

International Preliminary Examination of International Applications

International patent applications filed by British applicants are generally submitted twelve months after an original (priority) UK application. The European Patent Office (EPO) is normally the International Searching Authority for such applications. They conduct an international search, the report of which generally issues a few months after filing of the international application. A Written Opinion of the International Searching Authority (the EPO) is attached to the search report. The Written Opinion sets out the view of the search examiner as to patentability of the invention claimed in the international application. At least, it deals with the questions of novelty and inventive step in the light of the documents cited in the search report.

The applicant has a choice to make soon afterwards. A Demand for International Preliminary Examination can be filed, and if it is filed, this must be 22 months after the original priority filing date, or three months after issue of the International Search Report, whichever is later. The EPO is normally the International Examining Authority under the Patent Co-Operation Treaty in respect of international applications filed by British applicants.

Filing a Demand for International Preliminary Examination is a voluntary step, but it costs about £2000 plus VAT, exclusive of any work that is needed on our part. That work might be to amend the claims of the patent application to deal with any objections in the Written Opinion. It might also involve the development of argumentation in support of patentability. In response to the Demand, the EPO examiner issues an International Preliminary Examination Report (IPER). That report has certain benefits that might make it worthwhile filing the Demand. Generally, HGF does not consider it of sufficient value and does not, on the whole, advise clients to avail themselves of the opportunity.

The aim of International Preliminary Examination would be to gain a favourable IPER; that is, one which concedes that the claims (possibly as amended) define a patentable invention in the view of the international examiner.

The benefits of a favourable IPER vary depending on where the patent application is ultimately taken at the end of the international phase of the application. That phase ends at 30 months (or 31 months, in some cases) after the original priority filing date. At that point, it is necessary to give effect to the application in countries where patent protection is desired. The following categories of patent office/country apply:

Category 1 – The European Patent Office

The benefit of a favourable IPER is that it more or less guarantees that a European Patent will issue. It is very unlikely that the EPO will go back on the opinion reached (although they are not bound by the terms of the IPER) unless some new evidence of lack of patentability comes to light. On the other hand, an unfavourable IPER is really no worse than an unfavourable examination report; it does not mean that no patent will be secured. It means only that the examiner is not persuaded by the first round of amendment/argumentation provided.

Thus while a favourable IPER might effectively guarantee grant, an unfavourable IPER is not final. The cost of international preliminary examination is not entirely lost if the application is prosecuted in the European Patent Office. A reduction in fees payable to the EPO of about £700 can be expected, defraying some of the original cost.

Nevertheless, that extra cost is still extra, and the written opinion alone, taken with our own reading of the objections, should give the applicant a good indication of the chances of success without going through international preliminary examination

Category 2 – Sophisticated Examination Countries

Countries like the US, which have a sophisticated and well established examination system, presently take little notice of the IPER prepared by another office. They issue their own examination report. Consequently, having a favourable IPER is of little or no benefit in most countries of this ilk. On the other hand, see the comments on the PPH below.

Category 3 – Less sophisticated Examination Countries

Some countries have relatively inexperienced patent examination systems, yet still want only to grant valid patents. Examiners in these countries are more likely to be influenced by the IPER.

Unfortunately, this works both ways. An unfavourable IPER can be at least as damaging to eventual prospects as a favourable one is helpful. Consequently, one is probably better off without an IPER at all in these countries, rather than having an unfavourable one.

International Preliminary Examination of International Applications

April 2014

PPH

The Patent Prosecution Highway is a relatively recent initiative of the United States Patent and Trademark Office (USPTO) that has been taken up by numerous offices around the world. The EPO is an example. Now, it is feasible to request treatment of your application under the PPH in the USPTO, as well as in the Japanese Patent Office and the Korean Patent Office. Other countries also are involved, so please ask for details if this is of interest. When a patent office accepts an application for treatment under the PPH, it is necessary to conform the patent claims of your foreign patent application with claims that have been accepted or indicated as allowable in the home office. The same applies where an international application has been the subject of a favourable international preliminary examination. The foreign office then does not substantially question the patentability of those accepted claims, although there may be further examination of local issues and form.

Consequently, a favourable IPER could be used as a basis for facilitating examination in countries when the national phase of the application is entered.

IPRP v IPER

It should be said that the European Patent Office, in the event that international preliminary examination is not requested, ultimately issues the Written Opinion attached to the International Search Report as an International Preliminary Report on Patentability (IPRP). The only difference between an IPRP and an IPER is that the applicant played little part in the conclusions of the IPRP, which is issued by the International Searching Authority under Chapter I of PCT. The IPER is issued by the International Examining Authority under Chapter II of PCT. More weight should in theory be given to the latter. On the other hand, PPH can be based on the IPRP, so if that is favourable already, there is little point in going to the expense of IPE.

Conclusion

In view of the above, HGF does not generally recommend international preliminary examination although it might be appropriate in some cases.

For example, in the case where the applicant only intends to give effect to the international application in the European Patent Office (confirming it as a European patent application), then, if the written opinion is somewhat negative, international preliminary examination might be requested. This would be done with the premise in mind that, unless a favourable IPER is obtained, the applicant would not proceed. That is, the IPER would be used to help decide whether to proceed. If the applicant proceeds in any event, then there is really no point in filing the demand for international preliminary examination.

In another example, in the case where the applicant intends to file in a large number of countries, including some Category 3 countries, and the written opinion is positive, (or can at least with some confidence be rendered positive) then it may well be worth requesting international preliminary examination, since a favourable IPER will facilitate, and probably expedite, grant in a number of different countries. This cannot be guaranteed, of course, and is more a general opinion rather than a specific legal position in relation to any given country. However, the advent of the PPH system is suggesting that getting a favourable outcome will facilitate and expedite grant in some major countries also.