date. Applicants were often counseled to hold off examination of their Canadian application until claims from a corresponding application were allowed by an OFF. A typical North American scenario would be as follows: an applicant first files in the US (which is the OFF), and then later files in Canada (which is the OSF), claiming priority on the earlier-filed US application. The applicant delays examination of the Canadian application, while prosecution of the US is completed. Once

US claims are issued, the applicant requests examination of the Canadian application, along with entry into the US-Canada PPH program. If necessary, the pending claims are amended to have a scope similar to those allowed by the USPTO, as part of the PPH request.

The earlier form of the PPH has been replaced by the Mottainai program. In the Mottainai PPH framework, it does not matter where an application is first filed. Consider the following example: a patent application is first filed in jurisdiction ‘A’, with corresponding applications later filed in jurisdictions ‘B’ and ‘C’ respectively, and both claim priority to the application filed at patent office ‘A’. Patent offices ‘B’ and ‘C’ are signatories to the PPH. If patent office ‘B’ allows the claims first, the PPH can then be used to accelerate examination at patent office ‘C’. If patent office ‘A’ is also a signatory to the PPH, then the allowance of claims by patent office ‘B’ (the OEE) can also

be used to accelerate examination at patent office ‘A’ (an OLE). Entry into the PPH program at either patent office ‘A’ or ‘C’ is not allowed if examination has already commenced.

In addition, there is now a PCT-PPH program. For national phase applications, the PCT-PPH can advance examination based on either a Written Opinion (WO) or International Preliminary Report on Patentability (IPRP) (i.e. “international work product”) issued by an International Searching Authority (ISA) and/or an International Preliminary Examining Authority (IPEA). A formal PCT-PPH agreement must be in place between the national phase office and the ISA and/or the IPEA in order to use the PCT-PPH program.

Currently, the Canadian Intellectual Property Office (CIPO) is part of the Mottainai PPH framework with agreements in place with the following eleven national patent offices: Denmark, Germany, Israel, Japan, Portugal,

South Korea, Finland, Spain, China, the United Kingdom, and the United States.

In the Mottainai PPH, the results of an office of earlier examination (OEE) are used to advance prosecution in an office of later examination (OLE).

A Canadian application is eligible for the PPH if the following conditions are met: 1) at least one claim has been allowed by the OEE; 2) the pending Canadian application and the corresponding allowed application are part of the same patent family (for example, the two applications have the same earliest priority/filing date); 3) all pending claims sufficiently correspond to one or more of the claims allowed by the OEE; 4) the pending application has not yet been examined; and 5) office actions (issued by the OEE) that are unavailable via an electronic dossier system, must be provided (in French or English) to the CIPO. In addition, the applicant must request publication of the Canadian application has not yet been published by the CIPO. Given that examination of a Canadian application can be delayed up to five years from the filing date (or international filing date for a national phase application), it would be advantageous for an applicant to wait for claims to issue in a corresponding application filed in one of the above eleven countries, then request examination of the pending Canadian application, along with entry into the PPH program at the CIPO. The pending claims should be amended, if necessary, to have a scope similar to those allowed elsewhere. In addition, the remainder of the application should be amended to conform to Canadian patent practice, if required.

With regards to the PCT-PPH program, the CIPO currently has a bilateral agreement

with the USPTO. A Canadian national phase application is eligible for the PCT-PPH if the following conditions are met: 1) at least one claim has been deemed novel, inventive and industrially applicable in a WO or IPRP issued by either the USPTO or the CIPO; and 2) all pending claims sufficiently correspond to one or more of the claims deemed novel, inventive and industrially applicable in the WO or IPRP. One apparent drawback is that an international work product issued by a patent office other than the USPTO or the CIPO, cannot be used to advance examination of a Canadian national phase application.


Statistics provided by the PPH Portal Site reveal that the PPH is gaining in popularity. As of the end of June 2013, 3,552 PPH requests had been filed at the CIPO since the inception of the program. The majority of these request used the USPTO as the OFF/ OEE, followed sequentially by Japan, Germany, and the United Kingdom. The efficiency of the program is impressive: the grant rate was 91% for PPH applications (compared to an overall grant rate of 65%); the allowance rate as a first office action was 42% for PPH applications (compared to an overall rate of 5.1%); the average number of office actions issued for PPH applications was 0.7 (compared to 1.5 for all applications); the average pendency from the PPH request to the first office action was 2.1 months (compared to 17.8 months for all applications); and the average pendency from the PPH request to a final decision was 6.2 months (as opposed to 35.6 months from an examination request to a final decision for all applications).

The results are similar, if somewhat better, for the PCT-PPH program, bearing in mind that the CIPO only accepts an international work product issued by either itself or the USPTO. It should be noted that between January 2013 and June 2013, the grant rate of Canadian national

phase applications examined via the PCT-PPH program was 100%, while the average pendency from the PCT-PPH request to a final decision was a mere 3.7 months. In addition, the allowance rate as a first office action was 61%; the average number of office actions issued was 0.5; and the average pendency from the PCT-PPH request to the first office action was 2.25 months. Given these statistics, it is conceivable to receive a notice of allowance for a Canadian national phase application within four months of national entry – provided that a favourable international work product has been issued by either the USPTO or the CIPO. These claims allowed by the CIPO can then form the basis of a PPH request in one of the many countries that have a bilateral PPH agreement with Canada. For example, if a Canadian national phase application is allowed based on an international work product issued by the CIPO, then the allowed claims can serve as the basis for a Mottainai PPH request with a patent office that has a bilateral agreement with the CIPO.

A few peculiarities of Canadian patent law require some care when entering the PPH. For example, method of medical treatment claims allowed by an OEE must be amended to German and/or Swiss-style use claims in Canada, since method of medical treatment claims are deemed non-statutory by the CIPO.

Where an election of claims is made at an OEE, care should be taken not to file a voluntary divisional of the corresponding Canadian application, as this may result in double-patenting which may not be corrected later on. Canadian patent practice does not currently allow for terminal disclaimer practice (as is common in the U.S.). Instead, examination of the Canadian application should be delayed as long as possible until groups of claims have been issued by the OEE. A PPH request for one single application should then be filed at the CIPO for all of the groups of claims that have been allowed by the OEE. As unity of invention regulations are more aligned with those of PCT practice, the Canadian Examiner may not necessarily issue an election request.



If an election is requested, then the applicant should file a separate PPH request for each divisional application filed. Canadian courts have ruled that an application subject to a request for election by an Examiner is shielded from double-patenting attacks

The above describes strategies for fast-tracking Canadian applications with the CIPO serving as an OLE. However, as part of an international strategy, an applicant should file an application as quickly as possible in Canada, and immediately request accelerated examination (via one of two routes described below). Once the claims are allowed in Canada, the CIPO can then be used as an OEE for PPH requests with a patent office that has a bilateral PPH agreement with the CIPO. Applicants should take care to fulfill any foreign filing license requirements prior to filing in Canada.

One route towards accelerated examination is the CIPO's Special Order program, which provides a first office action within 60 days. Since prosecution of the application is accelerated, it is conceivable to have a set of allowed claims within one year of requesting the Special Order. The requirements are relatively simple - an applicant must: i) pay a \$500 (CAD) Special Order fee (plus examination fees); and ii) declare that failure to advance the application is likely to prejudice the applicant's rights.

Another route to accelerated examination

is entry into the CIPO's Green Technology Program which, unlike the Special Order program, requires no additional government fee. An application related to green technology can receive expedited examination if the applicant submits a declaration stating that their "application relates to technology the commercialization of which would help to resolve or mitigate environmental impacts or conserve the natural environment and resources." As with the Special Order program, a first office action should issue within 60 days of entry into the Green Technology Program.

Finally, thirteen patent offices (including the CIPO) plan to launch a pilot Global PPH program in January 2014, in which it is proposed that a dozen jurisdictions will participate in the Mottainai PPH and PCT-PPH; all work products of participating offices will be used; machine translations will be accepted; office actions will be obtained via dossier access systems; and there will be better harmonization of policies and procedures between participating offices. National patent offices from Australia, Canada, Denmark, Finland, Japan, South Korea, Norway, Portugal, Spain, Russia, the United Kingdom, the United States and the Nordic Patent Institute (an intergovernmental organization between Denmark, Iceland and Norway) will participate.

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