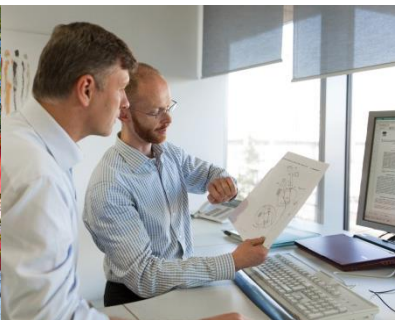




Europäisches  
Patentamt  
European  
Patent Office  
Office européen  
des brevets

# The European Patent Office as International Authority



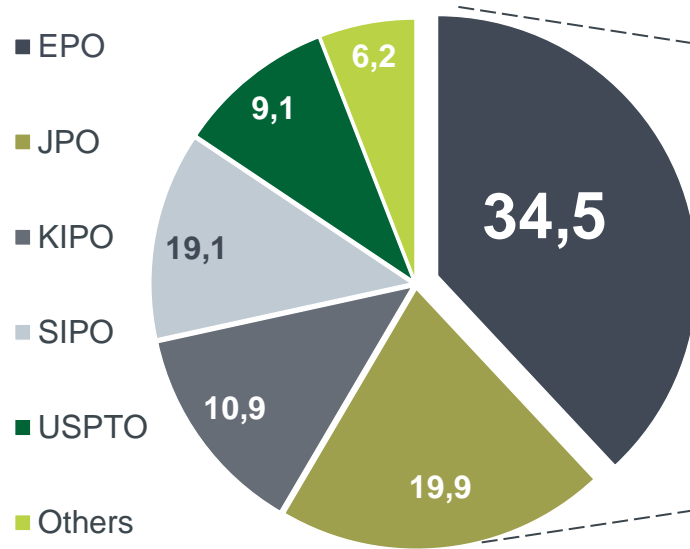
# Overview – EPO as International Authority

- EPO as ISA
- Information on search strategies
- Provisional opinion in cases of non-unity (POPS)
- Collaborative search and examination
- EPO as SISA
- EPO as IPEA
- Second written opinion in PCT Chapter II
- Top-up search in PCT Chapter II
- Positive IPER: Euro-PCT phase
- Focus on quality
- Update on fees

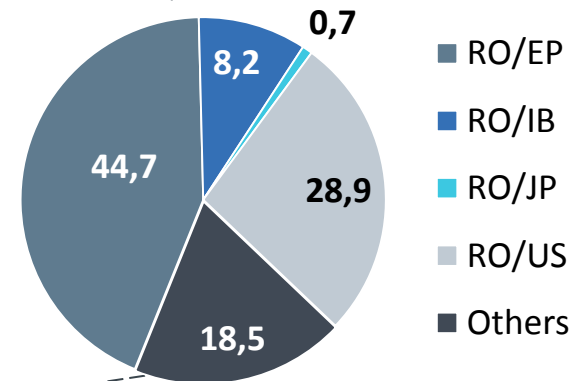
# EPO continues to be the main ISA

## EPO is No. 1: 79 600 ISRs established by the EPO in 2017

ISRs established in 2017 (%)



Origin of Search Copies  
received by ISA/EP in 2017 (%)



# EPO as ISA: our work

- **Competence**

- When RO has specified the EPO as ISA
- Some exceptions: CN, KR, AU, CA

- **One standard for all searches at the EPO**

- Search reports either in EN, FR or DE
- Highest quality including Asian prior art

- **Written Opinion**

- Thorough non-binding opinion on patentability
- Equivalent to the European search opinion (ESOP)

# EPO as ISA: latest developments

- **International search fee** charged by EPO=ISA reduced to EUR 1 775 in 2018
- **Improved timeliness:** 97% ISRs in time for A1 publication
- **New services** offered:
  - **PCT Direct** service fully operational and available at all ROs
  - Information on "**search strategies**"
  - Provisional Opinion accompanying the Partial Search results in cases of non-unity (**POPS**)


# EPO as ISA: Information on "search strategies"

- **Information Sheet on Search Strategy** annexed to all search reports established by EPO under both PCT and EPC
- Contains relevant data on **classification**, **databases** and **keywords** used by EPO examiners when performing the search
- Available via file inspection in PATENTSCOPE (for PCT) and European Patent Register (for EP)
- Pilot available since 1 November 2015 and running until 31 December 2017
- Permanent service since 1 January 2018

# Why provide information on Search Strategies?

- Increase user confidence in the quality of the search report
- Enable rapid understanding of:
  - what was searched (keywords),
  - where (e.g. classification searched)
- Facilitates internal quality reviews, even at grant stage
- Can be generally understood (no need for specialist knowledge)

# Where to find "Information on Search Strategy"



Europäisches  
Patentamt  
European  
Patent Office  
Office européen  
des brevets

European Patent Register

DeutschEnglishFrançais  
Contact

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EP3144669  
European procedure  
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→ Is it possible to open new windows?  
→ Can I open multiple documents in separate windows?  
→ Is it possible to print a document?  
Maintenance news +  
News flashes +  
Related links +

All documents: EP3144669  Refine search  Selected documents  Zip Archive Previous 45/2047 Next  Espacenet  Submit observations  Report error  PrintAll documents(17) 

European Patent Office

8



# Typical "Information on Search Strategy"

Information on Search Strategy - Pilot phase (see OJ 2015, A86) <small>The type of information contained in this sheet may change during the pilot for improving the usefulness of this new service.</small>		Application Number
		EP <input type="text"/>
TITLE: A SINGLE <input type="text"/> AND A METHOD USING THE <input type="text"/>		
APPLICANT: IDT Europe GmbH		
IPC CLASSIFICATION: G01N27/12, G01N33/497		
EXAMINER: <input type="text"/>		
CONSULTED DATABASES: WPI		
CLASSIFICATION SYMBOLS DEFINING EXTENT OF THE SEARCH:		
IPC:		
CPC: G01N27/123, G01N27/14, G01N33/497		
FI/F-TERMS:		
KEYWORDS OR OTHER ELEMENTS FEATURING THE INVENTION: Single metal-oxide-semiconductor (MOX) gas sensor capable of detecting and calculating the concentration of multiple gases with a single sensing element. The sensor comprises an MOX sensing element, a programmable heater and a resistance measuring unit. The heater is set to two temperatures and the MOX-resistance is measured at regular intervals, thereby creating a signature temperature-resistance profile characteristic for the gas composition. The gas sensor may be stacked on a silicon membrane (bridge-type sensor) or on a low-thermal mass ceramic to increase recovery time.		

# User surveys

EPO has surveyed its users for feedback concerning the Information on Search strategy.

- Users appreciated this additional service
- Users found the information sufficient to fully understand what was searched
- Users could use the information provided as a start in order to build on what was done

Feedback confirms that the provision of information in this format meets the European users' expectations and needs.

# EPO as ISA: Provisional opinion in cases of non-unity (POPS) (1)

**Additional service** for EPC and PCT applications since 1 April 2017 in case of finding of lack of unity at the search stage.

Change of practice: EPO provides a **provisional opinion** on the patentability of the invention first mentioned in the claims together with the invitation to pay additional search fees and the partial search results.

The provisional opinion is **for information only** and no reply is required.

## **EPO as ISA: Provisional opinion in cases of non-unity (POPS) (2)**

The provisional opinion accompanying the partial search results is made available to the public via online file inspection.

For further information see: OJ EPO 2017, A20.

# PCT Collaborative Search & Examination (CS&E) (1)

**Concept:** PCT search and written opinion by the main ISA in collaboration with "peer" ISAs which provide contributions and feedback.

**Aim:** high quality of ISR and WO-ISA, increased legal certainty early on in the procedure.

**Pilot phases 1 and 2:** concept operationally tested by EPO, KIPO and USPTO.

# PCT Collaborative Search & Examination (CS&E) (2)

**Pilot phase 3: CS&E concept** will be further developed and tested amongst the **IP5 Offices** in view of:

- **gauging users' interest** for a CS&E product
- **confirming expected benefits** for both users and participating Offices
- **setting the basis** for a decision as to the **future of this concept**

## CS&E: main features (1)

Collaboration organised according to a clear scheme:

- **provisional** ISR and WO established by the competent ISA
- **supplemented by** or **corrected** according to contributions of "peer" ISAs
- **final** ISR and WO established by the competent ISA

**Applicant driven: applications** will be **selected by applicants**  
(limited number of applications per applicant and a broad pool of applicants)

## CS&E: main features (2)

**Same number** of applications **per competent ISA** (around 100) and **all** collaborating ISAs will contribute to all collaborative work products (a total of around 500 files – a sufficient volume for benchmarking)

**Language:** applications filed in **English and in other languages** (German, French, Asian languages)

**A collaboration tool:** an IT infrastructure allowing exchanges under the CS&E scheme in a **secure** environment and automated data collection



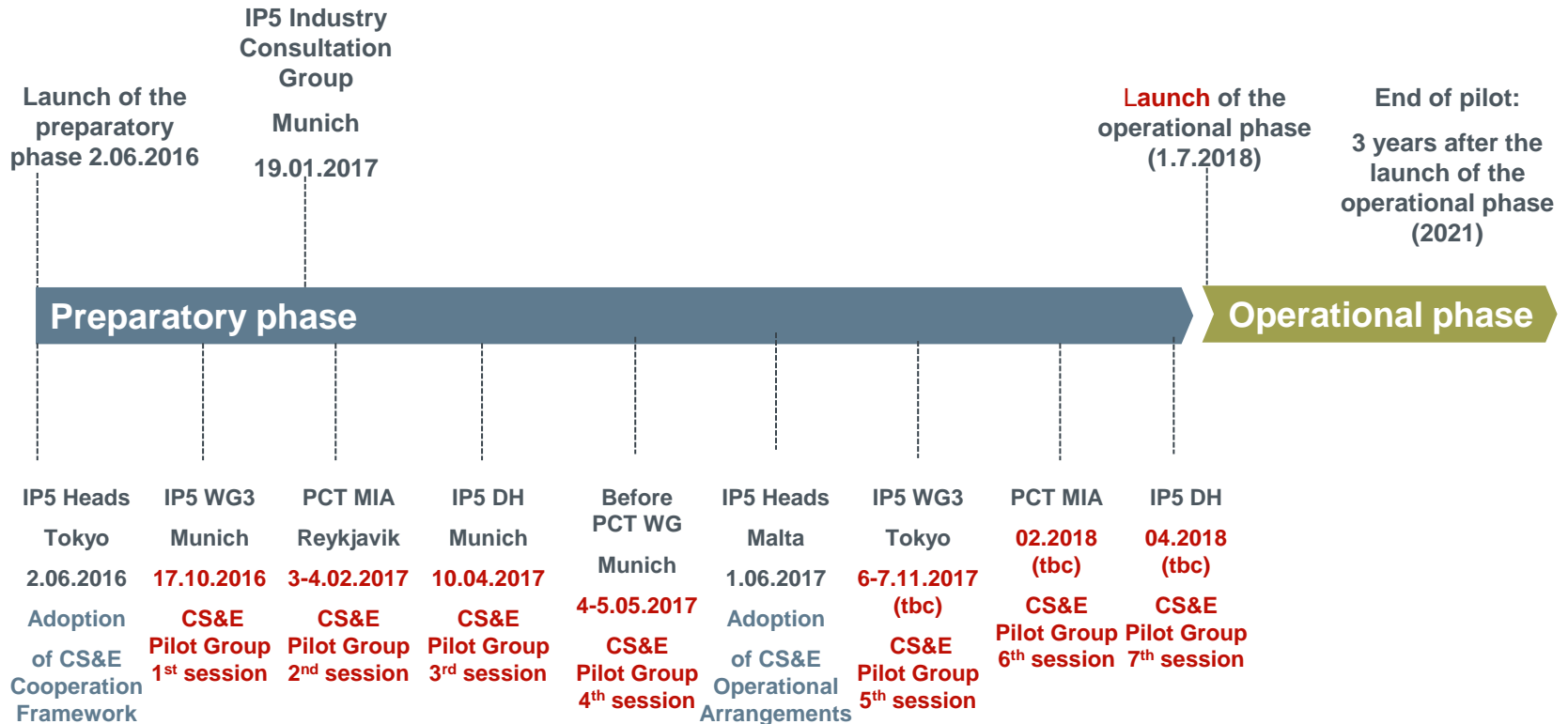
## CS&E: main features (3)

**Fees:** during the pilot: standard fee for a PCT Chapter I search at the competent ISA and information about prospective amount of a CS&E fee for a potential regular CS&E product (aggregated amount of the search fees of the collaborating ISAs + an administrative fee)

**Participation?** Applicants interested to participate in the pilot will need to insert a CS&E Participation Form available on WIPO's website to the submission containing the international application(s) which they wish to be processed in a collaborative manner.

Details: EPO OJ 2018, A47

# CS&E Pilot – Timeline



# EPO as SISA (1)

At the option of the applicant: second international search (by another Office)

Irrespective of ISA chosen

At the EPO: same quality of search, fee and advantages as for PCT search e.g. **dispensation of supplementary European search in EP phase**

Increases legal certainty **before** incurring the costs of entering the national/regional phases

## EPO as SISA (2)

- Applicants may be represented before the EPO as SISA by the agent appointed for the international phase.
- EPO as SISA may also search inventions which have not been searched by the ISA. The applicant must indicate which invention is to be searched.
- Requirements for filing a SIS request:  
A request must be filed (and the fees paid) with the IB within **22 months** from the priority date (**New** as of 1 July 2017: before it was 19 months).

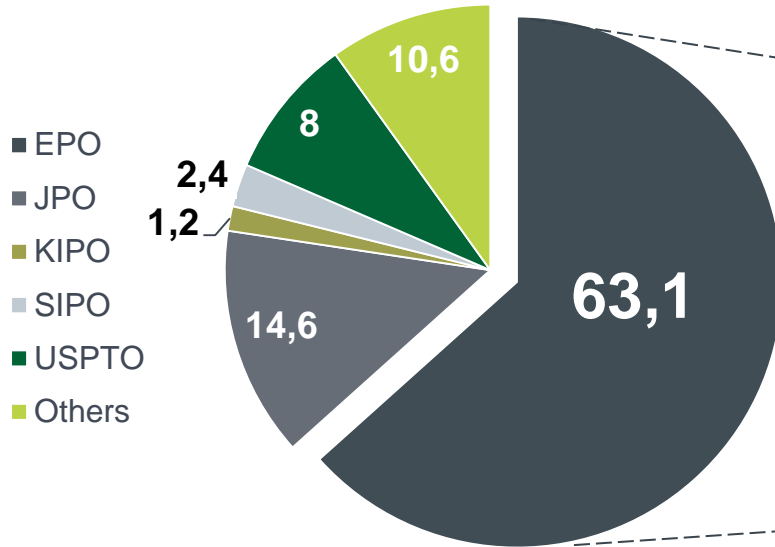
## EPO as SISA (3)

- Establishment of the SISR :  
SISR is established within 28 months within priority date. Therefore, it may improve the basis for deciding on national or European phase entry.

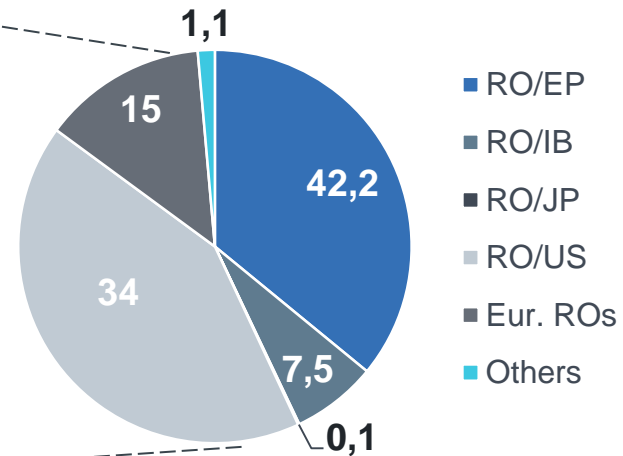
# EPO increases its share as IPEA (status in 2017)

## EPO is Nr. 1: 8 400 IPERs established by the EPO in 2017

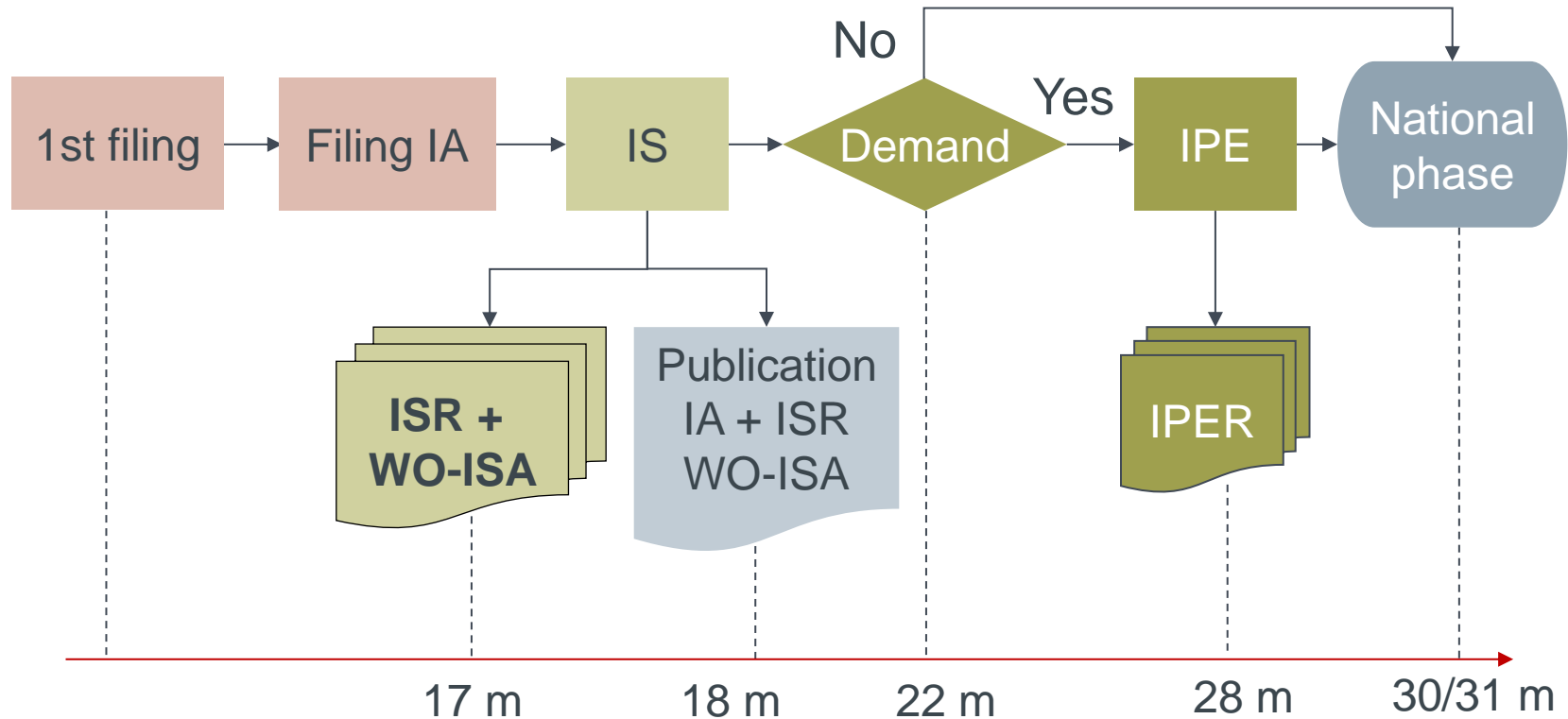
IPERs established in 2017 (%)



Origin of Demands received by IPEA/EP (%)



# EPO as IPEA: overview of the procedure



## Second WO in Chapter II PCT (1)

Since October 2011 in order to enable more interaction within Chapter II:

- ▶ Get ready for grant in the European phase.

If the EPO acted as ISA:

- ▶ The WO-ISA is considered the first WO under Chapter II PCT (Rule 66.1bis(a) PCT).



## Second WO in Chapter II PCT (2)

**A second WO is issued** under Rule 66.4 PCT if:

- the applicant filed amendments (or arguments) for the Chapter II procedure, **and**
- there are objections outstanding so that the IPER would be negative were it to be issued.

For further information see: OJ EPO 10/2011, 532.

## Second WO in Chapter II PCT (3)

Exception:

No second WO issued if a telephone consultation was requested before second WO is established.

Minutes of telephone consultation with time limit for reply takes the place of the second WO.

Background:

Article 34(2)(a) and Rule 66.6 PCT provide for the right to one telephone consultation.

## Second WO in Chapter II PCT (4)

The applicant may reply to the second WO or, where applicable, the minutes of the telephone consultation:

- within the time limit set of (as a rule) two months;
- by filing comments and/or amendments.

# Top-up search in Chapter II (EPO practice) (1)

New Rule 66.1ter PCT entered into force on 1 July 2014.

Top-up search in Chapter II will be done in the same manner as for European applications.

Will include potentially conflicting prior art under Article 54(3) EPC.

Concentrates on intermediate prior art but also e.g. documents cited in national proceedings for the same application if such documents became available to the EPO as IPEA.

Published in OJ EPO 2014, A57.

# Top-up search in Chapter II (EPO practice) (2)

EPO practice – timing of top-up search:

- Top-up search in Chapter II will normally be done **at the start of Chapter II** in order to allow further interaction with applicant should relevant documents be found.
- In cases of non-unity an invitation to pay additional fees will be sent first and then the top-up search conducted only for inventions for which fees were paid.

## Top-up search in Chapter II (EPO practice) (3)

EPO practice – scope with respect to the claims:

Will as a general rule be made for all claims forming the basis for the procedure under Chapter II.

Examples:

- Unsearched subject-matter claimed:  
the top-up search will not extend beyond the subject-matter searched by the ISA.
- Amendments going beyond the original disclosure:  
top-up search limited to the scope of the claims forming the basis of the Report.

# Top-up search in Chapter II (EPO practice) (4)

Exception:

No top-up search if considered to "serve no useful purpose"

Examples:

- "notorious knowledge" in the field of computer implemented inventions
- excluded subject-matter

# Top-up search in Chapter II (EPO practice) (5)

EPO practice – interaction with applicant:

- If relevant documents under Rule 64.1 are found giving rise to objections under novelty and inventive step:
  - A second WO is issued (or telephone consultation) along the lines set out before
- If only intermediate prior art or potentially conflicting applications are found and there are no other objections
  - Second WO only if Art. 54(3) EPC objection in EP phase
- Otherwise an IPER is issued mentioning the documents found under Box VI for information to the applicant.



# Advantages of Chapter II

Get the application in order for grant in the national/regional phase:

- If the EPO acted as IPEA
  - Reduction in the examination fee (Art. 14(2) RFees)
- With a positive IPER
  - A quick grant before the EPO
  - If desired in combination with PACE (accelerated examination)
- Strong basis for PPH (e.g. USPTO and JPO):
  - Enables accelerated examination

Many DOs rely to a large extent on a positive IPER from the EPO.

## Positive IPER: Euro-PCT phase (1)

To ensure consistency the EPO has taken the following measures:

- Same examiner in charge in the subsequent EP procedure as in PCT.
- In case of a positive IPER the future examining division will be consulted already at the Chapter II stage.

Positive results → very high grant rate for positive IPER, and quickly.

## Positive IPER: Euro-PCT phase (2)

Mandatory reply in case of positive assessment of patentability:

- In case no other objections in the IPER (e.g. non-unity, formal, clarity, etc.):
  - It is not necessary to provide a reply to the IPER upon entry into the EP phase.
  - The file will be treated with priority in the EP phase.
- In case of outstanding objections:
  - A substantive reply with amendments to overcome the raised objections, possibly in combination with a PACE request, is expected for a quick grant.

# Key components for Quality at the EPO

## High specialisation

and intensive training of EPO examiners – 4 400 examiners working in divisions of 3.  
Unique amongst IP Offices

EPO **does not outsource** any of its core tasks – **unique amongst IP5 Offices**

**no** outsource of core tasks

First of the world's largest offices to achieve ISO 9001 re-certification for the entire patent process

**World's largest database** for patent searches (1.3 bn records)

**1.3 bn** records

Access to **50 million** original patent **documents from Asia**

**50 million** documents

## Two year training programme

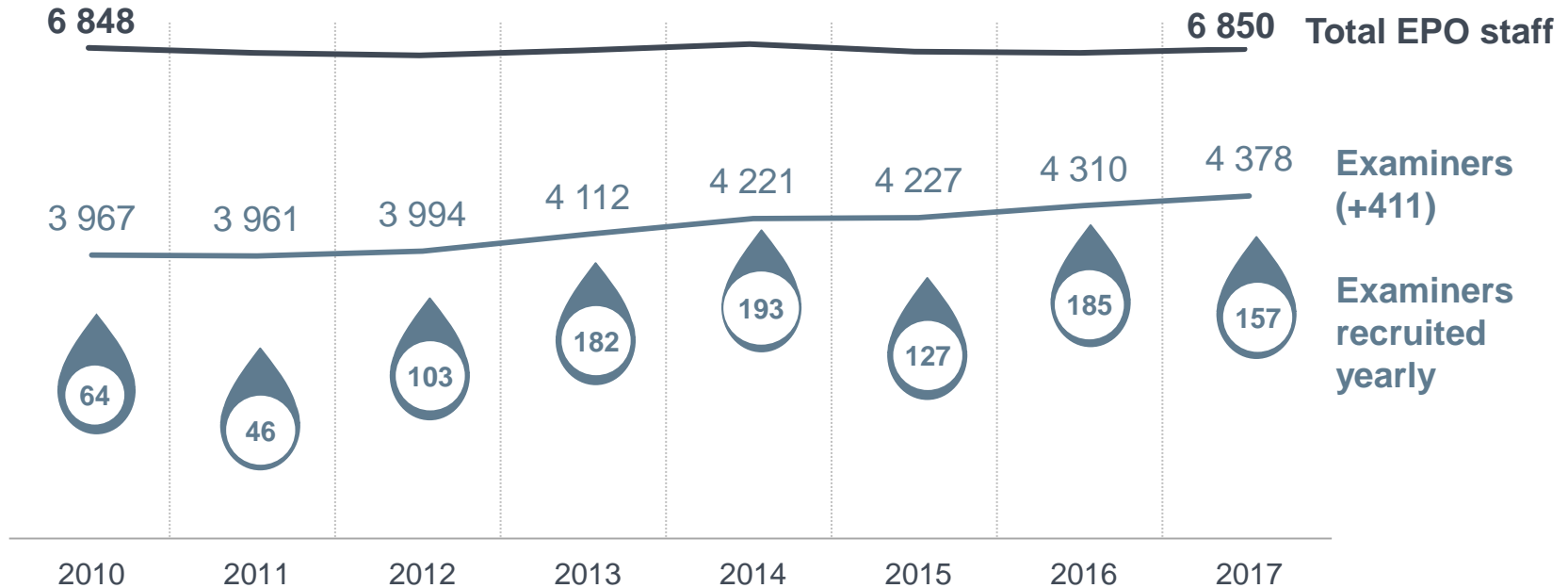
for newly recruited examiners

**State-of-the-art tools efficient access** to patent information (e.g. Patent Translate with Google – 20 000 requests/day)

**patent** information



# Continuous recruitment of examiners



Source: EPO staff figures. Status: 31 December 2017

# Highly qualified and continually trained examiners



## Minimum requirements

- **Master's degree** in physics, chemistry, engineering or natural sciences
- Excellent knowledge of one official language (DE, EN, FR) and the ability to understand the other two
- In 2017 we received 15 000 job applications and hired **only the best 1%**



## Continuous, career-long training on legal and procedural matters

- **45.5 days** initial instructor-led, interactive, classroom training
- First two years: **on the job coaching** by experienced examiners supervising all activities
- In 2017, **94%** of all DG1 staff received **training**
- Over **800 technical missions** per year to stay in touch with applicants
- **Low staff turnover** of 3.4%

# Consistent methods involving three examiners per file (1)



## One legal framework

- The PCT and EPC complemented by extensive, regularly updated guidelines for examinations



## A division of three technically qualified examiners to search and examine a file

- One examiner carries out search and examination
- Agreement from other two examiners required before grant

# Consistent methods involving three examiners per file (2)



**Another division of three technically qualified examiners to conduct oppositions**

- At least two of them must have not been involved in the grant proceedings for the patent



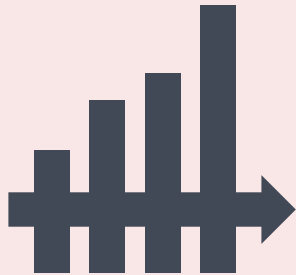
**An independent second instance for appeals**

- The Boards of Appeal Unit



# An EPO applicant friendly fee policy

No inflation-based biennial fee adjustment for 2018-2020



PCT fee reduction measures as of 1.4.2018

**PCT  
search**

**-5%/-100 €**



1 875 €

1 775 €

current  
fee

new  
fee

**PCT preliminary  
examination**

**-5%/-100 €**



1 930 €

1 830 €

current  
fee

new  
fee

**Examination  
European phase**

**-456.25 €**



current  
fee  
reduction

new  
fee  
reduction

-50%

**-75%**

**Thank you for your attention**