

Speeding Up and Slowing Down European Prosecution

Historically, it has been extremely difficult to predict how long it will take to obtain a granted European patent. Some cases proceed rapidly, with examination starting promptly and being concluded promptly. In other cases, inordinately long delays can occur, with some applications still pending towards the end of their 20 year lifetime, and even, occasionally, beyond.



Sue Scott
Consultant, London
sue.scott@abelimray.com



Julia Coggins
Associate, London
Julia.coggins@abelimray.com

In many cases, delays can be cost effective for Applicants. This is because there can be a significant saving in renewal fees. While a European application is pending, a single renewal fee is payable to the EPO. Once the patent is granted, renewal fees are payable to all the national patent offices in which the patent is to be validated. Unless the patent is validated in only a very small number of countries, the cost of the national fees is likely to be much greater than the cost of the single EPO fee. So, delaying grant beyond a renewal fee deadline can be advantageous. In addition, it may be helpful for cash-flow reasons to delay the costs associated with grant and validation of a European Patent in the various member states.

However, in other cases, Applicants require rapid grant. The EPO operates a system, PACE, for requesting accelerated search or examination. Following a recent change to the PACE programme, a separate PACE request is required for search and subsequently for examination. Following a request for search PACE, the EPO's target is to issue a Search Report within 6 months of the request. Following a request for examination PACE, the EPO's target is to issue a first Examination Report within 3 months of the request. At least in principle, there should be no need to request search PACE when entering the European Regional Phase of a PCT

Application, because the EPO operates to a PACE-like schedule in handling searches for new Euro-PCT applications. In addition, there are certain steps which Applicants can take on entering the European Regional Phase which will streamline the procedure and hence speed processing, for example waiving the right to a Rule 161/162 Communication.

The EPO has recently put in place a system where each application it receives is put into one of four categories which determine how rapidly the application will be handled. The highest priority, Priority 1, includes the following categories of work carried out by the EPO:

- First filing search
- PCT Chapter I search
- Searches with committed dates (e.g. applications on which PACE (accelerated prosecution) has been requested)
- PCT Chapter II search
- Opposition, limitation and revocation proceedings
- Fast track examination
- Supplementary search on Euro-PCT applications
- Second filing search
- National second filing search

Priority 2 applications are those not in Priority 1, where examination has already started.

Priority 3 applications are those not in Priority 1, where examination has not yet started.

Priority 4 is everything else, and is effectively a "freezer" into which a backlog of applications has been put. It includes all pending applications on which no search report was issued before July 2014.

If you have an application in the "freezer", there are two ways of unfreezing it. The first is to request PACE for either search or examination (or, eventually, both). This formal request will put an application into Priority 1. The second way is to write to the EPO and ask when they expect to issue the Search Report or the next Examination Report. This second way may also result in unfreezing the application. Because there is no fee for requesting PACE, it may seem as though this second route has no function. However, once PACE has been requested, there is an obligation on the Applicant to deal with matters arising expeditiously: for example, a request for extension of time to file a response to an Examination Report will result in the Application leaving PACE, and it is then not possible to re-enter PACE as an examination PACE request can only be filed once. Therefore in some cases it may be wise to make an enquiry of the EPO, rather than filing a formal PACE request.

Applicants should weigh up carefully the relative merits of speeding up and slowing down European prosecution on a case by case basis.

If you have any questions regarding the issues in this article, please do not hesitate to get in touch with your usual Abel & Imray contact, or send an email to ai@abelimray.com.

London
20 Red Lion Street
WC1R 4PQ, UK
T +44(0)20 7242 9984
F +44(0)20 7242 9989

Cardiff
3 Assembly Square
Britannia Quay
CF10 4PL, UK
T +44(0)29 2089 4200
F +44(0)29 2089 4201

Bath
Westpoint Building
James Street West
BA1 2DA, UK
T +44(0)1225 469 914
F +44(0)1225 338 098