

CIPO AND INPI-BRAZIL COLLABORATE IN THE PATENT PROSECUTION HIGHWAY PROGRAM

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As of February 1st, 2024, the Canadian Intellectual Property Office (CIPO) and the Brazil Instituto Nacional da Propriedade Industrial (INPI-Brazil) have entered into a Pilot Agreement for bilateral participation in the patent prosecution highway (PPH) program. [1] The PPH program allows patent applicants to expedite prosecution of their patent applications in other PPH participating IP offices upon receiving a favorable opinion from a PPH participating IP office. As such, the bilateral participation of CIPO and INPI-Brazil in the PPH program provides a further opportunity for patent applicants in each country to expedite prosecution of their patent applications in the other country.

How does it work?

When a patent applicant files corresponding patent applications in two or more IP offices participating in the PPH program, and receives a favorable opinion from one of the IP offices, the patent applicant is then able to file a PPH request for expedited examination in any of the other IP offices.

Each country has slightly different rules around the content and effect of a PPH request, but a granted PPH request will generally expedite the examination process in the IP office granting such request (the “granting IP office”). The granting IP office may still raise objections based on laws specific to the jurisdiction, but these objections are generally more likely to be procedural in nature (e.g., removing multiple dependencies, or providing antecedent support for claim features) and generally less likely to be substantial in nature (e.g., lack of novelty, or lack of inventiveness). As such, a granted PPH request typically results in allowance of the subject patent application on an expedited timeframe.

What are the requirements?

The general requirements to submit a PPH request for a pending application are:

- the pending application corresponds to a second application filed in a PPH participating IP office;
- the second application has received a favorable substantive opinion;
- all of the claims in the pending application correspond substantially to the allowed claims in the second

application; and

- substantive examination of the pending application has not yet begun, generally meaning that a search or office action has not been undertaken for the pending application.

Taking advantage of PPH at CIPO

Canadian patent applications are particularly well suited for taking advantage of the PPH program, in large part due to Canada's deferred examination scheme. Filing a patent application and requesting examination of the patent application are distinct steps in Canada. Examination can be requested at any time up to four years from the filing date of the patent application. Four years is generally sufficient time to conclude prosecution of a corresponding patent application in another PPH IP office. As such, applicants can defer examination of their Canadian patent application until after they receive a favorable opinion in another PPH IP office, and then request examination of the Canadian patent application along with filing a PPH request. This allays the risk of substantive examination commencing in Canada before receiving a favorable opinion in another PPH IP office, which would thereby bar the ability to request expedited examination through the PPH program in Canada.

The addition of INPI-Brazil to the list of PPH IP offices reciprocal with CIPO provides a further opportunity for Canadian patent applicants to streamline and accelerate examination of their Canadian patent applications, and vice-versa. Applicants with patent applications in both jurisdictions should consider reviewing their patent portfolios for opportunities to exploit the new opportunity under PPH.

[1] Online: [here](#).

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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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