

FICPI - SWEDEN

EUROPEAN PATENT PRACTICE

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PROBLEM OF EPO WORKLOAD

	<u>Filed</u>	<u>Granted</u>
1987	46,000	20,000
1992	59,000	30,400
1997	73,000	39,600
2002	106,000	47,300
2006	135,000	62,780
2007	141,266	54,700
2010	150,961	58,108

Plus PCT searches and preliminary examinations,
which take priority

RESPONSE

“Mastering the Workload” (1)

Plan of 2002.

- Search Opinions with Search Reports
- BEST (Bringing Examination and Search Together)
- Shift Effort Towards the Start of the Process

By 2008

- All Searches had Opinion as well.
- Most Examiners could do BEST.

“Mastering the Workload” (2)

- EPO claim that searches and first examination reports are now much more timely. (Which may be true, but second examination reports can be badly delayed).
- There are still complaints and backlogs.
- Recently filed cases processed ahead of older ones.
- Recent fee changes.

CLAIMS FEES CHANGES 2008

Prior to April 2008:-

- EUR 45 fee on each claim beyond the tenth

After 1 April 2008:-

- EUR 200 on each claim beyond the fifteenth

So 25 claims went from EUR 675 to EUR 2000

CLAIMS FEES CHANGES 2009

Claims fees

- In addition to the EUR 200 for 16th claim onwards introduced April 2008, there was from 1 April 2009 a

- 500 EUR –
(now 525 EUR)

fee for each claim beyond 50.

CONSEQUENCES

- Pre-filing consideration and amendment is much more likely to be economic and is now normal.
- Sub-claims “compacted”, alternatives introduced.
- Some consequent examination difficulty, lack of clarity point may be raised – do not be too greedy.
- EPO claims fee income collapses – but they do less work?

AN EXAMPLE OF COMPACTION

1. A life-giving elixir solution containing soluble extracts of peanuts, lemons and fish-oil.

16 - wherein the solution has a pH of 7

17 - wherein the solution has a pH less than 7

18 - wherein the solution has a pH more than 7

becomes

16 - wherein the solution has a pH equal to, less than or more than 7.

Saving EUR 420 fees

OTHER 2009 FEE CHANGES

Designation Fees

Previous system:

- Designation fees of EUR 80 for each state to a maximum of seven: all states deemed designated when seven are paid

Current system, from 1 April 2009:

- A single fixed designation fee of EUR 500
- All states will be automatically designated
- Extension state system unchanged

UNITARY EFFECT PROPOSALS

According to the draft Regulations, upon a Patentee's request patents granted under EPC and covering the participating member states (all except IT, ES) with the same set of claims can become "European Patents with Unitary Effect"

RAISING THE BAR

A project responding to:

- the criticism of lack of “legal certainty” in granted and pending situations
- revocations by national courts
- criticism of trivial or badly examined patents
- complaints about “abusive” divisionals
- concerns about applicant behaviour

RAISING THE BAR

AIM - IMPROVE QUALITY AND EFFICIENCY

- Inventive step conformity efforts
- Stricter on business methods and software following Boards of Appeals decisions
- New requirements of applicants in four areas – procedural changes intended to assist and hasten examination

Will this help?

- or could they just do their job better?
- no need for new tools?
- costly for applicants?

APRIL 2010 CHANGES

1. Obigatory response to search opinion (New Rule 70a)

(i) On “straight” Es (no previous search made) response to SO due within 6 months of publication of SR, same as for requesting examination

(ii) On E/PCTs, having EPO as ISA and perhaps IPEA (thus, normally, having an EPO Search and SO before regional phase entry is due) response to SO due within ONE month of the Rule 161 communication (Letter 1226) which invites amendment following E phase entry

(iii) On E/PCTs not having EPO as ISA or IPEA (therefore having an international search which will be supplemented by EPO supplementary search and SO) response due when confirming examination request, i.e. 6 months after SSR and Opinion

E/PCT WITH EPO AS ISA

- ONE MONTH to respond! and you might not receive IPER until near the 30 month deadline.
- How could they?
- From 1 May 2011 changed to 6 months, like the other situations.
- All cases from PCTS and “straight” need to respond to the SR or Supplementary Search and Opinion on making examination request; bringing forward the consideration and costs.

EPO as ISA

- Search by EPO may arrive rather late. But on entry to EP phase 1226 letter received, which starts the opportunity to amend, if negative you must respond.
- If EPO not the ISA, no response required to 1226 letter, Supplementary Search and Opinion issued, reply when confirming/requesting examination.
- Case deemed withdrawn if not complied with.
- Further processing available.
- Selecting EPO for search has drawbacks, many US applicants now go to other offices (cheaper, quicker, possibly more liberal).

Obligatory Response - Consequences

- Is this your only chance to amend?
- Is it too soon to know what you want to claim?
- Is effort wasted?
- Has it actually affected average prosecution times?

APRIL 2010 CHANGES (2)

2. Amendments

Rule 137 amended.

- There is now ONE opportunity to amend description, claims, drawings of own volition, otherwise it can only be at examiner's discretion (Rule 137(2), (3)).

The reply to the search opinion discussed above might be that opportunity, where previously the reply to the first exam report was that opportunity.

Limitation on amendment.

- Amended claims can only relate to searched subject matter (Rule 137(5)) (unless within the inventive concept of the originally claimed invention).
- in particular matter not searched under Rule 62a or Rule 63.

Amendment – Consequences

- Concern that only one chance, and too early.
- Worries about “searched” subject matter can provoke precautionary divisionals (if there is time).
- You don’t know what has been searched, Examiners are meant to look at where the Applicant might go to, but can’t be trusted.

APRIL 2010 CHANGES (3)

3. Searching

a. Of multiple independent claims

- By new Rule 62a if there are non-allowable multiple independent claims – in the meaning of Rule 43(2) – you will be given two months to say which you want searched, with the first presented being the default if you do not reply.
- Note this is not a disunity objection and if continued in examination will not provoke a divisional window (see below), although you may well be in one. Also note you cannot pay an additional fee for a further search in this situation. All you can do with unsearched claims under Rule 62a is divide and have them searched in a divisional.
- Be aware, during later examination you cannot (due to Rule 137(5)) pursue or limit to unsearched subject matter without dividing – but you may be too late for that (again see below).
- This last can arise even if you do not have Rule 62a problems.

Consequences – searching – Rule 62(a)

- The application of Rule 62(a) seems to be done at Formalities level. So can a pre-emptive argument based on the allowable scenarios of Rule 43(2) may be overlooked.
- May this be used retrospectively?

Searching continued (1)

b. Incomplete search

- By new Rule 63, where no meaningful search is possible the EPO can ask for an indication of what they should search (reply due in two months), and absent a reply will do what they can, but that may be nothing.
- You can reply; be careful not to “add matter”.
- This is seen as a good chance to influence the search in the right direction if the claims are a mess.
- Again be aware that in examination you can not limit to unsearched matter, a poor set of claims which does not represent the invention and does not lead to a proper search may thus be disastrous.

Consequences – Rule 63

On occasion this is used by Examiners unexpectedly. The objection has been heard – “the case contained added matter which does not comply with EPC, so we will not search”. This is beyond “no meaningful” as most would understand it.

Searching continued (2)

Related points

- If the EPO also indicates (in addition to a Rule 62a point) that there is non unity under Article 82.
- In a “straight” EPA, Rule 64 applies giving two months to request search of further inventions.
- But in a E/PCT having non unity you can not do this as Rule 164 does not allow an additional supplementary search (Supplementing the International Search) to be made on a further invention in these cases. In this situation you should delete and if you wish divide.
- The above procedure does not apply when EPO is acting as PCT authority, so if you have non unity or multiple independent claim issues in a PCT for which the EPO is ISA, you can have further inventions searched, by the EPO under PCT, when you are in the international phase, but not once you have entered the Euro phase.

Consequences

- No additional supplementary search in E/PCT cases: the rationale is you had a chance in international phase.
- But ISAs do not all work in the same way, e.g. what is plural invention in EPO may well not be in USA. You can only divide.
- With EPO as ISA and IPER you can have further inventions searched in the international phase. But at a fee of EUR 1765 (against normal search fee of EUR 1105).

APRIL 2010 CHANGES (4)

4. Divisionals

- New Rule 36(1) took effect 1 April 2010. It is retrospective, establishing time periods for voluntary divisionals which may have been set running by an exam report already issued, although no due date can be before 1 October 2010.
- Previously, so long as a parent was pending you could divide it. The problem seemed to be that the process could be eternal, and was abused in connection with OPs.
- Now, under 36(1)(a) the period for filing Div as of right expires 24 months after first exam report under Article 94(3) Rule 71(1) or (3) on the case concerned or, apparently – the wording was not clear - on any other case in the same “family”.
- Also under 36(1)(b) you can divide within 24 months of any exam communication raising a specific A82 non unity objection for the first time.
- No Further Processing is available on this, and of course the parent must be pending.

Divisionals continued (1)

- The above point may be combined with the potential problem of wishing to limit to unsearched matter, including matter which the EPO say they have not searched even though you might believe they had done, or should have done. You can not at that stage have supplementary searches so division will be only way to keep prospects alive – but the divisional chance will have timed out if examination of the family has been slow.
- Unsearched matter is the new “killer point”, under Rule 137(5) you may not use it to limit claims.

Divisionals continued (2)

Consequence

- Must think harder sooner, term may be running already, many people expect heavy filings just before October 2010.
- Doubts about situations such as simultaneously filed related cases which each start a family or group.
- Doubts about the interpretation of the rule as regards meaning of “group”.

Divisionals continued (3)

Worries

- Delays by EPO after first exam report, two years is not uncommon, so need to monitor progress of examined pending cases particularly if, for example, one has argued against a non unity objection.
- Failure by EPO to raise non unity when they should have done so. They may fail to set off a term of the second type. For example an objection might be raised under the new multiple claim rule (see above R43(2)) when really it should or could have been one of non unity. Or they might refuse to enter amendments which would provoke the non unity objection you expect, Rule 137(2).

Consequences - Divisionals

- Rule 36(1) was amended, with retrospective effect, to clarify the reference to A93(3) and R71(1 or 2) or R71(3) R71(3) on a suggestion of CIPA.
- Thousands of extra cases; many not necessary.
- Problem of “unsearched matter”.
- Preferable to delete a second independent claim than with it being “unsearched” and so restricted out.
- Problem of 24 months, and reaction by EPO to first examination response in that time – at expense of other cases?
- Why were “abusive” cases not simply rejected?

SEARCH RESULTS

- Obligation to provide results of searches on original applications for which priority is claimed, from January 2011. Automatic for US, JP, UK at least.

GRANT STAGE

- More changes at the grant stage. The EPO may allow, once again, discussion of exact language before you need to file claim translations, while, if you agree with the claims proposed, continuing with the one-step process.
- With effect from 1 April 2012, Rule 71(3).

CURRENT DIFFICULTIES

- Oppositions and appeals
 - too easy to enter, and cheap
 - too long to resolve
 - is the 9 month term really required.
- Amendments
 - over literal analysis
 - strict verbal basis
 - should be “what was clearly intended”
 - FICPI Resolution
- When will my case be examined?

Resolution of the Executive Committee, Rome, 6-9 November 2011

Post-filing amendments

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Rome, Italy, from 6 to 9 November 2011, passed the following Resolution:

SUPPORTING the legal provisions that forbid the addition of subject matter to a patent application after the filing date unless such subject matter can take the date on which it is added;

BUT NOTING WITH CONCERN that some but not all patent authorities examine amendments for the addition of subject matter formalistically and so insist on explicit support for the wording of such amendments in the application as filed, where such an approach is not required by the law;

OBSERVING that, as a result of such overly-strict examination practice, there is a tendency to include wording to provide a literal basis for all potential amendments, making applications considerably longer and more expensive to draft and to analyse and more difficult to comprehend, thus degrading their disclosure function and reducing the quality of any resulting patents;

BUT EMPHASISING that a literal basis for all potential amendments could be included in the application only with a complete knowledge of the relevant prior art, which is never achievable, and that under an overly strict practice, in the absence of explicit support for a necessary amendment, patent protection for a valuable invention may be lost or unduly limited;

THEREFORE URGES patent authorities to avoid a purely literal and formalistic analysis of the original application and instead to adopt a reasonable and balanced approach, at least by taking into account the common general knowledge of persons skilled in the art, supported if necessary by evidence, and therefore allowing any legitimate amendments which such persons would consider not to extend beyond the content of the application as filed.

The End

Thanks for your attention