

# Options For Speeding Up Or Slowing Down A European Patent Application

## Background

Speeding up or slowing down a patent application can be an important strategic tool in your commercial armoury.

In this guide, we highlight the best options for accelerating or decelerating your application in Europe in a cost-effective manner.



## Speeding Up

### PACE scheme

The PACE Scheme allows applicants to submit a request to the European Patent Office (EPO) for accelerated search and/or examination of a European patent (EP) application.

The scheme had been overused before 2016, which diluted its intended effect, but changes made since then mean that the scheme is now working more efficiently. Now, 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 the new system is a little more onerous from an administrative perspective, the scheme remains free of official fees and is available for all applications, making it still a useful tool.



**Time gained: potentially several months – EPO's stated aim is to “make every effort to issue the first examination communication within 3 months”.**



## IP5 Patent Prosecution Highway (PPH)

The IP5 PPH scheme is a current pilot scheme running between the EPO and the IP offices of the USA, China, Japan and Korea (the IP5). The scheme leverages fast-track examination procedures already in place at those offices and allows examiners to make use of the work products of the other offices.

Therefore, e.g., a granted US patent serving as the priority application for a subsequent EP application can be used as the basis for entering the PPH at the EPO. Whilst the scheme is a welcome addition to the range of acceleration options available, using the PPH does not mean that a corresponding European application with equivalent claims to the original patent will be automatically accepted by the EPO.

As such, we would generally recommend instead using the PACE scheme highlighted above, to gain the same acceleration effect without the administrative complexity associated with the PPH scheme.



**Time gained: potentially several months – expected to have similar effect to PACE scheme.**

## EPC communication waivers

- **Compressing 2-stage search & examination procedure into single stage (waiving Rule 70(2) epc invitation)**



It is possible to compress the EPO's default 2-stage search and examination procedure into a single stage by paying the examination fee upon filing and proactively waiving the standard Rule 70(2) EPC communication.

This communication is issued following issuance of the Extended European Search Report (EESR) (and accompanying Search Opinion) and invites an applicant to explicitly re-confirm their request for examination (usually within a 6-month period).

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 the opportunity to actively withdraw an



application following issuance of a negative EESR, and obtaining a refund of the official examination fee.

 **Time gained: 6 months**

- **Avoiding 6-month wait on voluntary amendment period for euro-pct applications (waiving Rule 161/162 epc communication)**



In European PCT 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 6-month deadline.

This communication may also be proactively waived to avoid the 6-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.

 **Time gained: 6 months.**

### **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 the other acceleration options mentioned here.

If Europe is to be the main designated or elected office of international (PCT) application, then consideration can also be given to selecting the EPO as the International Searching Authority (ISA). By doing this, this will (usually) ensure that the Euro-PCT application is allocated to the same examiner who handled the application during the international phase, reducing the likelihood of unexpected new objections during the European phase.



According to recent EPO statistics, 37% of US-originating PCT applications are already processed by the EPO as the ISA.

 **Time gained: potentially several months, depending on when Euro-PCT application filed and on whether same examiner allocated.**

## 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 2 and 6 months). Anecdotal evidence suggests that a European examiner is more likely to process an application which returns to his/her desk quickly whilst issues are fresh in the mind.

 **Time gained: up to 6 months dependent on length of original deadline.**

## Slowing Down

### Discretionary extensions

Extensions of time are often (but not always) available as of right. For example, a 2-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).

 **Delay gained: potentially 1-month.**

### EPO 10-day rule

The EPO's "10-day rule" applies to certain types of EPO communications which are deemed to be delivered on the tenth day after posting. Therefore, some deadlines actually begin shortly after the communication is deemed to have been physically received, even if it was actually received earlier (even if received electronically).



 **Delay gained: 10 days. Plus any available as-of-right extension which is typically 2 months.**



## EPO “further processing” procedure

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.

 **Delay gained: at least 2.5 months, and often more than 3 months.**

## Can we help you?

For tailored advice on acceleration and deceleration options for your European patent portfolio, please **contact Avir Patel**.



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