

EPO TIMELINES - THE EPO SPEEDS UP PATENT EXAMINATION AND OPPOSITION

The European Patent Office (EPO) has been subject to criticism with respect to duration at examination. While the Japanese or South Korean Offices JPO and KIPO averaged about 14 and 16 months from request for examination until final action in 2017¹, the EPO's average is over 20 months² for the same period.

However, the EPO has started an initiative to speed up examination as well as opposition proceedings. The goals set in 2017 are as follows:

Search reports	Examination time	Opposition time
Delivering search reports within 6 months of receipt	Reducing examination times to just 12 months on average by 2020	Completing oppositions in 15 months on average, while ensuring the parties are heard
Actual search timeliness: 4.8 months	Actual examination timeliness: 22.1 months	Actual duration of oppositions: 22.4 months

Source: EPO Quality Report 2017²

So, what are the consequences?

Let's have a look at the EPO timeline from EP regional phase entry until grant typical for Euro-PCT applications for which the EPO has not been the ISA (see Annex, Fig. 1) first:

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HRB Nr. 111307
Amtsgericht München

PA (Patentanwalt), EPA (European Patent Attorney),
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¹ IP5 Statistics Report 2017 edition, downloadable at www.fiveipoffices.org

² EPO Quality Report 2017, downloadable at <http://documents.epo.org>

Search

Currently, the EPO is delivering the search (Extended European Search Report EESR) already fast, within less than 5 months³.

Taking into account the 6-months' voluntary amendment period provided by the Communication pursuant to Rules 161(2) and 162 EPC, as well as the 1-2 months that the EPO often takes until issuance of such a Communication (see Fig. 1), the EESR can be expected to be delivered about 12 months after EP regional phase entry.

Examination

Substantive examination is triggered at the EPO once the Applicant has filed a response to the EESR (the EPO invites to do so with the Communication pursuant to Rule 70 EPC).

The EPO now intends to reduce the time from the response to the EESR until the issuance of an intention to grant (Communication pursuant to Rule 71(3) EPC) from about 22 to 12 months.

As can be also seen in Fig. 1, a 12 months' average examination time means that it will be difficult for the Examiner to issue more than one regular Article 94(3) EPC Office Action, in particular if the Applicant takes full advantage of the 4 months + 2 months' term extension = 6 months' response term. The Examiner would then have 6 months of examination time left at his disposal, which will be sufficient for considering the Applicant's submissions and to draft a first Office Action and a Rule 71(3) Communication, but not for a second round of Article 94(3) Office Action + response thereto.

The most likely scenario under these circumstances are:

- (i) If the Applicant files a reasonable response to the EESR, addressing all objections raised, the Examiner may issue one Article 94(3) Office Action, requesting the Applicant to attend to the remaining minor issues

³ EPO Annual report 2018, [Quality indicators](http://documents.epo.org), downloadable as XLS document at <http://documents.epo.org>

and to adapt the description, and then has sufficient time to issue the intention to grant (Rule 71(3) Communication), or

- (ii) If the Examiner is not satisfied with the response to the EESR, the first Article 94(3) Office Action might be already accompanied by a summons to oral proceedings.

In any way, the new timeline means more pressure for the Examiners, and our impression based on daily experience also is that many EPO Examiners appear to be in rush. However, quite surprisingly, the actual examination duration has not changed (22.1 months in 2017 and 22.3 months in 2018³). It seems that reducing examination time is not an easy task.

Recommendation

The above shows the importance of getting the response to the EESR right, as this will likely decide about whether one ends up with a straightforward grant, or a case that is in danger of running out of time for discussion with the Examiner. Our recommendation is thus to draft the response to the EESR carefully and diligently, and to make sure all objections are addressed and no new issues (such as added subject matter) are introduced.

If it is expected that some negotiation and thus more than one Office Action is needed, it might also be helpful to file the response to the first Office Action early, leaving time to the Examiner to issue a second Office Action.

Speeding up the Opposition procedure is also expected to lead to a substantial change in practice:

Opposition

So far, it has been common practice during opposition proceedings at the EPO that the parties have quite some time for a ping-pong of submissions from filing of the grounds of opposition until the preliminary opinion from the Opposition Division accompanied by the Summons to Oral Proceedings.

The new timeline, with the goal of completing oppositions in 15 months on average, will now put an end to this ping-pong. Since the Patentee has a 4 months' period of reply to the grounds of opposition, and the preliminary opinion / summons is

normally issued at least 6 months ahead of the oral proceedings (see [Guidelines for Examination, E-III, 6.\(ii\) and \(iii\)](#)), there will be less than 5 months in between (see Annex, Fig. 2).

We have in fact seen cases where the preliminary opinion and summons were issued already 3 months after the Patentee's response to the grounds of opposition. Statistics for 2018 show that the Opposition duration has been reduced from 22.4 to 18.6 months already³.

The consequence will be that both Patentee and Opponent will have one major submission, i.e. the Grounds of Opposition and the response thereto, in which preferably all issues are addressed. The response to the preliminary opinion (also with the EPO's "*late filed*"-practice getting ever stricter) should be limited to reactions to unforeseeable developments in the preliminary opinion, as well as clarifications, if possible.

While the streamlined timeline is tight for both sides, it is particularly difficult for the Patentee, since a term extension for the 4 months' term for responding to the Grounds of Opposition is meanwhile granted only in exceptional circumstances. This means that, where e.g. there are multiple Opponents, many documents to be studied, and a multitude of Auxiliary Requests to be prepared, one better starts immediately and not loses any time on formal procedures.

Eva Ehlich

Partner at Maiwald
German and European Patent Attorney

Naho Fujimoto

Senior Associate at Maiwald
German and European Patent Attorney

EPO Timelines – Annex

Fig. 1: EPO prosecution timeline Euro-PCT applications with EPO ≠ ISA

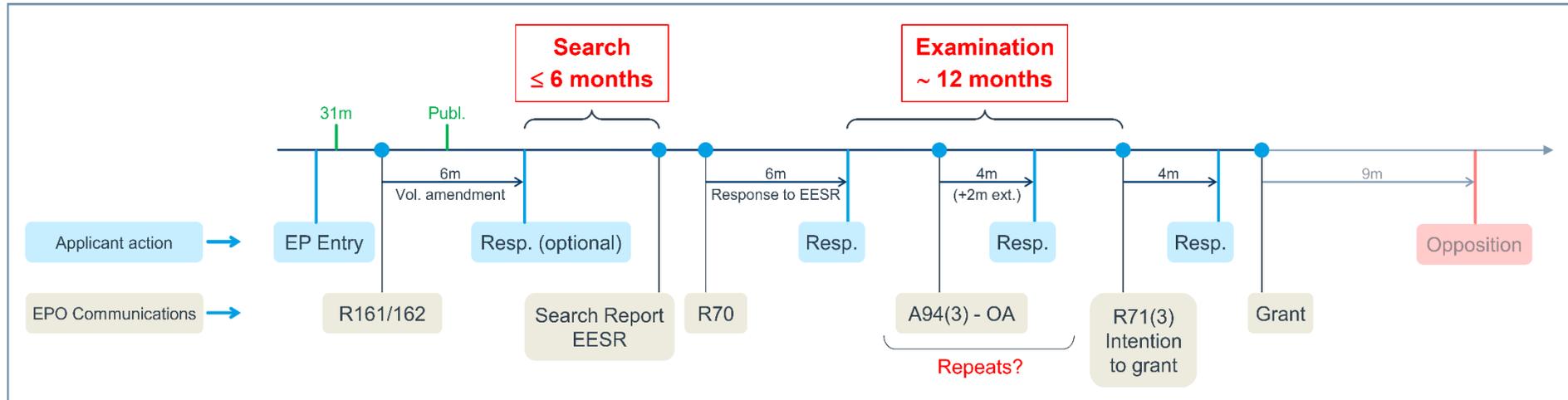


Fig. 2: EPO opposition timeline

