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Canada Joins the Patent Prosecution Highway **Jonathan Roch**

The Canadian Intellectual Property Office (CIPO) and the United States Patent and Trademark Office (USPTO) launched on January 28, 2008, the Patent Prosecution Highway (PPH) pilot program for expediting the prosecution of patent applications. Under this bilateral initiative, a patent application in a first country with at least one allowable claim can be used to accelerate the allowance of a corresponding claim in a second country provided that certain criteria are met.

The 12-month pilot program is designed to evaluate the general interest in the program and the benefits gained by each office in order to determine whether such a program should be fully implemented. During the pilot phase, applicants will be able to achieve a form of expedited examination without making a formal fee-based request under the *Patent Rules*. The CIPO believes that the collaboration between offices should not only allow patent applicants to obtain corresponding patents faster and more efficiently (there is a two to three year backlog at present), but it should also alleviate examination workload and improve the quality of patents.

In order to be eligible to participate in CIPO's PPH program the following conditions must be met:

1. The Canadian application must be either a Canadian *Paris Convention* application claiming priority to one or more US applications, a Canadian national phase application based on an international (PCT) application claiming priority to one or more US applications, or a divisional patent application of any of the above categories of applications.
2. The Canadian application must have a "corresponding" US case (e.g. the priority application or a US application or patent claiming priority to the same priority application)
3. The corresponding US case must have one or more allowed claims.
4. All claims on file for the Canadian application must sufficiently correspond (be the same or similar in scope) to one or more of the allowed claims in the corresponding US application.
5. The Canadian application must be open to public inspection. The applicant may request that the application be open to public inspection at the time the PPH request is made.
6. Examination must have been requested or be made at the time of the PPH request.
7. At the time of the PPH request examination of the Canadian application must not yet have begun.
8. The PPH request must include: a completed PPH request form, a copy of any office

action(s) for the corresponding US application, a copy of the claims examined and the allowed claims and a claim concordance table showing the relationship of the Canadian claims to be examined and the allowed or issued US claims.

The PPH may be particularly useful even in cases where a PPH request serves as a means to ensure that once the Examiner picks up an application, the Examiner's attention is focused on determining whether the scope of the Canadian claims is aligned with the allowed/issued claim(s) obtained for the corresponding US application/patent. If having the certainty of an issued patent in Canada to assert against third parties, or attract certain investors or partners is desirable, the PPH may provide considerable benefits to applicants.

The PPH pilot program may not be suitable for all applications. There may be significant value to a Canadian application if one can afford the time to prosecute the application based on broader claims that may have been previously cancelled or withdrawn during US prosecution, or adding additional or multiple dependent claims, at no additional government cost because there are no claim fees in Canada. Given that a claim set being submitted under the PPH program must still be examined in accordance with Canadian patent law, there is a risk that the claim scope may be narrowed during the Canadian prosecution, for example if new art was to come to the attention of the Examiner during prosecution.

In order to determine if an application is a good candidate for expedited examination under the PPH pilot program careful consideration should be given to the overall Canadian patent strategy for the invention.