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Conseil d'administration

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SUBJECT: Convergence of Practice: New cycle

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: 1. Administrative Council (for decision)
2. Committee on Patent Law (for information)

SUMMARY

This document replaces CA/73/22 dated 28.10.2022. The amendments are indicated by grey hatching.

The first cycle of the Convergence of Practice programme which was introduced as part of the Strategic Plan 2023 will be concluded in March 2023. The document provides a summary of the first cycle and possible topics and their prioritisation, as well as a working method for the next cycle of this successful programme.

The revised version takes into account the proposals made during the 56th meeting of the Committee on Patent Law, in particular on the order of dealing with the proposed new topics, the systematic monitoring of the implementation of the adopted common practices and the request of WIPO to become an observer in the working groups dealing with the proposed new topics for the new cycle.

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I. STRATEGIC/OPERATIONAL

1. Operational

II. RECOMMENDATION

2. At its 56th meeting, the Committee on Patent Law expressed its support for the continuation of the Convergence of Practice programme, welcoming the flexibility to refine the themes of the working groups and their prioritisation and gave a unanimous favourable opinion on the document CA/73/22. Furthermore, the Committee welcomed the request for observer status by WIPO for the next cycle. It requested the Office to submit a revised document to be submitted to the Council at its meeting in December which takes into account the results of the discussions at the meeting of the Committee on Patent Law.

3. The Administrative Council is requested to approve the proposed topics and their order for discussion for the next cycle of the Convergence of Practice programme.

III. MAJORITY NEEDED

4. Simple.

IV. CONTEXT

5. The Convergence of Practice programme is a key initiative of the Strategic Plan 2023 (CA/65/19). On the basis of this programme and with the involvement of user associations, the EPO and the national offices of the EPC contracting and extension states try to find common ground in areas where diverging administrative practices exist.

6. The programme was launched in December 2019 with the first six topics for convergence on the agenda (see CA/PL 14/19).

7. The topics were rolled out in pairs due to the limited resources and discussed in dedicated working groups. So far, four out of six working groups have successfully completed their works with a common practice adopted by the Administrative Council. They contribute to a number of benefits for both applicants and offices alike, leading to increased legal certainty and cost savings as well as quality of products and services.

8. The first cycle of convergence of practice will be completed in spring 2023 with the adoption of the expected common practices in the last two topics.

V. ARGUMENTS

A. INTRODUCTION

9. The first cycle of the Convergence of Practice programme covered the following topics

- Examination of unity of invention
- Designation of the inventor
- Accordance of a date of priority
- Re-establishment of rights
- Claim drafting and structure
- Examination practice for computer-implemented inventions and artificial intelligence

10. The working groups dealing with the different topics examined the existing practices in the various offices and analysed their disparities before defining a common practice. The implementation of any given agreed common practice by the contracting states and the EPO takes place on a voluntary basis.

11. The common practices with regard to the first four topics were adopted by the Administrative Council and published on a dedicated page on the EPO webpage.

12. Furthermore, the EPO held three dedicated virtual platform events informing representatives of the national patent offices that do not participate in the working groups as well as users about the progress and detailed contents of the discussions taking place in the different working groups. Users were also consulted throughout the process via the SACEPO Working Party on Rules.

13. Work is still ongoing in the two remaining topics, i.e., "claim drafting and structure" and "examination practice for computer-implemented inventions and artificial intelligence". With the planned adoption of common practices in these two topics by the Administrative Council in March 2023, the first cycle of the programme will be concluded.

14. Given the recognised benefits and the positive feedback from contracting states and users, the EPO together with the national offices of the EPC contracting states and extension states should continue this successful exercise.

15. For this purpose, it is required to agree on new topics for the next work cycle starting in April 2023, and on their prioritisation.

B. PROPOSED NEW TOPICS

16. The convergence of practice programme does not aim at harmonising substantial law but focuses on harmonising the administrative practice in certain patent related topics in Europe.

17. Against this background, the Office identified six new topics as particularly suitable for the next cycle of joint convergence efforts:

- Allowable features in drawings
- Observations by third parties
- Practices concerning assignment
- Broad claims
- Double patenting
- Issuing and accepting electronic priority documents

18. At the beginning of September 2022, an informal document was sent to the heads of delegation of the contracting states and users, listing and explaining the possible topics and asking for comments and suggestions for possible additional topics. In addition, contracting states and users were informed about the possible topics and invited to comment at this year's platform event on convergence of practice, which was held on 5 October 2022.

19. A first preliminary analysis of the issues which could be addressed with regard to the proposed new topics can be found in the Annexes of this document.

20. As to the working method, the Office proposes to use the same approach that was successfully used for the first cycle.

21. The chosen topics will be rolled out in pairs and discussed in dedicated working groups chaired by the EPO in online meetings. All EPC contracting states and extension states are invited to participate via one representative and join the working groups at any time. User organisations would again be invited to the working group as observers. Furthermore, WIPO will be invited to participate as an additional observer to the meetings of the working groups. The contracting and extension states which are not part of a working group will be kept informed about the discussions in the working groups via dedicated events. Furthermore, regular updates will be provided to users via the SACEPO. In their discussions, the working groups aim at reaching a recommendation for a common practice within a working cycle of 9 months which will be submitted to the Administrative Council for adoption.

22. Although it is the goal that as many offices as possible implement an adopted common practice to reach a true harmonisation in the chosen practice areas, any such practice will be implemented on a voluntary basis only. Nevertheless, a more systematic monitoring of the implementation of the adopted common practices with the different offices should take place in order to increase the transparency in particular for the benefit of our users.

23. The proposed possible topics could be rolled as follows:

- 1st pair of topics (2023/2024): "Allowable features in drawings", "Issuing and accepting electronic priority documents" ;
- 2nd pair of topics (2024/2025): "Observations by third parties", "Practices concerning assignment";
- 3rd pair of topics (2025/2026): "Broad claims", "Double patenting".

24. The Office will invite all national offices of the contracting states and extension states, as well as the user organisations in due time to indicate whether they would like to participate in the dedicated working groups, requesting the CVs of the representatives.

VI. ALTERNATIVES

25. N/A

VII. FINANCIAL IMPLICATIONS

26. None.

VIII. LEGAL BASIS

27. Article 10(2) EPC

IX. DOCUMENTS CITED

28. CA/65/19, CA/PL 14/19

X. RECOMMENDATION FOR PUBLICATION

29. Yes.

ANNEX 1 ALLOWABLE FEATURES IN DRAWINGS

1. It is proposed to achieve convergence on the formal requirements for drawings to reduce the burden for users arising from national offices' differing requirements.

2. At international level, offices already accept the PCT standard for drawings, which is highly appreciated by users (see in particular Rules 7 and 11 PCT and the Administrative Instructions, Part 7 and Annex F). Nonetheless, applicants sometimes still need to adapt their drawings when submitting patent applications in different jurisdictions as the formal requirements vary. This can lead to additional costs and effort.

3. At the EPO, the requirements for drawings are currently laid down in Rules 46 and 49 EPC and the Guidelines for Examination in the EPO. Following the adoption of the first basket of legal changes to support digital transformation in the patent grant procedure, the EPC Implementing Regulations will be amended to authorise the EPO President to decide on the presentation requirements for application documents, including the formal requirements for drawings.

4. The following serves as an example of existing divergences: the EPO requires drawings to be submitted without colourings (see current Rule 46(2)(a) EPC), but colour drawings can still be submitted and are then further processed in black and white (Guidelines for Examination A-IX, 1.2, 7.1 and 7.2). However, in some states (e.g., France, Germany and the UK) it is not necessarily possible to submit colour drawings.

5. A further example of diverging practice is the admissibility of photographs. Although the EPC contains no express provision for photographs, they can be submitted at the EPO, including colour photographs. However, practice in the EPC contracting states diverges. For example, France and the UK allow photographs if they are black and white, whereas in Germany only technical drawings are admitted.

6. This topic would allow a review of the formal requirements for drawings in patent applications. In addition, a practice to allow colour drawings (in priority documents, European patent applications, the publication and online file inspection) might be envisaged. Requirements that might be looked at include the minimum margins and fonts and those concerning the use of sheets and text on drawings (for instance, the EPO and WIPO accept flowcharts as drawings, but the text is to be kept to a minimum).

7. Common allowable features for drawings across contracting states might be identified and guidelines established as regards these features; in the process, the opportunity to modernise certain requirements for the benefit of users (e.g., margins/use of colour/photographs) might be considered.

ANNEX 2 OBSERVATIONS BY THIRD PARTIES

1. Following publication of a European patent application under Article 93 EPC, any person may present observations concerning the invention's patentability. Although lack of novelty and/or inventive step are the most common observations, third-party observations may also relate to clarity, sufficiency of disclosure, patentability and unallowable amendments. Such observations must include the grounds on which they are based. The person filing them may not be a party to the proceedings before the EPO. The web interface provided by the EPO is the preferred means of filing (see OJ EPO 2017, A86). Third-party observations are generally admitted in the EPC contracting states (e.g., France, Germany and the UK).

2. Although third parties are sent acknowledgement of receipt of their observations (if they were not filed anonymously), the EPO does not specifically inform them of any further action it takes in response to them. However, the outcome of the evaluation of the observations by the competent division is briefly indicated in the respective EPO action (e.g., a communication or the intention to grant) and thus visible to the public.

3. The EPO makes every effort to issue the next action within three months of receipt of third-party observations by the examining division, provided the observations are substantiated and have not been filed anonymously.

4. If the observations relate to alleged prior art available not from a document, but for instance from use, this is taken into account only if the alleged facts are either not disputed by the applicant or proprietor or established beyond reasonable doubt.

5. Where third-party observations have been filed during the international phase, the EPO as designated/elected Office will consider their content upon entry into the European phase, when they become available to it. The examining division will make every effort to issue the next office action within three months of expiry of the period under Rule 161 EPC, but only if the third party has clearly expressed its wish to achieve expedited treatment in the European phase, the observations were not filed anonymously and they were substantiated. A third party wishing to achieve such a result in the European phase must therefore make this clear in the observations or file the observations with the EPO as designated/elected Office.

6. This topic might achieve a common practice regarding numerous aspects, such as: allowed subjects for third-party observations, the formal requirements for filing them, whether they can be anonymous, the means for filing them (dedicated web form as at the EPO or paper form), the conditions for submitting allegations regarding prior use, the (accelerated) treatment of observations by offices and the processing of third-party observations filed during the PCT international phase by a designated/elected Office.

ANNEX 3 PRACTICES CONCERNING ASSIGNMENT

1. It is proposed to align practices concerning assignment to achieve a common form for the registration of transfers of patent applications and patents.

2. Currently, patent applicants and proprietors register assignment documents with multiple patent offices to secure ownership and preserve rights to license and enforce their rights. Yet different jurisdictions impose different requirements. which the working group could identify to the benefit of users, as emphasised by epi in their comments. Also Industry has repeatedly indicated that an alignment of practices concerning assignment would make the process simpler and less error-prone, provide for cost savings and lessen the overall administrative burden for users, particularly for small and medium-sized entities.

3. At the EPO, there is no obligation to register the transfer of a patent application or patent. However, if a transfer is not registered, the assignee cannot act in proceedings before the EPO, as only the applicant/patent proprietor entered in the European Patent Register is entitled to do so. While the EPO does not prescribe mandatory wording for an assignment, it must contain the following information: names and addresses of the parties to the assignment, application number (EP or WO; the application must be unambiguously identifiable), purpose of the agreement, signatures with name and position held within the legal entity if applicable. The legal basis for registering an assignment is Rule 22 EPC. This provision also requires the production of documents providing evidence of the transfer.

4. Currently some national offices require the filing of a specific form in addition to the required evidence. In other offices, there is no requirement to use a specific form. Finally, for some offices, there is no such requirement either, but the use of a specific template provided by the office is recommended. For the EPO, Form 5050 is not mandatory.

5. The main objective of this topic would be to develop and implement common forms for use by each office so that an assignment could potentially be recorded at multiple offices with a single form. Harmonising the standard evidence required for a transfer might also be considered. The aim would not be to try to harmonise substantive law, i.e., the conditions governing assignments, which are often laid down in the civil law of the respective jurisdiction. This is not within the scope of the convergence programme.

ANNEX 4 BROAD CLAIMS

1. The EPC does not explicitly mention overly broad claims. Broad claims usually define subject-matter in a way that allows many embodiments to fall within the claims' scope.

2. Applications containing broad claims raise a number of issues, starting with the limitation of the search. For instance, no special effort need be made to search unduly wide or speculative claims, to the extent that they relate to matter which is not sufficiently disclosed in the application and that they are not supported by the description.

3. They also raise issues as regards the assessment of patentability. For instance, where there are discrepancies between the claims and the description, the claims are not sufficiently supported by the description and, in most cases, the invention is not sufficiently disclosed. Sometimes an objection of lack of novelty can arise, for example if the claim is formulated in such broad terms that it also covers known subject-matter from other technical fields. Broad claims may also cover embodiments for which a purported effect has not been achieved.

4. At the EPO, when assessing the novelty of broad claims, examiners tend to construe the claims in their broadest meaning, whereas some offices will limit the claims to the embodiments mentioned in the description. This difference combined with potential divergences as regards the assessment of clarity often leads to diverging search results. This in turn makes it difficult to know to what extent search results for applications with broad claims can be reused by another office.

5. The outcomes of this topic might include agreeing on how to treat certain types of broad claim in particular as regards the completeness and meaningfulness of the search, and the drafting of examples for these cases. This would help to facilitate work-sharing, for example through better use of earlier searches.

ANNEX 5 DOUBLE PATENTING

1. As acknowledged by the EPO's Enlarged Board of Appeal, a prohibition on double patenting applies under Article 125 EPC (see Enlarged Board of Appeal decision G 4/19), which provides that in the absence of procedural provisions in the EPC, the EPO takes into account the principles of procedural law generally recognised in the contracting states. It is such a principle that two patents cannot be granted to the same applicant for the same subject-matter.

2. The prohibition on double patenting applies to three types of combination of European applications by the same applicant: two applications filed on the same day; parent and divisional applications; and an application and its priority application. At the EPO, an applicant is allowed to proceed with two applications which have the same description but do not claim the same subject-matter. Where there are two or more European applications from the same applicant designating the same state or states, and the claims of those applications have the same filing or priority date and relate to the same invention, the applicant should be required to perform one of the following:

   - amend one or more of the applications so that the subject-matter of the claims of the applications is not identical
   - withdraw overlapping designations
   - choose which one of those applications is to proceed to grant

3. If the applicant does not do so, once one of the applications has been granted, the other(s) are refused under Article 97(2) in conjunction with Article 125 EPC (see G 4/19). If the applications' claims are merely partially overlapping, no objection should be raised. Should two applications with the same effective date be received from two different applicants, each must be allowed to proceed as though the other did not exist.

4. The EPO Guidelines for Examination do not provide any further clarification of the term "same invention", other than that there is no double patenting if the claims do not relate to the same subject-matter. However, case law has established that a mere (i.e., partial) overlap does not prejudice the grant of two European patents.

5. In some contracting states, there are explicit legislative provisions on double patenting, while in others nothing is provided for. Similarly, in some countries case law and/or guidelines determine the question of when inventions are to be considered the same or considerably overlapping so as to amount to unallowable double patenting, while in others such case law or guidelines are missing. Furthermore, some countries do not provide for a double patenting prohibition where the divisional application is for the same invention as the parent (e.g. Hungary). There also seem to be differences between the contracting states' practices where the claims are merely partially overlapping, if any such practice exists at all. For instance, at the EPO, a claim reciting feature A does not preclude a claim in a second application from reciting features A+B. In some other states, no provisions, be it in law, regulations or guidelines, exist.

6. The objective might be to come up with a recommendation with some (non-binding) guiding principles regarding double patenting. The focus might be on the procedure to be followed by examiners when confronted with a double patenting case, and in particular:

- the situations where a double patenting objection is to be raised (same applicant; parent-divisional; two applications with the same effective date from two different applicants)

- what happens in cases of a partial overlap (including the question of whether the description may be identical)

- the legal basis to be cited

7. This might be complemented by some concrete examples to help examiners. This would further increase transparency, legal certainty and predictability for the benefit of examiners and users alike.

8. The objective of the convergence exercise would not be to establish double patenting prohibitions in those contracting states without one; as described above, it would be to harmonise to a certain extent the practice for those offices with a double patenting prohibition in their laws.

ANNEX 6 ISSUING AND ACCEPTING ELECTRONIC PRIORITY DOCUMENTS

1. The common practice adopted as regards the accordance of a date of priority (CP3) stipulates that offices should issue and accept (certified) electronic copies of priority documents.

2. In 2004, the WIPO Assemblies agreed on an "Understanding on the provision of priority documents under the Paris Convention and the PCT", clarifying that neither Article 4D(3) Paris Convention nor Article 8 and Rule 17 PCT prevent an office that furnishes priority documents from determining what constitutes certification of a priority document and the date of filing, and how it will certify such a document. In addition to paper, this applies to alternative forms of priority document certification that are suited to the electronic environment. Since then, the practice of issuing and accepting certified electronic priority documents has spread and is increasingly applied by patent offices across the world, such as in Brazil, Europe and the US.

3. Currently, Austria, the Czech Republic, France, Greece, Italy, Portugal and Poland issue certified electronic priority documents, using different digital signature formats for certification. The EPO intends to start issuing certified electronic priority documents from October 2022.

4. Annex F of the PCT Administrative Instructions sets out certain minimum requirements regarding electronic signatures with which all offices acting under the PCT or bound to the PLT must comply. In particular, electronic signatures must be embedded in the document itself. However, practice diverges as to several aspects, such as:

    - the use or not of qualified certificates within the meaning of Article 3(15) and Annex I of the eIDAS Regulation (EU) No 910/2014

    - whether the source of trust is obtained from European Union trusted lists, i.e., lists of trust service providers (TSPs) specifically accredited to deliver compliance with the eIDAS Regulation (EU) No 910/2014

    - whether the electronic signature's validity is extended by enabling a "long-time validation" field, possibly with a time stamp applied

    - the use of a seal indicating the office's designation versus individualised electronic signatures with the name of an office staff member

    - whether the private key related to the certificate resides in a qualified signature creation device (QSCD)

5. As an alternative route to issuing certified electronic priority documents, the EPO and – as of 1 July 2022 – 15 contracting states participate in the WIPO Digital Access Service (DAS). DAS provides participating offices ("accessing offices") with access to a digital library of electronic priority documents via an access code. Many participating offices also make their priority documents available through DAS ("depositing offices"). The 15 contracting states are: Austria, Belgium (accessing only), Denmark, Estonia, Finland, France (depositing only), Ireland (accessing only), Italy (depositing only), Latvia, the Netherlands, Norway, Spain, Sweden, the UK and Turkey (depositing only).

6. However, applicants also need to be able to submit certified copies of priority documents to offices of subsequent filing which do not participate in DAS. In addition, national courts may require the submission of certified copies of priority documents when determining the validity of a claimed priority date in the context of revocation proceedings. Finally, potential investors may require the production of certified copies of priority documents when applicants seek third-party funding. In these cases, the electronic priority document itself needs to vouch for its integrity and authenticity via its electronic signature. There is a risk of third parties tampering with the electronic priority document, a risk that is not present in the case of inter-office co-operation via DAS.

7. In this context, offering a uniform user experience to applicants at both national offices and the EPO would bring added value and reduce administrative costs for applicants.

8. Sub-topics on which a common practice might be established in conjunction with contracting states – on the one hand from the perspective of offices already issuing/accepting digital priority documents and on the other from the perspective of offices considering it in the future – might be:

    - How do/how should users best request the issuance of an electronic priority document from an office of first filing?

    - What type of electronic signature is used by offices currently and what type would offices use in the future when issuing an electronic priority document? Does the electronic signature have a qualified certificate within the meaning of Article 3(15) and Annex I of the eIDAS Regulation (EU) No 910/2014? Should this be the case?

    - Is the electronic signature currently embedded in the priority document itself? Should it be?

    - Does/should the electronic signature of the electronic priority document include the name of a member of staff (or of the head) of the issuing office? Or is the mere designation of the issuing office sufficient?

- For what minimum amount of time is/should a certified electronic priority document be valid?

- How is/should an electronic priority document be transferred from the issuing office to the user (email, download via the office's online portal, etc.)?

- Are/should fees be applicable for issuing electronic priority documents, and if so, what amounts are appropriate?

- What minimum requirements are/should be applied by offices of second filing to accept a certified electronic priority document?