

EPC :審査促進のための規則改正

審査促進のため、EPCに新たな規則(Rule 44a)が追加されました。

欧州特許庁作成のサーチレポートに、特許性に関する見解書(Opinion)が添付されることになりました。この見解書は、First Official Action の内容に近いもので、特許性に関する審査官の見解が示されます。なお、この見解書は公開されませんが、閲覧することは可能です。

この新たな規則は、2005年 7月 1 日以降に欧州特許庁に出願された出願に対して適用されます。EPCに移行された国際出願については、国際出願日が2005年 7月 1日以降のものに適用されます。

見解書において特許性を認める旨の見解が示された場合には、更なるサーチにより 54条 (3)の先行技術が見つからなければ、審査部は特許付与を認め、出願人に対し欧州特許条約規則 51 (4)の通知を発令します。

一方、見解書において特許性について否定的な見解が示された場合、出願人は、見解書受領後に補正書および意見書を提出することができます。その後に発令される Official Action では、提出された補正書および意見書を考慮した上で審査官の見解が示されます。これにより、審査期間の短縮が図られます。

また、出願人が見解書受領後、意見書および補正書を提出しなかった場合には、審査部は、見解書を参照した Official Action を発令します。これにより、通常の審査手続きが進行します。

以上は、TER MEER STEINMEISTER & PARTNER GbRのご厚意により、同事務所からご提供いただいた情報 (次頁以降をご参照下さい)を、弊所の責任の下に抜粋、翻訳したものです。

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Recent changes in the EP granting procedure:

**The Extended European Search Report and
how to deal with it
to speed up the examination procedure**

1 1. Introduction1.1 What is the Extended European Search Report (EESR)?

5 According to a decision of the Administrative Council dated 9 December 2004
a **New Rule 44a** was inserted into the EPC:

(1) *The European search report shall be **accompanied by an opinion** on whether the application and the invention to which it relates seem to meet the requirements of this Convention, unless a communication under Rule 51, paragraph*
10 *2 or paragraph 4, can be issued.*

(2) *The opinion under paragraph 1 shall not be published together with the search report.*

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This New Rule 44a of the Implementing Regulations shall apply to **European Patent Applications** and **International Applications entering the European Phase**, filed on or after **1 July 2005**.

20 1.2 Bringing Examination and Search Together (BEST)

Before the start of the project BEST at the EPO, search and examination were performed at **different locations** (The Hague and Munich) by **different Examiners** (Search Examiner and Substantive Examiner) resulting in low efficiency of the grant procedure.

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Now, within the BEST procedure, the **Search Examiner** is also the **Substantive Examiner** in the Examining Division. For increased efficiency in the overall grant procedure, a BEST Examiner prepares, already at the search stage, an opinion about the patentability of the invention claimed.

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Therefore, the BEST-project was an essential requirement for launching the EESR.

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1 2. Former patent granting proceedings

5 If an European Patent has been accorded a date of filing and is not deemed to be withdrawn, the Search Division draws up the European Search Report. The European Search Report is published together with the application 18 months after the filing date, if the European Search Report is completed before the completion of the technical preparation of the publication.

10 If the applicant has not filed the request for examination together with the application or the request for entry into the European Phase, a request for examination may still be filed up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European Search Report.

15 If the applicant has filed the request for examination before the European Search Report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate, within a period to be determined, whether he desires to proceed further with the European patent application (Art. 96 (1) EPC). Failure to respond to this communication
20 can be healed by a valid request for further processing or reinstitution in integrum.

For accelerated proceedings the applicant may waive the communication according to Art. 96 (1) EPC. In this case the application will be forwarded to
25 the Primary Examiner who prepares a communication according to Rule 51(2) or Art. 51(4) EPC.

However, since the Search Examiner and the Primary Examiner were not identical persons, **time delay occurred due to transmission and reanalyzing.**

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1 3. Present patent granting proceedings (since 1 July 2005)

After a preliminary pilot phase, the EESR is now obligatory. The new procedure also applies to the Supplementary European Search Report under Article
5 157(2)(a) EPC.

3.1 Standard patent granting proceedings

After filing of the application the **BEST Examiner** prepares the **Extended European Search Report** accompanied by an **opinion**.
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In the case of a **positive opinion**, the applicant then receives the communication under Rule 51(4) EPC, provided a final toppingup search does not reveal new prior art under Article 54(3) EPC and the examining division
15 concurs with the opinion.

If the **opinion contains objections to grant** of a patent, the Examining Division issues a communication under Article 96(2) and Rule 51(2) EPC, setting a time limit and referring to the content of the opinion. Then the normal examination procedure starts.
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The applicant can shorten the procedure by filing arguments or amendments under Rule 86(2) EPC to meet the objections raised in the opinion. Then the communication under Article 96(2) and Rule 51(2) EPC cannot merely refer to
25 the content of the opinion. The communication issued must take account of the amendments and arguments submitted.

3.2 Accelerated patent granting proceedings

30 **If the applicant has paid the examination fee before receiving the search report and waives the communication under Article 96(1) EPC**, then a valid request for examination has already been made. In such cases, examination proceedings can begin as soon as the European Search Report has been issued. The Examiner then issues either an examination communication
35 under Article 96(2) and Rule 51(2) EPC or a communication under Rule 51(4) EPC. Therefore, in these special cases, **no opinion under Rule 44a EPC**, but rather a communication under Rule 51(2) or (4) EPC is sent to the applicant.

1 If the Examining Division considers that the application and the invention to
which it relates **meet the requirements** of the EPC, it issues a **communica-**
tion under Rule 51(4) EPC, provided a final search does not reveal new prior
art under Article 54(3) EPC.

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If there are **objections to the grant** of a patent, the examination communica-
tion under Article 96(2) and Rule 51(2) EPC is issued as soon as possible after
the European Search Report. Under the BEST procedure (Bringing
Examination and Search Together), **the examination communication under**
10 **Article 96(2) and Rule 51(2) EPC is drawn up more quickly, significantly**
reducing the period of time elapsing between receipt of the European
Search Report and receipt of the first examination communication. This
also reduces the time available for filing amendments under Rule 86(2) EPC,
but does not affect amendments under Rule 86(3) EPC.

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1 4. Summary

 The EESR will be a first step to **bringing the procedures under the EPC and**
 the PCT into line, bearing in mind that for International Applications filed as
5 from 1 January 2004 the International Searching Authorities will issue an
 Extended International Search Report.

 We consider the EESR as an efficient tool and service helping you to make an
 informed decision about your case **at an early stage** and enabling the Office
10 to **streamline the grant procedure**. Therefore, the EESR gives you the option
 of accelerating the patent grant proceedings and to reduce economic risks.

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