

Accelerated Prosecution at the EPO

Obtaining patent protection for an invention at the European Patent Office (EPO) can take a considerable amount of time. Due to rigorous search and examination procedures undertaken by European patent Examiners, and time taken for Applicants to formulate and submit a response to communications issued by the EPO, it takes on average 4 years to obtain a granted European (EP) patent.

If Applicants wish to speed up this process, the EPO offer several mechanisms which can accelerate the prosecution of their application.

PACE

One possible method of speeding up prosecution of an EP patent application is by requesting accelerated search and/or accelerated examination of the application under the “Programme for Accelerated Prosecution of European Patent Applications” (also known as PACE). PACE is a free service offered by the EPO which an Applicant can use by filing an online request for participation in the programme. A separate request must be filed at each prosecution stage (i.e., once during search and once during examination) for entry into the programme at those stages.

Where accelerated search/examination has been requested, for direct EP applications, the EPO will endeavour to:

- issue the search report within six months from receipt of the accelerated search request; and
- issue the first/next examination report within three months of receipt of the accelerated examination request.

PACE requests may also be requested after PCT applications have entered into the European Regional phase. However, it should be noted that, where the EPO was not the International Searching Authority (ISA) or Supplementary International Searching Authority (SISA), the EPO already strive to issue the search report within six months from the expiry of the period set by the Communication pursuant to Rule 161(2) EPC. Accordingly, a request for accelerated search at this stage has no effect. Once the Examining Division assumes responsibility for the application, a request for accelerated examination may be filed as normal, and is subject to the same timeline as described above.

Importantly, PACE requests are hidden from view on the public file, and so third-parties are not informed if such a request is filed. However, it can be speculated if several communications to an Applicant have been sent in a relatively short period of time.

PACE Requirements

To participate in the PACE programme, the EPO expects Applicants to reply to communications sent by the EPO on time. That is, applications will be removed from the PACE programme if Applicants request extensions to time limits made during the relevant stage of prosecution. Once removed, further requests to accelerate that stage of prosecution will not be processed.

It seems that the EPO considers PACE to be a two-way street, expecting Applicants to remain interested in prosecuting their applications quickly if the EPO is to use their resources for its acceleration.

Furthermore, the EPO will not allow Applicants to request participation in the PACE programme for all (or even most) of their applications. That is, Applicants are required to limit the number of applications for which they request PACE.

Therefore, Applicants should carefully consider which applications are worth accelerating if they wish to continue utilising PACE.

Patent Prosecution Highway (PPH)

For EP patent applications with earlier-filed corresponding applications (e.g., in other jurisdictions), the PPH is another way to accelerate the prosecution process.

The PPH is a system formed by agreements between the EPO and other patent offices that allows for accelerated prosecution by enabling the EPO to re-use work performed at one of those other patent offices, such as previous searches/examination. The PPH is designed to promote efficiency and reduce duplication of work between offices. Currently, the EPO has PPH agreements with 15 offices, including national patent offices in:

- the US;
- Canada;
- Japan;
- China; and
- Australia.

When entered into the PPH system, examination of the application follows a timeline comparable to a PACE request for accelerated examination, with the additional benefit that relevant documents may already have been discovered and/or amendments may already have been made to overcome objections previously presented.

PPH requirements

The requirements for entry into the PPH system are more restrictive than for PACE:

- the EP application must have the same priority/filing date as the corresponding earlier application;
- the corresponding application must have at least one claim which is allowable;
- the claims of the European application must “correspond sufficiently” to the claims of the earlier application (which, in practice, often requires prosecution of the European application to be based on a claim set with a comparable, or narrower, scope); and
- substantial examination of the EP application must not have started by the time the PPH request is filed – after all, duplication of work is only prevented if that work has not yet started.

It should be noted that while a PPH request may be filed based on claims found allowable at, for example, the USPTO, European-specific objections may still be raised after substantial examination of the application under the EPC. Further, while the EPO can use the work results of other offices, there is no compulsory recognition of this work.

Like PACE, participation in the PPH system at the EPO is free of charge. However, in contrast, the PPH request is visible on the public file (and therefore visible to interested third-parties).

Further information on PPH may be found in one of our other articles [here](#).

Other Methods of Acceleration

In addition to PACE and PPH, Applicants can also speed up prosecution by:

- waiving time limits; and/or
- choosing to perform acts earlier than necessary.

For example, for direct EP applications, Applicants can waive the invitation under Rule 70(2) EPC, which requests that the Applicant indicate that they wish to proceed with prosecution following the search. If waived, the search report is accompanied with a first examination report, to which a full and prompt response may be filed quickly.

As another example, where the EPO was ISA/SISA, the Applicant can waive the 6-month period for making voluntary amendments under Rules 161 and 162 EPC when entering the European phase. Instead, Applicants can expect the next communication they receive to be an examination report, accelerating prosecution by over 6 months (the 6-month period itself, plus the time taken for the EPO to issue the communication after European phase entry).

For PCT applications, the European Regional phase may also be entered well before 31-months from the priority date - the deadline for entering the European Regional phase.

Conclusion

There are various ways of accelerating patent prosecution at the EPO, and it is important for Applicants to carefully consider the requirements and ramifications associated with each form of acceleration before deciding whether to pursue it.

For example, while accelerated prosecution can help Applicants obtain patent protection more quickly, it can also reduce the overall cost of obtaining an EP patent, as the number of annual renewal fees (payable to the EPO whilst the application is pending) may be reduced.

Additionally, a granted EP patent provides increased security to Applicants beyond that of provisional patent protection (which arises while the application is pending) – important in situations where there is a risk of infringement.

At HLK, our attorneys would be happy to answer any queries you may have regarding accelerated prosecution.

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 hk@hik-ip.com or your usual HLK advisor.