

# **PATENT PROTECTION IN CANADA AND THE UNITED STATES: TAKING ADVANTAGE OF THE PATENT PROSECUTION HIGHWAY BETWEEN CIPO AND THE USPTO**

## **Abstract**

Since the implementation of the Patent Prosecution Highway (PPH) pilot program between the Canadian Intellectual Property Office (CIPO) and the United States Patent and Trademark Office (USPTO) in 2008, the PPH has provided applicants with an accelerated patent examination proceeding that allows them to obtain patents more quickly in both countries and permitted the patent offices to share search results with one another, thereby reducing the workload and improving examination quality. The PPH pilot program therefore enables savings in time, cost and effort and encourages a more productive, quality-based patent system.

**Keywords:** Patent Prosecution Highway, PPH, Canada, United States, Accelerated examination, Examination practice.

*Desde a implementação do programa piloto Patent Prosecution Highway (PPH) entre o Canadian Intellectual Property Office (CIPO) e o United States Patent and Trademark Office (USPTO) em 2008, o PPH promoveu aos requerentes um processo acelerado de exame de patentes que lhes permite obter patentes mais rapidamente em ambos os países e permitiu que os escritórios de patentes compartilhassem os resultados da pesquisa entre si, reduzindo assim a carga de trabalho e melhorando a qualidade do exame. O programa piloto PPH, portanto, permite economia de tempo, custo e esforço e incentiva um sistema de patentes mais produtivo e baseado em qualidade.*

**Palavras-chave:** Patent Prosecution Highway, PPH, Canadá, Estados Unidos, Exame acelerado, Prática de exame.

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Since January 28, 2008, the Canadian Intellectual Property Office (CIPO) and the United States Patent and Trademark Office (USPTO) have implemented a Patent Prosecution Highway (PPH) pilot program that allows the search and examination results of an application to be shared between offices, the goal being to streamline prosecution and allowance in both countries. The PPH pilot program is meant to allow applicants to not only obtain patents more quickly and efficiently, but to permit each office to benefit from the work previously done on a patent application, thereby reducing the workload and improving examination quality. The pilot program has since evolved into the Global Patent Prosecution Highway (GPPH) pilot program, in which twenty-seven intellectual property offices currently participate.<sup>1</sup>

## **Canadian PPH Requests and Procedures**

In order to be eligible to enter the pilot program in Canada, the following requirements must be met:

- the Canadian application and the corresponding PPH partner application must have the same earliest priority or filing date;
- the corresponding application must have one or more claims that have been determined to be allowable;

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<sup>1</sup> <https://www.jpo.go.jp/e/toppage/pph-portal/globalpph.html>

- the claims in the Canadian application must sufficiently correspond to the claims allowed in the corresponding application;
- the Canadian application must be open to public inspection; and
- substantive examination of the Canadian application must not have begun.

A completed PPH request form must be submitted to CIPO along with all the supporting documentation, including copies of any office actions and the notice of allowance issued with respect to the corresponding application, a copy of the claims found to be allowable in the corresponding application, and translations of any documents that are not available in English or French.

It should be noted that a divisional application arising from a parent PPH application is not automatically granted PPH status. If an applicant wishes to have a divisional application enter the pilot program, a new PPH request and all necessary documentation must be submitted. This new PPH request may be submitted at the same time as the request for a new divisional application.

In preparing the PPH request, the claims in the Canadian application, as originally filed or as amended, must be reviewed to ensure that they sufficiently correspond to the claims indicated as allowable in the corresponding application. Claims “sufficiently correspond” when, accounting for differences due to translations and claim format, the claims in the Canadian Application are of the same or similar scope, or are narrower in scope than the claims in the corresponding application. A claims correspondence table should be included in the request if necessary.

CIPO will consider the corresponding claims to be allowable as indicated in work products such as a Written Opinion from an International Search Authority, where the claims are explicitly identified as patentable, an Examination Report and a Granted Patent Publication.

A PPH request can be made at CIPO if the Canadian application claims priority to a United States (U.S.) provisional patent application and if a U.S. national application claiming priority to the same U.S. provisional patent application is determined to be allowable by the USPTO, as the U.S. national application and the Canadian application will share the same earliest date, i.e., the filing date of the U.S. provisional patent application. The U.S. “national application” refers to either: a provisional application, a non-provisional utility patent application, a continuation patent application, a continuation-in-part patent application, or a divisional patent application. Where the U.S. national application claims internal priority or is a continuation-in-part of more than one application, the earliest date of the U.S. national application is the earliest date of the related U.S. applications.

Once a Canadian application has been accepted into the pilot program, an Examiner will assess the claims. An application that contains claims to non-statutory subject matter may still receive accelerated examination, as long as the claims on file sufficiently correspond to those allowed in the corresponding application. The presence of claims to non-statutory subject matter alone is not a reason to remove an application from the pilot program without first giving the applicant an opportunity to address the defect by way of amendment or argument. Where the Examiner raises an objection, the applicant should amend the claims to conform with the Canadian *Patent Act* and *Patent Rules*. Otherwise, if the applicant is unwilling to amend the claims or fails to provide persuasive arguments as to why the claims contain statutory subject-matter, the Examiner may remove the application from the pilot program. This is because one of the goals of the pilot program is to expedite prosecution with a view towards allowance of the application. An impasse between the applicant and the Examiner does not achieve that goal.

The Examiner may also remove an application from the pilot program if the claims are amended such that the amended claims do not sufficiently correspond to the claims indicated as allowable in the corresponding application. If a first office action is issued and the application is then removed from the pilot program, the applicant cannot apply to re-enter the pilot program. This is consistent with CIPO’s practice of not granting PPH requests for applications where substantive examination has begun. Therefore,

care should be exercised when amending the claims to ensure that they sufficiently correspond to those allowed in the corresponding application throughout prosecution.

### **PPH Pilot Program Between Canada and the US**

It has been nearly 15 years since the pilot program between Canada and the U.S. was first implemented, and it is clear that this program has been a success. The PPH provides applicants with a number of benefits, the main advantage being that once allowance has been obtained in one country, the corresponding application in the second country may be amended or conformed to the allowed claims. This expedites examination and provides the applicant with substantially similar patents and claims for both jurisdictions. The applicant thus obtains uniform protection throughout most of North America.

Further, the pilot project focuses on sharing work between patent offices in order to access developments in examinations and to save time and money. Applicants do not encounter any additional costs when a PPH request is submitted, and they can expect to receive a first examination report within three months of a compliant request. This time period is notably shorter than the average pendency for non-PPH applications, which is 13 months.<sup>2</sup> Moreover, between July and December 2021, a significantly higher percentage of PPH applications based on national work products (25%) and PPH applications based on international (PCT) work products (17%) were allowed without an examination report, compared to 3% for non-PPH applications.<sup>3</sup> This leads to savings of time, cost and effort, from both CIPO's and the applicants' perspectives.

The benefits of the pilot program are being recognized by applicants, as the use of the PPH pilot program between CIPO and the USPTO has increased over the last

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<sup>2</sup> <https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>

<sup>3</sup> <https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>

decade. In 2011, CIPO received 597 requests based on claims allowed in the US. By comparison, CIPO received 2050 requests in 2021.<sup>4</sup>

The PPH pilot program is a great contribution to the important and ever-growing trade and intellectual property protection between the two countries. The US-Canada Free Trade Agreement (FTA), in force since 1989, and the North American Free Trade Agreement (NAFTA) signed in 1994, which includes Mexico, have not only brought a remarkable increase in trade, but have also increased commercial integration between Canada and the U.S.

This well-established Canada-U.S. relationship translates into Canadian patents having significant commercial value to companies doing business in the U.S. Often, a process or a product protected under a U.S. patent will end up being either manufactured in Canada or exported to Canada. Although a U.S. patent is considered the most effective patent protection in the world, filing for a Canadian patent is just as important in building a company's intellectual property portfolio.

Inventors and companies around the world have increasingly recognized the value of protecting their intellectual property rights worldwide. If patent or industrial design protection in the U.S. is important for an applicant, he or she should also consider obtaining protection in Canada in order to cover the North American market, particularly in view of the trading relationship between the two countries.

While significant differences exist between U.S. and Canadian patent practice, they remain similar in many ways, and this integration should be explored by Brazilian and other intellectual property owners. For example, utility models filed in Brazil can be used as priority for filing patent applications in both Canada and the U.S. Although they require some minor changes, they have the same effect as normal patent applications and will have the same term as a patent.

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<sup>4</sup> <https://www.jpo.go.jp/e/toppage/pph-portal/statistics.html>

When a patent application is filed in the U.S., examination is requested automatically, while in Canada the applicant is granted a four-year period in order to request examination. This difference opens up interesting possibilities for applicants. A first option is to file applications in the U.S. and Canada at the same time, then wait until the application is granted in the U.S. before requesting examination in Canada and applying for the PPH. This will likely expedite the allowance of the patent application at CIPO at a lower cost. It should also be noted that any prosecution costs for Canadian applications are often reduced when they are adapted to corresponding U.S. applications.

With reference to *Festo*,<sup>5</sup> it may be beneficial to first file an application in Canada and then request expedited examination at CIPO in order to clearly define the scope of the claims before filing an application in the U.S. within the priority year. A PPH request may then be submitted at the USPTO to receive an early allowance.

However, it is important to emphasize that the PPH is not recommended for all types of inventions, since differences exist between the two countries. In the U.S., subject matter related to higher life forms and methods of medical treatments are patentable, while this subject matter remains unpatentable in Canada. Furthermore, Canada grants a one-year grace period for filing an application from the date of the public disclosure. In other words, the Canadian filing date must be no more than one year after the disclosure. By contrast, in the U.S., the one-year grace period applies to the date of the priority application.

It is highly recommended that all applicants wishing to file in the U.S. or Canada consult a patent agent about the possibility of filing a PPH request and obtain further information as to whether this tool is appropriate for the invention in question.

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<sup>5</sup> *Festo Corp. v. Shoketsu Kinzoki Kogyo Kabushiki Co.*, 525 U.S. 722 (2002)