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Canadian Intellectual Property Office Launches a PCT-Patent Prosecution Highway Program

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On January 31, 2011, the Canadian Intellectual Property Office (CIPO) will launch a new PCT-Patent Prosecution Highway (PCT-PPH) pilot program. This patent prosecution highway (PPH) program is the latest addition to similar programs already in place with patent offices of many other countries, including the United States, Germany, Japan, South Korea, Finland, Denmark and Spain^[1]. The PCT-PPH pilot project will last for two years^[2].

As with other PPH initiatives, the objective of the PCT-PPH pilot project is to allow applicants to obtain their Canadian patent more rapidly and more efficiently by significantly accelerating examination. However, this pilot is **limited to PCT work products established by CIPO** as the International Searching Authority (ISA) and/or the International Preliminary Examining Authority (IPEA), that is, the written opinion of the ISA, the written opinion of the IPEA or the international preliminary examination report.

CIPO applications entering national phase on or after January 31, 2011 can benefit from this new PCT-PPH pilot program. Where claims have been found allowable at the PCT level, the applicant can make a PCT-PPH request to CIPO for accelerated examination of a corresponding national phase application. CIPO will process requests for advanced prosecution under the PCT-PPH project free of charge but regular fees for requesting examination will continue to apply. CIPO's goal is to provide a first action (allowance or first substantive report) for qualifying requests within 90 days. Typically, first actions can take from 18 to 33 months, depending on the field of the invention.

On a related note, CIPO also announced recently that, effective January 29, 2011, the PPH pilot project with the United States Patent and Trademark Office (USPTO), will be replaced by a PPH agreement for an indeterminate period^[3]. The requirements and procedures of this agreement remain the same.

For more information on this or any other existing voluntary PPH programs, please contact the author of this Bulletin, or any one of our attorneys and patent agents listed on the next page.

^[1] Additional information about these existing voluntary pilot programs can be found on CIPO's web site at : http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02160.html

^[2] Additional details are available at : <http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr02934.html>

^[3] The Canadian Intellectual Property Office considers the CIPO-USPTO PPH pilot project a great success since, as of January 31, 2009, CIPO had received 413 requests to participate in the PPH pilot program. CIPO considers this to be an extremely high participation rate compared to other ongoing PPH programs offered by other intellectual property offices (IPOs) since this volume of examination requests represents about 1.5% of CIPO's first action (FA) examination capacity.

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