

JETRO seminar

Recent Rule change and latest developments at the EPO:

Alfred Spigarelli
Director Patent procedures management
DG1 Business services
EPO

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Overview

- RAISING THE BAR 1st basket
 - What, why and how?
 - Inventive step
 - Procedural changes
 - Overview
 - Scope of search R. 62a and 63
- DIVISIONAL APPLICATIONS R. 36
- RAISING THE BAR 2nd basket
- Collaborative Search & Examination project

Raising the Bar 1st basket



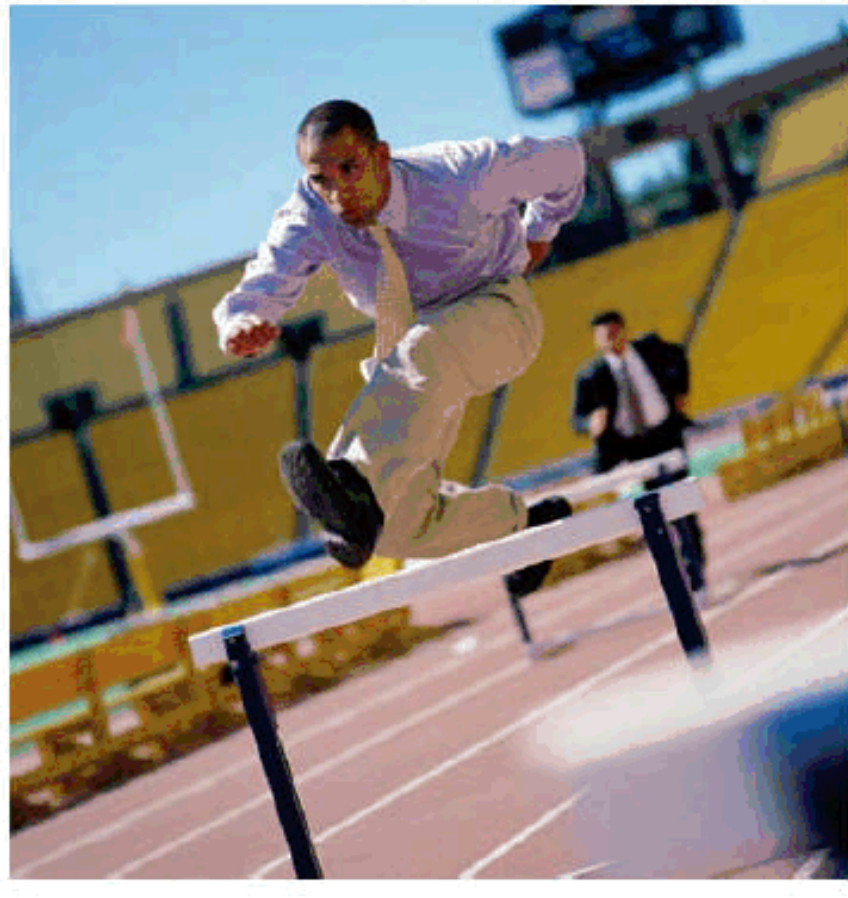
Meaning of Raising the Bar

- Definitely not this:



Meaning of Raising the Bar

- But more this:



Why Raising the Bar?

- Originally, the idea of "raising the bar" arose out of criticism of the assessment of inventive step at the EPO, in particular the definition of the role of the skilled person was highlighted.
- Very early it has also been recognised that inventive step is not the only area where the bar could be raised.
- Therefore the mandate of the domain was extended to:
 - the promotion of proposals intended to reinforce European patenting standards,
 - incite applicants to respect the European form of drafting applications and
 - foster the cooperation of applicants with the examiners so that each takes their due responsibility in the patent grant process.

How to raise the bar?

- The concept followed is that:
 - **better drafted applications** filed at the EPO enables
 - **more focus on the assessment of the patentability** of claimed inventions which in turn has
 - **a positive impact on the standards** of granted patents.
- The goal being to come back to the basic principle that: patents are only granted for innovations with sufficient inventive merit meeting needs of "society".

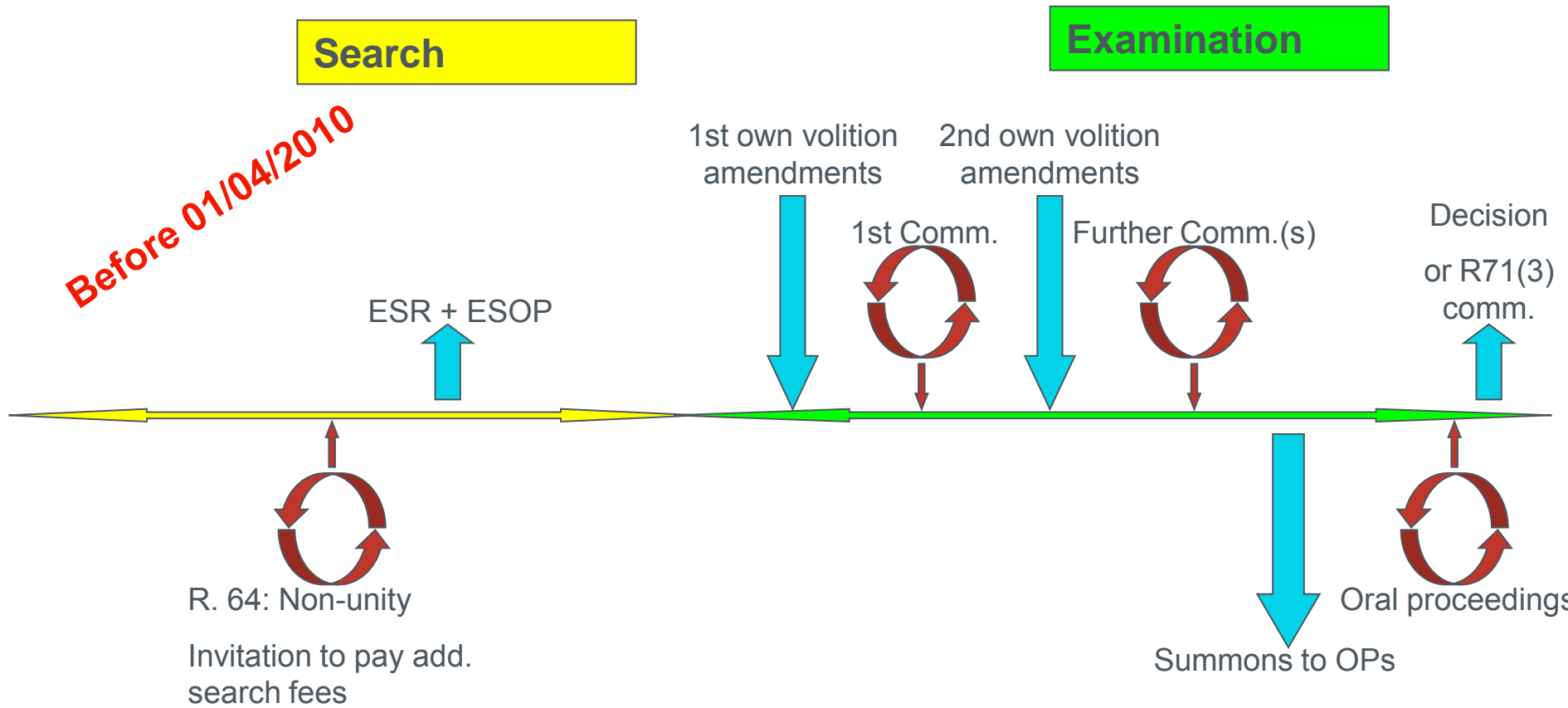
Inventive step

- No changes to the EPC
- No changes to current practice

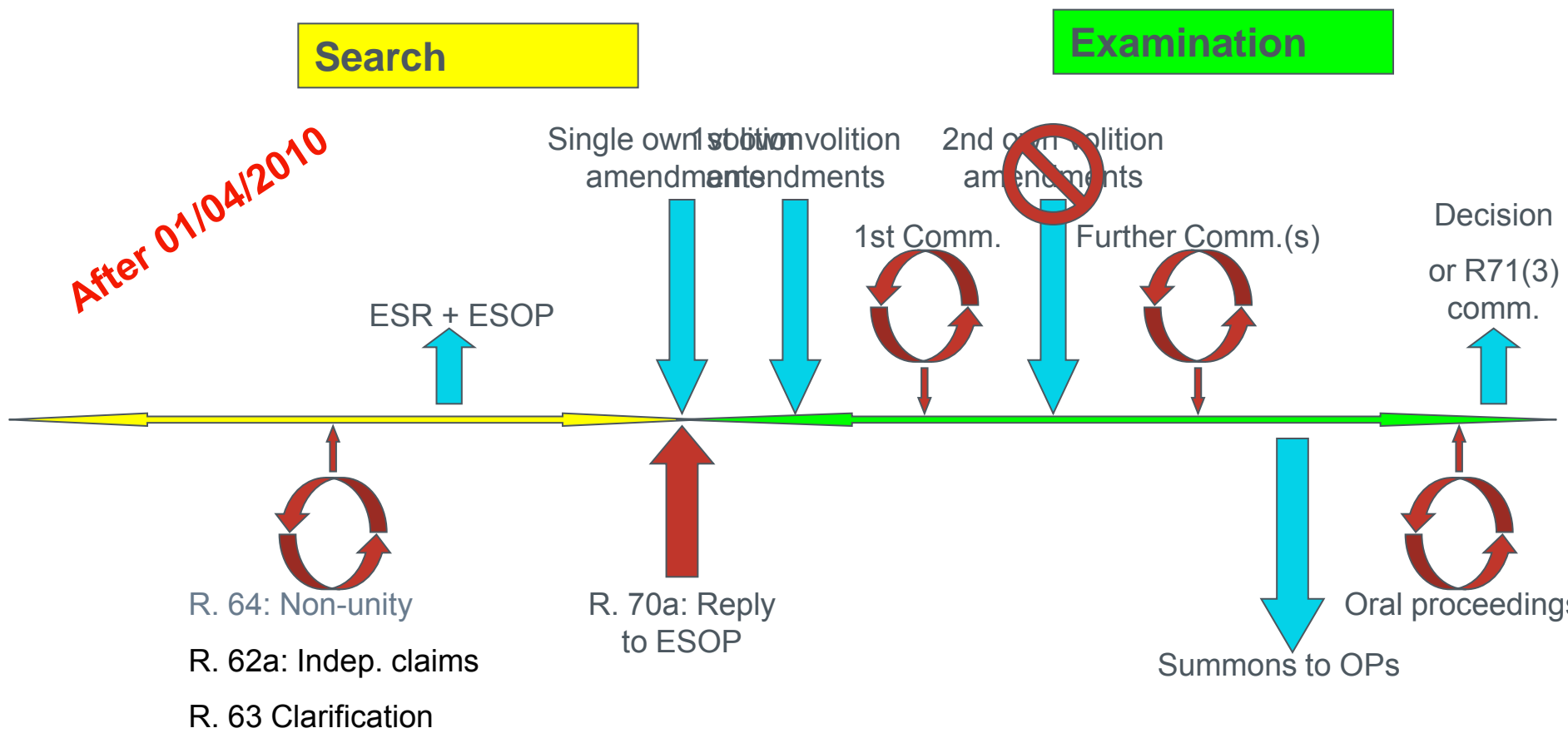
Inventive step

- Amended guidelines based on case law for reflecting current best practice:
 - Definition of the skilled person
 - State of the art may reside in common general knowledge
 - Problem solution approach to be applied
 - Technical effect to be credibly achieved over substantially the whole range claimed
 - Could-would approach: incentive or prompting may be implicit
 - Reference to "problem inventions" removed

Raising the bar 1st basket



Raising the bar 1st basket



R. 137(5) } Limitation to searched object when pre-search comm. issued

R. 137(4) } Identification of amendments and indication of their basis

R. 36 } Divisional applications can be filed only up to 24 months after 1st comm.

Scope of Search: Overview

- On request of the examiner, applicant to clarify the claims before the search is performed.
 - New rule 62a & amended Rule 63 EPC
- Same principles as for R. 64 (lack of unity)
- Amendments that relate to the subject matter not searched due to application of Rules 62a and 63 EPC not permitted
 - Amended Rule 137 new paragraph 5 EPC

Rule 62a Communication: When?

Requirements of Rule 43 (Paragraph 2) not met

- **One independent claim in the same category** (product, process, apparatus or use)
- **Unless** the subject-matter of the application involves one of the following:
 - (a) a plurality of interrelated products,
 - (b) different uses of a product or apparatus,
 - (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

NOTE: The examiner may make a complete search for all claims and raise an objection under R. 43(2) in the ESOP (C-III, 3.3).

R62a & R137(5): Restriction to searched subject-matter

- R. 137(5): no restriction from examination of subject-matter which is unitary with the originally claimed subject-matter, irrespective of search activity.
- Adding a technical feature to a claim which makes a contribution to the effect(s) of the originally claimed invention(s), and which was expressly not searched but disclosed in the context of the invention in the application as filed will not result in a finding of lack of unity of the amended claim with respect to the originally claimed invention(s).
- Consequently no objection under R. 137(5) should be raised in such circumstances, even though an additional search may be required.

Rule 62a: Reply

- Applicant invited to indicate the claims complying with Rule 43(2) EPC (time period = 2 months)
- Failure to respond in due time
 - Search carried out on the basis of the first claim in each category.
- Claims restricted in examination to searched subject matter - R137(5) unless the examining division finds that the objection was not justified

Rule 63 Communication: When?

- **Meaningful Search?**
- Rule 63 relates only to the extent to which a search can be carried out and not to the possible relevance of its results in later substantive examination
- Search Division to determine.
 - Construe reasonably.
- **Subject-matter excluded from search**
 - Examples:
 - Art 83 / 84
 - (i) claims lacking support; insufficient disclosure
 - (ii) claims lacking conciseness
 - (iii) claims lacking clarity
 - Subject Matter excluded from patentability or not to susceptible to industrial application
- **Search complete or incomplete?**
 - May be complete where all technical aspects have been searched
 - Even if some claims are not directed at patentable subject matter (e.g. method of medical treatment)

Rule 63 Invitation: content

- Invitation may additionally indicate the claimed subject-matter on which the Search Division considers it feasible to base a meaningful search
- Examiner will give the reasons why a meaningful search is not possible in the invitation

Rule 63: Reply

- Applicant invited to file a statement indicating the subject matter to be searched (time period = 2 months)
- Example: indicate part of description (such as specific embodiment) that can be used to interpret claims
- Where possible search based on provided interpretation of the claims
- Failure to respond in due time
 - search procedure = as current R63 practice
 - no search, or a partial search
- Claims restricted in examination to searched subject matter - R137(5)
unless the examining division finds that the objection was not justified

DIVISIONAL APPLICATIONS RULE 36



Filing Requirements for Divisional Applications

Amended Rule 36(1) EPC

- Two requirements which must be met:
 - (i) the application to be divided must be **pending**
 - see (G 1/05, G 1/06 and) **G 1/09**
 - (ii) at least one of the two periods of 24 months mentioned below must not yet have expired:
 - (a) the period for **voluntary** division under Rule 36(1)(a) EPC **or**
 - (b) the period for **mandatory** division under Rule 36(1)(b) EPC, where applicable

New Rule 36 EPC (approved by the AC last week)

European divisional applications

- *(1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that:*
- **(a)** the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication under Article 94, paragraph 3, and Rule 71, paragraph 1 or 2, or Rule 71, paragraph 3, in respect of the earliest application for which a communication has been issued, or
- **(b)**
- **(2)**

Raising the Bar 2nd basket



Raising the Bar 2nd basket

What's next after 1st April 2010:

- **Extension of the RTB 1st package to the PCT:**
 - Mandatory indication of the basis of amendments.
 - Invitation to the applicants to clarify their application before the search
- **Clarify the practice for:**
 - Rule 137(3) - discretionary power to allow amendments
 - Handling auxiliary requests in examination
- **Rule 71 EPC - Revision of the final stage of the examination procedure (approved by the AC last week)**
- **Article 115 EPC - Observation of third parties**
- **Review of roles in the division**
- **Make reasons for grant public (Cancelled)**
- **Rule 141/ Rule 70b: Reutilisation of OFF search results**

**All issues above are under discussion with internal and external users
If consultation outcome is negative on an issue, then it may be dropped**

Extension of RTB to the PCT

- **Clarification of PCT applications before the search - PCT GL 9.34 and 9.35**
 - Same approach as for R. 62a and 63 EPC
 - A communication inviting the applicant to clarify the application will be issued before conducting the international search when necessary]
 - Already in the PCT GL since 2004 but to date only used by JPO, use by EPO planned for April 2011
- **R. 66.8 and 45.6 PCT - Mandatory indication of the basis of amendments.**
 - The new wording of these rules approved by the PCT Assembly in September 2009 provides that the applicant must indicated the basis for the amendments as in R. 137(4) EPC
 - Entry into force on 01/07/2010, use by EPO asap after transmission by WIPO of the corresponding PCT forms

Review of the practice for allowing amendments

Beyond the changes in Rule 137 which entered into force on 01/04/2010, the following will be done:

- R137(3) - clarify practice for the exercise by examiners of the discretionary power to not allow amendments
- Auxiliary requests - clarify the practice as to the allowability of "parallel" sets of requests in examination.

This revision aims more at a clarification of what is the EPO policy based on case law than to change the practice.

Rule 137(3) - Clarify Practice

1. Consent is to be given to:

- corrections of obvious errors (Rule 139)
- reasonable attempts to overcome objections (e.g. amendment further limits the scope of protection sought)

2. Exercise of discretionary power only after:

- an amendment does not address all objections
- consideration of all relevant factors of the specific case
- due account taken to **balance EPO's interest** in bringing the examination to a close in an effective and speedy way **with applicant's interest** in seeking allowable protection for his invention
- opportunity has been given to applicant to comment on reasoning for intention to exercise discretion

Auxiliary Requests - Clarify Practice

Guidance for 3 situations:

1. Convergent

- cascading requests which sequentially further narrow the scope of protection sought

2. Incomplete

- requests which individually do not address all current objections

3. non-convergent

- requests that do not relate to the immediate sequentially higher request in further addressing all the objections raised

Non-convergent requests

- Definition:
 - Original claim 1 not novel
 - Auxiliary request 1: claim 1 + feature a
 - Auxiliary request 2: claim 1 + feature b
 - features a and b not originally claimed
 - Claim 1 +a not unitary with claim 1 +b
 - If both claims would have been in the application as originally filed this would have lead to a non-unity objection and a choice would have been required at the latest in examination
- Responsibility for defining the subject-matter of a patent rests with the applicant
- Take due account of the need to balance overall efficiency of proceedings with applicant's interests

Revision of Rule 71 - Final stage of examination phase

A new Rule 71 is proposed which aims at:

- Reinforcing the streamlining effect of the 2002 reform of R. 51(4) EPC 1973
- Increase legal certainty for applicants and flexibility for the examiners to propose amendments
- Approval of bibliographic data with the text for grant
- Simplify the procedure

A115 - Third Party Observations

Review Office practice under A. 115:

1. Communicate to the public the benefits of making use of Article 115 EPC
 - Official Journal
 - Template for making observations
 - Examples of best practice
2. More transparent processing of third party observations
 - Examiners to indicate how 3PO has been considered when communicating with applicants
3. Incentive for making third party observations
 - Increase internal priority for processing applications after 3PO
 - Maintain strict ex-parte nature of examination

Rules 141 and 70b: Reutilisation of OFF search results

Implementation of new Rule 141/70b:

- New Rule 141 (1) provides that applicants should transmit the search result from the OFF at the filing of the EP application.
- New Rule 70b provides that when this has not been done, then a reminder is sent at the start of examination setting a time limit of 2 months for providing the missing information.
- Rule 141(3) provides that at any time during examination the examining division may request the search results of any office treating the priority application or parallel applications.

IP5

Collaborative Search & Examination pilot project under the PCT

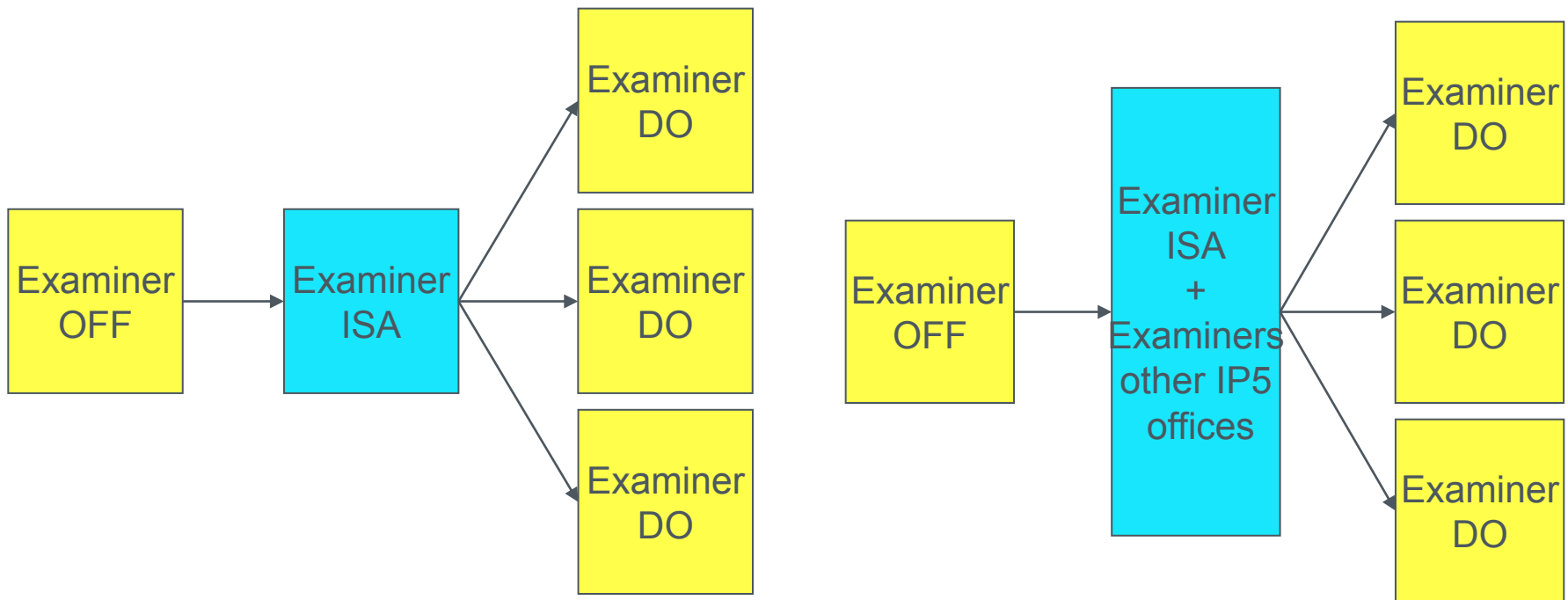


CS&E History

- Original idea came from the industry (IBM)
- First discussion with WIPO in 2008 of a test in the PCT framework
- Introduced in the **PCT roadmap of WIPO** General Director Francis Gurry
- In June 2009 the EPO proposed to launch a pilot project in the IP5 framework for testing the concept of collaborative search on PCT applications.
- A first pilot project on collaborative search and examination under the PCT (CS&E) between the USPTO, the KIPO and the EPO has been concluded between May and September 2010.

CS&E Concept

- Examiners from different authorities in different regions and with different language specialities would work together on one PCT application with the objective to establish a **single common high quality international search report and written opinion.**



Success story

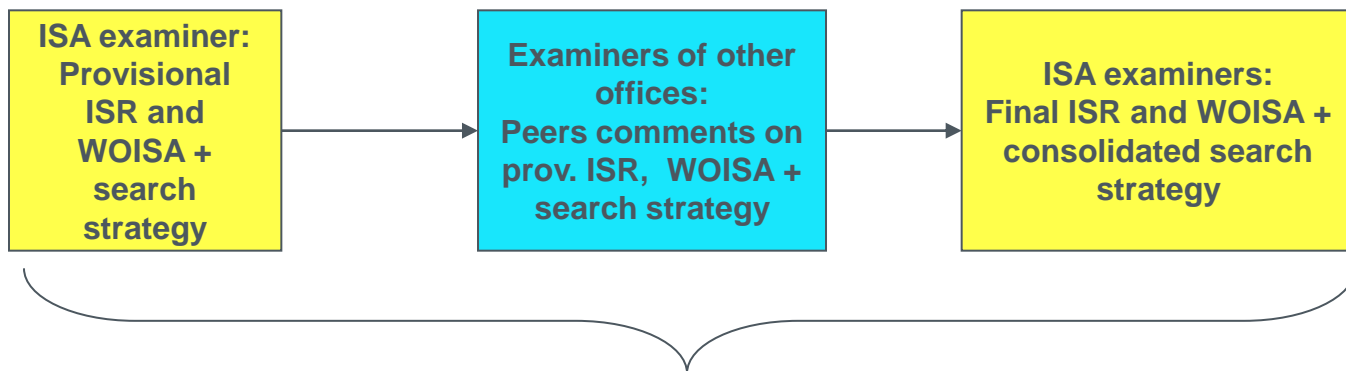
- Small scale pilot project completed by KIPO, USPTO and EPO.
- From May to September the Offices managed to agree on the methodology, the objectives, assumptions and timeline.
- Why is CS&E so interesting ?
 - **Innovative way** of collaboration between the Offices.
 - It is more than **work-sharing: co-production**
 - It addresses quality and efficiency aspects.
 - Highly motivating for examiners
 - Consulted external users look forward to this development.
 - It is part of the **PCT Roadmap** of WIPO General Director

Objectives of pilot phase 1

- Testing the **potential of collaborative work** between examiners of different ISAs for producing the ISR and the WOISA for international applications.
- Defining the **material condition and the methodology** under which examiners of different ISAs in different regions can collaborate on the ISR and the WOISA.
- Evaluating the project achievements in terms of **quality and efficiency**.
- One of the **main assumptions**: to what extent the examiners contributing to the ISR WO-ISA of another office will consider it as being their own product in the national/regional phase.

Methodology & Communication

- Email was the main communication channel, sometimes telephone.
- The objective was not to agree on results, but to deliver complete products:
 - ISR as complete as possible
 - Complete WOISA as long as statements are not self-contradictory



Goal 1 month maximum

Quality and efficiency

- **Quality:** In all the cases the final products have been more complete, which increases their usefulness for applicants. Offices, and third parties:
 - Sometimes additional citations were included.
 - Sometimes not, but discussions provided confidence to examiners about results.
- **Efficiency:** In all cases **no major investment will be required in regional / national phase:**
 - Sometimes full search was performed by peer examiners.
 - Sometimes only partial search or no additional search was needed by peer examiner.

CS&E pilot Phase 2

- CS&E has proven to be a **feasible concept**.
- A **second phase** of the pilot project will be launched in 2011: More files and longer duration.
- Need to **improve methodology** with the lessons learned during phase 1.
- Participating Offices would welcome the involvement of JPO and SIPO in the second phase.

**Thank you for
your attention**

