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How flexible should the EPO be in the timing of the examination process?

Thorsten Bausch (Hoffmann Eitle) · Monday, March 11th, 2019

The results of the EPO's online user consultation on a procedural option for postponing examination of a European patent application have now been published and are available here (pdf). To cut a long story short, users' opinions are quite divided. The overall result is surprisingly similar to the result of the Brexit referendum (52% in favour for providing such an option, 46% against, 2% abstentions), but fortunately the question in dispute is much less relevant and divisive than the UK referendum, and above all no evidence of any illegal influencing has come to light or is to be expected. So I hope we can have a civilized debate on these questions.

The signals from the contracting member states and earlier user feedback were also mixed, thus raising the question what the EPO will now do with all of this. Spoiler: the EPO document provides no hint whatsoever in any direction; it merely lists the main arguments provided by both opponents and proponents and thus allows everybody to develop an informed own opinion.

For background, in autumn 2017, the EPO presented a proposal bearing the slightly unfortunate, if not downright misleading, title „User-driven Early Certainty" (UDEC) offering applicants the possibility to postpone the start of substantive examination by a maximum period of 3 years. Let us forget about the title and focus on the substance and the rationale behind it. It was to provide applicants more time, where needed, to decide about the economic relevance and scope of protection for an invention before incurring significant prosecution and validation costs.

I must say that I always found this rationale quite sensible and liked the idea. This may possibly have to do both with my national and my technical background. In Germany such a possibility has existed for ages (more than 50 years, see §28b PatG 1968) and has never since caused a lot of problems or discussions, at least as far as I can remember. One can also hardly argue that the option of deferred examination has greatly harmed innovation or stifled competition in Germany, which was a fear expressed by some opponents against the EPO's proposal for flexible timing of examination (abbreviated FTE in the following). And in my technical field, i.e. chemistry and pharmaceuticals, I am constantly reminded on how many inventions never make it to market for regulatory or economic reasons and how many applications are dropped in the course of the examination proceedings despite a

positive evaluation of patentability by the EPO. If an opportunity existed to defer the examination of these applications at applicant's request, I do not see why this would cause any harm to the public or applicant's competitors. And the EPO would have more capacity to examine the urgent applications faster.

Clearly, any system of deferred examination or FTE must be accompanied by an easily accessible activation mechanism of examination by third parties. This seems to be almost common ground (75% approval). The EPO asked a question on what further requirements should be attached to the third-party activation mechanism (only disclose identity of third party? – show a legitimate interest? – pay a fee? – any two or three of these requirements?). Given that even oppositions may be filed by a strawman, I do not see a need why a third party objecting to deferred examination of a particular application should be required to identify itself; at least I would support the notion that a request filed by an authorized representative before the EPO should always be valid. I would also not support a fee. The applicant must pay the examination fee anyway, and deferred examination is a favour the EPO would do him upon request, if there are no contravening interests of third parties.

But, as stated above, opinions on this matter are divided, and reasonable minds may very well differ. Thus, I hope for and look forward to a civilized debate in the comments on this blog. And I hope that the EPO will take note thereof and let us know soon what its conclusions are from this discussion.

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