

EPO procedural efficiency

[[EPO papers CA/162/09 and CA/03/10]]

The members of the Federation wholeheartedly support the aim of improving the procedural efficiency of the examination process in the EPO. It is well accepted that a properly efficient process should lead to better quality in granted patents, at lower overall cost.

Recent changes

Some relatively recent changes in procedure, such as the introduction of the extended search report, should be of considerable help in improving the efficiency of the overall process. However, some of the changes that are about to come into effect under the revised implementing regulations and possibly revised examination guidelines are more problematic. As we have pointed out in recent papers, e.g., PP03/09 concerning time limits for divisional applications, and PP 04/09 concerning restriction of the search on independent claims, and their amendment, applicants will be faced with considerable problems in achieving proper and justified protection for their inventions.

Once fully implemented, the recent rule changes and anticipated practice changes e.g., concerning inventive step, will constitute a major shift in the way applications are examined, which may often be unhelpful to the applicant trying to secure the best, legitimate protection. As this may lead to dispute, improvements in efficiency may not be as great as hoped for.

Proposals for future changes

Examiner's communications

Recent rule changes affecting procedures have been concerned almost wholly with influencing the behaviour of the applicant. Proposals in the pipeline also have this objective. We consider that the EPO itself should improve its approach. We have commented in the past on the need for this, but it should be stressed again that the examiner's first communication should be comprehensive, raising all major objections and dealing with all citations. Our members regularly remark that first communications often concern mainly peripheral and secondary issues, with the major substantive matters being dealt with, and major objections being made for the first time, in subsequent communications.

Moreover, the scope for more informal discussion between the examiner and applicant should be explored, e.g., through telephone conversation. The aim of this should be to achieve better understanding of the other's position. Adequate records of such conversations, focussing on the arguments and agreements, will of course be needed.

Opportunity to amend

The applicant must be given a proper and fair opportunity to respond to each formal communication from the examiner. To rule that there will be only one single opportunity to amend, in response to the first communication, with any subsequent opportunity being dependent on the individual examiner's discretion, will result in considerable uncertainty and unfairness for the applicant. Discretion is likely to be exercised in different ways by different examiners, and even by the same examiner at different times, even if there are clear guidelines.

In order for the applicant to achieve an optimum set of claims, it is often necessary for the dialogue with the examiner to be iterative. So long as the applicant is making a reasonable

effort to meet legitimate objections and to make relevant modifications to the application, there should be no arbitrary cut off to the procedure.

Oral hearings

In our view, oral hearings should be called as a matter of last resort, not routinely at an early stage. It is a waste of resources, both of the applicant and of the EPO, to call an oral hearing when there are still good prospects of resolving matters in writing. For applicants and representatives located a long way from Munich, oral hearings are extremely time consuming and expensive. The EPO should be striving to avoid them, rather than proposing that they should be called at an early stage to shorten the procedure.

Where an oral hearing does become essential, the Office should be ready to accede to a request from the applicant that he and his representative, with others as necessary, should participate via video or tele conference.

It is quite wrong that new arguments or new citations should be deployed by an examiner in oral proceedings, as can happen at present. They should be contained in a written communication giving the applicant an opportunity to respond in writing. An oral hearing should concern itself only with the arguments and citations exposed in the written procedure. In any event, new citations in particular, additional to those in the search report, should be rare. They should be pointed out in the first communication.

Oral proceedings should always involve the full examining division. The applicant is entitled to have his arguments heard by the whole division, two of whom should not have been directly involved in the written procedure and therefore unprejudiced by earlier discussion with the applicant. Oral proceedings should be fully and accurately recorded and the transcript should be made available promptly.

3rd party observations

It appears that the Office is to take some sort of initiative to encourage 3rd party observations. The applicant must be allowed to respond to any such observations, and make amendments if necessary.

Final stage of the examination procedure (rule 71EPC)

While we agree that there should be more flexibility in the procedure under rule 71, we consider that there should be no scope under rule 71(3) for the examining division to propose substantive amendments. Any proposals from the division should be limited to the correction of textual error. Moreover, the applicant should not be expected to formally approve the bibliographic data before grant.

If the provision for amendment by the examiner is retained, then it must be possible for the applicant to challenge the proposed amendments. The rule should make clear that in the event of such a challenge, the application will be returned to the examination process.

Examination guidelines

Possible changes in these should be discussed with users.

Compact Examination

It does not seem to us that the average number of examiner communications per case (1.25) is particularly high. It is not clear why this figure is of such concern that the overall examination procedure needs to be modified.

It is said that each communication from an examiner extends the procedure by 12 months. The extension need not be anything like this if both the applicant and the EPO examiner were expected to respond rapidly to objections and proposals. Short time limits should be adhered to by both the applicant and the Office, after the first communication.

We consider that an iterative discussion between applicant and examiner will often be the way to put the application into a satisfactory condition for grant, rather than tightly limiting the number of communications. However, we would be opposed to undue informality in this process as a way of speeding things up, such as unrecorded telephone



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discussions. A clear record of anything communicated between the examiner and applicant must be maintained. Unrecorded negotiations are unacceptable (though informal contacts may be appropriate for finally settling outstanding minor points).

Finally

While they are an important guideline, the so-called "Paris criteria" should not be regarded as a rigid constraint. The main aim should be to achieve a granted patent of high quality.

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