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Can you keep up with the PACE?

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On 1 January 2016, a revised programme for accelerated prosecution of European patent applications (PACE) at the European Patent Office (EPO) entered into force. Its conditions will apply to PACE requests filed on or after this date and to applications already under PACE.

PACE has been available at the EPO for a number of years to provide accelerated prosecution of patent applications. A patent application for which participation on PACE has been requested will be processed more quickly by the EPO through search and examination, but the applicant must also complete required acts in a timely fashion without requesting extensions to avoid the application being removed from the accelerated programme.

The EPO has now introduced an updated PACE programme in an apparent attempt to reduce frivolous PACE requests and encourage applicants to request PACE only for cases where accelerated prosecution is a necessity.

The major changes to PACE:

- A request for PACE may now only be filed **ONCE** for Search and **ONCE** for Examination.

If an application is removed from PACE due to a late response to a communication or fee payment, then accelerated procedure is lost in that prosecution stage permanently. This applies to ALL applications whether PACE was requested before or after 01/01/16.

- An application will now also be removed from PACE if a renewal fee is not paid in time.

Therefore, an application will be removed from PACE if the 6 month grace period for late renewal payment is utilised.

- PACE must now be requested on a specific EPO Form 1005.

PACE requests filed in the body of letters or otherwise will not be processed. It is our understanding that the Form 1005 will not appear on the EPO register in order to maintain the confidentiality of PACE requests, but incorrect requests in letters will be part of the EPO's public file.

- PACE must now be specifically requested during **both** Search and Examination at the EPO.

A PACE request during Search must be followed up with a request during Examination if you wish to use PACE through the entire prosecution of your application.

- Applicants will not be entitled to request PACE for all of their pending European patent applications.

The EPO notice indicates that “applicants requesting accelerated prosecution for all or most of their applications will, as a rule, be required by the Office to limit the number of their PACE requests by making a selection”.

The changes to PACE appear to be an attempt by the EPO to streamline the programme and putting more onus on the applicant to ensure that actions are taken in a timely manner.

The new rules should serve to reduce the number of applications for which PACE is requested simply because of delays at the EPO, rather than because the applicant actually requires accelerated prosecution. It is hoped that the tougher PACE rules will reduce the overall number of applications under PACE and that this will, in turn, improve the level of acceleration that can be achieved via PACE, which is often unremarkable at present.

There is currently no indication as to whether the revisions will affect the various Patent Prosecution Highway (PPH) programmes with foreign patent offices. However, the more stringent rules for PACE may make the PPH a more attractive option where an applicant requires expedited processing of their European patent application without the increased pressure to ensure all acts are completed on time before the EPO.

What does this mean for applicants?

Applicants should be mindful of the increased importance of filing timely responses and paying renewal fees on time when their European patent application is being accelerated under PACE. AAT would advise that applicants put robust systems in place to ensure that their applications under PACE are not removed inadvertently due to a deadline extension or renewal grace period being

utilised, as it is no longer possible to request PACE in the same prosecution stage if it is lost.

How can A.A. Thornton & Co. help?

If you would like to know more about accelerating the prosecution of your patent applications at the EPO either under PACE or the PPH, then please contact your usual A.A. Thornton & Co. advisor or one of our patent attorneys via our website at www.aathornton.com.

Our UK, European and German patent attorneys are qualified to advise on all aspects of UK, European and German patent law, and provide the following services (click on the links for more information):

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- [Patent litigation support](#)

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