

## **SACEPO WORKING PARTY ON RULES**

### **Summary of conclusions of the 20<sup>th</sup> meeting held on 17 January 2019**

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#### **I. Opening and adoption of the agenda [SACEPO/WPR 1/19]**

The Chair Heli Pihlajamaa welcomed all 9 members of the Working Party on Rules present for this meeting as well as EPO participants. The full list of participants is enclosed as Annex 1. There were lively and constructive exchanges on all agenda points throughout the meeting, and SACEPO members welcomed this first opportunity to present ideas to simplify procedures.

The provisional agenda was adopted and is enclosed as Annex 2.

#### **II. Agenda point on Notification by postal services – Rules 126 EPC [SACEPO WPR 2/19]**

The Office presented the proposal to abolish the notification by registered letter with advice of delivery.

In general, SACEPO members expressed their support for the proposal, finding that it was a good measure considering the current inefficiencies in the area.

The Office took note of a comment from epi on the tracking of registered letter to be used in the assessment of successful notification. It was explained that the Office had explored this possibility in the past. However, tracking of notifications by registered letter cannot be adopted as an automatic means and therefore is only used for individual postal investigations, for instance if delivery is disputed.

The members of SACEPO commented that the proposed abolishment of advice of delivery does not in principle affect them, because they are increasingly using electronic notifications. They also noted that the Mailbox system is not widely used yet and asked for improvements enhancing its flexibility and providing an easier management (such as finding solutions to have more than one account). It was stressed that such improvements could encourage more users to move to use electronic notification.

#### **III. Agenda point on Simplification of procedures [SACEPO WPR 3/19]**

The EPO presented the aim of the Simplification of procedures initiative, explaining the 3 main pillars or goals on which the focus is put. Building on the preliminary

discussions which took place at the last meeting of the SACEPO Working Party Rules on 22.10.2018, the EPO provided further examples of changes or improvements in the procedure that would support these goals (e.g. precise indication in all Office communications of the date by which a reply has to be filed, or revision of the procedure applicable to amendments filed upon entry into the European phase to make it more efficient).

Before starting the discussions on the proposals submitted by SACEPO members in advance of the meeting, the Chair made clear that proposals requiring amendments of Articles of the EPC would be considered outside the scope of the current simplification/streamlining project. Likewise, discussions on any consequence to TBoA decision T 1063/18 were referred to the upcoming meeting of the SACEPO Working Party on Guidelines on 22.2.20.9.

Thereafter, the proposals submitted by the SACEPO members in advance of the meeting were reviewed one by one (see Annex 3: List of proposals presented by members of SACEPO Working Party Rules). These proposals touch different aspects of the procedure at the EPO, ranging from improvements to the electronic filing and processing of applications to suggestions aimed at increasing the efficiency of some procedures or at making them more transparent. Another series of proposals are related to the structure of the fees and the need to rethink some of its elements.

The EPO thanked the users for the valuable input and the fruitful discussions. It was noted that the input received shows that the EPO is going in the right direction, as the users are making many proposals similar to those which have been included in the Simplification/Streamlining project.

As a number of proposals made by SACEPO members concerned online tools and future means of electronic communications, it was agreed that these proposals should be discussed at the meeting of the SACEPO Working Party on e-Patent-Process on 30.1.2019 – where also epi and BusinessEurope are represented. In general, SACEPO members expressed their appreciation of the efforts the EPO to invest in this initiative and showed high interest in being further involved. They suggested that smaller groups including the members of SACEPO Working Party on Rules could be put in place to support the project on an *ad hoc* basis.

On a specific proposal from epi re. improvements to the Patent Register, it was noted by SACEPO members that the European Patent Register, which was one of the first worldwide to give internet access to files relating to European patent applications and European patents, has come to its limits. Amended – in particular intensified electronic – working methods on the users' side would require a complete new set-up based on today's standards. SACEPO members appreciate that the Office has already started to work on making the information easier accessible, but

would favour a system using latest technology and features supporting working in an electronic environment.

On epi's request for a follow-up on bulks requests, the Office reacted to the detailed examples provided by epi. Most of the comments are to be considered as reasonable and very interesting. Some of these are the subject of initiatives already taken up by the Office (e.g. standardised forms for requests of registration of transfers, declaration of assignment and structure of fees) or will be part of the revision of the current IT-system (improvement of "UFO", visibility of information in the European Patent Register). Others will have to be discussed in more depth (e.g. history of modification, rules and guidance regarding owner details). It was stated that the implementation of some of these proposals will only be possible within the framework of a major revision of the IT-system. With regard to the suggestion that the Office should provide (patent)-application portfolios to the parties, the Office took a reluctant position for reasons of possible liabilities. It was agreed with epi that further exchange of opinions and clarification will take place. An additional aspect which can be derived from the general debate on the European Patent Register might be that the overall purpose and the features of the Register should be analysed from scratch.

#### **IV. Agenda point on Opposition and accelerations [Oral report]**

The Office informed SACEPO members about the effects of the measures taken since 2016 to streamline opposition proceedings. It was emphasised in particular that the average duration of opposition proceedings has been shortened by nine months to 20.4 months.

SACEPO members welcomed the information and expressed their satisfaction with both the recent measures and the progress achieved so far. It was stressed that the additional means available since 2008 to accelerated opposition in case an infringement action is pending before a national court of an EPC contracting state is sufficient. Regarding the possibility to request acceleration, SACEPO members did not see any need to allow 3<sup>rd</sup> parties to request acceleration. They stressed that it suffices that the parties to proceedings may request it or proceedings are accelerated upon information by the national court of the contracting state where infringement proceedings have been instituted.

A further discussion arose about the impact of the future Rules of proceedings of the Boards of Appeal for the opposition proceedings. SACEPO members made some useful and some controversial proposals. The Office stated that it will return to the topic in a future meeting.

**V. Any other business: Update on DOCX]**

epi enquired about the developments in the XML project. The Office explained that work is ongoing and good progress is being made. An update would be given to users at the SACEPO Working Party on e-Patent-Process on 30.1.2019. An OJ Notice explaining the decision of the AC on the fees will be issues soon, highlighting the application of the change in the filing fee for applications not filed online.

## **Annex 1**

### **List of Participants**

#### **I. Members of SACEPO Working Party on Rules**

Mr Francesco MACCHETTA (BusinessEurope)

Mr Scott ROBERTS (BusinessEurope)

Mr Leo STEENBEEK (BusinessEurope)

Ms Marjut HONKASALO (epi)

Mr Chris MERCER (epi)

Mr Martin WILMING (epi)

Mr Felix HERMMANN (ad personam member)

Mr Antonio PIZZOLI (ad personam member)

Mr Markku SIMMELVUO (ad personam member)

#### **II. EPO Representatives**

DG 1            Mr John BEATTY  
                  Mr Giuseppe FIORANI

DG 5            Ms Heli PIHLAJAMAA  
                  Mr Hans-Christian HAUGG  
                  Ms Laurence BRÜNING–PETIT  
                  Ms Doris THUMS  
                  Ms Anna BACCHIN

## **Annex 2**

### **Final agenda**

#### **20<sup>th</sup> meeting of SACEPO Working Party on Rules Munich, 17 January 2019**

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|---|-----------------|
| 1. Opening and adoption of the agenda             | SACEPO/WPR 1/19 |
| 2. Notification by postal services – Rule 126 EPC | SACEPO/WPR 2/19 |
| 3. Simplification of procedures                   | SACEPO/WPR 3/19 |
| 4. Opposition and accelerations                   | Oral report     |
| 5. Any other business                             |                 |
| - Update on DOCX                                  |                 |

## Annex 3

### List of proposals presented by members of SACEPO Working Party Rules

#### Proposals presented by epi

##### Overview:

1. Reliable, easy-to-use online system
2. Update the definition of what is the text of the patent as approved by applicant and on what the decision to grant is based
3. Improve Patent Register for users
4. Update possibility to file amended claims to reflect the way search and examination are brought together
5. Fee-related simplifications
6. Follow up on bulk requests

1. The most important is to have a reliable, easy-to-use online system that is consistent with other online services, such as WIPO. However, the online system falls within the remit of e-SACEPO.

##### 2. Update the definition of what is the text of the patent as approved by applicant and on what the decision to grant is based:

R71(3) waiver: G1/10 and EDREX problems mean that it is very risky to use the waiver and waivers should thus be actively discouraged. (We want to maintain the flexibility to propose amendments when responding to R71(3) and not using a waiver is not an abuse of the process.)

The risk could be at least minimized by updating the definition of what is the text of the patent as approved by applicant. One way is to update the Notice from the European Patent Office dated 8 June 2015 concerning the possibility to waive the right to a further communication under Rule 71(3) EPC (<https://www.epo.org/law-practice/legal-texts/official-journal/2015/06/a52.html>). For example, point 9 could be amended to exclude errors/amendments that are introduced after the applicant's response to the Rule 71(3) Communication and to treat them as errors caused by tools and, if applicant's amendments require examiner amendments, they should be agreed with the applicant, possibly by use of emails or a telephone call.

##### 3. Improve Patent Register for users

It could be considered whether it is necessary to have all parts of all documents as individual documents. For example, in an opposition having 2 opponents, the 3 summons to oral proceedings and confirmations of receipt could all be in one document. Similarly, EPO Communications and the annex thereto could be one single document. In opposition proceedings, the decision and the reasons could be one document.

Further, the notice of opposition could be replaced by an alert to the patentee and a combined notice of opposition sent when the opposition period has ended, the combined notice having in the register the alerts as attachments.

There should be no delay in uploading documents to the Patent Register, especially if online systems are used.

#### 4. Update possibility to file amended claims to reflect the way search and examination are brought together

Provide possibility to file an amended set of claims in response to the Rule 63 Communication or at least a possibility to discuss with the examiner on whether a certain clarification/statement is such that the examiner can properly perform the search. The rest of the process would then run more smoothly.

#### 5. Fee-related simplifications

- fee **simplification** should be one aim of the review, to reduce the scope for error requiring corrective administrative action and to reduce the number of dates that the applicant needs to docket and the Office needs to monitor. Examples of suggestions (for development further in committee) include:
  - for further processing fees - moving to a system where one fee can cover multiple procedural acts if within the time limit for each act, thereby simplifying both fee calculation and administration as there would be a lower chance for error;
  - for back renewal fees on a divisional application, postponing the due date for paying back renewal fees to the deadline for response to the search opinion – thereby reducing docketing costs and lowering the up-front costs to applicants, while minimising the risk of adverse incentives that could result from an abolition of back renewal fees. Such an approach may also lead to divisional applications being filed that are currently deterred by the current procedure. As the grant rate for divisional applications is higher than the grant rate for first filings, this seems a sensible option.
- fee reduction, and in some cases abolition, at least for fees with no attached service and with a view to reducing the scope for error requiring corrective administrative action. Examples of suggestions (for further development) include:
  - abolishing renewal fees for applications beyond the 15th year – any application beyond its 15<sup>th</sup> year represents a failure of efficient processing in the Office
  - abolishing the third annuity with perhaps redistribution of fees to later annuities – the annuity that results in the greatest number of errors and administrative burden to the Office is the 3<sup>rd</sup> annuity as it falls so soon after entry into the regional phase of PCT applications.
  - abolishing the designation fee and wrapping it into the examination fee – the designation fee attracts no specific service but represents an opportunity for an applicant to miss the fee with consequent cost. Including it in the examination fee would represent no change in EPO income but would reduce the opportunity for error and subsequent administrative correction.
  - reduce the fee for the late payment of renewal fees to 25% rather than the 50 % of fees as currently applies.



- reduce the fee for further processing to 25% with a maximum of €X (EUIPO have a maximum of €1500 for late payment of renewal fees) rather than the 50 % of fees as currently applies.
- a review of the fee structure generally to ascertain its effect on demand and production, and hence on the EPO's finances, would be desirable. The current fee structure represents a slow development of a structure geared to old law and includes "useless" items such as the designation fee.
- integrating the Register with fee payment so that the Register indicates outstanding fees and amounts, and so that users have the option of paying such fees electronically through the Register if appropriate. Such an approach would minimise the risk of double payment.

#### 6. Follow up on bulk requests

## **Proposals presented by BusinessEurope**

- The use of emails must now become an accepted mode of communication between applicants/representatives and the Office. Emails can be instantly entered into the register for transparency. Preferably a redaction of email addresses takes place before such entry in the register.
- Electronic notification is currently available though it is an all-or-nothing option. No paper copy is currently sent where electronic notification is adopted by a representative. Many applicants and firms still depend on paper copies and the option to receive electronic notification in addition to paper copies, at least as a transitional measure towards an entirely electronic case management system, would be beneficial.
- The notification of communications by attachment to an email, preferably in addition to paper copy, would be similarly beneficial. For example, in the case where the receiving section determines it cannot accord a date of filing, the immediate communication of such determination by email would permit applicants to rectify in the shortest possible timeframe so securing the earliest filing date possible.
- Telephone interviews between applicants/representatives and examiners could be enhanced by readily available technology such as Skype for Business or the like. Using such communication aids, documents can be shared and edited efficiently during telephone communications. Further, the addition of email communication permits the potential instantaneous dispatch of communications and responses. Examination is at its most efficient when both the applicant and examiner have the application fresh in their minds (this is clearly seen during, for example, examination oral proceedings). This freshness and currency of familiarity with an application during telephone interviews should be exploited by such efficient communication.
- The storage of documents in text-searchable format on the Register would provide the opportunity to search application documents including, for example, search and examination reports, claim features, applicant responses, citations and the like. This would provide a valuable facility for applicants and further improves transparency for third parties.
- Where application documents are filed and stored in an editable file format (such as the XML file format), such documents could be edited within cloud-hosted editing software such as cloud versions of word processors or the like, commonly available to both the examiners and applicants and preferably hosted by, or on behalf of, the Office. This would provide for the collaborative editing of application documents within a web-browser including recording of full change-history, comments and markups in a transparent and efficient manner. The benefit here is that there would never be a need for conversion or synchronization of application documents between the Office and the applicant, all changes are automatically identified and recorded, the entire change history is meticulously stored in a searchable manner, the communication of amendments can be effected instantaneously and the entire procedure is visible to third parties (who

- can access the document in a non-editable manner).
- To simplify the transition to an efficient electronic grant process, the adoption of common technologies would be preferred rather than seeking to accommodate a wide range of possible technologies. Potential incompatibilities present problems. E.g. the inclusion of mathematical or chemical formulae in specification documents is not problematic if all parties (applicants and the Office) use the same software.

## **Proposals presented by an ad personam member**

- A. **Article amendments (long term – strategic)**
  - 1. Art. 4 and 4a EPC (judicial independence of the BoA)
  - 2. Art. 52 EPC (introduction of a 12 months grace period without compulsory declaration)
  - 3. Art. 64 EPC (introduction of prior user rights needed for the grace period)
- B. **Rule amendments**
  - 1. Deletion of Rule 19(3,4) EPC (communication to inventors)
  - 2. Deletion of Rule 28(2) EPC (essentially biological process)
  - 3. Amendment of Rules 42(1)(b)/50(1) EPC (no new citation of prior art in the description)
  - 4. Deletion of Rule 141 EPC (duty of disclosure)
- C. **Examination streamlining**
  - 1. Deferred examination only with sufficient safeguards for public and third parties
  - 2. Review of Rule 161 EPC (removal of “downtime”)
  - 3. Time limits also for the EPO (e.g. 4/6 months for 2nd and further 94(3) communications)
  - 4. Precise time limits in the EPO communications
- D. **Electronic communications**
  - 1. EPO Mailbox available also for ISA/IPEA, opposition and appeal communications
  - 2. Exchange (both ways) of documents in DOCX format (e.g. in 71(3) communications)
  - 3. Email (informal) notifications with link when a new EPO communication is issued
  - 4. Videoconferences always available for ex-parte oral proceedings
- E. **Fee reductions**
  - 1. Reduction (by 50%?) of the appeal fee for ex-parte (examination) appeals
  - 2. Reduction (to 50 EUR?) of the claims fee
- F. **Unitary patent**
  - 1. Increase (to 1700 EUR) of the (500 EUR) compensation for small entities under Art. 11 UPP
  - 2. Amendment of Art. 5(2) UPP (no unitary patent for different proprietors in different UP states)