

Accelerated prosecution at the EPO: PPH v PACE

The European Patent Office (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 another has already done. That is, if you have a patent granted or allowed by one Patent Office subscribing 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. Many countries participate in the PPH scheme, so check with us for a complete list, but notable subscribers include the 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 do not. PPH can only be requested before examination of the later application has begun, and for the application to be accelerated, its claims must 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 required, 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 of work.

What is PACE?

The 'programme for accelerated prosecution of European patent applications' is a scheme run solely by the EPO, allowing applicants to accelerate their patent application on request. A

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simple form is all that is needed – there is no requirement to amend the claims or file additional paperwork. PACE has its drawbacks, however - it can only be requested once before the search report is issued and once afterwards (I.e., during examination). It also requires diligence on the applicant's part - failure to respond to official actions on time (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. PPH is the obvious choice if you have a granted patent already. In 2012, European patent applications filed via the PCT using the PPH route had a shorter time to first action than regular 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 other applications.

Of course, these apparent advantages could be linked to PPH applications typically having narrower claims and/or less complicated issues than non-PPH applications. After all, PPH applications do not necessarily have a granted counterpart somewhere.

Even so, anecdotal evidence suggests that the 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 if left to its own devices. The average patent application pendency at the EPO is five years, with pendencies of 10+ years not being unknown. Both schemes can cut this down dramatically.

PACE can be requested in situations where PPH cannot - if you do not have a granted patent or the examination has already begun, PACE is a suitable alternative option.

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

What next?

If you would like more information, then please get in touch. You can email us info@barkerbrettell.co.uk or call us on **+44 (0)121 456 0000**.

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