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Subject : Enhanced Partnership in Community Patent  
- Non-paper by the Danish, Finnish and United Kingdom delegations

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Delegations will find in Annex a non-paper submitted by the Danish, Finnish and United Kingdom delegations.

This non-paper is produced for the purposes of contributing to discussions and does not represent the official positions of the Danish, Finnish and United Kingdom governments.

## **Enhanced Partnership in Community Patent**

### **I Introduction**

The principle of enhanced partnership was discussed at Council Working Group on 17 February 2009. At this meeting, the majority of delegations supported the principle of utilizing resources from across Europe to help provide an efficient and effective Community Patent, which could meet user expectations in terms of quality. The UK, Danish and Finnish delegations undertook to provide further information on how this could work as a basis for more detailed discussions. This information is based on experiences gained with work-sharing through contract work and active participation in the Patent Cooperation Treaty, European Patent Network, Utilization Project and Patent Prosecution Highway Program.

### **II Objectives**

1. Enhanced partnership should meet two main objectives:

#### **A) Affordable patenting**

The direct benefit of a properly functioning Community patent is an affordable patenting system for businesses in Europe, especially SMEs. Practical experience and technological developments have demonstrated that it is possible for patent granting authorities to share and outsource work leading up to the patentability decision. For example, experience of the Utilization Project has shown that savings in time and improvements in quality can be gained from increased cooperation between offices. An effective enhanced partnership arrangement must provide faster delivery of high-quality patents and a reduction in overall costs.

## **B) High quality and efficiency**

Backlogs of unexamined patent applications need to be reduced without a detrimental effect on the quality of granted rights. Enhanced partnership between the European Patent Office (EPO) and national patent offices could include distribution of applications to minimize overall backlogs, and acceptance of work carried out by different offices in order to avoid duplication. This work would need to be done within an agreed patent quality assurance system and practice framework covering the EPO and national patent offices.

2. In addition to the above objectives, a sustainable and reliable enhanced partnership arrangement must at all times be fit and flexible to respond to present and future challenges. Therefore, any national patent office should be allowed, on a voluntary basis, to contribute to a well-functioning Community patent by providing services corresponding to their resources and competences. This would maximize the potential of existing resources and also provide national patent offices with a firm platform to maintain and develop their capabilities.

## **III Cooperation Criteria**

3. There are a number of criteria that should be agreed before proceeding with any enhanced partnership arrangements.

### **A) Quality Standards**

Any office undertaking Community patent work would have to meet the agreed quality standards which could be based on the European Quality System. In addition to this, there would have to be an objective quality assurance framework to assess work undertaken by offices to ensure this work meets appropriate standards.

To guarantee appropriate levels of quality, the quality assurance framework could involve representatives from the EPO, national patent offices and professional users of the patents system.

## **B) Central Role of the EPO**

The EPO should be the only final authority for granting Community patents.

## **C) Law and Practice**

When undertaking Community patent work, all offices will have to agree to use the same set of patent law and practice to ensure a consistent approach to processing patent applications. All patent offices should have access to the same training, and guidance materials to ensure that patent law and practice is reliably applied.

## **D) Accessibility**

All national patents offices shall on a voluntary basis have the opportunity to undertake Community patent work on all applications as long as they meet and maintain the agreed quality standards. Where applicable, it is the applicant's choice whether work should be carried out by the EPO or a national patent office.

## **IV Options**

4. The system of enhanced partnership should build on experience gained from existing arrangements such as the Utilization Project, Patent Prosecution Highway and the Patent Cooperation Treaty rather than revisiting the work that has been done before. As outlined above all national patent offices should be allowed to carry out tasks related to innovation support activities (option A below). In addition we believe that something positive could be achieved by allowing national patent offices to undertake additional activities from the following set of options B-D.

## **A) Innovation Support Activities**

All national patent offices have an essential role advising potential applicants including SMEs, disseminating patent information and receiving applications. National patent offices can also play a vital role fostering innovation.

National offices are ideally placed to offer IP audits to SMEs to help them understand the IP they have created and to advise them on how best to use it. It would be unrealistic to expect national offices to visit every SME in Europe, therefore the development of online tools to allow businesses to assess their own IP is another potential activity. The training of business advisors so that they recognize IP issues when they speak to SMEs is another way that national offices can support innovation. In addition, national offices can play a vital role in educating the entrepreneurs of the future in the value of IP through schools competitions and national exhibitions.

## **B) Search work**

Searching is the first stage of the examination process where an examiner determines what is already known in the technology field relevant to an application. This usually involves extensive online searching for patents and other documents in order to establish the patentability of an invention.

Bilateral work-sharing arrangements on search work have indeed proven beneficial both with respect to increased quality and time efficiency. Following the report on the recent Utilization Project, which stated that the reuse of search work carried out by national patent offices was possible, the Administrative Council of the EPO has decided to implement this as a permanent arrangement.

The Patent Cooperation Treaty PCT was originally designed to share work. Sharing of work is still a cornerstone of the PCT and continuing interest and recognition of the benefits of sharing of work is shown by the ongoing discussions on how to improve this system further.

Sharing of search work in the Community patent system could be done using a variety of different methods, including the two options set out below.

In one option, as under the Utilization Project, an EPO examiner could utilize the results of searches done by national patent offices on earlier-filed priority applications. This search could then supplement the work done by the EPO examiner and be used to save time in undertaking the searches.

Alternatively, an EPO examiner could accept a search carried out by a national patent office which meets the independently-verified quality standards. The expectation would be that the EPO examiner would not carry out further searching unless exceptional circumstances made it necessary, for example if the EPO claims were significantly different. Valid searches could include searches done on earlierfiled priority applications or searches done by national patent offices undertaking Community patent search work.

As stated above, participating patent offices would need to meet an agreed quality standard. Utilization of search results is probably the easiest to achieve initially as searching is not as susceptible as examination to local variations in patent practice. Searching is a highly skilled and time-consuming process and it may be expected that, by accepting the work performed by other offices, substantial savings could be made at the EPO.

### **C) Preliminary Examination Opinion**

At search stage, in many patent offices, examiners will provide the applicant with a preliminary opinion. This report will give an initial opinion on the patentability of the application taking into account the results of the search.

In this scenario, the national patent office's examiner would provide an initial report on the patentability of an application with any search carried out. The EPO examiner would then consult this report before issuing their own examination report. Prior to the EPO examiner undertaking their examination, the applicant would be encouraged to file amendments in response to the initial report. If the EPO examiner is happy with the initial report and the applicant has made no amendments, the EPO examiner could then choose to re-issue that report as the substantive examination report. Alternatively, the EPO examiner could re-examine the application using the preliminary opinion to supplement the examiner's own efforts and to reflect any amendments.

#### **D) Substantive Examination**

Substantive examination is where a reasoned opinion on the patentability of an application is made by an examiner taking into account the results of the search.

In this scenario, an examiner at a fully-accredited national patent office would issue a full substantive examination. Any amendments would then be dealt with by the examiner at the national patent office. When the examiner at the national office was happy that the case was suitable to grant the case would be sent to the EPO where an examiner would look through the case and ensure that it met EPO quality requirements before granting. This would be made possible by utilizing a common quality assurance framework and ensuring that national and EPO examiners have access to the same training and guidance materials so that the law and practices are applied consistently.

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