



Joseph Sofer jsofer@ipsilon-ip.com ; 110 West 40th Street, Suite 2001, New York, NY 10018 (212)697-2800

Expediting Patent Registration in Europe: A Comprehensive Guide for In-House Counsel

Dated: January 2026

The European patent registration process traditionally takes 4-6 years, creating significant challenges for companies with products that have short commercial life cycles. Many U.S. in-house counsel have expressed concerns about this timeline when considering European patent protection. However, the European Patent Office (EPO) offers several robust mechanisms to substantially expedite the prosecution process. By strategically employing these tools, applicants can realistically achieve patent grant in approximately three years.

This memorandum provides detailed explanations of each acceleration option to help in-house counsel make informed decisions about European patent strategy.

1. PATENT PROSECUTION HIGHWAY (PPH)

PPH is a collaborative framework between participating patent offices worldwide that enables applicants to request fast-track examination in one office based on favorable examination results obtained in another participating office. The EPO participates in PPH agreements with numerous patent offices, including the USPTO, JPO (Japan), KIPO (Korea), SIPO (China), and many others.

How Does PPH Work?

When you file corresponding patent applications in multiple jurisdictions, the examination proceeds independently in each office. If one office (the "Office of Earlier Examination" or OEE) determines that at least one claim is allowable or patentable, you can use that positive result to request accelerated examination at the EPO.

The process involves:

1. Obtaining allowable claims or a notice of allowance from a participating office
2. Filing a PPH request with the EPO
3. Submitting the claims that correspond to the allowable claims from the OEE
4. Providing necessary documentation (office actions, claims, etc.)

Key Benefits:

- Dramatic time reduction: PPH applications are typically processed significantly faster than standard applications
- Higher grant rates: Because the EPO examiner can review and rely on the work already completed by the first office, there is often less back-and-forth

- Cost efficiency: Fewer office actions typically mean lower attorney fees and translation costs
- Strategic flexibility: You can choose which favorable result to leverage if you have multiple applications

Practical Considerations:

- Claim correspondence: The claims submitted under PPH must sufficiently correspond to the allowable claims from the OEE
- Timing: PPH requests should be filed before the EPO has issued a substantive examination report
- Documentation requirements: You must provide copies of relevant office actions, claims, and sometimes translations
- Strategic filing: Consider filing first in jurisdictions known for faster examination (e.g., USPTO) to create PPH opportunities

Example Scenario

A U.S. company files a patent application with the USPTO and simultaneously files a corresponding European application. The USPTO issues a Notice of Allowance after 18 months. The company then files a PPH request with the EPO, providing the allowed claims and USPTO examination history. The EPO prioritizes the examination and issues a communication within months rather than years.

2. PACE PROGRAM (PROGRAM FOR ACCELERATED PROSECUTION)

What is PACE?

PACE is the EPO's own acceleration program, available to all applicants without preconditions, special eligibility requirements, or additional fees. It represents the most accessible form of acceleration for European patent applications.

How Does PACE Work?

PACE allows applicants to request acceleration of different stages of the patent prosecution process:

Search Acceleration: The EPO will expedite the preparation and issuance of the European Search Report, typically issuing it within months of the request rather than the standard 6-12 month timeline.

Examination Acceleration: The EPO will prioritize substantive examination, aiming to issue office actions and examination communications on an expedited basis.

Combined Acceleration: Applicants can request PACE for both search and examination phases.

The request is simple and can be made online through the EPO's filing systems or by letter. Once granted, the application is placed in a priority queue.

Key Benefits

- No prerequisites: Unlike PPH, PACE requires no prior favorable examination results
- No fees: The service is provided at no additional cost
- Flexibility: Can be requested at any stage before completion of the relevant phase
- Simple process: Online request takes minutes to complete
- Broad applicability: Available for all types of inventions and applicants
- Combinable: Can be used alongside other acceleration methods like PPH

Practical Considerations

- Timing of request: PACE is most effective when requested early in the process
- Applicant responsiveness: To maintain accelerated status, applicants must respond promptly to EPO communications (typically within shorter deadlines)
- Withdrawal: PACE status can be withdrawn if needed, though this is rarely advantageous
- Strategic use: Particularly valuable when PPH is not available or when immediate acceleration is needed

Example Scenario

A biotech company has a patent application for a diagnostic method with a projected 5-year market window. They file a European application and immediately request PACE for both search and examination. The EPO issues the search report within 4 months instead of the typical 9-12 months, and examination communications follow on an accelerated schedule, resulting in grant within 2.5 years.

3. WAIVING RULE 161 EPC COMMUNICATION

What is Rule 161 EPC?

Rule 161 of the European Patent Convention (EPC) is a procedural requirement that applies when entering the European regional phase from a PCT (Patent Cooperation Treaty) international application. Under this rule, the EPO must invite the applicant to confirm which claims they wish to pursue and whether they want to make any amendments.

How Does Waiving Work?

Instead of waiting to receive the Rule 161 communication and then responding to it (which adds several months to the timeline), applicants can proactively file the required information at the

time of entering the European phase. By doing so, they effectively waive their right to receive the formal communication, eliminating this procedural step entirely.

This is accomplished by:

1. Filing the required information (indication of claims to be examined, any desired amendments, payment of claims fees) when entering the European phase
2. Explicitly stating that the Rule 161 communication is waived
3. Ensuring all necessary documentation is complete to avoid further communications

Key Benefits

- Time savings: Eliminates 2-4 months from the prosecution timeline
- No substantive impact: This is purely procedural and does not affect the substantive examination of the application
- No additional cost: No fees are associated with this approach
- Simple implementation: Can be standard practice for all PCT applications entering Europe
- Certainty: Removes one variable from the timeline

Practical Considerations

- Applies only to PCT applications: This mechanism is specific to applications entering the European regional phase from PCT
- Requires proactive planning: European patent counsel must be instructed in advance to file the necessary information
- Completeness is critical: If the filed information is incomplete, the EPO may still issue communications, negating the time savings
- Coordination with counsel: U.S. in-house counsel should establish this as standard practice with their European patent attorneys

Example Scenario:

A technology company files a PCT application covering a new software algorithm. At the 30-month deadline, they enter the European phase. Their European patent attorney files the European phase entry documents along with the Rule 161 response information, explicitly waiving the communication. The EPO proceeds directly to search without issuing the Rule 161 invitation, saving 3 months in the process.

---COMBINING ACCELERATION METHODS

The most effective strategy often involves combining multiple acceleration methods:

Optimal Combination Example:

- Enter European phase from PCT while waiving Rule 161 communication (saves 2-4 months)
- Request PACE for both search and examination (accelerates both phases)
- If allowable claims are obtained from USPTO or another office, file PPH request (further accelerates examination)

This combined approach can reduce the timeline from 4-6 years to approximately 2.5-3 years.

EXPECTED TIMELINE

Standard European Patent Prosecution: 4-6 years

- PCT filing to European phase entry: 30-31 months
- Search report: 6-12 months after entry
- Examination: 1-3 years
- Grant and opposition period: 9-12 months

Accelerated European Patent Prosecution: 2.5-3 years

- PCT filing to European phase entry with Rule 161 waiver: 30-31 months
- PACE-accelerated search report: 2-4 months
- PPH/PACE-accelerated examination: 6-12 months
- Grant: 3-6 months

Note: Actual timelines depend on the complexity of the technology, number of office actions, and applicant responsiveness.

For questions or assistance in implementing these strategies, please contact your European patent counsel at the IPSI Group or Joe Sofer at our New York Office: jsofer@ipsilon-ip.com .