

European Patent Office | 80298 MUNICH | GERMANY

Mr James Pooley
Deputy Director General
World Intellectual Property Organization
34, chemin des Colombettes
1211 Geneva 20
SWITZERLAND

European Patent Office
80298 Munich
Germany

PD52
Patent Law and Multilateral Affairs

Principal Director

Tel. +49 (0)89 2399 - 5200
Fax +49 (0)89 2399 - 5270
mfroehlinger@epo.org

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Dear Mr Pooley,

Jim

Thank you for your correspondence of 19 April regarding the preparation of the working documents for the upcoming Standing Committee on the Law of Patents (SCP).

Below please find the EPO contribution:

Exceptions and limitations to patent rights

The topic concerns situations in which the use of an invention contained in an application or a patent is not infringing (e.g. private/non-commercial use, preparation of medicines, etc.). According to Article 64 EPC, this is a question of national law.

Article 64(1) and (3) read:

(1) A European patent shall, subject to the provisions of paragraph 2, confer on its proprietor from the date on which the mention of its grant is published in the European Patent Bulletin, in each Contracting State in respect of which it is granted, the same rights as would be conferred by a national patent granted in that State.

(3) Any infringement of a European patent shall be dealt with by national law.

Quality of patents

A. Work-sharing programs and policy at EPO

1. Institutional work sharing schemes

Rule 141(1) and rule 70b EPC: The EPC entails legal provisions requesting the applicants when claiming a priority to provide at filing (or as soon as available) the search results from the office of first filing (OFF). At examination start in

European Patent Office
Erhardtstr. 27
80469 Munich
Germany

www.epo.org

absence of the OFF search results, the applicant will be reminded that this must be done (Rule 70b(1) EPC).

Rule 141(2) EPC: This provision allows the office to exempt applicants from the obligation indicated above when an agreement exists for the office to office exchange of search results.

Rule 141(3) EPC: At any time during the examination procedure examiners may invite applicants to provide search results of any office working on a family member of an European patent application.

The legal consequence in case of no reply to one of these requests is that the application is deemed withdrawn. This shows that EPO considers the reutilisation of other offices search results very seriously.

2. Work sharing projects

The EPO is actively fostering the inter office cooperation in term of work sharing, in particular within the IP5 framework. The EPO position in this respect is that the OFF should provide as early as possible the search results to the Office of Second Filing (OSF), when the OSF inform the OFF that a priority has been claimed on the basis of one of its applications. This search results exchange should take place at the latest 15 month after the priority date. In this respect the EPO is involved in several bilateral work sharing pilots such as FLASH 2.0 with the USPTO and JP-FIRST with JPO. A similar pilot has been launched recently with SIPO and another is in discussion with KIPO.

3. EPO as work-sharing enabler

The EPO policy towards other offices is supportive for efficient work sharing schemes as it sets a high priority on its first filings which are available for work sharing at 9 months after the filing date, therefore, well before the end of the priority period. Unfortunately this policy is until now rather unique. Deferred examination regimes are on the contrary a hindrance to effective work sharing as search and/or examination in such regimes are delayed for several years.

4. PCT

The EPO considers that the PCT is the platform for effective work-sharing. Therefore the quality of ISR and WOISA is key for re-utilisation by the designated offices.

5. PPH

The EPO is involved in several bilateral PPH pilots and is actively promoting the so-called PCT PPH. Unlike the other work-sharing programs, PPH is applicant driven and linked to subsequent acceleration of the procedure. The IP5 Offices are intending to establish a uniform and all inclusive IP5 PPH programme.

B. Use of other offices search results

The EPO fosters the re-utilisation by its examiners of search results from other offices when available. The EPO believes that systematic re-utilisation of available search results is beneficial to both efficiency and quality.

The EPO recently introduced different measures for encouraging reutilisation of other offices search results.

Pre-search routine: When starting to draft a search report EPO examiners launch automatically a pre-search routine aiming at collecting information relating to the prior art cited by other offices in family members of European patent applications.

Extended top up search: EPO examiners have been instructed to systematically perform a top up search at least at the start and before concluding the examination procedure. The search preparation used for this has been extended to retrieve in addition to the conflicting applications according to Art 54(3), prior art retrieved by other offices.

Access to other offices files wrappers: EPO has provided to its examiners efficient tools for accessing file wrappers at other offices and thereby retrieving and reusing procedural information relevant for their work, in particular information on how cited prior art has been used in other offices examination.

I hope this information will be of use for the preparation of the working documents. Please let me know if I can assist you with anything else.

Kind regards,


Margot Fröhlinger