Blake, Cassels & Graydon LLP January 2012

Blakes Bulletin

Intellectual Property

Speed Bump on the Patent Prosecution Highway

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Patent Prosecution Highways (PPH) have been established pursuant to bilateral agreements between patent offices of different countries. Upon an indication of allowability of an application in one patent office, another patent office with which it has a PPH agreement will accelerate its consideration of the corresponding application, provided the claims being considered are the same as those allowed by the first office. The rationale behind the PPH is to avoid duplication of effort by the patent offices and provide a reduced pendency for applications.

The PPH procedure has proven popular, with substantial savings being noted by large filers, and the procedures are evolving to provide increased flexibility for the applicant. For example, initially the PPH had to be based on the first-filed application, but a number of countries are now permitting the PPH to be based on the first case to be allowed.

The advantage of requesting PPH processing in Canada is that the application is taken up for examination before all other categories of applications, except for those granted special status for "accelerated examination" and those which are clearly in condition for allowance. The Canadian Intellectual Property Office (CIPO) promises a response within three months of requesting PPH processing. In our experience, however, the CIPO has provided an examination action in as little as a week after requesting PPH processing. Equally importantly, there are no official fees associated with requesting PPH processing in Canada.

Canada has PPH agreements with the U.S., Denmark, Germany, Japan, Korea, Finland and Spain. In addition, PPH processing from a PCT application is also possible. It is possible to request PPH processing in the CIPO based on an indication of allowability, such as the Notice of Allowance of the U.S. claims, or a similar notice from one of the other offices.

Many patent applications include different categories of claims such as apparatus, method and product. In most countries, including Canada, those claims are generally considered different aspects of a single invention and so may be retained in a single application, provided they have a common inventive feature. The U.S. patent office, however, will often require a restriction, i.e., an election, to one category of claims and the cancellation of other categories. For example, the allowed claims may be directed to an apparatus and the method or product claims then filed in a continuation or divisional application. Similar issues may arise in the prosecution of chemical cases if the U.S. patent office requires restriction of the compounds of a Markush claim to a single classification under the U.S. classification system.

To access the PPH, the Canadian claims would similarly have to be restricted to the one category, or the one classification, or the one set, as the case may be.

The conformity of the Canadian claims to the allowed claims introduces a potential speed bump, requiring caution to be exercised when pursuing the allowed claims in Canada. This is of particular relevance where reliance is placed on the allowed U.S. claims, although similar situations may arise in other countries, where, for example, claims are amended to comply with local practices.

In most countries, any claims cancelled to bring the claim set into conformity could be prosecuted in a divisional application, so that one set is prosecuted in the parent application and the others in a divisional application. In Canada, however, there is a significant potential risk in doing so. In Canada, there is a double patenting doctrine, similar to the U.S., but without the escape route of the terminal disclaimer provisions. This was confirmed in the 2003 Federal Court decision in *GlaxoSmithKline v. Apotex*.

A divisional application is vulnerable to a double patenting attack, either during examination or in court proceedings, unless the examiner in Canada has specifically indicated that the claims on file are

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directed to more than one invention. Should a divisional application be filed, and should the examiner raise a double patenting objection, it would become necessary to argue for claims of the divisional application over claims in the parent patent. Such arguments in favour of patentability over your own claims can often lead to statements that might be seen as restricting the scope of the claims in the parent application or require an amendment that restricts the scope in the divisional application. This is particularly acute when the parent application contains one category of claims, e.g., the product, and the divisional application contains the corresponding method claims, as could easily happen with U.S.-prosecuted claims.

It is for that reason that we recommend filing a full set of claims in Canada, even when there are clearly multiple inventions, to provoke the unity of invention objection and provide a safeguard against subsequent double patenting attacks. With the PPH, however, this option may not be available as the claims have to be amended to conform to the allowed claims prior to any objections from the examiner. In that case, the defence to double patenting is not available.

One possibility is to wait for the divisional U.S. application to be allowed and request a PPH based on both allowed sets of claims. This, however, will typically introduce delay while the second application is examined.

Another possibility that might be considered is the retention of each set of claims and an argument that they are substantially the same as the allowed U.S. claims, merely directed to different aspects of the same invention. However, the PPH rules in Canada specifically address that possibility and make it clear that only the category of claims allowed will be permitted in the Canadian application processed under PPH.

Although the risk is greatest with U.S.-based applications, a similar situation might arise where only a single independent claim is allowed for each category, or where claim sets are reduced to avoid excess claim fees. In those situations, an attempt to file divisional applications for the omitted claims could lead to double patenting objections and a potential loss of protection.

A corresponding PCT application may allow the risk of double patenting objections to be assessed and provide some comfort. As Canadian unity objections are aligned with the PCT rules, rather than the U.S. practice, a unity of invention objection during the PCT phase would suggest a similar conclusion in the CIPO and the risk would therefore be minimal. If there has been no unity objection in the PCT, the opposite could be inferred, i.e., the claims are to the same invention. In that case, proceeding with the PPH based on a reduced set of claims may jeopardize claims filed in a divisional application.

An alternative approach, if early consideration is required, is to file a request for expedited examination. This requires a fee of **C$500** and a generic statement that the applicant requires early grant. The claims can be amended per the allowed claims, but the other sets of claims retained or added. The examiner would then consider unity, and if there is an objection, the divisional application could be filed with no risk.

This is perhaps a classic example of where lack of harmonization of procedures in the patent offices frustrates the efforts of those same offices to be more efficient, and provides a trap for the unwary applicant.

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