



Institut der beim Europäischen Patentamt zugelassenen Vertreter
Institute of Professional Representatives before the European Patent Office
Institut des mandataires agréés près l'Office européen des brevets

The Patent Offices' Backlog Crisis AIPLA/FICPI Colloquium Edinburgh, 17-18 June 2010

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Critical Review of Proposed Strategies

- Fee Strategies to Influence User Behavior – continuations, divisionals, claim strategies, including restrictions on total number of claims and number of independent claims
- A European Perspective



- At the end of 2007 EPO decided on a first step towards a new fee structure aiming to influence applicant behavior, with effect from 1 April 2008
- Firstly, EPO decided on a general fee increase of 5%
- At the same time EPO decided on a raise in the claims fee, whereby no fee would be payable for 1-15 claims
- From the 16th and each subsequent claim a fee of 200 EUR would be due
- This was intended to:
 - Reduce the workload by reducing the number claims for search and examination
 - Provide additional income

Change in Fee Structure

- Further, EPO decided to drastically raise the internal renewal fees from the 4th year onwards
- The additional fee for belated payment was also increased from 10% to 50%
- The raise of the internal renewal fees was intended to compensate:
 - A decline in the average life of a European patent
 - An increased rate of abandonment for European applications

- The change to the fee structure was intended to steer the behavior of applicants

BUT:

- The claim fee change resulted in a decrease in income
- The drastic raise of the internal renewal fees
 - Certainly increased income
 - Who's behavior did it influence? – not applicants' behavior
- Relative workload still seems to grow at the EPO

- Now the EPO has realized that it is time to move away from *ad hoc* decisions on individual fees towards a coherent fee policy
- Further, the EPO suggests to base this on evidence based policy
- This we do welcome very much

- The EPO has introduced and is continuing to introduce amendments to the rules (Implementing Regulations) relating to the prosecution of patent applications
- The amendments relate to
 - Restrictions on filing divisionals, mandatory time-limited responses, limitation of voluntary amendments, etc.

- This is being done with an accelerating speed
- The EPO has been obliged to publish subsequent notices in order to clarify the various amendments

- However, there is still a lack of clarity and confusion prevails
- Applicants have had to invest heavily in changing their docketing and monitoring systems

Procedural changes – intended results

- The desired micro level result seems to be a one-pit-stop grant or refusal
- On a global scale, the desired result is a diminished overall workload

- However, we do not have a clear picture of how the rule changes actually affect examiner work

Procedural changes – drivers and policy

- Applicants “abuse” and “gaming of the system” seem to be two of the prominent drivers
- The present rule making policy has the characteristics of a lasso thrower
- When the object is caught in the loop, and the rope is pulled too tight, the end result will be that the object is dead
- This is a dangerous avenue that slowly might kill innovation to the detriment of technical development
- In order to avoid this, we would encourage the office, both the legislative and the implementing side, to engage in a constructive dialogue with the users for discussing the practical implications of proposed regulations before they are put into effect

A long term project

- The backlog is not new, the number of filings has been growing exponentially for a long time
- In order to better understand the backlog more detailed information is needed
 - clarity on pending cases, pendency times, stage of prosecution, technical field, applicants/([potential] third parties) etc.
- Band-aid solutions will not deliver sustainable results on a long term basis
- On a global scale a common application format as well as common rules for examination and quality control developed in cooperation with the users could be the right way to go
- A long term, timetabled roadmap is needed

**Wishing you a successful continuation
of the colloquium!**

**Thank you very much
for your attention!**