EPO2day 2019

Final stage of grant procedure

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28 February 2019
Presenting today

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At the EPO since 2011

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Legal and policy advisor at STPO (2005-2011)

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The final stage of the grant procedure

Agenda

- The final stage of the grant procedure at a glance
- Amendments proposed by the division
- Waiver to a further Rule 71(3) communication
- Third party observations
- Errors in the application documents
- Editing and formatting errors
The final stage of the grant procedure

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The final stage of the grant procedure at a glance

Intention to grant

Communication under Rule 71(3) EPC

4-month time limit

Applicant's reaction

Next office action / legal consequence

- approval of the proposed text
- request for amendments
- simple disapproval
- no response

- decision to grant
- new intention to grant
- resumption of examination
- resumption of examination
- (refusal?)
- application deemed withdrawn
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Amendments proposed by the division

Amendments

The text intended for grant under Rule 71(3) EPC may include amendments and corrections made by the examining division of its own initiative,

- which it can reasonably expect the applicant to accept
- In case of doubt, the division will contact the applicant

Rule 71(3) EPC
(GL C-V, 1.1)
Warm-up question

Question

May the examining division reformulate a claim in a communication under Rule 71(3) EPC into the two-part form without previous consultation with the applicant?

- yes  
- no
Warm-up question – solution

Solution

May the examining division reformulate a claim in a communication under Rule 71(3) EPC into the two-part form without previous consultation with the applicant?

† The correct answer is: yes
Amendments proposed by the division (I)

Amendments

Examples of amendments which can be introduced by the division without previous consultation with the applicant:

- amendments in the description to:
  - bring it into conformity with the claims
  - delete vague general statements or irrelevant matter
  - introduce a summary of background art

- amendments in the claims which clearly need to be made, e.g. to reformulate them into an allowable format
Amendments proposed by the division (II)

Amendments

Examples of amendments which may **not be proposed without consultation**:

- amendments **significantly changing the meaning or scope** of the claims, if there are different ways of amending them

- **deletion** of entire claims, with the exception of "omnibus claims"

- **combining claims**, so as to overcome a novelty or inventive step objection
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Waiver to a further Rule 71(3) communication (I)

When requesting amendments or corrections to the text intended for grant (Rule 71(3) communication), the applicant may waive his right to a further Rule 71(3) comm.

(GL C-V, 4.11)
Waiver to a further Rule 71(3) communication (II)

Waiver

Requirements of an **effective waiver**:

- the waiver must be expressly indicated
- filing of the translation of the claims and payments of the fees due for grant
- indication of the basis of the amendments (Rule 137(4) EPC)
- the waiver is consented to by the examining division,
  
  } if it does not require resumption of examination
In reply to a communication under Rule 71(3) EPC, the applicant requests some minor amendments and states the following:

“The issuance of a new communication under Rule 71(3) EPC is not required, unless the examining division considers it strictly necessary”

Can this be interpreted as an express waiver to a further communication under Rule 71(3) EPC?

yes  no
Question on "expressly indicated"

Solution

“The issuance of a new communication under Rule 71(3) EPC is not required, unless the examining division considers it strictly necessary”

Can this be interpreted as an express waiver to a further communication under Rule 71(3) EPC?

† The correct answer is: “no”
Waiver to a further Rule 71(3) communication (III)

Waiver

Consequences of an effective waiver:

§ no further communication under Rule 71(3) EPC before grant

§ "information under Rule 71(3) EPC" (Form 2004W) published in the European Patent Register
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Third party observations (I)

Intention to grant

Communication under Rule 71(3) EPC

4-month time limit

Applicant's reaction

approval of the text for grant

Next office action / legal consequence

grant

grant

resumption of examination

request for amendments + waiver

filing of third party observations
Third party observations (II)

Recap

The decision-making process following written proceedings is completed on the date the decision to be notified is handed over to the EPO postal service.

Until that moment, the examining division may resume the examination proceedings at any time.
Recap

Where third party observations are received before the issuance of the Rule 71(3) communication, the division indicates (Form 2004) the relevance of them.
Third party observations (IV)

Observations

Third party observations received after issuance of a Rule 71(3) communication (and before completion of the decision-making process)

- If relevant
  - resumption of examination

- If not relevant
  - no further substantive communication
  - procedure continues to grant
  - the division publishes a brief substantive assessment of the observations in the Register
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Errors in the application documents (I)

Errors

Any errors in the approved text can be corrected before the completion of the decision-making process

After the issuance of the decision to grant (G 1/10):

- Rule 140 EPC is not available to correct errors in the text of the granted patent (description, claims and drawings). Such requests are to be rejected as inadmissible.

- The applicant is held responsible for any errors remaining in the approved text
Errors in the application documents (II)

Errors

Possibilities for the post-grant correction of errors:

- Rule 140 EPC is available for the correction of errors in bibliographic data
- Correction of editing and formatting errors (H-VI, 3.3)
- Appeal (and interlocutory revision) against the grant, if the errors were introduced by the examining division after the approval (case of waiver)
- Amendments during opposition or limitation proceedings
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Editing and formatting errors (I)

Errors

Formatting/editing errors are **alterations in the patent documents** occurring during the **technical preparation** of the text intended for grant (**eDrex**), and which are indicated neither by **standard marks** nor in the text of the communication under Rule 71(3) EPC.

E.g. some lines disappear:

8. Method according to claim 6 or 7, wherein (19) and (20) are obtained by real-time calibration. (end of page)

(following page)

the information obtained regarding the distance is used to control equipment associated with the painting process.

10. Method according to any of the preceding claims, wherein the information regarding the distance is displayed on a graphic user interface or other display means.
Editing and formatting errors (II)

Errors

Errors **not qualifying** as editing and formatting errors:

- **non-marked substantive amendments**
  - errors introduced by the Examining Division or the applicant and contained in the part of the application having been amended
  - errors which the applicant could have been reasonably expected to identify when approving the text for grant

- Available means of redress: appeal