

# Bringing the European patent grant process into focus

The European Patent Office's Raising the Bar initiative is designed to ensure that the office continues to issue high-quality patents

By **Thomas Hammer**, European Patent Office

After 30 years of successfully supporting innovation in Europe and beyond, it has become obvious that the European patent system needs adjusting and updating. Now that the political push for a unified EU patent system finally seems to be making progress and, at a global level, a common approach among the five largest patent offices for tackling the issue of backlogs is taking shape, the European Patent Office (EPO) has been carefully considering ways in which these important processes can be reflected in its day-to-day practice. The guiding principle has been to fine-tune patent practice in such a way that the European system can maintain its reputation as the efficient and just system that its founding fathers intended it to be.

To achieve this, experts at the EPO have been submitting its procedural mechanisms to meticulous scrutiny: What can be done to speed up the procedure? How can the quality of incoming patent applications be improved? In what ways does the present application of the office's rules allow uses of the patent system that were not intended by the legislature? And finally, how can the overall aims of the 2000 revision of the European Patent Convention (EPC) be further strengthened?

In response to justified external criticism, as well as the internal perception of procedural inadequacies, an initiative has been started which should help the office to "raise the bar", ensuring that a greater

number of sound patents are granted in future.

Although comparatively unspectacular in its project description, this initiative has quickly emerged as pivotal for the success of any far-reaching changes to the existing patent system. Fully aware of its implications, the EPO has invested considerable internal resources to guaranteeing the project's success. Unfortunately, Raising the Bar has rapidly become a catchword inside and outside the EPO, conjuring up an image of raising the patentability standard at the EPO and, in turn, making the chances of patent protection being granted lower at the EPO than at other patent offices around the world. This perception does not, however, reflect what really lies behind Raising the Bar.

## The basics of Raising the Bar

In essence, the Raising the Bar measures have the following aims:

- To support the EPO's practice with respect to assessment of patentability requirements.
- To enable examiners to ensure that the search is focused on the subject matter for which protection is sought.
- To place more emphasis on the search opinion and streamline the search and examination process.
- To formalise the existing welcome applicant practice of identifying and indicating the basis of amendments.
- To restrict the filing of divisional applications to 24 months from the date of either the first communication or a specific non-unity objection raised by the examining division for the first time, whichever falls later.

These points make it very clear that Raising the Bar is not about raising the level of inventive step. "Is the inventive step level

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right at the EPO?” was one of the questions the EPO put to its experts. Their answer, following a detailed review of EPO case law and practice around the world, was clear: yes. The focus has therefore been on providing examiners with support in applying the existing EPO inventive step standard in an efficient and consistent manner. To this end, the *EPO Guidelines for Examination and Internal Instructions* have been adapted from the EPO Boards of Appeal’s recent case law. They will enter into force on 1st April 2010.

In general, to keep to the metaphor, the Raising the Bar programme could be considered as straightening out some of the bends in the bar rather than raising it. This applies to all the work conducted within Raising the Bar.

#### **Changes to EPC rules**

The conclusions reached under Raising the Bar have been reflected in changes to the EPC rules. Each change is the result of a painstaking analysis into the burden and benefits for both the applicant and the office. A change cannot enter into force until the EPO Administrative Council has formally adopted it.

Change always generates debate, and changes to the EPC rules are no exception. The changes that will enter into force on 1st April 2010 have been the subject of much discussion both for and against. The new amended rules relate to the filing of divisional applications, pre-search communication between the examiner and the applicant, the obligatory response to the search opinion prior to the start of

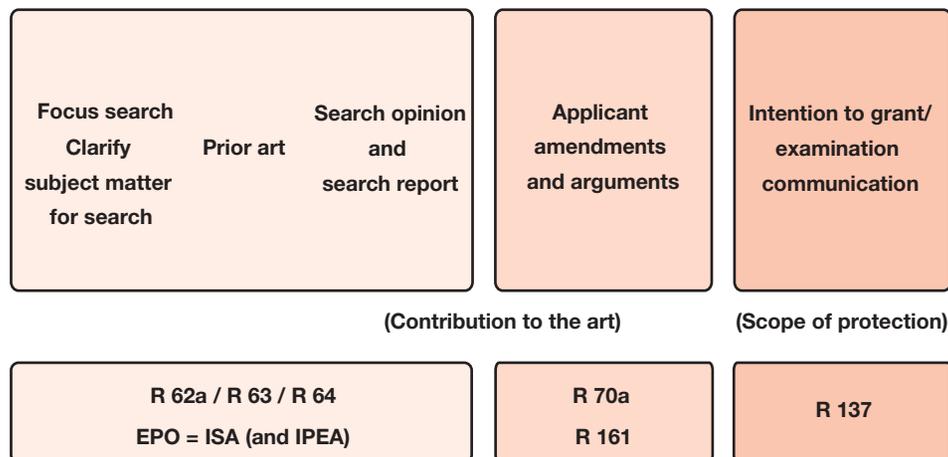
substantive examination, a requirement for applicants to identify and indicate the basis for amendments and a clearer restriction on examination to searched subject matter only.

#### **Re-focusing examiners’ work**

The work involved in maintaining a consistent quality level at the EPO is directly related to the quality of incoming applications. With the trend in recent years of incoming applications adhering less and less to the requirements of the EPC, it has been necessary to expend an ever-increasing amount of effort on bringing applications into basic conformity with the EPC. Although this does not apply to all applications, it can be said that many of the deficiencies relating to the basic drafting of applications dealt with by the EPO could and should have been removed by the applicant prior to filing. Resolving such deficiencies through official EPC communications can slow down the processing of applications significantly, because the deficiencies have to be resolved in an unavoidable but inappropriate sequence. This distracts the examiner’s attention from the fundamental task of assessing the patentability of the subject matter for which protection is sought.

As part of its daily work the EPO takes pains to sort out the issues that such applications present. It hopes thereby to maintain its quality standards and excellent reputation. However, it is also clear that should a poor-quality patent get through the system, regardless of the manner in which the application was drafted, the

## Search and examination procedure from April 2010



## Focus on the search. Examine what has been searched

responsibility for its grant lies with the examining division at the EPO. Safeguarding well-respected standards and supporting the EPO's staff in accomplishing their tasks efficiently and at a consistent quality level is important and a fundamental goal of Raising the Bar.

The recent changes to the EPC rules allow the applicant to indicate the subject matter on which the search is to be based. Applicants are well advised to provide this information when invited to do so and also to amend their applications at the appropriate time, as the subsequent substantive examination cannot extend to unsearched subject matter. The new changes should satisfy applicants seeking robust patents and provide welcome relief to users of the patent system who suffer from the legal uncertainty associated with low-quality incoming applications.

**Balancing interests**

The interest of the applicant in obtaining adequate protection for his invention must be balanced against the EPO's aim of bringing the examination to a close in an efficient and a speedy manner. To achieve this balance, responsibilities and workload must be placed where they belong: applicants need to take responsibility for ensuring that their applications are drafted so as to claim the subject matter for which protection is sought and meet the requirements of the EPC prior to grant. It is reasonable to share responsibility and workload in a fair manner. The changes contemplated or introduced under the Raising the Bar initiative place a fair

demand on applicants in view of the need to work in a manner consistent with the aim of granting patents that have a high presumption of validity – an aim that benefits the patent system as a whole.

It is up to both EPO examiners and applicants to apply the Raising the Bar measures in a way that upholds the quality standards of European patents and the legal certainty provided by the European patent system. *iam*

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