

## How to get a patent quicker - Europe

### Official Procedure

Many applicants before the European Patent Office (EPO) are likely to consider the possibility of bypassing office backlogs by requesting accelerated processing. According to the EPO's 2009 Business Report a granted patent was published on average 43.1 months after the application was received (the figure varying between 35 months and 57 months depending on the area of technology). Last year accelerated processing was requested in around 7% of cases undergoing examination.

The EPO provides a dedicated programme for accelerated prosecution of European patent applications - "PACE" - which enables applicants who want their applications processed rapidly to obtain search and examination reports within tight deadlines.

When accelerated examination is requested the EPO makes every effort to issue the first examination communication within three months. It is then aimed to produce subsequent examination communications within three months of receipt of the applicant's reply, provided it is received within the time limit set and deals with all the points raised. The accelerated examination process therefore requires co-operation between the applicant and the office. Applicants can expect accelerated applications to be granted within 12 months as opposed to the average of around 3.5 years.

Accelerated examination can be requested at any time for European or Euro-PCT applications. No reasons need to be given; accelerated prosecution simply commences on written request. The EPO does not publish PACE requests and they are excluded from file inspection provided they are made using EPO Form 1005 or filed on a separate sheet of paper. This allows an applicant to hide any commercial reasons behind its desire for accelerated grant of a European patent.

There is no fee required for a PACE request.

Although there is no restriction on the number of PACE requests that can be filed by a particular applicant, any applicant requesting accelerated prosecution for all or most of their applications will, as a rule, be required by the EPO to limit the number of their PACE requests by making a selection.

### Advice

In many cases the main reason for speeding an application through to grant is so that the patent can be enforced against infringers. Fast action can be particularly important where a patent holder wants to be able to apply for an interim injunction, potentially closing down infringing activities before they have had chance to take hold in the market.

Another reason for seeking to get a patent granted more quickly is where an applicant is seeking investment or undergoing negotiations with a potential licensee. Parties interested in commercial exploitation of an invention will often want the confidence that comes with a granted patent, especially one that has been searched and examined to the high standards of the EPO.



## Patent prosecution highways

The Patent Prosecution Highway (PPH) enables an applicant whose claims are determined to be patentable by one office to have a corresponding application filed in another office advanced out of turn for examination while sharing work results. At present the EPO has launched pilot PPH programmes with the United States Patent and Trademark Office (USPTO) and the Japanese Patent Office (JPO).

The PPH pilot programme between the EPO and the USPTO was launched on 29 September 2008 and has been extended up until 30 September 2010. The PPH pilot programme between the EPO and the JPO commenced on 29 January 2010 for a trial period of two years ending on 28 January 2012.

Where a European application contains claims that are determined to be allowable, the applicant may request accelerated examination of a corresponding application at the USPTO or JPO. The procedures and requirements for filing a request with the USPTO or JPO for participation in the PPH pilot programme are determined by the respective offices. Typically the applicant must provide the USPTO or JPO with the necessary documents, such as results of search and examination in the EPO and a copy of the claims as allowed. The applicant can then expect to receive an Office Action in the US or JP application within three months, greatly speeding up the process of obtaining patents in several jurisdictions.

## Other prosecution strategies

In various European states it is possible to obtain protection more quickly by filing a utility model application. Utility models are available in Spain, Hungary, Poland and Turkey, and in Austria, Belgium, Czech Republic, Germany, Denmark, Estonia, Finland, Portugal, Slovakia utility models may even be granted in addition to patent rights for the same invention.

Germany provides a good example of how a dual system can be used to maximise IP protection. Both a utility model and patent application can be filed in parallel. Although a utility model must meet many of the same basic validity requirements as a patent in terms of novelty and inventive step, it is registered without substantive examination being carried out. Utility model protection may therefore be obtained within 3-6 months from filing, while a patent application may be pending for 3-5 years while it undergoes examination.

One of the main advantages of e.g. a German utility model is that it can provide an enforceable IP right in a short timeframe. Infringement proceedings can be initiated on the basis of a utility model and the same remedies are typically available as in patent litigation, i.e. injunctions (including interim injunctions), damages, seizure and destruction. If a corresponding patent is later granted then it may be joined in the proceedings.

Another feature of the German system is that a utility model can be branched off from a pending European patent application at any time, even up to a few months after grant or conclusion of EPO opposition/appeal proceedings. This can enable savvy applicants to branch off a utility model with claims that are tailored to catch a particular infringer, or which are valid in view of non-citeable prior art such as prior use outside of Germany or the applicant's own disclosure in the six month grace period prior to filing.



However the benefits of utility models are limited in terms of a reduced term (typically 10 years) as compared to patents and in terms of the type technology that can be protected, for example German utility models cannot include method claims.

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