

Consultation Response by the Chartered Institute of Patent Attorneys (CIPA)

The Chartered Institute of Patent Attorneys (CIPA) is the professional and examining body for patent attorneys in the UK, representing virtually all the 2,400 registered patent attorneys in the UK, whether in industry or in private practice. Total membership is over 4,000 and includes judges, barristers, trainee patent attorneys and other professionals with an interest in intellectual property. CIPA represents the views of the profession to policy makers at national, European and international level, with representatives sitting on a range of influential policy bodies and working groups in the UK and overseas.

Response to EPO Draft Strategic Plan – Consultation Invitation

CIPA welcomes the significant effort put in by the European Patent Office to design a long-term strategy. We would express our complete support for a wide range of the initiatives proposed including those supporting enhanced employee satisfaction, improvements to systems and processes from the “bottom up”, maintaining quality and hence the reputation of the European Patent Office as the world’s foremost patenting granting authority, and enhancing collaboration and consultation in the interests of harmonisation.

Turning to specific points, in view of the time constraints we highlight a limited set of issues as follows:

Quality

- We welcome the Directorate Quality Audit Process but reiterate that the primary quality framework at the European Patent Office is the European Patent Convention itself. Of course quality should be maintained at the highest level throughout the European Patent Office but the primary goal of ensuring that patents are granted for inventions meeting the patentability criteria outweighs all other considerations.
- Relaxation of the language requirements, and additional language training, for Examiners to broaden the available pool of examining talent is essential; the multi-language regime at the

European Patent Office is a useful legacy, but in view of the incredibly high qualifications already expected from Examiners, all practical efforts to ensure that as many candidates as possible are available should be considered.

- We note the specific initiatives in relation to various search options and again agree that as much flexibility as possible should be introduced. In relation to written opinions provided within a week, this appears an attractive proposition but we believe even more attractive would be enhanced ability for applicants to specify the approximate timescales within which they would like the patent process to be completed, with an appropriate upper limit for the benefit of third parties. This would allow a more accurate mapping of patent timeliness to commercial and third party requirements. We understand that the EPO would contemplate these additional measures once the backlog is dealt with and believe this is the correct prioritisation. Similarly, other offerings such as pre-filing validity searches could be of significant interest to users of the system; the more that the corresponding tools are made accessible to the public, the better of course. We also note the suggestion of providing a Freedom to Operate service. We believe that the European Patent Office should consult extremely carefully about this aspect; with respect, the EPO has no experience of considering infringement issues, and users of any FTO service from the EPO would need to be extremely clear about the level of liability the EPO carried for any results.
- We note the proposal to “merge” more secondary legislation into the Guidelines (Goal 3, Key Initiative 2). We suggest that this passage be clarified to make it clear that the Guidelines will reflect but not be the primary source of secondary legislation. We fully agree that a single resource setting out all of the legal and procedural requirements at the EPO is incredibly useful, but the exact status of the Guidelines must be maintained clear for constitutional reasons.

Efficiency

- The full review of systems and processes is of major interest. To the extent that system tools are being developed, it is vital that they are consistent between users and multiple offices; certainly, tools should be available for users to interact with the EPO suite without the requirement for additional development.
- Equally importantly is the enhancement of all of aspects of flexibility of working. To focus on a specific requirement, the video conferencing facilities at the EPO are currently being modernised which is an important step. However, currently, Examiner discretion remains in relation to ex-parte videoconferencing. For interests of sustainability (for example air travel reduction) as well as access to justice (there is inevitable expense because of hearings being called at multiple centres), videoconferencing for ex-parte proceedings should be available as of right.

Harmonisation

- The EPO’s efforts to consult have increased massively in recent times and this initiative is much appreciated and should continue. All stakeholders should be able to comment and be encouraged to do so. For example in relation to development of a “single tool” for patent

grant, enhanced Examiner-Attorney collaboration and increased use of Guidelines, consultation with all stakeholders is essential. We would urge that this extends not only to applicants and epi, but also to national patent attorney groups in view of the significant expertise and experience that they represent.

- Initiatives such as the UP and UPC should be pressed ahead with, with the involvement of all EPO contracting states if possible.
- In relation to the proposals for an enhanced Academy, and the introduction of an Observatory, integration and discussion with multiple stakeholders is again essential. CIPA would like to volunteer its services for both of these initiatives going forward. The importance of the Observatory as a potential tool for the EPO to influence the national, regional and international IP landscape should not be underestimated. More generally, the efforts by the European Patent Office to harmonise patent practice for example through the IP5 are vital; in an era of political fragmentation, a harmonised Intellectual Property system provides the foundations for enhanced economic stability, as well as an excellent example to other areas of enterprise.