



## Acceleration / Deceleration Options for European Patent Applications

We are all familiar with the issue of patent office backlogs whether at home or overseas, and the frustration that this can cause to those applicants seeking to obtain enforceable rights quickly. As European attorneys we are aware of the existence of the USPTO's *Track One prioritized examination* scheme and the possibility of obtaining a Patent Term Adjustment (PTA) to compensate for processing delays. Whilst the European Patent Office (EPO) does not offer an equivalent to the latter, a range of effective (and inexpensive/free) acceleration options are nevertheless available.

### 1. PACE Scheme

Submitting a request for accelerated search and/or examination of a European patent application under the PACE scheme has long been a popular means of shortening processing times at the European Patent Office (EPO). However, overuse of the scheme has significantly diluted its benefit over time with the EPO struggling to fulfil its stated aim of *"making every effort to issue the first examination communication within three months"*.

Significant changes were made to the PACE scheme in 2016 aimed at restoring its intended effect. For example, if an applicant requests an extension of time for responding to an official communication, or pays an annuity fee late, the corresponding application will lose its PACE status. Whilst applying for and maintaining PACE status is now a little more onerous from an administrative perspective, the scheme remains free of official fees, is available to all and will reduce the overall pendency of applications.

## **2. Waiver of *Rule 70(2) EPC* Communication**

PACE is often mistakenly viewed as the sole option for acceleration in Europe. However, there are other alternative options available to speed things up. For example, the EPO's default two-stage search and examination procedure can be compressed into a single stage by paying the official examination fee upon filing and proactively waiving the standard Rule 70(2) communication. This communication is issued following issuance of the Extended European Search Report (EESR) (and accompanying Search Opinion) and requires an applicant to explicitly re-confirm their request for examination (usually within a period of six months) after considering the content of the EESR.

Clearly, if this communication is waived and the search and examination stages are performed simultaneously then the timescale to grant can be shortened, particularly if this strategy is combined with the PACE scheme mentioned above. However, this is at the expense of foregoing the opportunity to actively withdraw an application following issuance of a negative EESR, and obtaining a refund of the official examination fee.

## **3. Waiver of *Rule 161/162 EPC* Communications**

In the case of European regional phase (or Euro-PCT) applications, an EPO communication is automatically issued under Rules 161/162 EPC shortly after filing. In response, an applicant may submit voluntary amendments (and pay any required "excess claims" fees) within a six month deadline.

This communication may also be proactively waived to avoid the six month stasis that would otherwise occur if no amendments are necessary. This requires any claim amendments to be submitted (and excess claims fees to be paid) at the time of filing. Ideally, those claim amendments should include reference numerals; include the two-part form favoured by the EPO; and address objections (if any) raised in the International Preliminary Report on Patentability. This strategy can also be combined with the PACE scheme and waiving of the Rule 70(2) communication mentioned above for maximum compound effect.

#### **4. Early Entry into European Regional Phase (Euro-PCT)**

The normal deadline for filing a Euro-PCT application is 31-months from the earliest priority date. However, an applicant may file a Euro-PCT application well before this deadline and make an explicit request for early processing by the EPO. This can be combined with any (or all) of the other acceleration options mentioned above.

If Europe is to be the main designated or elected office of international (PCT) application then consideration can also be given to selecting the European Patent Office as the International Searching Authority (ISA). By doing so, this will (usually) ensure that the Euro-PCT application is allocated to the same examiner who handled the application during the international phase, thus reducing the likelihood of new unexpected objections during the European phase. According to recent EPO statistics, 37% of all United States originating PCT applications are already processed by the EPO as the ISA.

#### **5. Patent Prosecution Highway (PPH)**

As members of the IP5 Office network, the EPO and USPTO are each participants in a Patent Prosecution Highway (PPH) pilot programme, the term of which was recently extended until at least 2019. Therefore, a granted US patent serving as the priority application for a subsequent European application can be used as the basis for entering the PPH at the EPO.

Whilst this is a welcome addition to a wide range of acceleration options available to applicants, it should be noted that participation in the PPH does not mean that a corresponding European application with equivalent claims to a granted US patent will automatically be accepted by the EPO. For this reason, we would generally recommend instead using the EPO's PACE scheme mentioned above, to gain the same acceleration effect without the administrative complexity associated with the PPH scheme.

## 6. Responding Promptly to Examination Reports

An obvious way of minimising delays in prosecution is to respond quickly to any official communications rather than utilising the full time period allowed for response (which is typically between two and six months). Anecdotal evidence suggests that a European examiner is more likely to process an application which returns to his/her desk quickly whilst the issues are fresh in the mind.

## 7. Deceleration Options

There will of course be occasions where it is desirable to slow down the progress of a particular patent application. In addition to not deploying any of the acceleration strategies summarized above, there are a few other delaying tactics that can be used.

Extensions of time are often (but not always) available as of right. For example, a two month extension of time is normally available for responding to an examination report. Further discretionary extensions can sometimes be obtained. Annual renewal fees can be paid up to six months late (with a 50% surcharge on official fees).

The EPO's "10-day Rule" applies to certain types of EPO communications which are deemed to be delivered on the tenth day following their posting. Therefore, *some* deadlines actually begin shortly after the communication is physically received.

The EPO's "Further" Processing procedure can be used to revive an application which has been deemed withdrawn due to the failure to meet certain types of deadlines. It is normally only used in emergency situations (with official fees being payable) but can be also used strategically to significantly extend the pendency of an application.

## 8. Further Information

Please contact us if you would like any further information or advice on any of the above options.