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SUBJECT: Treatment of complex applications

DRAWN UP BY: Swedish Patent Office

ADDRESSEES: Central industrial property offices of the Contracting States

This document sets out the comments of the Swedish Patent Office on
EUROTAB 3/2002 drawn up by the European Patent Office.

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Version originale – traduction sera envoyée incessamment

TREATMENT OF COMPLEX APPLICATIONS

Comments from the Swedish Patent Office (PRV) on the issue drawn up by the EPO

1. General remarks

In the PRV there has been a long felt need to get a more strict and consequent approach towards complex applications. The amount of applications with numerous claims or obscure claims has gradually increased during the 1990ths. Such applications consume an unreasonable amount of time, which is not economically justified, apart from causing a prolonged delay for the treatment of normal applications. Further the quality of searches performed in such applications might be poor even if a lot of effort is made. The scope of protection will also be wide and difficult to interpret for third parties.

For the PRV the new EPO approach on complex applications from 1999 was most welcome, as the problems with such applications had long been recognized and discussed. The new EPO approach has therefore been adopted as guiding principles also for the PRV.

For the time being, most of the problems with complex applications have been associated with search and examination. From the formalities section the main view is that such applications may involve the handling of a lot of papers. However, very voluminous applications are very rare.

2. The filing of applications

When **filing** an application it is troublesome if a very large number of pages are involved. This is not very frequent but may occur in chemical applications. Regarding chemical applications with sequence listings applicants are required to file the sequence listings on a discette in order for the sequences to be searchable.

The **formalities check** comprises checking that the various documents required for an application have been filed and thus only concerns the mere presence of a set of claims and a description. The contents and the extent of said documents is, however, the responsibility of the examiner to check before starting the search.

The **scanning** of applications at filing was introduced in 1997 but only for the purpose of preparing priority documents. Paper documents are made from the scanned version of the original documents. Within one year the Phoenix system will be introduced in a simplified version. This version will comprise scanning and electronic data storage. Electronic filing will come in a further step.

The priorities in mega applications not being first filings may be derived from many national applications, even from different countries when big global companies are involved. However, such applications are rare. Today the priority documents are received on paper and may be extensive if mega applications are concerned. When Phoenix is introduced also the priority documents will be scanned.

The possibility of **filing fees** per page for mega-applications have not been discussed. However, this type of fees exists for granting fees, with a basic fee comprising a certain number of pages and further fees per page exceeding this.

3. The publication of applications

Complex or voluminous applications do not cause problems concerning publication as no complete publication at the 18 month date is made. Only the abstract and a relevant drawing are published together with bibliographic data. This publication is made on the Internet and the application is made open to public inspection. The published parts can be reached on the Internet via the Swedish Patent Gazette or Espacenet.

Publication of the complete application is made when the granting procedure is finished. Publication by printing on paper was stopped in 2001. Publication is now made on Internet and the documents are obtainable for the public as mentioned above.

4. Public file inspection

When a file inspection is required in an application which is open for the public, paper copies from the scanned files can be required from the PRV. Concerning extensive sequence listings it would be possible to get a discette copy from the original discette.

Public file inspection will be highly simplified within a couple of years when the future complete Phoenix system is introduced. Then public file inspection will be possible to obtain via a web browser.

5. New approach at search and examination stage

The PRV agrees that a strict approach has to be adopted against the small but increasing number of applicants, who abuse the patent system by creating very exhaustive or obscure patent claims, which are of doubtful use for society, misleading for third parties and creating an extensive work burden for patent authorities. The new EPO approach from 1999 in this matter is based on the applying of existing regulations in a more rigorous way. This way of reasoning has made it easy for the PRV to assimilate the EPO approach and adopt a similar rigorous interpretation of the corresponding regulations in the Swedish Patent Law (PL) and the Swedish Rules of Practice (PB).

The key paragraphs for such interpretation is 8§ PL "The application shall contain a distinct statement of what is sought to be protected by the patent (the patent claims)", further 39§ PL "The extent of patent protection shall be determined by the patent claims. For understanding of the patent claims guidance may be taken from the description", and also 6§ PB "The invention shall be so exemplified that the claims are sufficiently supported". New sections of the Swedish Guidelines for the treatment of Patent Applications were issued already in June 2000, where interpretations and definitions from the EPO Guidelines were adopted and transformed into Swedish practice.

6. The policy in search and examination

The extent of the claimed scope of protection must be reasonable in relation to the contribution to the art given by the invention and to the effort of making a reasonable search over the whole extent defined. Wide and speculative claims trying to monopolize large future developing technical areas therefore have to be treated in a strict and rigorous way.

In the PRV a small number of skilled and experienced examiners have been trained to be experts of complex applications and shall be consulted when such applications are treated in order to ensure a fair and harmonized treatment.

a) National applications

The four types of complexity as defined by the EPO is adopted in Swedish practice. When a search has to be restricted because of complexity the arguments for this restriction is made in accordance with standard clauses used at the EPO.

When complexity is recognised there are principally three different ways to act :

- If certain claims are unclear and obscure and do not define a clear scope of protection, the invention should be searched in accordance with the non-obscure claims. An expert on complex applications should always be consulted. The obscure claims should be commented in the communication. Clear information should be given in the communication about the extent of the search performed.
- If all claims are obscure and undetermined but an invention can be regarded to be defined in the description, an evaluation of the inventive idea should be made from the description. After consultation of an expert on complex application the search is based on the inventive idea or on the examples. In the communication the evaluated inventive idea should be stated and information about the extent of the search performed should be given. In this case and also in the case above the applicant is invited in the communication to revise the claims, after which the PRV might have to make a supplementary search.
- If the claims are so undetermined that a meaningful search cannot be performed a communication without search and with a shortened time limit can be issued, where the applicant is asked to revise the claims, if possible. This will be done only after a thorough consultation of an expert. Cases with no search at all is very rare. If new revised and clarified claims are filed and supported by the originally filed documents a search will be performed.
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In national applications search and examination have always been made in the same step. Further examination will probably have to be made after the applicant's response to a first communication, where revised claims are required.

b) PCT-applications

Concerning PCT-applications the same practice as in the PCT routines at the EPO is used at the PRV for complex applications.

c) Statistics

If the consulted expert agrees that a restricted search is justified, an electronic form concerning complex applications shall be filled in. This form states the kind of complexity and the measures performed. One copy of the form is sent for statistics and one copy is signed by the expert and put in the application dossier.

Statistics on complex applications have been made since September 2000. In 125 applications, national as well as PCT, complexity has been identified. The two most common categories are claims comprising a large number of possibilities and claims defined by a result to be achieved.

7. Conclusion

In the PRV elaborated routines for treatment of complex applications exist and information and education to examiners is given.