

IMPROVING EXAMINATION COMMUNICATIONS



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There is a will on the side of the European Patent Office (EPO) to make patent prosecution more effective and faster. Raising the bar of patent quality was a theme some years ago, when the EPO encouraged representatives to draft patent applications according to European Patent Convention (EPC) standards.

The aim was fewer examination communications, to the expected benefit of both EPO, in view of reduced workload of the examiners, and the applicant because of lower patent prosecution costs.

The *Guidelines for Examination in the EPO* instruct examiners to use the 'problem-and-solution' approach to determine inventive step. The 'problem-and-solution' approach tells that to deprive an invention of inventive step, there has to be something (an 'incentive') in the closest prior art that would prompt a given skilled person to combine the cited documents.

To have effective and fast patent prosecution, examination communications need to be clear and precise, and provide sufficient and eligible support for all stated objections. But some examination communications and European Search Opinions, as well as written opinions issued during the Patent Cooperation Treaty (PCT) stage with the EPO as the search authority, still do not explain what the incentive is. The applicant or the professional representative should, however, not be put in doubt of the content and construction of the examination communication.

According to case law, common general knowledge is usually presented in encyclopaedias, textbooks, dictionaries or handbooks. The content of a patent application can also be common general knowledge but only for newer technical fields and normally not for already established technical fields.

An examiner's use of personal knowledge is another issue. Although personal knowledge is difficult to disregard when examining a patent application, it should not be used without a citable reference for the applicant to relate to.

Nevertheless, many search opinions or examination communications without referring to prior art state a technical feature to be common general knowledge or deem a claimed invention obvious, arguing that the person skilled in the art would be aware of the invention or have no problems arriving at it based on the closest prior art.

Some inventions are not complicated and their simplicity may seem obvious in hindsight and the solution given in the application. So whether a technical feature is part of the common general knowledge can, thus, be quite important to the prospects of any patent application, and it is essential

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that the applicant or his representative is provided with a proper basis for such objections.

Vague objections like these cause the applicant/representative to waste time and money to argue against them. How can the applicant or his representative establish the common general knowledge? In principle, the only way is to consult all known encyclopaedias, textbooks, dictionaries or handbooks within the relevant technological field to establish the basis for the examiner's general objection, but in reality this is impossible.

So not only does the applicant/representative have to use more time to reply to a search opinion or examination communication, but there is also the risk that the reply misses the mark and an extra communication has to be issued. If the technical feature really is part of the common general knowledge, why not present good arguments and supportive evidence in the first place?

As indicated in the introduction, this article should be understood as a suggested continuation of the work started by the EPO towards raising the bar and enabling the communication between examiner and applicant/representative to be clearer and better.

A more precise and transparent approach would give a much better starting point for the examiner and the applicant to agree about what is novel and whether the novel technical feature comprises an inventive step. ■

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