

## CHAPTER 7

### PRELIMINARY EXAMINATION AND REPORTS

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## **Introduction**

- 7.01 The preliminary examination of a patent application is performed when the Application Fee has been paid. The fee may be paid with F1 when the application is filed or later with F9A or it may be paid separately. A non-statutory form AF1 exists for use in paying the fee but its use is not mandatory. The fee must be paid within 12 months of an application's earliest date or within 2 months of its filing date whichever expires later.
- Payment of the application fee will trigger a preliminary (non-technical) examination under s.15A and carried out by a Formalities Examiner. Following preliminary examination, the Formalities Examiner should check if a search has been requested and paid for on F9A (s.17(1)(c)). If it has, and there is a description and at least one claim in English, the application should be forwarded to the technical examiner.
- 7.02 All procedural and non-technical requirements of an application must be checked by the Formalities Examiner. A quality check of the images on PECS should also be carried out and a re-scan requested for any which are illegible or unclear. The detail relating to the individual aspects of the examination are outlined in Chapters 2-6. These chapters outline the requirements and detail the procedure for examination of F1, F7, the description, claims, abstract, the drawings and the claim to priority.
- 7.03 If the application is found to be deficient in any way in respect of these requirements a report is prepared by the Formalities Examiner identifying the outstanding matters. This report is then sent to the applicant, or to his agent, if appropriate.
- 7.04 The following paragraphs identify how the Formalities Examiner prepares the preliminary examination report and the other procedures required at the examination stage.

## **Case identification**

- 7.05 Before examination the Formalities Examiner must identify the type of case being dealt with. The following must be identified:-
- a. Is the application from a private applicant?
  - b. Is the application a Combined Search & Examination Case?
  - c. Is the application the national phase of an application filed under the PCT?

- d. Is the application a divisional application divided out of a previous GB application?
- 7.06 Different procedures need to be followed depending on the type of the case. Applications of type a) and b) above need to be examined in respect to Chapters 2-6 already mentioned. Applications of type c) should be examined in respect of Chapter 13 - PCT Applications. Applications of type d) should be examined in respect of Chapter 14 - Divisional applications.
- 7.07 If the application is of type a) or b) the Formalities Examiner will make an examination of the application under s.15A. The examination should ensure that any deficiencies in the application are identified to the applicant before the application is published.
- 7.08 The results of the examination are recorded on the Formalities checklist. If necessary a Preliminary Examination Report is then produced using FL1 or LFEPA and a report. These are produced using PROSE.
- 7.09 The Formalities Examiner at this stage will need to identify if the application is for combined search and examination (CS&E). A CSE label should be on the dossier cover. All cases that have a F9A and F10 filed with the initial application will be treated as requesting combined search and examination unless there is a specific request in the application that it should not take place. See paragraphs 7.49 to 7.72 for processing CS&E cases.
- 7.10 The Formalities Examiner will also need to identify if the application comes from a private applicant. A Private Applicant label should be on the dossier cover. Any application that has no patent agent named in Section 5 of the F1 should be treated as a private applicant case. See s.274 of the Copyright Designs and Patents Act 1988 for information about a person permitted to carry on the business of a patent agent/attorney.
- 7.11 For all applications the trigger for Preliminary Examination is payment of the Application Fee. In most cases this fee will be paid when the F1 or F9A are filed and the Preliminary Examination in these cases will either follow the filing of the application or will immediately precede the application being sent for search. The Application Fee can also be paid independently of these forms and may be paid using non-statutory form AF1. It is not the filing of these forms however that is important it is the payment of the fee itself. The fee may therefore be filed without an associated form and in these cases an AF1 will be made up by Finance for somewhere to record the payment. It is assumed for the rest of this chapter that the Application Fee has been paid by one of these methods.

## Preparation of the Preliminary Examination report

- 7.12 Once the outstanding requirements have been identified the Formalities Examiner should then prepare a preliminary examination report. **If no deficiencies are found in the application, no report needs to be issued except for Private Applicant cases when a ‘No Objection’ letter is issued.** If the application is found deficient in some way, a FL1 or LFEPA letter and report will need to be prepared using PROSE.
- 7.13 The PROSE system is available for registered users. It is a WORD based letter system which is linked to Optics. The latest information about the case held on the Optics database will be downloaded into the letter produced by the user.
- 7.14 The user should add the case to their work-list and select ‘Documents’ and then ‘New’. From the menu select the Preliminary Examination Report category if it not already selected by default. This gives three options, "FL1 for agents" or "LFEPA for private applicants" or “No Objections”. The option selected will depend on the type of case the user is dealing with (see 7.06 above). For cases where the address for service is identified as an agent the "FL1 for Agents" should be selected: where there is no agent appointed the "LFEPA for Private Applicants" should be selected. The production of the letter will then vary depending upon this selection.

### FL1 for Agents

- 7.15 On selecting FL1 from the selection screen the PROSE Document Wizard will display the Agent’s name and address details and the name of the applicant taken directly from Optics. This should be checked with the F1.
- 7.16 Once the name and address details are completed to the user’s satisfaction, the user should click ‘Next’. The agent’s reference and salutation will then be displayed. The user should click ‘Next’ to display the list of outstanding documents and select the relevant items. When all items have been selected the user should click ‘Next’ and then ‘Finish’ to complete the process.
- 7.17 WORD will then produce the required letter which can be edited if necessary.
- 7.18 The preliminary examination report will then need to be produced using the ‘Insert Clauses’ button. This is described in 7.23-7.29 below.

## **LFEPA For Private Applicants**

- 7.19 On selecting the "LFEPA for Private Applicants" letter from the selection screen and after confirming the applicant and address details, the user is asked if a previous letter has issued and if objections to Claims or Abstract are being made. The user must click on YES or NO to go on. This selection will determine the content of the letter when produced i.e. providing further information about the claims etc.
- 7.20 The user should click 'Next' to display the list of outstanding documents and select the relevant items. When all items have been selected the user should click 'Next' and then 'Finish' to complete the process.
- 7.21 WORD will then produce the required letter which can be edited if necessary.
- 7.22 The preliminary examination report will then need to be produced using the 'Insert Clauses' button. This is described in 7.23-7.29 below.

## **The Preliminary Examination Report**

- 7.23 Regardless of which covering letter has been produced (FL1 or LFEPA), the next stage is to produce the report part of the preliminary examination process. With the covering letter (FL1 or LFEPA) on the screen, click the 'Insert Clauses' button at the right hand side of the screen. This will then produce the "Insert Standard Clauses" screen. This screen itemizes all the objections it is possible to include at this stage. If a plus sign appears at the left of the item it indicates that there are further menus within that category of objection.
- 7.24 Select all the objections which apply by clicking the box at the left. Click again to deselect if you make a mistake.
- 7.25 Once all the objections have been made, the user should click OK and WORD will then compile the report.
- 7.26 The user should then check the report on screen to ensure it is correct. Any minor errors can now be corrected manually as the document on screen is the same as any other WORD document. For major alterations it may be better to go through the procedure again. Care should be taken to ensure that all dates have been correctly calculated and have not expired.
- 7.27 If the report is satisfactory, it should be saved and printed using the PRINT button on the button bar or by using the FILE menu. The

document status should be changed to LOCKED and a file copy should be imported using the 'Send to Dossier' wizard.

- 7.28 A copy of the report is then issued to the applicant.
- 7.29 Once all actions have been completed the case should then be removed from the user's PROSE work-list.

## **Other Reports**

- 7.30 It may become necessary for an objection to be made to any of the matters covered in Chapters 2-6 after the initial preliminary examination is made. If this is the case and there is still time left for the requirement to be met, a further Preliminary Examination Report can be issued. The Formalities Examiner should consult their Formalities Manager on the procedure if the time period has expired. Judgement should be used where there is less than 1 month of a time period left as other types of report may need to be issued. The time periods for reply are described in Chapters 2-6.
- 7.31 An objection to one of the requirements set out in Chapters 2-6 may be made by telephone. In these circumstances a telephone report should be prepared using the PROSE system. By selecting the category "Other Reports" on the left of the letter selection screen the "Telephone Conversation Report" can then be selected from the right of the screen. On selecting this letter you can input the name of the caller or person called, whether a copy has been sent to them and a response date if applicable.
- 7.32 The text of the report should be included below the details of who held the conversation and above the warning about accuracy. The warning about accuracy of the report is displayed near the bottom of the report and this should remain in the report.
- 7.33 The telephone report should reflect what was actually said. The nature of the objection(s) should be outlined and the response period(s) stated. In addition to the response period, warnings should be included that the application may be refused if there is no response. A suitable form of wording follows:
- You must either meet the requirements set out in this report or make observations on them by the date(s) given. If you do not the application may be refused.*
- 7.34 Objections can also be made by Official Letter. Again they must state response period(s) and include a warning as in 7.33. A "Free Text" letter is available in the "Other Reports" category of the PROSE System. The

content and issue of a complex free text letter should be approved by the Formalities Manager.

## **Completion of the Formalities Checklist**

- 7.35 The formalities checklist is a quick reference aid which can help the Formalities Examiner to keep track of objections made to an application. Once completed it is also reference tool to identify the progress of an application.
- 7.36 There are three types of formalities checklist, Pre-publication, Post-publication and S89. Guidance on completion of the S89 checklist can be found in Chapter 13.
- 7.37 This checklist is completed for every application that has a preliminary examination performed by Formalities. The checklist is filled in from the top, confirming whether all the drawings referred to in the application have been filed. (For details see Chapter 5.) Once the Formalities Examiner is happy in this respect, the rest of the checklist can be completed.
- 7.38 If the requirements of any of the categories are met the box should be ticked. If an objection is to be made the box remains unchecked. Any categories which are not relevant should be ticked and annotated "N/A." If a F10 has been filed and there is an objection to the F10, the Formalities Manager should assess whether combined search and examination is now appropriate. If there are any objections to the application, a Preliminary Examination Report will need to be issued as per 7.12 et seq. above.
- 7.39 If there are no objections to the application, the "Formalities Complied EP" box should be ticked.
- 7.40 A message should then be sent to the ESO to be booked onto PAFS as a search or CSE before a message is sent to the Patent Examiner.

## **OPTICS ACTION**

- 7.41 **ADD F1** updates OPTICS to the status "Ready for Search". The user is asked to input the following:
- a) the filing date of the F9A;
  - b) whether each applicant is an inventor (check section 7 of F1);

- c) if the address for service (AFS) is that of the applicant (if not the user will be prompted to enter the ADP number for the AFS unless the applicant is the inventor.)
- 7.42 **REC F7** adds the inventor(s) details to OPTICS. The user is asked to input the filing date of the F7, and the inventor(s) ADP number(s) from F7.
- 7.43 If a F10 has been filed, **REC PRE** should be used to record the form number and the date the form was received.

## **Requests for Accelerated Processing**

7.44 When inspecting an application the Formalities Examiner must look out for any requests to accelerate or expedite the processing of the application. These can be found on any document which forms part of the application and the Formalities Examiner should be vigilant in order to identify them. Accelerated examination requests have a 2 month turnaround target. PCT cases may also contain requests for accelerated examination under the PCT Fast Track arrangements – see PFM 13.52a-d.

7.45 The applicant/agent can request that all aspects of processing an application be expedited or just specific stages. The applicant may request accelerated ‘prosecution’, in which case all aspects are to be expedited or just accelerated search, publication (see 8.29), examination or grant, or any combination of these. It can be assumed if accelerated grant is requested this should mean all stages of patent processing are to be expedited. However, if there is any doubt as to what is being requested the Formalities Examiner should seek clarification from the applicant/agent.

**Particular care should be taken never to accelerate publication unless it is certain that this is what the applicant wishes as unintended early publication has serious implications. If there is any doubt at all the position should be clarified with the agent/applicant and the dossier noted.**

7.46 A request for accelerated processing (except for accelerated publication) should be accompanied by adequate reasons and requests giving no reasons or inadequate reasons should be refused.

### 7.46a **Green Channel**

Applicants are also able to request accelerated processing via the ‘Green Channel’ if their invention relates to a ‘green’ ie environmentally friendly technology; in these cases no further reasons are required. The request should clearly state which parts of the process the applicant wishes to

accelerate. If it does not the Formalities Examiner should check with the applicant or agent before proceeding.

7.47 Once the Formalities Examiner has identified what the request for accelerated processing entails, they should follow the procedure outlined below.

The dossier should be annotated in the following manner.

- a) A minute should be created to the examiner identifying what stages the applicant requires to be expedited;
- b) the relevant accelerated label should be added to the dossier cover showing what stages are to be expedited.
- c) Green Channel cases should have the 'Green Channel' label applied in addition to the appropriate accelerated label(s).
- d) The Green Channel request must also be recorded on Optics using the function **REC GRE**. This records the number of requests we receive so that statistics can be published. The date of the request should be entered and the 'Accepted Indicator' will default to 'Y'. If the examiner accepts the request no further Optics action is needed. If the request is refused the examiner will send the message 'REFUSED GREEN CHANNEL' and the refusal should be recorded in REC GRE by setting the 'Accepted Indicator' to 'N' and entering the date of the refusal.

7.48. Once this and the other aspects of preliminary examination have been completed the case should be sent to the Patent Examiner through the ESO. Accelerated labels should still remain on the dossier cover when the accelerated action has been completed. However, if accelerated treatment is refused then the accelerated labels should be removed. Green Channel and PCT Fast Track labels should **always** remain in place to record that a request was made.

See also [www.ipo.gov.uk/p-fastgrantguide.pdf](http://www.ipo.gov.uk/p-fastgrantguide.pdf)

## Combined Search and Examination

7.49 When a F9A and F10 are filed on the same day or when the F10 is filed shortly after the F9A but before the search commences, the application will be subject to "Combined Search and Examination" (CS&E), i.e. it will be searched and examined at the same time and before it is published.

- 7.50 The applicant does not have to request CS&E as it is carried out automatically unless the applicant specifically states that he does not want CS&E. The Formalities Examiner should check the Form 10 and accompanying documents for any indication that CS&E is not required.
- 7.51 CS&E also applies to divisionals but not to s.89 PCT applications where a copy of the International Search Report is on file with the WIPO publication.

### **Formalities Procedures for CS&E**

- 7.52 The Formalities Examiner should check that both F9A and F10 (and fees) are on file and that the applicant has not specifically given an instruction that CS&E is not required. If the forms have been logged on with the same filing date, the OPTICS flag for CS&E will have been set automatically to 'YES'.
- 7.53 If the applicant has stated either on the F10 or in a separate letter that CS&E is not wanted, the Formalities Examiner should set the CS&E flag to 'NO' and explain the situation to the Patent Examiner. In the event of a F10 being filed after the F9A with a written request for CS&E, the Formalities Examiner should check whether the search report has issued.

If it has already issued, the applicant should be informed that the request was received too late to allow CS&E and that substantive examination will occur in due course after publication. If, on the other hand, the search report has not issued, the Formalities Examiner should arrange without delay for the F10 to be actioned, inform the examiner and add the CS&E label to the cover so that the Patent Examiner is alerted as soon as possible to the need for CS&E. The CS&E OPTICS flag should then be set to 'YES'.

- 7.54 Where CS&E is applicable, the Formalities Examiner should carry out the usual formalities examination: completing the Formalities Pre-publication checklist and issuing reports as appropriate. In addition, they should add the CS&E label to the dossier cover and prepare a minute to the Patent Examiner to advise that CS&E is applicable, e.g.

“Examiner

Combined Search and Examination is required”

- 7.55 In those cases where a claim to priority has been made but the priority document(s) are not yet on file, the minute should also include a note to that effect, e.g.

“Examiner

Combined Search and Examination is required. Please note that a claim to priority has been made, priority document(s) not yet filed”

The file should then be forwarded in the usual manner.

- 7.56 Where CS&E is not applicable, that is, where F9A and F10 are present but the applicant has specifically instructed that CS&E is not carried out, the Formalities Examiner should carry out the usual formalities examination. In addition, a minute to the Patent Examiner advising that CS&E is not applicable, e.g.

“Examiner

Combined Search and Examination is not required”

The file should then be forwarded in the usual manner.

Search and Examination

- 7.57 Where CS&E is applicable, the Patent Examiner will carry out the search and examination at the same time. However, the resulting reports will differ from those of a non CS&E case.
- 7.58 Where CS&E has been carried out and the examination has revealed objections, the search and examination reports will issue together under cover of the existing SL1/EL14 but with the incorporation of letter clause RC43. This letter will have a reply period of two years calculated from the earliest date.
- 7.59 Where CS&E has been carried out and the examination has not revealed any objections, an examination report will not issue. Instead only a search report is issued under cover of the letter SL1CE. In addition, the patent examiner will set a diary date to have the file returned to him three months after 'A' publication.
- 7.60 However, as the patent examiner will not be able to determine when the case will enter the publication cycle and therefore the date of 'A' publication, the diary date (if provided) will be an estimate. Where the date given is not suitable or a date is simply not provided, the Formalities

Examiner should diary the case for a three month period calculated from the intended publication date given on the screen during REC FOR action.

- 7.61 In the rare case where no search is possible, the patent examiner will issue letter SL2CSE. In this case no further CS&E action is taken until amended claims are submitted.

#### Amendments - Partial Response

- 7.62 Any amendment to the claims (including new claims) should be published in the 'A' Document in the normal manner, providing the case is not already in Publication Section for 'A' publication. If it is then the amended pages can still be actioned but Optics should not be changed.
- 7.63 The applicants will have been advised in letter clause RC43 to clearly indicate whether or not the new or amended claims are intended to form part of a full response to the examination report.

#### Amendment - Full Response

- 7.64 Where amendments intended to be a full response to the examination report are filed and the case is in the publication cycle, the Formalities Examiner should confirm with the Divisional Publication Liaison Officer (PLO), or their deputy as to whether the claims if the 'A' letter has not been issued can form part of the published document.
- 7.65 The PLO will instruct formalities as to whether the amended claims are included for publication. The Post-Publication checklist should be updated and the pages incorporated (Optics not updated) and a message sent to the examiner.
- 7.66 In addition, they will issue letter CS1 in all cases unless 'A' Publication would have occurred by the time the CS1 would be ready for issue.

#### Action when a case which is with the patent examiner is required for 'A' Publication

- 7.67 If the Patent Examiner is re-examining the application when it is selected on the EP Picklist, the Formalities Examiner should tell the Patent Examiner that the case will enter the publication cycle.
- 7.68 The Patent Examiner must complete the re- examination or inform formalities that he will complete his re-examination after publication.

7.69 If the Patent Examiner chooses not to complete the re-examination an EL31 should issue.

Extension of reply period/third party observations

7.70 Any requests for extension of the reply period set in a CS&E report should be dealt with in the usual way. Any third party observations submitted on a CS&E case should be referred to the Patent Examiner in the usual way.

Refunds

7.71 Normally, no refund of the search and substantive examination fees should be made if CS&E reports have issued. Any request for refund on a CS&E case booked out to the Patent Examiner should be immediately brought to his attention.

Acceleration

7.72 Requests for accelerated search, publication and grant may be made on CS&E cases. Any such requests should be referred to the Patent Examiner for consideration. If allowed, the Formalities Examiner should carry out the appropriate actions as for non CS&E cases.