

Rule Changes at the European Patent Office

The Administrative Council of the EPO has decided to change some of the Implementing Regulations of the European Patent Convention. The Decision (CA/D 3/09) can be viewed at:

<http://www.epo.org/patents/law/legal-texts/decisions/archive/20090325a.html>

The changes seem to have been made to streamline the grant process and thus some actions which were previously optional are now mandatory. The consequences are that patent applicants will need to make important decisions about their patent applications much earlier in the prosecution process. The new Rules will come into force on **1st April 2010**.

Amended Rule 161 – amendment of the application in response to ISR or IPER

This change affects PCT applicants entering the European regional phase.

Currently, a response to the Written Opinion of the International Search Report (ISR) or International Preliminary Examination Report (IPER) is not obligatory. If the EPO acts as the International Searching Authority (ISA) or the International Preliminary Examining Authority (IPEA), the first communication issued by the Examining Division of the EPO upon entry into European regional phase will generally be a reiteration of the written opinion of the ISR or IPER.

Change: new Rule 161 means that if the EPO was the ISA, or the IPEA if a Demand was filed under Article 31 PCT, a response to the written opinion must be filed within one month of the date of the communication under Rule 161. This communication is issued shortly after the publication of the ISR or shortly after entry of the application into the European regional phase, whichever is later.

Consequently, we recommend that a response to the written opinion or IPER should be considered prior to entering the European regional phase, due to the very short time period available once the communication under Rule 161 has issued.

If the EPO was not the ISA or IPEA, and the ISR was not drawn up by the Patent Office of any of Austria, Spain, Sweden, Finland or Norway, the EPO will issue a supplementary European search report, as happens currently. Prior to issuing the Supplementary search report a time limit of one month will be set to amend the application. The amended application will form the basis of the supplementary search.

The amended Rule 161 will apply to any application where the communication under Rule 161 is issued on or after 1st April 2010.

New Rule 70a – Mandatory response to Extended European Search Report

Currently, it is optional to file a response to the Extended European Search Report (EESR). If no response is filed, the opinion accompanying the EESR is re-issued as the first Examination Report.

Change: new Rule 70a means that a response to the EESR opinion will be necessary in order to prevent an application becoming deemed withdrawn.

Consequently, the EESR should be treated as the first examination report insofar as all objections of the Searching Examiner must be addressed. The time period to respond to the EESR for an ex-PCT application is the same as that given for responding to the communication inviting the applicant to confirm that it wishes to proceed with the application, which is usually 2 months from the date of that communication. This communication usually issues shortly after the issuance of the EESR. For a direct convention European application, the period for response is within 6 months of publication of the EESR. The application will be deemed to be withdrawn if no response filed.

New Rule 70a will apply to any application for which the EESR is drawn up on or after 1st April 2010.

New Rule 62a – Plurality of independent claims in the same category

Currently, if the EPO considers that there is a plurality of independent claims in any one category, all such claims will be searched, and the Applicant will be requested to restrict the claims to one independent claim per category during Examination.

Change: under new Rule 62a, if the EPO considers there to be a plurality of independent claims in any one category, it will ask the Applicant to indicate which of those independent claims it wishes to form the basis of the search. A two month time limit will be given for the applicant to respond.

If the applicant fails to respond, the search will be carried out on the basis of the first independent claim in each category. Once the application proceeds to examination, the Examining Division will issue a communication requesting that the applicant restrict the claim to those searched, unless the Examining Division considers that the initial objection was unjustified

Consequently, due to the introduction of new Rule 62a, not all independent claims will be searched, meaning that the subject matter of these claims cannot be re-introduced into the claim set during examination, since unsearched subject matter cannot be examined. It therefore seems, at present, that the only way to pursue such unsearched subject matter will be by way of filing a divisional application.

New Rule 62a will apply to any application for which the European Search Report is drawn up on or after 1st April 2010.

Amended Rule 63 – incomplete search

Currently, if the EPO considers it impossible to carry out a meaningful search on some or all of the claims of an application (due to unpatentable subject matter, unclear claims, or a large number of embodiments), it will draw up a search report as far as it can or it will issue a reasoned statement as to why a meaningful search cannot be carried out.

Change: the amendment to Rule 63 means that if the EPO considers a meaningful search to be impossible, it will ask the applicant to provide a statement of the subject matter to be searched. If not provided, or if the statement is considered to be insufficient, the EPO will conduct a search to the extent that it can, or will issue a reasoned statement as to why no meaningful search can be carried out. Once the application has proceeded to examination, the Examining Division will request that the claims are restricted to searched subject

matter.

Consequently, due to the amendment to Rule 63, the applicant will now have a chance to respond to an objection of the EPO that no meaningful search can be carried out. This should result in the searching of claims that may currently be unsearched by the EPO.

Amended Rule 63 will apply to any application for which the European Search Report is drawn up on or after 1st April 2010.

Amended Rule 137 - amendments to the application

Currently, the applicant may amend the description, claims and drawings of his own volition in response to the European Search Report and again after receipt of the first examination report. Any further amendments are only admissible at the discretion of the Examining Division.

Change: the applicant may amend the description, claims and drawings of his own volition only in response to the European Search Report. Any further amendments (for example, in response to any communication for the Examining Division) will only be admissible at the discretion of the Examining Division. Furthermore, any amendments made to the description, claims and drawings must be identified and basis in the application as filed must be provided.

Consequently, the applicant has only one chance, as of right, to make amendments to the application. All basis for amendments must be given. If basis is not provided or if the requirement is not met, the EPO will request that the Applicant corrects this deficiency within one month.

Amended Rule 137 will apply to any application for which the European Search Report is drawn up on or after 1st April 2010.

Amended Rule 64 - time limit for payment of further search fees.

Currently, if a lack of unity is found in the European search on a direct European application, the EPO will invite the applicant to pay an additional search fee for each of the separate inventions. The time limit for this is set as no less than two weeks and no more than six weeks from the date of the partial search report.

Change: Rule 64 has been amended to state that any further search fees must be paid within two months.

Consequently, more time is available to decide whether to pay further search fees.

Amended Rule 64 will apply to any application for which the European Search Report is drawn up on or after 1st April 2010.

For further advice on these Rule changes and how they may affect your portfolio, please do not hesitate to contact your usual Kilburn & Strode advisor.