

# Influencing Examination of Competitor Applications at the EPO

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# 5 growing offices in the UK and Europe



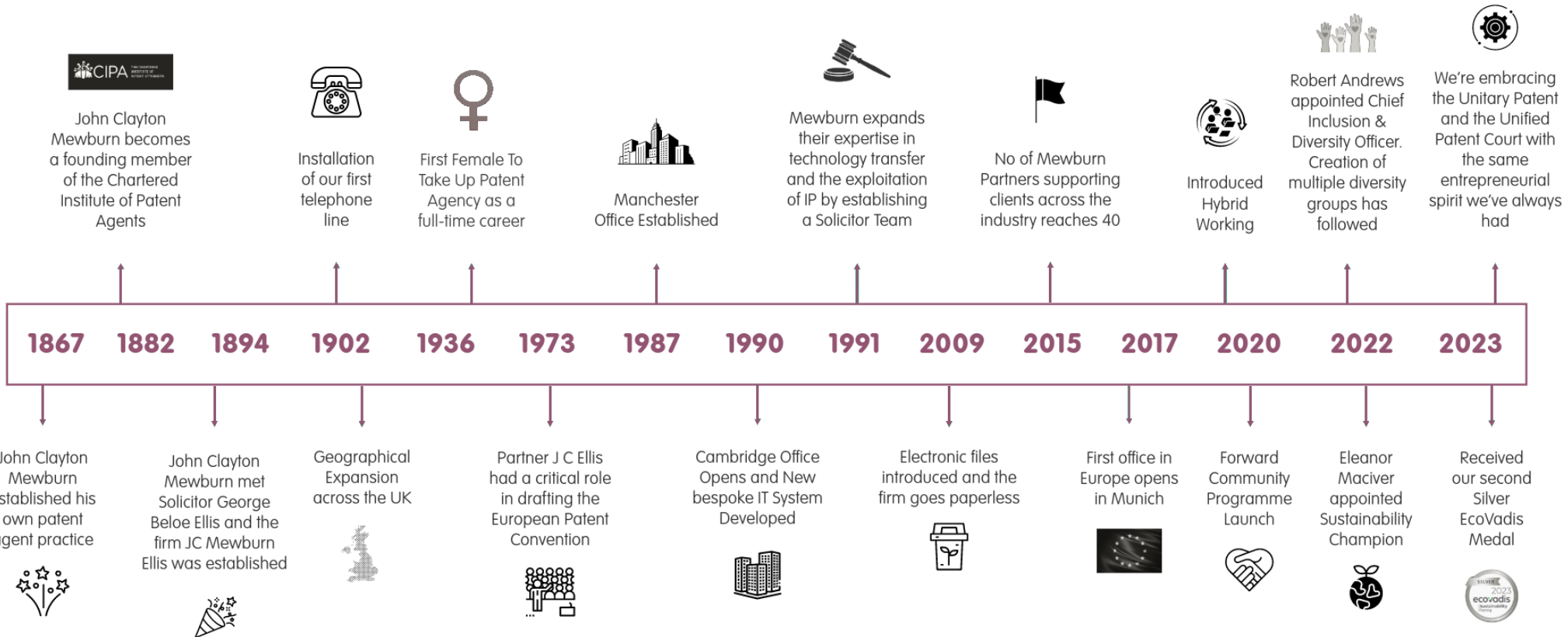
# Mewburn at a glance



# A business founded on a passion for innovation



We can trace our history back to 1867, when the talented and enthusiastic John Clayton Mewburn founded an IP office in London aged just 27 years old. He knew an opportunity when he saw one. The Industrial Revolution was still in full swing, with technological and scientific innovation at its height. There were more people looking to protect their inventions and ideas and it was easier and cheaper to do so than ever before. In the 1890's he joined forces with George Beloe Ellis – a solicitor who shared his passion for new inventions and industrial property. Together the two men set about fulfilling their desire to protect the technologies they loved.



# Law & practice guides

- Fully searchable, our [Law and Practice Library](#) consists of over 100 guides with some in Chinese, Japanese and Korean language, all available online and covering a huge range of IP topics.
- In the spirit of openness and information sharing we have decided to keep them openly available to all.
- These are so good our competitors use them as reference – we know because they’ve told us!

## ACCELERATED PROSECUTION

Our pages ‘UK Patents - The Basics’ and ‘European Patents - The Basics’ set out in detail the various procedural steps involved in obtaining UK and...

## COMPENSATION OF INVENTORS ACCORDING TO THE PRINCIPLES OF THE GERMAN COMPENSATION GUIDELINES

Type (lump sum or instalments) and amount of compensation are determined by an agreement between the employer and employee. The calculation of a...

## CONFIDENTIALITY

[Download Confidentiality Agreement Form](#)

Often you may wish to tell other people about your invention, for example if you are trying to license or...

## COPYRIGHT IN TRADE MARKS

When a trade mark contains or consists of a logo, it is likely that there is copyright in the trade mark. If so, it is important that the trade mark...

## DEFERRED PATENT EXAMINATION SYSTEM

Several Patent Offices operate a deferred patent examination system under which patent applications remain dormant until the applicant takes steps...

## DEFERRED PATENT EXAMINATION SYSTEM - GERMANY

The German Patent Office operates a deferred patent examination system under which patent applications remain dormant until the applicant takes steps...

## DESIGNATION OF THE EU VIA THE MADRID PROTOCOL

The European Union is a member of the Madrid Protocol and so the European Union can be designated in an International Registration so as to seek...

## DESIGNATION, EXTENSION AND VALIDATION STATES FOR EUROPEAN PATENT APPLICATIONS

For European patent applications filed since 2009, all available EPC member states are designated by payment of one designation fee.

The EPO has a...

## DIRECT EUROPEAN PATENT APPLICATIONS: EARLY STAGE PROCEDURE AND PAYING SEARCH FEES

[Download flow chart - EP Early Stage Procedure & Paying Search Fees - Decision chart for action after issuance of a partial search report on a direct...](#)

## DISCLOSURE OF SEARCH RESULTS

From 1st July 2004 the UK Intellectual Property Office has been requesting the results of official searches produced by other patent offices to be...

## DOMAIN NAMES


The importance of trade marks is being increasingly highlighted by the rapid growth in use of the Internet. This page explains the process and some...

## DUTY OF DISCLOSURE

Failure to disclose relevant information to the United States Patent and Trademark Office (USPTO) can result in a patent becoming invalid and...



We have a responsibility to ensure our business has a positive impact on the people, communities and environment around us so have launched the Forward Community Programme.

Diversity & Inclusion	Sustainability	Community
<ul style="list-style-type: none"> <li>• We have appointed a Chief I&amp;D Officer &amp; Collaboration Group</li> <li>• Completed an I&amp;D Audit</li> <li>• We have created a diversity dashboard which we publish externally</li> <li>• We report our Gender Pay Gap figures</li> <li>• Sponsor the CREST Awards</li> <li>• Created a Wellness Committee</li> <li>• Introduced a reciprocal mentoring scheme</li> <li>• Launched the WoME of Mewburn Ellis network</li> <li>• Launched our LGBTQ+ME network</li> <li>• Mentoring of school age children</li> <li>• Sponsoring BSA 'Smashing Stereotypes' campaign</li> <li>• We support I&amp;D charities</li> </ul> <p><a href="#">Read More</a></p>	 <ul style="list-style-type: none"> <li>• We are working to reduce and offset our carbon use as part of our commitment to be carbon neutral by 2025</li> <li>• We have developed a <a href="#">five-step climate action plan</a> that we're using as a framework to help us improve in this key area</li> <li>• We're working with environmental organisation <a href="#">Ecologi</a> and plant a tree for every new matter we open</li> <li>• Our near and long-term science-based emissions reductions targets approved by the <a href="#">Science Based Targets initiative (SBTi)</a></li> <li>• We are the first UK IP firm to be rated Silver by <a href="#">EcoVadis</a>, the sustainability ratings agency</li> </ul> <p><a href="#">Read More</a></p>	<ul style="list-style-type: none"> <li>• We donate 1% of our profits to charity</li> <li>• We have donated over £750,000 since 2020</li> <li>• All staff have a CSR Day</li> <li>• We respond to humanitarian crises where we can, for example Ukraine, Afghanistan, Turkey</li> <li>• We support for local charities covering: cancer, end of life care for children, homelessness, mental health, poverty &amp; equality</li> <li>• We support the Sustainable Development Goals. Our community work delivers against ten of the seventeen goals.</li> </ul> <p><a href="#">Read More</a></p>

## Dr Eleanor Maciver

- BA and MSci in Natural Sciences from Cambridge University; DPhil from Oxford University; Post Doctoral Research at Kyoto University
- Qualified 2017; partner 2022
- Lived in Japan for one year, speak some Japanese; now visit Japan for 1-2 weeks most years
- Involved with JIPA since joining the profession
- Practice: Chemistry specialising in sustainable technologies, food chemistry, polymers and small molecule pharmaceuticals
- Passionate about the role technology can play in sustainability
- Major clients: Japanese food and drinks companies, Japanese polymer companies, Sustainable technology SMEs and pharmaceutical companies from start-ups to global corporations
- Significant experience of EPO opposition and appeal work



# Influencing Examination of Competitors Applications at the EPO

## Third Party Observations





What are third party observations (TPOs)



Why File TPOs?



TPOs vs EPO Opposition



Tips for Strategy

# What Are Third Party Observations

# What are Third Party Observations

- Third party Observations are a mechanism providing an EPO Examiner with objections and prior art evidence
  - Similar to the JPO
- They can be filed during prosecution (pre-grant) *and* after grant

## Pre-grant procedure:

- After publication
- Before grant
- Including after allowance

## Post-grant procedure:

Can be submitted during:

- Opposition and
- Appeal



# Legal context

- Art 115 EPC:

*In proceedings before the European Patent Office, following the publication of the European patent application, any third party may, in accordance with the Implementing Regulations, present observations concerning the patentability of the invention to which the application or patent relates. That person shall not be a party to the proceedings.*

- Rule 114 EPC:

*(1) Any observations by a third party shall be filed in writing in an official language of the European Patent Office and state the grounds on which they are based. Rule 3, paragraph 3, shall apply.*

*(2) Any such observations shall be communicated to the applicant for or proprietor of the patent, who may comment on them.*

- GL-E-VI-3

# Who can and How to file?

- Anyone who is not directly involved in the proceedings
- Can be filed anonymously or in company name
- No requirement to be submitted by representative
- Many routes for filing
  - EPO has dedicated web form for submission
  - Submission by representative via EPO online filing portal
  - By hand

# What can be included?



TPOs typically include arguments and evidence



A good way to alert the Examiner to prior art they might have missed



Documents must be in (translated into) an official language of the EPO



Some types of evidence are not possible if filing anonymously (e.g. prior use)



# What can be included?

**All grounds relating to patentability can be raised:**

**Novelty**

**Inventive  
step**

**Clarity**

**Added  
Matter**

**Lack of  
unity**

**Sufficiency**

**Important note: includes factors that are not available as grounds of opposition**

# How does the EPO handle TPOs?

- The EPO will forward any TPOs filed to applicant/proprietor
- The EPO Examiner must consider the observations and comment on them
- TPOs will result in **acceleration** if *not* filed anonymously
  - EPO target OA within 3 months of TPO submission

# Why File TPOs?



# When to consider TPOs?

## When to consider TPOs?

When you come across a patent application that will pose a problem for your client's business in Europe if granted.

### First Step

Assess likelihood of *granted* claims that are a problem.

[Your EPA colleagues can help with this analysis e.g. what claims are likely to be patentable in Europe.]

### Second Step

Consider if you should file third party observations or wait to see whether the patent gets granted and then file an opposition?

# Some Further Considerations



Is the desired outcome achievable in examination as a non-party member?

E.g. is there a 'fall back' position in the application that would mean the claims are not a problem and can we push the examination towards this fall back?



Do we have a strong case that the claims should be limited in a meaningful way?

E.g. have we got new prior art to cite that clearly changes the situation

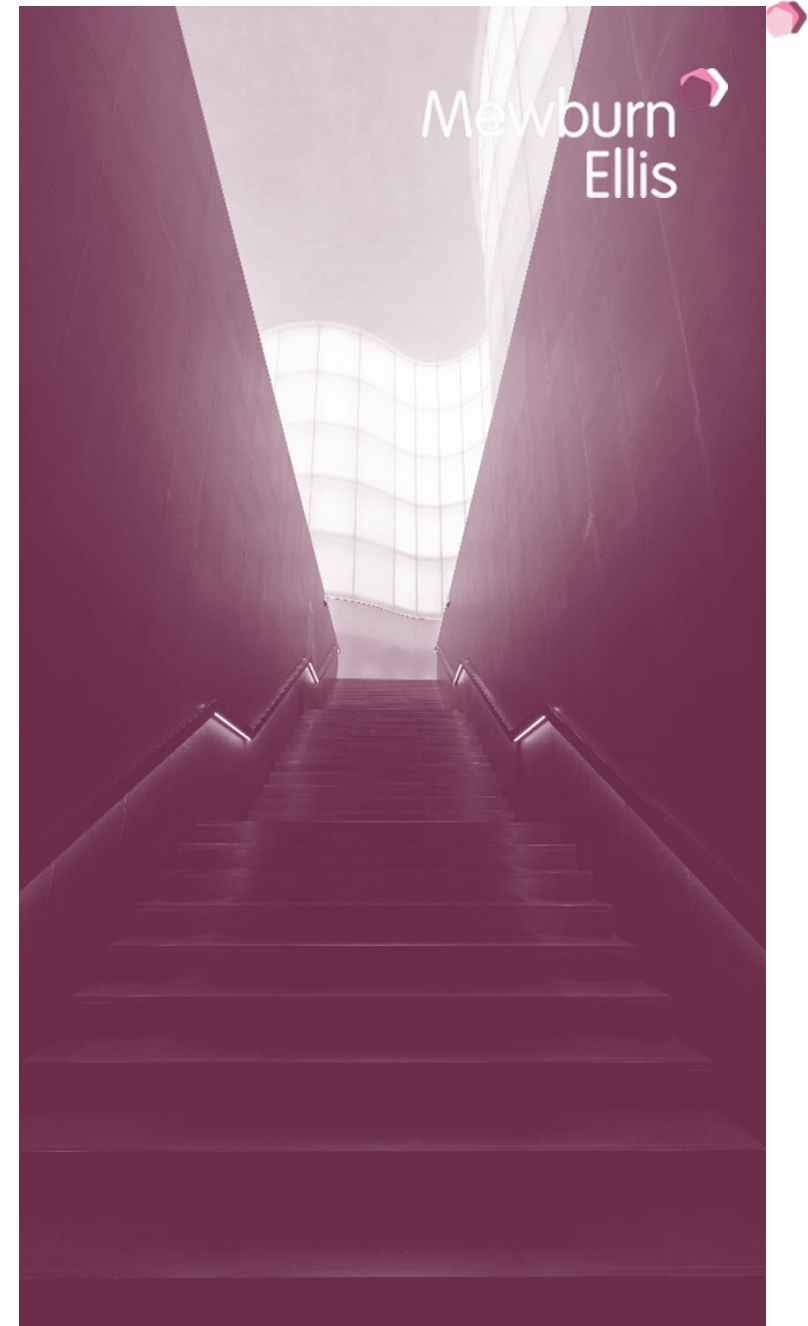


Has the Examiner misunderstood the technology, or the prior art already cited?

# TPOs vs EPO Opposition

# EPO Oppositions

- 9 months from grant
- Grounds of opposition do not include Clarity
- Timeline
  - <18 months for first instance decision*
  - 2-3+ years for an appeal*
- Robust, interactive proceedings
- Significantly more expensive than TPOs



# TPO v Opposition

**TPO** = Observer status only – options to “persuade” are limited

**TPO** = any ground

**TPO** = puts applicant on notice; possible divisional(s)

**Opposition** = party to the proceedings – fully involved, multiple opportunities to argue, EPO must engage fully

**Opposition** = clarity excluded

**Opposition** = “surprise”; cannot shift claim scope (only narrow))

## Tips for Strategy



## Pros

- Very cost-effective way to raise objections and alert the Examiner to additional prior art
- Opportunity to raise objections (clarity, lack of unity) that cannot be raised in opposition

## Cons

- Relies on EPO engagement - by definition TPOs are submitted after Examiner has completed initial review
- Allows competitor to opportunity to overcome objections in prosecution
- Some objections might be better saved for opposition (e.g. added matter)

## How to maximise success?

**Simplicity** – make it easy for the EPO examiner

## Novelty and inventive step

- Typically the main arguments in terms of effecting the scope of the claims
- New, strong prior art is strongly recommended
- Often Japanese language documents are not easily found by Examiner's at the EPO and so this can be a good source of new documents for TPOs

## Clarity and Added Matter

- These can be very effective – EPO Examiner's often adopt arguments on these grounds
- Care needed to consider what overall effect these objections will have on the case
- For example, added matter objections raised during examination can be more easily addressed than after grant

# Anonymous Or Not?

## Anonymous vs Not-Anonymous



Do you want examination to speed up or not?

Do you need to keep your identity secret?

No speeding-up wanted or  
need to keep identity secret -  
**anonymous**

Speeding up wanted –  
**non anonymous**

Thank you for listening

If you have any questions  
please contact me.

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