

Subject: Initial comments on Procedural efficiency

By: *epi*

To: EPO, Chair of Administrative Council, Chair of Committee on Patent Law (CPL),
CPL Member State Delegations, National IP Associations in the EPC Member
States

Summary: The Procedural efficiency paper provides an overview of measures, which have
been adopted or planned to be adopted affecting Quality and Efficiency. The paper
does not define quality or efficiency and this is the more pressing since quality and
efficiency do not go hand-in-hand automatically.

epi has studied the various stages of the examination of European patent
applications and patents as to their potential for quality improvement, without
causing significant cost increases. These stages include those addressed in the
Procedural efficiency paper under "NEXT STEPS: RAISING THE BAR – SECOND
BASKET". Our paper gives our initial views on these matters.

Documents: CA/162/09 Procedural efficiency, 23.09.2009

Date: 23.06.2010

The Institute of Professional Representatives before the European Patent Office („*epi*“) came into existence pursuant to the European Patent Convention (EPC) upon provisions adopted by the Administrative Council of the European Patent Organization. The Institute being an international non-governmental public law corporation has its own by-laws and code of professional conduct. At present, the Institute which represents the first all-European patent profession comprises about 9600 members from 37 European countries, both from industry and free profession.

The governing body of the Institute is the *epi* Council which comprises registered European Patent Attorneys from all the states contracting to the European Patent Convention. The senior body within the Council is the Board which comprises a Presidium.

The work of *epi* is mainly the function of thirteen specially elected Committees essential to the representative role *epi* fills with the EPO, the World Intellectual Property Organisation (WIPO), the European Commission and various national institutes and associations.

***epi* Position**

Initial comments to the “Procedural Efficiency” paper CA/162/09

INTRODUCTION

CA/162/09 provides an overview of measures, which have been adopted or planned to be adopted affecting Quality and Efficiency. The paper does not define quality or efficiency and this is the more pressing since quality and efficiency do not go hand-in-hand automatically.

To our understanding, quality has two aspects

Quality of the patents delivered by the system: A high quality patent confers a fair protection for the invention, makes clear to the public the extent of the protection, and clearly discloses to the society all necessary information related to the invention as patented.

Quality of the granting procedure: Good quality is provided if the procedure (1) delivers decisions of high quality based on sound reasoning, and (2) is efficient.

epi is of the opinion that such a procedure requires that:

- all objections to the grant of a patent are presented at the earliest possible stage, in the interest of the applicant or patentee and third parties; this includes novelty and inventive step objections resulting from relevant prior art, as well as clarity, support, sufficiency and formal matters;
- there is an efficient and effective exchange of arguments between the office and the applicant or patentee, and where appropriate third parties, taking into account both the office's and the applicant/patentee's restraints as to timing.

We may also observe, by the way, that there is no direct relationship between quality of patents and objections raised by third parties. A third party only objects to a patent (e.g. by using opposition proceedings) because it is hindered by the patent, not because it is of poor quality.

With these considerations in mind, *epi* has studied the various stages of the examination of European patent applications and patents as to their potential for quality improvement, without causing significant cost increases. These stages include those addressed in the EPO paper under “NEXT STEPS: RAISING THE BAR – SECOND BASKET”.

Single opportunity for filing amendments [Rule 137(3)]

There is no fundamental objection against allowing, as a general rule, a single opportunity for filing amendments on applicant's own volition, and that further amendments are only allowed if they clearly address objections made by the examiner. Indeed, this has been the rule all the time.

However, a prerequisite is that at the time of the first (and then only) opportunity, the applicant should have been made aware of all objections that would prevent the allowance of the application. This means that the written opinion accompanying the search report, or the comparable opinion from the PCT procedure, should be complete. Under the current practice, this is not always the case. In this respect, *epi* is concerned about a proposal (CA/PL 7/10) to amend Rule 71(2) in such a manner that it would no longer be required to mention all the grounds against the grant of the European patent in a communication under Article 94, paragraph 3.

Thus, in cases where the office chooses, perhaps for good reasons such as non-unity objections, not to deal with all the requirements of the EPC at the same time, this automatically implies a further opportunity to amend when the office comes up with further objections.

Importantly, an amendment which serves to overcome all objections should always be allowed, as ruled by G 7/93 and T 375/90.

In conclusion, further opportunities to amend should continue to be allowed as prescribed by Art 94(3) EPC, particularly when new objections are raised by the examining division.

Auxiliary Requests

Auxiliary requests are an effective means of short-cutting discussions between examining or opposition division and the applicant/patentee. Of course, the number should be reasonable under the circumstances. The practice of auxiliary requests is based on the principle of Art 113(2) EPC, ruling that the office can only decide on texts submitted (or agreed) by the applicant/patentee.

Rigorous application of this principle implies that the applicant/patentee has to submit a distinct auxiliary request for each issue or claim or combination of issues under discussion. Should the office adopt a practice to give substantiated opinions on individual claims, this would reduce the need for auxiliary requests. Such a practice could increase efficiency, especially in examination proceedings.

Observations by third parties (Art 115)

epi agrees that quality of granted patents can be improved by taking into account observations made by third parties. Under the current practice, the examining division often appears to ignore observations by third parties, and this practice discourages third parties to file such observations. We therefore propose – as it has done in its paper reported in SACEPO/WPR 8/09 – to make it mandatory for an examining division to take into account third party observations. This could mean an obligation to the examiner to comment in writing on whether the third party observations preclude the grant of a patent.

Preparation to oral proceedings

We welcome initiatives to shorten the duration of the procedure of oral proceedings. Much can be gained, especially in opposition proceedings, if the time between the response of the patentee and the office's response – be it a preliminary opinion or summons or both – is shortened.

Number of communications in examination

Here, the same applies as with allowing further amendments. It is noted that the average of 1.25 non-automated examination communications per final action as reported in CA/162/09 is not a bad score, and that with the introduction of Rule 70a/161 it will further decrease. Further reduction of the number of non-automated (written) communications, without lowering quality, can only be achieved when communication between examiner and applicant is enhanced, e.g. by using more telephone consultations. In many cases, this will allow a better mutual understanding of the views at both ends, allowing a swifter conclusion of the examining procedure.

As a side note, *epi* feels that denying the applicant a reasonable further opportunity for comment will lead to an increased number of oral proceedings and/or appeals, both of which are undesirable from an efficiency point of view. As a matter of fact, a further communication is not necessarily a great burden in effort or time, as it will deal with a limited number of issues, taking a few months only.

Finally, any compacting of the proceedings may never compromise the primary and non-negotiable task of the system to produce high quality patents.

Manual of Best Practice

The EPO and *epi* are discussing the EPO initiative for the provision of a Manual of Best Practice. *epi* has presented its views, and will present further views on the feasibility and value of such a Manual for applicants.

Language provisions in oral proceedings

epi agrees that unwarranted interpretation costs should be avoided. This includes the situation where simultaneous interpretation is requested, but eventually it is not used by the requesting party. This may happen when at a late stage the party decides not to attend the proceedings or to change the representation. We have already urged its members to minimise such situations, and where inevitable, to notify the office as soon as possible, and we will continue to do so. We also note that, where the office is of the opinion that the conduct of a representative is questionable in this respect, the disciplinary mechanisms of *epi* are open.

This all applies to *inter partes* proceedings. For *ex parte* proceedings, *epi* expects no problems, as the divisions and Boards are able and have shown to be willing to use any one of the EPO official languages in oral proceedings.