

Accelerated Prosecution

Our information sheets titled 'UK Patents - The Basics' and 'European Patents - The Basics' set out in detail the various procedural steps involved in obtaining UK and European patents, along with the likely time scale involved. This time scale is summarised below:

- 0 months - file priority application
- 14-16 months - search report issued
- 18 months - application published
- 30 months - examination commences
- 32-44 months - grant

It is possible to shorten many of the stages in the prosecution of both UK and European patent applications by requesting accelerated prosecution. There is no charge for requesting accelerated prosecution, and in most cases no reasons need be given.

Why should I accelerate prosecution?

In many cases it is undesirable to accelerate prosecution. For example, if you wish to delay costs, then you probably do not want to accelerate prosecution.

However, there are several reasons why you may wish to speed up various stages of the prosecution of your patent application.

- After filing the priority application, there is a period of 12 months during which you can file applications in other countries. Filing abroad can involve considerable expense. Therefore, if you are unsure about your prospects for gaining a patent, it may be a good idea to request an **early search** so that you will have the search results **before you take the decision whether or not to file in other countries**.
- Filing a patent application gives you no protection from infringers until the application is published. After publication, you will have "provisional" protection which can be acted on after the grant of the patent. Therefore, if you become aware of a potential infringer early on during the life of your application, it may be a good idea to request **early publication** if possible so that your **provisional protection extends from the earliest date possible**.
- As mentioned above, once the application is published, you will have only provisional protection. However, this is of limited scope and you cannot take action against any potential infringers until your patent is granted. Therefore, if you are aware of a potential infringer, then it may be a good idea to **accelerate examination** of your application and/or **grant** of your patent so that you can **take action**

against any potential infringer at the earliest date possible.

What stages in the prosecution of my UK patent application can be accelerated?

• SEARCH

The UK Patent Office claim to search all applications as soon as possible and therefore suggest that an early search should not be requested.

However, if an early search is requested along with a **suitable reason** for the request, the UK Patent Office will attempt to carry out an early search. A suitable reason could be that you wish to study the search results before deciding whether to proceed with foreign filings.

• PUBLICATION

It is possible to request early publication of a UK patent application. However, the application cannot be published until the search report has been issued and so it may be necessary to request an early search in combination with a request for early publication. There are also several other formalities which must be met prior to publication. Once early publication is requested, the publication process takes about **five weeks**. It should be noted that if the application is published early, the **examination fee** becomes due at an earlier date than would otherwise have been the case.

• EXAMINATION

There are several ways to accelerate examination at the UK Patent Office. Firstly, if on filing your application you know that you wish to accelerate prosecution, you can **request**

search and examination together. In this case, the Patent Office will carry out the examination at the same time as the search. Secondly, if after filing you decide you want an early examination, it is possible to request an **early examination** provided that an adequate reason is given, such as a possible infringement. Thirdly, in certain circumstances you can make use of the 'Patent Prosecution Highway', explained in more detail below.

- **FAST-TRACK FOR PCT(UK) APPLICATIONS**

The UK Patent Office permits applicants to request fast-tracking of PCT applications entering the UK national phase, where all the claims were considered in the IPRP (the patentability opinion issued in the international phase) and not objected to. Once an application is on the fast-track, the UK Patent Office aims to issue the first examination report within two months. Fast-tracking may be requested for both new and existing PCT(UK) applications.

- **GRANT**

In cases where early examination is requested, it is possible for early grant to occur. However, the grant will be delayed until **three months after** publication of the application in order to allow third parties to make observations. Therefore, in cases where an early grant is required, it may be a good idea to request early publication as well.

What stages in the prosecution of my European application can be accelerated?

- **SEARCH**

If a request is made for early search, the European Patent Office (EPO) will search your application as soon as possible.

In the unusual circumstance that your European application is your first filing then the EPO will automatically issue a search report within six months, to provide you with a search report to help you to decide whether or not you wish to file in any other countries.

- **PUBLICATION**

It is possible to request early publication of a European patent application. However, publication may still not occur for up to five months after the request is received.

- **EXAMINATION**

Accelerated examination can be requested in writing at any time using the EPO's "PACE" procedure. If such a request is received by the EPO, they will attempt to issue the first examination report **within three months.**

If accelerated examination is requested, it is necessary to file any responses to the examination reports without requesting extensions of time, in order to maintain a speedy examination process.

It is also possible to waive your right to a communication from the EPO requesting whether you wish to proceed with the application. This waiver further increases the speed of the prosecution.

An alternative to requesting accelerated examination is to file comments after receipt of the search report. The Examiner will take these comments into account on examination and the comments may deal with some issues that the Examiner would otherwise have raised in the examination process.

Another option is to make use of the 'Patent Prosecution Highway' which is available in certain circumstances.

Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) offers a mechanism by which positive examination results from one patent office (the Office of First Filing, OFF) can be used to accelerate examination of a corresponding application at another (the Office of Second Filing, OSF).

In the UK, a positive examination report from the Japanese, US or Korean patent office can be used to accelerate examination of a corresponding UK application.

At the EPO, a positive examination report from the Japanese or US patent office, or a positive report from one of those offices in their capacity as an International Search or Examination Authority can be used to accelerate examination of a corresponding European application.

Many conditions need to be met to make use of the PPH program. Some points to note are:

- For PPH to be used, examination at the UK Intellectual Property Office, or at the EPO, must not have begun.
- At least one claim must have been said to be allowable by the OFF.
- The claim(s) pursued under PPH must correspond to the claim(s) said to be allowable by the OFF.
- For the UK and EPO, there is no fee for using PPH.

Please refer to our information sheet entitled "Patent Prosecution Highway" for more details about this program and the general requirements for its use.

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London

33 Gutter Lane

London

EC2V 8AS

Tel: 020 7776 5300

Fax: 020 7776 5399

Bristol

22-24 Queen Square

Bristol

BS1 4ND

Tel: 0117 945 1234

Fax: 0117 926 5692

Manchester

Bridgewater House

Whitworth Street

Manchester M1 6LT

Tel: 0161 247 7722

Fax: 0161 247 7766

Cambridge

Newnham House

Cambridge Business Park

Cambridge CB4 0WZ

Tel: 01223 420383

Fax: 01223 423792