

CANADA/CHINA PATENT PROSECUTION HIGHWAY PROGRAM: THREE YEARS IN BRIEF

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Since September 1, 2013, the Canadian Intellectual Property Office (“CIPO”) and the State Intellectual Property Office of the People’s Republic of China (“SIPO”) have been participating in a patent prosecution highway (“PPH”) pilot project, a project which in principle allows innovative entities to seek and achieve patent protection on both sides of the Pacific Ocean more quickly and more cost-effectively.

Generally, the PPH pilot project permits patent applicants to accelerate the examination of a corresponding second patent application in a second jurisdiction (the “second application”), based on the allowance or registration of a corresponding first patent application in a first jurisdiction (the “first application”). Under a PPH request, the patent office examining the second application takes into account (hopefully with a favourable view) the examination history of the first application. The Canadian patent office does not charge a fee for receiving PPH requests under the PPH pilot project between CIPO and SIPO.

The PPH pilot project between CIPO and SIPO has a current sunset date of August 31, 2018.^[1] Based on data tabulated up to December 2016, the number of applications participating in the PPH pilot project between CIPO and SIPO has steadily increased since its inception^[2]:

Year	Inbound PPH request (from China)	Outbound PPH request (to China)
2013	3	0
2014	17	4
2015	31	6
2016	66	17

This is a promising sign, and suggests that at least some Canadian and Chinese applicants are considering the potential benefits of the PPH pilot project between CIPO and SIPO.

Relative to other Asian jurisdictions like Japan and the Republic of Korea, however, the number of PPH requests coming from Chinese applicants pales in comparison both numerically and proportionally. Referring to the immediate past three years of 2014, 2015, 2016, and years where CIPO had PPH pilot projects in place with China, Japan, and the Republic of Korea, the following number of inbound PPH requests from Chinese, Japanese, and South Korean applicants were reportedly received at CIPO^[3]:

Year	Inbound PPH request (from China)	Inbound PPH request (from Japan)	Inbound PPH request (from South Korea)
2014	17	132	37
2015	31	152	67
2016	66	669	201

Over approximately the same time period, the following inbound patent applications from Chinese, Japanese, and South Korean applicants were reported received at CIPO [\[4\]](#), [\[5\]](#), [\[6\]](#):

Year	Inbound applications (from China)	Inbound applications (from Japan)	Inbound applications (from South Korea)
2013-2014	528	1830	424
2014-2015	661	1903	352
2015-2016	672	1940	370

While the PPH requests in any given year may not be specifically related to the particular patent applications filed in Canada in any given year, the above tables do suggest that Japanese and South Korean applicants use the PPH program at a higher proportional rate than Chinese applicants year-to-year and over the same period of time.

We note, however, that the above numbers may not be entirely representative regarding Chinese applicants' interest in the PPH program at CIPO. For example, it is entirely possible that examination of patent applications before SIPO, as the first office of examination, simply takes longer than examinations at the Japanese Patent Office and the Korean Intellectual Property Office, thereby resulting in a delay in a Chinese applicant's ability to actually make a PPH request at CIPO. Also, different applicants may choose to use our delayed examination option in different ways in order to maximize the benefit of that option.

In any event, it would be interesting to see if the statistics at CIPO will paint a different picture for 2017 and beyond, and while the PPH pilot project exists between CIPO and its counterpart Asian-Pacific patent offices.

by Pablo Tseng

[1] [Patent Prosecution Highway \(PPH\) – Fast-track Examination](#), (accessed October 4, 2017).[ps2id id='1' target='']

[2] Patent Prosecution Highway Portal Site, <http://www.jpo.go.jp/ppph-portal/statistics.htm> (accessed October 4, 2017).[ps2id id='2' target='']

[3] *Ibid.*[ps2id id='3' target='']

[4] [Annual Report 2013-2014](#), (accessed October 4, 2017).

[5] [Annual Report 2014-2015](#), (accessed October 4, 2017).

[6] [Annual Report 2015-2016](#), (accessed October 4, 2017).

A Cautionary Note

The foregoing provides only an overview and does not constitute legal advice. Readers are cautioned against making any decisions based on this material alone. Rather, specific legal advice should be obtained.

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