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Ausschuss für Europäische Patentpraxis
European Patent Practice Committee
Commission pour la Pratique du Brevet Européen

26th February, 2018

SACEPO WP on guidelines

Note in respect of EPC and PCT Guidelines and the revision cycle

Introduction

At the 15th SACEPO WP on GL we were informed by the EPO

- that It is not possible to change the revision cycle of the EPC and PCT guidelines, and
- that introduction of new procedures would always have been discussed at the SACEPO WP on Rules and would therefore not be discussed at a late stage in the SACEPO WP on GL.

Hence, we can conclude that the 16th SACEPO WP on GL for discussing changes to the 2018 Guidelines will take place after the 2018 Guidelines have entered into force on 1 November 2018.

Therefore, we wish to express our opinion on a few important aspects, which may or may not be included in the 2018 Guidelines at this early stage to ensure that the EPO has sufficient time to take our opinion into consideration.

Revision cycle

The epi is of the opinion that the revision cycle can be improved. This improvement may for example include one or more of the following changes:

The SACEPO WP on GL meeting can be held in September/October.

The amended Guidelines can enter into force later than 1st November, for example 1st January or preferably 1st April.

The EPO can send draft amendments to the Guidelines earlier than late June, for example April.



The EPO can send preliminary draft amendments to selected parts of the Guidelines already in January or February or even earlier.

We think that a combination of the above changes will be preferred.

In particular, we request the EPO to send preliminary draft amendments to selected parts of the Guidelines as early as possible. We know that the EPO starts working on selected parts of the Guidelines in the autumn immediately after the introduction of the previous version of the Guidelines and that such preliminary draft amendments are available and are discussed internally at the EPO in December and January. We believe that it would be beneficial for both the EPO and its users that these preliminary drafts would be available to representatives of the epi and Business Europe. Please observe that we as users are considering different aspects and consequences of changed, added or deleted wordings and/or procedures than the EPO and that our combined effort therefore will ensure more complete and improved Guidelines.

We ask the EPO to consider our above proposals.

Issuing Summons to OP as first action in examination

At the 15th SACEPO WP on GL, we discussed the introduced amendments relating to “*issuing summons to OP as first action*”.

The EPO stressed that this point had already been discussed at the SACEPO WPR and that it was not open for general discussion, but the EPO would discuss internally if a rewording would be appropriate.

We wish to stress that the majority of the epi members find it unreasonable and unacceptable to issue summons to OP as the first action.

The proceedings at the EPO are as a general rule written proceedings. According to Article 94(3) EPC, the **Examining Division** shall invite the applicant as often as necessary to file observations and amendments if the examination reveals that the application or the invention to which it relates does not meet the requirements of the EPC.

Hence, if the **Examining Division** finds that the application does not meet one or more requirement of the EPC, the **Examining Division** must send at least one communication under Article 94(3).

Thus, issuing summons to OP as the first action in examination violates Article 94(3). EPC.

In addition, we cannot see why it would be difficult for the EPO to set out the reasons for non-compliance with the EPC and explicitly state that the next action will be an invitation to oral proceedings unless the response by the applicant shows progress towards grant.

If the EPO maintains the option of issuing summons to OP as the first action, at least the following conditions should be explicitly stated in the EPC Guidelines:

- a) Issuing summons to OP as the first action in examination should only be applied if the applicant approves – e.g. an approval by phone.
- b) Issuing summons to OP as the first action in examination should only be applied in case of real deadlock and the possible causes of such a deadlock should be defined.

The “deadlock” must not be limited to certain technical areas but could, for example, be a situation where a divisional application is examined and it has essentially the same problems as a parent application, for which several communications under Article 94(3) have been sent.

Using a telephone interview as first action in examination

We note that the option of using a telephone interview as the first action in examination was also discussed at the 15th SACEPO WPR.

In principle, the epi welcomes using telephone interview as the first action in examination, provided that the subsequent action is a communication under Article 94(3) EPC or a communication under Rule 71(3).

The applicant must have at least one communication under Article 94(3) EPC unless the first action in examination is a communication under Rule 71(3).

The PCT-EPO Guidelines and references to the Euro-PCT Guide

We have several times objected to references to the Euro-PCT Guide in the PCTEPO Guidelines.

The PCT-EPO Guidelines are Guidelines for Search and Examination at the EPO as PCT Authority give instructions on the practice and procedure to be followed in various aspects of the handling of international applications before the EPO as International Searching Authority and International Preliminary Examining Authority.

In the preliminary remarks of the PCT-EPO Guidelines it is stated that:



“These Guidelines can be used and referred to by examiners and formalities officers, as well as patent attorneys, in addition to the Euro-PCT Guide They will exist in parallel with the Euro-PCT Guide which, as before, **has the status of a Notice from the EPO** (emphasis added).”

This contradicts the statement on the EPO website in respect of the Euro-PCT Guide:

“The Euro-PCT Guide is of a summary nature. It gives an overview of the procedures under the PCT before the EPO, including entry into the European phase before the EPO as designated/elected Office.”

Thus, the PCT-EPO Guidelines explicitly have official status, whereas the status of the Euro-PCT Guide is highly doubtful and further it is a guide for applicants – not examiners.

In view of this, we find it incorrect to have references in the PCT-EPO Guidelines to the Euro-PCT Guide.

We understand that it is practical to have the valid text only at one location, so that any risk of having contradictory text passages is reduced. However, the correct way of doing this is to have the full text in the PCT-EPO Guidelines and have references to the PCT-EPO Guidelines at relevant locations of the Euro-PCT Guide.

We appreciate the EPOs attempt to reduce the number of references and we understand that it will take time to complete the PCT-EPO Guidelines. However, we think that the ultimate goal should be to make the PCT-EPO Guidelines as comprehensive as possible without references to the Euro-PCT Guide. The EuroPCT Guide has the purpose of guiding applicants and there it would be appropriate to have references to the PCT-EPO Guidelines.

We hope that the EPO will consider our above opinions and proposals and that they will be reflected in the amendments of the 2018 EPC guidelines and PCT-EPO Guidelines.