

Expediting Prosecution of “directly-filed” European 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. These include:

1. Request accelerated prosecution under the EPO’s “PACE” programme; and/or
2. Request accelerated prosecution via the Patent Prosecution Highway (PPH)
3. Waive a further communication under Rule 71(3) EPC

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

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 If a request is withdrawn, deemed to be withdrawn or the application is removed from PACE for procedural reasons a second request for the same stage on the same application cannot later be made.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 conform to claims in a corresponding national patent that shares a common priority with the European application that have been determined to be patentable/allowable by that corresponding national office. Applicants whose claims have been examined by the national patent office may ask for accelerated processing of their corresponding EP application.

At the time of writing, the EPO has an operational PPH programmes with the IP5 offices (a grouping of the world’s five largest IP offices made up of the EPO plus the patent offices of China, Japan, Korea, and the US), as well as with the national patent offices of Australia, Canada, Colombia, Israel, Mexico, Russia and Singapore.

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.