

SEEKING SPEEDY PATENT PROSECUTION



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Standard accelerated examination procedures

In Canada, the examination of a patent application is not automatic and must be requested within five years of the filing date. Applicants interested in seeking speedy prosecution may therefore wish to consider filing an accelerated examination request. The request, along with the payment of the standard C\$500 (\$412) fee, is usually granted automatically. This is subject to the application being open to public inspection (if not, the applicant can request early publication) and a statement that failure to advance the prosecution of the application will prejudice the applicant's rights.

The request can be filed at any time and the procedure can be seen as a mere formality—in contrast to the considerably more onerous requirements for accelerated examination at the United States Patent and Trademark Office (USPTO). Accelerated examination effectively places the application at the front of the 'queue' of the examination line, and a first office action can be issued within three months of filing the request.

Accelerated examination by the Patent Prosecution Highway

The Patent Prosecution Highway (PPH) provides a scheme to accelerate the examination of patent applications if examination has already been conducted at another intellectual property office. For example, if at least one claim has been found allowable by one office, an accelerated examination can be requested at the other office.

A one-year PPH pilot programme undertaken jointly by Canada and the US was launched on January 28, 2008 and has been extended to end on January 28, 2011. During the pilot, the Canadian Intellectual Property Office (CIPO) will process requests for advance prosecution free of charge. Regular fees for requesting examination will continue to apply.

There are five requirements for requesting accelerated examination under the PPH pilot at CIPO:

- (a) The CIPO application is one of the following: "(i) a nationally filed application which validly claims priority under the Paris Convention from either a single USPTO national application or multiple USPTO national applications; or (ii) a nationally filed application which validly claims priority under the Paris Convention from a PCT application which has no priority claims; or (iii) a PCT national phase application where the PCT international application has validly claimed priority from a USPTO national application or multiple USPTO national applications; or (iv) a PCT national phase application where the PCT international application which has no priority claims; or (v) a PCT national phase application

where the PCT international application has validly claimed priority from a PCT international application which has no priority claims; or (vi) a divisional of an application referred to any of (i) to (v)".

- (b) At least one corresponding USPTO application has one or more claims that are determined to be allowable by the USPTO.
- (c) All claims on file, as originally filed or as amended, for accelerated examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the USPTO. Claims shall be considered to sufficiently correspond where the claims are of the same or similar scope. CIPO shall consider corresponding USPTO claims to be allowable as indicated in a US letters patent or in an office action.
- (d) The CIPO application is open to public inspection.
- (e) CIPO has received a request for examination but has not begun examination of the application.

Applicants wishing to take advantage of the programme for a Canadian application must file a request for accelerated examination under the PPH, fill in a PPH request form and provide relevant supporting documents, including a copy of the claims found to be allowed by the USPTO.

During the pilot, PPH has accelerated the allowance of Canadian claims. According to CIPO statistics, in 2008, it received 375 requests to participate in the PPH pilot programme with the USPTO. A sample of the PPH requests examined revealed that 40 percent of PPH requests were in condition for allowance at the first action.

Useful strategic considerations

The Canada/US PPH scheme provides some useful and strategic options for applicants. By first filing an accelerated examination on a Canadian patent application, an applicant may be able to receive a first office action, and possibly allowance, within a year of such a filing. Accelerated examination on the corresponding US application may be requested under the PPH at the USPTO as soon as the Canadian application is allowed. In this manner, applicants may avoid the onerous and expensive accelerated examination requirements of the USPTO in order to obtain speedy allowance on the US application.

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