

Accelerated Prosecution of patent applications at the EPO and UK IPO – an update

1. Introduction

1.1 As previously described¹, the EPO and UK IPO each have procedures for applicants who wish to increase the speed with which their patent application is prosecuted and granted. Recent publications from these patent offices have shed more light on these procedures.

2. The EPO

2.1 With its notice of 4th May 2010², the EPO explained revisions made to the programme for accelerated prosecution of European patent applications (PACE) following the EPO rule changes that took effect on 1st April 2010³. Mainly, these revisions were specific to PACE requests for Euro-PCT applications.

2.2 In particular, the EPO has clarified that if the PACE request is made when entering a PCT application into the European regional phase, then the accelerated prosecution covers formalities examination, as well as the generation of any supplementary European search report and substantive examination. In our experience, such acceleration of formalities examination and processing has not previously been consistently implemented, so the explicit clarification in the EPO notice is welcomed.

2.3 With the new rule changes in April has come the requirement that if the EPO was the International Search Authority (ISA) for a PCT application, then soon after entry into the European regional phase the Applicant must file a response to any opinion given by the EPO in the international phase⁴. The EPO is now

¹ [Accelerated Prosecution of patent applications at the EPO and UK IPO](#)

² [Notice from the European Patent Office dated 4 May 2010 concerning the programme for accelerated prosecution of European patent applications – "PACE"](#)

³ Summarised in [Recent EPC rule changes raise the bar for Applicants](#)

⁴ [Rule 161\(1\) EPC](#)

suggesting, therefore, that to be most effective any such required response should accompany the PACE request.

2.4 Similarly, if accelerated examination is only requested after receipt of the search report for either a Euro-PCT or a direct European application, then the applicant's response to the search opinion should be filed with the PACE request.

2.5 The EPO has also provided clarification of two other procedures that can be used to accelerate the prosecution of an application, which procedures are often (though not always) used in conjunction with a PACE request.

2.5.1 Firstly, it is possible to unconditionally request examination before the search report is prepared⁵, in which case the European search report is issued with the first examination report, rather than with a search opinion.

2.5.2 Secondly, it remains possible to explicitly waive the right to receive the communication from the EPO inviting amendment of the application and payment of any excess claims fees for a Euro-PCT application⁶. However, and since this Communication now also sets the deadline for filing a response to any opinion given by the EPO (acting as ISA, for example) in the international phase, before waiving the request the applicant must make sure that they have made any amendments, paid any excess claims fees and, where necessary, responded to the EPO's opinion from the international phase. These steps should therefore be taken on regional phase entry and before the right is waived to receive the communication.

2.6 More generally, the EPO is obviously concerned about potential overuse or abuse of the PACE procedure by applicants, as in the notice² the EPO

⁵ [By waiving the invitation under Rule 70\(2\) EPC](#)

⁶ The "[Rule 161 Communication](#)" and the "[Rule 162 Communication](#)")

