

Patent Cooperation Treaty (PCT) Working Group

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REPORT ON IMPLEMENTATION AT THE EUROPEAN PATENT OFFICE OF THE MANDATORY REPLY TO A NEGATIVE SEARCH OPINION

Document submitted by the European Patent Office

1. By decision of December 9, 2004, the Administrative Council of the European Patent Organisation adopted new Rule 44a EPC1973 (now Rule 62 EPC) introducing the extended European search report (EESR) as of July 1, 2005. A similar change was made to the PCT Regulations by establishing the written opinion of the International Searching Authority (WO-ISA, new Rule 43*bis* as of January 1, 2004). These newly-introduced search-type products (EESR and WO-ISA) require more time and effort during the search phase. This, however, is compensated by a reduced examination time at the individual dossier level. Thus, more time and effort have been shifted to an earlier stage of the procedure. In 2008, 100 per cent of the search products by European Patent Office (EPO) comprised a written 'opinion'.
2. One of the purposes of introducing an opinion accompanying the search report was to enhance procedural efficiency by providing already at the search stage a product corresponding to the examiner's first communication in examination. However, an efficiency gain was achieved only in part, because the discretion to reply to the negative opinion was left to the applicant, and often applicants did not do so. As a result, in most cases, the first communication in examination (under Article 94(3) EPC) ended up being a mere copy of the search opinion.
3. In 2009, the EPO launched a strategic renewal program aimed, *inter alia*, to improve procedural efficiency, under which the above mentioned deficiency was addressed. By decision of March 25, 2009 (entering into force on April 1, 2010), the Administrative Council of the European Patent Organisation adopted new Rules 70a and 161 EPC rendering a reply from an applicant mandatory where the opinion accompanying the search report established by the EPO is negative. Where the applicant does not reply to a negative opinion by submitting comments

and/or amendments to the application, the application is deemed to be withdrawn. Applicants are not required to reply to a positive opinion. Although it is not mandatory to amend the application, it was expected that applicants would more frequently do so, and in particular amend the claims, when replying to a negative search opinion.

4. In 2009 (when it was not yet mandatory to reply to a negative opinion) only 18.3 per cent of Euro-PCT applications in respect of which the EPO as International Authority issued a negative written opinion (or IPER) were accompanied by amendments when entering the national phase. In 2011 (first complete calendar year where the mandatory reply was implemented) this percentage increased to 85.5 per cent. This significant increase suggests that applicants reacted to the new procedure in a positive manner. A similar trend was observed for applications filed under the EPC. In 2009, in 34.2 per cent of the applications' amendments were filed before examination. This figure rose to 81.3 per cent in 2011. A slight improvement of these parameters was observed over the following years.

5. The rate of so-called "direct grants" after a negative search opinion was also measured. The term "direct grant" refers to applications for which an "intention to grant" was the first communication after amendments made in reply to a negative search opinion.) *Vis-à-vis* the 2009 baseline of 59.8 per cent, an increase of up to 65 per cent was observed in 2011. In subsequent years this ratio has remained stable.

6. It can thus be concluded that the introduction at the EPO of a mandatory reply to a negative written search opinion issued by the EPO had a positive impact on legal certainty and efficiency, as suggested by the increase in the overall rate of direct grants for applications in which a negative opinion was issued by the EPO during the search stage.

7. *The Working Group is invited to note the contents of the present document.*

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