

BY EMAIL

AA THORNTON

INTELLECTUAL PROPERTY LAW

Mr António Campinos, President
European Patent Office
D-80298 MUNICH
Germany

15 February 2019

Dear Mr Campinos,

EPO Strategic Plan 2019-2023

Thank you for letter of 21 December inviting us to provide recommendations for the EPO's strategic plan for 2019-2023. AA Thornton is very pleased to be referred to as a "strategic partner of the European Patent Office".

AA Thornton is consistently ranked as one of the UK's leading IP firms⁽¹⁾. With a history going back to 1911, we were also one of the UK's first specialist IP firms and the combined experience of our Partners and staff can be counted in hundreds of years. So we know what works and what doesn't.

We believe close collaboration between the EPO and European representatives is critical if we are to fulfil our shared responsibility to industry. With that in mind, we have been delighted by the openness and responsiveness of your senior management team when we have shared ideas in recent years. The current consultation on your strategic plan and numerous other discussions with user groups are evidence of the office's commitment to provide services that match the needs of your users. We will continue working closely with your examiners and your management team to achieve high quality patents and to achieve a cost-effective and efficient European patent system that meets our clients' commercial needs.

From our involvement in the recent quality reviews within SACEPO⁽²⁾, we believe that most of the EPO's current priorities are the right ones, but we have some specific recommendations.

Quality – focussing on the invention

The EPO has earned its reputation for high quality over many years, but it is vital that you maintain that quality when you recruit and train new staff and when you drive increased productivity. We believe your management team recognizes that high quality is not synonymous with the number of clarity objections under Article 84 or the strictness with which Article 123(2) is applied.

For the office to continue to lead the world on quality, **we recommend that your training of new examiners focusses most attention on the inherent patentability of each invention – with an emphasis on novelty, inventive step and sufficiency. These requirements should be the main focus of examination reports whenever there are substantive objections.**

(1) See Legal 500: "*The 'excellent' A.A. Thornton & Co. 'goes the extra mile to provide outstanding customer service' and has expertise in both contentious and non-contentious matters*"; "*timeliness and appropriateness of advice are a constant*"; '*excellent*' scientific knowledge.

(2) 7 February 2019 meeting of Standing Advisory Committee working group on quality

London Office | 10 Old Bailey, London, EC4M 7NG | T +44 (0) 20 7405 4044 | F +44 (0) 20 7405 3580 | aat@aathornton.com | aathornton.com

Partners: I S Gill | C R Turner | R S Havard | A R Bennett | M J Jennings | L King | G D Hussey |
N G South | N P Patel | S M Darby | M L Privett | A M T Bone

Although the clarity of patent claims is important, industry and the international patent system is best served when the EPO focusses most of its attention on the main patentability criteria of Articles 52-57 and 83 EPC, and when your examiners work closely with applicants to grant patents with the full scope of protection that the applicant is entitled to. The EPO will not be followed by other patent offices if clarity and added matter assessments are very different from European courts and national patent offices around the world.

Clarity and added matter should be assessed consistently by all Examining Divisions, and added matter should be assessed consistently by Examining and Opposition Divisions, with full consideration of the understanding of a person skilled in the art. Any requirements of specialist examining groups that are not set out in the EPO's Guidelines should be published, for transparency.

We believe EPO quality is closely associated with the clarity, consistency and thoroughness of EPO communications, which help us to accurately predict outcomes for applicants and opponents and third parties from an early stage. When these quality parameters are achieved, the EPO really does provide "Early Certainty" and leads the world on quality.

Efficiency with quality – balancing timeliness & cost-effectiveness to meet industry needs

We applaud the EPO's efforts to improve timeliness in search and examination:

- We applaud the success of the Early Certainty from Search initiative, which has achieved its objective to deliver substantive search opinions within 5 months of EPO filing, such that EPO work products (and advice from European patent attorneys) are available early enough to guide important commercial decisions.
- We applaud the current focus on clearing the backlog of cases that have spent several years under examination. In view of the cost of cumulative renewal fees for pending applications, unpredictable long delays at the EPO have a massive impact on applicants' costs. We understand that this problem will be addressed by 2020.

However, **we do not see a need for the EPO's examination process to be completed within a median period of only 12 months** – a current EPO target. We believe this 12 month target should be dropped, because it is distorting examiner behaviours. Each patent application should be given the time that is needed to address its particular objections, and that will often require a second or a third examination report to be issued before an Examining Division can approve an application for grant and before the EPO should impose costs on an applicant by issuing a summons to oral proceedings.

On the other hand, **we recommend that EPO Examining Divisions set themselves timeliness targets for responding to each written submission from an applicant**; we believe this will improve customer service. As well as setting applicants response periods of 4 months (extendable to 6), we recommend that Examining Divisions set themselves similar 4-6 month timeliness targets for issuing the next official communication following an applicant's submissions. This will avoid proactive applicants suffering long delays and unnecessarily high cumulative renewal costs, without imposing the high cost of excessively-early summons to oral proceedings.

We were very pleased to hear that the EPO management team agrees with our **recommendation to carry out checks before issuing a summons**. Examiners should take account of E-III, 4 of the EPO's Guidelines for Examination and should check whether there are new objections (if so, do not issue a summons) and should check whether an applicant's efforts to progress towards grant can be supported most efficiently via the written procedure. Oral proceedings are an important and much valued part of the EPO's procedures, but they involve costs and critical decisions for applicants and they should not be used too early in the life of an application when the applicant has not had an opportunity to address the objections.

Supporting environmental improvements

We recommend that the EPO introduces a low-fee option for patent applications directed to environmentally beneficial inventions, to stimulate innovation. This could include an option for fast-track search and examination. We note that inventions that save energy or make other environmental improvements can arise in well-established technical fields - e.g. more efficient computers, efficient control of industrial processes based on computer modelling, and biodegradable alternatives to conventional plastics all have “green” credentials, so this does not need to be limited to renewable sources of energy. At the UKIPO, fast-tracking under their “green channel” scheme is available to applicants who summarize the environmental benefit of their inventions – and this seems to work.

Recent Initiatives and Improvements

As noted above, we believe most of the EPO’s current priorities are the right ones, and we support many of your recent initiatives:

- We applaud the development of advanced search tools and machine translations for more comprehensive search reports (e.g. 46% of searches now have at least one citation originating in Asia).
- We applaud the decision to select and train specialists for opposition work, who will handle opposition work 30% of their time to build experience – this should reduce unpredictability of first instance oppositions.
- We welcome the increased availability of videoconference suites for oral proceedings.
- We appreciate your investment in collaborations with IP offices and users.
- We are grateful for the improved responsiveness to our phone calls to examiners.
- We praised your efforts in 2018 to consult with industry and others and then update your guidelines on patentability of the technical applications of computer-implemented algorithms (a timely reflection of the proliferation of AI solutions across many industries).
- We applauded your seamless reorganisation of the formalities, search, examination and opposition functions under your three excellent COOs (and we were impressed at how seamlessly this was done from the perspective of your customers).

Most of all, we fully support your commitment to high quality and efficient services that support the needs of industry. AA Thornton has made the same commitment to our clients.

Yours faithfully,
A.A. Thornton & Co.

Michael J Jennings

Adrian Bennett

Dr Marianne Privett

Dr Lawrence King

Dr Craig Turner

Nikesh Patel

Nick South

Alex Bone

Ian Gill

Geoff Hussey

DL +44 (0)20 7440 6850
E mjj@aathornton.com