

European patent prosecution

Tips to reduce costs while maintaining quality

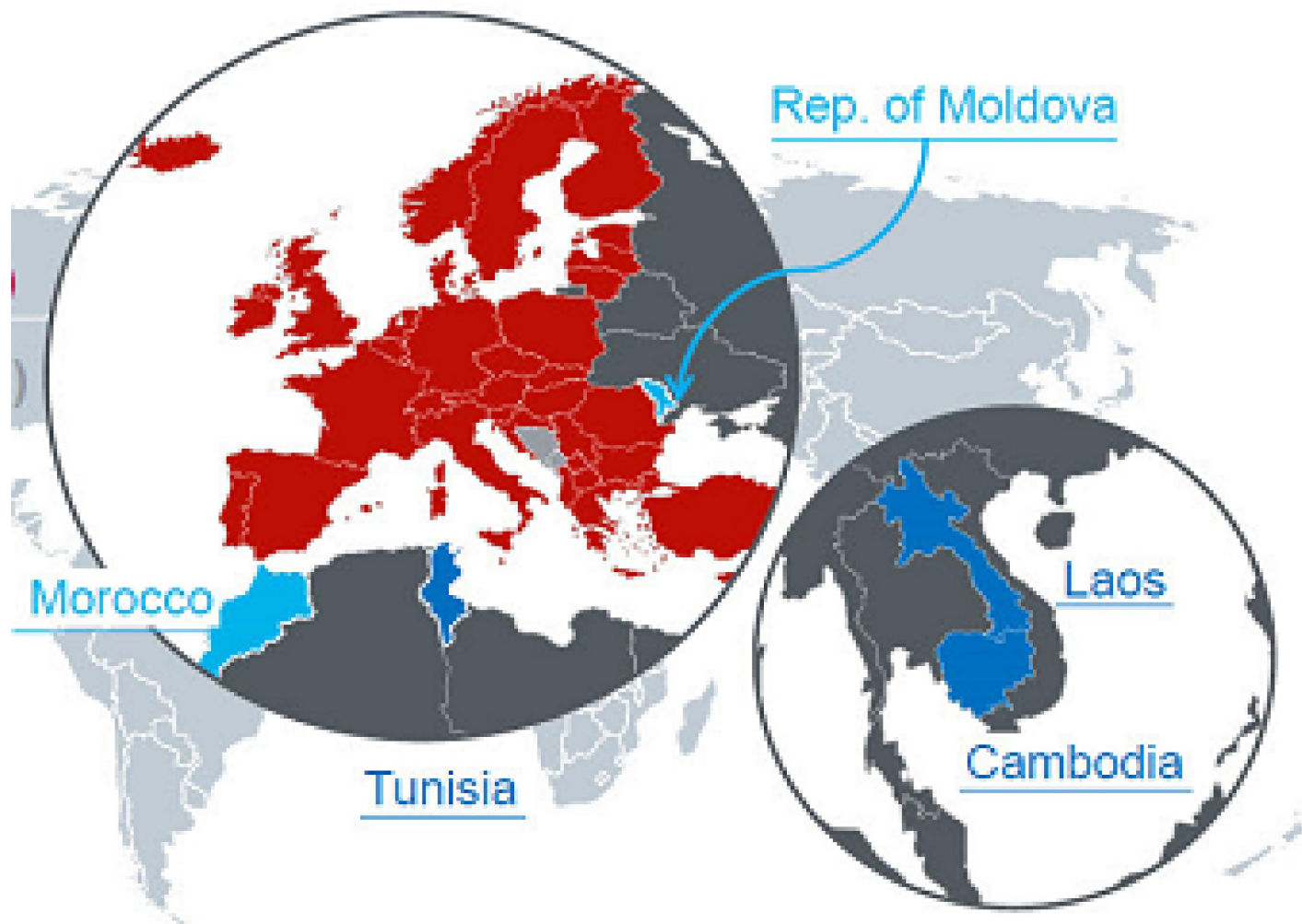
Scope of this presentation

- Overview of the European (EP) prosecution mainly of Euro-PCT applications
- Identify the available options for reducing costs while not impairing quality

European patent system (1/2)

- European member states: 38
(European Union countries + 10 countries, including Norway, Switzerland, Turkey, etc.)
- European extension states: 2
(Bosnia and Herzegovina, Montenegro)
- Validation states: 3
(Republic of Moldova, Morocco, Cambodia)

European patent system (2/2)



Source: EPO

Euro-PCT: main steps

- Priority application
- PCT claiming the priority
- Entry of the PCT in the EP phase
- EP Search and Examination
 - Renewal fees due to the EPO
- Grant of EP patent
- Validation: bundle of national patents
 - Renewal fees due to national Offices

Total pendency*

- EP direct
 - 51.9 months (goal: 36 months)
- Euro-PCT where EPO is ISA
 - 66.0 months (goal: 49 months)
- Euro-PCT where EPO is not ISA
 - **73.9 months** (goal: 61 months)
- EP Divisionals
 - 31.2 months (goal: 24 months)

*From priority to grant, status as of September 2017

Factors impacting costs

- Drafting the JP priority and the PCT application
- Translation of the PCT application into English
- Length of the EP procedure
- Number and type of validation states

The application (1/3)

- Quality of the JP priority application
 - more chances to have a valid priority date
- Quality of the PCT application
 - more room for clearly supported amendments and fallback positions
- Quality of the translation of the PCT application
 - less clarity issues

The application (2/3)

- Do not qualify any feature as essential
- Provide several fallback positions in the summary, including intermediate fallback positions between the independent claims and the detailed embodiments:
 - e.g. Claim 1: A+B. Detailed embodiment: A+B+C+D. Amendment A+B+C is not supported under Art. 123(2) EPC
- Use multidependencies in the claims

The application (3/3)

- Avoid claims containing the result to be achieved
- Define the product/apparatus claims in terms of structural features
- Define the method/process claims in terms of steps
- Avoid claims referring to unclaimed entities

Length of the EP procedure

- Shortening the EP procedure reduces:
 - number of Office Actions, responses and related professional fees
 - number of annuities due to the EPO
 - 3rd year: EUR 470 ~ JPY 62,000
 - 10th year (constant from 10th year on): EUR 1575 ~ JPY 208,000

Search and Examination (1/2)

- Prosecute max. 15 claims (no claim fees) when entering the EP phase
- Prosecute only one independent claim per category (product or apparatus, method, use) when entering the EP phase
- Submit clearly supported amendments on entry in the EP phase and later on
- Do not request time extensions

Search and Examination (2/2)

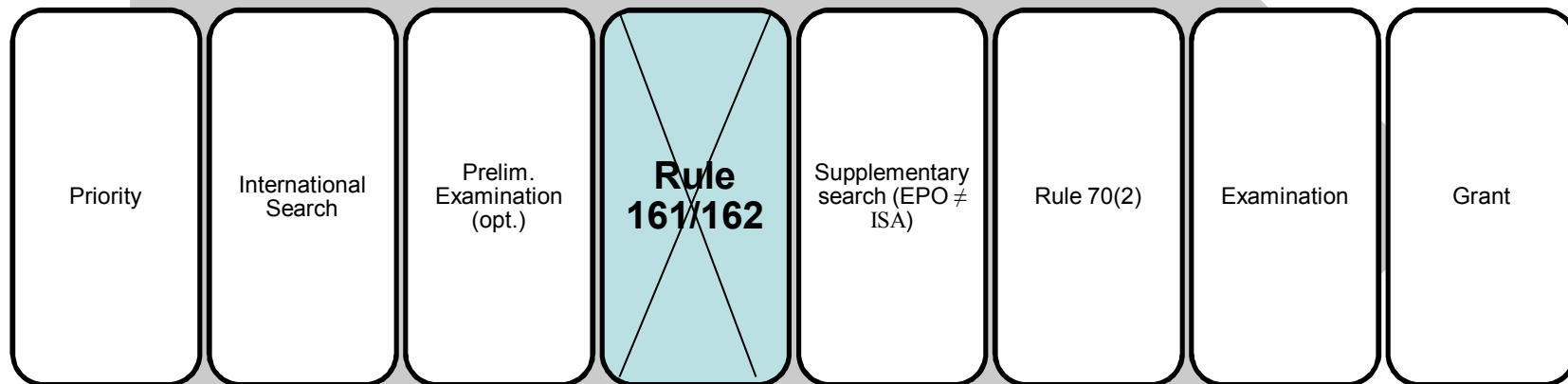
- Use waivers
- Use programme for accelerated prosecution of European patent applications (PACE)
- Do not forget PCT-Direct when applicable
- Make Early entry of PCT into the European phase
- Use Patent Prosecution Highway (PPH)

Clearly supported amendments

- Based on summary
- Based on dependent claims by respecting the dependencies
- Not exclusively based on drawings
- Not based on detailed examples
- Do not drop features disclosed in combination, i.e., do not extrapolate features from an embodiment

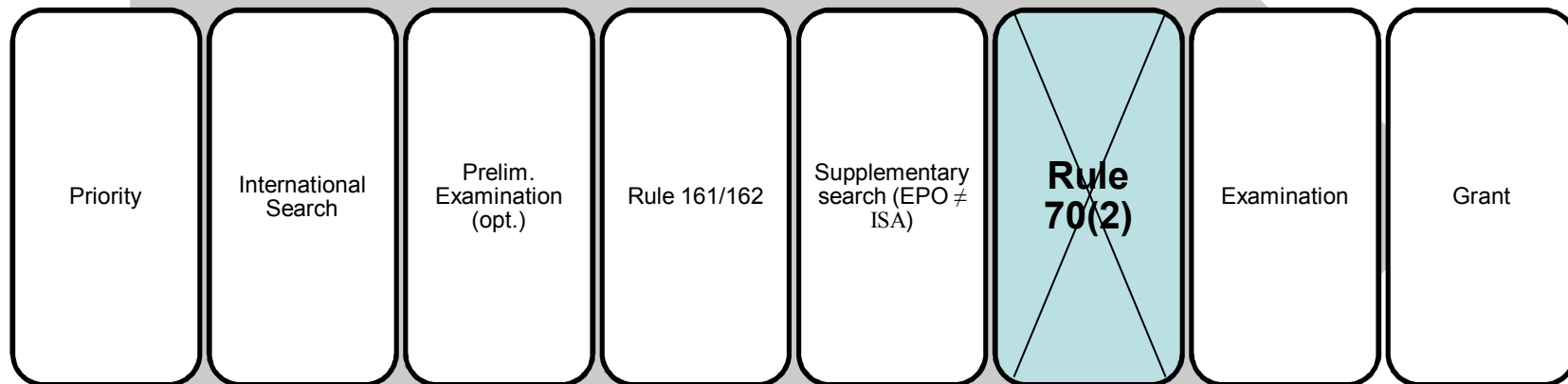
Waivers

- Rule 161/162 EPC for further amending the application
- Rule 161/162 waiver to save 6 months



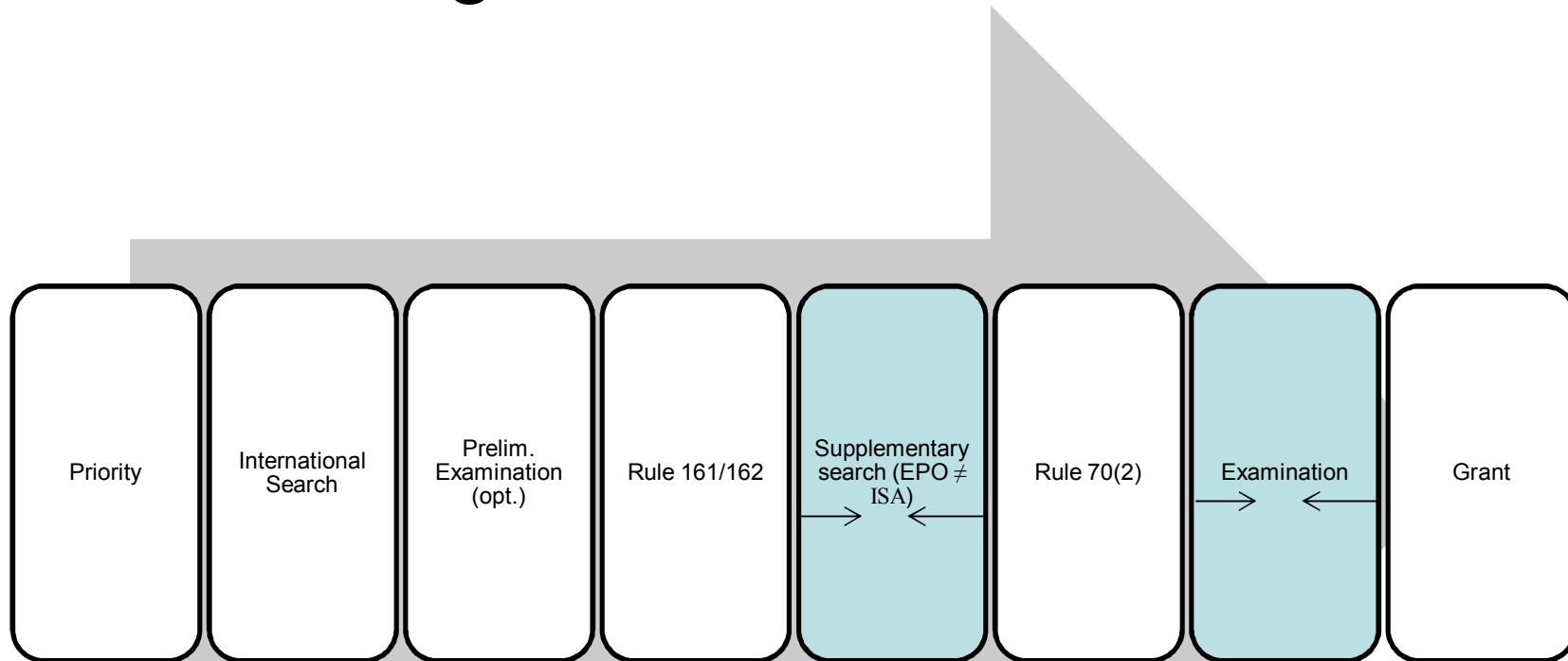
Waivers

- Rule 70(2) EPC for proceeding further
- Rule 70(2) waiver to save 6 months



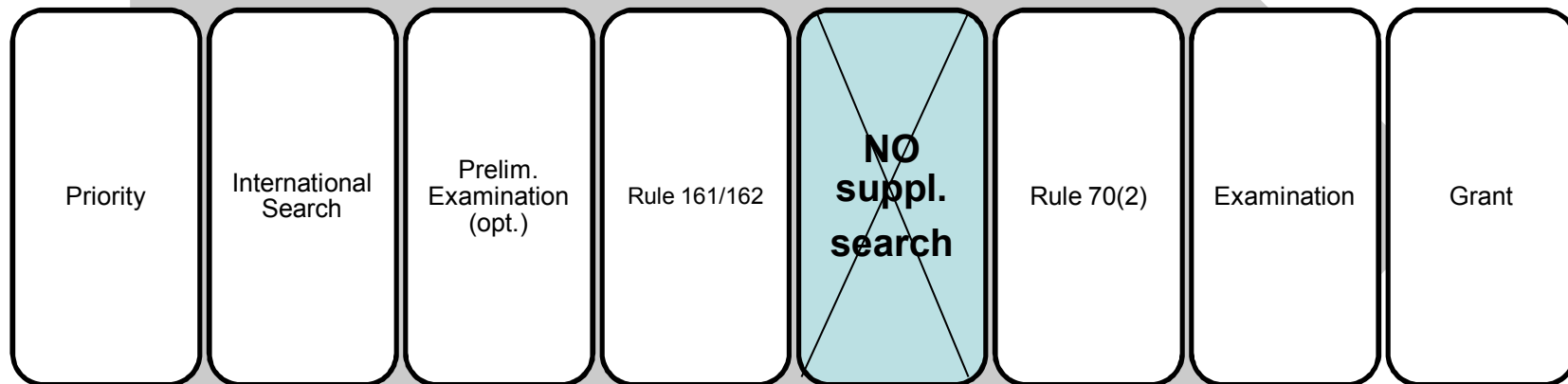
PACE Request

- Processing is accelerated



Choose EPO as ISA

- No supplementary search is performed
- No search fee is due
- Save 6 months



PCT Direct

- Suitable for your European subsidiaries or when you need protection only in Japan and Europe
- File priority application with the EPO
- Respond and amend the application in response to EPO search opinion
- File PCT application claiming priority with EPO as ISA and attach PCT Direct letter including arguments of said response
- The ISA Written Opinion takes account of the PCT Direct letter
- Chances of positive outcome are increased

Early entry into the EP phase

- Perform early the entry into the EP phase, i.e., well before the 31-month deadline
- File an express request for early processing
- If the entry is performed from the publication date and before the 31-month deadline, up to 13 months after publication may be saved

PPH

- PPH may be requested with an EPO partner office when at least one claim is allowable in an EP search opinion/office action
- EPO partner offices: Japan, China, Korea, the US, Australia, Brazil, Colombia, Malaysia, the Philippines, Russia, the Eurasian Patent Office, Canada, Israel, Mexico and Singapore

Grant

- Sometimes formal amendments need to be filed in response to a first Communication under Rule 71(3) EPC (intention to grant)
- In this case, the right to a second Communication under Rule 71(3) EPC may be waived
- Save 4 months

Validation states

- Focus protection on EPC countries party to the London Agreement
- Translation costs may be saved
- No translation costs and no official fees:
 - Germany (21.1% GDP), United Kingdom (16.0%) , France (15.0% GDP), Belgium (2.8 GDP), Ireland, Switzerland+Liechtenstein, Luxembourg, Monaco

ご清聴ありがとうございました



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