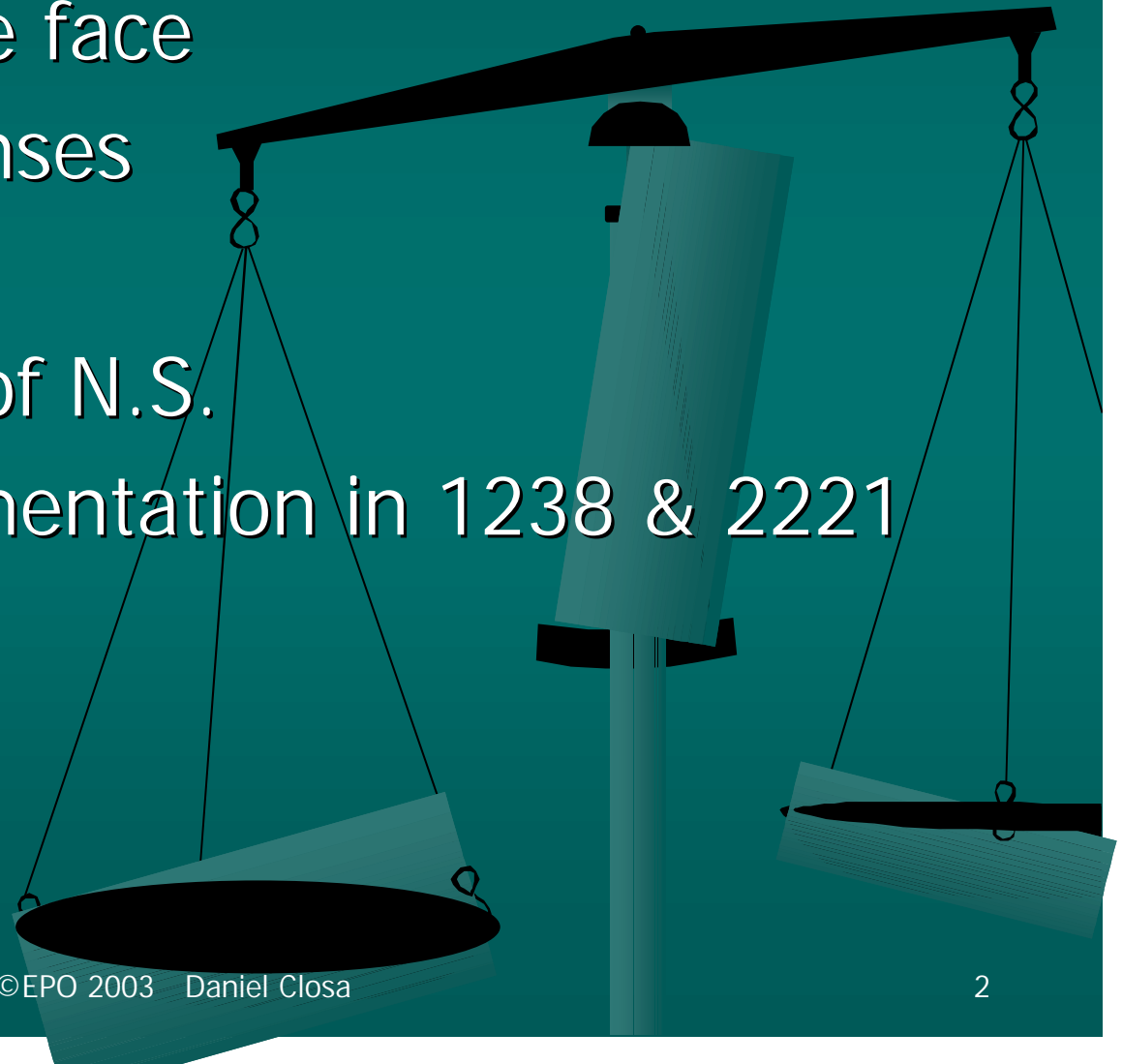


Communication under Rule 45 EPC (Non Search) in Directorates 1238 & 2221

Overview of the Presentation

- n The problem we face
- n Different responses
- n Why no search
- n Consequences of N.S.
- n Practical implementation in 1238 & 2221



Our Problem (1)

- n Is this problem directly linked to business methods?
 - n Not really!
 - n The EPO has always searched applications and granted patents related to business methods if they present a technical character which is new and inventive

Our Problem (2)

- n The content of recently filed applications has changed dramatically!
 - n In the US, it is now possible to have patents for application having very little (almost no) technical content
 - n The same type of application is then filed in Europe and in particular at the EPO („If it is possible in US, why not in Europe?“)

Our Problem (3)

- n Suddenly (May 2001-March 2002) the number of applications to be searched at the EPO in that field increased from 20 a month to 600 per month
- n 80% of these applications (in particular US-PCT) were drafted according to the US legal criteria, not ours

Our Problem (4)

Summary

- n We are overloaded with an enormous quantity of search files
- n The technical content of an important part of these applications is a priori too low to fulfill the requirements of the EPC

Possible Responses 1(a)

- n We want to send a complete search report for all files
- n But then,
 - n What do we search? Only the technical aspects or also the business aspects?
 - n If we search only the technical aspects, can we justify the view that our search was complete?
 - n Where can we search the business aspects? Neither our classification nor our searchable databases are appropriate or adapted

Possible Responses 1(b)

- n Is it of value to the Public to spend a lot of time on searching applications which will, according to the present state of the law, never result in a European grant?
- n No answer other than ,no' appears logical

Possible Resonances 1(c)

- n We could send, before performing a search, a letter to the applicant asking him what he considers to be the technical features to be included in the search.
 - n This was trialled by 1238 examiners; 400 letters were sent, very few answers were received.
 - n Where an answer was received it was rarely convincing or helpful.

Possible Responses 2



- n We issue a Partial Search

- n We search only the technical aspects of the application and we send a partial search report

- n But;

- n It is not always easy to distinguish in a set of claims those features which are technical from those which are not

- n Would the applicant or the Public understand what we had done?

Possible Response 3

- n We try to not accept the applications
 - n As from 1/3/2002 the US-PCT applications in the field of business methods should be retained by the USPTO and not searched/examined by the EPO as ISA and IPEA.
 - n This was partly due to political pressure but also to N.S. And feedback from US applicants to the USPTO.

Possible Responses 4

- n NO SEARCH
- n N.S. (and partial search) are issued as a Communication under Rule 45 EPC (PCT Art. 17(2) and PCT Rule 39.1)

Rule 45 EPC

- n If the Search Division considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims, it shall either declare that search is not possible or shall, so far as is practicable, draw up a partial European search report. The declaration and the partial report referred to shall be considered, for the purposes of subsequent proceedings, as the European search report.

WHY N.S. (1)

- n We did not invent N.S. It was already the practice of the EPO (see GL B-VIII, 1-6), whether for EP or PCT search
- n We did decide however to send a strong and clear signal to applicants and to other large players in Patenting

Why N.S. (2)

- n Standard clause used in the European SR
 - n The claims relate to subject matter excluded from patentability under Art. 52(2) and (3) EPC. Given that the claims are formulated in terms of such subject matter or merely specify commonplace features relating to its technological implementation, the search examiner could not establish any technical problem which might potentially have required an inventive step to overcome. Hence it was not possible to carry out a meaningful search into the state of the art (Rule 45 EPC). See also Guidelines Part B Chapter VIII, 1-6.

Why N.S. (3)

- n We want to send the following message
 - n Either the subject-matter of the application is excluded from patentability (in Europe)
 - n Or the technical content of the application is so insufficient that the probability of a grant being issued is very low (52(2) and (3) or 54 or 56)

WHY N.S. (4)

- n We use the N.S. solution because we believe it to be the best way to send a very clear signal to the applicants and the public (our law is different from the US law)

Consequences of the N.S.

- n For the applicant

- n A N.S. is not a loss of rights. He can still enter the examination phase (EP N.S.) or the regional phase (PCT N.S.), amend the claims and argue we should do a search during substantive examination
- n If he convinces us that a search has to be done, then documents are cited according to C-VI, 8.9. He does not have to pay for a supplementary search, nor is this issued as a Search Report

Consequences of the N.S.



- n For the applicant and the outside world
 - n The signal was understood in many cases
 - n 50% of the EP N.S. files do not proceed to substantive examination
 - n If they do proceed to substantive examination they often request accelerated examination
 - n The USPTO now processes the vast majority of US-PCT in the field

Practical implementation in both 1238 and 2221

- n All new search files are checked on arrival by the examiners in the field as a group to ensure harmonization
- n All the N.S. files are equally distributed among the examiners, usually to those with more than one year experience
- n When an examiner receives the file for searching, he takes the final decision (he signs the Search Report)

Practical implementation in both 1238 and 2221

- n The following criteria are used separately or together
 - n Are the technical aspects of the case merely generically described?
 - n Is there any a priori technical problem/solution apparent?
 - n Does a clear need for a document exist in order to refuse?

Practical implementation in both 1238 and 2221

- n An examiner should not be influenced to search by a feeling of 'I know there must be documents on this subject', nor to N.S. by a search being 'difficult'. That is not the point.
- n The point is...
- n TO GRANT PATENTS when justified
- n TO REFUSE EFFICIENTLY when not

Example 1

A method for increasing a bid for an item being auctioned at an on-line auction using a mobile telephone, said method comprising:-

- n (a) receiving a notification from a wireless network at the mobile telephone that a prior bid by a particular bidder has been out-bid;
- n (b) obtaining auction information pertaining to the item being auctioned; and
- n (c) displaying the auction information on a display screen of the mobile telephone.

Example 2

- n Method for purchasing and payment of goods and services, preferably audio and/or video data provided on a provider's platform in a computer network, like the Internet, comprising the steps:
- n taking a customer's order for goods and services, preferably an order for audio and/or video data files;
- n providing a download of ordered goods and services, preferably of audio and/or video data files, for the customer; and
- n debiting a mobile telephone account of the customer.

Example 3

A system for controlling Internet Web page advertising comprising:

means for a user to request a specific World Wide Web (Web) page on the Internet ;

means for initially displaying an advertising page occupying the full browser window display, prior to said user desired Web page is displayed;

and means for subsequently displaying said user requested Web page absent any advertisement

Example 4

A method of reducing the risk associated with reducing the cost of maintaining intellectual property rights for a first legal entity, comprising creating a contractual relationship between the first legal entity and a second legally independent entity, the contractual relationship having the following legally binding obligations:

commitment from the second legal entity to pay such fees and undertake to perform such acts at the expense of the second legal entity as are required to maintain the intellectual property right enforceable, the commitment being made for a predetermined period and resulting in a monetary cost to the second legal entity;

commitment to transfer title in an intellectual property right from the first legal entity to the second legal entity, any valuable consideration provided to the second legal entity being of less value than the monetary cost to be incurred by the second legal entity;

and commitment to grant during the predetermined period the right to regain title in the intellectual property right from the second legal entity for predetermined consideration;

the second legal entity being otherwise free to exploit the intellectual property right for financial gain during the predetermined period.