



Navigating the Patent Prosecution Highway in Canada

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The Patent Prosecution Highway (PPH) is a program through which examination of a Canadian patent application may be accelerated by aligning the patent claims with those issued or allowed in a foreign counterpart application.

The Canadian Intellectual Property Office (CIPO) currently has PPH agreements with patent offices in the United States, United Kingdom, Germany, Denmark, Finland, Israel, Portugal, Spain, Japan, Korea and China. The program can also be accessed based on claims deemed to be allowable in an international search report (ISR) issued in Canada or the United States.

Using the PPH

There are no government fees for using the PPH program. A Canadian application is eligible if:

1. the claims are “sufficiently similar” to those allowed or issued in the foreign counterpart;

2. the application is open to public inspection;
3. examination is requested but no Office Action has issued; and
4. the application has never been abandoned.

An amendment may be filed to align the Canadian claims with those of the foreign counterpart. There are no claim fees in Canada and claims from multiple foreign counterparts may be combined.

Once accepted into the PPH program, CIPO will issue an Office Action (or Notice of Allowance) within three months. The Applicant will then have three months to respond. Delays can result in the application being expelled from the program.

Benefits of the PPH

The PPH provides a means to accelerate prosecution in Canada and other PPH jurisdictions without fee, thereby

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reducing portfolio management time and costs. Use of the PPH can also provide consistency in scope of protection across multiple jurisdictions.

Drawbacks of the PPH

By limiting the claims to those of a foreign counterpart, an Applicant may be giving up scope that could have otherwise been pursued in Canada.

Whereas some jurisdictions have a flexible divisional practice, permitting an Applicant to pursue additional claims in a later application, Canada does not. Divisional applications are vulnerable to double patenting challenges in Canada, unless they are filed in response to a unity of invention objection, and terminal disclaimer is not a remedy. Therefore, it is advised to pursue all potential claims in a single application in Canada.

Alternatives to the PPH

Examination may be accelerated in Canada by two alternative routes:

1. Special Order may be requested by paying a government fee and indicating that failure to accelerate prosecution may prejudice the Applicant's rights. No reasoning or evidence is required.
2. Green Technology applications are eligible for accelerated examination if the application relates to a technology that, if commercialized, would help resolve or mitigate environmental impacts or conserve the natural environment and resources. There is no government fee for this program.

An Applicant is not limited by the scope of claims granted in a foreign jurisdiction when using these alternative routes.

Using the PPH in Reverse

An Applicant may consider accelerating prosecution in Canada via one of the routes listed above and then entering the PPH in another jurisdiction based on the allowed Canadian claims.

Conclusions

The PPH is an effective means to accelerate patent prosecution but may not always be the best route for Canada due to our laws on double patenting. In some cases, better protection can be obtained by accelerating examination via an alternative route. A patent agent can help you navigate this highway.

About the Authors

Jennifer Raoul is a partner and patent agent at Borden Ladner Gervais LLP. Jennifer has a PhD in Pharmacology and specializes in drafting and prosecution of biotechnology and pharmaceutical patent applications. Jennifer provides

legal opinions related to infringement, validity, patentability and freedom-to-operate issues, provides patent portfolio management and related strategic advice, and advises clients on the regulatory regimes related to therapeutic patents in Canada.

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