



Since 1950 IP Protection in the Heart of Europe

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GRANT OF EUROPEAN PATENTS: THE EUROPEAN PATENT OFFICE LISTENS TO ITS USERS

When the European Patent Office (EPO) decides, at the end of the examination procedure of a European patent application, that the applicant has filed an allowable set of claims, the EPO issues a communication enclosing the entire text (description, claims, drawings if any, and abstract) with which it intends to grant the patent, and asks the applicant to approve that text.

In reply to that communication, the applicant can either simply approve the text or file an amendment.

If the applicant simply approves the text, the EPO will issue the decision to grant the patent and the patent will grant soon after.

However, in their reply to the EPO communication the applicant can also decide not to approve the text enclosed with that communication. This can happen when the applicant has second thoughts on the wording of the claims, or when, during the preparation of the text to be sent to the applicant for their approval, the Examiner inserts certain changes that the applicant does not agree with.

In the latter case, the applicant will reply to the EPO communication indicating the amendments they wish to introduce, or by indicating why the Examiner's changes are not justified.

Until now, when the applicant replied to the EPO communication indicating certain amendments rather than simply approving the text, the applicant had the option of:

(a) receiving a second EPO communication containing the new text of the prospective patent, thus having the opportunity to review that new text prior to the grant of the patent,

or

(b) waiving the right to such second EPO communication, thus potentially obtaining a faster grant of the patent.

When the EPO introduced the option of waiving the right to the second EPO communication in 2015, it had considered that this option would be very popular among users due to the resulting efficiency.

However, following a recent consultation with users, the EPO has established that the waiver option is only rarely used by the applicants, probably because the review of the text with which the EPO intends to grant the patent is a crucial procedural step for applicants who therefore want to benefit from the possibility of reviewing such text. In addition, the EPO starts preparations for the publication of the granted patent as soon as the applicant approves the text - be it the one sent with the first EPO communication or the revised one sent with the second EPO communication - so that the delays in the grant of the patent are not significant even in the absence of a waiver of the right to receive the second EPO communication.

As a result of this consultation with users, the EPO has therefore decided to abolish the option to waive the right to the second EPO communication, starting on July 1, 2020. This will essentially allow applicants to always review the text with which the EPO intends to grant the patent, and will simplify the grant procedure both for the EPO and for the users.

This decision by the EPO is yet another example of the EPO's commendable practice of listening to the users and changing its procedures based on the users' needs and preferences.