CIPO-EPO Patent Prosecution Highway Pilot Agreement Extended with Revised Eligibility Criteria

January 12, 2018

The Canadian Intellectual Property Office ("CIPO") recently announced a three-year extension to its pilot Patent Prosecution Highway ("PPH") agreement with the European Patent Office ("EPO"). Notably, the previous requirement for an application to have entered the Canadian national phase on or after January 5, 2015 has been lifted. Applicants with applications that were previously considered ineligible for CIPO-EPO PPH due to this date restriction may wish to consider if their applications could now qualify for expedited treatment, bearing in mind that examination must not yet have commenced for an application to be PPH-eligible.

PPH has proven to be an effective means of expediting examination in Canada.CIPO reports that 98 per cent of patent applications for which a PPH request was filed in the 2016-2017 period received a first substantive action (Office Action or Notice of Allowance) within three months.

The PPH requirement for “sufficient correspondence” with allowable foreign counterpart claims is liberally interpreted in Canada, such that claims narrower in scope than the allowable counterparts are generally considered by CIPO to be PPH-eligible. This, together with the lack of excess claims fees, provides applicants with the opportunity to pursue claims of differing scopes in Canada under the PPH, and to proactively address national formalities.

PPH may not be advisable, however, when there are other claims of interest outside the scope of the allowable foreign counterparts. Canada does not have continuation practice and voluntary divisional applications are not recommended due to local law on double patenting (briefly, Canada has an obviousness standard for double patenting and terminal disclaimer is not available). If there are additional claims of interest, it is advisable to add them to the main application for formal consideration by the examiner. If a unity objection is raised, Canadian jurisprudence indicates that a divisional can be filed without creating a double patenting situation.

For cases in which PPH is not an option, applicants may wish to consider regular "special order" expedited examination under paragraph 28(1)(a) of the *Patent Rules* or

so-called "green technology" expedited examination prescribed in paragraph 28(1)(b), provided that eligibility criteria are met.

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