

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.

By

[Graeme Boocock](#)

Expertise

[Intellectual Property](#), [Patents](#)

BLG | Canada's Law Firm

As the largest, truly full-service Canadian law firm, Borden Ladner Gervais LLP (BLG) delivers practical legal advice for domestic and international clients across more practices and industries than any Canadian firm. With over 725 lawyers, intellectual property agents and other professionals, BLG serves the legal needs of businesses and institutions across Canada and beyond – from M&A and capital markets, to disputes, financing, and trademark & patent registration.

blg.com

BLG Offices

Calgary

Centennial Place, East Tower
520 3rd Avenue S.W.
Calgary, AB, Canada
T2P 0R3

T 403.232.9500
F 403.266.1395

Ottawa

World Exchange Plaza
100 Queen Street
Ottawa, ON, Canada
K1P 1J9

T 613.237.5160
F 613.230.8842

Vancouver

1200 Waterfront Centre
200 Burrard Street
Vancouver, BC, Canada
V7X 1T2

T 604.687.5744
F 604.687.1415

Montréal

1000 De La Gauchetière Street West
Suite 900
Montréal, QC, Canada
H3B 5H4

T 514.954.2555
F 514.879.9015

Toronto

Bay Adelaide Centre, East Tower
22 Adelaide Street West
Toronto, ON, Canada
M5H 4E3

T 416.367.6000
F 416.367.6749

The information contained herein is of a general nature and is not intended to constitute legal advice, a complete statement of the law, or an opinion on any subject. No one should act upon it or refrain from acting without a thorough examination of the law after the facts of a specific situation are considered. You are urged to consult your legal adviser in cases of specific questions or concerns. BLG does not warrant or guarantee the accuracy, currency or completeness of this publication. No part of this publication may be reproduced without prior written permission of Borden Ladner Gervais LLP. If this publication was sent to you by BLG and you do not wish to receive further publications from BLG, you may ask to remove your contact information from our mailing lists by emailing unsubscribe@blg.com or manage your subscription preferences at blg.com/MyPreferences. If you feel you have received this message in error please contact communications@blg.com. BLG's privacy policy for publications may be found at blg.com/en/privacy.

© 2024 Borden Ladner Gervais LLP. Borden Ladner Gervais LLP is an Ontario Limited Liability Partnership.