



Correcting Minor Errors in the EPO Notice of Allowance/communication under Rule 71(3) - Change in Procedure

It is now necessary to balance the desire to correct minor errors in a communication under rule 71(3) against the delay correcting them will cause and the remote chance that it could reopen the prosecution procedure.

Background

The final stage of prosecution of a patent application at the EPO is that the EPO present back to the applicant the text in the form that they intend to grant the patent. It is a last chance to check that an unfortunate error has not crept into claim 1 – or anywhere – in the application. The applicant can either approve the text for grant or disapprove it and replace it with an amended text.

The Old Position

If there was a typing error, or one of the reference numbers in the claims was not quite the best one to use, we could disapprove the text, replace it with a corrected text, and waive the right to a new communication under rule 71(3) and invite the EPO to proceed straight to grant, subject to accepting the correction and not making any more changes. This could save a delay associated with issuing a new communication under rule 71(3), and the need to report and recheck the new communication.

The New Rules

Now the option to waive a second communication under rule 71(3) has been removed – there has to be a second 71(3) communication.

So applicants have a choice between noticing a trivial error that does not affect the scope of the patent and just letting it go, and proceeding to grant, or correcting it and adding to the cost and introducing a delay.

Docketing a second rule 71(3) communication, reviewing it to see what else might have changed and whether the EPO has introduced any errors, and reporting it, are all extra work on a new office action. It will also delay grant by a couple of months at least (more if you want it to – see later). Also, it is not completely unknown for the EPO to reopen examination in the second rule 71(3) communication. It is rare, but not unknown. So fixing an error can risk a new examiner

taking a different view (or the same one taking another look).

Delay can be Good

The other side of the coin is that sometimes delay can be good. Delaying the decision on the countries in which to validate, and delaying the associated cost for another 4 – 6 months (or longer if you want to delay as a tactic) can be very useful to a client in some situations. The validation step is post grant, and can be one of the more expensive steps, depending on the number of countries chosen. Therefore, delaying grant delays the validation costs and decisions.

Conclusion

You should still check the text offered for grant in a rule 71(3) communication carefully. It is a last safety check. But there might be times when you decide a minor imperfection is worth accepting compared to the consequences of changing anything at that stage.

If you would like further advice on this subject, or on any EPO tactics, please do feel free to contact your normal Barker Brettell Attorney.