



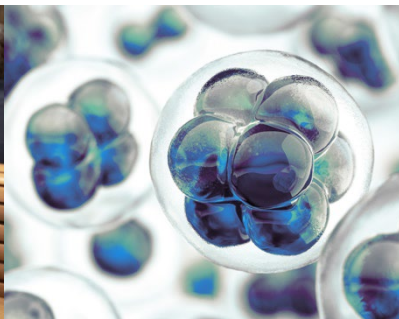
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Examination Matters 2021

How to successfully communicate with the examining division



Stephan Tatzel
Harald Schmidt-Yodlee



epi
Senior expert | Healthcare, Biotechnology and Chemistry



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Presenter



Stephan Tatzel

- European and German patent attorney, Diploma from the University of Strasbourg in European patent litigation
- **isarp**patent®, Munich
- Chemistry, pharma and biotechnology
- Degree in Chemistry; PhD in Biotechnology, University of Stuttgart
- Experienced tutor for the EQE and co-author of a legal commentary on the EPC 2000



Presenter



Harald Schmidt-Yodlee

- Senior expert, EPO
- Search/Examination/Opposition, since 2001
- Sector Healthcare, Biotechnology and Chemistry –
Biotechnology, The Hague
- Degree in Food Chemistry; PhD in Biochemistry,
Technical University Berlin



Programme

- Introduction
- Consultations
- Minutes of consultations
- Emails
- Oral proceedings
- Positive suggestions
- Case studies

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Question



How often do you have informal contact with a member of the examining division (by telephone, email, video calls?)

- Often
- Sometimes
- Never

Introduction

- EPC sets formal communication standards (Articles 94(3), 113, 116 EPC)
- In most cases, applicants and examining division communicate in writing
- Informal communications possible: consultations by telephone or by video-conference, emails (Guidelines C-VII, 2)
- Informal consultations must be reflected in file history

Art. 94 EPC

Examination of the European patent application

Art. 113 EPC

Right to be heard and basis of decision

Art. 116 EPC

Oral proceedings

Introduction

- Informal communications can be initiated by either the applicant or the examiner
- Discretion of examiner to grant a request for informal communication
- No decision can be taken during an informal consultation

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Consultations

Consultations can be held by

- telephone or
- videoconference (using MS teams or ZOOM)

Guidelines C-VII, 2.1

Consultations

Consultations are **not** allowed:

- At the search stage (Guidelines B-II, 1.1), unless a Rule 62a and/or 63 EPC invitation has been issued
- Discussion of substantive issues after receipt of an invitation under Rule 62a and/or 63 EPC (Guidelines B-VIII, 3.2.2 and 4.2.2)
- When the file is not (yet) in examination phase (Guidelines B-XI, 8)

Consultations

Consultations are allowed:

- At the search stage to discuss formal issues in reply to an invitation under Rule 62a/63 EPC (Guidelines B-VIII, 3.2.2 and 4.2.2)
- When the file is in the examination phase (Guidelines B-XI, 8)
- At the examination stage as the first action to replace a normal communication under Article 94(3) EPC (Guidelines C-VII, 2.7)

Consultations – applicant's view

Consultations are **good practice**, when:

- Errors in the communication/reply which make it difficult to prepare the next action
- To clarify misunderstandings
- Before oral proceedings: to check whether the representative will attend the oral proceedings

Consultations – examiner's view

Consultations are **good practice**, when:

- Possibility for grant:
 - Minor issues remain in the claims which are beyond what can be changed *ex officio*
 - When submitted amendments are insufficient, yet an alternative can be proposed

- After Rule 71(3) communication:
 - if applicant has requested amendments/corrections to which the examining division cannot agree

Consultations – Question



Scenario:

In the international phase, the EPO as ISA found that the original 180 claims lacked unity and were only partially supported and disclosed by the description. When entering the regional phase before the EPO, the number of claims has been reduced.

There are, however, severe issues with lack of unity, non-searched subject-matter, technical support and disclosure. The examiner calls the applicant.

What would be your reaction?

- Discuss the file with examiner over the phone
- Ask examiner to issue a written communication

Consultations – Answer



- Discuss the file with examiner over the phone
- Ask examiner to issue a written communication**

The case is rather complex and there are still issues with unity of invention. Probably, an invitation under Rule 164(2)(a) EPC is due.

Consultations

- Cases in which consultations are **less appropriate**:
- Asking examiner to defer examination
- Asking an examiner who is not member of the division to discuss the case with the first examiner
- Asking for a preliminary opinion on claims to be filed in reply to the written opinion before formally entering the examination phase
- Asking for a pre-search for a divisional to be filed
- Asking examiner about formal issues (time extensions, fees)

Question



How would you contact the first examiner in an urgent case?

- I call the telephone number of the examiner indicated on the communication
- I call the customer service indicated on the communication
- I try to send an email to the examiner's personal email address

Answer



- I call the telephone number of the examiner indicated on the communication**
- I call the customer service indicated on the communication**
- I try to send an email to the examiner's personal email address

You can call the number of the first examiner or contact customer desk in Munich or The Hague. Customer desk records the applicant's contact details, creates a CRM ticket and informs the first examiner and the examiner's line manager.

Consultations – Personal interviews

- Personal interviews at the premises of the EPO are no longer foreseen
- Applicant's request for a face-to-face interview at the premises of the EPO is rejected
- Possibility of holding consultation as video-conference

Guidelines C-VII, 2.1

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Minutes of consultations

- Oral statements must be confirmed in writing in order to be procedurally effective
- Minor points: sufficient to mention matter discussed
- Major points (novelty, inventive step etc.): complete record of the matter discussed
- If action by applicant is required, minutes are issued with a time limit

Minutes of consultations

- Indication of next action necessary
- For information only (previous time limit is running)
- New time limit set or time limit extended
- Time limit associated with despatch of minutes

Minutes of consultations

- Telephone consultation as first action: triggers start of examination (no full refund of examination fee is possible upon withdrawal of application)
- Any document (such as amended claims) filed during the consultation is attached to the minutes
- Minutes and attachments are part of the public file dossier

Minutes issued as the first action in examination replace the first communication under Art. 94(3) and Rule 71(1), (2) EPC (Guidelines C-III, 4; C-VII, 2.5)

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Question




Statement:

An email has never a legal effect in proceedings under the EPC and thus cannot be used to validly perform any procedural act

Is this statement true?

yes

no

 = yes

Answer



During consultations and oral proceedings held by videoconference, documents filed subsequently as referred to in Rule 50 EPC, including authorizations, must be filed by email.

Other than in the above-mentioned cases, email has no legal effect in proceedings under the EPC and thus cannot be used to validly perform any procedural act and, in particular, cannot be used to comply with time limits (see OJ EPO 2000, 458, and Guidelines A-VIII, 2.5; Guidelines C-VII, 3)

yes

no

Emails

Emails may be useful:

- for arranging a date for a consultation
- if during a consultation possible amendments to claims are being discussed the applicant might want to communicate these immediately without submitting them formally
- shortly before oral proceedings: sending an electronic copy of amended claims in addition to the official submission made

Guidelines E-VII, 3

Emails

- There should be mutual agreement between examiner and applicant to use emails, if the content goes beyond arranging a date for consultation or oral proceedings.
- Examiner is responsible for adding the email to the file
- Emails cannot replace an official communication under Article 94(3) EPC
- Amended application documents must be filed as attachments in PDF format

Emails – Signature

Where the filed documents require signature:

- Signature may be applied to the attached document or to the text of the accompanying email
- The signature may take the form of a string of characters or a facsimile signature
 - The string of characters must clearly indicate the person's name and position
 - A facsimile signature is the facsimile reproduction of a person's signature

Guidelines E-III, 8.5.2
OJ 2020, A71, Art. 2

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Question



What happens if the applicant has severe technical problems during a video-conference (e.g. lost connection)?

- The oral proceedings will continue in the absence of the applicant
- A new date will be scheduled, and applicant will be summoned to attend oral proceedings at the premises of the EPO
- A new date for oral proceedings held as video-conference will be scheduled

Answer



- The oral proceedings will continue in the absence of the applicant
- A new date will be scheduled, and applicant will be summoned to attend oral proceedings at the premises of the EPO
- A new date for oral proceedings held as video-conference will be scheduled**

In case of total or partial breakdown in communication, the video-conference is terminated and a new summons to oral proceedings is issued.

The EPO will not attempt to re-establish the line in case of technical problems, but the applicant may be contacted by phone and asked to do so.

As a rule, new oral proceedings will be held by videoconference, unless there are serious reasons for not doing so.

Guidelines E-III, 11.3

OJ 2020, A122 , point 22

Oral proceedings

- Oral proceedings will take place before the whole examining division
- Oral proceedings are generally held by video-conference, unless there are serious reasons
 - reasons relating to participant as individual
 - reasons related to subject-matter of the proceedings

OJ EPO 2020, A134, Art. 1(2)

Oral proceedings – tips and tricks

- Indicate in the submission in reply to Rule 116 EPC that you intend to call the first examiner to discuss outstanding objections
- Call the first examiner at latest one week before oral proceedings
- Maybe oral proceedings can be avoided
- If summons are maintained prepare electronic copies of documents likely to be amended


Question



As a first action in the examination phase, have you ever been summoned to attend oral proceedings?

yes

no

 = yes
Raise Hand

Answer



The number of summonses to attend oral proceedings as first action in examination is rather low and is only allowed in exceptional cases (Guidelines C-III, 5).

Oral Proceedings as first action in examination

- **Annex** to the summons ...
 - must be as detailed as a communication under Article 94(3) EPC
 - must not include new objections or cite new documents
 - must justify why summons are issued as 1st action
- At least 6 months notice must be given
- Requests filed after the Rule 116(1) EPC deadline are not to be treated as late-filed

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Positive suggestions

- Advantage: provides applicant with division's position at the earliest possible time



The applicant is responsible for any amendment

Guidelines C-III 4.1.2
Guidelines B-XI, 3.2.2

Positive suggestions – when it is beneficial

- To introduce an essential feature from description to establish clarity, novelty or inventive step
- To replace an unclear or broad term with a clear or more specific term
- To combine an independent and a dependent claim
- To re-formulate the claim as clear second medical use claim
- To introduce a disclaimer with respect to Article 53 EPC issues

Positive suggestions – when it is risky

- Amendments for which compliance with Article 123(2) is not straightforward
- Adding several features from description which combination may not be directly and unambiguously derivable
- Amendments with features from specific examples or tables which may result in non-admissible intermediate generalization
- Arbitrarily chosen features which do not reflect the contribution to the prior art

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Question



Case study 1

- The examining division issues an intention to grant (Rule 71(3) EPC)
- The applicant requests correction of typos in *Druckexemplar*
- The examining division consents to corrections and issues a new intention to grant
- The applicant disapproves text and files a new set of claims dependent claim 3 split into two dependent claims 3 and 4
- The examining division does not admit the new set of claims

What is expected as next action?

- The examining division issues a written decision refusing the application
- The examining division calls the applicant
- The examining division has to issue a further communication pursuant to Article 94(3) EPC, or a summons to attend oral proceedings

Answer



- The examining division issues a written decision refusing the application
- The examining division calls the applicant**
- The examining division has to issue a further communication pursuant to Article 94(3) EPC, or a summons to attend oral proceedings**

The examining division can envision the refusal of the application, as there is no text agreed by the applicant on which a decision can be based. The examining division issues a further communication, summons to oral proceedings or can call the applicant (Article 113(2) EPC).

It is also recommended that the applicant calls the examiner to discuss amendments to the application prior to his second written request for correction.

Art. 113 EPC

Right to be heard and basis of decisions

Question



Case study 2

- In October 2020 applicant informs representative that he is not interested in the application any more
- The application shall not be actively withdrawn, but the renewal fees due in August 2021 shall not be paid. No further costs shall arise
- In April 2021 a summons to attend oral proceedings is issued by the examining division for November 2021

How would you react as representative?

- Call the first examiner and inform him about the circumstances
- Do nothing
- Withdraw the request for oral proceedings

Answer



It depends on what is the best choice for the applicant!

Further questions



Now

via chat to "All Panellists"

Later

via e-mail to academy@epo.org

BONUS slides

Consultations during PCT international phase

Article 34(2) and Rule 66.6 PCT give the applicant the right to communicate orally with the IPEA

In PCT Chapter I:

- For informal clarification (PCT-CLAR) before search (see PCT-EPO Guidelines B-VIII, 3.3)

In PCT Chapter II:

- Where there is a request for telephone consultation
- When requested by applicant: must be granted at least once
- Only possible after a written response to the WO-ISA or an invitation to pay additional fees (see PCT-EPO Guidelines C-VII, 1)

Consultations during PCT international phase

- EPO is the only IPEA worldwide that issues a second written opinion (Rule 66.2 PCT)
- If you wish to have a positive international preliminary examination report:
 - Wait for the second written opinion to be issued
- Then immediately request a telephone consultation
- The request for a telephone consultation must be granted before a negative international preliminary examination report is issued