



European Patent Office update

The Federation has engaged with the European Patent Office (EPO) throughout 2014 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 represents the Confederation of British Industry (CBI) (as a member of BUSINESSEUROPE) on the Standing Advisory Committee of the EPO (SACEPO) through which the EPO undertakes user consultation in the development of the European patent system. In addition, the Federation maintains ongoing working relationships with EPO representatives including meetings with the President and Directors throughout the year.

Procedural Developments

The end of handwritten amendments

2014 saw the introduction of a number of procedural changes at the EPO that generally reflect a move towards a less paper-based way of working. The changes were led by a discontinuation of the EPO practice of accepting handwritten amendments to documents replacing parts of a European patent application (OJ EPO 2014, 603). The implementing regulations have always required that the description, claims and abstract of a patent application (and amendments) are typed or printed (Rule 49(8) and Rule 50(1) EPC), though it had been accepted practice to admit handwritten amendments, in particular in oral proceedings. The new strict application of Rules 49(8) and 50(1) EPC came hand-in-hand with a promise of more support for applicants at oral proceedings to ensure compliance. Such support was to include: kiosk PCs; improved Wi-Fi; printing facilities; administrative support to users when typed amendment must be prepared; support for downloading, formatting A and B publications and for inserting amendments and producing clean copies; a possibility to file submissions electronically including the possibility to file submissions via e-mail during all oral proceedings (not only videoconference). As 2014 progressed it became clear that the support was in fact limited to the provision of communal computers and printers. It has been the experience of Federation members that preparing typed amendments at oral proceedings is overly burdensome and can actually lead to mistakes. The EPO response has been to informally temper the requirement by encouraging EPO staff to continue to accept handwritten amendments during oral proceedings subject to filing formal typed amendments soon after, though even this is inconsistently applied by the EPO and applicants are currently left with the extra burden. The Federation continues to advance the concerns of applicants and representatives for whom this change has become an unacceptable hurdle in addition to all other challenges to be expected at oral proceedings.

Early certainty from search

According to the EPO, the average time to receive an EPO search (for European and International applications) is 15 months. In the spring of 2014 the EPO announced a new initiative, "early certainty from search", through which the EPO aims to reduce the average time to receive a search to 6 months for all European first-filed applications and for international applications using the EPO as search authority and being filed at the EPO as receiving office. The initiative is understood to have been implemented in July 2014 and the EPO have acknowledged that it has required a change in the priorities of EPO examiners. Examiners are now being encouraged to focus on new searches (for applications received from July) leading to an inevitable backlog of applications awaiting search just before implementation of the new initiative. The initiative is also supplemented by a new procedure whereby examination of a European application is accelerated where "non-anonymous and substantiated" third party observations are received by the EPO. Notably,

non-anonymous includes observations by a 'straw-person' and the degree of substantiation is merely a statement of a substantive issue along with an argument and/or evidence.

Attestation of the commencement of search and examination

The EPO has implemented a new procedure by which the commencement of search and examination is now indicated in the patent register. When a search or examination is started, an indicator with a start date is generated and made available in the public part of the file. After publication this information is open to file inspection via the Patent Register. Before publication it is available only to the applicant.

New electronic Case Management System

The EPO has been trialling a new online file handling system, the Case Management System (CMS), for some time, and 2014 saw the system launched for general use (OJ EPO 2014, A97). The system is entirely web-based (requiring no special software installation) though is currently limited to the filing of European applications, entry into the European phase for international applications, subsequently filed documents (such as responses to examination reports) and the filing of a notice of opposition. CMS cannot be used for filing documents in respect of appeal proceedings. Further, patent applications filed using CMS cannot be initially received at a national office, as may be necessary to satisfy security requirements (e.g. Section 22 of the UK Patents Act). The EPO's increasing investment in, and promotion of, CMS brings into question the future of the existing EPO online filing software for which many users are trained and experienced. There would be a considerable cost for applicants and their formalities departments to transfer to new online filing software. It is currently not clear if EPO online filing software is to be phased out and, if so, when.

PCT direct

From 1 November 2014 the EPO has offered a new facility linking first filings at the EPO (European patent applications) with subsequent PCT applications having the EPO as search authority. The facility, known as "PCT direct", allows applicants filing the subsequent PCT application to also file submissions (amendments and/or arguments) in the form of a reply to the search opinion of the former application. The EPO will then take these submissions into account when preparing the international search report, offering a new opportunity to emphasise any differences between the former European and subsequent PCT applications. On the whole, PCT direct is welcomed as a further opportunity to achieve a positive opinion in the international phase, though it is noted that the EPO has previously neglected to consider differences between (especially the claims of) former European and subsequent PCT applications which would have led to the same result.

Wi-Fi at EPO premises

It has long been the experience of Federation members that access to Wi-Fi facilities at the EPO has been sporadic and often impossible. Even where a Wi-Fi connection can be established, the connection is restricted and prevents communication with corporate networks over VPN connections and the like. With the new emphasis on typed amendments at oral proceedings the need for network access has only increased. The Federation worked with the EPO during 2014 to request the implementation of a more effective and appropriate Wi-Fi offering for applicants and representatives on EPO premises, and from October 2014 a new Wi-Fi service has been provided at the EPO in Munich and The Hague. The new service involves tokens issued by the EPO and allows seemingly unfettered internet access including VPN access to corporate networks.

Payments to the EPO

From 1 April 2014 the EPO abolished the administrative fee for insufficient funds in a deposit account (as part of the revision of the arrangements for deposit accounts, OJ EPO 2014, A26). The abolition of the administrative fee means that deposit account holders are no longer able to assure payments are made to the EPO when there are insufficient funds in a deposit account. The EPO indicated that this change is occasioned because the administrative fee overlapped with fees for further processing, though it is noted that the process and provisions for further processing are wholly different and unrelated to the process and provisions for executing a payment per se. Following the abolition of the administrative fee

it is very difficult to make instantaneous payments to the EPO, except perhaps for applicants holding a German bank account. Further, since it is not possible to readily query the exact balance of a deposit account in real-time, applicants cannot be certain of whether an account has adequate funds. To temper these concerns the EPO have indicated that they will, in future, accept new methods of payment including direct debiting from Euro bank accounts using SEPA (Single European Payment Area) and payment by credit card. It is noted, however, that payment by credit card will only be possible via the new case management system (CMS).

Symposium on Article 123(2) EPC

In February 2014 the EPO hosted a Symposium dedicated to the EPO's practice in the application of Article 123(2) EPC. The symposium was attended by representatives of the Federation who contributed across a number of technical fields to identify inconsistencies in the EPO's approach and to highlight particularly problematic applications of the provisions, especially in the field of chemistry. Examples of problems were shown to arise in relation to selections from lists, combining from dependent claims, and deleting options which might lead to a charge of singling out new matter. The approach of the EPO in some cases can drive patent attorneys to draft longer, and thus more expensive, specifications. The EPO was receptive to the feedback and indicated an interest in amending the Guidelines for Examination, which they subsequently did in the 2014 revision. Already the 2013 revision of the Guidelines were clarified to emphasise that Article 123(2) EPC does not require literal support of the amendment in the application as filed. From 2014, further amendments were made to Section H of the guidelines. Section H-IV 2.3 was amended to recite:

When assessing the conformity of the amended claims to the requirements of Art. 123(2), the focus should be placed on what is really disclosed to the skilled person by the documents as filed as directed to a technical audience. In particular, the examiner should avoid disproportionately focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole.

Section H-V 3.2.1 was amended to recite:

These conditions should be understood as a help for assessing, in the particular case of an intermediate generalization, if the amendment fulfils the requirements of Art. 123(2). In any case it has to be assured that the skilled person is not presented with information which is not directly and unambiguously derivable from the originally filed application, even when account is taken of matter which is implicit to a person skilled in the art using his common general knowledge.

Section H-III 2.1 was amended to recite:

When filing amendments, the applicant must identify them and indicate the basis for them in the application as filed. This requirement should be understood as an opportunity for the applicant to provide convincing arguments to the division as to why the amendment(s) is/are directly and unambiguously derivable from the application as filed. These arguments will be taken into account by the division for the assessment of Art. 123(2). They are particularly important for the outcome of the division's assessment where literal support for the amendment(s) is not present in the application as filed.

These amendments to the guidelines are seen as a positive step though it remains to be seen if they lead to any improvement in consistency of application of Article 123(2) EPC by the Boards of Appeal.

Changes to the Implementing Regulations to the EPC

This year saw a number of changes to the implementing regulations to the EPC.

Rules 36 and 38 EPC - divisionals

Changes to the rules relating to the filing of divisional applications came into force on 1 April 2014. The requirements for filing a divisional application are now only that the earlier application is pending. There is an additional fee for the filing of divisional applications of a second or subsequent generation patent application (new Rule 38(4) EPC and Article 2(1b) of the rules relating to fees).

Rule 6 EPC - reduction of fees

Changes to the rule relating to the filing of translations and the reduction of fees came into force on 1 April 2014. The new Rule 6 EPC provides only for a reduction of the filing fee and the examination fee, and such a reduction is now only available to SMEs, natural persons, non-profit organisations, universities and public research organisation. The reduction itself in Rule 14(1) of the rules relating to fees is increased from 20% to 30%.

Rule 103 EPC - reimbursement of appeal fees

Changes to the provisions for the reimbursement of appeal fees came into force on 1 April 2014. The new Rule 103 EPC provides for the reimbursement of 50% of the appeal fee when an appeal is withdrawn after the filing of a statement of grounds of appeal or expiry of the four-month period for filing that statement provided that the withdrawal occurs: at least 4 weeks before a date of oral proceedings (where oral proceedings are scheduled); or where oral proceedings are not scheduled, before the expiry of the period set by the board for filing observations; or where there is no invitation to file observations, before the decision is issued.

Rule 164 EPC - unity

Changes to the provisions relating to searches for applications considered by the EPO to lack unity came into force on 1 November 2014. The rule change affects PCT applications entering the European regional phase whose first examination report or supplementary search report was not drawn up by 1 November 2014. Where the EPO was the search authority for an application, the EPO will invite the applicant to have additional inventions searched if it identifies a lack of unity in the supplementary search carried out on regional phase entry. Where the EPO was not the search authority for an application, if the EPO notices at the start of examination that some of the claims relate to subject matter not searched during the international phase, the EPO will invite the applicant to have this subject matter searched.

Proposed change to Rules 125 and 126 EPC - notifications

The EPO is finalising its proposal to change the provisions relating to notification in Rules 125 and 126 EPC to cover the use of private postal services and to extend the "10 day rule" of Rule 126(2) EPC to electronic notifications. The EPO has also confirmed that failed electronic notification would not be followed by public notification without first attempting written notification. The timeframe for introduction of the change is not yet clear.

Proposed change to Rule 147 EPC - preservation of files

In September 2014 the EPO outlined proposed changes to Rule 147 relating to the preservation of files. Currently, the EPO scans printed materials for patent applications and incorporates scanned copies in an electronic filing system. This file system is used to provide the online register. Under Rule 147(3) EPC documents incorporated in an electronic file are considered to be 'originals'. The paper versions (referred to, by the EPO, as 'blueprints') are, therefore, no longer 'originals' when scanned. Blueprints are currently retained by the EPO for the maximum retention period of 30 years. The EPO propose to amend Rule 147 to reduce the time period for retaining the blueprints, with a proposal to reduce this to 2 years. While scanned documents may be considered 'originals' under Rule 147 EPC, the practical reality is that scanning is not infallible, and there can always be a prospect of referring to blueprints where scanned documents are illegible or corrupted. In this regard a change to a 2 year retention period would seem to be far too short.

Scott Roberts, 7 November 2014