

User Driven Early Certainty (UDEEC)

The EPO kindly requests your feedback on a new procedural option to postpone the start of substantive examination for up to 3 years (User Driven Early Certainty).

1. The Office has fully accomplished Early Certainty from Search (ECfS¹) and is well on track to achieve its Early Certainty from Examination (ECfE²) and Early Certainty from Opposition (ECfO)³ targets by 2020.
2. Users of the European patent system have expressed their satisfaction with the Early Certainty initiative. At the same time, some applicants have called for more flexibility and raised concern that a one-size-fits all 12-month examination timeline may negatively affect the innovation and development capacities of some companies. Depending on the technical field and individual applications more time may be needed in some cases before the start and conclusion of substantive examination.
3. This feedback has been received in particular from companies in the pharma and biotech field, but also from other technical areas with very long product development cycles where applications are filed at a very early stage. Regulatory approval requirements may also be a reason why applicants need more time before the start of examination and before a patent is granted. The same applies to companies (such as start-ups, SMEs or universities) who need time to licence an invention after filing before being able to finance substantial prosecution and validation costs.
4. The EPO wishes to promote innovation across all technological fields and to provide the right services for all its users. While applicants have a number of means to speed up the grant procedure (PACE⁴, waivers⁵, early entry into the EP-phase) there is currently no procedural option for applicants who have an interest that substantive examination begins later than 6 months after the (supplementary) European search / entry into the EP-phase.
5. For this reason the Office is considering introducing the possibility for applicants to postpone the start of substantive examination for a limited period of time. Full transparency about postponed applications and the strict adherence to the ECfS principles as regards the early establishment of search reports and the acceleration of applications with third-party observations will avoid unintended consequences for competitors potentially affected by pending applications.

¹ Establishment of search reports with a preliminary opinion on patentability within 6 months of receipt of the file.

² Average examination time of 12 months from request for examination to intention to grant a patent.

³ Standard oppositions cases on average concluded within 15 months from expiry of the opposition period.

⁴ Programme for Accelerated Examination of European patent applications.

⁵ Waiver of the communications under Rule 70(2) and Rule 161 EPC.

6. Based on user feedback it may be assumed that applicants will in about 10% of cases make use of the postponement option. Postponement will thus be an exceptional procedure, and examination according to ECfE will remain the standard.
7. The main features of UDEC are foreseen as follows:
 - The procedure would remain unchanged up until conclusion of the search stage. In particular the EPO will continue to draw up the (supplementary) European search report with a preliminary opinion on patentability within 6 months. The applicant continues to be obliged to reply to the search opinion and to pay the examination fee in the same way as currently.
 - As new procedural option the applicant would be given the possibility to request a postponement of the start of substantive examination within 6 months from the (supplementary) European search or from entry into the EP-phase (where the EPO does not perform a supplementary search).
 - In order to ensure efficient processing of incoming requests for postponement, applicants would be required to file the request online only and by means of a dedicated form made available by the EPO.
 - If the request is valid the EPO would not begin substantive examination of the application before expiry of 3 years calculated: in case of EP-Direct applications from expiry of 6 months after the search; in case of Euro-PCT applications from valid entry into the EP-phase).⁶
 - For divisional applications the postponement period would be calculated from filing of the earliest application with the EPO.
 - While making use of the postponement option would not be subject to a special administrative fee, applicants making use of this option would be required to pay the applicable EPO fees in the same way as if no postponement had been requested. This concerns in particular the payment of the examination, designation, validation, claims and annual renewal fees for an application.
 - Applicants would be given full flexibility to initiate examination before expiry of the maximum 3 year postponement period by filing either an explicit request for lifting postponement or a request for PACE or PPH.
 - A postponement would be lifted in case of receipt of substantiated non-anonymous third party observations, which are not subject to a fee.
 - In order for third parties and the public to be able to determine that substantive examination of an application has been postponed, the applicant's request for postponement would be made public via file inspection and information on the postponement would be entered in the European Patent Register.

⁶ Annex 1 shows the average procedural duration if full use of postponement is made.

- At the end of postponement, examination would begin in accordance with ECfE priorities. Accelerated processing applies in case postponement would be lifted due to third-party observations or if requested by the applicant (PACE, PPH).
- The new procedure would enter into force on 1 July 2018 and apply to EP-Direct applications for which the search report is published on or after this date, and to Euro-PCT applications which enter the EP- phase on or after 1 July 2018.
- Information about the new option would be published in the Official Journal and in the November 2018 Examination Guidelines.
- A full review of the programme, taking into account feedback on the experience of users with the new procedure, would take place within three years after entry into operation.

Annex 1: Average procedural duration in case of full use of postponement

