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Assessing the EPO's Early Certainty initiatives

Cristina Biggi of Bugnion evaluates the European Patent Office's implementation of Early Certainty at the examination and opposition stages

Early Certainty is the title being given to a number of initiatives undertaken by the European Patent Office (EPO) in order to speed up the patent granting process and to provide greater certainty and timeliness when it comes to patent applications.

EPO pre- and post-grant proceedings can be slow and, frequently, cases can lie dormant at the EPO for several years with a very slow turn-around. This can be an issue when the application concerns a rapidly changing technical field with short product cycles. The first implemented initiative was the Early Certainty from Search (ECfS) which was established in July 2014 with the aim of accelerating the search phase and providing a high-quality search report with a preliminary written opinion on patentability within six months of filing. This objective was accomplished in 2016 and, following this success, the EPO has extended Early Certainty to the examination and opposition stages. This responds to users' calls for better efficiency and timeliness for the overall procedure and it should result in significant improvements to these services.



“Another new feature resulting from the implementation of Early Certainty initiatives concerns minutes as the first communication in examination”

Applicants can file a request for the examination of a European patent application up to six months after the European Patent Bulletin mentions the publication of the search report. In this examination phase, the EPO examines whether the application and invention meet the requirements of the European Patent Convention and whether the invention is patentable in the light of the search report issued in the search phase. Currently this stage lasts 22.6 months on average, which is generally considered a long period. For this reason, by 2020 the EPO aims to reduce the aforementioned timescale to 12 months after the start of the examination.

The principal features of the new procedure for examination are listed in the new version of the EPO Guidelines for Examination issued on November 1 2017 (Part C of EPO Guidelines). Briefly, the Early Certainty initiative for examination mainly concerns the reduction of time for the first instance decision, the introduction of summons to oral proceedings as a first action in examination, a minuted telephone conversation as the first communication in examination, a specific procedure for enquiries, extensions of time less likely to be given and new refunds of examination fees.

In exceptional situations the examining division may now, as the first action in examination proceedings, decide to summon the applicant to oral proceedings (see C-III, 5). In this case, the applicant's response to the search opinion will be taken into account when drafting the annex to the summons. The annex to the summons shall include the applicant's requests in their entirety, as detailed as a communication under Article 94(3) of the EPC, contain no new objections or new documents and include reasons as to why the division decided to directly summon to oral proceedings as the first action in examination. This will only occur in exceptional circumstances and if, despite the applicant's reply to the search opinion, no possibility of a grant can be envisaged. The sine qua non requirements are that the con-

tent of the claims on file must not substantially differ from those that served as a basis for the search and that one or more of the objections raised in the search opinion, among those considered crucial to the outcome of the examination procedure, shall still apply.

The summons should be issued with at least six months' notice in order to allow the applicant sufficient time to prepare any submissions ahead of the oral proceedings. In accordance with the principles applicable to the summons to oral proceedings, the applicant may avail himself of the possibility to submit any arguments and amendments by expiry of the deadline set under Rule 116(1) EPC. If the applicant's submissions contain a forthright effort to overcome the examining division's objections, oral proceedings may be postponed or cancelled. Otherwise, the examining division may take a decision during these oral proceedings, in principle, even if the applicant does not attend them (see E-III, 6 and E-III, 8.3.3.3).

Another new feature resulting from the implementation of Early Certainty initiatives concerns minutes as the first communication in examination (see C-VII, 2.7). A telephone conversation can now be used as the first action in examination provided the following conditions are fulfilled: telephone minutes are issued, the telephone minutes present the matters discussed (for example, objections or reasoning) with the same level of information and structure as communication under Article 94(3), the telephone minutes are issued with a time limit for reply not shorter than four months, unless agreed otherwise with the applicant.

Matters not discussed during the conversation itself may be included in such minutes. However, it must be clear in the minutes that they were not discussed during the telephone conversation. If the above criteria are met, minutes issued as the first action in examination can replace the first communication under Article 94(3) and Rule 71(1), (2) (see C-III, 4). Furthermore, examiners may inform the applicant in a telephone call if the examining division is considering issuing summons to oral proceedings as the first action in examination (see C-III, 5). Instead of issuing separate telephone minutes, a remark regarding the telephone call may be included in the summons. If, however, the examining division decides not to issue summons at that stage, telephone minutes must be issued.

In specific cases, parties to proceedings before the EPO may have an interest in making enquiries about the progress of their file and thus obtaining information on when the next office action is to be expected. A specific procedure for enquiries is now available to all parties to proceedings before the EPO's departments of first instance and applies to enquiries filed on or after November 1 2016 (see the notice from the EPO

dated August 2 2016, OJ EPO 2016, A66). This procedure of processing and replying to an enquiry is possible only if the enquiry is filed online using the EPO form 1012 and submitted for only one application or patent at a time for which the EPO will issue an acknowledgment of receipt. Both the enquiries and the replies from the EPO form integral parts of the file and, as such, are open to public file inspection.

The time necessary for managing enquiries can be very variable and can depend on specific factors. For example, the non-payment of the renewal fee by the due date under Rule 51(1) may delay the EPO's handling of an enquiry. In general, the EPO will reply to enquiries by indicating a time within which the next office action may be expected, taking into account the workload in the technical area concerned and the internal deadline for the completion of the pending action.

Nevertheless, the EPO can automatically issue the next official action within one month from an enquiry in the following cases:

- if the extended/partial European search report in respect of European patent applications filed on or after June 1 2014 (including international applications entering the European phase where the EPO did not act as (Supplementary) International Searching Authority) has not been issued within six months from the filing date or from expiry of the period under Rule 161(2); or
 - if an office action in respect of an application which is being processed under the PACE programme or for which a previous enquiry has been made has not been performed within the committed period.
- It can issue the action within six months from receipt of the enquiry:
- if the extended/partial European search report in respect of European patent applications (including Patent Cooperation Treaty (PCT) applications entering the European phase where the EPO did not act as (S)ISA) filed before June 1 2014 and which do claim



Cristina Biggi

Prior to joining Bugnion in 2008, Cristina worked as a trainee in patent law for a major intellectual property law firm in Milan for almost five years where she drafted and prosecuted patent applications in the chemical and biotechnological sectors.

She has headed the chemistry and life sciences patent group of Bugnion since 2011 and became a partner of the firm in 2017.

Cristina is a European and Italian patent and design attorney. She has over 15 years of experience and has filed and prosecuted hundreds of cases before the EPO, WIPO and the Italian PTO. She has extensive experience in technological areas such as polymers, novel pharmaceutical compounds and their use, novel cosmetic and pharmaceutical compositions and formulations and biomaterials for medical use. Cristina has also filed and prosecuted plant variety applications.

She is involved in opposition and appeal proceedings at the EPO.

Cristina is a recognised technical patent expert in patent litigation before the Italian courts and is regularly appointed as a technical patent expert by Italian judges in nullity and infringement litigation.

priority (second filings) has not been issued.

Unlike the PACE programme, the filing of enquiries does not imply a general acceleration of the prosecution of European patent applications. Prosecution of the application can be accelerated by separately requesting application of the PACE programme (see E-VIII, 4). Although filing an enquiry does not guarantee acceleration of the examination, it can provide more certainty as to when the next communication may be expected.

In addition, in accordance with Article 11(b) rules relating to fees, the EPO has increased the existing 75% refund of examination fee to 100% if the European patent application is subsequently withdrawn before start of substantive examination and an additional 50% refund will be introduced in cases where the application is withdrawn before expiry of the time limit for replying to the first official communication in examination. For a summons to oral proceedings, this is also the deadline provided on the summons for making written submissions and/or amendments under Rule 116 EPC. However, other formats for a first communication in examination are also now possible, such as an invitation under Rule 137(4) EPC to indicate basis for amendments.

The opposition procedure is a post-grant inter partes (proprietor versus one or more opponents) procedure which comprises a first instance before a panel of three examiners and, if necessary, a second instance (appeal) before a technical board of appeal. The term for filing an opposition is nine months from publication of the mention of grant of the European patent. The grounds for opposition are limited to non-patentable subject matter, lack of novelty or inventive step, insufficient disclosure or added subject matter. There are three possible outcomes at the end of the proceedings: a) the opposition is rejected and the patent is maintained as granted; b) the patent is maintained in an amended form (in which case a new patent specification is published) and c) the patent is revoked. All adverse decisions taken by the opposition divi-

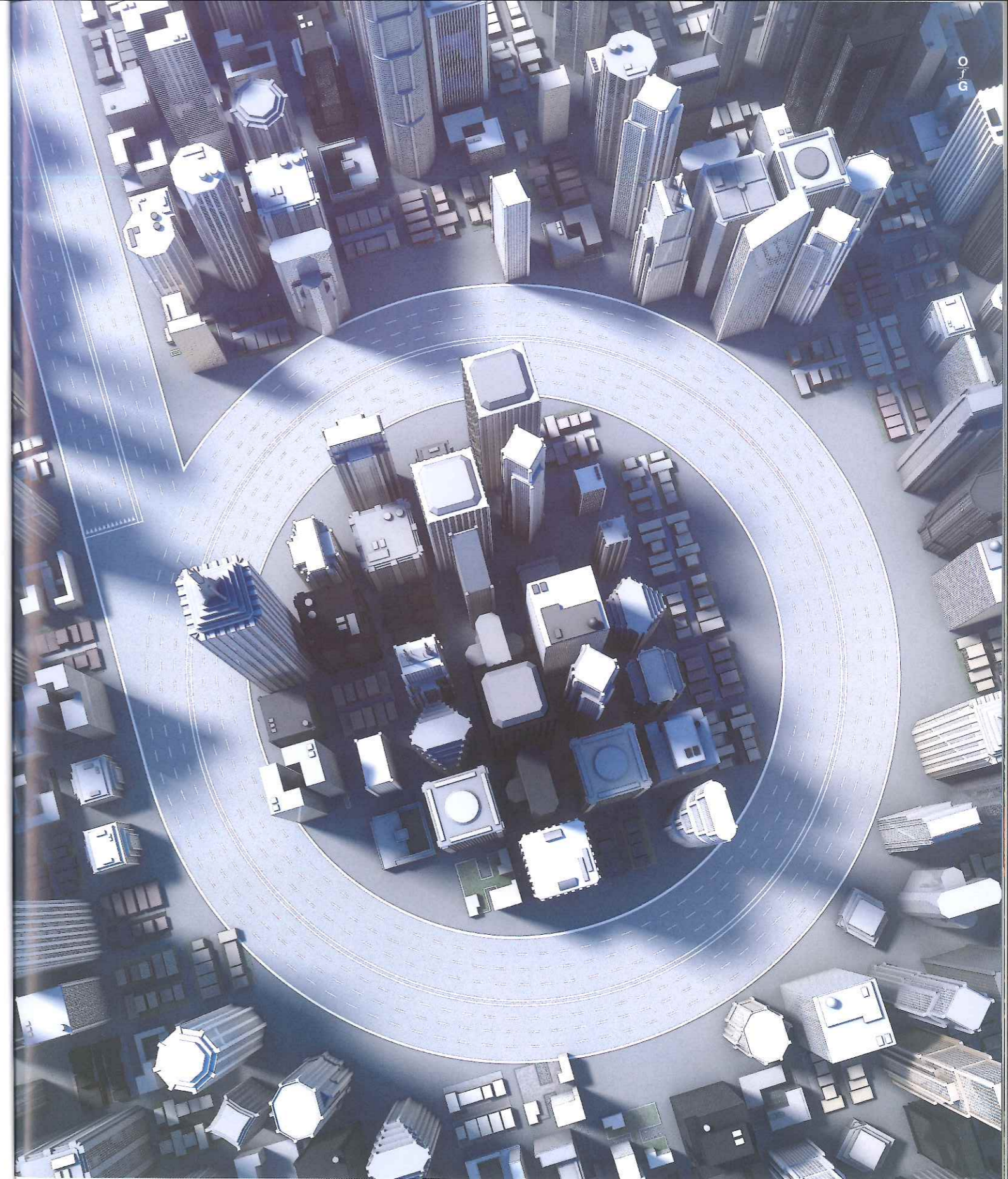
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sion (OD) can be appealed within two months from the date of notification of the opposition decision.

In order to simplify and reduce the length of straightforward opposition proceedings, the EPO started the Early Certainty from Opposition with the goal of reducing the average time for a decision for a standard case to within 15 months of the expiry of the ninth month opposition filing term. The EPO also guaranteed that it would maintain a certain flexibility in allowing longer timelines if necessary in order to take account of post-filing data and complicated cases. The principal features of the new procedure concern a reduced time to the first instance decision. Previously, patent proprietors had four months to reply to an opposition, with a two-month extension available upon request and additional further extensions. With the new Early Certainty initiative, extension will be available only in exceptional cases. Therefore patent proprietors will now have just four months to arrange their response to the opposition.

In conclusion, accelerating the patent-granting procedure with the Early Certainty initiatives seems to be the right answer for applicants who want their patents quickly granted and want to exploit their inventions before the technology becomes outdated. The same also applies to patentees and opponents who may be waiting for the outcome of opposition proceedings to decide on a business strategy. Faster decisions will increase legal certainty not only for proceedings before the EPO but also for infringement proceedings in national jurisdictions. On the other hand, not all users have the same interest in accelerating the patent-granting process. For example, they may wish to delay the prosecution process until they know the outcome of examination in another country or they may be waiting for agreement on a funding or licensing matter. Furthermore, the meaning of straightforward opposition and exceptional circumstances is not clear, and it seems that the EPO will judge each request for a time extension on its individual merits. Another questionable point is whether this policy is fair for patentees, since opponents have nine months to prepare and file an opposition, while patentees now have only four months to respond. Additionally, if the Early Certainty programme results in a significant increase in the number of oral proceedings at an early stage of the examination proceedings, this could have quite significant negative consequences for most applicants due to an increase in costs of the overall prosecution. Finally, it should be considered that these changes only apply to the first instance part of the opposition process and therefore do not affect appeal proceedings. Leaving untouched backlogs before the Board of Appeal results in a delay of at least three years. Thus, even with a streamlined examination and opposition procedure, it is likely that several years will still be needed for cases to be finally resolved before the EPO.



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