



The Social-Economic Impact of the Delay in the Prosecution of Patent Applications

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Overview

- The Brazilian landscape: an outsider's perspective
- Some preliminary thoughts on delays
- The European Patent Office and some recent developments
- Conclusions

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Introduction

It's not just patents...

... and not just Brazil...

EUTM file information

BABY-DRY
000200006

Timeline



Trade mark information

Name	BABY-DRY	Filing date	09/04/1996
Filing number	000200006	Registration date	
Basis	EUTM	Expiry date	
Date of receipt	09/04/1996	Designation date	
Type	Word	Filing language	English
Nature	Individual	Second language	French
Nice classes	16, 25 (Nice Classification)	Application reference	TM-105780/EU-BB
Vienna Classification		Trade mark status	Application opposed
		Acquired distinctiveness	No

Goods and services

English (en)

- 16 Disposable diapers made out of paper or cellulose.
- 25 Diapers made out of textile.

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Introduction

The BABY-DRY saga: the EUTM process

- Filed: 9 April 1996
- Objections on absolute grounds; appeals...
- Published: November 2002
- Opposed: February 2003
- Decision (opp rejected): December 2014
- Appeal pending...

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The position in Brazil

- *“It is an old question in Brazil, how to cope with patent and trademark applications which have been pending before the BPTO for a long time.”*
- Over 10 years from filing for patent examination to begin
- Currently backlog of 230,000+ applications

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The position in Brazil

- Rule No. 193/2017 to expedite examination of patents by making use of search reports issued by International Search and Preliminary Examining Authorities recently revoked
- New simplified allowance procedure without technical examination if certain requirements met? (Public consultation ends today...!)
- Recent Court Orders for BPTO to proceed immediately with decision of long-pending Applications (Federal Constitution)

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Social-economic impact of delays

- Undeniably patent application processes in some countries are not as fast as Applicants would hope
- Applicants want to see ROI; ability to enforce against competitors
- Yet in other countries it may be quicker than they would like...
- Quick examination = poor examination = poor patents...?

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Social-economic impact of delays

- Overall, middle ground preferred
- BUT speedy prosecution important:
 - grant may be condition of financing
 - grant = certainty to market
- Undoubtedly slow prosecution = reduced investment (Brazil good e.g. of this)
- Holy Grail: speed + rigorous examination
- Certainty = key word here...

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THE EUROPEAN PATENT OFFICE (“EPO”)

38 European member states

- Belgium • Germany • France • Luxembourg • Netherlands • Switzerland • United Kingdom • Sweden
- Italy • Austria • Liechtenstein • Greece • Spain • Denmark • Monaco • Portugal • Ireland • Finland
- Cyprus • Turkey • Bulgaria • Czech Republic • Estonia • Slovakia • Slovenia • Hungary • Romania
- Poland • Iceland • Lithuania • Latvia • Malta • Croatia • Norway • Former Yugoslav Rep. of Macedonia
- San Marino • Albania • Serbia

2 European extension states

- Bosnia-Herzegovina • Montenegro

2 Validation states

- Morocco
- Republic of Moldova

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**OR PUT
ANOTHER WAY...**



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EARLY CERTAINTY (“EC”)

- Initiative started in 2014 with ECfS – from search (search report within 6 mths of filing)
- Extended in 2016: now ECfE – from examination; and ECfO – from Opposition
- ECfE: grant within 12 mths from examination
 - exam fee refund changes
- ECfO: down from 26 mths to 15 mths
 - reduction in patentee/Opponent reply periods and oral proceedings deadlines
 - preliminary view of Opp Division from patentee reply
 - backlog of Opp files fell by c.75% in 2015/6

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EARLY CERTAINTY (cont.)

EPO aims to provide by 2020

- Prior art search & written opinion within : 6 mths
- Examination on average within: 12 mths
- Opposition (standard case) within: 15 mths

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HOW ACHIEVED...?

- Not always been a swift system
- Drive for speed has been a long process
- Formal rules implemented to ensure Examiners act swiftly
- Sophisticated software to automate sequencing

DOWNSIDES?

- Recruitment drive for Examiners = less experienced juniors
- Substantial increase in OPs...

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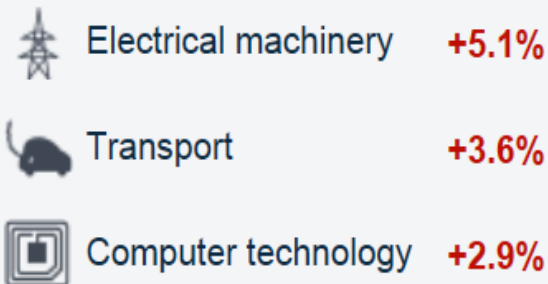


2016 - EPO STATISTICS

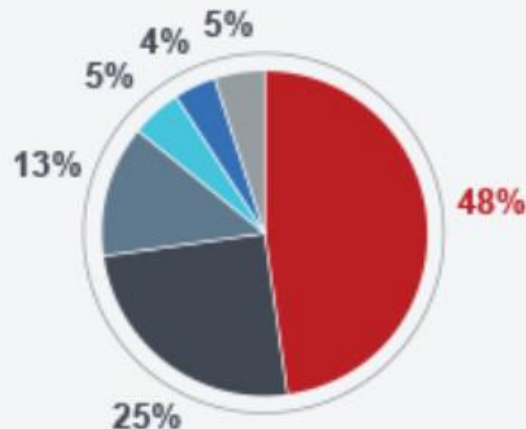
> Application level remains high



> Fastest growing technology fields



> Origin of applications



> Top applicants



Productionincreased by **8.5%**
Search, Examination, Opposition

Granted patentsincreased by **40%**

Stock of workdecreased by **25%**
Search, Examination, Opposition (2 years)



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CONCLUSIONS

- Delays can be beneficial... but usually only to patentees...
- But speed and efficiency will drive innovation and investment
- Speed \neq necessarily technically complex solutions
- Slowing down generally not a formal option

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