



European Patent Office (EPO) Update

Users welcomed a slowing of the pace of amendment of the European Patent Convention (EPC) itself, as the EPO digests the ramifications of previous changes. This did not mean that the EPO rested on its laurels in 2012 and in other areas it was active in ways that users welcome, such as the innovations in the area of machine translations.

Divisionals

The EPO's new divisional rules remained on the agenda throughout 2012 and the matter still awaits resolution in 2013. The EPO's declared intent when it introduced new Rule 36 EPC was to prevent the practice of filing chains of divisional applications, by which means some applicants apparently attempted to extend their monopoly and the resulting uncertainty for 3rd parties. It has been pointed out that the rule, in addition to placing an onerous burden on applicants, does not even achieve the stated objective and can be circumvented. In addition, the rule has actually resulted in an increase in the number of divisional applications filed, because industry has been compelled to file speculative divisional applications within the available short time limits, which the EPO then has to search and examine. Furthermore, the current system renders it difficult for 3rd parties to know whether or not an applicant still has the ability to file a divisional application and that runs counter to an objective of changing the rules in the first place.

Representatives have repeatedly requested that the rules be amended to lessen their impact. One proposal made by representatives has been to amend the rules to require the payment of all fees up front and to accelerate the examination. The reasoning behind this proposal is that it would act as an economic disincentive to file divisional applications. Another proposal is simply to revert to the old rules. It remains to be seen what the EPO will do, but it has sent strong signals that it does intend to act soon to address users' concerns.

RFees Arts. 9(1) and 11(b)

In 2012, the EPO proposed to remove applicants' ability to obtain 75% refunds of the search and examination fees, in the case in which an application is withdrawn prior to commencement of the search and examination respectively. The proposals were motivated by a board of appeal decision which highlighted the difficulty in determining the point in time at which examination commences. In the EPO's view, since clear cut-offs cannot be identified to trigger termination of the ability to obtain refunds, the facility to obtain such refunds should be removed altogether. The IP Federation and indeed most users strongly opposed the EPO's suggested solutions and pointed out that clear triggers are available - namely the transmission of the search and first examination reports. The IP Federation also made strong representations to the effect that it is not acceptable for the EPO simply to retain applicants' money for which no service had been provided. I understand that the EPO's proposed elimination of fee refunds was not accepted by the Committee on Patent Law, but that it has not dropped the proposals, so it remains to be seen how, if at all, the EPO will respond to users' concerns.

Patent Cooperation Treaty (PCT)

The EPO is looking to harmonise as many aspects as possible of the PCT procedure with the procedure for Euro-direct filings to give PCT-users an equivalent level of service. One example is the inability to use direct-debiting for PCT, which is being investigated. In some cases, different PCT rules do not allow such harmonisation and, in others, the EPO has

deemed it appropriate to maintain a different process (such as the requirement to mail a confirmation copy after a faxed submission in the international phase).

Substantive patent law harmonisation

The EPO has no formal mandate or powers to negotiate in this area, but has a strong interest in the outcomes and involves itself, wherever possible. In particular, it has created the "Tegernsee Experts Group", named after the Bavarian lake, Tegernsee, where a group of experts from European national patent offices, the EPO, the Japanese and US patent offices first met to discuss patent law harmonisation. The Tegernsee Experts Group is currently engaging in a broad stakeholder consultation concerning four particular aspects of harmonisation: the grace period, 18-month publication, the treatment of conflicting applications and prior user rights. The experts will report on the outcome of the consultations at the next meeting of the Tegernsee Heads, which will take place in late spring 2013. The IP Federation has adopted clear positions and has also published policy papers in relation to all of these matters (please refer to PP14/11 on the IP Federation's website) and has represented these positions to the EPO and other interested parties on many occasions. In particular, IP Federation members are in favour of a "safety net" grace period, which graces unintended disclosures by the applicant only.

Cooperative Patent Classification (CPC)

Since October 2010, the EPO and the USPTO have worked jointly to develop the CPC, including approximately 250,000 symbols based on the European Classification system (ECLA). This system, which will allow more thorough classification-based searches using the same classified patent document collections, has just become operational. It will not only lead to more efficient prior art searches, but will also enhance efficiency through work-sharing initiatives aimed at reducing unnecessary duplication of work. According to some estimates, the CPC will save the EPO about 50 man-years of work in re-classifying US cases.

Machine Translations

The EPO continues to enhance its capabilities in the area of machine translations. As previously reported, in 2011 it commenced a collaboration with Google® which provides Google's machine translation tool free of charge to users of EPO databases, such as Espacenet. In December 2012, the fruits of a collaboration with SIPO, the Chinese Patent Office, went live. Translations of four million Chinese patents can now be performed free of charge via the EPO's "Patent Translate" tool.

EPO Official Journal

The EPO announced its intention to improve the electronic version of its Official Journal (OJ) with a view to ceasing publication of the paper version by January 2014, after which the OJ would be exclusively an electronic publication.

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With agreement having been reached on the Unitary Patent, it is to be expected that the pace of change will accelerate in 2013. In addition to changes necessitated by the Unitary Patent, we should see continued efforts to harmonise procedures globally, via bilateral agreements, within the framework of IP5 (a group of five important national patent offices) and as part of the Tegernsee process. The EPO will continue to implement its IT roadmap, with a case management system intended to replace and upgrade the present EPO online facility. Further enhancement of the EPO's machine translation facilities as well as the addition of further languages are also to be expected.

Richard Wilding, 6 January 2013