



PP11/09

DEFERRED EXAMINATION OF EUROPEAN PATENT APPLICATIONS

EPO COUNCIL PAPER CA/51/09 - SUBMITTED BY THE DANISH, GERMAN AND NETHERLANDS DELEGATIONS

COMMENTS FROM THE IP FEDERATION

General

At the time when the European patent convention was established, it was a basic and guiding principle that deferral of the examination request would not be permitted beyond the time needed to search and publish the application (18 months from priority), plus a relatively short time in which to consider the search report (6 months following publication). It was a strongly held view that the existence of a great number of published but unexamined "suspended" patent applications, which might never be examined or proceed to grant, would create a quagmire of uncertainty for competitive research and development and would be against the public interest. It was anticipated that the EPO would make a major contribution to the elimination of the excessive backlogs of national applications that existed in many of the participating states within Europe. Notwithstanding the current backlog of cases in the EPO awaiting examination following a request, it has indeed made this contribution.

However, much needs to be done to alleviate the increasingly long average time to grant experienced by all applications. In some of our members' experience, the average time from application to grant is in excess of 66 months, not the 43 months mentioned in CA/51/09. Even for those patents where owners and interested third parties are not too concerned about expeditious grant, this is excessive.

We consider that there is still much that should be done by the EPO in the context of managing the workload and increasing both efficiency and quality. In response to the study on Future Workload in CA/144/07 prepared by the Board of the Administrative Council, we submitted comments on these matters in our paper PP05/08. We would welcome a determined effort by the EPO to reduce inefficiencies, manage cases to a determined timetable (with defined periods for both examiner and applicant responses) and increase examiner and other productivity.

Moreover, the possibility that greater use might be made of work done elsewhere, such as that done under the PCT or in national patent offices, should be vigorously pursued. The present initiative by the Director General of WIPO to maximise the quality and usefulness of the PCT should be enthusiastically supported.

The delivery of high quality granted patents, efficiently and in reasonably good time, should be the EPO's basic aim.

The IP Federation is the operating name of the Trade Marks, Patents and Designs Federation
Registered Office 5th floor, 63-66 Hatton Garden, London EC1N 8LE

Email: admin@ipfederation.com | Tel: 0207 2423923 | Fax: 0207 2423924 | Web: www.ipfederation.com

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Deferred search and examination

Search

As regards the search and opinion on patentability, our members are strongly opposed to the possibility of this being deferred. It is most important to third parties that search results should be available as soon as possible, without them having to make their interest known by filing a request for a prompt search. It is a fundamental aspect of the system in Europe and internationally (PCT) that the search result on each published application should be quickly available to facilitate third party analysis of the application.

Examination

As patent applicants, many of our members can see significant advantages in a deferred examination system, since it would enable decisions about whether to pursue grant to be postponed, e.g., until it is clear whether or not the invention has commercial possibilities, and would enable the precise scope of the invention to be clarified at a late stage. It would be a way in which applications could be “prioritised” for examination.

However, our members are not only patent owners but can also be seriously affected by the patents and applications of others. A significant proportion of our members are opposed to the proposal in CA/51/09. In the technical fields that concern them they need to know the scopes of the granted claims as soon as possible. (Claims as published are often broad and unhelpful.) The increased uncertainty about whether large numbers of published applications will ever proceed to grant and if so what their form might be, possibly many years hence, makes the proposal unattractive to them.

Deferred examination - conditions

If a deferred examination procedure is to be introduced, then certain conditions will be needed.

First, it should not be possible to defer making a request for examination by more than five years from the filing date of the application. If no request is made by then, the application should be treated as withdrawn.

Second, interested third parties should be able to request examination of the application by paying the examination fee. It should be possible to do this without the identity of the requester being disclosed to the applicant.

Third, following a request for examination, by either the applicant or a third party, the procedure should be expeditious. Clear time limits should be set out for responses from both the applicant and the examiner.

There should be no requirement for interested third parties to present observations under Article 115 EPC. Third parties might not wish to prejudice their positions in possible opposition proceedings by being obliged to present early observations.

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Prioritisation

A significant and general problem highlighted in paper CA/51/09 is that the EPO has little or no way of distinguishing between the more important or urgent applications and those less so. Thus under the present regime, all are likely to experience long delays before grant. Deferred examination is suggested as the way in which the work of the EPO can be prioritised in accordance with applicant and third party demand.

We consider that arrangements to enable work to be prioritised should be improved, regardless of the introduction of deferred examination. The present arrangements whereby applicants can request accelerated processing (PACE) should be maintained, and extended so that third parties may also make such a request on an application of interest (on payment of a significant fee to discourage frivolous requests). Third parties should be able to make such a request without their identity being disclosed to the applicant. It should be possible to make such a request after the request and fee for examination have been submitted. A clear timetable for processing a prioritised case should be laid down.

A review of the fees, and the balance between them, that are or might be levied in relation to the examination procedure (e.g., examination request, annual renewals, accelerated processing request, by applicant or third party) should be conducted so as to ensure that the system can accommodate prioritised applications properly. It might be possible, for example, for the examination fee to be somewhat lower than at present, with a significant fee thereafter for accelerated processing.

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