

Examination practice in the EPO

Introduction

The IP Federation represents IP-intensive companies in the United Kingdom (see list of members attached). All our members are extensive users of the patent system in Europe, both as applicants and litigators (either plaintiffs or defendants in patent actions), and employ their own in-house patent professionals.

In previous papers, most recently in [PP03/10](#) concerning procedural efficiency in the EPO, we have referred to aspects of patent examination practice in the EPO which appear to be driven by management constraints and restrictions on procedure, including an aim to fully comply with the “Paris criteria”¹, rather than with the aim of delivering a granted patent of high quality. A high quality patent is one that can be presumed valid with a high degree of certainty and that will afford the holder the maximum legitimate protection consistent with the objectives of the invention.

It seems that there is particular pressure on the substantive examiner to recommend grant or refusal to the examining division after only one communication to the applicant, regardless of the complexities of the case or the potential for reaching a better understanding and outcome by taking proper account of the applicant’s observations (see for example paper CA/162/09).

We consider that the EPO should conduct the examination of patent applications in a comprehensive and efficient way, taking full account of the observations of the applicant. If the examiner is not satisfied with the applicant’s response to the first substantive communication, he or she should ensure that he or she properly appreciates the invention and the aims of the applicant by further discussion.

The Convention (Article 94(3)) and the current guidelines to examination in the EPO (dated 1 April 2010), clearly allow for such an iterative approach to examination. (A summary of our understanding of the current guidelines is attached.) However, the guidelines do not emphasise the need, when appropriate, for the examiner to enter into dialogue with the applicant to ensure that he or she has a full appreciation of the application.

We consider that some modification of the current approach to examination and an elaboration of the guidelines is called for, as discussed below.

¹ Part of the mandate to the EPO from the Intergovernmental Conference of Contracting States held in Paris in June 1999 was ‘to cut the average time taken to grant a European patent to 3 years’.

Examiner's communications and the opportunity to amend

We stress that both the search report and the substantive examiner's first communication should be comprehensive, raising all major objections and dealing with all citations. Our members regularly remark that first communications often concern mainly peripheral and secondary issues. Major objections are often made for the first time at a late stage, often even only during oral proceedings.

The applicant should be given a proper and fair opportunity to respond to each formal communication from the examiner. Furthermore, the examiner should respond positively to an applicant who is making an effort to meet his or her objections or to assist him or her in understanding the invention and/or the aim of the application. The applicant should be entitled to a further opportunity to amend.

The need for an examiner to completely understand the invention is crucial, but our members' experience is that examiners are often not wholly familiar with the technical areas that they examine. More specialised technical training and, possibly, suitable industry placements would help in these cases. Moreover, the examiner should always be prepared to seek further observations from the applicant when there appears to be a divergence in understanding.

In order for the applicant to achieve an optimum set of claims, it is often necessary for the dialogue with the examiner to be repeated. So long as the applicant is making a reasonable effort to meet legitimate objections and to make relevant modifications to the application, or to explain where the examiner has not appreciated aspects of the invention, there should be no arbitrary cut off to the procedure.

We understand that increased use of e-mail between the examiner and applicant/representative is being considered, as an aid towards reaching improved understandings. Whilst we can support this development, provided that no comments, other than the e-mails themselves, are added to the application file, we consider that the approach outlined below will in many cases be more effective.

Many difficulties could be resolved by interview or, bearing in mind the difficulty of access for many applicants and representatives, telephone discussion. At present, telephone discussion is the exception rather than the rule because many examiners seem unwilling to attempt to resolve difficulties in this way. Indeed, our members report cases of examiners not being accessible by telephone, e.g., because voice mail facilities are turned off. This reluctance on the part of examiners to engage in telephone discussion may be because they feel unable to conduct a deep technical conversation in the relevant working language of the EPO. Examiners should be encouraged to use the telephone and further training in this aspect of the work may be needed, particularly in non-mother-tongue conversation.

One possibility is that, where appropriate, examiners schedule a preliminary technical conversation with the applicants, either by interview or telephone discussion, to clarify any points about how the claimed technology works or

what the prior art means. This would be a practical way of addressing the reality that technology today is so wide ranging and often so complex that no one person can be expected to have expertise in everything. It would also likely save an examiner the time of trying to understand the invention from scratch with little by way of resources to support him or her. After all, this is the way that patent attorneys work in industry where they have ready access to their inventor community. Under this approach it is proposed that substantive patentability issues are not discussed at this stage so that the focus is solely on the technology itself.

Such interviews and telephone discussions must be clearly distinguished from formal oral proceedings, but nonetheless, adequate records of them must be kept and agreed between those involved, focussing on the arguments deployed and the understandings reached.

Furthermore, the legitimate need for third parties to have sufficient time to note developments and submit third party observations before issue of the Rule 71(3) communication must be taken into account

Oral proceedings

Oral proceedings should be a matter of last resort, not resorted to routinely at an early stage. It is a waste of resources, both of the applicant and of the EPO, to institute oral proceedings when there are still reasonable prospects of resolving matters in writing. For applicants and representatives located a long way from Munich, such proceedings are extremely time consuming and expensive. The EPO should be striving to avoid them, rather than calling for them at an early stage to shorten the grant procedure.

Where oral proceedings do become essential, the summons to the applicant should clearly set out the issues to be resolved. It is unacceptable that applicants should be put to the expense and time of an oral hearing without being given a precise indication as to the matters to be considered. To confirm that all members of the examining division have read the examination file and confirm the need for oral proceedings, all should sign the summons. Our members report numerous instances of vague summonses.

The Office should be ready to conduct oral proceedings by video or telephone conference, where this is requested by the applicant. Skype™ or WebEx™ on-line proceedings should also be considered.

In general, it is wrong that new arguments or new citations should be deployed by the examining division in oral proceedings, as can happen at present. They should be contained in a written communication giving the applicant an opportunity to respond in writing. Oral proceedings should concern only the arguments and citations, together with the applicant's replies and proposed amendments, exposed in the written procedure. In any event, new citations in particular, additional to those in the search report, should be very rare. They should be pointed out in the first communication.

Oral proceedings should always involve the full examining division. Our members have experienced situations where the primary examiner has not been present and the remaining members of the division have taken a

markedly different approach to the application under consideration. This should be unacceptable. The applicant is entitled to know in advance the position of the examining division as a whole and to have his observations heard by the whole division.

Moreover, only the primary examiner should have been directly involved in previous discussions with the applicant - other members of the division should not be prejudiced by such contact.

Oral proceedings should be fully and accurately recorded and the transcript should be made available promptly. Vague and/or delayed reports should be unacceptable.

General

It does not seem to us that the average number of examiner communications per case (1.25) in the past was particularly high. It is not clear why this figure is of such concern that the examination procedure has been modified.

It is said that each communication from an examiner extends the procedure by 12 months. The extension need not be anything like this. Following the first communication from the examiner, short time limits should be observed by both the applicant and the Office where rapid grant is desired.

An iterative discussion between applicant and examiner will most often be the way to put the application into a satisfactory condition for grant, rather than a single action examination. While we advocate much greater use of the telephone to speed understanding, a clear record of anything communicated between the examiner and applicant must be maintained. Unrecorded negotiations are unacceptable (though informal contacts may be appropriate for finally settling outstanding minor points).

The so-called "Paris criteria" should not be regarded as a rigid constraint. The main aim should be to achieve a granted patent of high quality. We do not consider the average time from first application to grant in recent years - 43 months - to be unreasonable. What should be avoided are very long pendency times where examiners neglect to process cases expeditiously. Ensuring that examiners respond to replies and observations from applicants promptly is a management issue for the Office.

Summary

1. An iterative examination process will often be the best way of ensuring that the examiner fully appreciates the invention and the applicant's aims, while the applicant has an adequate opportunity to respond to the examiner's objections. It is the way to ensure that a high quality patent is granted.
2. Telephone discussions are to be encouraged and training given to examiners to help them with this.
3. In appropriate cases, it would be good practice for the examiner to schedule a preliminary technical conversation with the applicant, to

ensure that there is a common understanding of the nature and objectives of the invention.

4. Oral proceedings should be a matter of last resort. When they are necessary, they should be conducted by video, telephone or on-line conference if requested by the applicant.
5. The summons to oral proceedings should clearly define the issues and new objections should, in general, not be raised in oral proceedings.

Recommendation

Examiner training should take account of these points and the Guidelines to Examination should be amplified to give them proper emphasis.

IP Federation
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Annex - The approach to examination as set out in the EPO Guidelines

(Summarised and simplified from the Guidelines for Examination in the EPO, effective from 1st April 2010)

- (a) The EPO examination starts at the search stage. The search report is accompanied by a search opinion. As a general rule, the opinion should cover **all** objections to the application. (There are exceptions that will lead to a more limited or generalised opinion, e.g., if the application is generally deficient, or there are fundamental objections such as lack of novelty or an international application entering the European phase has been substantially amended to add subject matter or render the claims unclear.)
- (b) For each objection, the search opinion should indicate the part of the application which is deficient and the requirement of the EPC that has not been met. Substantive matters will normally be set out first.
- (c) If the application is to proceed to the substantive examination stage, the applicant must respond to this opinion, within the time limit for requesting examination, either by amendment, filing observations, or both, unless the search opinion is positive (i.e., the application is acceptable).
- (d) The substantive examiner, when considering the amended application and observations, should proceed as in (a) and (b), i.e., as a general rule he or she should raise all outstanding objections, in a detailed way, in the first written communication.
- (e) The applicant replies to the examiner's objections by amendment, observation or both.
- (f) If examination of the applicant's reply shows that there are good prospects of bringing proceedings to a positive conclusion, the examiner must decide whether to issue a further communication, invite the applicant to interview or have a telephone discussion.
- (g) If no positive reaction is to be expected and provided that the applicant has had the opportunity to be heard, the examiner should recommend refusal to the examining division.

IP Federation members 2011

The IP Federation (formerly TMPDF), represents the views of UK industry in both IPR policy and practice matters within the EU, the UK and internationally. Its membership comprises the innovative and influential companies listed below. It is listed on the European Commission's register of interest representatives with identity no: 83549331760-12.

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