

PPH PROGRAM (CANADA AND ASIA-PACIFIC JURISDICTIONS): ANNUAL UPDATE

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Since September 1, 2013, the Canadian Intellectual Property Office (“**CIPO**”) and the National Intellectual Property Administration, People’s Republic of China (“**CNIPA**”) 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. The PPH pilot project between CIPO and CNIPA was launched on September 1, 2013 for an initial two year term. The project was subsequently extended to August 31, 2018. Most recently, the project was further extended by the CIPO and the CNIPA and now has a sunset date of August 31, 2021. This PPH pilot project further allows applicants to utilize CNIPA’s international work products as the basis for a PCT-PPH request in Canada.^[1]

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 government fee for receiving PPH requests under the PPH pilot project between CIPO and CNIPA.

As mentioned above, the PPH pilot project between CIPO and CNIPA was recently extended, and now has an anticipated sunset date of August 31, 2021. Based on data tabulated up to December 2017, the number of applications participating in the PPH pilot project between CIPO and CNIPA has steadily increased since its inception:^{[2],[3]}

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

2017

94

24

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 four years of 2014, 2015, 2016, 2017 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:[\[4\]](#),[\[5\]](#) 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 CNIPA.

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
2017	94	863	257

Over approximately the same time period, the following inbound patent applications from Chinese, Japanese, and South Korean applicants were reported received at CIPO:[\[6\]](#),[\[7\]](#)

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
2016-2017	836	1903	328

While the PPH requests in any given year may not be specifically related to the particular patent applications filed in Canada in that 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 do, year-to-year and over the same period of time.

However, 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 CNIPA, 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 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 addition to the above remarks, we further note that CIPO has also entered into a PPH pilot project with the Taiwan Intellectual Property Office (“**TIPO**”). This pilot project commenced on February 1, 2018 and has an end date currently set for January 31, 2021. We hope to provide some commentary on this pilot project in the coming years.

by Pablo Tseng and Fang Chen, Articled Student

[1] Extension of the PPH pilot agreement between CIPO and SIPO (accessed December 10, 2018).

[2] Canada/China Patent Prosecution Highway Program: Three Years in Brief (accessed December 10, 2018).

[3] PPH Patent Prosecution Highway Statistics (accessed December 10, 2018).

[4] *Supra*, note 2.

[5] *Supra*, note 3.

[6] *Supra*, note 2.

[7] Annual Report 2016-2017 - Patent Statistics (accessed December 10, 2018).

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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