

Expediting Prosecution of Euro-PCT Patent Applications

Obtaining a granted patent as quickly as possible may be desirable if you are aware of infringement and want to be able to assert your patent, or because an investor is willing to invest once a patent is granted. There are several options to accelerate the processing in the European Patent Office (EPO) of a European Patent application derived from an international application filed under the Patent Cooperation Treaty (PCT). These include:

1. Enter the regional phase (Euro-PCT) of the international application in the EPO well before the 31 month deadline, and ask for early prosecution of the application
2. In respect of a Euro-PCT, file a response to the Written Opinion (if any), amending the claims as necessary, and waive the right to receive the EPO's Communication under Rule 161/162 EPC
3. Request accelerated prosecution under the EPO's "PACE" programme
4. Request accelerated prosecution via the Patent Prosecution Highway (PPH)
5. Waive a further communication under Rule 71(3) EPC

All of the above are independent of each other and have different effects. It is possible in suitable cases to apply each step.

Early Entry

The first step can only make a difference if the regional phase is entered many months before the 31 month deadline. If the international application has not yet published, we may need to request a copy of the application filed for submission to the EPO.

Waiver of rule 161/162

The second step may save about six months of prosecution time. Normally, the EPO issues a Communication under Rule 161/162 EPC shortly after the regional phase entry. This gives the applicant a period of six months within which to file voluntary amendments to the claims and/or respond to a Written Opinion of the international searching authority (ISA), in the case where the ISA is the EPO itself. However, that opportunity is lost when the waiver is made. By attending to the requirements of Rules 161 and 162 EPC in advance of regional phase entry and waiving the right to this communication, the application should be passed more quickly to an examiner for the next stage of the application. Since the next step (examination or search of the application by an EPO examiner) is generally taking two, three or more years to complete (due to the EPO's backlog of unexamined and unsearched cases), taking this step alone might not have much noticeable effect.

PACE

PACE will result in the application being treated ahead of other applications and no reason needs to be given for accelerated prosecution. A PACE request may be filed only once for search and once for examination. If a request is withdrawn, deemed to be withdrawn or the application is removed from PACE for procedural reasons a second request for the same stage on the same application cannot later be made. It is only effective if all steps reasonably to be taken by the applicant are taken promptly (e.g. responding to the Search Opinion, or voluntarily dealing with expected objections).

PPH

Accelerated prosecution via the PPH programme is only available when certain qualifying conditions are met and where examination of the European patent application has not yet started. In these circumstances the claims of the European application must be amended to either:

- I. conform to claims that have been determined to be patentable/allowable by the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO) or the United States Patent and Trademark Office (USPTO), (together with the EPO, collectively referred to as the IP5 Offices), acting as the International Search Authority (ISA) or the International Preliminary Examining Authority (IPEA) of the PCT application from which this European application is derived; or
- II. conform to claims in a corresponding national IP5 Office patent application (i.e. a US, Chinese, Korean or Japanese patent application that shares a common priority with this European application) that have been determined to be patentable/allowable by corresponding national office; or
- III. conform to claims in the corresponding national patent offices of Australia, Canada, Colombia, Israel, Mexico, Russia or Singapore that have been determined to be patentable/allowable by corresponding national office.

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Waive a further communication under Rule 71(3) EPC

Applicants can expressly waive the right to receive a further communication under Rule 71(3) EPC where amendments or corrections to the text communicated by the examining division by means of a previous Rule 71(3) EPC communication are requested. Provided that specific formal requirements are fulfilled and the examining division has no objections to the amendments or corrections, the Office will not send a further communication under Rule 71(3) EPC and will proceed to issue the decision to grant the European patent.

Disadvantages of Accelerated Prosecution

Prosecuting a European application quickly does also have some disadvantages:

1. Costs are incurred more quickly, particularly of grant and validation costs, and, ultimately, national renewal fees. Obtaining rapid grant of a European application will remove the requirement to pay European maintenance fees (which are quite expensive by national standards) yet they will be supplanted by national renewal fees once a European patent is granted. This will be far more expensive in annual fees if the patent is validated and maintained in a significant number of countries (probably about three or more, although it depends entirely on which countries are selected).
2. Keeping an application pending enables a divisional application to be filed at more leisure, and may allow for amendments to be made to the claims, should that prove desirable (e.g. in the event of relevant prior art or a potential infringement coming to light). Accelerated grant may preclude this.
3. Geographical coverage of a patent granted by the EPO is decided by the applicant on grant. Decisions on national validation in up to 38 contracting states of the European Patent Convention can be taken once the patent is granted, so a more rapid grant, means taking a more rapid decision on where to validate.

Consequently, we are not advising applicants to expedite prosecution, but this is an option. If you are interested in expediting prosecution then please let the relevant attorney know.