



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Resolution of the Executive Committee Cannes, France, 25 to 29 September 2022

“Complete Examination”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee at the World Congress held in Cannes, France, 25 to 29 September 2022, passed the following resolution:

NOTING that many technologies being examined for patent protection, including both emerging and traditional, face subject matter eligibility¹, internal issue² and prior art rejections,

FURTHER NOTING that in some jurisdictions, examination reports are being issued that are incomplete, by raising a first set of substantive issues that must be dealt with before moving on to a second set of substantive issues,

RECOGNISING that such incomplete examination can be particularly troublesome when one of these sets of substantive issues involves subject matter eligibility, for example the applicant may overcome the cited prior art only to then face a challenging subject matter eligibility rejection (or vice versa) that requires further consideration of claim amendments,

FURTHER RECOGNISING that dealing with substantive issues one at a time due to an incomplete examination of a patent application can lead to prolonged prosecution, unnecessary claim limitations, and increased costs to the applicant,

URGES Patent Offices to avoid incomplete examination of applications and conduct a complete and comprehensive examination of all substantive issues, including subject matter

¹ Also referred to as “technical effect” and “inventive contribution”

² Such as clarity, sufficiency and enablement



eligibility, internal issue and prior art rejections in a single substantive examination report, and

FURTHER URGES that should a Patent Office wish to allow applicants to defer consideration of a substantive issue of patentability, such deferment is voluntary and an invitation to do so is only made after the Patent Office has conducted a complete and comprehensive examination and identified all substantive issues in a single substantive examination report.