Strategic Renewal Process
"Raising the bar"

How to improve the quality of incoming applications

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Raising the bar

- Introduction

- Legal Framework
  - Inventive step
  - Divisional applications

- External practice
Patent law as a matter of policy

• Main objectives of the patent system:

Promotion of innovation by granting exclusive rights only for innovations with inventive merit meeting the needs of "society"
Patent law as a matter of policy

• Unprecedented rise in the number of patent applications
  – Patent system used as a business tool
  – Number of patents seen as an economic weapon
    • irrespective of their merit or quality
  – Patents seen as a means to instil uncertainty into competitors

• Marked increase in the average number of pages and claims per patent application

• EPO principally used as an office of second filing
  – First filings not being adapted to the legal and substantive requirements in Europe
Reasons for "Raising the bar"

- Quality vs. quantity?
  - Risk of vicious cycle between lower quality and more patent applications (examination requests)
  - Tightening examination standard may significantly reduce patent applications
  - Higher examination standards would solve both quality and quantity problems
LEGAL FRAMEWORK

Inventive step
Strengthen current examination practice
Patentability Standards

Evaluation of the right patentability standards

- EPO Case law and its integration into Guidelines and Internal Instructions
- Standards and practice in some Contracting states
- Standards and recent developments at USPTO and JPO
- Analysis of economic consequences of a low inventive step ongoing
No legal (re-)definition of the person skilled in the art

Person skilled in the art

- Term used in Art. 83 (sufficiency of disclosure) and Art. 1 Protocol on interpretation (scope of protection)
- Term used in case law to Priority right, Prohibition of extension, Allowability of disclaimers, Correction of errors, Novelty, Clarity (Art. 87, 123(2) and (3), 139, 54, 84 EPC)
- (Re-)definition may "Raise the bar" for inventive step, however, lower the bar in other areas
Raising the bar
- may be a group of people (a team), multidisciplinary
- looks for suggestions in neighbouring and general technical fields
- is aware of the common general knowledge
- is involved in constant development
- has the same level of skill for assessing inventive step and sufficient disclosure

Evaluation of Case Law will be implemented into the Guidelines

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Problem-and-solution approach

- should be mandatory
- the teaching in the prior art does not need to be explicit
- in "problem-inventions" the posed problem should thoroughly reviewed, etc.

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Problem - Solution Approach

• Normally mandatory

• Technical effect to be achieved over the whole range claimed

• Could-would approach: teaching or suggestion does not need to be explicit

• Problem inventions to be treated with caution
LEGAL FRAMEWORK

Divisional applications
Divisional applications: G 01/05 and G 01/06

• Art. 76(1), Rule 36 EPC (Rule 25 EPC 1973): no additional requirements to be imposed on divisional applications beyond the requirements that all applications have to fulfil as well.

• **legitimate exploitation of the procedural possibilities** afforded by the EPC ← → abuse?

• "It is **unsatisfactory** that sequences of divisional applications each containing the same broad disclosures of the original patent application, by means of at least an unamended description, should be pending for up to twenty years." (emphasis added)

• If administrative measures not adequate: it would be for the legislator to consider where there are abuses and what the remedy could be.

(G 01/05 and G 01/06, Reasons point 13.5, OJ EPO 2008, 271, 307)
"Abuse" of divisional applications

- **duplication** of the proceedings

- **identical** divisional application filed on the day before the oral proceedings, i.e. before any refusal might occur: detrimental to legal certainty and to EPO workload

- Administrative measures cannot prevent the filing of divisional applications
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 in respect of the earliest application for which a communication has been issued, or (b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.

(CA/D 2/09, OJ EPO 5/2009, 296)
Non-Compliance: Legal consequence

• Non-compliance with the 24-month time limit:
  → the application cannot be treated as a European divisional application.

• Time limits excluded from further processing (see Rule 135(2) EPC)

• Re-establishment of rights available (see Article 122 and Rule 136(1) and (2) EPC)
Language of divisional applications: Amended Rule 36(2) EPC

The divisional application

• shall be filed in the language of the proceedings for the earlier application
• may be filed in the language of the earlier application, if the latter was not in an official language of the EPO

(CA/D 2/09, OJ EPO 5/2009, 296)
EXTERNAL PRACTICE

Increase procedural efficiency
Increase procedural efficiency

- Earlier focus of attention on scope of protection sought
- Ensure appropriate search documents for examination
- Reduction of additional search in examination
- Applicant decisions prior to substantive examination
- Fewer examination communications
Overview

• On request of the examiner, applicant to clarify the claims before the search is performed.
  – [New rule 62a & amended Rule 63 EPC]

• 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]

• Applicant to provide a response to the extended European search report before entry into examination phase
  – [New rule 70a; amended Rule 161 EPC]

• Only one opportunity for "own volition" amendment
  – [Rule 137 paragraphs 2 & 3 EPC]

• Applicant to identify amendments & indicate their basis the original filing
  – [Amended Rule 137 paragraph 4 EPC]
Only search one independent claim per category

New Rule 62a EPC

- Applicant will be invited to indicate, within two months, the claims complying with Rule 43(2) EPC on the basis of which the search should be carried out
- In the absence of such an indication, search will be carried out on the first claim in each category
- In examination, the application will be restricted to the searched subject-matter unless the examining division finds that the objection was not justified

Clarification of Complex Applications

- to improve the extent applications lacking support, clarity or conciseness can be searched and examined

Amended Rule 63 EPC

- Where it is not possible to carry out a meaningful search, the applicant will be invited to file, within two months, a statement indicating the subject-matter to be searched

- The statement could, for example:
  - indicate a part of the description (such as a specific embodiment) that can be used to interpret the claims
  - include improved claim wording which would become a formal amendment in the response to the search opinion

- In the absence of such a statement or where the statement is not sufficient to overcome the deficiency, no search, or a partial search will be carried out (as was previously the case)

(CA/29/09)
Clarification of Complex Applications - parallels in PCT

• Similar provisions to the amended Rule 63 EPC also exist in the PCT, namely:
  – paragraphs 9.34 and 9.35 of the PCT Guidelines

• The EPO has invited:
  – the IB to proceed with the necessary preparatory work for enabling International Authorities to make use of the above provisions
  – the other International Authorities to make use of these provisions

• This would benefit:
  – the quality and efficiency of the work of International Authorities
  – applicants, the public and other third parties
  – the designated offices, who would have a better view of what was searched
  – the reusability of international work by designated offices
Mandatory response to the search opinion

New Rule 70a EPC

• In the search opinion, the EPO will:
  – give the applicant the opportunity to comment on the EESR and,
  – where appropriate, invite him to correct any deficiencies noted in the ESOP and
  – to amend the description, claims and drawings

• The applicant must react within the period for requesting examination/confirming the examination request by providing arguments and/or by making amendments, or the application will be deemed withdrawn

Rule 137(2) EPC is amended to clarify that this is the applicant's chance to amend "of his own volition"

Rule 161 EPC correspondingly amended (for Euro-PCT applications)

Mandatory response to the search opinion (2)

Amended Rule 161 EPC

If the EPO acted as ISA (and where a demand was filed also as IPEA), it will:

- give the applicant the opportunity to comment on WO-ISA (or IPER), and
- where appropriate, invite the applicant to correct any deficiencies noted +
- to amend the description, claims and drawings

• The applicant must react within the 1-month period set in the communication under Rule 161(1) EPC, or the application will be deemed withdrawn.

• Rule 137(2) EPC is amended to clarify that this is the applicant's chance to amend "of his own volition"

Supplementary European search report → Rule 161(2) EPC → "may be amended" → Mandatory reply to EESR under Rule 70a(2) EPC

Mandatory identification of amendments
New paragraph in Rule 137 EPC

• When filing amendments, the applicant must identify them and indicate the basis for them in the application as filed

• If not, the examining division will request the applicant to do so

• Essentially, this formalises a requirement presently expressed in the Guidelines (E-II, 1)

• Entry into force of (amended/new) Rules 36, 62a, 63, 70a, 137, 161: 1 April 2010

• Transitional arrangements:

  **Rule 36(1)**
  • If the time limits have expired before 01.04.2010, a divisional application may still be filed within six months of that date
  • If they are still running on 01.04.2010, they will continue to do so for not less than six months

  **Rules 62a, 63, 70a, 137:**
  • apply to applications for which the (supplementary) European search report is drawn up on or after 01.04.2010

  **Rule 161**
  • applies to applications where a communication under current Rule 161 has not been issued before 01.04.2010

### Further processing
### Amended Rule 135 EPC

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*ADWI = Application Deemed Withdrawn

Re-establishment of rights available for Rules 62a & 63 EPC
Further information:

- On the EPO website [www.epo.org](http://www.epo.org): Notice of the European Patent Office dated 20 August 2009 concerning amended Rule 36(1) and (2) EPC (European divisional applications) and consequential amendments to Rules 57(a) and 135(2) EPC ([http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20090820.html](http://www.epo.org/patents/law/legal-texts/InformationEPO/archiveinfo/20090820.html))

- The Notice concerning amended Rule 36 EPC is scheduled for publication in **OJ 10/2009**.

- A Notice concerning new/amended Rules 62a, 63, 70a, 137, 161 is expected to be published in **OJ 11/2009** (with online pre-publication).

- English draft of the revised Guidelines is expected to be published at the end of the year.
Effects
• Encourage higher quality incoming applications

• Earlier focus of attention on scope of protection sought

• Increased value of search report

• Appropriate patentability standards

• Assist applicant decisions prior to entry into substantive examination

• Increase usefulness of patent information

• Predictable process
Thank You!