



Managing costs and timeliness at EPO & UKIPO

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Patent attorneys don't like:

- **Excessive official fees – such as**
 - EPO fees on entry to PCT regional phase – may deter filing
 - EPO renewal fees – may encourage abandonments if progress is slow
- **Excessive patent office delays**
 - Delayed start of examination (unless clients wants it)
 - Delayed progress of examination - inefficient
 - UKIPO short deadlines → unnecessary urgency
- **Any refusals !**
 - Discourage future filings
 - Especially after high costs and delays – e.g. at EPO oral proceedings

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Patent attorneys **and/or clients** don't like:

- **Excessive official **and/or attorney** fees – such as**
 - EPO fees on entry to PCT regional phase – may deter filing
 - EPO renewal fees – may encourage abandonments if progress is slow
 - **Costs associated with EPO oral proceedings – especially if we lose**
- **Excessive patent office delays**
 - Delayed start of examination - **some clients and some cases**
 - Delayed progress of examination - inefficient
 - UKIPO short deadlines → unnecessary urgency
- **Any refusals !**
 - Discourage future filings
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Progress on timeliness at EPO

Delivering on priorities announced 2014

- ‘Early Certainty from Search’ – faster search reports and written opinions – **a success**
 - **Search timeliness improved under ECfS – median now 5 months**
- Prioritized completion of examination once started + cases with substantiated observations and oppositions – **starting to see results**
- Consequential delayed start of new substantive examinations – **we can use PACE (once)**

Short-term timeliness issue at UKIPO

- Recruitment of 150 more examiners 2014-2016 to reduce backlog by end 2020
- But 2017-19 backlog so consider acceleration options:
 - PCT (UK) Fast Track, Green Channel,
 - Combined Search and Exam (CSE) for non-PCT cases
- **Note that UK acceleration reduces time pressure on applicants**

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What can we influence? – initial stages

- Whether to file
 - Exclusions of Article 52(2) and 53 EPC and likely effect on claim scope
 - **consider pre-filing conversation with UK attorney**
- Where to file
 - Required countries and costs - EPO for wide protection or national filings?
 - **Changes coming - Unitary patent & UPC, more validation countries**
- Speed of progress
 - Client objectives – fast or slow?
 - PPH, PACE (& UK options) or defer prosecution & watch competitors?
- Which claims to keep
 - Reduce EP filing to 15 claims to avoid excess claim fees **and** Rule 43(2) EPC
 - we can decide which claims after commence EP regional phase

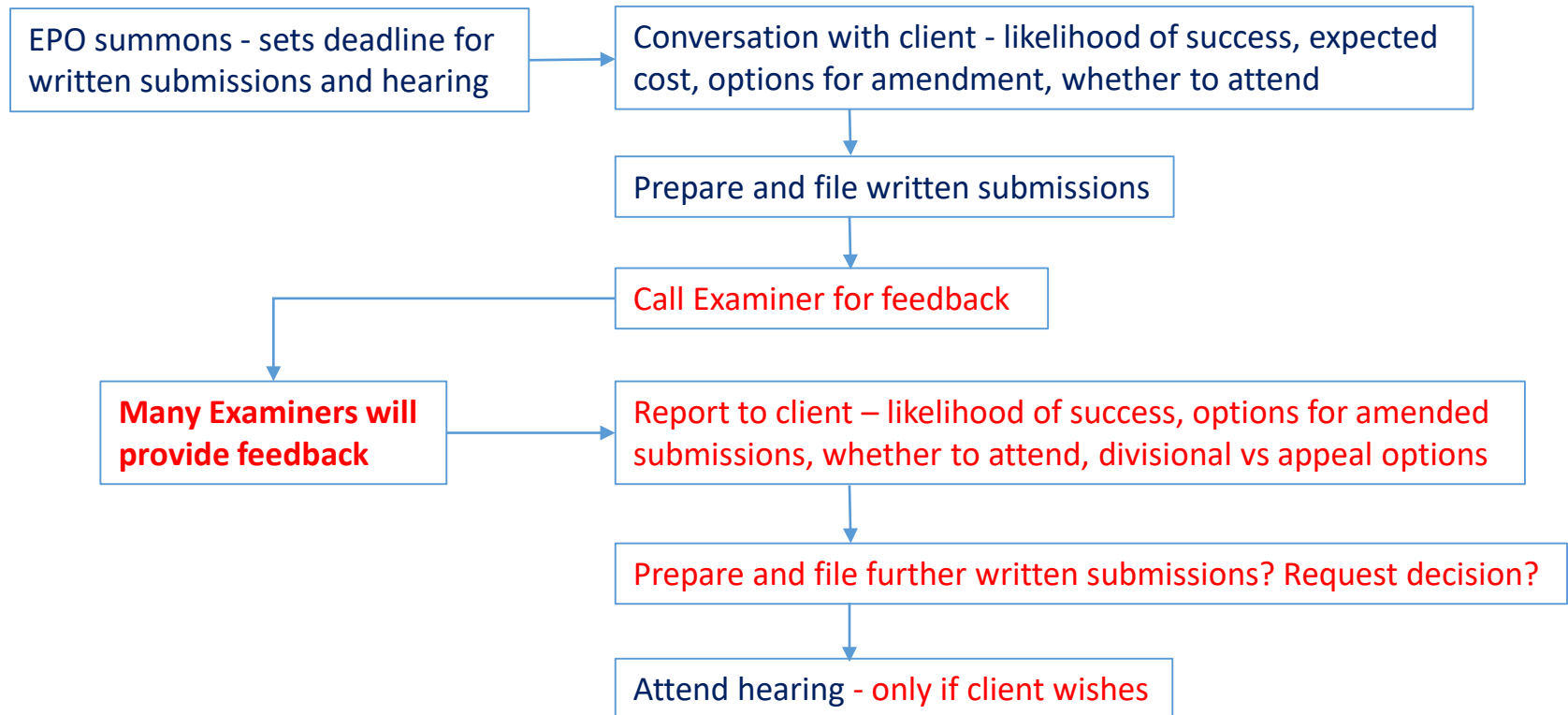
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What can we influence? – later stages

- Speed of progress
 - PACE request at any time - once, timeliness throughout
- EPO Refunds – when we abandon matters
 - Search fee – only if EPO has not begun search or previous search reused
 - Renewal fee – only if paid early and app withdrawn before due date
 - Exam fee – €1635 100% refund if substantive exam not begun; 50% if withdrawn before expiry of the time limit for replying to the first invitation under Article 94(3) EPC (Article 11 of Rules relating to Fees amended 2016)
- EPO oral proceedings – maximizing success rate
 - Written submissions is not the last step before hearing...

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Steps to remove uncertainty, increase success rate and manage costs following summons to oral proceedings



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More EPO progress

- Opposition duration starting to reduce - median now 24 months
- PACE working again – median back down to 3 months
- Invitation to send recommendations to EPO via new Quality Working Group within Standing Advisory Council before the EPO (SACEPO)
 - Mike Jennings invited UK member 2017-2020 – mjj@aathornton.com
 - Complaints & recommendations welcomed – examples: flexibility on old cases; Examiner feedback on written submissions; increased industry involvement in consultations

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Any questions?

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