

## Canada-U.S. Patent Prosecution Highway Now Open

March 17, 2008

January 28, 2008 marked the beginning of a Patent Prosecution Highway ("PPH") one-year pilot project between Canada and the United States. The PPH is a joint initiative between the Canadian Intellectual Property Office ("CIPO") and the United States Patent and Trademark Office ("USPTO") to expedite the examination of patent applications, while also reducing the workload on patent examiners.

That same day, the first-ever PPH (between the U.S. and Japan) became permanent, after a successful pilot project that had been initiated in July 2006. Similar pilot projects are currently underway, including ones between the U.S. and the UK, the U.S. and South Korea, South Korea and Japan, and Japan and the UK.

### Requirements

The concept behind the PPH is that an allowed patent application in a first country may expedite prosecution and allowance of a corresponding patent application (based on a priority claim) in the other country. The PPH can be initiated after the first country finds at least one claim to be patentable (allowed). Upon filing a successful PPH request in the second country, the corresponding application will be placed on a separate PPH examination list, with the aim of expediting its allowance.

Eligibility for the PPH depends on where the application was first filed. In Canada, the PPH may be accessed where (a) a Canadian application claims priority, or (b) there is a Canadian National Entry of a PCT application which claims priority, from an allowed U.S. application. Canadian divisional applications that meet these criteria are also eligible for the PPH.

In the U.S., the PPH may be accessed where (a) a U.S. application claims priority, or (b) there is a U.S. National Entry of a PCT application which claims priority, from an allowed Canadian application. An alternate route onto the PPH, available only in the U.S., exists for (c) a U.S. National Entry of an originating PCT application, where a Canadian National Entry (stemming from the same PCT application) has been allowed. U.S. divisional and continuation applications that meet these criteria are also eligible for the PPH.

In both countries, only published applications are eligible for the PPH, and only if examination has been requested but not commenced. For Canadian applications, it will generally be possible to delay filing a request for examination until the same time as filing a PPH request.

Along with a PPH request, an applicant must also file a table showing a direct correspondence between the yet-to-be-examined claims and the allowed claims in the first-filed application. If necessary, an amendment may be contemporaneously submitted to place the claims in such condition. If the patent office finds that the claim sets do not correspond with one another, the PPH request will be irrevocably denied. Accordingly, prior to filing the PPH request, care must be taken to make any necessary amendments.

Presently, there is no additional fee charged in Canada for submitting a PPH request (i.e., beyond the standard examination fee), although this is subject to change. In the U.S., there is a petition fee of US\$130 for filing a PPH request.

### Strategic Considerations

The Canada-U.S. PPH may create some significant benefits for patent applicants. By first filing a Canadian patent application along with a request for accelerated examination, an applicant might receive a first office action, and possibly even allowance, within a year of such filing.

In the United States, a corresponding U.S. application could gain entry onto the PPH as soon as the Canadian parent application is allowed. In this manner, it should be possible for applicants to avoid the complex (and expensive) accelerated examination requirements of the USPTO, so as to obtain an allowed and granted U.S. patent in an expedited fashion. (Alternately, overly negative examination results, received from CIPO within the first year, may suggest that no corresponding applications should

be filed so as to save the associated costs.)

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If patent protection beyond Canada and the U.S. is desired, the foregoing strategy could also be employed by filing an originating PCT application.

## **Conclusion**

Notably, the PPH is now open for both new and *existing* (i.e., previously filed) applications that meet the necessary criteria. As such, a review of all contemplated and pending patent applications should be undertaken to determine if any are appropriate for expedited prosecution and allowance using the PPH.

The Canada-U.S. PPH creates new possibilities, and new decisions, for patent applicants. Choosing the right jurisdiction of first-filing for a patent application is now more crucial than ever – i.e., in view of the potential repercussions on PPH eligibility.

**Orin Del Vecchio** is an associate in the Intellectual Property Group in Toronto. Contact him directly at 416-307-4161 or [odelvecchio@langmichener.ca](mailto:odelvecchio@langmichener.ca).

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