

### 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 a UK and a European patent respectively, 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

However, in certain circumstances it is possible to accelerate various stages in the prosecution of both UK and European patent applications. The proceedings may be considerably shortened in comparison with the average processing time.

#### 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 and 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 potential protection from infringers until the application is published, from which time you will have “provisional” protection which can be acted on only 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 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 two 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 file a request for a **combined search and examination**. 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.

### • 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 well be a good idea to request early publication as well.

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

### • SEARCH

Usually, your European application will have been filed 12 months after your national priority application and in this case the European Patent Office (EPO) will search your application as soon as possible if, on filing, a request is made for an early search.

In the unusual circumstance that your European application is your first filing then, automatically, the EPO will 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, typically, 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. 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, then, to maintain a speedy examination process, it is necessary to file any responses to the examination reports without requesting extensions of time.

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.

### • GRANT

If the application is in order for grant and the text is approved without delay, it is possible to request immediate grant provided that you have already met certain formality requirements such as providing a translation of the claims and paying the fees.

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