

# Speeding up Grant before the EPO & GPTO

*TBK*

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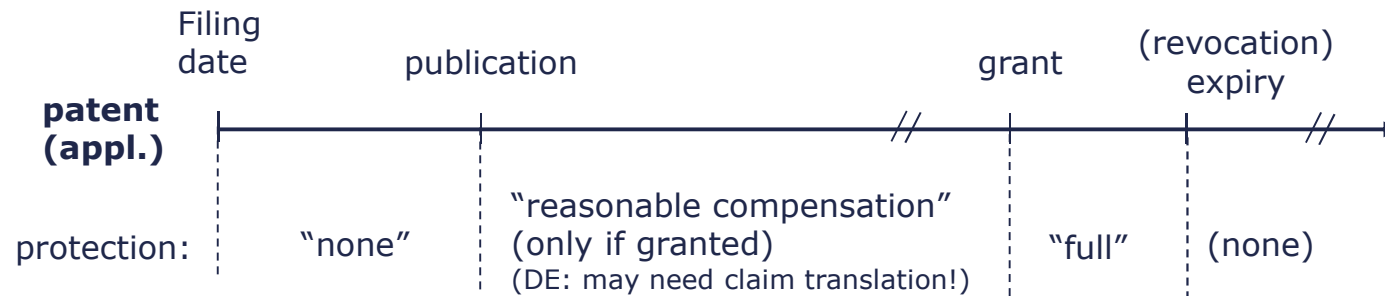
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## 1. Introduction

### Protection conferred over lifetime of application



⇒ **Full protection desired**

⇒ **As early as possible**

## 1. Introduction (II)

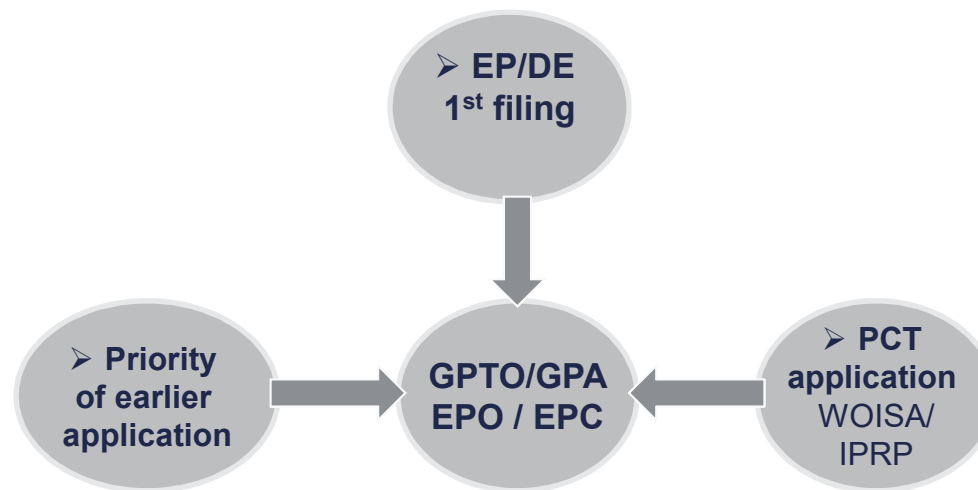
### Status quo (2018):

Average examination duration of patent applications in different jurisdictions:

<i>Pendency in Months</i>	<b>First Action</b>	<b>Final Action</b>	
<b>JPO</b>	<b>9.3</b>	<b>14.1</b>	(ex. request → grant)
<b>USPTO</b>	<b>15.6</b>	<b>23.8</b>	(filing date → grant)
<b>EPO</b>	<b>4.4</b>	<b>25.1</b>	(6M after EESR → grant)

➤ Strong desire to speed up examination also in EP

## 2. Entering the EP / DE procedure



### 3. Procedural aspects

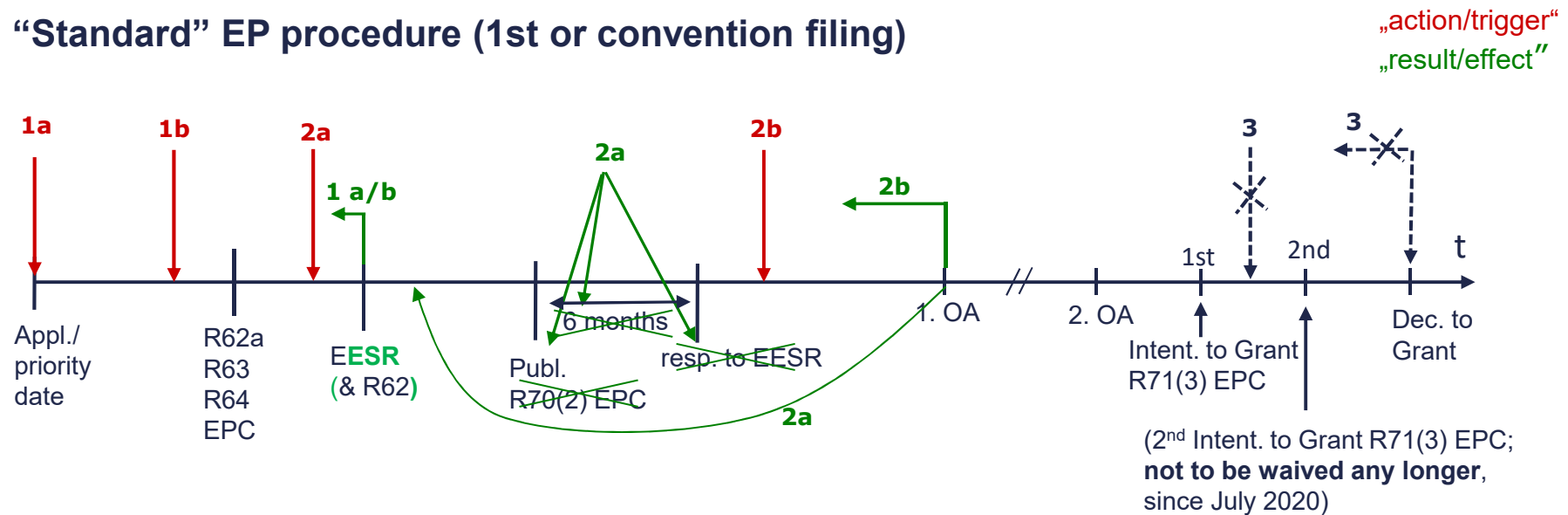
#### 3.1. PACE in general

- Acceleration under PACE upon request
- No official fee due for PACE
- Available for search, examination, or both (requests to be filed separately)
- PACE request can be filed only once per phase (search, examination)
- Not possible to restore application to PACE program once removed
  - If PACE request withdrawn
  - If extension of time limit requested
  - If application refused / withdrawn / deemed to be withdrawn (regardless of legal remedies)
- No publication of PACE requests by EPO (if filed separately)
- Using special EPO Form (EPO Form 1005) mandatory for PACE requests
- Acceleration only where practically feasible and subject to workload of Search/Exam. Div. (no legal claim to acceleration)
- Not possible to apply PACE to “*all*” of applicant’s applications, selection required

### 3. Procedural aspects

#### 3.2. Trigger points in EP procedure

##### “Standard” EP procedure (1st or convention filing)



1a: Accelerated search for EP 1st filings, no request

1b: Accelerated search, PACE request

2a: Accelerated examination, PACE request & waiving communication under R70(2) EPC

2b: Accelerated examination, PACE request

3: Decision to Grant (not to be advanced any more)

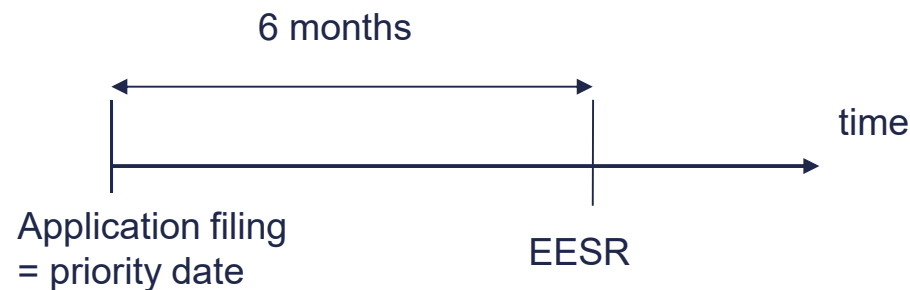


### 3. Procedural aspects

#### 3.3. Specials in accelerated search (I):

##### a) EP 1st filings

- Accelerated search on EPO's initiative
- No PACE request necessary
- Precondition:
  - ✓ Application documents are complete enough for a search to be carried out
- Result: EESR set up (in general) within 6 months from filing/priority date

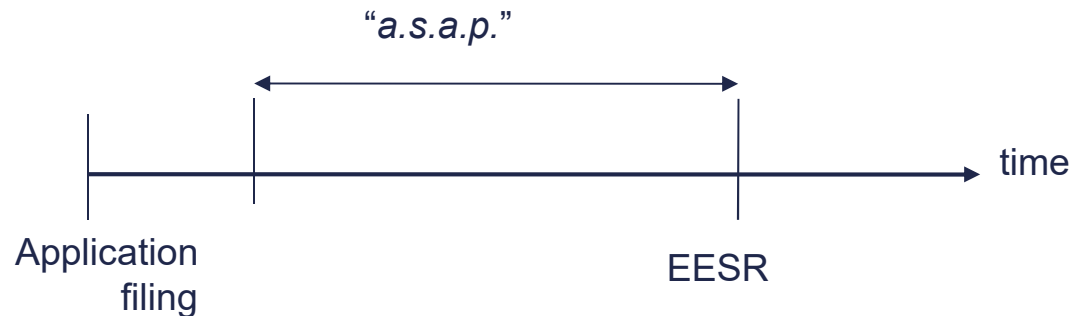


### 3. Procedural aspects

#### 3.3. Specials in accelerated search (II):

##### b) EP convention filings claiming priority

- Accelerated search only upon PACE request
- Request may be filed “anytime”, preferably already upon filing
- Precondition:
  - ✓ Application documents are complete enough for a search to be carried out
- Result: EESR set up (in general) “*as soon as possible*” after PACE request



### 3. Procedural aspects

#### 3.3. Specials in accelerated search (III):

##### c) Interaction with EPO during search

###### i) Accelerated search under PACE *not feasible* in case of

- application is filed by reference to an earlier application,
- a subsequent filing of parts of description / drawings
- a subsequent filing of claims

###### ii) Accelerated search under PACE *delayed* in case of

- a necessity to issue a communication under
  - R62a (“*limit a plurality of independent claims*”)
  - R63 (“*no meaningful search possible*”)
  - R64 (“lack of unity/invitation to pay additional search fee(s)”)

until response of applicant received, or

until set time limit (generally 2 months) expired

### 3. Procedural aspects

#### 3.4. Specials in accelerated examination (I):

- Only upon PACE request (EPO Form 1005 mandatory)
- PACE request for accelerated examination may be filed
  - “anytime once the examining division becomes responsible for examining the European patent application (R 10 EPC)”

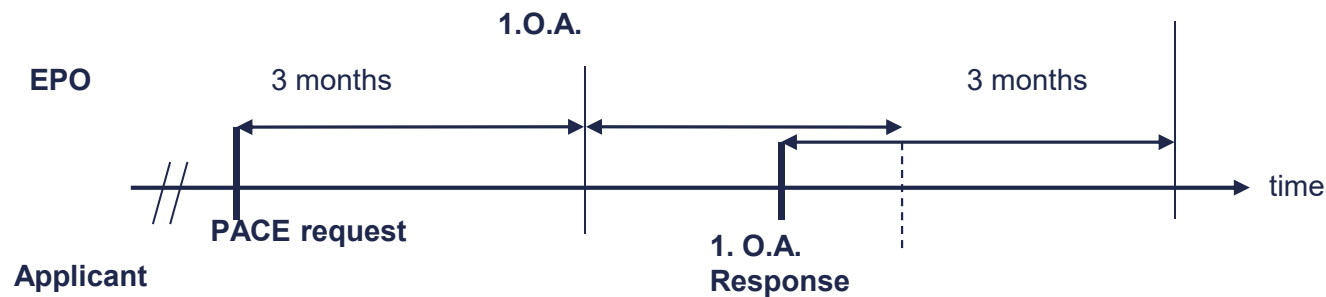
***but preferably***

- upon filing response to EESR

### 3. Procedural aspects

#### 3.4. Specials in accelerated examination (II):

##### EP examination procedure under PACE

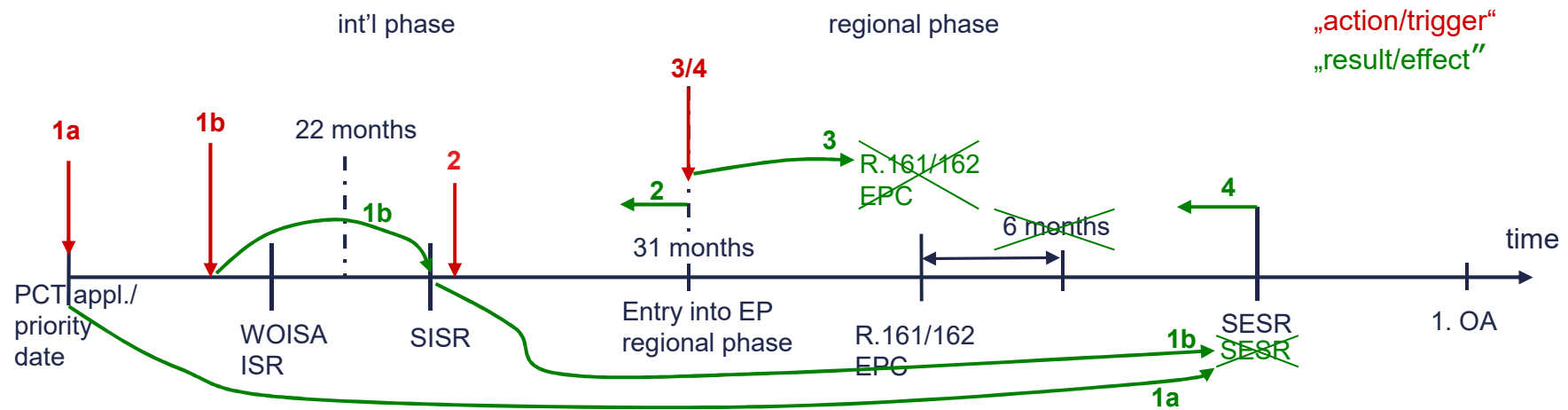


- 1st O.A. issued in general within 3 months of receipt by the Ex. Div. of the PACE req. filed as such, or with application, or with response to EESR
- 1st O.A. Response required within time limit set
- No extension permitted, else PACE treatment lost (not restorable)
- O.A. response needs to deal with all points raised
- Subsequent O.A. generally issued within 3 months from receipt of O.A. response

### 3. Procedural aspects

#### 3.5. Trigger points in EP-PCT procedure

##### “Standard” EP-PCT procedure



- (1) Avoid Supplementary European Search Report (SESR) to be drawn up
- (2) Advance EP regional phase entry
- (3) Waive R.161/162 EPC communications upon regional phase entry
- (4) PACE request upon EP regional phase entry

### 3. Procedural aspects

#### 3.6. Specials in EP-PCT procedure (I):

##### (1) Avoid SESR to be drawn up

###### a) upon filing

- file with RO = EPO => EPO = ISA

or

- file with RO for which EPO is a competent ISA
- JPO as RO admits EPO as ISA if filed in English

###### b) after filing:

request with the International Bureau (IB), prior to 22 months after priority, that the EPO draws up a SISR (scope of SIS is same as int'l search by EPO)

- ✓ pay fee for int'l search & SIS handling fee to IB
- ✓ int'l appl. needs to be (translated) in(to) English, French or German & SISR will be in that language
- ✓ EPO accepts only limited No. of SIS requests/year!
- ✓ no fee for SESR due upon EP regional phase entry

### 3. Procedural aspects

#### 3.6. Specials in EP-PCT procedure (II):

##### **(2) Advance EP regional phase entry**

- By clearly requesting early processing (preferably referring to Art. 23(2)/40(2) PCT)
- Request to be made with the EPO
- At any time before the expiry of 31 months deadline from the priority
- And by fulfilling the requirements for EP reg. phase entry (Rule 159(1)EPC)



### 3. Procedural aspects

#### 3.6. Specials in EP-PCT procedure (III):

#### Requirements for EP reg. phase entry under Rule 159(1)EPC

➤ **MUST DO's:**

- ✓ Pay filing fee + additional fee(s) (if > 35 pages)
- ✓ file translation in an official language of EPO
- ✓ pay search fee for SESR, if to be drawn up

➤ **SHOULD DO's / PREPARE TO**

(dependent on date of request for early proc.)

- |                       |   |                                  |
|-----------------------|---|----------------------------------|
| ✓ pay designation fee | } | within 6 months from ISR public. |
| ✓ pay examination fee |   |                                  |
| ✓ pay renewal fee     | } | within 2 years from PCT filing   |
| ✓ claims fees         |   |                                  |

➤ **“NO-GO”:**

- ✓ do NOT pay via automatic debit order! (payment only effective upon 31 month deadline)

### 3. Procedural aspects

#### 3.6. Specials in EP-PCT procedure (IV):

##### **(3) Waive R161/162 communications**

- Declare waiver expressly
  - ✓ in a separate single and signed statement, or
  - ✓ in the EPO Form 1200 (Box 6.4) for reg. phase entry
- Fulfill requirements of R161/162
  - ✓ pay claims fees (for claims in excess of 15)
  - ✓ submit response to WOISA, IPER, SISR
- Do NOT pay via automatic debit order

##### **(4) PACE request**

- Upon regional phase entry, or
- Together with response to WOISA, IPER, SISR, under R161 (if not waived)

### 3. Procedural aspects

#### 3.7. Patent Prosecution Highway (PPH) (I)

##### PPH between EPO and JPO for EP procedure

- Exploit *national* work products for acceleration  
(exploiting int'l work products => *PCT-PPH*)

##### Preconditions:

- ✓ EP and JP application must have the same priority/filing date
- ✓ At least one claim in JP application is found patentable/allowable
- ✓ EP claims sufficiently correspond to or be amended to sufficiently correspond to JP claims
- ✓ Examination of the EP application for which PPH is requested has **not** begun

### 3. Procedural aspects

#### 3.7. Patent Prosecution Highway (PPH) (II)

***“Same priority/filing date of EP & JP application”***

- ✓ EP application claims priority of JP application
- ✓ EP application is basis for priority claimed in JP
- ✓ EP & JP application share a common priority
- ✓ EP & JP applications derived from PCT application without a priority claim

### 3. Procedural aspects

#### 3.7. Patent Prosecution Highway (PPH) (III)

***“EP/JP claims sufficiently correspond”,  
if***

- *EP claims are of same/similar scope*
- *EP claims are narrower in scope,  
e.g. limited by a feature supported in  
specification and/or claims*
- *Different claim format requirements do not harm*

***BUT: correspondence denied, if***

- *EP claims introduce new / different category*
  - *e.g. product claims for product (in EP)  
produced by a manufacturing process (claimed & allowable in JP)*

### 3. Procedural aspects

#### 3.7. Patent Prosecution Highway (PPH) (IV)

##### **Actions to be taken:**

- ✓ File request for participation, no official fee due
- ✓ File a declaration of claims correspondence
- ✓ Submit copies of all (prior art) documents other than patent documents cited in the JPO O.A.s
- ✓ Submit a copy of all JPO O.A.s of the corresponding JP application specifying allowable claims with translation thereof into official EPO language, and
- ✓ Submit a copy of the claims deemed patentable / allowable from JP application with translation thereof,

OR

- ✓ Refer to previously submitted documents, or provide list of documents retrievable via AIPN (the JPO's electronic Dossier Access System)

### 3. Procedural aspects

#### 3.7. Patent Prosecution Highway (PPH) (V)

##### **Upon PPH request defective:**

- Applicant be given opportunity to correct (once)

##### **Upon PPH request granted:**

- Applicant will be notified
- Application is treated under PACE

## 4. Options to PACE/PPH in Germany (I)

### Limitations in speeding up grant procedure

- Advancing certain events limited
- Even under PACE, e.g. due to EPO workload
- Even if 1<sup>st</sup> O.A. = R 71(3) EPC grant delayed by some months due to EPO's internal processing until publication of Decision to grant



#### 4. Options to PACE/PPH in Germany (II)

##### **Solution:**

- Parallel protection by German utility model
- Possible by „*splitting off*“ of utility model based on a patent application with effect for Germany

## 4. Options to PACE/PPH in Germany (III)

### Split off

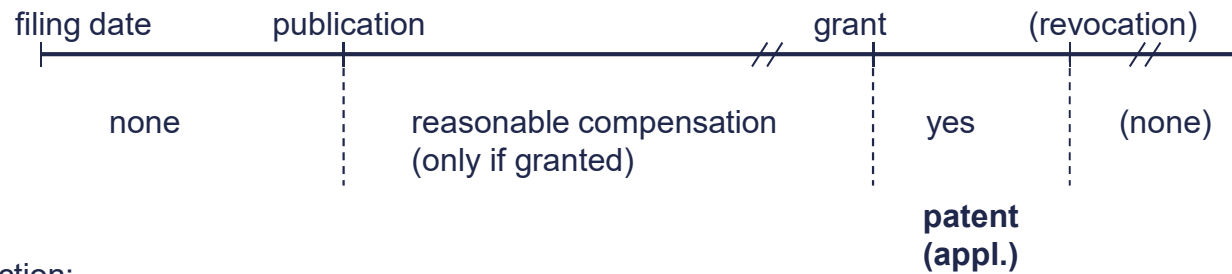
- In principle: file a utility model application based on pending patent (application), even after expiry of priority year, similar to a divisional application
- Split off benefits from filing and priority date of a patent application with effect in Germany (DE, EP, PCT) for the same invention (Note: only apparatus claims, no method claims)
- Up to expiration of two months from the end of the month in which processing of the patent application or any opposition procedure is terminated
- Up to ten years from filing date of the patent application
- Declaration of claiming the filing date from the patent application filed together with the split off of the utility model application
- Specifying the application number and filing a copy of the patent application necessary

## 4. Options to PACE/PPH in Germany (IV)

### Utility model as a supplement

#### (I) Advancing protection by parallel utility model application

protection:



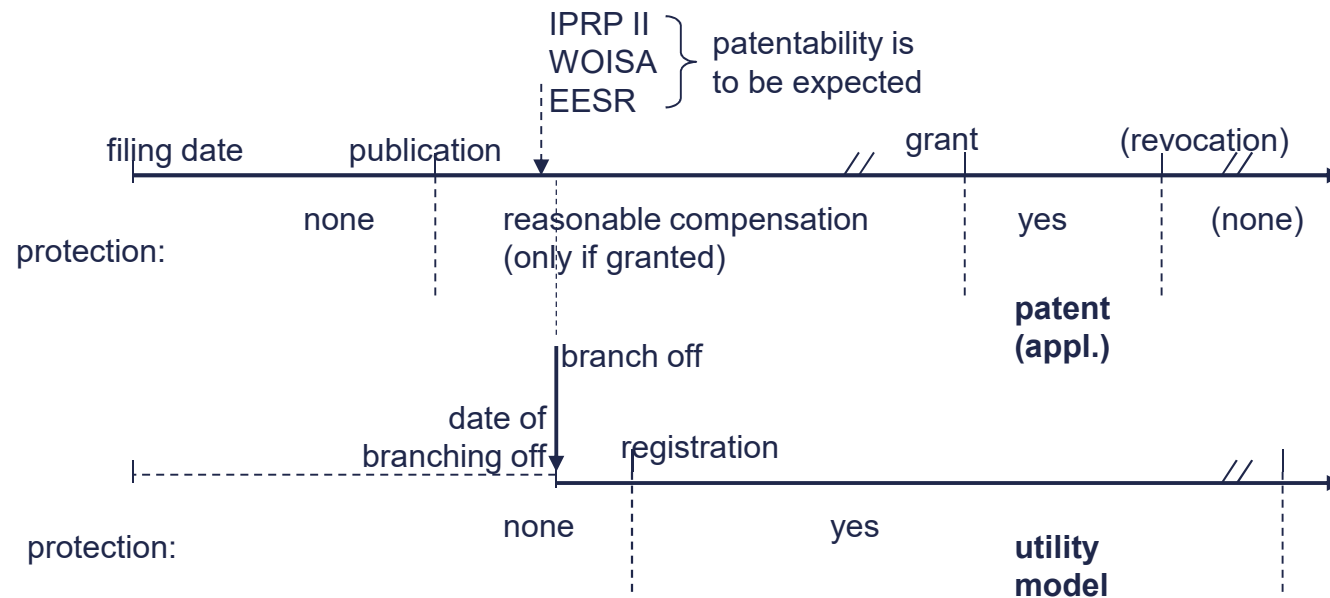
protection:



## 4. Options to PACE/PPH in Germany (V)

### Utility model as a supplement

(II) Advancing protection by splitting off utility model application



## 4. Options to PACE/PPH in Germany (VI)

### Utility model as a supplement

Tactical usage of utility model (application)

- As a substitute for patent application (cheaper, different prior art definitions apply)
- Advancing protection by split off
- Tailoring scope of claims/protection to competitor's products (literal "*infringement*" more likely to be confirmed) & split off
- Saving protection costs (utility model instead of divisional application) in case of a lack of unity
- "Rescuing" inventive aspects (in EP appl.), if no divisional application is possible anymore

## 5. Procedural aspects in DE

### 5.1. Procedure for accelerated examination - GPPH

#### File a Request to the GPTO for Participation in the GPPH

How to ...

- Filing a request form for accelerated examination under GPPH pilot program to the GPTO (including relevant supporting documents)
- If requirements are met, the GPTO will conduct an accelerated examination
- If GPPH pilot program participation is **not** qualified ...
  - Applicant will be informed accordingly
  - Application will be further processed under the standard GPTO examination procedure, without acceleration

## 5. Procedural aspects in DE

### 5.2. Required documents - GPPH

#### **Procedures to File a Request to the GPTO for Participation in the GPPH**

You will need ...

- A copy of all office actions on the corresponding OEE application(s)
- A copy of the claims found to be patentable by the OEE where appropriate
- A completed claim correspondence table showing the relationship between the claims of the GPTO application for accelerated examination under the GPPH and the claims of the corresponding OEE application considered patentable by the OEE
- A copy of the document(s) cited by the OEE examiner

## 5. Procedural aspects in DE

### 5.3. Requirements - GPPH

Do not forget to think about ...

➤ Both ...

- ... the GPTO application on which PPH is requested and ...
- ... the Office of Earlier Examination (OEE) application(s) forming the basis of the PPH request ...

... shall have the same earliest date

- At least one corresponding OEE application has one or more claims determined to be patentable by the OEE
- All claims in the GPTO application for examination under the GPPH must sufficiently correspond to one or more of those claims indicated as allowable (patentable) by the OEE
- The GPTO **has not begun** substantive examination of the application yet



## 5. Procedural aspects in DE

### 5.4. Procedure for accelerated examination at the GPTO other than GPPH

## GPTO – Guidelines for the Examination Procedure

### 3.3.2. Requests for accelerated processing

- **Substantiated** request, if ...
- ... expected duration of procedure might lead to **considerable disadvantages** for the requester
- Typical reasons:
  - potential infringement discovered
  - ongoing license negotiations
- Applicable to the next procedural step only (next Office Action)
- Further procedure is speeded up if a corresponding interest is derivable from the request

## 6. Conclusion

### **Speeding up grant / protection:**

- Variety of options
- Flexible combinations possible
- Sometimes “tricky”
- Best benefit for acceleration, if acceleration strategy is planned well in advance, e.g. already before filing

Please feel free to ask questions!

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## 7. Annex

[http://www.epo.org/applying/european/Guide-for-applicants/html/e/ga\\_aii.html](http://www.epo.org/applying/european/Guide-for-applicants/html/e/ga_aii.html)

<https://www.epo.org/law-practice/legal-texts/official-journal/2020/06/a73.html>

[https://www.dpma.de/docs/english/formulare/patent\\_eng/pph1029\\_1.pdf](https://www.dpma.de/docs/english/formulare/patent_eng/pph1029_1.pdf)

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