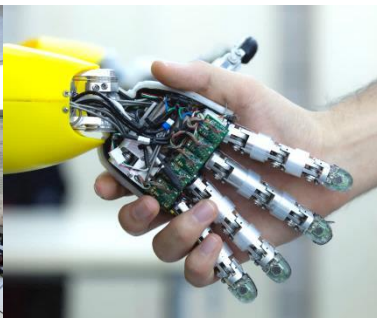




Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

7b. UDEC/Deferred examination – Outcome of the online user consultation US Bar-EPO Liaison Council

Washington, DC, 24 September 2019

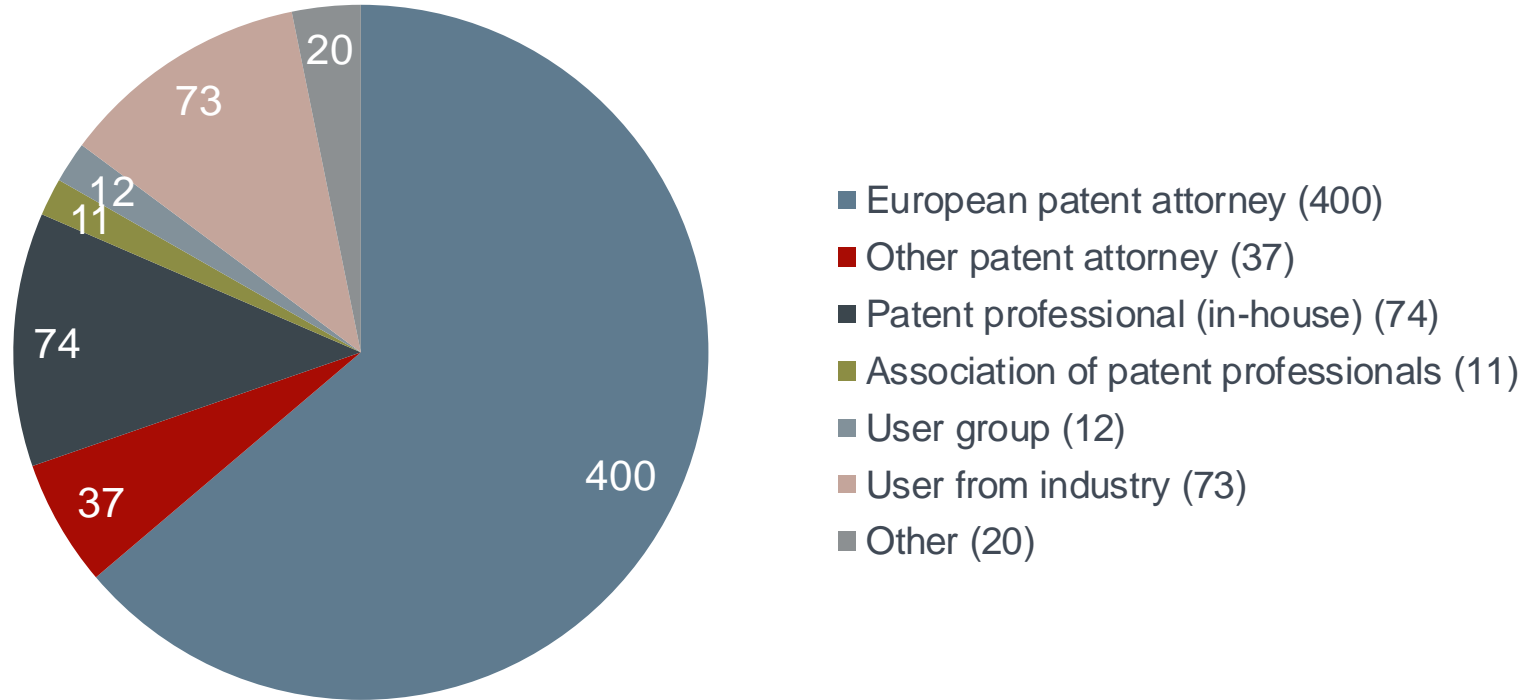


UDEEC/Deferred Examination – Background

- In autumn 2017, the Office presented a proposal for User-driven Early Certainty (UDEEC) offering applicants the possibility to postpone the start of substantive examination by a maximum period of 3 years
- Mixed feedback received from the users and the Contracting States
 - All stakeholders called for more consultation
- The EPO launched a broad online user consultation in November 2018
 - User feedback gathered for almost two months (19.11.2018-11.01.2019)
- Comprehensive questionnaire (20 questions) on
 - The need for more flexibility in the timing of examination, possible features of a postponed examination system, third-party and Office activation mechanisms, other suggestions to increase flexibility

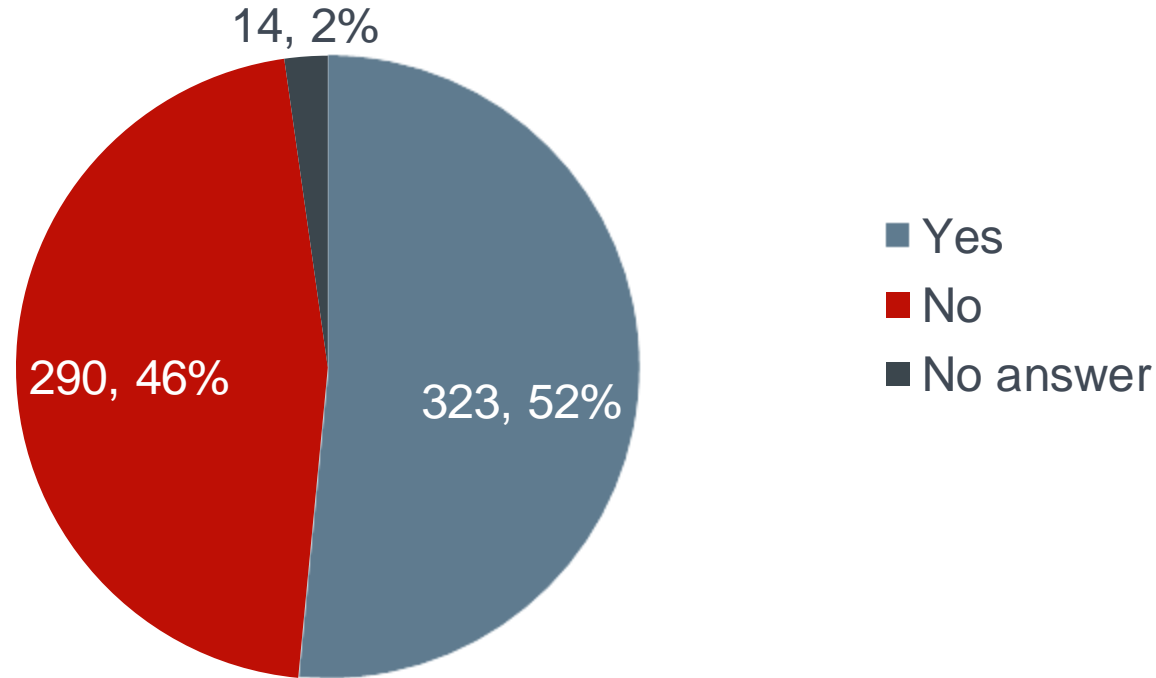
User consultation: Participation figures

Total: 627 replies



User consultation: Main results

Would you be in favour of a procedural option for postponing examination of a European patent application?



User consultation: Main results

More flexibility

- Better aligning the timing of examination with long product development cycles, regulatory approval procedures e.g. in pharma and biotech
- More time to assess the commercial value of the invention, e.g. in view of standardisation process or the situation in the relevant market(s)
- Possibility to await examination results from other countries before deciding how to proceed

Saving costs

- Companies, especially SMEs, could optimise resources by postponing the prosecution and/or validation costs
- More time to obtain funding or arrange for licensing, especially relevant for SMEs and universities

Giving more control to the applicant

- Pace of procedure and/or prioritisation of files decided by the applicant
- Postponement and PACE= balanced range of procedural options

Comments in favour of a postponed examination system

User consultation: Main results

Increased legal uncertainty for third parties, especially SMEs, and the public at large

- Prolonged pendency of applications
- Prolonged uncertainty on the final scope of patent protection sought (impact on freedom-to-operate)
- More resources required to monitor the patent system

Balance of interests achieved by the European patent system shifted in favour of the applicant

- More applications filed, possibly of lower quality
- Benefits only for large companies with more resources

Other comments

- Harm to competition and stifling innovation in Europe
- Postponement contrary to the EPC and/or “Early Certainty” initiative
- De facto postponement available via PCT route

Comments against a postponed examination system

Conclusions

- Consultation results show that the users' views on the need for and the possible features of a postponed examination system are very diverging
 - Some users need more time in examination
- Results presented to the EPO Contracting States in the CPL on 19-20 February 2019
 - Results of the user consultation considered inconclusive
 - Concerns expressed on the impact of a postponed examination system on legal certainty and the economy as a whole
- Increased flexibility in the form of postponed examination no longer pursued

Strategic Plan 2023: Offering a more flexible patent granting process

- Early Certainty and PACE to be replaced by a new programme (Goal 3, KI 3)
 - Addressing users' needs for flexibility in both search and examination
- Flexible examination processing times balancing the interests of applicants with those of third parties or the public
 - Accelerated (mean average of 6-12 months)
 - Standard (mean average of 12-24 months)
 - Maximum (mean average of up to 36 months)