Patent applications and processing times – What's right for you

January 6, 2023

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Part 1: Why slow down or speed up the process?

Slowing down the process

Why would anyone want to slow down the process when it already usually takes several years for a patent to be issued?

- Cash flow
- Uncertainty for competitors
- Possibility of changing the scope
- Possibility of filing a divisional application

In some cases, cash flow may justify spreading expenses over a longer period of time. Keeping an application pending longer may also be beneficial from a business perspective. In fact, it could create uncertainty for competitors, who cannot easily determine the scope of the exclusive right that may be granted to you. Moreover, claims are easier to amend while the application is pending. Lastly, filing a divisional application is usually only possible when the parent patent application is still pending.

Speeding up the process

If slowing down the process is so advantageous, why speed it up?

- Proof of patentability before expanding the patent application family
- Monetary valuation or capital raising

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After filing a priority application, the applicant has 12 months to file corresponding applications in other countries. Filing abroad can entail considerable expenses. It may therefore be advantageous to obtain results quickly so you can make the best decision about filing applications in other countries. An issued patent is a far better indication of a technology's value. This can have a major impact on a company's valuation and, at the same time, allow for additional capital to be raised. Moreover, filing a patent application will not prevent infringers from marketing your technology; you may only commence proceedings in front of the court with an issued patent. The possibility of instituting legal proceedings could drastically change the tone of negotiations with your competitors —and sometimes your suppliers, too.

Strategies and costs

Special provisions exist to speed up and slow down the process in many territories. For the purposes of this exercise, we will discuss patent applications in Canada, the United States and Europe. We will also look at international patent applications, namely PCT applications.

Part 2: Slowing down the process

Canada

With regard to slowing down the process, the simplest strategy in Canada is to wait before requesting examination as much as possible. While the provision for this has changed over the years, applicants now have four (4) years from the date of filing a Canadian application to request an examination.

For PCT national phase entry, Canada allows an extension of the standard 30-month time limit to up to 42 months under certain conditions. However, examination request dates and maintenance fees remain the same. Therefore, this is beneficial in the short term only.

For each examiner's report (also called office action), it is possible to request an extension of the time limit by two months before the original time limit expires. This request must be accompanied by the late fee and is only accepted under certain conditions. The other option is to not reply to the examiner's report and to wait until the application is deemed abandoned. The application may then be reinstated by filing a response to the examiner's report and paying an additional fee.

It is important to note that a Canadian application is no longer eligible for accelerated processing if an extension of the time limit was obtained for it or it was reinstated. Furthermore, while an application is abandoned, and even if it is later reinstated, third parties could obtain certain rights to the technology.

United States

In the United States, an extension of time fee may be paid at the same time as the reply to an examiner's report is filed. However, the maximum time limit must not exceed six (6) months. It is also possible to file a request (or petition) for the suspension of the time limit for replying to an examiner's report (by paying the relevant fee, of course). This request is only acceptable under certain conditions and cannot exceed six (6) months.

Similarly, a request may be filed to defer the examination of the application, which may delay examination by up to three (3) years after the priority date. Once again, certain conditions must be met and there is a fee to pay.

Europe

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As is the case for Canada, for each examiner's report, a request can be made to extend the time limit by two (2) months before the original time limit expires. However, unlike in Canada, there are no fees or conditions for this request to be accepted.

The other option is to not reply to the examiner's report and to let the application lapse. The application may then be reinstated by filing a response to the examiner's report and paying an additional fee.

As for the 10-day rule, it will continue to apply until November 2023. This rule, which was established at a time when communications were still sent by mail, provides that a dated communication is deemed to have been delivered ten (10) days after the date of the document—the time limit is therefore automatically extended by ten (10) days. All things considered, the elimination of this rule is a plus in helping prevent various communication problems.

PCT

When it comes to slowing things down, the PCT application itself may be used to slow down the process. In fact, the international patent application system provides allows a decision on international applications to be made as late as 30 months from the priority date. The PCT system is based more on the reservation of rights than on slowing down the process. Nevertheless, both from cash flow and filing strategy standpoints, the longer time limit for making decisions may be beneficial.

Summary–slowing down the process

CA:

Postpone filing the Canadian application or entering the national phase.
Push back the examination request.
Apply for an extension of the time limit.
Do not respond, then apply for reinstatement.

US:

Pay time limit extension fees.
Submit a request to suspend processing.
Submit a request to defer the examination.

EP:

Apply for an extension of the time limit.
Apply the 10-day rule.
Do not respond, then pay the fees to have the application reinstated.

PCT:

Take advantage of the 30-to-42-month extension for each country.

Part 3: Fast track

Canada

Of course, the best way to speed up the process is to request an examination as soon as possible and, above all, not put off replying to the examiner's reports received.

After requesting an examination and before receiving the first examiner's report, it is possible to request that the application be processed expeditiously. The request requires that the Canadian application be published and it may be subject to a number of conditions. An applicant whose rights may be prejudiced by the examination time limit can pay an additional fee to expedite the process.

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When a patent application relates to so-called green technology or the COVID-19 pandemic, the notion of prejudice does not apply and no fee is due. Speeding up the process is also possible by taking advantage of the outcome of a corresponding application in another jurisdiction deemed credible by the Canadian Patent Office (e.g., Europe, United States, Japan, etc.). This is referred to as a PPH (patent prosecution highway) request (the French translation by "*autoroute de traitement des demandes de brevet*", while quite accurate, is rarely used).

United States

Those who have the means to do so may pay an acceleration fee when filing the application in the US. The intent is then to complete the entire process within 12 months. The ability of the US Patent Office to meet the expectation is also taken into consideration before accepting the request.

Special treatment may also be requested for a patent application where the health or age of one of the inventors warrants this. Such a request may also be made when the technology in the patent application is "green" or relates to "counterterrorism."

The US also takes part in the PPH system, and the decision made regarding a corresponding application in another jurisdiction can also help speed up the process.

Evidently, it is important not to delay replying to the examiner's reports received, no matter how else you may choose to accelerate the process.

Europe

The European Patent Office accepts PPH requests and also offers the "PACE" programme, which helps speed up processing times (search and/or examination) without any fees or specific conditions other than responding to examiner's reports in a timely manner. The European Patent Office's ability to handle the requests is also taken into account.

PCT

Quickly completing national phase entries (i.e., well before the 30-month time limit) makes it possible to proceed faster with the substantive examination in each jurisdiction.

During the international phase of the PCT, attempts can be made to move the process along before entering the national phase. This procedure often dubbed as a "Chapter II request" does not guarantee that time will be saved, but certain questions may be anticipated thus avoid multiple delays in front of different examiners.

Summary – speeding up the process

CA:

File the Canadian application or enter the national phase as soon as possible.
Make the examination request as soon as possible.
Respond quickly to examiner's reports.
Request accelerated processing based on PPH, green technology, COVID-19 technology or possible prejudice.

US:

Pay acceleration fees when filing.
Request accelerated processing through the PPH system.
Respond quickly to examiner's reports.
Submit a petition to make the application special (on the basis of age or health, green technology or counterterrorism technology).

EP:

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Request access to PACE programme.
Request accelerated processing through the PPH system.
Quickly respond to examiner's reports.

PCT:

Enter national phase as soon as possible.
Apply for examination under "Chapter II."

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