

Requirements and Procedures to File a Request to CIPO for the PCT-PPH (CIPO ISA/IPEA)

Request to CIPO for accelerated examination under the PCT-PPH (CIPO ISA/IPEA)

An applicant should file a request for accelerated examination under the PCT-PPH (CIPO ISA/IPEA) by submitting a letter requesting accelerated examination under the PCT-PPH accompanied by a completed PCT-PPH request form and the relevant supporting documents.

The PCT-PPH request form must be the uppermost document to ensure that the request is correctly processed. The PCT-PPH request form is given in Annex A and is also available online at the CIPO PPH website.

Requirements for requesting accelerated examination under the PCT-PPH (CIPO ISA/IPEA)

There are six requirements for requesting accelerated examination under the PCT-PPH (CIPO ISA/IPEA). These are:

- (a)** The CIPO application has entered national phase on or after January 31, 2011.
- (b)** A work product in the international phase of the corresponding PCT international application (the “international work product”) indicates that the subject matter of at least one claim appears to be novel, inventive and industrially applicable. The international work product is one of following documents established by CIPO as the ISA and/or IPEA: the Written Opinion of the International Searching Authority (WO-ISA), the Written Opinion of the International Preliminary Examining Authority (WO-IPEA) or the International Preliminary Report on Patentability (IPRP).

Note that the ISA and the IPEA which produced the WO-ISA, WO-IPEA and the IPRP are limited to CIPO, but, if priority is claimed, the priority claim can be to an earlier application filed with any member of the Paris Convention or the WTO, see example A' in Annex D (application ZZ is an earlier application filed with any member of the Paris Convention or the WTO).

Further, in case any observation is described in Box VIII of the WO-ISA, WO-IPEA or IPRP which forms the basis of a PCT-PPH request, the applicant must identify and explain why the claim(s) is/are not subject to any observation described in Box VIII.

Illustrated examples of Canadian patent applications that may request accelerated examination under the PCT-PPH are given in Annex D.

- (c)** The relationship between the CIPO national phase application and the corresponding international application satisfies one of the following requirements:
 - (i) The application is a national phase application of the corresponding international application (see Diagrams A, A', and A'' in Annex D),
 - (ii) The application is a national application which is the basis of the priority claim of the corresponding international application (see Diagram B in Annex D),

- (iii) The application is a national phase application of an international application claiming priority from the corresponding international application (see Diagram C in Annex D),
- (iv) The application is a national application claiming priority from the corresponding international application (see Diagram D in Annex D), or
- (v) An application which derived from an application referred to in any of (i) – (iv), (for example, a divisional application or an application claiming internal priority; see Diagrams E1 and E2 in Annex D).

Where the CIPO national application is not a national phase entry of the same international application (that contains one or more claims having novelty, inventive step and industrial applicability), the applicant must identify the relationship between the corresponding international application and the CIPO national phase application.

(d) All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated as having novelty, inventive step and industrial applicability in the international work product for the corresponding international application.

Claims are considered to "sufficiently correspond" where, except for differences due to translations and claim format, the claims on file are of the same or similar scope as the claims having novelty, inventive step and industrial applicability in the international work product, or the claims of the application are narrower in scope than the claims having novelty, inventive step and industrial applicability in the international work product.

In this regard, a claim that is narrower in scope occurs when a claim having novelty, inventive step and industrial applicability in the international work product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims) of the application.

A claim of the application which introduces a new/different category of claims to those claims having novelty, inventive step and industrial applicability in the international work product is not considered to sufficiently correspond. For example, the claims having novelty, inventive step and industrial applicability in the international work product only contain claims to a process of manufacturing a product, then the claims of the application are not considered to sufficiently correspond if the claims of the application introduce product claims that are dependent on the corresponding process claims.

An example of claims which comply with requirement (d) is given in Annex C.

(e) The CIPO application is open to public inspection.

(f) CIPO has received a request for examination, but has not begun examination of the application.

Required documents for accelerated examination under the PCT-PPH (CIPO ISA/IPEA)

The applicant is required to include a claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims having novelty, inventive step and industrial applicability in the international work product. It is necessary to explain the sufficient correspondence of each claim. A sample claim correspondence table is given in Annex B.

Procedures for filing a request for accelerated examination under the PCT-PPH (CIPO ISA/IPEA)

The applicant files a letter requesting accelerated examination under the PCT-PPH, a completed PCT-PPH request form, and the relevant supporting documents as noted above.

The request for accelerated examination under PCT-PPH may be made by mail, fax, or electronically via the Industry Canada website as per the CIPO patent correspondence procedures. The PCT-PPH request form must be the uppermost document to ensure that the request is correctly processed. The PCT-PPH request form is given in Annex A and is also available online at the CIPO PPH website. In case any observation is described in Box VIII of the WO-ISA, WO-IPEA or IPRP which forms the basis of a PCT-PPH request, the applicant must identify and explain why the claim(s) is/are not subject to any observation described in Box VIII.

All subsequent correspondence with the office must be clearly identified on each page as relating to the PCT-PPH to ensure that the correspondence is correctly processed. Please prominently mark each page of the covering letter in subsequent correspondence with the term "PPH".

It is recommended that the applicant not only focus on the claims when making the PCT-PPH request but additionally review the application as a whole and amend the application to correct any known informalities.

These informalities may include defects such as a statement that incorporates by reference another document (section 81(1) of the *Patent Rules*), and reference to documents that are not available to the public (subsection 81(2) of the *Patent Rules*).

The request for accelerated examination under the PCT-PPH must also be accompanied by, or preceded by a request for examination.

If the CIPO application is not open for public inspection at the time of request, the applicant must authorize the application be made open for public inspection.

Procedures of examination under the PCT-PPH (CIPO ISA/IPEA)

The PCT-PPH request will be considered by a patent examiner and, if all requirements are met, the application will receive accelerated examination. Each Canadian patent application will be examined in accordance with the Canadian *Patent Act* and *Patent Rules* and CIPO's Patent Office Practice.

If the patent examiner determines that the claims on file do not sufficiently correspond to one or more of those claims indicated as having novelty, inventive step and industrial applicability in the international work product of the corresponding international application, the applicant will be notified that the request for accelerated examination is not granted. To re-enter the PCT-PPH, the applicant must amend the claims accordingly and reapply altogether.

At any time during the prosecution of a PCT-PPH application, if the patent examiner determines that the claims on file do not sufficiently correspond to one or more of those claims having novelty, inventive step and industrial applicability in the international work product of the

corresponding international application, the applicant will be notified that the application will await action in its regular turn.

All amendments to the claims made with the request for accelerated examination under the PCT-PPH will be entered regardless of whether the request is granted or not.

ANNEX A

PCT-PPH (CIPO ISA/IPEA) Request Form

Request for accelerated examination at CIPO under the PCT-PPH (CIPO ISA/IPEA)

Application information

CIPO application number: _____

Corresponding PCT application number(s): _____

Claims on file and claim correspondence table

(a) The claims on file correspond to one or more of those claims indicated as novel, inventive and industrially applicable in the WO-ISA, WO-IPEA and/or IPRP established by CIPO as the ISA and/or IPEA; or

(b) The applicant is amending the claims with this request to correspond with one or more of those claims indicated as novel, inventive and industrially applicable in the WO-ISA, WO-IPEA and/or IPRP established by CIPO as the ISA and/or IPEA;

and

A claim correspondence table is completed.

Box VIII observations

In case any observation is described in Box VIII of the WO-ISA, WO-IPEA and/or IPRP which forms the basis of the PCT-PPH request, the applicant has attached an explanation of why the claims are not subject to the observation described in Box VIII.

Relationship between the corresponding international application and the CIPO national phase application

Where the CIPO national application is not a national phase entry of the same international application (that contains one or more claims having novelty, inventive step and industrial applicability), the applicant must identify the relationship between the corresponding international application and the CIPO national phase application.

Other amendments to application (Optional)

Either:

(a) The applicant has reviewed the application, and the specification on file conforms with Canadian patent application requirements and practice; or

(b) The applicant is amending the specification to conform with Canadian patent application requirements and practice.

ANNEX B

Claim Correspondence Table

Claim number (CIPO national phase application)	Claim number (corresponding international application)	Comment

Examples:

Claim Correspondence Table

Claim number (CIPO national phase application)	Claim number (corresponding international application)	Comment
1 to 5	1 to 5	Applicant has amended the claims to the present claims having the same scope as the claims of the applicant's corresponding international application. Claims 1 to 5 were indicated as having novelty, inventive step and industrial applicability in the WO-ISA dated ___.
6 to 8	6 to 8	Applicant has amended the claims to the present claims having the same scope as the claims of the applicant's corresponding international application. Claims 6 to 8 were indicated as having novelty, inventive step and industrial applicability in the IPRP dated ___.

ANNEX C

With regard to requirement (d), the claims in the following example are considered to "sufficiently correspond":

Claim Correspondence Table

CIPO national phase application claims	Subject matter	International application claims	Subject matter	Comment
1	A	1 (independent)	A	The same as corresponding international application claim 1.
2	A + a + b	2 (dependent on 1)	A + a	Claim 2 has the additional technical feature "b" in relation to the corresponding international application claim 2.
3	A	3 (dependent on 1)	A + b	Similar to corresponding international application claim 1 except for claim format.
4	A + d			Claim 4 has an additional technical feature "d" in relation to the corresponding international application claim 1, where "d" is supported in the description but is not claimed in the corresponding international application.
<p><i>Where "A" is the subject matter and "a", "b", and "d" are the additional technical features which narrow (further restrict) the scope of the subject matter.</i></p>				

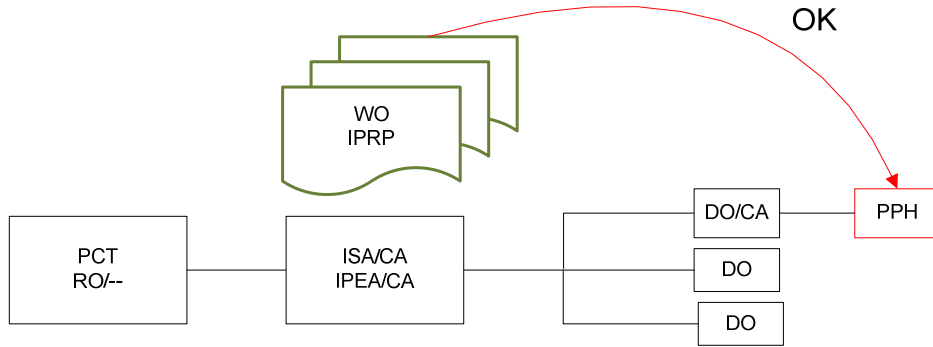
A CIPO national phase application claim which introduces a new/different category of claims to those claims indicated as having novelty, inventive step and industrial applicability in the corresponding international application is not considered to sufficiently correspond. For example, where the corresponding international application only contains claims to a process of manufacturing a product, then the CIPO national phase application claims are not considered to sufficiently correspond if the CIPO national phase application claims introduce product claims which are independent or dependent on the corresponding process claims.

Please note that the CIPO national phase application need not include "all" claims determined to have novelty, inventive step and industrial applicability in the corresponding international application (the deletion of claims is allowable). For example, in the case where the corresponding international application contains 5 claims determined to have novelty, inventive step and industrial applicability, the corresponding CIPO national phase application may contain only 3 of these 5 claims.

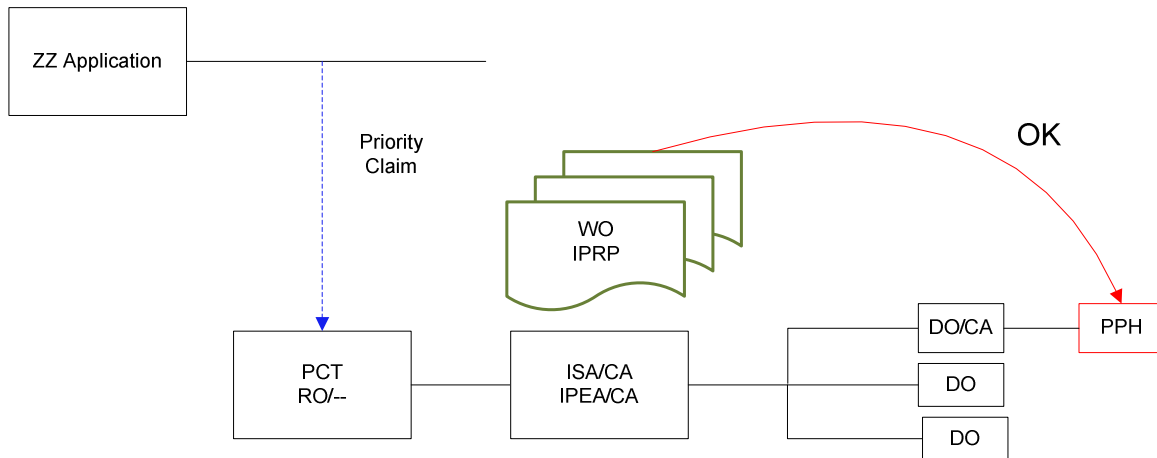
ANNEX D

Examples of Canadian patent applications that may request accelerated examination under the PCT-PPH at CIPO:

(A) The application is a national phase application of the corresponding international application.

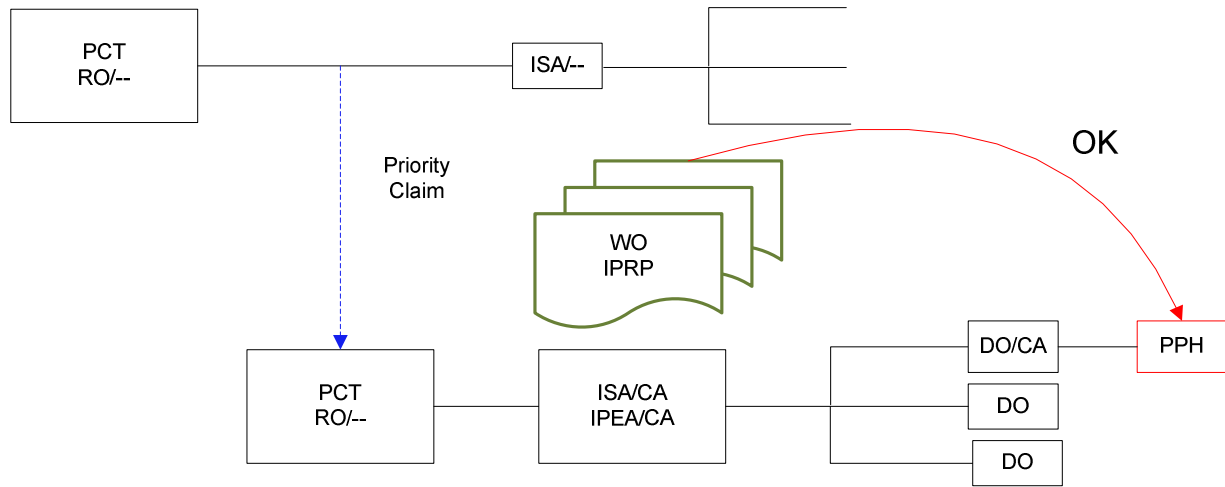


(A') The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from a national application.)

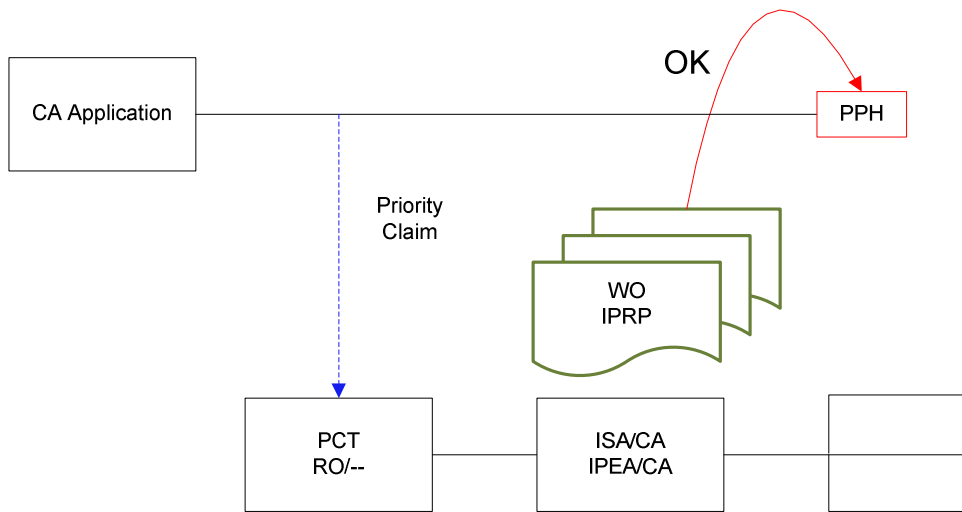


ZZ = an earlier application filed with any member of the Paris Convention or the WTO

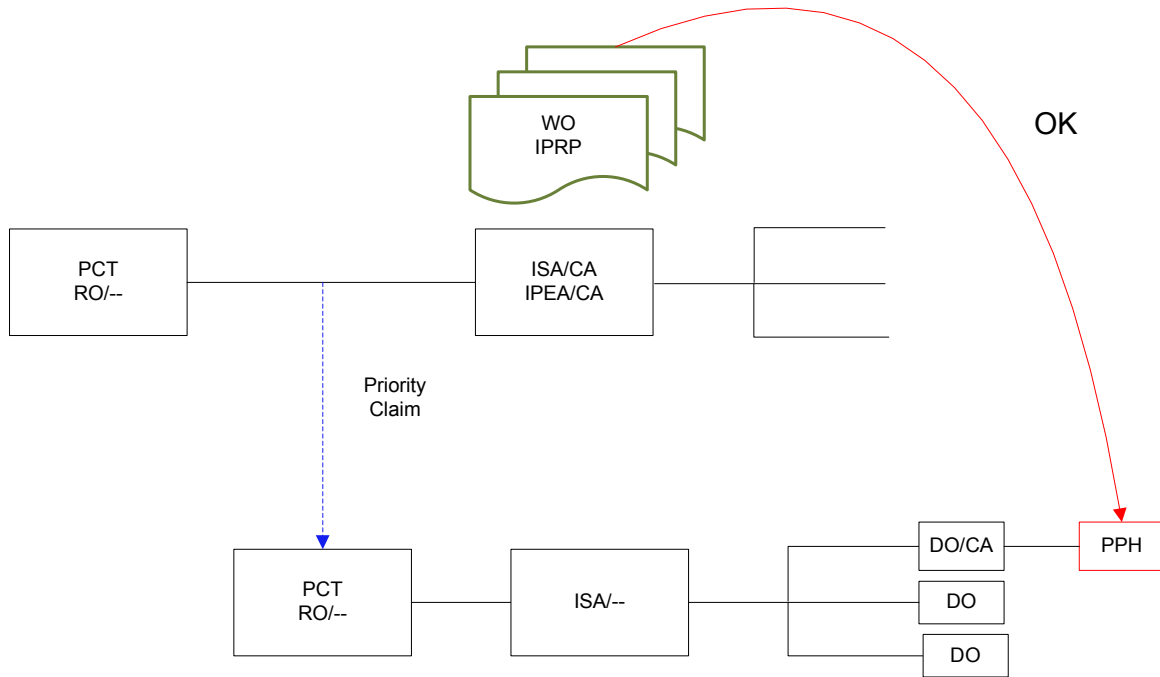
(A'') The application is a national phase application of the corresponding international application. (The corresponding international application claims priority from an international application.)



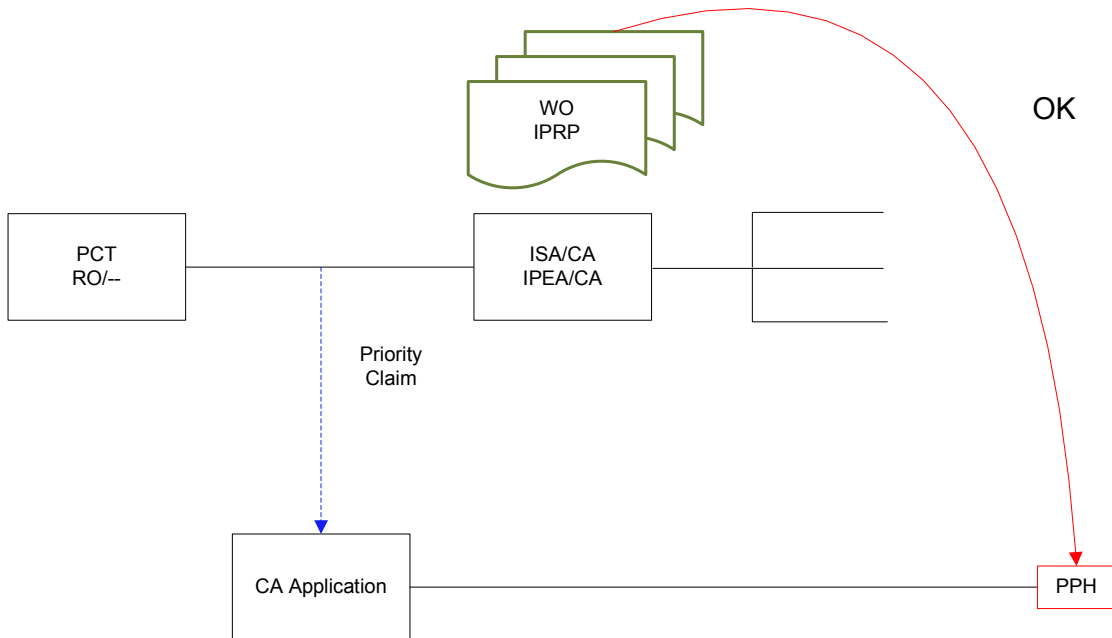
(B) The application is a national application which is the basis of the priority claim of the corresponding international application.



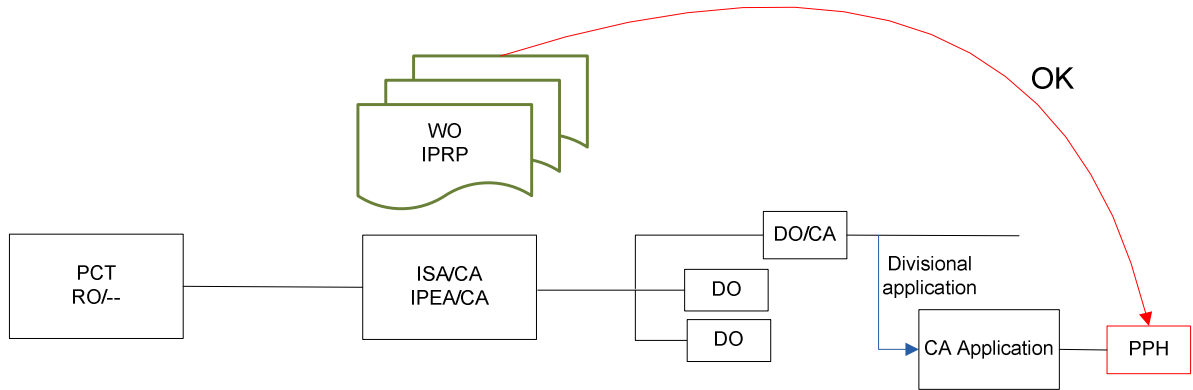
(C) The application is a national phase application of an international application claiming priority from the corresponding international application.



(D) The application is a national application claiming priority from the corresponding international application.



(E1) The application is a divisional application of an application which satisfies scenario (A).



(E2) The application is an application claiming internal priority from an application which satisfies scenario (B).

