

Obtaining a granted patent as quickly as possible may be desirable for various reasons, for example if you are aware of infringement and want to be able to assert the 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 'PCT' application (also known as a 'Euro-PCT' application). These include:

1. **entering the European regional phase early**, i.e. well before the 31 month deadline, and requesting early prosecution of the application
2. where the international search was performed by the EPO, filing a response to the Written Opinion, amending the claims as necessary, and **waiving the right to receive the Communication under Rule 161/162 EPC**
3. requesting accelerated prosecution under the EPO's '**PACE**' programme
4. requesting accelerated prosecution via the **Patent Prosecution Highway (PPH)**

These options are independent of each other and have different effects. It is possible in suitable cases to apply each of them.

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 submit a copy of the PCT application as originally filed to the EPO, to enable the request for early entry to take effect.

Waiving the Rule 161/162 communication

The second step typically saves about six months of prosecution time. The EPO usually issues a '*Communication under Rule 161/162 EPC*' shortly after regional phase entry. This communication gives the applicant a period of six months within to file voluntary amendments to the specification. If the EPO acted as the International Searching Authority (ISA) in relation to the base PCT application, then the applicant will also need to respond to any objections mentioned in the latest written opinion issued by the EPO upon requesting entry to the European regional phase.

By attending to the requirements of Rules 161 and 162 EPC in advance of regional phase entry and waiving the right to this communication (as well as the right to file any further voluntary amendments), the application should be passed more quickly to an examiner for the next stage of the application.

PACE (the '*programme for accelerated prosecution of European patent applications*')

A request for PACE will result in the application being examined ahead of other applications. (It is no longer possible to request accelerated search under the PACE scheme.) PACE requests can be submitted without incurring any official fees and without needing to provide any reasons for acceleration.

A PACE request may only be filed once per application, and whilst the application remains enrolled in the PACE scheme the examining division will aim to issue each subsequent communication within three months of the applicant's latest procedural action.

If a PACE request is withdrawn, or if the applicant takes certain actions that delay prosecution (e.g. by requesting an extension of time, or allowing the application to be temporarily deemed withdrawn) then the application will be removed from the PACE scheme and will be ineligible for PACE in the future. As such, a PACE request is only effective whilst the applicant takes prompt action to maintain the application at each procedural stage.

PPH (the 'Patent Prosecution Highway')

Accelerated prosecution via the PPH programme is available when certain qualifying conditions are met (e.g. the European application must be amended to 'correspond sufficiently' to a corresponding patent application found allowable by another patent office that the EPO has an agreement with) and where examination of the European patent application has not yet started.

At the time of writing, the EPO has permanent PPH programmes with the patent offices of China, Japan, South Korea and the US (the other 'IP5 offices') as well as Australia, Canada, Colombia, Israel, Malaysia, Mexico, Peru, Philippines and Singapore. The EPO also participates in pilot PPH programmes with the patent offices of Bahrain, Brazil, Chile and New Zealand.

Similar to PACE, the PPH programme has the effect of accelerating the examination stage of the application process. The main difference between the two programmes, is that the EPO will be able to review and consider the opinion of another patent office where a valid PPH request is made – this may help to persuade the examiner that the claims are also allowable within Europe.

Disadvantages of accelerated prosecution

Prosecuting a European application quickly also has some disadvantages:

1. Costs are incurred more quickly, particularly 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 for longer provides more time in which to consider filing a divisional application and/or amending 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. The geographical coverage of a European patent is decided by the applicant on grant. Speeding up the grant process means taking a more rapid decision on where to validate and maintain the patent in (up to) 39 contracting states of the European Patent Convention. If the commercial viability or relevance of an invention in particular countries is unclear, then it may be preferable to take a slower approach to obtaining grant instead.

Consequently, we do not routinely advise applicants to expedite prosecution, but this is an option. If you are interested in expediting prosecution then please let the HGF attorney responsible for your application know.