

Requirements and Procedures to File a Request to CIPO for the Patent Prosecution Highway (PPH)

Request to CIPO for accelerated examination under the PPH

An applicant should file a request for accelerated examination under the Patent Prosecution Highway (PPH) to CIPO by submitting a completed PPH request form and the relevant supporting documents.

The PPH request form must be the uppermost document to ensure that the request is correctly processed. The PPH request form is available online at the CIPO PPH website at <http://www.cipo.ic.gc.ca/pph/>.

Requirements for requesting accelerated examination under the PPH

There are five requirements for requesting accelerated examination under the PPH:

- a) The CIPO application for which the PPH request is made, and the Office of Earlier Examination (OEE) application(s) forming the basis of the PPH request, shall be corresponding patent applications. The CIPO application for which participation in the PPH is requested and the corresponding OEE application(s) must have the same earliest date (whether this is a priority date or a filing date), wherein the CIPO application (including PCT national phase application) is either:
 - (i) an application which validly claims priority under the Paris Convention to the OEE application(s)¹, or
 - (ii) an application which is the basis of a valid priority claim under the Paris Convention for the OEE application(s) (including PCT national phase application(s)), or
 - (iii) an application which shares a common priority document with the OEE application(s) (including PCT national phase application(s)), or
 - (iv) a PCT national phase application where both the CIPO application and the OEE application(s) are derived from a common PCT application having no priority claim.

Such “corresponding patent applications” should not be necessarily interpreted as the application which forms the basis of the priority, but might be the application which derived from the application which forms the basis of the priority or the PCT application which has no priority claim; e.g., a divisional application of the application or an application which claims internal priority to the application.

¹ Where the USPTO is the OEE, a national application refers to either: a provisional patent application, a non-provisional utility patent application, a continuation patent application, a continuation in part patent application, or a divisional patent application.

Illustrated examples of Canadian patent applications that may request accelerated examination under the PPH at CIPO are given in Annex A.

b) At least one corresponding application in the OEE has one or more claims that are determined to be allowable by the OEE.

Applicant should identify the relationship between the OEE application that contains the allowable/patentable claims and the CIPO application.

CIPO shall consider corresponding claims to be allowable as indicated in the following documents:

OEE	Document
JPO	Granted Patent Publication and/or in an Office action. A JPO Office action includes a "Notification of Reasons for Refusal" and a "Decision to Grant a Patent".
NBPR	Granted Patent Publication and/or in the Office action entitled "Hyväksyvä välipäätös" (Communication of Approval).
SPTO	Granted Patent Publication and/or in the "Resolución de concesión con examen previo de la solicitud de patente" (Granting decision) as part of the substantive examination procedure.
USPTO	US Letters Patent or in an Office action. A USPTO Office action includes a "Non-Final Rejection", "Final Rejection", "Ex parte Quayle", and a "Notice of Allowability".

The following indications of allowable subject matter are not eligible for the PPH: a positive opinion is shown in the ISR, WO/ISA, WO/IPEA, IPER, or IPRP of the PCT international phase, but the OEE has not determined the claims to be patentable/allowable yet; and/or Examination was conducted in the European Patent Office (EPO) and the patent right was validated in the OEE as a designated state.

c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the OEE.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the CIPO are of the same or similar scope as the claims in the OEE, or the claims in the CIPO are narrower in scope than the claims in the OEE.

In this regard, a claim that is narrower in scope occurs when an OEE claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims). When possible, the narrower claim on file should be presented in dependent form.

A claim in the CIPO which introduces a new/different category of claims to those claims indicated as allowable in the OEE is not considered to sufficiently correspond.

For example, the OEE claims only contain claims to a process of manufacturing a product, then the claims in the CIPO are not considered to sufficiently correspond if the CIPO claims introduce product claims that are dependent on the corresponding process claims.

An example of claims on file which comply with this requirement is given in Annex B.

d) The CIPO application is open to public inspection.

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

Required documents for accelerated examination under the PPH

The following relevant documentation will be needed to support a request for accelerated examination under the PPH at CIPO:

Document	USPTO	JPO	NBPR and SPTO
Office actions	<p>If the Office actions are available on USPTO Public PAIR, CIPO will retrieve the USPTO Office actions.</p> <p>If the Office actions are not available on the USPTO Public PAIR, a copy of the USPTO Office actions must be attached.</p>	<p>If the Office actions are available, in English, on the respective OEE online network², CIPO will retrieve the Office actions.</p> <p>If the Office actions are not available on the respective OEE online network, an accurate translation in English or French of the OEE Office actions is attached.</p>	An accurate translation of the OEE Office actions is attached.
Claims in the OEE granted patent or indicated as allowable by OEE	Provide with the PPH request or request that CIPO obtain the documents from the USPTO (where publicly available on USPTO Public PAIR).	Provide a professional translation into English or French of the allowed OEE claims.	Provide a professional translation into English or French of the allowed OEE claims.
Claim correspondence table	A completed claim correspondence table showing the relationship between the claims of the CIPO application and the allowed OEE claims ³ .	A completed claim correspondence table showing the relationship between the claims of the CIPO application and the allowed OEE claims ³ .	A completed claim correspondence table showing the relationship between the claims of the CIPO application and the allowed OEE claims ³ .

In addition, applicant should notify CIPO of any Office actions from the OEE that are relevant to patentability and issued after submitting a PPH request, wherein the OEE has reversed a prior indication of allowability. Further, if the Office actions cannot be retrieved by CIPO, they should be submitted with the notification.

If it is impossible for the patent examiner to understand even the outline of the translated Office action(s) or the scope of the translated claims, due to inadequate translation, the

² Online networks: Advanced Industrial Property Network or AIPN (JPO). Please note that while applicants do not have access to AIPN, one can inquire if information about a JPO national application is available on the AIPN by contacting the JPO via email: PA2260@jpo.go.jp.

³ A sample claim correspondence table is given in Annex C.

examiner can request that the applicant resubmit a translation. A PPH request will not be rejected on the basis that the translation is inadequate until after at least one opportunity is given to submit adequate translations.

Patent documents (where not publicly available) and non-patent literature cited by the OEE may be provided with the request. While provision of these documents is optional, it may further accelerate examination. Applicants may file translations of citations as part of the supporting documentation when initially requesting accelerated examination under the PPH to allow prompt consideration of the citations, if they so desire. The CIPO Examiner may request translation of citations using the standard CIPO examination procedure where translation of a cited document is necessary.

The applicant need not provide further copies of documentation if they have already submitted the documents noted above to CIPO through simultaneous or past procedures related to the application.

Procedures for filing a request for accelerated examination under the PPH at CIPO

The applicant files a completed PPH request form and the relevant supporting documents, as noted above.

The request for examination under PPH may be made by mail, fax, or electronically via the Industry Canada website as per the CIPO patent correspondence procedures. The PPH request form must be the uppermost document to ensure that the request is correctly processed. The PPH request form is available online at the CIPO PPH website for the respective agreement.

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

The request for accelerated examination under the 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 that the application be made open for public inspection.

It is recommended that when requesting accelerated examination under the PPH, applicants should not only focus on the claims but on the application as a whole. The applicant should review the complete application and amend the application to correct known informalities that result from the differences between CIPO and OEE patent application requirements. These informalities 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*).

Procedures of examination under the PPH at CIPO

The PPH request will be considered by an Examiner, and, if all requirements are met, the Examiner will conduct the 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 Examiner determines that the claims on file do not sufficiently correspond to one or more of those claims indicated as allowable in the OEE, the applicant will be notified that the request for accelerated examination is not granted. To re-enter the PPH, the applicant must amend the claims accordingly and reapply altogether.

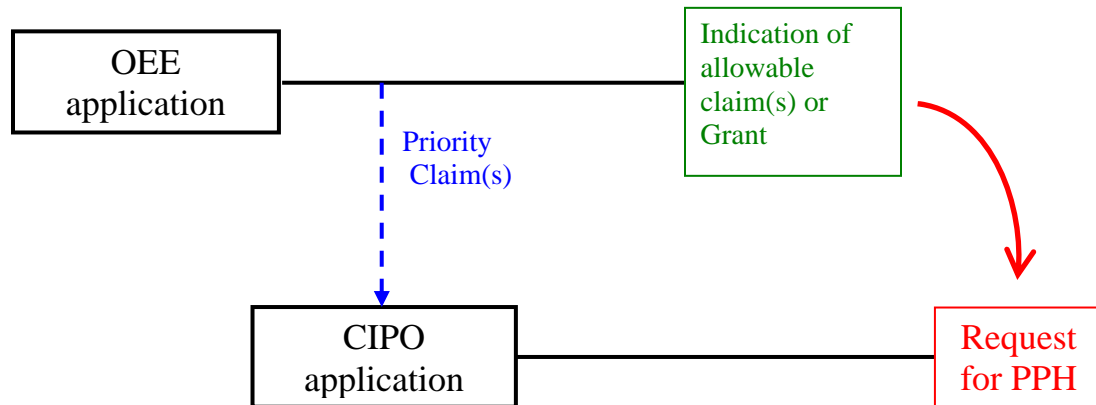
At any time during the prosecution of a PPH application, if the Examiner determines that the claims on file do not sufficiently correspond to one or more of those claims indicated as allowable in the OEE, the applicant will be notified that the application will await action in its regular turn.

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

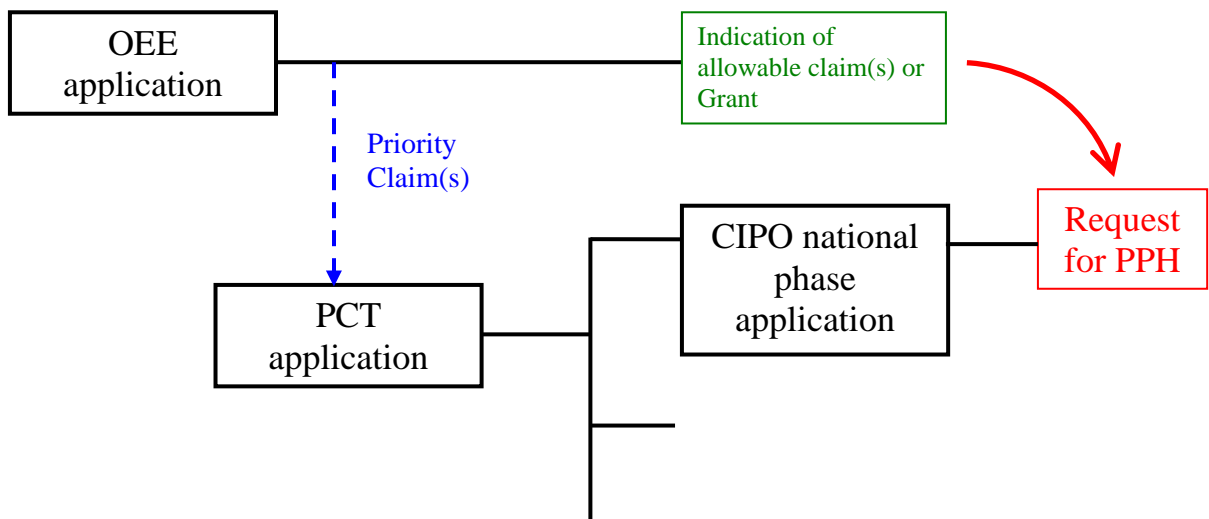
ANNEX A

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

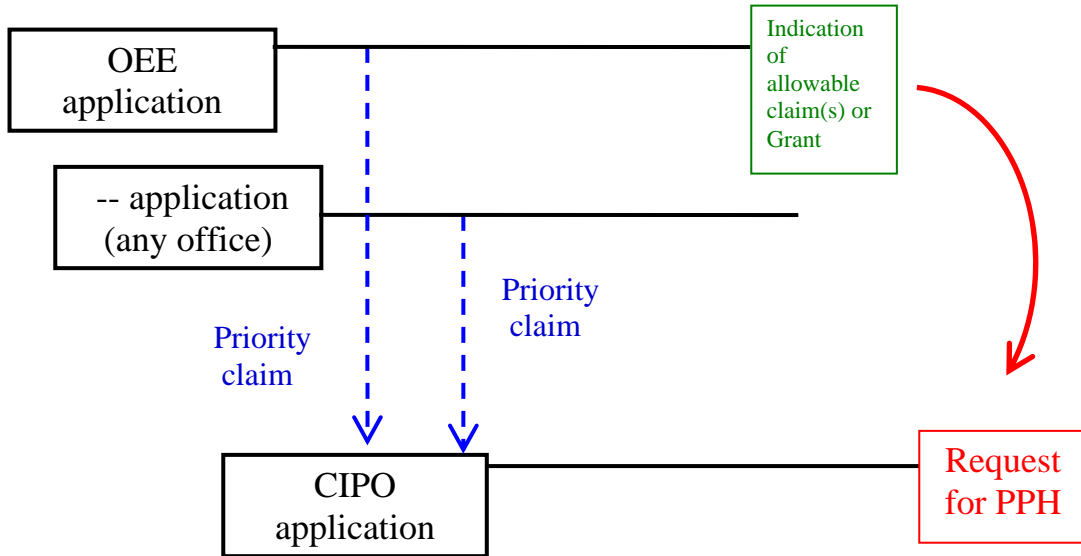
Example A:



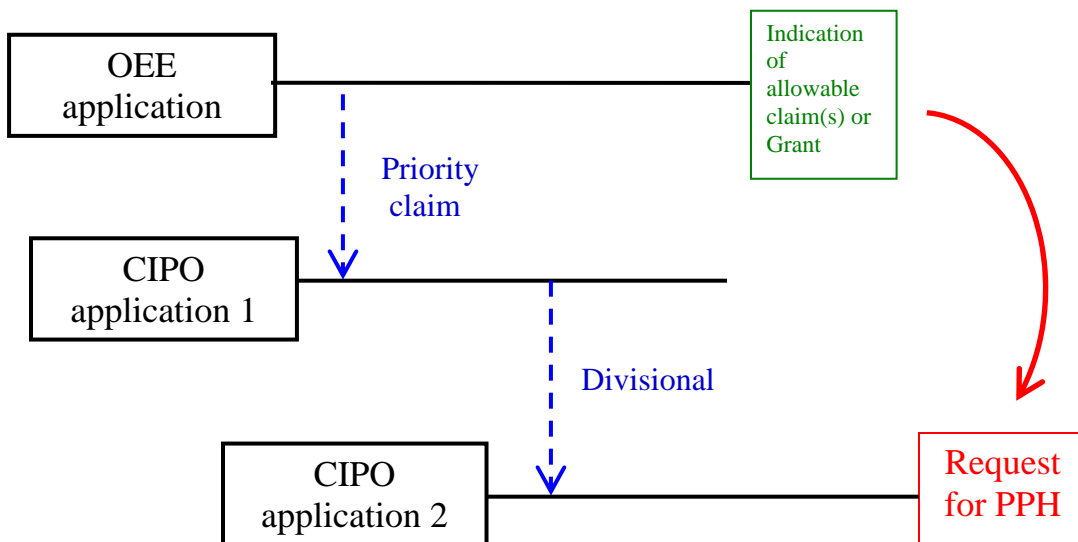
Example B:



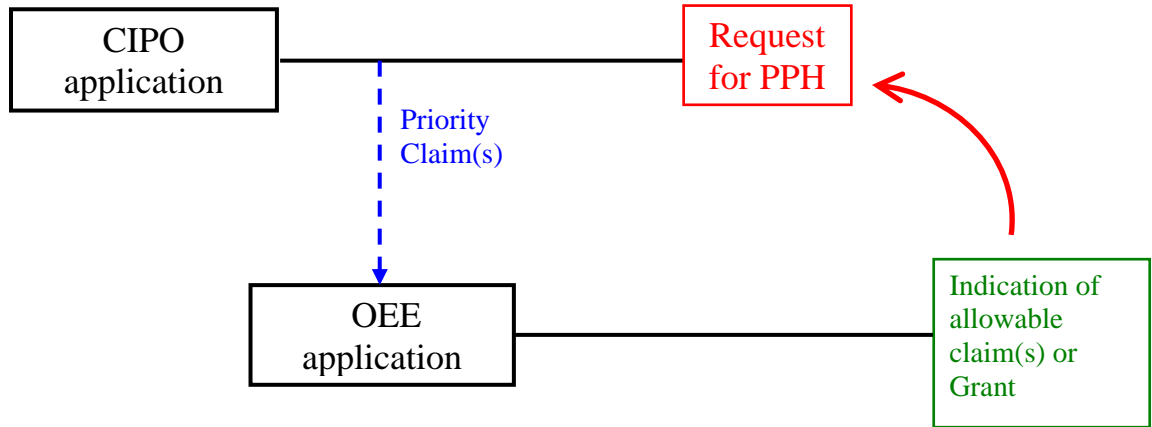
Example C:



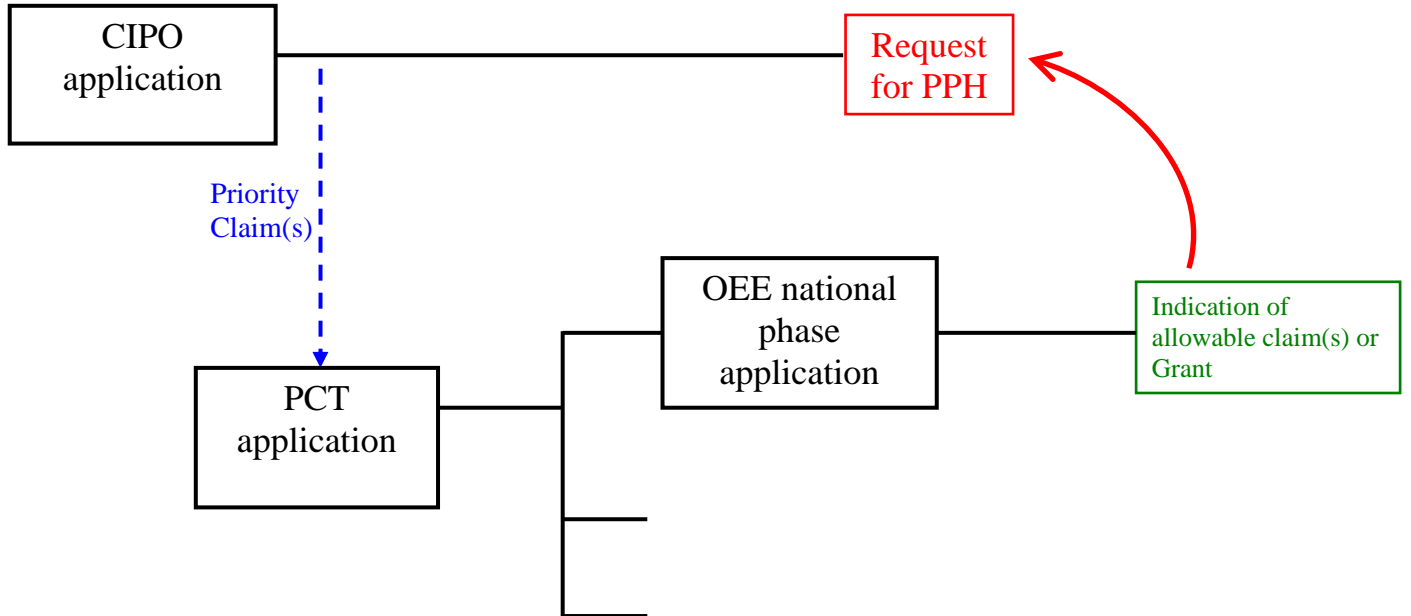
Example D:



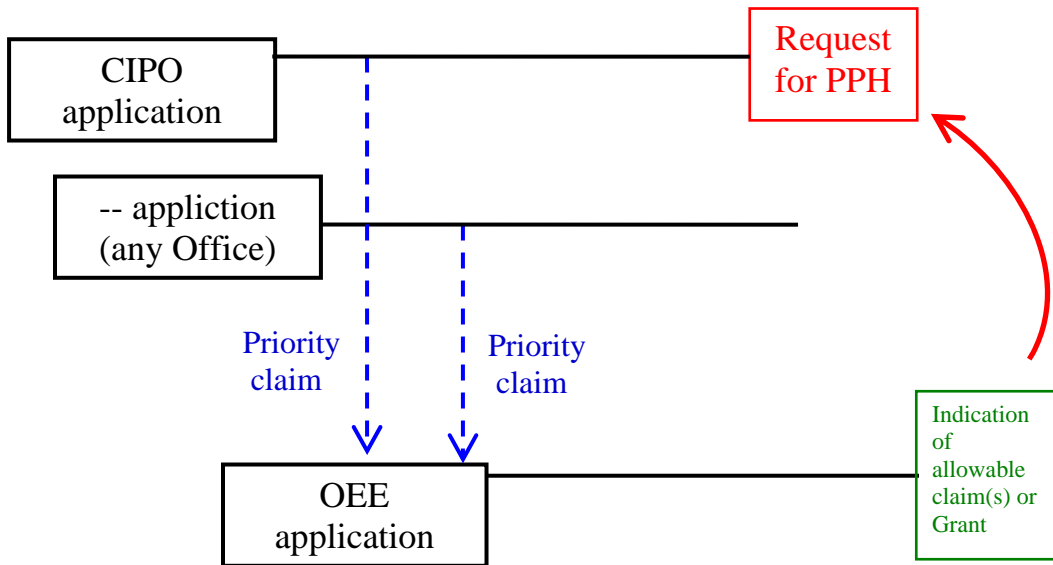
Example E:



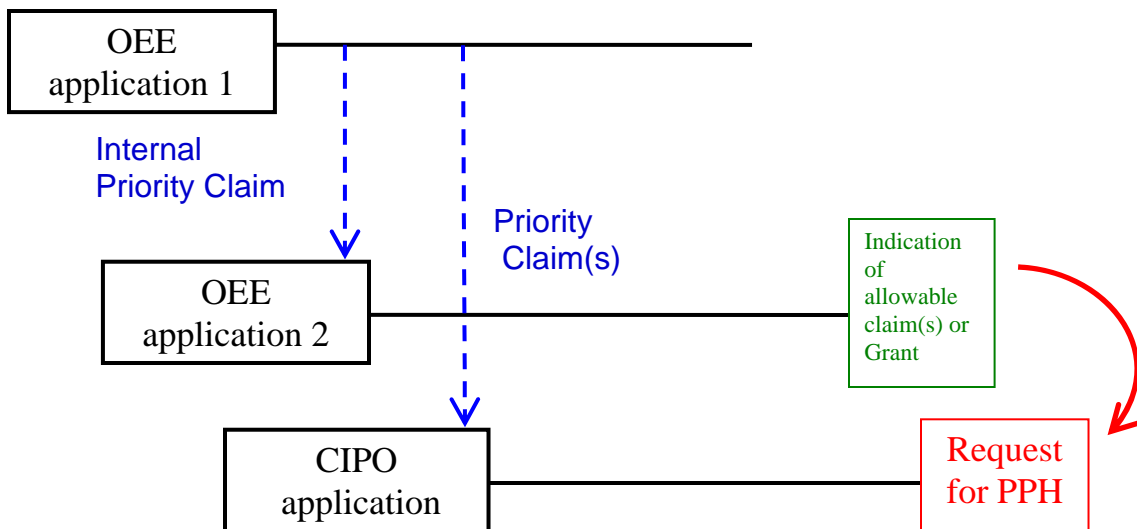
Example F:



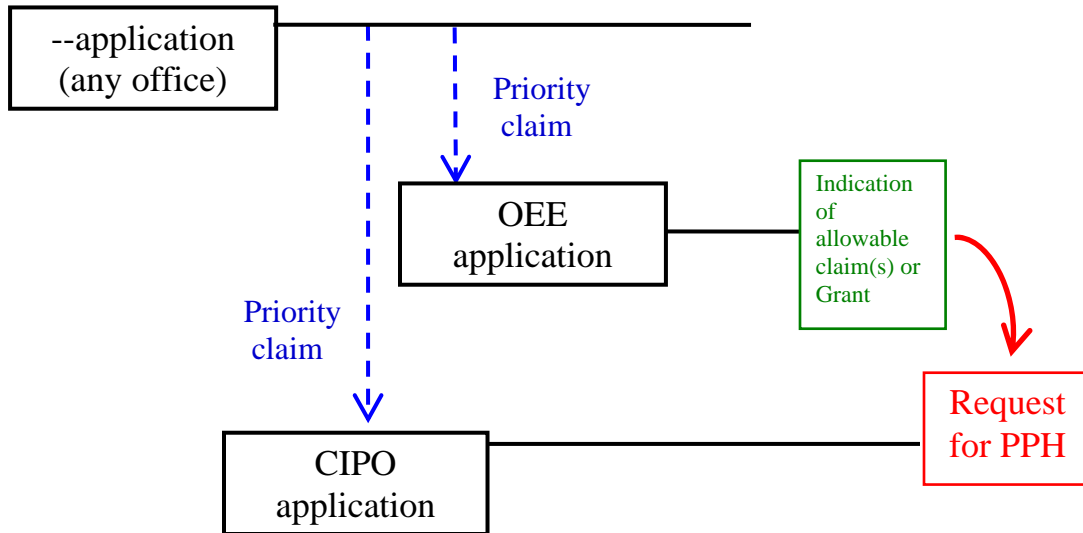
Example G:



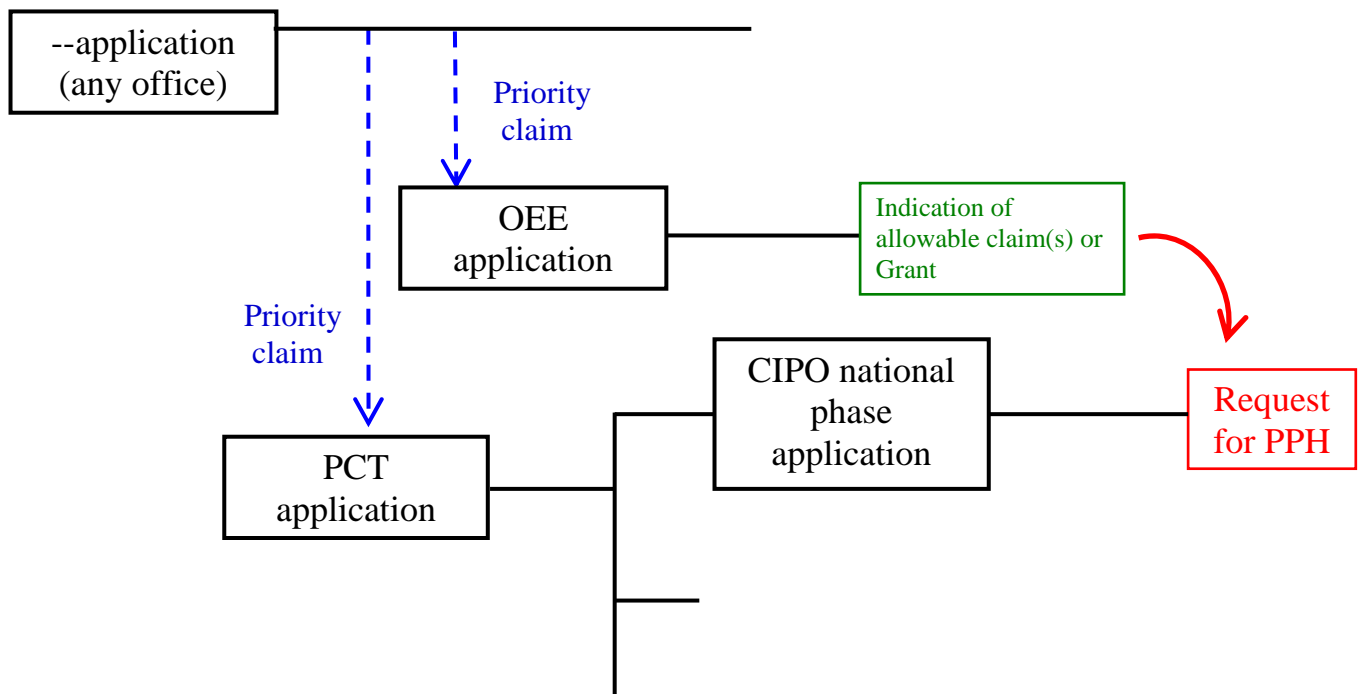
Example H:



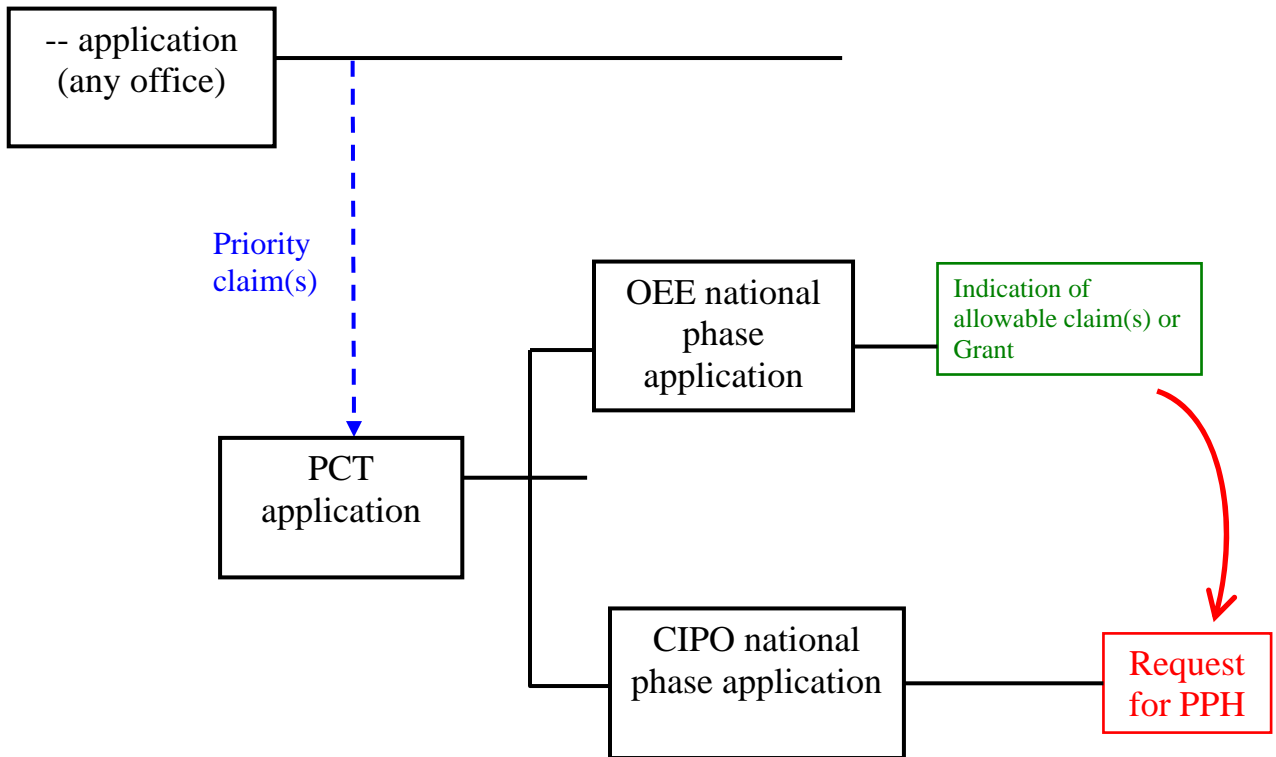
Example I:



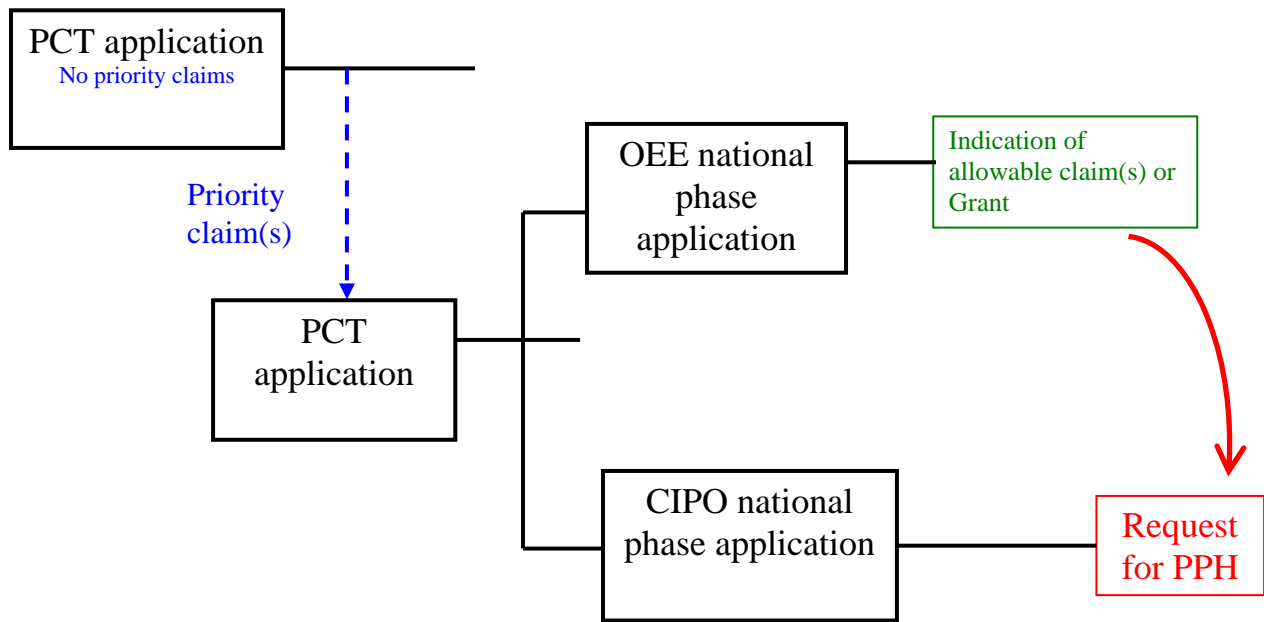
Example J



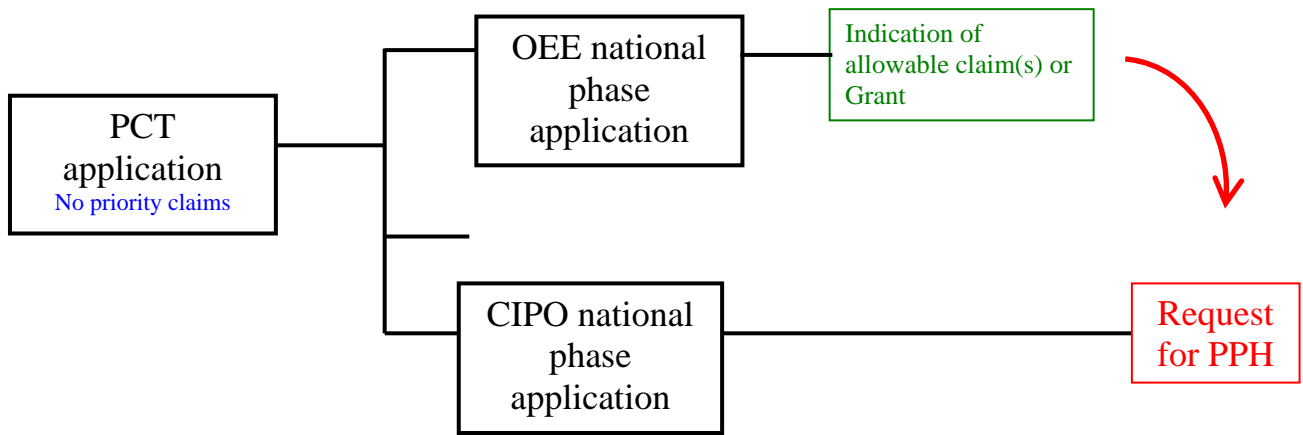
Example K



Example L:



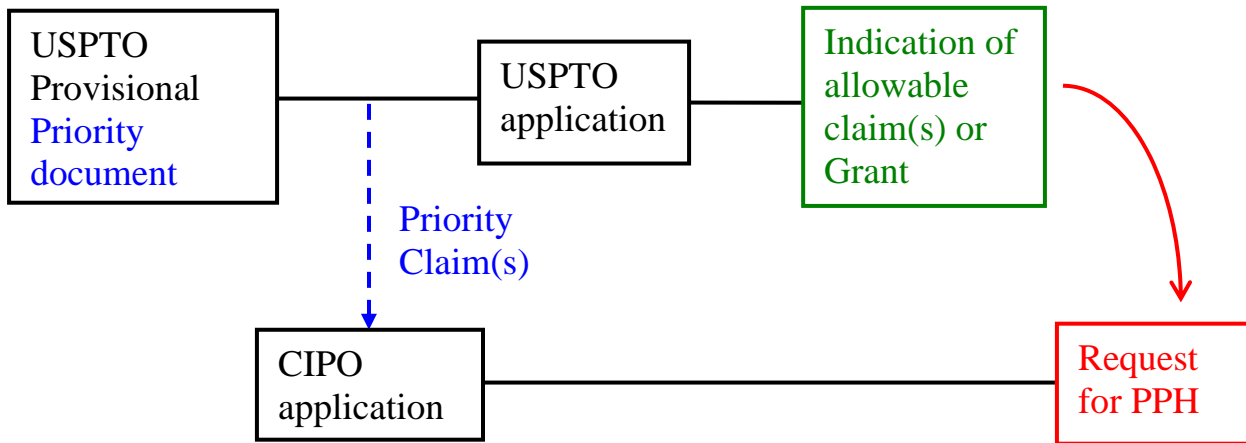
Example M:



Examples specific to the CIPO-USPTO PPH agreement:

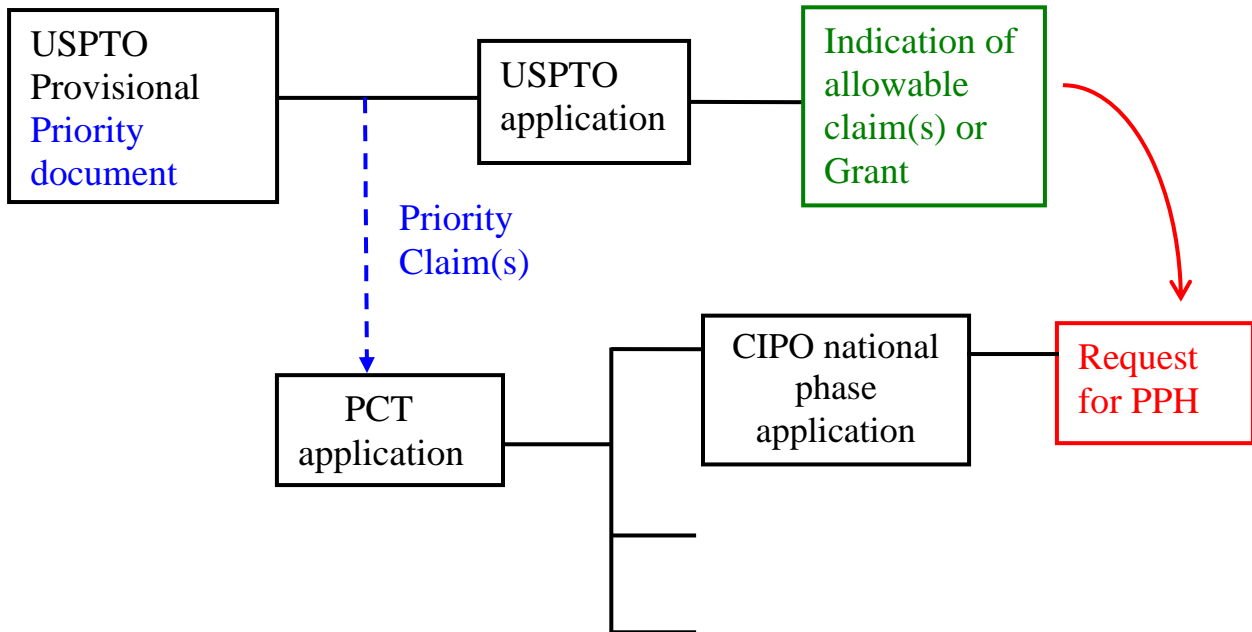
Example N:

This filing scenario includes a nationally filed application which validly claims priority under the Paris Convention from either a single USPTO provisional application or multiple USPTO provisional applications. The corresponding USPTO application must claim the benefit of the provisional application.



Example O:

This filing scenario includes a PCT national phase application where the PCT application has validly claimed priority from a USPTO provisional application or multiple USPTO provisional applications. The corresponding USPTO application must claim the benefit of the provisional application.



ANNEX B

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

CIPO claims	Subject matter	OEE claims	Subject matter	Comment
1	A	1 (independent)	A	The same as OEE claim 1.
2	A + a + b	2 (dependent on 1)	A + a	Claim 2 has the additional feature "b" in relation to OEE claim 2.
3	A + d			Claim 3 has an additional feature "d" in relation to OEE claim 1 (where "d" is supported in the description but is not claimed in the OEE).

Where "A" is the subject matter and "a", "b", and "d" are the additional features which narrow (further restrict) the scope of the subject matter.

A CIPO claim which introduces a new/different category of claims to those claims indicated as allowable in the OEE is not considered to sufficiently correspond. For example, the OEE claims only contain claims to a process of manufacturing a product, then the CIPO claims are not considered to sufficiently correspond if the CIPO claims introduce product claims which are independent or dependent on the corresponding process claims.

Please note that it is not necessary to include "all" claims determined to be allowable in the OEE in an application in CIPO (the deletion of claims is allowable). For example, in the case where an application in the OEE contains 5 claims determined to be patentable/allowable, the corresponding application in CIPO may contain only 3 of these 5 claims.

ANNEX C

Example: Claim Correspondence Table

CIPO application claim on file	Corresponding OEE claim	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 OEE application. OEE claims 1 to 5 have been indicated as allowable in the notice dated ____.
1 to 3	1 to 3	Applicant has amended the claims to the present claims having the same scope as the claims of the applicant's corresponding OEE application. OEE claims 1 to 3 have been indicated as allowable in the Office action dated ____.