

How to speed prosecution, save money and still maximize your rights in Europe

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How to speed prosecution, save money and still maximize your rights in Europe

- The EPO is becoming more hostile to Applicants
- EPO wants to reduce prosecution/pendency times
- Examiner's points system incentivizes them to expedite examination



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How do we give the Examiner the fewest possible reasons to refuse grant?

- By knowing what he is looking for
 - Acknowledge closest prior art
 - Reference numerals in claims
 - Independent claims in 2 part form
 - What is the technical problem solved?
 - Reasons why claimed solution not obvious



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Should we provide these?

- Acknowledge closest prior art ✓
- Reference numerals in claims maybe
- Independent claims in 2 part form maybe
- What is the technical problem solved? ✓
- Reasons why claimed solution not obvious,
using problem/solution approach ✓



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If so, when?

- Drafting/pre-filing review (make case look more European)
We routinely reduce the number of claims as far as possible to avoid excess claims fees which are €200 per claim from the 16th claim onwards
- Voluntary submissions after European Search Report issues
- Response to office action
- Interview with Examiner
- Oral proceedings



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Tricks to accelerate examination



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Why accelerate prosecution?

- Quick grant
- Cost savings, especially annuities
- But costs now not later



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Patent Prosecution Highway (PPH) can accelerate grant

- Aim of PPH
 - Mutual recognition
 - ie. Examining Offices share their work

Improves speed of issuance

Raises quality of granted patents



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How PPH works

- If claims allowed by ‘Office of First Filing’ (OFF) a corresponding application filed in the ‘Office of Second Filing’ (OSF) will be examined
 - Out of turn
 - The OSF will utilize work product of OFF



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How PPH works (2)

- There is no expectation that an application will be treated more favourably by OSF just because claims allowed by OFF
 - In practice, USPTO allowance rate doubled when OSF
 - But JPO still very ready to refuse when it is OSF (ie. ignoring USPTO findings)



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PPH pilot scheme now introduced between US and Europe

- Bridges exist between:
 - USPTO and JPO
 - UK and JPO (launched 2nd July 2007)
 - UK and USPTO (launched 4th Sept 2007)
 - EPO and USPTO (launched 29th Sept 2008 for 1 year trial)



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Requirements of EPO-USPTO PPH

Only applies to a European application claiming priority from a US application, therefore of very limited use

- Not PCT applications
- Not Continuation applications



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Onerous process of EPO-USPTO PPH

- US case must have **1** allowable claim according to USPTO
- EP claims must have correspond to US claims
ie. be of 'same or similar scope'
- Must submit
 - A claim correspondence table
 - File request form
 - Provide copies of Search Report and all Official Actions which are relevant to patentability and translations of all documents cited by USPTO
- EP examination must not have begun
- Once participation in PPH pilot program allowed EP application processed under PACE



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EPO-USPTO PPH Progress Report

- 5 applications under PPH received by EPO so far
 - All refused
 - 3 because related to PCT applications
 - 2 because related to divisional applications

Clear lack of understanding of PPH amongst
European practitioners



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Benefits of PPH

USPTO-JPO	USPTO-EPO
<p>Has real benefits for applicant</p> <ul style="list-style-type: none">• Can bypass petition to make special in USA• JP accelerated examination requirements quite high	<p>Has no real benefits for applicant</p> <ul style="list-style-type: none">• Can go straight into PACE without meeting strict PPH requirements



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Accelerated Prosecution of European Patent Applications (PACE)



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How PACE works - Search

- If there is no priority claim, search will be accelerated automatically
- If there is a priority claim, accelerated search can be requested on filing



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How PACE works - Examination

- Accelerated examination of a European Application can be requested on filing (*if* examination requested bindingly and fee paid)
- Accelerated examination of a Euro(PCT) can be requested on entry or after
- EPO *aims* to issue 1st Official Action within 3 months of receipt of application by Examiner (subsequent Official Actions also issue within 3 months)
- Applicant must not extend



Limitations of PACE

- PACE not possible if
 - Parts of application missing or outstanding
 - Application refers to an earlier application



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Uptake of PACE provisions tiny

- Search 4%
- Examination 6%



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PACE a missed opportunity

- PACE speeds search and examination
- PACE is free
- PACE is confidential
- PACE is available on request
- PACE can be accessed independently of PPH
- Unlike using PPH, there is no work product sharing between Patent Offices



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Other ways to speed grant of EP Applications

- Early entry into EP regional phase *Art 23(2) or 40(2) PCT*
- Before Search Report issues waive invitation under *R70(2) EPC* and request examination unconditionally
- After Search Report issues file a substantive response without waiting for first Office Action



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Conclusions



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Saving money and maximising your rights

By being more proactive throughout we can

- Speed pendency**
- Reduce number of Official Actions**
- Avoid Oral Proceedings**
- Save money**

Without sacrificing scope of protection



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Thank you for your attention

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