



Accelerated prosecution at the EPO – PPH v PACE

The EPO offers two distinct schemes for speeding up patent prosecution - PPH and PACE. If you want a patent granted quickly it can be difficult to know which to choose. Unfortunately, this is a question with no short answer. Both schemes have their merits, and the best scheme for you might be PPH, PACE, or both.

What is PPH?

The “Patent Prosecution Highway” is operated by a group of Patent Offices around the world, and allows one Patent Office in the group to take advantage of work that has already been done by another. That is, if you have a patent that has been granted or allowed by one Patent Office that subscribes to the scheme, you can request accelerated examination of a corresponding patent application at another Patent Office also in the scheme. The idea is that the second Patent Office can complete its examination more quickly, because the first Patent Office has already done much of the work. Lots of countries take part in the PPH scheme, so check with us for a full list, but notable subscribers include UK, USA, Europe, Japan, Korea, Canada and Australia.

The main downside of PPH is that you must already have a granted or allowed patent - the scheme is not open to applicants who don't. PPH can only be requested before examination of the later application has begun, and for the application to be accelerated it is necessary for its claims to be the same as, or narrower than, the claims of the corresponding granted patent. This means that typically an amendment needs to be filed together with a PPH request. Other supporting documentation is needed too - a table showing the relationship between the two sets of claims, any non-patent literature cited during the prosecution of the granted case, and (possibly) translations of any required prosecution history documents that are not in English, German or French. A PPH request can thus sometimes (although not always) require quite a few hours work.

What is PACE?

The “programme for accelerated prosecution of European patent applications” is a scheme run solely by the EPO that allows an applicant to accelerate his or her patent application on request. A simple form is all that is needed – there is no requirement to amend the claims or file additional paperwork.

PACE has its own drawbacks however - it can only be requested once prior to the search report being issued, and once afterwards (i.e. during examination). It also requires diligence on the part of the applicant - failure to respond to official actions in a timely manner (for instance, by requesting an extension of time) will result in the application being ejected from the PACE scheme, with no possibility of requesting acceleration again.

Which is better - PACE or PPH?

As hinted above - it depends. If you have a granted patent already, then PPH is the obvious choice. In 2012, European patent applications filed via the PCT using the PPH route had a shorter time to first action than normal European (PCT) applications, even those with accelerated search completed under the PACE scheme. The EPO was also less likely to find additional 'X' documents (i.e. relevant new prior art) for PCT-PPH applications than for other applications.

Of course these apparent advantages could be linked to the fact that PPH applications typically have narrower claims and/or less complicated issues than non-PPH applications. After all, PPH applications necessarily have a granted counterpart somewhere.

Even so, anecdotal evidence suggests that time to issuance of a first official action is (marginally) faster for PPH applications than PACE, and that PPH prosecution can be more straightforward overall.

However, both schemes work - there is no doubt about that. The EPO will typically issue a search report or first official action much more quickly under either scheme than it would if left to its own devices. Average patent application pendency at the EPO is 5 years, with pendencies of 10+ years not being unknown. Both schemes can cut this down dramatically.

PACE can be requested in situations where PPH can't - if you don't have a granted patent, or if examination has already begun, then PACE is a good alternative option.

Furthermore, there are a couple of situations where PPH might not be appropriate even if it is available. For instance, if your granted patent claims include a lot of amendments that might result in added matter problems, or if the granted patent encountered prior art that wouldn't be citable in Europe. In such cases, PACE might be the best choice, as it allows more freedom to amend the claims.