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Expediting The European Grant Procedure

RGC Jenkins&Co.
Partner

Dr. Kei Enomoto

In our Patent Issues Autumn 2014 publication¹, we reported on the European Patent Office's "Early Certainty from Search" scheme (ECfS) aiming at issuing all search reports and written opinions within six months of filing, prioritising completion of older cases over beginning work on new ones, and expediting grant once a "positive search opinion" has been issued.

After investigations, we speculated that the hierarchy of priority in the ECfS scheme could look alike this :

- Top priority : Expediting "positive search opinion" cases direct to grant ;
- Medium priority : Searches on new applications ;
- Low priority : First communication/first response ;
- Very low priority : Oppositions ;
- Out of sight : Dealing with older/existing open cases

The average time for European grant procedure is still above the 40 month mark and, without positive action from the Applicant, the applications at the bottom of this priority scale risk being left to languish in the EPO backlog pile.

In November 2015, the EPO issued two notices, namely OJ EPO 2015 A93 relating to the PACE procedure and OJ EPO 2015 A94 relating to other ways to expedite the European grant procedure.

I. Programme for accelerated prosecution of European patent application "PACE"

I.1. General Remarks

The request must be filed online using EPO Form 1005. The EPO will no longer accept requests filed in a letter.

The request must relate to one application only, i.e. a request cannot relate to multiple applications.

Accelerated examination can only be requested once the Examining Division has assumed responsibility. Therefore, it is not possible to request PACE for both search and examination in advance.

The application will be removed from the PACE programme :

- if the PACE request is withdrawn,
- if the Applicant has requested an extension of time,
- if the application has been refused or withdrawn or is deemed to be withdrawn.

Equally, the application will be removed from PACE if, instead of requesting an extension of time, the Applicant relies on the further processing procedure. The rationale is that, if the Applicant wants the EPO to issue communications promptly, then he should respond equally promptly.

Only one request can be filed at each stage of the procedure so that, if an application is removed from the PACE programme (see below), a second request will not be accepted.

Accelerated prosecution will be suspended if the renewal fees are not paid within the initial deadline. This implies that if the renewal fees are paid within the 6-month grace period, then the accelerated prosecution will resume.

I.2. Accelerated Search

The EPO endeavours to issue the European search report within six months from receipt of a PACE request. No requests are required for applications filed on or after 1st July 2014, as the EPO already sets itself a six-month target issuance time.

The accelerated search can only start :

- Once the EPO has received an application complete enough for the search report to be drawn up, e.g. the application should include a description and claims and, where required, drawings, a translation, sequence listing.
- For PCT(EP) applications, where the EPO was not the ISA, after expiry of the six-month period under Rule 161(2)EPC, unless the Applicant has waived the right to communications under rules 161(2) and 162(2)EPC and paid any claims fee due.

I.3 Accelerated Examination

Accelerated examination can be requested at any time once the Examining Division has assumed responsibility. For PCT(EP) applications where the EPO was the ISA, accelerated examination can be requested on European phase entry or together with a response to the Rule 161(1)EPC communication.

The EPO endeavours to issue its next communication within 3 months from the latest of :

- the Examining Division's receipt of the application, or

- the rule 70a or 161(1)EPC response, or
- the PACE request

Similarly, when the Applicant files a response to an examination report, the subsequent examination report should issue within 3 months.

I.4. Entry into Force

The revised PACE programme applies to requests filed on or after 1st January 2016. The provisions relating to the removal from the PACE programme or suspension of the accelerating prosecution applies to pending applications from 1st January 2016.

II. Other ways to expedite the European grant procedure

In a second notice, the EPO lists and summarises other ways to accelerate the grant procedure. In our experience, these procedures should be opted on a case-by-case basis as opposed to routinely. Indeed, the communications under Rule 70(2)EPC, 161/162 EPC and 71(3)EPC give opportunities to the Applicant to adjust the application to meet his requirements and to put the application in order for grant.

II.1. Waiving the invitation under Rule 70(2)EPC

This applies to applications in which the request for examination is filed before the European search report issues. Under Rule 70(2)EPC, the EPO invites the Applicant to indicate whether he wishes to proceed further with the application and give him the opportunity to comment on the search report.

Before issuance of the search report, the Applicant can waive the invitation under Rule 70(2) EPC and request examination unconditionally, irrespective of the results of the search. In this case, the European search report is issued together with a first examining communication, instead of the opinion on patentability under Rule 62 EPC.

II.2. Waiving the communication under Rules 161 and 162 EPC

The Rules 161 and 162 EPC communication gives the opportunity to the Applicant of a PCT(EP) application to amend the application and informs him of any excess claim fees due.

The EPO will not issue a Rules 161/162 communication, if the Applicant has waived his right to it, for example, in the European phase entry form and if all the Rules 161/162 requirements are fulfilled. In this case, the application will proceed directly to the supplementary European search report.

II.3. Waiving a further communication under Rule 71(3) EPC

The Rule 71(3) EPC communication is the notice of allowance, including the text approved for grant and if applicable, amendments proposed by the Examiner. If the

applicant disagrees with the approved text and/or the proposed amendments and files a response accordingly, the EPO will issue a second Rule 71(3) EPC communication once agreement has been reached.

The EPO will not issue a second Rule 71(3)EPC communication, if the Applicant has waived his right it, if the specific formal requirements are fulfilled and the Examining Division has not objections to the amendments or corrections.

II.4. Early entry into the European phase

The Applicant may request entry into the European phase before expiry of the 31 month time limit by filing an explicit request for early processing under Article 23(2)/40(2)PCT).

II.5. Accelerated processing of oppositions

If an infringement action is pending before a national court of an EPC Contracting State, it is possible to request the accelerated processing of EPO opposition. The request may be filed at any time by a party to the proceedings and must be filed in written reasoned form. In addition, the

EPO will also accelerate the processing of the opposition if it is informed by the national court of a Contracting State that infringement actions are pending.

III. Patent Prosecution Highway

The Patent Prosecution Highway (PPH) is a fast-track patent examination procedure in which a patent office (i.e. the "office of later examination" – OLE) can use the results of work previously done by another partner patent office (i.e. the "office of earlier examination" – OEE). This is another popular procedure in particular where an application claims priority. For example, where a Japanese priority application is allowed by the time the PCT application enters the European regional phase.

It is also worthy to note that an application admitted into the PPH programme will be automatically processed in an accelerated manner, as if under the PACE programme.

The downsides, in our experience, are that the EPO is not bound by the findings of the OEE. The EPO carries out its own search and forms its own opinion on patentability under the EPC. It may also be that the OEE findings will draw the EPO examiner to issues that it would not have considered in the first place.

III.1. Eligibility

The requirements for eligibility for PPH participation are listed below :

1. The application filed at the OLE must have the same earliest date (filing date or, if applicable priority date) with the earlier corresponding application.
2. The OEE must have found that the earlier application contains at least one .

patentable/allowable claim.

3. All the claims of the OLE application must sufficiently correspond to the patentable/allowable claims of the OEE application. This means that the OLE claims must have the same or a similar scope, or a narrower scope. Please note that claims of a new or different category (e.g. process, product) are not considered to sufficiently correspond.

4. The request for PPH participation must be filed before the OLE substantive examination procedure has begun.

III.2. The Request

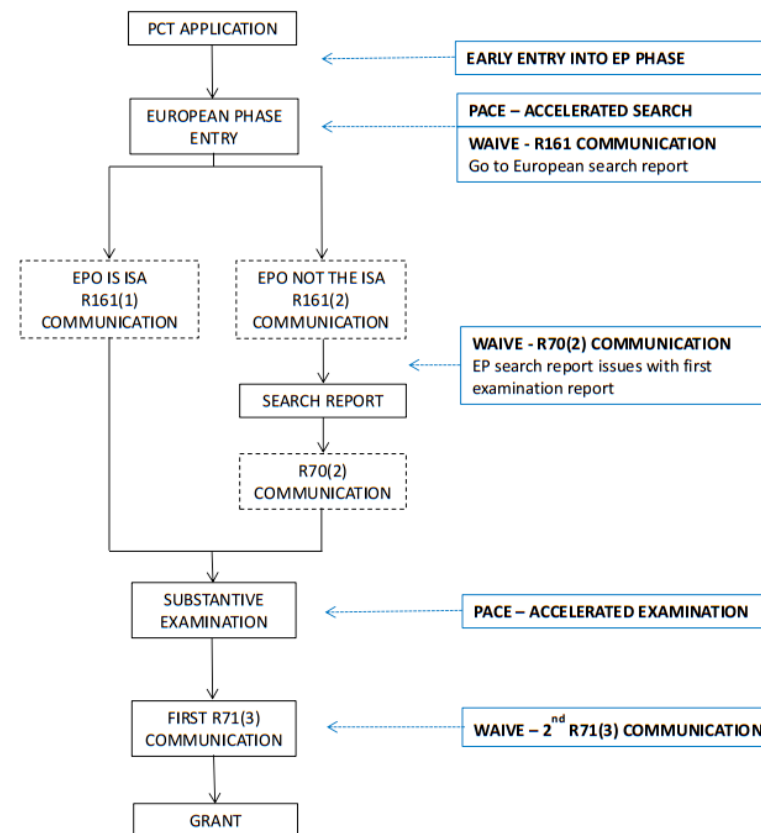
In order to participate to the PPH programme, the Applicant has to file :

1. a request (Form EPO 1009)
2. a declaration of claim correspondence
3. copies of the office actions issued in connection to the OEE application and copies of all the non-patent documents cited in the office actions (and translations into an EPO language if required).
4. a copy of the patentable/allowable claim(s) of the OEE application (and translation into an EPO language if required).

III.3. Participating States

At present, the EPO has PPH agreements with the following offices :

US Patent and Trademark Office	Until 5th January 2017
Japanese Patent Office	For PPH requests filed on or after 6th January 2014
Korean Intellectual Property Office	
Chinese Patent Office (SIPO)	
Canadian Intellectual Property Office	Until 5th January 2018
Israel Patent Office	For PPH requests filed on or after 6th January 2015
Mexican Institute of Industrial Property	
Intellectual Property Office of Singapore	



For more information, please do not hesitate to contact your attorney at RGC Jenkins & Co.

see also

[http : //www.jenkins.eu/news-and-publications/patent-issues-autumn-2014/whats-going-on-at-the-epo-schemes-and-statistics/](http://www.jenkins.eu/news-and-publications/patent-issues-autumn-2014/whats-going-on-at-the-epo-schemes-and-statistics/)