

Obtaining a Granted Euro-PCT Patent Before PCT National Phasing Deadline

In 2014, the EPO launched the Early Certainty initiative to speed up the patent granting process. This initiative has resulted in speedier establishment of search reports and a shorter examination procedure.



Source: Quality Report 2019, EPO

The chart above shows the median, mean and 95-percentile time (in months) it took the EPO to establish the search report from the time of filing. As shown, the mean time in 2019 was 5.5 months. According to the EPO’s Quality Reports of 2020 and 2021, this figure was further slashed to 4.5 and 4.8 months, respectively. This is confirmed by our experience, in which a consistently short turnaround time has been noticeable, with a sizable portion of applications proceeding to grant directly after a response to the search report is filed.

While options exist to slow down prosecution if desired, this increased prosecution speed opens up a new possibility for an international filing strategy. The strategy proposed below shows that a granted EP patent can be secured before the 30/31m deadline for further PCT national phasing, especially where a positive WO-ISA is issued by the EPO.

The granted EP patent may be used to streamline prosecution before other national patent offices of interest, especially if a national patent office is part of a Patent Prosecution Highway (PPH) agreement. For example, the IP5 PPH covers the five biggest patent offices, namely China, Japan, Korea, the United States and the EPO.

The following suggests a possible timeline of how this may be achieved, and the steps that need to be taken at each stage.



0m Filing date of the earliest priority application

12m File PCT application, designating the EPO as the International Search Authority.

17m International Search Report (ISR) issued with the Written Opinion (WO-ISA). Our own data within the past 5 years shows that the median time between filing a PCT application and receiving the ISR from the EPO is 13 weeks. We allow 5 months in this timeline.

19m Publication of the application

20m EP regional phase entry, allowing ourselves 3 months to review the ISR. The following acts are to be completed at this point:

1. Request early processing, paying official fees: the filing fee, examination fee, designation fee, excess claims fees (if more than 15 claims are to be retained), and page fees (if more than 35 pages). Pay any extension/validation fees if protection in any of BA, ME, MA, MD, TN and KH is desired.
2. File a complete response to any objections in the WO-ISA, including any necessary amendments. This response should address all the objections and all the formal requirements. The examiner that issued the ISR will be allocated the European regional phase, so it is unusual after a positive WO-ISA for unexpected new objections to be raised in the European regional phase.
3. Waive the requirement for a Rule 161/162 EPC communication.
4. File a PACE request for expedited examination. The examiner will then endeavour to issue the first official action within 3 months.

23m If all objections overcome, intention to grant under Rule 71(3) EPC issued as first official action. We allow 1 month in which to respond, approving the text for grant, filing French and German claims translations, and paying the official fees.

26m European patent granted. Our experience shows that the time between responding to the Rule 71(3) EPC communication and the actual date of grant is around 6 weeks. We allow 2 months in this timeline.

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30/31m Entry into the PCT national phase in other countries, as required.

As shown above, it is possible to obtain a granted European patent with up to 4 months to spare before the national phasing deadline. If, at 23 months, an examination report is issued instead of an intention to grant, then there will often still be enough time to go through one round of examination.

If you are interested in this strategy, please contact your usual J A Kemp attorney.

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