

Streamlining of EPO Procedure

The European Patent Office (EPO) is making significant inroads into its notorious patent examination and opposition backlogs. This has brought its own issues, but applicants can still obtain the patent protection they deserve.



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Background

The patent prosecution process at the EPO has traditionally been relatively slow. Some applications would not be searched and examined for several years and it was not unusual for responses to examination reports (Office Actions) to go unexamined for a year or more. Three or four examination reports would be issued before proceedings were brought to a head, either by allowance of the application or by being called to Oral Proceedings (a hearing). Post-grant opposition proceedings were also very slow and could take many years. Such delays led to uncertainty for all parties involved.

Recent developments – overview

The EPO has taken many positive steps to reduce its patent prosecution backlog, and granted patents are now being obtained more quickly. The EPO is doing this by taking positive steps during the search, examination and opposition stages. The EPO wants to bring prosecution to a conclusion as soon as possible, concentrating on what the applicant, and sometimes the EPO itself, perceives as being the invention. The EPO is becoming far less tolerant of what some may describe as “fishing expeditions” in which applicants make a series of minor claim amendments and/or arguments when responding to Office Actions to see what protection can be obtained. We discuss below our

experience of recent EPO practice and actions that the applicant can take to obtain the patent protection they deserve.

Search practice

The EPO typically performs one thorough search of all the claims it thinks relates to the first-listed invention in a set of claims. The EPO search is directed to a single invention, and if the EPO thinks that the claim set relates to more than one invention, the second and further inventions will not be searched without payment of further search fees. In this connection, the EPO has, particularly when acting as International Search Authority, developed a nasty habit of raising *a posteriori* non-unity objections, in which the claims are deemed to lack unity when taking the prior art into consideration. In those cases, the EPO will only search the first listed invention without the payment of further search fees. Therefore, the order in which subject matter is presented in the claims (both independent and dependent) is important. Preferred dependent claims should be high-up the list of dependent claims to maximise the chance of those claims being searched without having to pay extra search fees. If an independent claim has a feature that may be chosen from a list of options (e.g. in a Markush listing), then we recommend that the preferred options are placed first in the list (even

though such lists are traditionally written in alphabetical order e.g. –NH-, –O-, –S-). If you have an ex-PCT European application and you know that claim 1 lacks novelty, consider amending the claims before the EPO performs the European search.

As of 1st April 2017, if the EPO finds during a search that there is non-unity, then the EPO will issue a preliminary (non-binding) patentability opinion and will invite the applicant to pay further search fees. This new practice is consistent with the EPO’s drive to progress prosecution and to conclude matters as soon as practicable. The EPO now issues a Search Opinion with its Search Report, the Search Opinion being a reasoned statement relating to patentability. This effectively provides the applicant with an extra Office Action, and it is sensible to use this Office Action wisely.

Examination practice

Unlike the US, it is not possible to continue examination by filing a Request for Continued Examination. Applicants should no longer rely on receiving three or four examination reports as part of the examination proceedings before allowance or call to Oral Proceedings. We are seeing more instances of applications being called to Oral Proceedings after only one examination report, and new prior art being cited in Office Actions, with a threat of a Summons to Oral Proceedings if all objections based on the new prior art are not overcome. We have even had one case in which an Office Action was issued, proposing a date for Oral Proceedings in the event

that the objections raised in the Office Action were not overcome. It is therefore becoming far more difficult to “string out” the examination process before making substantive amendments to the claims. Examiners are suggesting possible amendments to claims, which can be helpful, but we have also seen cases in which Examiners have made amendments to the claims unilaterally without seeking the approval of the applicant.

There are several ways in which we can obtain allowance for desirable subject matter and reduce the risk of being called to Oral Proceedings. Applicants should use all opportunities to argue their case and/or amend their claims in a productive manner. Applicants should use the Search Opinion sensibly, making amendments to the claims if appropriate. If your patentability arguments in relation to claim 1 are not strong, then you may wish to consider making patentability arguments in relation to certain preferred dependent claims, giving the examiner a strong clue as to the preferred dependent claims and also making it easier for the Examiner to issue a further Office Action indicating that the dependent claim is allowable.

A further option is to file more than one set of claims for the EPO to consider (filing of multiple “requests”). Historically, some applicants have been reluctant to do this because of a perception that the EPO would only allow the narrowest set of claims. This is not something we have recently experienced.

The EPO is encouraging applicants to consider whether or not to continue with applications by offering a full refund of the examination fee if an application is withdrawn before the start of examination and by offering a 50% refund of the examination fee if an application is withdrawn before the end of the (unextended) deadline for responding to the first Examination Report.

Allowance practice

When the EPO thinks that an application is in order for grant, it issues an allowance communication, accompanied by the text of the application which is allowed. Examiners are being encouraged to get applications to grant quickly, but this has given rise to some practices which are less than satisfactory.

We are seeing cases in which the EPO is making amendments unilaterally without agreement from the applicant and allowing the application based on that amendment. In some cases, the amendment made by the Examiner is acceptable, but some amendments raise problems. For example, we have seen some amendments which arguably add matter and therefore should not be allowed, and may not be correctable post-grant. In this instance, we recommend that the text be disapproved, if possible replacing the “offending” wording with similar wording which is less likely to add subject matter.

Things are more difficult if the examiner’s amendment is directed to subject matter which is of no interest to the applicant; in this case, we can

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disapprove the text, directing the claims to desirable subject matter, but this may lead to a Summons to Oral Proceedings. A further option is to file a divisional application for the desired subject matter, but this is expensive. A more detailed analysis of the allowance and grant procedure may be found in Matthew Fletcher's Newsletter [here](#).

Opposition Practice

The EPO provides an opportunity for third parties to oppose patents by filing an opposition within 9 months of the date of grant of the European patent. The opposition process has, in the past, taken many years.

As of July 2016 the EPO opposition procedure has been streamlined, with a target of 15 months for straightforward cases, from the end of the opposition deadline to the Oral Proceedings. Patentees are now given only 4 months to reply to the opposition, with extensions only being available in exceptional cases. Far fewer extensions are being sought than before, and extensions are only being granted in very limited cases; one should certainly not rely on being able to obtain an extension to the deadline. Some reasons which were acceptable in the past for obtaining an extension (e.g. patentee is a non-European company, and the European attorney has to liaise with another attorney who has to liaise with the patentee) are no longer acceptable. Patentees therefore need to consider the opposition at their earliest convenience.

It appears that the EPO is striving hard to meet the 15 month target. Summons to Oral Proceedings are being issued quickly after the patentee files its response to the opposition. While this streamlining process encourages the patentee to file more than one set of claims for consideration by the EPO, each of those sets of claims should seek

to address and overcome objections raised in the opposition, not be a "fishing expedition" for what the EPO may or may not accept. We have also seen the EPO question whether or not to enter certain sets of claims into the proceedings because they do not limit the subject matter of the claims when compared to higher-ranked requests. Given the streamlining of the opposition procedure, we recommend that both the opponent and patentee address issues as soon as possible. For example, patentees should not assume that they will be able to file amended claim sets late in the proceedings. We also recommend patentees address all of the objections raised in an opposition, and reply robustly to the same in the response.

We recommend opponents submit all of their prior art, evidence and arguments when filing the opposition, bearing in mind that we have found it more productive to concentrate more on stronger arguments. Opponents should not rely on being able to introduce prior art late into the proceedings.

Summary

The EPO is proactively reducing its examination backlog and patents are now being granted within a more sensible timescale, which is only to be applauded. This has led, however, to some peculiar practices and outcomes. Applicants can, however, take steps to reduce the risk of such outcomes from occurring and to secure the patent protection they deserve.