



# Expediting patent grant by the EPO and UKIPO

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# How can we expedite grant?

- Use official acceleration procedures
- Make life easy for the examiner



# How long does EPO patent grant typically take?

Average time to grant ~ 5 years from priority date

- But many applications have been pending longer than 7 years, and some are never granted
- EPO “early certainty from search” initiative since July 2014
  - Issue search report and written opinion within 6 months of the actual EP filing date
  - Prioritise processing of applications for which examination report has been issued
  - Expedite grant if a positive search opinion has been issued
  - Prioritise processing of oppositions and requests for limitation or revocation



# Acceleration procedures at the EPO

## Programme for Accelerated Examination (PACE)

- Can be used for search, examination or grant
- No fee
- No reason required
- EPO aims to issue communication within 3 months of request
- Times not guaranteed by EPO
- PACE request can be kept off the public register
- Does it work?



# Acceleration procedures at the EPO

## Waive the right to some communications

- For direct EPO filings, pay exam and designation fee on filing and waive right to Rule 70(2) EPC communication
  - Examination will then proceed immediately after search
- For PCT(EP) filings, waive right to receive communication under Rule 161 and Rule 162 EPC
  - Must deal with any PCT International phase objections on entry
  - Must pay excess claims fees on entry



# Acceleration procedures at the EPO

## Patent Prosecution Highway (PPH)

- Aims to expedite grant of claims approved by ISA (PPH IP5) or if claims granted by approved patent office
- But no presumption of validity of claims
- No faster than PACE accelerated search and examination
- Just more paperwork?

# How fast could you go at the EPO?





# How long does UKIPO patent grant typically take?

Average time to grant ~ 2.5-3 years from priority date (if granted)

- Statutory period for completing examination : later of
  - 4.5 years from priority date or
  - 12 months from first examination report
- Most cases granted between 2 and 4 years from priority date





# Acceleration procedures at the UKIPO

## Combined search and examination (CSE)

- Request search and examination together
- Very effective at speeding up the process if you respond quickly
- Obligatory for PCT national phase entries unless very early national phase entry



# Acceleration procedures at the UKIPO

## Accelerated search and examination

- No fee
- But you must have an adequate reason e.g. potential infringer, need to secure investor, required for PPH request elsewhere
- “Green channel” allows acceleration without reason
- PCT(UK) fast track
- Early publication must also be requested if quick grant required

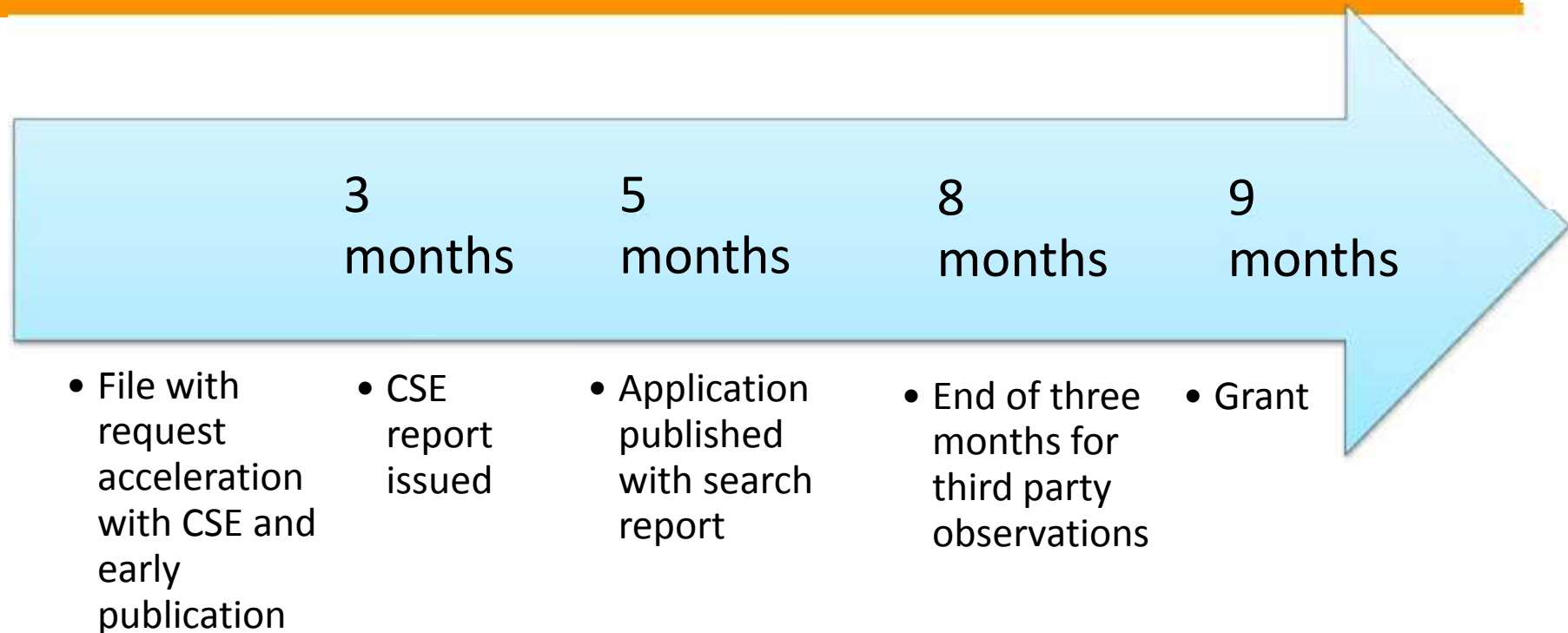


# Acceleration procedures at the UKIPO

## PPH and PCT-PPH

- PPH as EPO PPH
- PCT-PPH as EPO IP5 PPH
- No faster than accelerated search and examination
- No presumption of validity of claims

# How fast could you go at the UKIPO?





# Early entry into the UK national or EP regional phase

Early entry is possible in both EPO and UKIPO

- You must request early processing as well as filing the application early
- Then request accelerated search and examination as for direct filings



# Make life easy for the examiner

## Before filing

- Good quality translation
- EP/UK patent attorney review, especially of the claims
- Attend to all formal requirements
- Limit to single invention
  
- Deal with objections raised in PCT International phase



# Make life easy for the examiner

## During prosecution

- Respond early and fully to Office Actions
- Telephone the examiner if needed
- Restrict claims to narrow scope (then file divisional?)
- Accept examiner suggestions, if possible



Thank you!

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