lavery
Lawyers

Getting on the fast track: Accelerating patent examination in Canada

May 10, 2017

Authors

Serge Shahinian

Partner, Patent Agent

Gonzalo Lavin

Partner, Patent Agent

Would you like to obtain a Canadian patent quickly? You're in luck – mechanisms are available to accelerate patent examination at the Canadian Intellectual Property Office (CIPO), depending on the technology, the situation and your particular needs.

Benefits

Such acceleration of examination greatly reduces the time to receive an Examiner's report from CIPO – down to within a few months, as opposed to about a year or more depending on the technology area. Subsequently, the accelerated "rhythm" of examination is maintained throughout examination, assuming all requirements are maintained. The overall result is that a Canadian patent may be obtained significantly faster than if the application was examined under the regular track of examination.

How does it work? Choice of three mechanisms

In all cases, the first requirement is to request regular examination of the patent application, which may be done at filing or up to 5 years later. For a Canadian national phase of a PCT application, the deadline to do so is 5 years from the PCT filing date. Once regular examination has been requested, there are three mechanisms for acceleration:

1. "Special Order" accelerated examination

Requesting "Special Order" accelerated examination pursuant to subsection 28(1)(*a*) of the *Patent*

Copyright (c) Lavery, de Billy, S.E.N.C.R.L. - L.L.P.

Rules entails filing the request for acceleration together with payment of an official fee. Interestingly, the request may be made by "any person", i.e. the Applicant or a third party (the latter being extremely rare), if failure to advance the application is likely to prejudice that person's rights. Further, if the application has not yet been published, a request for early publication, which may only be made by the Applicant, is required. CIPO often shortens the delay to file a response to an Examiner's report for "Special Order" applications (typically 3 months instead of 6 months for regular examination), which means that the Applicant must be ready to act more quickly when an Examiner's report is issued.

This mechanism is the most broadly applicable of the three. It does not depend on the area of technology, and offers the greatest flexibility in the claims which can be presented, as any number or type of claims may be presented as long as their subject matter finds sufficient basis in the application as filed. It should be noted, however, that this mechanism is unavailable or lost if an extension is requested, or if the case undergoes a period of abandonment, after April 30, 2011. Overall, this mechanism is a good option if flexibility in claiming is important and/or the other mechanisms are unsuitable.

2. "Green-tech" accelerated examination

As the name suggests, this mechanism is directed to patent applications in green technologies, falling under the following broad definition:

> *"technology the commercialization of which would help to resolve or mitigate environmental impacts or to conserve the natural environment and resources"*

Requesting "Green-tech" accelerated examination pursuant to subsection 28(1)(*b*) of the *Patent Rules* entails filing a request for acceleration together with a declaration that the application relates to a green technology as defined above. No official fee is required. Otherwise, this mechanism is similar to "Special Order" accelerated examination, in that there is flexibility in the claims that may be presented, the accelerated track is unavailable/lost in cases of extension or abandonment, and publication or a request to that effect is required. Overall, this mechanism is a good option if the application relates to a green technology.

3. Patent Prosecution Highway (PPH)

The PPH is based on a series of agreements between CIPO and partner patent offices, under which an accelerated examination may be carried out by CIPO based on a positive "work product" of the partner patent office in their counterpart application. The "work product" typically refers to claims allowed or granted by the partner patent office, but may also refer to claims defined as being novel and inventive by the partner patent office when acting as a PCT International Search/Examination authority (including CIPO) in a counterpart PCT application. Currently, CIPO has PPH agreements with over two dozen partner patent offices (the list may be found here), and is constantly adding more.

While requesting PPH accelerated examination does not require an official fee, it typically requires submitting an amendment together with the request, to bring the Canadian claims in line with those of the partner patent office on which the request is based. Various formalities of Canadian practice may also be addressed at that time. Further, publication of the application or a request to that effect is required. However, unlike the mechanisms described above, a PPH request can no longer be made if CIPO has already issued a first Examiner's report.

The main difference between the PPH and the other mechanisms noted above is that under the PPH, the Canadian claims must "sufficiently correspond" to those of the partner patent office, thus resulting in reduced flexibility of claiming in the Canadian case. While extension or abandonment does not preclude/terminate use of the PPH (in contrast to the other mechanisms), PPH accelerated

Copyright (c) Lavery, de Billy, S.E.N.C.R.L. - L.L.P.

status will be lost if the claims are subsequently amended to no longer “sufficiently correspond” to those of the partner patent office. Overall, the PPH is a good option if the counterpart allowed/granted claims cover all the claims of interest to be pursued in Canada. We invite you to read our previous newsletter on the double-patenting practice in Canada for potential pitfalls of PPH accelerated examination in cases where multiple claim sets are being pursued in multiple related applications in the foreign jurisdiction (a common strategy in the US, for example).

Ready, set, go!

So if you have a need for speed, please contact us to determine the mechanism to accelerate examination that best suits your case, and fasten your seat belt!

Copyright (c) Lavery, de Billy, S.E.N.C.R.L. - L.L.P.