



Introduction to Accelerated Handling in the European Patent Office

What are the options to accelerate a European patent application?

Where the application is the EP regional phase of a PCT application, the applicant can speed up the process by:

- filing the PCT application as early as possible;
- obtaining an EPO search during the international phase;
- entering the EP regional phase early;
- accelerating the EPO procedure.

Where the application is not the EP regional phase of a PCT application, the options are:

- filing the European application as early as possible;
- accelerating the EPO procedure.

Filing the PCT or European application as early as possible

Where a basic patent application has been filed in the applicant's home country to establish priority, the European procedure can be brought forward by not waiting until the end of the priority year before filing a PCT or European patent application.

Obtaining an EPO search during the international phase of a PCT application

A number of PCT Receiving Offices, including the US Patent and Trademark Office (US) and - for PCT applications filed in English - the Japanese Patent Office (JP) and the China National Intellectual Property Administration (CN), permit the European Patent Office (EPO) to be designated as the International Searching Authority (ISA) in a PCT application.

In cases where the ISA was not the EPO, within the period of 22 months after the priority date a Supplementary International Search (SIS) can be requested in the international phase of a PCT

application, using the EPO as the Supplementary International Searching Authority (SISA). The request is filed directly with the International Bureau of WIPO using Form PCT/IB/375.

When the EPO is the (S)ISA, no further searching is performed in the EP regional phase, with consequent acceleration of the European procedure.

Entering the EP regional phase early

A PCT applicant does not need to wait until the end of the international phase before entering the EP regional phase. Provided that a specific request is made that processing of the EP regional phase should start immediately, the EP regional phase can be started at any time. For further information, see [Guidelines, Part E, Chapter IX, paragraph 2.8.](#)

Accelerating the EPO procedure

Generally, there are three options for accelerating the handling in the EPO:

- acceleration under the EPO's PACE program;
- acceleration using the Patent Prosecution Highway (PPH);
- acceleration by online status enquiry.

Acceleration under the PACE program

The PACE program is the EPO's procedure for accelerated handling of applications. Any or all of the following PACE measures are available:

- waiving the right to the communication under Rules 161 and 162 EPC (this communication sets a 6 month delay for pre-search amendment, in cases where the EPO performs a search in the regional phase)*;
- waiving the right to the communication under Rules 70(2) and 70a(2) EPC (this communication sets a 6 month delay for filing a post-search confirmation of desire to proceed, and amendment and response to the Search Examiner's written opinion, prior to start of the substantive examination)*;
- waiving the right to a second communication under Rule 71(3) EPC (second opportunity to approve the text proposed for grant, if the text initially proposed for grant could not be approved);
- requesting acceleration of any EPO search*;
- requesting acceleration of the substantive examination*.

If all of the measures marked * are taken, it can be expected that any required European search report and the first substantive examination report would be received within about 4 months after filing of the European application or entry into the European regional phase of the PCT application.

A request for accelerated examination can only be filed when the responsibility for the application has been passed to the examining division. However, for PCT applications where the EPO acted as (S)ISA, accelerated examination may be requested at any time such as upon entry into the EP regional phase or together with any response to the WO-ISA, IPER or SISR required under Rule 161(1) EPC.

An examination report will normally be issued by the EPO within about 3 months after making the request for acceleration of the substantive examination, provided that all necessary earlier procedural steps have been completed.

Any subsequent examination communications will also normally be issued within 3 months after a response.

Under the ECfS (Early Certainty from Search) program, a search report will normally be issued within 6 months after the filing date or expiry of the period under Rule 161(1) EPC. A request for acceleration of the search is therefore not normally necessary.

An application will be removed from the PACE program if:

- the PACE request has been withdrawn;
- the applicant has requested an extension of time limits;
- the application has been refused;
- the application has been withdrawn; or
- the application is deemed to be withdrawn.

Acceleration will be suspended if an annual maintenance fee is not timely paid.

PACE handling can only be requested once during examination.

Accelerated processing of oppositions is possible where infringement proceedings have been instituted, and accelerated processing before the Boards of Appeal can be requested in suitable cases.

Requests for accelerated handling filed online using the prescribed form are confidential. The documents relating to the request will not appear on the public file.

There is no official fee for requesting PACE handling.

Acceleration under the PPH

Please see our Information Sheet “Introduction to the Patent Prosecution Highway (PPH) System” in our Guiding Practice series of Information Sheets.

The aim of PPH is to allow the examination work product from one participating Patent Office to be re-used by another participating Patent Office. This “work product” may arise either from the work of a participating Patent Office on national patent applications, or from the work of a participating Patent Office as an International Searching Authority or International Preliminary Examination Authority on PCT patent applications.

To request PPH in the EPO, the same case must have been allowed or granted by another participating Patent Office (the “Office of Earlier Examination” or OEE), the European patent application must not yet have started its substantive examination, and the EPO claims must correspond in scope, or be narrower than, those allowed or granted claims. The available OEEs are the other “IP5” Patent Offices (the US Patent and Trademark Office, the China National Intellectual Property Administration, the Japanese

Patent Office and the Korean Patent Office), the Eurasian Patent Office and the Intellectual Property Offices of Israel, Canada, Mexico, Singapore, Australia, Colombia, Russia, Malaysia, the Philippines and Brazil.

If it is necessary to amend the EPO claims to fulfil this requirement, the amendment must be requested when filing the PPH request.

To support the PPH request, we will require:

- details of the allowed or granted OEE claims and an English translation if necessary;
- details of any proposed amendments to the EPO claims;
- copies of all national office actions in an OEE national procedure, or the IPRP in an OEE PCT procedure, and English translations if necessary;
- copies of all non-patent prior art cited in the OEE's office actions / IPRP;
- if not obvious, an explanation of how the EPO claims correspond in scope, or are narrower than, the allowed or granted OEE claims.

If PPH is requested, the EPO will normally handle the application with at least a level of acceleration corresponding to the PACE program.

There is no official fee for requesting PPH.

Acceleration by online status enquiry

If a status enquiry is filed on-line using the EPO Form 1012, this will result in the following specific acceleration of the next action by the EPO:

- the European Search Report will issue within 6 months in priority-claiming applications filed before June 2014;
- the European Search Report will issue within 1 month in applications filed on or after 1 June 2014 where more than 6 months have passed since the filing date or expiry of the deadline for pre-search amendments under Rule 161 EPC;
- the next Office Action will issue within 1 month in applications under PACE handling where a commitment as to speed of handling has not been met;
- the next Office Action will issue within 1 month in applications for which a previous enquiry has been made and where a commitment as to speed of handling has not been met.

There is no official fee for an online status enquiry.

Examples and Q&A

Question 1: What is the shortest time taken between entry into the EP regional phase and grant of the European patent with acceleration?

Answer: We are not aware that the record has ever been announced, but a good example is European

Patent No. 2811833, which entered its EP regional phase on 1 August 2014 and was granted as a European patent on 9 September 2015. PACE handling was requested shortly after issuance of the Communication under Rule 161 EPC and the remainder of the delay period for response to that Communication was waived. The right to receive a Communication under Rule 70 was waived at the same time. This resulted in a combined search and examination report, and the application was placed in order in response to that report. The on-line file is available at <https://register.epo.org/application?number=EP13746016>.

Question 2: When requesting accelerated handling of an application under the PACE program, is it necessary to provide reasons for acceleration, such as the need for early grant to sue infringers or attract investment?

Answer: No. No reasons need to be given.

Question 3: If I request accelerated handling of an application under the PACE program, is it guaranteed that the case will be accelerated?

Answer: There is no absolute guarantee, although normally the EPO will accelerate. The Guidelines for Examination state that accelerated prosecution under the PACE program will be provided only where it is practically feasible and subject to the workload of the search and examining divisions. It is also stated that in certain technical fields there may be constraints due to the numbers of PACE requests. In addition, applicants who request accelerated prosecution for all or most of their applications will, as a rule, be required by the EPO to limit the number of their PACE requests by making a selection (see [Guidelines, Part E, Chapter VIII, paragraph 4](#)).

Question 4: Can you show me an EP regional phase of a PCT application that was speeded up by obtaining a Supplementary International Search Report (SISR) from the EPO in the international phase?

Answer: A good example is European Patent No. 3041846. The basic PCT application was filed (in the English language) in China, designating CNIPA as the ISA. The EPO was used to provide an SISR in the international phase. As a result, no further searching was performed in the EP regional phase and the case went from regional phase entry to grant in about 2½ years.

Sources of Further Information and Advice

This is for general information only and does not constitute legal advice. Should you require advice on this or any other topic then please contact Joanna Deas (partner) at jdeas@hlk-ip.com or your usual Haseltine Lake Kempner advisor.