



Europäisches
Patentamt
European
Patent Office
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des brevets

Work-sharing in the unpublished phase

The EPO perspective



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Exchanging unpublished information – legal framework

- USPTO

- applicant based: possibility of practical solution to exchange unpublished information between IP5 offices (e.g. rule change facilitating applicant authorisation).

- JPO

- possible in specific cases

- KIPO

- possible to exchange bibliographical data and prior art citations; prepared to expand the scope of shared information

- SIPO

- legally not feasible, examination/search can only start once the application is published (i.e. no work will be performed on unpublished applications)

- EPO

- governed by the EPC: applicant's consent is required, however, possible by virtue of working agreements between the EPO and offices of non-EPOrg MS

EPO improvements in timeliness



- EPO implemented on 1 July 2014 its “Early Certainty from Search” programme where priority is placed on producing a search and written opinion within six months of receipt of the application regardless of the route used by the applicant (thus including 1st filings).
- Therefore, the EPO will increasingly have the search and written opinion work done at an early stage of the application, which can be reused by other offices.

Legal Certainty in the whole IP5 area



fiveIPoffices

European Patent Office // Japan Patent Office //
Korean Intellectual Property Office // State Intellectual
Property Office of the People's Republic of China //
United States Patent and Trademark Office

The Office of Second Filing should have as much as possible at its disposal when it starts work on the file:

- for the EPO this means at search stage (15 months from priority) for 2nd filings
- receiving work from Office of First Filing later is also useful, but costs examiners and applicants time; detrimental to offices' benefits and reduces legal certainty
- Timelines is thus a prerequisite for meaningful and balanced sharing of data
 - shift the focus on sharing useful data in unpublished phase → actually in applicants' hands for offices having a deferred examination regime

Situation at the EPO: Rule 141 EPC

- R141(1) Obliges applicants to file a copy of any earlier search results.
 - R142(2) If search results are available to the EPO (by virtue of inter-office exchange) applicants are exempted from filing a copy of search results
 - At present applicants are exempted from R141(1) if they are claiming the priority of a first filing made in:
 - **the Republic of Korea**
 - **the United States of America**
 - **Japan**
 - Austria
 - Denmark
 - the United Kingdom
- (OJ EPO 2015, A3)

Data exchange

- Useful data for an OSF are:
 - Search results
 - Classification
 - Type of citation (X,Y,A)

- Exchange of other procedural data (e.g. related to examination, opposition, appeal, etc.) not really useful if basic data not shared in time

- Other data currently exchanged in unpublished phase:
 - Priority documents (EPO ↔ JPO, SIPO, KIPO, USPTO)

Users' input is necessary for boosting results achievement

- Users' clear preference is needed, should subsequent family applications filed in different offices be treated:
 - in a distinct manner or
 - rather in a successive manner taking into account earlier results which should be delivered in chronologic order
- EPO's view is that examination of successive applications should be built up on earlier work results
- With EPO's Early Certainty from Search, EPO ensures that it delivers its first results always in time to be used by others

Legal certainty and user's perspective

- Users opting for IP5 protection must play their role and apply rules so that global IP5 legal certainty is obtained by requesting examination at the OFF so that it produces its 1st office action before OSF start their procedures.
- Request the office of first filing to do its work before offices of second filings start theirs.
- Prompt for legal changes allowing IP5 patent system to work optimally (harmonising timeliness) and where feasible also procedures.

Citation of prior art

- A priority for the IP5 Offices

- IP5 Industry position
 - IP5 Offices should adopt an automatic, electronic prior art citation practice,
 - shall enable applicants to submit the relevant prior art items only once
 - compliance with all duties and obligations of disclosure deemed automatically fulfilled
 - maximisation of use of electronic tools, e.g. CCD, GD

- Need for Offices to exchange unpublished information