

EPO Grant Phase

A final stage in the successful prosecution of European patent applications is the issuance by the European Patent Office (EPO) of a Notice of Allowance Communication under Rule 71(3) EPC. In most instances this is good news. However, it is important to pay careful attention to the communication to ensure that what the EPO intends to grant is what the applicant wants.



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The Specification Proposed for Grant

The Notice of Allowance Communication sets out the pages intended for grant, referred to as the “Druckexemplar”. If accepted by the applicant, the Druckexemplar becomes the patent specification and it is that, rather than any later published patent document (the “B-spec”), that is the definitive legal text. Therefore it is essential that that text and drawings are checked carefully.

Examiner Amendments

When issuing a Druckexemplar, the EPO examiner can propose changes. Those changes can vary from minor editorial changes to the description to a wholesale rewriting of the independent claims.

In recent years there have been internal campaigns by the EPO to enhance productivity and dispose of applications in fewer office actions. This has led to a greater tendency for examiners to propose amendments in a Druckexemplar specification in order to rapidly move a case to its conclusion.

It is known for examiners to introduce unsuitable amendments, for example, altering claim scope or introducing subject matter not present in the application as filed. Just because an amendment is proposed by the examiner does not absolve the

applicant of their responsibility to ensure that the specification granted is valid. European patents may be held invalid due to inappropriate amendments introduced by examiners, there being no guarantee that amendments proposed by examiners meet the legal requirements.

EPO Mistakes

The internal procedure the EPO uses to draw up a Druckexemplar specification has recently changed. Whereas in the past, the examiner reviewed a copy of the text on paper and made handwritten annotations, now the specification is reviewed and amended electronically. Subsequent to this change, the number of errors being introduced by EPO examiners has significantly increased.

Druckexemplar specifications proposed for grant frequently include old versions of pages that have been superseded or deleted during prosecution, extraneous content and omissions of elements such as whole pages of text or drawings.

Mistakes on the part of the EPO in the drawing up of the Druckexemplar are common.

As well as reviewing any examiner-introduced changes, it is vital to ensure that the specification described in the Rule 71(3) EPC Communication matches that of the Druckexemplar specification,

reflects the amendments made during prosecution, and is complete.

Disapproving the Specification

In the event that the applicant is not happy with the Druckexemplar specification, a response to the Notice of Allowance Communication should be filed amending the specification proposed for grant and requesting that a new Druckexemplar be issued incorporating those amendments. When this is done, the application is sent back to the examiner to approve the revised specification. If the amendment is approved a new Notice of Allowance Communication and a new Druckexemplar are issued.

In the event that only minor editorial changes are requested by the applicant, it is usual for the examiner to approve the changes thereby disposing of the case. However, where changes are more substantive, e.g. reversing restrictions to the claims proposed by the examiner, substantive examination is reopened and an Examination Report or Summons to Oral Proceedings is issued.

In the past, it used to be possible to point out minor errors to EPO formalities officers and ask them to simply reissue the Notice of Allowance Communication. However, the EPO no longer appears to be willing to make any changes to the Druckexemplar specification once a Notice of Allowance Communication is issued unless the applicant formally disapproves the specification proposed for grant and proposes an alternative.

When disapproving a specification for grant and proposing an alternative, the applicant has the option of completing all the necessary formalities and waiving the right to receive a further Notice of

Allowance Communication under Rule 71(3)EPC, thereby enabling the application to proceed straight to grant if the changes are approved by the examiner. In that event, no further opportunity to review the specification will be provided and if further mistakes are made by the EPO or the EPO misinterprets the applicant's intention, the patent will be granted with errors.

The applicant's ability to make corrections to a patent specification after grant are now restricted to a narrow set of circumstances following Enlarged Board of Appeal decision G 1/10.

Accordingly, we strongly recommend that applicants do not waive the right to a further communication when disapproving a specification. Instead we suggest that the applicant await the issuance of a new Communication enclosing a revised Druckexemplar. The applicant then has an opportunity to check that everything is in order before allowing the application to proceed to grant.

Waiting for the issuance of a further Notice of Allowance Communication to be issued need not substantially delay grant. The applicant can line up the necessary response approving the application for grant (see below) and file it on the day the new Communication is issued, if desired.

Bibliographic details

In addition to enclosing a Druckexemplar specification, the Notice of Allowance Communication under Rule 71(3) EPC sets out the bibliographic details of the intended patent. It is important that those details be checked and any corrections or amendments effected at this stage. Whilst changes to bibliographic information can usually be

made after grant, it is much cheaper and straightforward to do so when responding to the Notice of Allowance Communication.

Designated states

The Notice of Allowance Communication sets out the states covered by the application and which will be available for validation of the resulting European patent. It is important to check that no states are missing and that the EPO has not, for example, inadvertently missed off any extension or validation states that were covered by the European application.

It is also vital to ensure that any states that should not be covered by the granted European patent, e.g. to avoid double patenting, are not included in the list of designated states. Any corrections to the designated states should be effected at this stage because once granted, the legal effect of the designation of the European patent may be irreversible.

Applicant / Patent Proprietor

The Notice of Allowance Communication sets out the names and addresses of the applicant(s). It is important to check those details are correct and up to date. While it is relatively straightforward to update the address of the applicant and record changes of name or assignments centrally at the EPO at this stage, once granted it can be extremely costly and/or time consuming to effect changes in before the patent offices of individual states in which a European patent has been validated. Thus, it is highly recommended that any changes be recorded at this stage rather than waiting until after grant.

Recordal of Changes and Transactions

Registering changes in the applicant centrally at the EPO can be carried out

by filing a copy of a document evidencing the transfer, e.g. a copy of an assignment document, or for changes of name or address by simply requesting the register be updated.

There is no requirement to file original documents, have documents legalised or file certified copies when registering transaction before the EPO and the procedure is often relatively straightforward. The EPO will check the documents and can raise objections to deficiencies setting a deadline for rectifying any deficiencies. Grant will be delayed until they have been rectified or the request to record the change has been withdrawn.

Approving the Application for Grant

Once everything is in order, the applicant needs to approve the specification for grant, file translations of the claims into the other two official languages of the EPO (i.e. French and German when English is the language of proceedings) and pay the official fees.

Once the application is approved for grant it will typically proceed to grant within about 6 weeks assuming everything else is in order, e.g. annuities are up to date. A Decision to Grant notifying the applicant of the grant date should be issued a few weeks in advance of the intended grant date, but on occasion the Decision to Grant goes astray or only arrives shortly before the date of grant.

Divisional Applications

Divisional applications must be filed while the parent application is still pending, i.e. at the latest the day before the date of grant. Thus, a divisional application should ideally be filed at the same time as responding to the Notice of Allowance Communication accepting

the application for grant, or shortly thereafter, to ensure that it is filed in time.

Action to Defer Grant

In the event that the applicant wishes to defer grant of an application, action can be taken to keep the application pending.

Deferring grant may be advantageous for a number of commercial or legal reasons, including allowing for a transaction to be recorded centrally, allowing time to file a divisional application and deferring the costs of validation. Applicants may also wish to defer grant to keep open the option of validating the European patent as a Unitary Patent, which is now expected to come into existence by early 2018 (see below). While there is currently no formal mechanism to postpone grant until after the Unitary Patent has come into effect, the EPO is aware that the new system is attractive to some and is expecting applicants to use delaying tactics keep applications pending until the Unitary Patent is in place.

Some common ways in which grant can be delayed are set out below. Use of a combination of these tactics can be used to delay grant for many months.

Disapproving the Specification

One way of deferring grant can be to disapprove the specification proposed for grant and propose an alternative. When the revised specification is approved by the examiner a further Notice of Allowance Communication is issued setting a further four month term for completing the grant formalities, usually within about two months. Accordingly disapproving the text can be used to defer grant for up to six months.

It is almost always possible to find some non-controversial amendment, e.g. in correcting a typo or changing some formatting, that provides a reason for filing a replacement specification. While it is very unusual for the Examiner to raise objections where the applicant only proposes minor non-controversial amendments, disapproving the text does formally reopen examination and caution should be exercised, for example, where examination has been particularly difficult.

It is not uncommon for an applicant to disapprove the specification proposed for grant more than once, thus postponing grant for 12 months or more. Although there is no restriction on disapproving the specification for grant repeatedly, we would caution against doing so as it risks annoying the examiner and could be considered an abuse of procedure.

Using Further Processing

If the applicant fails to respond to the Notice of Allowance Communication under Rule 71(3) EPC, a Loss of Rights Notification will be issued, typically in about 1-2 months of the deadline being missed. The Loss of Rights Notification sets a further two month term to file the response and pay an additional further processing fee (currently 255 Euro). Thus, making use of further processing will postpone grant for about 3 months.

Non-payment of an Annuity

EPO renewal fees are due annually and can validly be paid, together with a surcharge, in a grace period ending on the last day of the sixth month after that in which the annuity fell due. The EPO will not issue a Decision to Grant on an application for which an annuity is overdue. Thus, deferring to pay an annuity can be used to postpone grant.

The EU Unitary Patent

It is expected that, from very early 2018, it will be possible to validate a European Patent as a Unitary Patent as well as or instead of as individual national patents. Validation as a Unitary Patent will give the European Patent legal effect in a number of participating EU states.

The procedure for validating as a single Unitary Patent will be administered centrally and will be substantially streamlined compared to validating the European patent in each of the individual participating states. A single renewal fee, approximately equivalent to that of four individual states, will be payable to maintain the Unitary Patent in force. The cost of obtaining and maintaining a Unitary Patent will thus be less than validating in multiple individual states and those applicants who routinely validate in more than four EU states may find obtaining a Unitary Patent a cost effective way of maintaining protection in Europe.

More information on the Unitary Patent can be found [here](#).

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