

Accelerated prosecution of patent applications at the EPO and UK IPO

1. Introduction

1.1 Obtaining a patent can seem like a long, drawn-out process, and frequently it is desirable to obtain the patent as quickly as possible.

1.2 For example, you may want to use a granted UK patent and the patent prosecution highway program to expedite prosecution of a corresponding US, Japanese or South Korean application, or you may want to be able to start enforcing your patent as quickly as possible as infringement is likely to occur imminently, or you may want to use the outcome of prosecution to encourage investment and/or as an indication of likely success in other jurisdictions.

1.3 Both the EPO and UK IPO provide procedures for accelerated prosecution which may be requested by the applicant for a patent application, and the UK IPO have recently published a notice¹ outlining new conditions under which acceleration can be requested.

2. The EPO PACE procedure

2.1 The programme for accelerated prosecution of European patent applications (PACE)² can be used to speed up the search and/or examination of a European Application. To use the PACE procedure, the Applicant normally just needs to request it in writing. No specific reasons need to be supplied with the request, and the EPO will not publish the request as long as it is made on either a separate sheet of paper or EPO form 1005.

2.2 A PACE request to accelerate the search procedure must be made on filing the application. As long as the application documents were complete on filing, the EPO should then aim to issue a search report as soon as possible.

2.3 A PACE request to accelerate examination may be made on filing,

¹ [Intellectual Property Office - Green Channel for patent applications](#)

² [Notice from the EPO, Special Edition 3, OJ EPO 2007, F.1](#)

provided that at the same time the applicant bindingly requests examination, or it may be made in response to the search report, or it may even be made subsequently. The Examining Division should issue a communication regarding whether the application meets the requirements for grant within 3 months of the receipt of the request. Any further communications should be issued within 3 months of the applicant's reply.

2.4 Using the PACE procedure is therefore an easy and painless way of accelerating what can be a very lengthy process. Therefore, if it would be advantageous to obtain a European Patent quickly, for example where imminent infringement is likely or where a granted patent would be of help for investment or licensing, a PACE request should be considered.

3. The UK IPO

3.1 Acceleration of prosecution at the UK IPO may encompass accelerated search, examination and/or publication. If a request for acceleration of all three stages of prosecution is made on filing the application, then it should be possible to obtain a patent within a year of filing the application³.

3.2 If the applicant wants accelerated publication of the application then they just need to request this and, as long as the search has been carried out, the application should publish in about six weeks after the request was filed.

3.3 However, adequate reasons for the accelerated prosecution request must be supplied to the UK IPO in order for a request to be granted for accelerated search and/or examination. Traditionally, such adequate reasons might include the applicant being aware of a potential infringer, or faster prosecution being important in order to secure investment.

3.4 More recently, the UK IPO has announced² a new "Green Channel" which can be used instead if the application relates to a "green" or environmentally friendly technology.

3.5 To make use of the "Green Channel", an applicant merely needs to tell the UK

³ [UK IPO Patents Fast Grant Guidance](#)

IPO firstly that their application relates to a green technology, and secondly which stages of the prosecution they wish to accelerate (i.e. search, combined search and examination, examination, and/or publication). No further reasons for the request need to be given.

3.6 A request for acceleration can be filed at any time during prosecution; although it can obviously have a greater effect the earlier it is filed. An examiner will then consider the request, and confirm whether or not it has been allowed, based on the reasons given.

3.7 Even if it is not possible to provide adequate reasons for accelerated search and examination, there are steps that can be taken to make sure that the prosecution proceeds as swiftly as possible, such as filing the search and examination requests when filing the application, in which case the first search and examination report should issue within four months, and responding to any communications as quickly as possible.

3.8 According to data obtained from the UK IPO, currently the average time taken for any application to be granted is 32 months, and on average grant takes place 26 months after filing a request for examination. The technical field of the application will influence this though, as there are large backlogs at the UK IPO for some technical fields. For some applicants this will simply be too slow, in which case accelerating prosecution may be the answer.

4. Practice Tips/ Advice

1. Accelerated prosecution can be requested at both the EPO and the UK IPO, though the UK IPO require reasons for the request
2. The new "Green Channel" makes it much easier to obtain accelerated prosecution at the UK IPO if the application relates to "green" or environmentally friendly technology
3. For some applicants a quickly granted patent can be important to aid funding or licensing negotiations, or to allow early enforcement of the patent rights against infringing activity.

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