



Accelerated prosecution of European patent applications - PACE

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Accelerating the prosecution of a patent application can be useful. The grant of a patent can be critical in terms of its value with regards to investment and enforcement.

Requesting the 'Procedure for Accelerated Prosecution of European Patent Applications' (PACE) at the European Patent Office is a route that can expedite the search, examination and grant process of a European patent.

PACE can be applied for at any point in the pendency of a European patent application. The earlier the request is made, the greater the impact on the length of time of overall prosecution. A written request is necessary to initiate the PACE procedure. A dedicated request form is required, which must be filed online. There is no fee for requesting PACE, no reason for the request is required, and a request for PACE is not open to the public on the EPO Register (or otherwise). A separate PACE request must be filed for each stage of the procedure (i.e. a PACE request filed during search will not trigger accelerated examination).

In technical areas with limited search and examination capacity, the EPO may not be able to fulfil all PACE requests. Additionally, the EPO may require applicants who request PACE for many or all of their applications to select a limited number for accelerated prosecution.

An application is removed from the PACE program if the PACE request is withdrawn, if an extension of a time limit is requested, or if the application is refused, withdrawn or deemed withdrawn. In such cases, the application cannot be restored to the PACE program (i.e. a second PACE request for the same application during the same stage of the procedure will not be processed by the EPO).

Accelerated search

If a European application is a first filing at the EPO, claiming no priority, the EPO will always provide an accelerated search. This does not require a request to be made. The extended European search report will usually be issued within 6 months of filing. For applications claiming priority, the EPO will issue the extended European search report as soon as possible following a PACE request. However, an accelerated search report can only be issued if the EPO has all the necessary documents to complete the search. This includes the description, claims, any required translations and applicable drawings or correctly formatted sequence listings. Reference cannot be made to previous applications (Rule 40(1)(c) EPC) or subsequently filed description, drawings or claims.

Accelerated examination

The EPO will endeavour to issue a first office action within 3 months of a PACE request. A response must be filed at the EPO within the given time frame, without requesting an extension of time, and all the issues raised in the office action must be addressed. Failure to do so will result in the application being withdrawn from the accelerated procedure.

Provided that a prompt and full response is filed, the EPO will continue to issue any further office actions within 3 months of receiving the previous response.

Considerations for accelerated prosecution

Accelerating prosecution of a European patent may have clear advantages; however, the implications of expediting grant should be considered.

Cost implications:

In order to meet the requirements after allowance, claims translations in two languages must be filed at the European Patent Office and the fee for grant and publishing must be paid. The patent must be validated in each country where protection is required, which may incur significant costs. These certain costs are always due at grant. Accelerated prosecution may mean that they are incurred earlier in time.

National renewal fees:

In order to ensure a patent remains in force, renewal fees must be paid annually. Renewal fee cost for a granted patent may be significantly higher than for a pending application, dependent on the number of countries in which the patent has been validated.

Divisional applications:

A divisional application can only be filed during the lifetime of a pending application. Using the PACE program may reduce the time to consider the commercial embodiment of an invention, obtain additional data and consider whether a divisional application is advantageous.

Summons to oral proceedings:

Under the EPO's 'Early Certainty' initiative, Examiners have been issuing summons to oral proceedings more readily, and after a smaller number of preceding office actions. Where examination is accelerated, this can lead to a summons to oral proceedings being issued relatively early in prosecution, which may lead to significant costs.

Alternatives to PACE

There are ways to speed up prosecution outside the PACE program. For example, for Euro-PCT applications it is possible to enter the regional phase before the deadline of 31 months from priority and request early processing and commence the prosecution process early.

Rules 161(1) or (2) and 162 EPC communication waiver:

The right to receive a communication pursuant to Rules 161(1) or (2) and 162 EPC, which would usually issue shortly after a Euro-PCT has entered the regional phase, can be waived. Such communications have a six-month time period for filing a response. To be eligible for a waiver, the requirements of Rules 161 and 162 EPC must be met, which means paying any excess claims fees which are due and, if required, submitting a response to the written opinion of the International Search Report. The application will then proceed directly to the supplementary European search report or examination.