

# Examination delays can be a substantial procedural violation

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Late in 2018, Board 3.5.07 issued two decisions on appeals from Examining Division decisions, in which the length of the examination procedure was excessive. The Board decided that such delays can amount to a substantial procedural violation, but that it is only equitable to reimburse the appeal fee if the applicant took some proactive measures to try to move examination along.

T2707/16 was the first of these two decisions and has the full analysis of the contributing factors to the finding of a substantial procedural violation and subsequent decision T2377/17 provides more of a summary.

## How long is too long for examination?

T2377/17 concerns an application for which over 16 years elapsed between regional phase entry (October 1999) and issuance of the first Rule 71(3) communication (August 2016). In T2707/16, the first instance decision to refuse (July 2016) was over 14 years after the filing date (November 2001).

Clearly these are exceptionally long durations for patent examination, considering the 20-year maximum term of a patent. The Board did not provide any hard line as to exactly when accumulated examination delays tip from merely long to excessive, but does provide a thorough assessment of the factors that should be considered in reaching a conclusion either way.

## Reimbursement does not require that the substantial procedural violation necessitated the appeal

Board 3.5.07 reasoned that it is not a requirement that the procedural violation (i.e. the excessive delay) affected the reasoning of the decision under appeal in order for that violation to be substantial. This is because the date of the decision is an "essential element" of the decision itself (T2707/16, reasons 34).

T2707/16 analyses the position of the patent system within the wider context, noting that competitors are negatively affected by long delays, which is undesirable for competition (reasons 20 onwards).

In addition, the Board makes references to decisions of the European Court of Human Rights as regards to the length of administrative procedures and access to a court (reasons 29).

As summarised in T2377/17, "the requirement that the procedural deficiency was causal for the necessity to appeal, which in the jurisprudence of the boards of appeal is often considered to be a necessary condition for reimbursement of the appeal fee to be equitable, does not in fact sufficiently take into account all possible circumstances in which reimbursement may be equitable" (reasons 7.4).

## What measures may applicants take?

In T2707/16, reasons 36, the Board wrote that it "is nevertheless of the opinion that a reimbursement of the appeal fee in view of unreasonable delays in first-instance proceedings should be regarded as equitable only where the applicant has made clear by some action that he did not tacitly agree with the stagnation of the proceedings".

A timely-filed enquiry as to the expected date for the next communication and a request for acceleration (i.e. PACE) are specifically mentioned in T2707/16 as possible actions that indicate disagreement with stagnation of examination proceedings. Regardless of the means chosen in attempt to drive forward the examination procedure, the key point is to be proactive.

In T2377/17, the Board found that reimbursement of the appeal fee was equitable because the applicant had made attempts to accelerate the examination procedure (reasons 7.6).

## Criticism of the system, not the examiners

The decision T2707/16 emphasises that examination should not be rushed, acknowledging the skill and effort required for quality examination of patent applications, which it notes is an "intellectually demanding task of high responsibility" (reasons 18). Here, a distinction should be made between the actual time that an examiner requires to prepare for and write an examination report, which is a necessary expenditure of time, and the time that the patent application spends in a queue for examination, which is an unnecessary delay.

T2707/16 further takes care to avoid criticising individual examiners, instead calling out the system that allows files to languish in cupboards real or electronic for so many years (reasons 33).

G1/05 and T84/82 are also referenced. In particular T84/82 notes the aim of the EPO "to carry out the substantive examination thoroughly, efficiently and expeditiously". Hence not only should undue delays be avoided, but examination should also be thorough and not rushed.

## User-driven Early Certainty

These decisions raise questions as to the proposed "User-driven Early Certainty" (i.e. postponed examination) system. In particular, if an application is treated as a regular, non-accelerated file on exit from the postponement period, then an unacceptable accumulation of delays can be envisaged.

In contrast to the focus on EPO stakeholders in the recent EPO survey on postponed examination, the Board 3.5.07 considered in T2707/16 and T2377/17 the needs of the wider public and the position and purpose of the patent system in the economy.