



Controlling the speed of prosecution of European patent applications

The time it takes for European patent applications to proceed from filing to grant varies greatly from case to case, and is to a large extent under the control of the applicant. On average, it takes about four years for a European patent to go through the various prosecution stages before it reaches the grant stage, but this timescale can vary greatly and it is not unusual for some applications take much longer than this before they are eventually granted. The EPO are getting faster, however.

Some applicants are more than happy to wait for as long as possible for their patent to be granted, and there are ways to delay the process even longer if that is what the applicant wants to do. Delay puts off the expense of validating the patent once it has been granted, and defers the need to make a decision on whether to file a divisional application. On the other hand, there are applicants who want their patent to grant quickly, possibly so that they can enforce it against their competitors.

Slowing down prosecution:

A typical European examination report sets a four-month deadline for response, although some official actions will set a two-month or a six-month deadline depending upon the type of communication issued. Most deadlines can be extended past the set deadline, but some cannot. The list below gives details of some of the different official actions which can be received during the prosecution of a typical application:

Type of Official Action	Normal Term for response (calculated from date of issue of the communication)	Would an extension of time be possible?	What happens if I miss the deadline?
Form 1226 (Rule 161) Invitation to file: 1. voluntary amendments 2. pay any outstanding excess claims fees 3. file (mandatory) amendments to the International Search Report (but only if the EPO was the ISA)	6 months	No	The EPO will ignore any claims which have not been paid for (if there are any) and case will proceed to European search on the basis of the claims presently on file. However if a mandatory response to the search report is required, then this would have to be dealt with under further

			processing
Non-unity of invention/election of claims	2 months	No	If no response filed then the EPO would automatically search the first set of claims to be presented and the remaining would be ignored in this application (divisional applications could be filed to cover these inventions)
Form 1224/Form 1081/Form 1082 (Rule 70) Communications – providing 1. confirmation of intent to proceed to substantive examination of the application, 2. payment of the examination and search fees (Form 1081 only) and 3. response to the European search opinion (if necessary)	6 months	No	Further processing is available if the deadlines are missed. However, this would include 50% surcharges on the official fees if the official examination and designation fees had not been paid within the time limit – so often we pay the fees and just omit the response (item 3)
Examination Report	Typically 4 months, but some actions set a 2-month deadline	Yes – up to six months is available as of right	Further processing is available
Rule 71(3) communication – grant and print procedure	4 months	No	Further processing is available

So, if an applicant wished to delay the processing of their application for as long as possible, then as can be seen above, it would be possible to extend many of the deadlines past the original time limit set, and then to extend them even further still by failing to respond by the extended deadline, thus allowing the case to enter into a period of further processing before eventually having to file a response to avoid the application being deemed to have been irrevocably abandoned. It is possible to add several months to the prosecution period, just by using delaying tactics.

Further processing:

If a set deadline is missed, whether that be the original or extended deadline, then the European patent office would issue an Notice of Loss of Rights on the case, deeming that that the application had lapsed. The Notice of Loss of Rights would (for most, but not all, deadlines) also set a deadline of two months for requesting further processing of the application, should it not have been the intention of the applicant to allow the case to lapse in the first place. Within this two-month period, further processing of the application would need to be requested, the appropriate further processing fees paid and the outstanding response filed. Failure to complete these requirements within the two-month time limit would result in the irrevocable abandonment of the application.

Delaying the grant of applications that have been allowed for grant

Sometimes, applicants may wish to delay the grant of their application, maybe to ensure that any changes taking place on the application (due to changes of name and/or address, or assignments) can be recorded centrally at the European patent office, rather than at the individual patent offices, as would be the case if the application was granted before the changes had been effected. The grant procedure could be delayed by making use of the further processing period, but could also be delayed if the applicant disapproved the text for grant, as this would mean that the application would have to return back to the examination stage whilst the objections raised by the applicant were considered by the examiner.

An approach is, of course, to file a response that meets the minimum standard to count as a bona-fide response, but which is likely to still have issues that will cause an additional office action to be issued (many months later), and there will, of course, be the response time to the new office action, which will delay things even further.

Delaying payment of annual renewal fees:

Another "trick" is to delay the payment of the annual renewal fee that is due at the EPO on pending applications until five months into the six-month period for late-payment (although we do not recommend paying the renewal fee right at the last minute because things can go wrong and it is hard to try to rectify matters should the payment get missed altogether). The EPO have a practice now of not progressing prosecution on a pending application if the renewal fee is overdue. They prioritise their time on cases that might not be about to be abandoned. This can go to the extreme of postponing Oral Proceedings until after the last day for paying a renewal fee on maximum extension. If the renewal fee is never paid, then the EPO do not have to do the work at all.

There are other, more sophisticated, approaches to delaying prosecution and in rare cases where it is important to do so and your Barker Brettell attorney will be happy to discuss these with you.

Speeding up prosecution

If an applicant is keen to get their application granted as quickly as possible, they will want the procedure to move on swiftly as it can. Responding to official actions and communications without delay and without using extensions of time would help the process to move a bit faster, but the application could still sit on an examiner's desk for a long time before they get around to reviewing the response filed, or issuing the next official action on the case. Therefore, if speed is of the essence, then there are two practical approaches to ensuring that the application receives accelerated prosecution.

PPH Processing:

If you have a first patent which has been granted or allowed by one of the patent offices which is a member of the Global Patent Prosecution Highway, the IP5 PPH pilot programme or has an individual PPH agreement with other patent offices, then under this scheme you can request PPH processing of a later-filed application so long as this is done before examination takes place and the claims of the later-filed application are identical to, or narrower than, with the claims of the earlier, granted, patent. Applications handled under the PPH scheme should be examined and granted more quickly than those which are not receiving any sort of accelerated examination. We have seen success with PPH and it tends to reduce the prosecution costs as well as speed up grant.

Programme for accelerated prosecution of European patent applications (PACE):

If PPH processing is not an attractive option available to you, either because you do not have a granted patent in another country where the scheme is operational, or you want to pursue a different claim set to that granted in a corresponding application, then you can request PACE processing of your European application. PACE is divided into two stages:

1. to receive an accelerated search and
2. to receive an accelerated examination

You must specify which of these two processes should receive accelerated processing, as the request would only cover one process. So, if you filed a PACE request for an accelerated search, once the search report had been issued and the case had been transferred to the examining division, a further PACE request for accelerated examination would need to be filed if the PACE processing is to continue through the examination stage. Only one PACE request can be filed during each stage and failure to pay a renewal fee on time (the application would be deemed to have been withdrawn if this happens), or to respond to an official action within the set time limit (and without resorting to obtaining an extension of time, or further processing) would mean that the right to the accelerated processing would be lost and the case would then return to normal processing.

Waiving Rights to accelerate prosecution:

There are some other ways in which the applicant could try to accelerate prosecution of his application, and these are set out in the table below:

Type of European Application	Action taken to accelerate prosecution	Effect
Regional phase out of the PCT system	request early processing of their application so that the application is processed immediately, rather than waiting for the regional phase deadline to pass	the application would be processed immediately, rather than waiting for the 31-month regional phase entry deadline to pass
Regional phase out of the PCT system	waive the right to receive a the Rule 161 communication (Form 1226)	the case would go straight from filing to search, rather than waiting for Form 1226 to be issued and responded to (if necessary) within the six-month time limit set in the communication
Regional phase out of the PCT system	waive the right to receive a Rule 70 communication (Form 1224)	provided a formal request for examination had already been filed and the fee paid, the case would go straight from the search division to the examination division, without waiting for Form 1224 to be issued and responded to (if necessary) within the six-month time limit set in the communication

Direct European application filed at the EPO	waive the right to receive a Rule 70 communication (Forms 1081/1082)	provided a formal request for examination had already been filed and the fee paid, the case would go straight from the search division to the examination division, without waiting for Form 1081/1082 to be issued and responded to (if necessary) within the six-month time limit set in the communication
European direct and ex-PCT cases	waive right to receive a further Communication under Rule 71(3)	If the text ready for grant has been disapproved, so long as the amendments required are minor in nature then it should be possible for the application to go straight to grant, rather than waiting for another Rule 71(3) communication to be issued

Options to waive rights and/or request early processing of patent applications, can be implemented in conjunction with or without PACE or PPH processing, and should help to cut down considerably on the time taken to prosecute applications.

Using the various methods available to us, we are regularly getting EPO patents allowed within twelve months of filing.