

Acceleration of a regional European patent application based on an International PCT application

The standard procedure for granting a Euro-PCT application can take up to six years, with the international phase lasting for 31 months and the European phase then taking up to another 38 months. Fortunately, there are five possible ways you can shorten or cut out certain steps and so accelerate the proceedings.

You can save the most time by selecting all six options but, if you prefer to target only certain procedural steps, you can also choose the individual ones that best suit you. The various options are described in more detail below. The first one is already available in the international phase, while the other three all become available on entry into the European phase.

Shorten the European phase by 12 months by choosing the EUROPEAN PATENT OFFICE (EPO) as your INTERNATIONAL SEARCHING AUTHORITY (ISA)

The first option is to choose the EPO as your International Searching Authority (ISA) when filing your international application. The EPO can act as ISA if the receiving Office where you file your international application has specified the EPO as a possible ISA. Most receiving Offices in the world have done so, including the USPTO, the JPO and, more recently, the CNIPA, which has appointed the EPO to act as ISA in a pilot project for applications filed in English.

Choosing the EPO as your ISA will save you 12 months in total once your application is in the European phase. Firstly, the EPO's international search report (ISR) replaces the European search report, which means there is no need for it to carry out a European search and so saves you the six-month period allowed for this. Secondly, dispensing with the European search report means there is also no accompanying written opinion and so cuts out the six-month period available for replying to it under

Rules 70(2) and 70a(2) EPC. If the EPO acts as ISA, your application can therefore go straight to the EPO examining division as soon as it has entered the European phase.

Choosing the EPO as your ISA also makes the process cheaper as you no longer need to pay any supplementary European search fee in the European phase.

Safe up to 15 months by requesting early entry into the European phase

The second option is to request early entry into the European phase by submitting a "request for early processing".

Pursuant to Article 23(1) PCT, the EPO acting as designated Office does not normally start processing Euro-PCT applications until the 31-month time limit that marks the end of the international phase has expired.

However, by filing a request for early processing pursuant to Article 23(2) PCT, you can enter the European phase earlier and so shorten the time spent in the international phase by up to 15 months. If you choose this option and you fulfil all the requirements for validly entering the

European phase, the EPO can start processing your Euro-PCT application as designated Office as soon as it receives the international search report (ISR).

If you selected the EPO itself as your ISA, it will have issued the ISR within three months of receiving your application where it claims priority from an earlier application or within eight months from the priority date where it is a first filing.

Since the EPO as ISA establishes the written opinion accompanying its ISR in one of its official languages (English, German or French), it does not need any translation by the International Bureau (IB) - as would be required, for example, for a written opinion in Chinese - and so it can start processing your Euro-PCT application as soon as it receives your valid request for early entry.

Save six months with a Rule 161/162 EPC waiver

The third option is to waive your right to amend your application by filing what is known as a "Rule 161/162 EPC waiver". This waiver can only be filed by entry into the regional phase.

Rule 161 EPC gives you the right to amend your application (again) before the EPO as designated Office. This right is enshrined in the PCT itself (Articles 28 and 41 PCT) and so - even if you have already filed amendments together with entry into the regional phase - the EPO remains obliged to offer you the opportunity to make further amendments.

However, if you do not need or want to amend your application - or if you have already amended it when entering the regional phase and paid any claims fees due (claims fees must be paid from the 16th claim onwards) - you can save six months by stating that you do not want to receive the communication under Rules 161 and

162 EPC and so waiving your right to amend your application in response to it.

If you did not waive your right on entry into the European phase, or if your waiver was invalid (e.g. because you had not paid the claims fees due), the EPO will issue the communication under Rules 161 and 162 EPC. However, you can still shorten the process by filing an early reply and explicitly forgoing the remainder of the six-month period available.

The EPO will then not wait until the end of this whole period before moving on to examine your application.

Request accelerated examination (PACE)

The fourth and final option for speeding up processing is to file a request under the "PACE" programme for accelerated examination of European patent applications.

If you file a PACE request, the examination division will strive to issue its next official communication within three months of your most recent procedural action.

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

Bear in mind that you can make only one PACE request during the examination stage. A PACE request will also not shorten the six-month time limit under Rules 161 and 162 EPC, which you must waive separately (see above). It is also very important that 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.

Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) is a programme to fast-track patent examination.

It allows you to request accelerated processing of a European application if the claims have been deemed patentable/allowable by another office. At the same time, it enables the EPO to re-use the work done at other offices.

The EPO currently has PPH programmes with a number of other offices.

The office that initially deems the claims patentable/allowable is called the Office of Earlier Examination (OEE). The office that can then make use of the OEE's work results is called the Office of Later Examination (OLE). The work done by the OEE (search reports, written opinions and international preliminary reports on patentability) can streamline work at the OLE, and thus speed up the procedure. At the EPO, there is no compulsory recognition of work results.

In the interest of efficiency and user-friendliness, all the EPO's PPH programmes are in line with PPH programmes operational worldwide, e.g. the IP5 PPH and the Global PPH (GPPH), thus ensuring full compatibility.

The EPO's current PPH programmes are with: Australia (IPA), Bahrain (MOIC), Brazil (INPI), Canada (CIPO), Chile (INAPI), China (CNIPA), Colombia (SIC), Israel (ILPO), Japan (JPO), Korea (KIPO), Malaysia (MyIPO), Mexico (IMPI), New Zealand (IPONZ), Peru (INDECOPI), the Philippines (IPOPPL), Singapore (IPOS), Saudi Arabia (SAIP) and the United States (USPTO).

The PPH programmes with the Eurasian Patent Office (EAPO) and Russia (Rospatent) are suspended.

Participation in the PPH programme is free of official charge.

- ✦ To participate in the PPH programme, you must meet the following requirements:
- ✦ the European patent application must have the same earliest date (i.e. priority or filing date) as the corresponding application,
- ✦ the corresponding application must have at least one claim that is patentable/allowable,
- ✦ all claims in the European patent application need to correspond sufficiently (claims are considered to fulfil this requirement if they have the same, a similar or a narrower scope),
- ✦ substantive examination of the European patent application must not have begun at the time the PPH request is filed.

To request participation, you need the following documents:

- ✦ the request for participation in the programme,
- ✦ the declaration of "claims correspondence",
- ✦ a copy of the latest national or PCT work product drawn up by the OEE,
- ✦ a copy of the patentable/allowable claims and copies of the documents

cited in the national work product or latest PCT work product. Translations will need to be filed if these documents are not in an official EPO language. If any of the above documents are already available to the EPO, then you do not need to resubmit them.

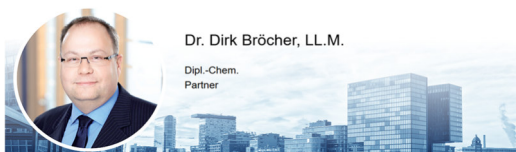
Alternatively, you may request the EPO to retrieve the documents and/or translations from the available dossier access system (electronic file wrapper) or Patentscope.

Acceleration by online status enquiry or personal consultations

If a status enquiry is filed on-line, this may result in an acceleration of the next action by the EPO.

One further possibility is to contact the Examiner-in-charge personally to discuss the existing objections.

Although the EPO is not obliged to speed-up the examination, we have good experience that such measures will speed up the procedure at least in some cases.



If you're looking for some guidance or assistance with your EPO applications, get in touch with our specialist patent attorneys at GILLE HRABAL.