

# How to speed prosecution, save money and still maximize your rights in Europe

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# How to speed prosecution, save money and still maximize your rights in Europe

- The EPO is becoming more hostile to Applicants
- EPO wants to reduce prosecution/pendency times
- Examiner's points system incentivizes them to expedite examination



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# How do we give the Examiner the fewest possible reasons to refuse grant?

- By knowing what he is looking for
  - Acknowledge closest prior art
  - Reference numerals in claims
  - Independent claims in 2 part form
  - What is the technical problem solved?
  - Reasons why claimed solution not obvious



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# Should we provide these?

- Acknowledge closest prior art ✓
- Reference numerals in claims maybe
- Independent claims in 2 part form maybe
- What is the technical problem solved? ✓
- Reasons why claimed solution not obvious,  
using problem/solution approach ✓



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## If so, when?

- Drafting/pre-filing review (make case look more European)  
We routinely reduce the number of claims as far as possible to avoid excess claims fees which are €200 per claim from the 16<sup>th</sup> claim onwards
- Voluntary submissions after European Search Report issues
- Response to office action
- Interview with Examiner
- Oral proceedings



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# Tricks to accelerate examination



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# Why accelerate prosecution?

- Quick grant
- Cost savings, especially annuities
- But costs now not later



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# Patent Prosecution Highway (PPH) can accelerate grant

- Aim of PPH
  - Mutual recognition
    - ie. Examining Offices share their work

Improves speed of issuance

Raises quality of granted patents



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## How PPH works

- If claims allowed by ‘Office of First Filing’ (OFF) a corresponding application filed in the ‘Office of Second Filing’ (OSF) will be examined
  - Out of turn
  - The OSF will utilize work product of OFF



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## How PPH works (2)

- There is no expectation that an application will be treated more favourably by OSF just because claims allowed by OFF
  - In practice, USPTO allowance rate doubled when OSF
  - But JPO still very ready to refuse when it is OSF (ie. ignoring USPTO findings)



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# PPH pilot scheme now introduced between US and Europe

- Bridges exist between:
  - USPTO and JPO
  - UK and JPO (launched 2<sup>nd</sup> July 2007)
  - UK and USPTO (launched 4<sup>th</sup> Sept 2007)
  - EPO and USPTO (launched 29<sup>th</sup> Sept 2008 for 1 year trial)



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# Requirements of EPO-USPTO PPH

Only applies to a European application claiming priority from a US application, therefore of very limited use

- Not PCT applications
- Not Continuation applications



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# Onerous process of EPO-USPTO PPH

- US case must have **1** allowable claim according to USPTO
- EP claims must have correspond to US claims  
ie. be of 'same or similar scope'
- Must submit
  - A claim correspondence table
  - File request form
  - Provide copies of Search Report and all Official Actions which are relevant to patentability and translations of all documents cited by USPTO
- EP examination must not have begun
- Once participation in PPH pilot program allowed EP application processed under PACE



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# EPO-USPTO PPH Progress Report

- 5 applications under PPH received by EPO so far
  - All refused
  - 3 because related to PCT applications
  - 2 because related to divisional applications

Clear lack of understanding of PPH amongst  
European practitioners



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# Benefits of PPH

USPTO-JPO	USPTO-EPO
<p>Has real benefits for applicant</p> <ul style="list-style-type: none"><li>• Can bypass petition to make special in USA</li><li>• JP accelerated examination requirements quite high</li></ul>	<p>Has no real benefits for applicant</p> <ul style="list-style-type: none"><li>• Can go straight into PACE without meeting strict PPH requirements</li></ul>



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# Accelerated Prosecution of European Patent Applications (PACE)



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## How PACE works - Search

- If there is no priority claim, search will be accelerated automatically
- If there is a priority claim, accelerated search can be requested on filing



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## How PACE works - Examination

- Accelerated examination of a European Application can be requested on filing (*if* examination requested bindingly and fee paid)
- Accelerated examination of a Euro(PCT) can be requested on entry or after
- EPO *aims* to issue 1<sup>st</sup> Official Action within 3 months of receipt of application by Examiner (subsequent Official Actions also issue within 3 months)
- Applicant must not extend



# Limitations of PACE

- PACE not possible if
  - Parts of application missing or outstanding
  - Application refers to an earlier application



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# Uptake of PACE provisions tiny

- Search 4%
- Examination 6%



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# PACE a missed opportunity

- PACE speeds search and examination
- PACE is free
- PACE is confidential
- PACE is available on request
- PACE can be accessed independently of PPH
- Unlike using PPH, there is no work product sharing between Patent Offices



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# Other ways to speed grant of EP Applications

- Early entry into EP regional phase *Art 23(2) or 40(2) PCT*
- Before Search Report issues waive invitation under *R70(2) EPC* and request examination unconditionally
- After Search Report issues file a substantive response without waiting for first Office Action



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# Conclusions



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# **Saving money and maximising your rights**

**By being more proactive throughout we can**

- Speed pendency**
- Reduce number of Official Actions**
- Avoid Oral Proceedings**
- Save money**

**Without sacrificing scope of protection**



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**Thank you for your attention**

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