



## HOW TO ACCELERATE A CANADIAN PATENT APPLICATION?

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The Canadian Intellectual Property Office (CIPO) will not begin examination of a patent application, unless a request for examination has been made within five years from the filing/priority date of the application.

Depending on the technological field of the invention, a first Office Action is then usually issued by the CIPO within a few months to a few years from the filing date of the request for examination. The Applicant is then entitled to file a response within 6 months from the emission date of the Office Action. An unlimited number of Office Actions may be issued before issuance of a Notice of Allowance. Thus, prosecution of a patent application can be a lengthy process.

Fortunately, once the application has been published and the request for examination has been filed, expedited patent examination of an application is available upon request in Canada. There are four options to expedite examination of a patent application:

- 1) If the subject-matter of the invention is green technology;
- 2) Through Prosecution Highway programs (Patent Prosecution Highway (PPH) program and Patent Cooperation Treaty-Patent Prosecution Highway program (PCT-PPH));
- 3) Through requesting accelerating examination upon a fee to avoid jeopardizing the rights of the entity seeking accelerated examination; and
- 4) Voluntary amendment.

Each option may present different requirements to make a request or is entitled to make such a request, when the request can be made, and the fees involved.

### 1) Green technology

A patent application can benefit from an expedited examination if the application relates to green technology. The Applicant must submit the following declaration to

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the CIPO: “the application relates to technology the commercialization of which would help to resolve or mitigate environmental impacts or conserve the natural environment resources”. The Canadian Patent Office has yet to provide a detailed definition of what constitutes green technology and has purposely left the definition broad so as to encompass a wide range of environmentally beneficial inventions. This option is still open once the examination has begun.

### ***First Patent Office Action***

A first Patent Office Action should be issued within two months of the filing date of the expedited examination request. The Applicant is entitled to respond within three months from the emission date of the Patent Office Action; a second Patent Office Action or a response from the Examiner should be issued within two months of receiving the Applicant’s response.

If the Applicant requests an extension for doing anything with respect to the application, or if the application is abandoned before being reinstated, the application no longer benefits from the expedited examination.

### ***Fees***

There is no governmental fee associated with this type of expedited examination.

## **2) Prosecution Highway programs (PPH and PCT-PPH)**

The PPH programs provide that a Canadian patent application be advanced out of turn for examination if:

- 1) a positive report was established regarding a corresponding international patent application (PCT) by the CIPO or a foreign cooperating patent office during the international phase (PPH-PCT); and/or
- 2) there are one or more claims of a corresponding regular national patent application to be found allowable by a foreign cooperating patent office (PPH).

In order for the Canadian application to be advanced out of turn under the PPH or PCT-PPH programs, the following criteria must also be met:

- i. the PPH request is filed by the Applicant;
- ii. examination of the application must not have already begun;
- iii. the Canadian patent application and the foreign patent application (PPH) or the Canadian patent application and the PCT application (PPH-PCT) forming the basis of the PPH request must have the same earliest date (this is the filing or priority date); and

- v. all claims on file in the Canadian patent application, as originally filed or as amended, sufficiently correspond (i.e. be of the same category and of the same or similar scope) to one or more of the claims indicated as allowable by the foreign patent office (PPH) or indicated as having novelty, inventive step and industrial applicability in the international report (PPH-PCT).

The foreign partner patent offices currently under the PPH program (either through the Global PPH or bilateral agreements) are Australia, China, Europe, Denmark, Finland, Germany, Hungary, Iceland, Israel, Japan, Korea, Mexico, Nordic Patent Institute, Norway, Portugal, Russia, Spain, Sweden, United Kingdom, Singapore and United States of America.

### **First Patent Office Action**

A first communication from the Examiner should be issued within three months of the filing date of the request for expedited examination under the Prosecution Highway programs and the Applicant is entitled to respond within six months from the emission date of the Patent Office Action. A second Patent Office Action or a response from the Examiner should be issued within three months of receiving the Applicant's response. If the application is abandoned and then reinstated, the application still remains in the PPH program.

### **Fees**

There is no governmental fee associated with this type of expedited examination.

### **3) Accelerated Examination**

Under section 28(1)(a) of the *Patent Rules*, the CIPO shall advance out of its routine order the examination of the application on the request of any person, on payment of the fee, if failure to advance the application is likely to prejudice that person's rights. The CIPO will likely grant this type of accelerated examination for one of the following reasons: infringement is likely to occur in Canada, a monetary grant was allowed, an agreement with a third party was concluded or any other valuable reason. This option is still open once the examination has begun.

### **First Patent Office Action**

A first Patent Office Action should be issued within three months of the filing date of the accelerated examination request. The Applicant is entitled to respond within three months following the emission date of the Patent Office Action, and a second Patent

Office Action or a response from the Examiner should be issued within three months of receiving the Applicant's response.

If the Applicant requests an extension for doing anything with respect to the application or if the application is abandoned, the application no longer benefits from the expedited examination, but a second accelerated examination could be requested upon payment of the fee.

**Fees**

This type of request for accelerated examination must be accompanied by a government fee of \$500.

**4) Voluntary Amendment**

Once the request for examination has been filed, before a notice of allowance is issued, the Applicant may at any time amend the claims in the hope of reducing the number of rejections and to accelerate the issuance of a notice of allowance. The set of claims may be based on a corresponding granted set of claims.

**First Patent Office Action**

A first communication from the Examiner should be issued within 12-24 months of the filing date of the voluntary amendment and the Applicant is entitled to respond within six months from the emission date of the Patent Office Action. A second Patent Office Action or a response from the Examiner should be issued within 12 months of receiving the Applicant's response. If the application is abandoned and then reinstated, the application still follows its regular path.

**Fees**

There is no governmental fee associated with the filing of a voluntary amendment.

**Table** summarizing the delay for emitting first and second Patent Office Actions, the time limit for responding to the Patent Office Actions and the fees associated with the three options of expediting examination.

Expedited Examination Options	Emission of a first Office Action <sup>1</sup>	Time limit to respond to the first Office Action <sup>2</sup>	Emission of a second Office Action <sup>3</sup>	Government fee (for each option)  (CAD \$)
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<b>Green technology</b>	2 months	3 months	2 months	None
<b>PPH programs</b>	3 months	6 months	3 months	None
<b>Accelerated Examination</b>	3 months	3 months	3 months	\$500
<b>Voluntary Amendment</b>	12-24 months	6 months	12-24 months	None

<sup>1</sup> From the filing date of the request

<sup>2</sup> From the emission date of the first Patent Office Action.

<sup>3</sup> From the response date



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