



# Examination problems encountered by EPO-applicants

**Dr. Daniel Alge**  
**Chairman CET Group 4 (European  
Patents)**

# *Examination problems encountered by EPO applicants*



- *Timeliness*
- *Quality of Search and Examination*
- *Flexibility for Users*
- *Quality of Decision Practice*



# *Examination problems encountered by EPO applicants*



- *Timeliness*
- *Quality of Search and Examination*
- *Flexibility for Users*
- *Quality of Decision Practice*

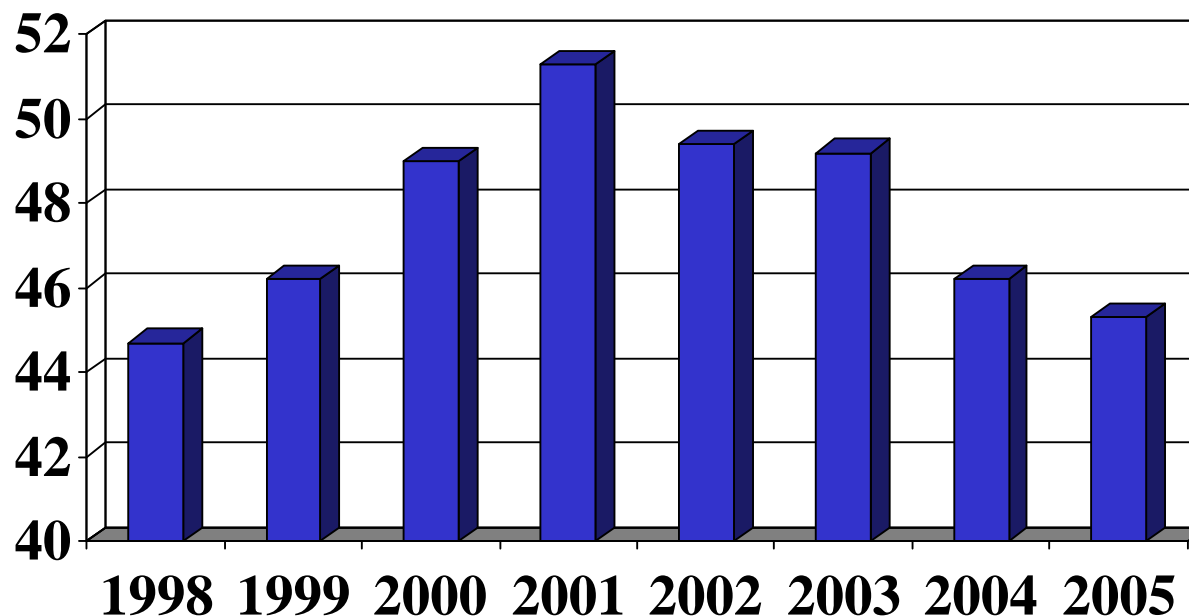


# *Examination problems encountered by EPO applicants - Timeliness*



## mean granting period for European Patents

months



## ***Examination problems encountered by EPO applicants -Timeliness***



- *almost 4 years on average until grant*
- *lengthy opposition/appeal proceedings*
  
- *accelerated examination possible*
- *accelerated opposition/appeal proceedings  
theoretically foreseen (Notice from the President  
of the EPO 19 May 1998)*



# ***Examination problems encountered by EPO applicants -Timeliness***



- *recent years: significant reduction of time periods after acceptance of application (after Communication according to Rule 51(4))*
- *applicants have less time for deciding about validation strategy (= costly step (translations))*
- *it often takes years until Com.R51(4) is issued after response to an office action or enter into regional phase*



# *Examination problems encountered by EPO applicants -Timeliness*

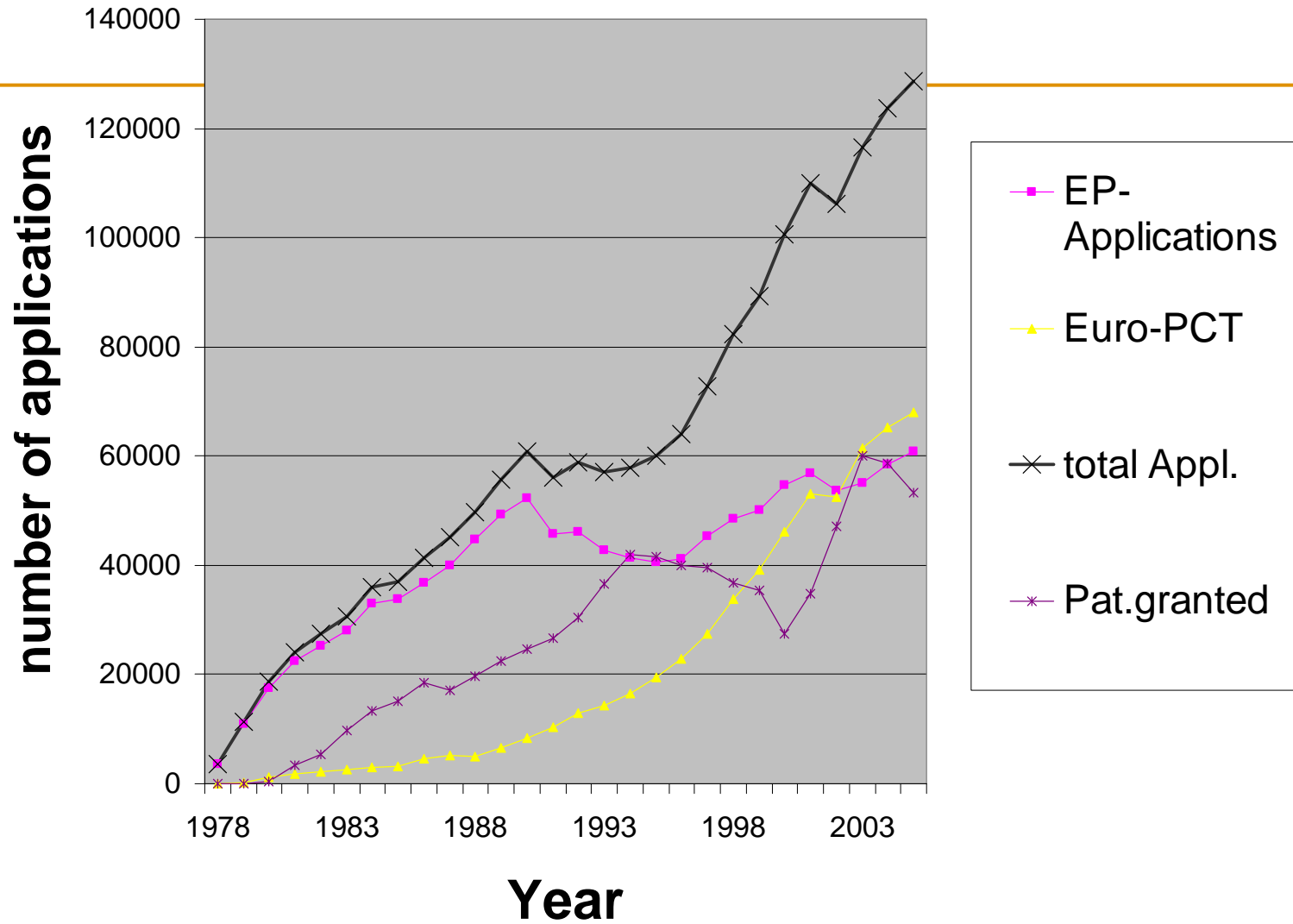


- *still too many “A2” documents (EP and PCT)*
  - *getting better (compared to 2000-2003)*
- *4216 Examiners (Annual Report 2005)*
- *194.000 applications/year*
- *46/Examiner/Year*





# Applications 1978-2005



# *Examination problems encountered by EPO applicants*



- *Timeliness*
- *Quality of Search and Examination*
- *Flexibility for Users*
- *Quality of Decision Practice*



# *Examination problems encountered by EPO applicants – Quality of Search and Examination*



## ➤ *Inexperienced Examiners*

➤ *getting better*

## ➤ *Extended European Search Reports*

➤ *Written Opinion – International Search Report*

## ➤ *No reflection on arguments*

➤ *especially in International Phase*



## **Examination problems encountered by EPO applicants – Quality of Search and Examination**



- ***Formalistic (Rule 29(2) EPC; not more than one independent claim per category) - usual***
- ***“Threat” of oral proceedings before the Examining Division (e.g. after 2nd or 3rd Office Action) – usual***
- ***Quality of Filing: Online-filing: potentially good working system: no immediate control possible in the file at the EPO → uncertainty, however, in the full responsibility of the applicant (representative)***



# *Examination problems encountered by EPO applicants – Quality of Search and Examination*



➤ *difference in practice (inventive step, enablement, formal issues, etc.) between different Examining Divisions, Opposition Divisions and Appeal Boards*



# *Examination problems encountered by EPO applicants*



- *Timeliness*
- *Quality of Search and Examination*
- *Flexibility for Users*
- *Quality of Decision Practice*



# *Examination problems encountered by EPO applicants – Flexibility for Users*



- *Only one prolongation of term for responding Office Actions is granted*
- *PCT International Examination is mostly ignored by EPO (strong contrast to before 2000-2003)*
- *Change of Date for Oral Proceedings*



# *Examination problems encountered by EPO applicants*



- *Timeliness*
- *Quality of Search and Examination*
- *Flexibility for Users*
- *Quality of Decision Practice*



# Examination problems encountered by EPO applicants – Quality of Decision Practice



- *Article 123(2): “A European patent application or a European patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed.”*
- *Very rigid practice applied (“directly and unambiguously” → literal wording necessary → filed applications get more voluminous to contain potential basis for claim amendments)*
- *Practice differs individually*
  - *(rigid – very rigid – mega rigid)*



# ***Examination problems encountered by EPO applicants – Quality of Decision Practice***



- ***Priority Claiming: Article 123(2) – standard applied: leads often to loss of priority rights; publications (of applicants) in the priority year become full prior art → recommendation not to publish within the priority year***



# **Examination problems encountered by EPO applicants – Quality of Decision Practice**



- *EPO Appeal Board decisions have no direct impact on national courts (not even decisions of the Enlarged Board of Appeal) → patents get revoked by national courts although they are patentable according to EPO practice → legal uncertainty*
- *EPO (incl. Appeal Boards) are not part of European jurisdiction*





# Examination problems encountered by EPO-applicants

**Dr. Daniel Alge**  
**Chairman CET Group 4 (European  
Patents)**