

Blakes Bulletin

Intellectual Property

Canadian Patent System Expedites Applications for Green Technology

WILFRED SO

Amendments to the *Canadian Patent Rules*, which took effect in March 2011, will enable the expedited examination of patent applications related to "green technology."

In some cases, applicants must preserve rights to seek accelerated examination of current applications by April 30, 2011.

The term "green technology" is not defined in the rules. Instead, they state that, in order to expedite examination, a declaration is required "indicating that the application relates to technology the commercialization of which would help to resolve or mitigate environmental impacts or to conserve the natural environment and resources."

Non-limiting examples of green technology sectors include biofuels and bioenergy, power generation, energy infrastructure, advanced materials, process efficiency and abatement, remediation, transportation, recycling and waste, water, and wastewater.

The new rules provide that the Commissioner of Patents may expedite the prosecution of a patent application when the invention is related to green technology without payment of the government fee usually required for accelerated prosecution.

To expedite the examination of such an application, the applicant must request advanced examination, declare that the application relates to "green technology," and request that the application be laid open for public inspection.

By accelerating examination, an applicant may expect to receive a first office action from the Canadian Intellectual Property Office (CIPO) within three to six months. This is in contrast to the typical wait of 18 months to three years, from the time when a request for examination is filed, for applications examined in the standard course.

During accelerated examination, the time limit to respond to an examiner's office action is three months. This reduced time limit, compared to the standard six-month time limit, has been established to allow the CIPO to further expedite the prosecution of these patent applications. The CIPO's new service standard further includes providing a response to an applicant's correspondence within two months.

The amendments also eliminate undue delays that are contrary to the objectives of the accelerated examination provision. After April 30, 2011, the Commissioner will not advance an application for examination out of its routine order and will return to its routine order any application that has been advanced for examination should the applicant cause any delay to occur during the prosecution. Examples of delay include allowing the application to be deemed abandoned or requesting that the Commissioner extend a deadline.

Therefore, an applicant who has a currently abandoned application must request reinstatement of the abandoned application by April 30, 2011, if it wishes to preserve eligibility for expedited examination.

The Canadian government's position is that fast-tracking green technology patent applications is for the public benefit and is aligned with other priorities on science and technology. The government has stated that this approach supports the growth of small- and medium-sized enterprises, develops a clean energy economy, and is responsive to global warming.

Other countries that expedite the examination of green technology patent applications include Australia, Japan, South Korea, the United Kingdom, and the United States. Notably, the U.S. has a Green Technology Pilot Program that ends December 31, 2011. This program is limited to the first 3,000 grantable petitions to expedite examination. As of April 4, 2011, a total of 1,595 petitions have been granted and 310 petitions are currently awaiting a decision. Not all petitions have been granted. In fact, approximately 40% of petitions are dismissed or denied.

CONT'D ON PAGE 2

CONT'D FROM PAGE 1

The new green technology provisions in Canada may provide an alternative expedited route in the U.S. by taking advantage of the Patent Prosecution Highway (PPH) program. The PPH program is an initiative between patent offices of different countries to speed up the examination of applications filed therein by allowing examiners in one patent office to reference examination results in another. Such a program exists between Canada and the U.S. and may be extended to other countries.

The PPH program expedites the prosecution of a patent application in a second country after allowance in a first country. Therefore, by expediting examination of a Canadian patent application to obtain early allowance, the PPH program may then be used to expedite prosecution of a corresponding U.S. patent application. Certain conditions and requirements must be met in order to qualify under the PPH.

For further information, please contact a member of our Intellectual Property Group.

Go to blakes.com/english/subscribe.asp to subscribe to other Blakes Bulletins.

NEW YORK MONTRÉAL OTTAWA TORONTO CALGARY VANCOUVER
CHICAGO LONDON BAHRAIN AL-KHOBAR* BEIJING SHANGHAI* blakes.com
* Associated Office