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Enhanced international search and Extended European search
Rationale and background of the changes

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Main objectives of PCT reform

➢ Three main objectives

1. ● Simplification – PCT procedure seen as unduly complex – not “applicant friendly” -

➢ Autumn 2000, general consensus in PCT Assembly that PCT in need of reform unforgiving in certain important areas e.g. mistakes in claiming priority

● Simplification would assist not only applicants but also International Authorities and national offices in administering the PCT and thus enable provision of a better all round service
Main objectives of PCT reform (cont.)

2. ● Allow International Authorities to manage their workload
   - No secret that especially larger International Authorities were encountering problems managing a growing PCT workload
   - Backlogs
   - Delays in issuing ISRs

● EPO, as largest International Search Authority (ISA) forced to reconsider principle of universal competence and restrict its competence in certain technical fields for US applicants – currently subject to review
Main objectives of PCT reform (cont.)

3. Improve efficiency

- Many PCT procedures seen as inefficient

- US proposal in document PCT/R/1/2 – combine search and examination to redress “built in inefficiencies of separate search and examination”

- Suggestion also to soften distinction between PCT Chapter I and Chapter II
Main objectives of PCT reform (cont.)

4. ● US proposal fully supported by EPO

  ● BEST conform so in line with EPO working methods

  ● Consistent with EPO pilot project
    Extended European Search Report
Rationale of the new procedures

- Enhanced International Search Report (EISR) should not be seen in isolation, rather as part of a broader plan to improve the PCT

- Fits in with
  - new uniform time limit for national phase entry under Article 22/39 PCT
  - simplified designation system

- Basic intention is to give the applicant and national offices information normally only available if Chapter II demand filed and at an earlier stage than present

- Allows for better “risk management” by applicants since ISO available in all cases – more transparency for third parties
Expressly acknowledged, however, in the PCT Reform Committee and Working Group that the option to use Chapter II was still valued by applicants and must be retained for the foreseeable future.

Consequently, if the applicant feels for any reason that the ISO is insufficient, he may still file a demand and make amendments under Article 34 PCT and submit arguments.
Further development

- “First stage” of PCT reform more or less concluded, i.e. reform achievable by amendment of *Rules* not *Articles*

- Next stage of reform still subject to debate
  - “Consolidation v deep reform”

- Reform discussions will have implications for future of search and examination under PCT

- US proposes possible shift from preliminary non binding nature of PCT reports – “optional protocols”

- JPO has floated idea of simultaneous processing of national and international phase
EPO has introduced pilot project similar to EISR for European applications – OJ EPO 5/2003

EESR will be part of the European procedure as from 1. July 2005

Applicant can opt out if he wants to avoid possibility of the EESR communication being open to file inspection after publication of the European application.
The EESR and ISR differ as to content

- EISR established on key patentability criteria
  - novelty, inventive step, industrial applicability – clarity and conciseness handled in so far as necessary to formulate such an opinion

- Intended for use before all PCT designated offices

- EESR tailored to European procedure

- Focuses on requirements of European Patent Convention (EPC)
Conclusions

- EISR and EESR are a first step in bringing EPC and PCT procedures into line

- PCT ISO should, for the most part, avoid the need for Chapter II with corresponding advantages for applicant and designated offices, but applicant options remain open

- Introduction of EESR as part of European procedure as from 1. July 2005 with amended Rule 44 (a) EPC
New Rule 44(a) EPC

1) The European search report shall be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of this Convention.

2) The opinion accompanying the European search report under paragraph 1 shall not be published.

(but EESR opinion will be accessible through public file inspection 18 months after priority date)
Traditional European Procedure

1. **First phase**: Search
   - by a search examiner
   - in DG1 (The Hague / Berlin)

2. **Second phase**: Substantive examination
   - by a substantive examiner
   - in DG2 (Munich)
1. First phase: Search + Preparation of the first communication
   - by a BEST examiner
   - in DG Operational

2. Second phase: substantive examination
   - by the same BEST examiner
   - in DG Operational
Nov 2000 : EPC Revision ; BEST becomes normal practice

- BEST is now the normal procedure

- Every new examiner recruited since 1/1/2001 is trained as a BEST examiner
  - Training optimised: from 456 days over 5-6 years to 325 days spread over 3 years

- Office-wide extension of BEST (85% penetration) by the end of 2005
  - end 2001, 44% penetration
  - end 2002, 61% penetration
Extended European Search Report

What?

A pilot project to test possible new procedures:

- The usual search report plus an opinion on whether the application meets the requirements of the EPC

- Sent to the applicant together with search report for all European first filings (since 1 July 2003)

- As a „free“ service / legally non-binding

- Applicants have possibility to „opt out“
European procedure for first filings

- 1st Filing (no priority)
- Search Report
- Publication of application with SR
- Entry into Examination Procedure
- Communication examiner/applicant
- Grant/Refusal

Time (months):
0 6 18 ≤6

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European procedure for first filings

with EESR

1st Filing (no priority)  EESR  Publication of application with SR  Entry into Examination Procedure  Communication examiner/applicant  Grant/Refusal

0  6  18  ≤6  Time (months)
Extended European Search Report

Why?

- Procedure fits to the way of working under BEST conditions
- Creates more value for the applicant earlier in time
  - Reduced economic risks
  - Encourages early withdrawal of „weak“ applications
- Allows to considerably reduce the average pendency time (cf. Paris criteria)
- A similar evolution is taking place for the PCT (EISR as of 1/1/2004)
Is the EESR obligatory?

No – the applicant can „opt out“ in which case the procedure is exactly the same as before – the search report is sent without any opinion. Applicants can opt out for individual applications:

• A request not to receive an EESR can be made when filing the application
EESR: SCENARIOS

- First communication contains no objections – application is ready for grant:
  - EESR contains a positive opinion (form 1702)
  - Applicant can pay the examination fee and will promptly receive the Rule 51(4) EPC communication (the proposed text for grant) as long as:
    - the final topping-up search (Art. 54(3) EPC) carried out after the end of the priority year does not reveal new prior art
    - The rest of the examining division agrees
EESR: SCENARIOS

- First communication does contain objections to patentability:
  - EESR contains a negative opinion (forms 1702 & 2906). This opinion is exactly the same as that presently written in the European procedure.
  - Applicant can file amendments for the consideration of the examining division (examination fee still has to be paid) and so shorten the procedure.
  - If no amendments are filed then the same communication will be issued as the official first communication once the examination fee has been paid.
After assessment of the pilot project the following has been considered:

- Formalising the EESR procedure by
  - amendment of the EPC (no opting out)
  - Extending the procedure to European second filings (i.e. it would apply to all European applications)

These amendments are scheduled to start in July 2005
Coordination of International Search and Examination

- Enhanced International Search Report (EISR)
- Optional International Preliminary Examination
Content

- Enhanced International Search Report (EISR)
  - Same content as former International Search Report (ISR), plus
  - First opinion on novelty and inventive step
    WO-ISA (Written Opinion of the International Search Authority)

  - Reasoned opinion on core issues of patentability (positive and/or negative)
  - Citation of relevant documents
  - Major clarity objections and exclusions which affect the above
Opinion part comparable to Written Opinion (WO) in PCT Chapter II

WO-ISA (Written Opinion of the International Search Authority) will always contain positive statements, where applicable

ISA Opinion is normally deemed to be Written Opinion for Chapter II if demand filed (WO-ISA not re-issued)

If IPEA is different from ISA, ISA Opinion may not be taken as Chapter II Written Opinion (IPEA may choose)

Maximum benefit if same examiner for EISR and IPE
• Established by ISA within 3 months of receipt (as currently for ISR)
• Opinion part of EISR will be sent to applicant, but not published with ISR
• Informal comments on ISA opinion by applicant possible (if no Chapter II desired)
  – transmitted to the Designated Office (DO) by the International Bureau (IB) of WIPO
Procedure

• Chapter II procedure
  — Demand to be filed at latest of either 3 month from receipt of ISR + Opinion
    OR
  — 22 months from priority date
  — Any Article 19/34 amendments and observations considered in optional Chapter II procedure
  — IPER (International Preliminary Examination Report) normally established within 6 months of EISR
  — If no observations/amendments filed, IPER will merely repeat the content of the WO-ISA
Procedure

- If no Chapter II, Chapter I Opinion converted to Report by IB of WIPO

- International Preliminary Report on Patentability (IPRP - Chapter I or Chapter II) transmitted to DOs or EOs (Elected Offices) by IB of WIPO after 30 months from priority date
Effect

- Effect on EPO Rationalised Examination
  - Elimination of “standard format” Written Opinions and IPERs
  - Rapid availability of reasoned assessment of core substantive issues (at the time of the International Search Report ISR)
Outline of the former PCT Procedure

1st filing → Filing IA → IS → Demand → IPE → National phase

ISR → Publication IA + ISR → IPER

17m 18m 19m 20/21m 28m 30/31m if Art. 22 ratified
Outline of the PCT Procedure since January 2004

1st filing → Filing IA → IS → Demand → No → ISR + WO-ISA

1st filing → Filing IA → IS → Demand → Yes → IPE → National phase

Filing IA → IS → ISR + WO-ISA

Publication IA + ISR

IPER

17 m

18 m

22 m

28 m

30/31m
Application filed → Chapter I procedure → WO of ISA → ISR → Publication by IB:
- Application pamphlet + ISR + Art. 19 amendments

 Applicant's reply to WO of ISA

 International preliminary examination

 Demand for Chapter II?

 Yes → IPRP by IPEA

 No → Continuation of Chapter I → Applicant's informal comments

 Filing of Art. 19 amendments by applicant

 ISR/WO of ISA transmitted to: Applicant, IB and IPEA if Chap. II

 IPRP by ISA based on WO of ISA
Main differences between the WO-ISA produced under the new PCT system and the EESR:

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<th>EPC</th>
<th>PCT</th>
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<tbody>
<tr>
<td>EESR communication</td>
<td>EESR communication is open to public at 18 months (through file inspection)</td>
<td>WO-ISA is not until 30 months (via the IPRP or the IPER if PCT Chapter II is requested)</td>
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<td>WO-ISA focuses on core issues of patentability</td>
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<td>EESR communication is a full communication as sent today when normal substantive examination is requested</td>
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<td>In neither case (EESR nor WO-ISA), a reaction of the applicant is necessary</td>
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Thank you for your attention