



EPO Update

The Federation has engaged with the European Patent Office (EPO) throughout 2015 to provide input on matters relating to implementing and ancillary regulations to the European Patent Convention (EPC) and to procedures of the EPO. The Federation maintains ongoing working relationships with EPO representatives including meetings with the President and Directors throughout the year.

Reform of the Boards of Appeal

In March 2015 the President of the EPO submitted a Proposal for a structural reform of the EPO Boards of Appeal (BOA) (CA/16/15) prompted by decision R 19/12 of the Enlarged Board of Appeal. The President's proposal is intended to increase the organisational and managerial autonomy of the BOA, the perception of their independence and also their efficiency. The proposal introduces a new President of the BOA who will not be a Vice President of the EPO and who will have organisational, managerial and budgetary responsibility for the BOA reporting to a new subsidiary committee of the Administrative Council (AC), the Board of Appeal Committee (BOAC). It is proposed that the BOAC will comprise AC members, experienced judges, the President of the EPO and the President of the BOA. The BOAC will monitor efficiency and independence of the BOA while guiding on recruitment of board members. The President further proposed to relocate the BOA to provide geographic separation from the EPO to improve the perception of independence.

A consultation on the President's proposal was held during May and June 2015 and the results of the consultation were published by the President of the EPO on 25 September 2015 (CA/82/15). According to the published results of the consultation the proposals for a structural reform of the BOA are in general welcomed by users and considered to be able to bring about a significant improvement. Subsequently the President published more detailed "Orientations for the structural reform of the EPO Boards of Appeal" (CA/98/15) for discussion at the Administrative Council meeting on 16 and 17 December 2015. The Orientations document outlines in more detail the institutional framework including the specific role of the President of the BOA and the relationship with the BOAC. The constitution of the BOAC is elaborated and the mechanism for proposing and adopting Rules of Procedure of the BOA is outlined, whereby the Rules of Procedure are proposed by the EPO. The Orientations document further outlines proposals for career structure of board members and options for the relocation of the BOA to Berlin, Munich or Vienna.

Changes to the Implementing Regulations

Amendment of Rule 82 EPC for typed documents in opposition

Rule 82 EPC is amended by Decision of the Administrative Council CA/D 9/15 to come into force on 1 May 2016. The amendment allows for decisions under Article 106(2) EPC or Article 111(2) EPC to be based on documents with handwritten amendments filed in oral proceedings. Documents compliant with the formal requirements under Rule 49(8) EPC will need to be submitted only within the period of three months foreseen in Rule 82(2) EPC.

Amendment of Rule 147 EPC for preservation of files

Rule 147 EPC is amended by Decision of the Administrative Council CA/D 10/15 to recite that files for European patent applications and Patents will be maintained and preserved in electronic form (Rule 147(1) EPC) and that initial paper versions of documents incorporated into an electronic file shall be preserved for at least five years from the end of the year in which they were incorporated in the electronic file (Rule 147(3) EPC). The disposal of paper documents five years from filing emphasises the importance for applicants to verify the

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accuracy of digital scanned copies in the electronic file.

Procedural Developments

PACE

In a Notice from the EPO dated 30 November 2015 (OJ 2015, A93) the EPO announced changes to the programme for accelerated prosecution of European patent applications (PACE). The changes arise in part from the EPO's "Early Certainty from Search" project and from a requirement to ensure requests for accelerated prosecution are not made available on the public part of the file. In summary the new PACE arrangements which take effect from 1 January 2016 require that all PACE requests must be filed on EPO form 1005 and that a request by letter or as part of another item of correspondence is no longer acceptable. All PACE requests must be filed electronically (i.e. by EPO Online Filing client or the EPO Case Management System - CMS). Each PACE request can relate only to a single European application, and accelerated processing will cease if any extension of time is requested or where an application is withdrawn, deemed withdrawn or refused. Additionally, accelerated prosecution will be suspended in the event of failure to pay renewal fees by the due date stipulated in Rule 51(1) EPC. For accelerated applications the EPO will seek to issue communications within 3 months of any response by the applicant.

Electronic Druckexemplar - eDrex

The EPO proposes to extend a programme of preparing electronic Druckexemplar (a printer's copy of a granted patent) on the basis of which patent documents are approved by applicants for grant. Known as "eDrex" the electronic Druckexemplar is a digital version of patent documents processed by scanning and optical character recognition (OCR). It is on the basis of the scanned OCR version of the patent documents that applicants will be expected to approve the text for grant.

This has consequences in the event of errors or artefacts in the scanning or OCR process resulting in incorrect content in a granted patent publication ("B" specification). In view of Enlarged Board decision G1/10 only two types of errors in granted patents can be corrected under Rule 140 EPC once the patent specifications are published: printing errors (i.e. discrepancies between the text of the published patent and the text of the Druckexemplar sent with the last communication under Rule 71(3) EPC as approved by the applicant; and formatting or editing errors which occur during the preparation of the Druckexemplar and which are indicated neither by standard marks nor in EPO Form 2004C or 2004W. Accordingly, the use of eDrex places a new burden on applicants to check and verify every single character and symbol in an electronic Druckexemplar before approval of text since the opportunity for subsequent correction is limited.

User organisations including the IP Federation are working with the EPO to alleviate this new burden on applicants. In the longer term the filing of application documents in electronic form from the outset may alleviate these challenges and such possibilities are being investigated by the EPO.

Forward Thinking Proposals

Colour Drawings

The EPO has proposed to amend Rule 46 EPC to allow the filing of colour drawings. The filing of colour drawings is already contemplated for international applications (see WIPO document PCT/MIA/21/6, January 2014 and WIPO document PCT/MIA/21/22 paragraph 37(b)). There will clearly be challenges in selecting an appropriate colour format that is compatible with offices around the world and the EPO is consulting on proposals through the Standing Advisory Committee before the EPO.

Simplification of Procedures Project

Early in 2015 the EPO invited EPO examining staff working with first-instance proceedings to propose procedural improvements that may enhance office efficiency. The following proposals were raised and the EPO is actively consulting on the proposals with users and user organisations including the IP Federation:

Auxiliary Requests: The EPO considers the filing of large numbers of auxiliary requests is a hindrance to efficient processing. It is therefore proposed that only a single request is permitted in advance of first instance oral proceedings before an examining division and in the event the request is not allowable a discussion of different options for claim amendments will take place at the oral proceedings themselves. This proposal must be considered in the context of the increased proclivity of the BOAs to hold inadmissible facts, evidence or requests which could have been presented in the first instance proceedings (Article 12(4) Rules of Procedure of the BOA). In view of this power of the Boards it is incumbent on applicants to ensure their entire case is presented and maintained at first instance to retain the right to be heard and considered at second instance. For this reason there is a strong argument for retaining the opportunity to file auxiliary requests.

EPO Clerks in Oral Proceedings: The EPO proposed to introduce a "Greffier" (Clerk) in the lead-up to, and holding of, oral proceedings. The Greffier would assist applicants with support issues including preparing, accessing and printing specifications, amendments and submissions. Such a Clerk would prove helpful for applicants especially in view of the need to access and use EPO computing facilities to prepare submissions and the like.

Harmonising Discretion of First Instance Examiners: The approach to the application of discretion by first instance examiners under Rule 137(3) and (5) EPC is considered by the EPO to be inconsistent across technical areas, and the EPO proposes to harmonise the approach. The EPO considers how examiner's applying discretion to admit clearly unallowable amendments can cause the expenditure of unnecessary resource by examiners in providing reasoned substantive objections when such amendments could be more readily dispensed with by a finding of inadmissibility under Rule 137(3) or (5) EPC.

Harmonised Approach to Suggestions on Patentability in Written Opinions: It is proposed that the EPO encourage examiners to make more positive statements on patentability for European applications and to make suggestions on how objections might be overcome where examiners see clear solutions.

Telephone Interviews as First Action: The EPO proposes to undertake telephone interviews with applicants or representatives as a first action in examination proceedings before issuance of a first examination report. The minutes of the telephone interview would constitute the first communication under Article 94(3) EPC. The Office emphasised that such telephone interviews would always follow a written opinion issued with a search report, and any response thereto, such that applicants would have notice of the issues for discussion.

Scott Roberts, 17 December 2015