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**EPO PROBLEMS up to March 08 2006**

**A. DELAYS**

**(1) Search Report/Office Action**

**(a) Search Reports Awaited**

01111155.6 filed 10/05/2001

(01117709.4 filed 27/07/2001; (withdrawn 06/02/2006))

01122610.7 filed 27/09/2001

**(Eastman Kodak Co.)** (was Heidelberg Druckmaschinen AG)

(02006506.6 filed 18/03/2002 (withdrawn 06/02/2006))

02013462.3 filed 14/06/2002

**(Eastman Kodak Co.)** (was Nexpress Solutions Inc.)

**These Kodak cases were reported last year but still not actioned**

**(b) Search Reports Delayed**

93302122.2 filed 19/03/1993; Search Report 21/08/2003

94105709.3 filed 13/04/1994; Search Report 26/05/2004

94480052.3 filed 21/06/1994; Search Report 12/01/2005

94110159.4 filed 30/06/1994; Search Report 12/06/2002

95480135.3 filed 22/09/1995; Search Report 05/01/2005

95117739.3 filed 10/11/1995; Search Report 16/02/2005

95118102.3 filed 17/11/1995; Search Report 22/10/2003

95480190.8 filed 20/12/1995; Search Report 08/12/2004

**+ 33 more cases where Search Report delayed 5-10 years**

**(see Annex A)**

**(IBM UK IP Law)**

01105399.8 filed 12/03/2001: Search Report 26/01/2006

01204461.6 filed 22/11/2001: Search Report 17/01/2006

02079343.6 filed 18/10/2002: Search Report 05/07/2005

**(Eastman Kodak Co.)**

97202975. Page 1 of 95 filed 29/09/1997; Search Report 03/06/2004

99308212.2 filed 18/10/1999; Search Report 02/12/2003

00304318.9 filed 22/05/2000; Search Report 18/03/2004

00309213.7 filed 19/10/2000; Search Report 30/06/2004

00310420.5 filed 23/11/2000; Search Report 25/10/2005

**(+ others in Annex B)**

**(BAE Systems plc)**

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**(c) First Office Actions Awaited**

97111729.6 exam. fee paid 16/05/**2000**  
97122899.4 exam fee paid 11/12/**1999**  
97300203.3 exam. fee paid 24/01/**1997**  
97305279.8 exam. fee paid 14/07/**1998**  
97306169.0 exam. fee paid 01/12/**1998**  
97306436.3 exam fee paid 15/06/**1999**  
97308844.6 exam fee paid 27/10/**2000**  
98305285.3 exam. fee paid 30/01/**1999**

**(see Annex A)**  
**(IBM UK IP Law)**

01301545.8 exam. fee paid 23/01/2002

**(The BOC Group plc)**

**This case was reported last year but still not actioned**

96105606.6 exam. fee paid 24/03/**1999**  
00203610.1 exam. fee paid 15/08/**2003**  
00203611.9 exam. fee paid 15/08/**2003**  
**(Eastman Kodak Co.)**

96919196.4 exam. fee paid 08/12/**1997**  
**(GE Healthcare Ltd)**

96940208.0 exam. fee paid 19/05/**1998**  
98909919.7 exam. fee paid 07/10/**1999**  
**(GE Healthcare Biosciences AB)**

97904082.1 exam. fee paid 31/07/**1998**  
97913691.8 exam. fee paid 18/05/**1999**  
97940695.6 exam. fee paid 15/03/**1999**  
**(Amersham Biosciences Corp./Niagra Inc.)**  
**plus 21 other GE cases (see Annex C)**

99940287.8 exam fee paid 16/01/**2001**  
99300946.3 exam fee paid 03/05/**2001**  
**(BAE Systems plc)**

**(d) First Office Actions Delayed**

95303532.6 exam fee paid 08/03/**1996**; first office action 30/08/**2005**  
96300051.8 exam fee paid 25/11/**1996**; first office action 10/10/**2005**  
96300569.9 exam fee paid 20/01/**1997**; first office action 28/10/**2005**  
96305899.5 exam. fee paid 29/08/**2000**; first office action 22/12/**2004**  
96105013.5 exam fee paid 13/02/**1997**; 51(4) 10/10/**2005**  
97926164.1 PCT filed 25/06/**1997**; positive IPER issued 8/10/1999;  
regional phase entered 6/01/ 2000; first action 51(4) 15/11/**2005**  
**+ 22 other cases with delay of at least 4 years only after  
submissions to EPO  
(see Annex A)  
(IBM UK IP Law)**

98200030.9 exam. fee paid 09/04/**1999**; first office action 09/12/**2005**  
99202315.0 exam. fee paid 02/08/**2000**; first office action 16/11/**2005**  
00201432.2 exam. fee paid 14/01/**2004**; first office action 08/12/**2005**  
**(Eastman Kodak Co.)**

96308749.9 exam fee paid 21/08/**1997**; first office action 12/11/**2001**  
96943292.0 exam fee paid 25/09/**1998**; first office action 04/02/**2003**  
99310081.7 exam fee paid 11/04/**2002**; first office action 13/01/**2006**  
99950967.2 exam fee paid 03/05/**2001**; first office action 16/09/**2005**  
01951170.8 exam fee paid 19/07/**2002**; first office action 17/01/**2006**  
**(+ others as listed in Annex B)  
(BAE Systems plc.)**

**(e) Subsequent Office Action/51(4) Delayed**

97120539.8 first office action response 04/07/**2002**; second office action issued 08/07/**2005**  
**(IBM UK IP Law)**

98940473.6 first office action 25/05/**2001**; second office action 13/04/**2005**  
99309639.5 first office action response 08/08/**2001**, second response 13/04/**2002**; 51(4)  
issued 15/10/**2005** despite reminder 06/2003 and promise of office action within 6 months  
99954242.6 first office action response 21/05/**2003**; second office action 02/12/**2005** after  
reminder  
**(BAE Systems plc.)**

99204350.5 first office action 21/02/**2001**; second office action 30/01/**2004**  
third office action 08/04/**2005**, accelerated prosecution requested December 2005 but no  
further communication  
**(Eastman Kodak Co.)**

**(f) IPER delayed**

PCT/GB02/04905 filed 31/01/2002 not received (by 17/08/2005)  
**(IBM UK IP Law)**

**(2) Grant**

97309191.1 Response to R.51(4) received by EPO 27/09/**2002**; R.51(6) issued 28/02/**2005**

97309940.1 Response to R.51(4) received by EPO 26/09/**2002**; R.51(6) issued 28/02/**2005** i.e. 29 months from approval of text to R.51(6)

**(IBM UK IP Law)**

**(3) Oral Proceedings**

**Summons**

01204923.5 Summons dated one day before 2-month deadline week but received 4 days later - i.e. outside 2 month Rule 71 period. The delay was caused by a 4 week formality delay but the Chairman refused to change the date, although agreement on a text was resolved with the Examiner by phone.

**(Eastman Kodak Co.)**

**Examination**

91920634.2 filed **1991**; appeal from Examination Division **2001**; reverted to same division for prosecuting in May **2002**; not yet re-examined 4 years later (patent will expire in 2011).

**(AstraZeneca plc)**

**Oppositions**

Opposition filed October **2002**; response filed June **2003**, Oral Proceedings October **2006**

**(Pfizer Ltd.)**

96939199.4 Oral Proceedings 23/11/2004; Decision 11/10/2005

96939199.4 Oral Proceedings 23/01/2005; Decision 11/10/2005

00202715.9 Oral Proceedings 12/05/2005; Decision 14/12/2005

**(Eastman Kodak Co.)**

**B. 51(4)/51(6) COMMUNICATIONS**  
**(a) Controversial amendments**

Very widespread reports that amendments, sometimes quite extensive, made without referral to agent, perhaps to avoid issuance of further office action (for which examiners receive no 'credit') leading to delay of grant

In pharma. field EPO insists prodrugs deleted from claims to new chemical entities but at 51(4) stage Examiner deletes related language to *modus operandi*. Examiners generally allow reinsertion but submitted that should not be removed in the first place

**(Pfizer Ltd.)**

**(b) Non-review of amendments before translations due**

Examiner's decision re amendments (on Form 2098A) can only be issued after translated claims have been filed, leading to uncertainty in what to translate and delay in grant.

**(c) Different consequences for default in approval of text and filing of translations**

02746824.8 51(4) was a first Communication after which Applicant found significant new prior art. Approval of text impossible and Applicant submitted revised claims. Loss or rights notice received.

Failure to agree text results in loss of right (Rule 69(1)); failure to file translations results in withdrawal (Rule 51(8)) but operation of latter presupposes agreed text exists. T1181/04 states that "Rule 51 does not provide any way to express disapproval but this does not mean that the Applicant should be deprived of the possibility of expressing his disapproval" "51(8) cannot be applied to applicants who did not approve the text, otherwise they would be deprived of the possibility of disapproving".

Decision under Rule 69(2) requested.

**(Merck & Co. Inc.)**

**(d) Designation errors**

02779708.3 51(4) received December 2004 listing all designations correctly. However Form 2006A received 06 May 2005 and B1 publication omitted 7 last designations in error, but not realised by Applicant. On attempting to validate in 6 major markets found that Sweden was not listed and so delay at Swedish PO while corrections sought.

**(AstraZeneca plc)**

**(e) Scanning errors**

03077028.3 Page 33 was missing from 51(4)

03078608.1 Page 42 was missing from 51(4)

**(Eastman Kodak Co.)**

00308660.0 Fig. 4 missing

**(see Annex D)**

**(Rohm and Haas)**

**MISCELLANEOUS**

**Oral Proceedings**

02075633.4 notification dated 24/01/06 of maintenance of date of Oral Proceedings which had already occurred on 09/12/05

**(Eastman Kodak Co.)**

00200317.6 and another

Oral proceedings dates set for two different cases for same time on same date with the same Examiners

**(Eastman Kodak Co.)**

02080407.6 and 02080397.9

Two Oral Proceedings set after one office action only on two related cases for both of which comprehensive responses had been filed. Moreover on 02080407.6 no Search Report had been received nor placed on file history, the single office action was received only 18 days from dated letter and two new citations were made as part of Summons.

The Examiner agreed to cancel the Oral Proceedings and to send second office actions on both cases

**(Eastman Kodak Co.)**

### **Conflicting decisions**

Exhaustion of Priority- although T998/99 not followed in T15/01 and said to be spurious, for legal certainty should be referred to EBA.

**(Pfizer Ltd.)**

### **FORMALITY/OTHER ISSUES**

#### **(a)Mixed Applicant/ application number details**

04717682.1

An EPO Form 1201 describing the procedural steps required for entry into the European phase sent to NL address which had no connection with the Applicant or the authorised representative. The register shows the NL company as an Applicant, but all the register details, including the International publication and applications numbers, the title and the inventor name are in the name of IBM.

**(IBM UK IP LAW)**

#### **b)Misleading/unclear/incorrect Communications**

01202974.0 Form 2944A indicates extension of 2 months for response to Communication under Art. 96(2) being allowed but the Form also states that to the extent that your request exceeds the above extension, your request has been refused.

**(Eastman Kodak Co.)**

02728940.4 Examiner referred in office action to Sheet C and after various clarification requests responded 1 week before deadline, forcing 1 month extension. In fact objection based on ISR had already been overcome.

**(GE Healthcare)**

98305199.6 Translation of priority document requested but priority document in English

**(Rohm and Haas)**

## **Fees**

04727590.4

Incorrect request from EPO for payment of claims fees already paid  
Communication 30 December 2005 informing of non payment of fees for claims (fees actually paid 24 November 2005)

Second case

Excess claim fees for claims 11-18 paid on entry to national phase, as confirmed on file history, but Communication under Rules 109 and 110 stated fees not paid for claims 11-20.

This is a recurring problem indicating possible generic software problem

**(IBM UK IP Law).**

05076683.1 Refund issued incorrectly and EPO could not explain error

**(Rohm and Haas)**

## **Loss of rights**

02080301.1 Notification of loss of rights submitted despite acknowledgment of receipt of response to office action by EPO and later Communication from Examiner referring to documents received on that day. Notification withdrawn

**(Eastman Kodak Co.)**

## **Office Action in error**

012793979.3 Issued incorrectly after non-payment of annuity and surcharge date

**(Rohm and Haas)**

## **Triplicate replacement pages**

Examiners still requesting replacement pages (and hand-amended pages) to be filed in triplicate

04078163.5 and 04078162.7

## **(c) Search Report errors**

### **No or wrong citations enclosed with Search Report**

02077810.6 (with one wrong one)

01954860.1 (with three wrong citations)

**(Eastman Kodak Co.)**

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**(d) Incorrect Names**

**(i) Inventors**

04256807.1; 05250783.7; 05291765.5

**(ii) Opponent**

0097599.1 and 00932537.4

**(iii) Entity**

05290484.4; 05252553.2 and 04256803.0 and 19 other examples

**(see Annex D)**

**(Rohm and Haas)**

**(e) Prosecution issues**

0021432.2 Two month term set for response despite significant objections and relatively 'young' case

99203809.1

Double patenting objection raised despite 'second' application having an additional essential feature. Examiner explained he needed argument for 'votum' why this did not relate to the same invention.

**(Eastman Kodak Co.)**

**(f) Ignoring waiver letters**

e.g. 0525251205.0 Waiver routinely filed by Applicant requesting examination regardless of novelty search to avoid (a) losing application due to non-payment and (b) docketing deadlines. Often Form 1082 sent requesting confirmation, setting 6 month term to reply or application lost.

**(see Annex D)**

**(Rohm and Haas)**

**(f) Voice mails/absences**

Messages often only in one language; often messages cannot be left; suggest part-time staff specify their working days and days of return from holiday.

99204350.5

One Examiner has voice mail to say returning September 2005. He is retiring soon and works very infrequently but meanwhile other Examiners cannot deal with case, on which accelerated prosecution requested December 2005, until his return

**(Eastman Kodak Co.)**



## **MUNICH/THE HAGUE ISSUES**

Very closely related cases going to Munich and the Hague  
-almost identical titles, inventors; different standards of examination  
0323282.4 and 0323280.8  
**(Eastman Kodak Co.)**

Different standards/mode of operation of Oral Proceedings Munich/the Hague

### **Questions**

What data is needed in second medical use at filing? Traditionally provided post-filing but rumours that might change. If so new date should apply only to new filings after certain date so that Applicant not disadvantaged by relying on previous EPO practice.

Can internal guideline for examiners be published cf. the UKPO Manual of Patent Practice?  
**(Pfizer Ltd.)**

**See Annexes A, B, C and D (separate document)**