

Recent EPC rule changes raise the bar for Applicants

Background

On 25th March 2009, the Administrative Council of the European Patent Organisation issued Decisions **CA/D 2/09** and **CA/D 3/09** amending the Regulations of the EPC. These amendments raise several bars for Applicants and are due to come into effect on **1 April 2010**.

1. Divisional Applications

1.1 The Rules

1.1.1 Under current EPC Regulations¹, a divisional application may be filed at any time as long as the application on which it is based is pending. However, under the new regulations, the opportunities for filing a divisional application will be limited.

1.1.2 As of 1st April 2010, in addition to the requirement that the application on which the divisional is based needs to be pending, a 24 month period calculated from the first examination report of the *earliest application*, will be set for filing a voluntary divisional. The use of the term *earliest application* means that if the divisional is based on an application which is itself a divisional, then the 24-month period will be calculated from the date of the first examination report of the *earliest application* in the sequence, e.g. the grandparent application.

1.1.3 Further, and irrespective of the above, if an examiner raises a non-unity objection on the *earlier application*² for the first time, an alternative 24 month time period from the date of the examination report raising the non-unity objection will be set for filing a mandatory³ divisional.

¹ Rule 36(1) EPC

² i.e. the immediate parent application from which the divisional is filed

³ The term "mandatory" is used by the EPO to differentiate a divisional filed within the 24 month period from the non-unity objection as opposed to the "voluntary" divisional which must be filed 24 months from the first examination

1.1.4 Please note that the alternative 24 month period for filing a mandatory divisional starts from the date of the first examination report of the Examining Division in which the non-unity objection is raised, and not the date of the Extended European Search Report (EESR) even if the non-unity objection is first raised in the EESR⁴. Repetition of the same non-unity objection in a subsequent examination report will not set a new 24 month period. However, if a subsequent examination report raises a new and different non-unity objection, then a new 24 month period would be triggered.

1.1.5 If any of the 24 month periods for a pending application have expired before 1st April 2010, i.e. the date on which these rules come into effect, or are still running on 1st April 2010 but due to expire before 1st October 2010, then the EPO's transitional regulations will allow for divisional applications to be filed up to 1st October 2010.

1.1.6 Importantly, please note that further processing cannot be used if a "24 month period" has been missed. The (more onerous) remedy of Reestablishment may however still be possible.

1.1.7 Finally, the EPC Regulations have also been amended⁵ to allow that, where an earlier application was filed in a language which is not an official language of the EPO⁶, a divisional application may be filed in the same unofficial language of the earlier application⁷.

1.2 What does this mean for Applicants?

1.2.1 Applicants will need to be aware that from 1 April 2010, there will be new restrictions on

report. The use of the term "mandatory" does not mean that the Applicant has to file a divisional.

⁴ Where the applicant has waived his right to receive the communication according to Rule 70(2) EPC, no search opinion is issued. Instead, the first Communication is an examination report from the Examining Division.

⁵ Rule 36(2) EPC has been amended.

⁶ English, French and German

⁷ A translation, into whichever official language became the language of proceedings in respect of the earlier application, must then be filed within two months of the filing of the divisional application. The remedy of Further Processing is not available for filing the translation.

when a divisional can be filed during the pendency of an application. In the past, many Applicants will have filed a divisional just prior to the grant of an application or just before oral proceedings in examination. Under the new regulations however, such “last minute” filing strategies will frequently not be possible.

1.2.2 Applicants will therefore have to re-assess their divisional filing strategies in Europe, and it is suggested that Applicants explore what subject matter they wish to pursue in divisional applications as soon as possible during the prosecution of an application.

2. Multiple Independent Claims

2.1 The Rules

2.1.1 According to current Rule 43(2) EPC, an application may contain only one independent claim in any category (i.e. product, process, apparatus or use)⁸.

2.1.2 Under the new regulations⁹, compliance with Rule 43(2) EPC will be considered when a search is carried out on the application (currently, compliance with Rule 43(2) is first considered during examination of the application). If the claim set is found to contain more than one independent claim in the same category during the search, then the EPO will give the Applicants a period of two months to indicate which of the independent claims should be searched¹⁰. If the Applicant fails to indicate which of the independent claims should be searched, the search will be carried out on the basis of the first independent claim in each category, where “first” refers to the order in which the claims are listed in the claim set. In due course, the Examining Division will

⁸ An exception to this is that more than one independent claim in the same category may be allowed if the subject-matter includes: a) a plurality of interrelated products, such as a plug and socket; b) different uses of a product or apparatus; or c) alternative solutions to a particular problem, where it is inappropriate to cover the alternatives using a single claim.

⁹ Rule 62a EPC

¹⁰ Failure to meet the 2 month time limit may not be remedied by Further Processing. However, a request for re-establishment of rights may be granted, provided the relevant conditions are met.

compel the applicant to delete the unsearched claims, unless it finds that the Rule 43(2) objection was not justified¹¹.

2.1.3 This regulation change will apply to pending European patent applications for which the supplementary search report or the European search report will be drawn up on or after 1 April 2010.

2.2 What does this mean for Applicants?

2.2.1 Under the new regulations, if an application contains multiple independent claims then the Applicants will have to decide which claims they would like to proceed with prior to the EPO performing a search and examination. The implementation of this amended rule will therefore force Applicants to make decisions as to how they wish their applications to proceed at an earlier stage. It will also mean that some of the costs associated with prosecution will be brought forward.

2.2.2 Importantly, it should also be noted that as a result of other amendments to the EPC regulations¹², the filing of amended claims at a later stage in prosecution which covers unsearched subject matter will be expressly prohibited, even if the unsearched subject-matter is unified with the claims that were searched.

2.2.3 We therefore recommend that applications which are to be filed in Europe should be drafted so as to contain only one independent claim per claim category, in compliance with Rule 43(2) EPC, if a European Search Report for the application is to be drawn up after 1st April 2010. When a PCT application enters the EP regional phase, the claims should similarly be amended so as to comply with Rule 43(2) EPC.

3. Search Procedure

3.1 The Rules

¹¹ Rule 62a (2) EPC

¹² Rule 137(5) EPC

3.1.1 Currently, if the Search Division of the EPO finds that the claims in an application lack support, clarity, or conciseness to such an extent that no meaningful search can be carried out, then they will issue a decision that a search cannot be carried out.

3.1.2 Under the new regulations¹³, instead of the Search Division issuing the above decision they will instead issue a communication asking the Applicant to file a statement indicating the subject-matter to be searched, and also if necessary to file amendments, within a two month period¹⁴. If the statement does not overcome the deficiencies noted in the communication, or if a statement is not filed before expiry of the two month period, then the EPO will issue a reasoned declaration stating the impossibility of performing a search, or as far as it can it will draw up a partial search report.

3.1.3 When a partial search report has been drawn up, the Examining Division will then invite the applicant to restrict the claims to the searched subject matter, unless it finds that the original objection was not justified.

3.1.4 The new regulation applies to pending applications for which a search report or a supplementary search report is drawn up after 1st April 2010.

3.2 What does this mean for Applicants?

3.2.1 As with the change in the regulations relating to multiple independent claims, this change means that Applicants will have to decide which claims and subject matter they would like to proceed with prior to the EPO performing a search and examination. The implementation of this amended rule will therefore force Applicants to make decisions as to how they wish their applications to proceed at an earlier stage. It could also bring some of the prosecution costs forward.

3.2.2 Again and importantly, it should also be noted that as a result of other amendments to

¹³ Rule 63 EPC

¹⁴ Failure to meet the 2 month time limit may not be remedied by Further Processing

EPC regulations¹⁵, the filing of amended claims to unsearched subject matter at a later stage, even if the unsearched subject matter is unified with the claims searched, will be expressly prohibited.

4. Mandatory Response to the Extended European Search Report (EESR)

4.1 The Rules

4.1.1 Currently, there is no obligation for the Applicant to respond to any objections raised in the written opinion of the EESR. If no response to the written opinion of the EESR is filed, the Examining Division eventually issues an examination report setting a four-month term for filing a Response.

4.1.2 However, under the new regulations¹⁶, the Applicant will have to respond to objections raised in the written opinion accompanying the EESR, during the period for filing a Request for examination. i.e. within 6 months from the publication of the search report^{17 18}.

4.1.3 Failure to file a response to the EESR will result in the application being deemed withdrawn. Further processing will, however, be available if the deadline is missed.

4.1.4 The new regulations will apply to pending applications for which a European or supplementary search report is drawn up on or after 1st April 2010.

4.2 What does this mean for Applicants?

¹⁵ Rule 137(5) EPC

¹⁶ Rule 70a EPC

¹⁷ If examination was requested before issuance of the EESR, then the Rule 70(2) invitation to proceed further with the application will additionally invite the applicant to respond to the EESR. Alternatively, if the Applicant has already requested examination and waived the right to indicate whether he wishes to proceed with the application after dispatch of the EESR, no search opinion will be issued. Instead, a first examination report will be issued immediately under Article 94(3) EPC, rather than Rule 70a EPC.

¹⁸ The 6 month period is extendible only under exceptional circumstances (EPO Guidelines for examination E-VIII, 1.6)

4.2.1 Under the new regulations, initial stages of prosecution will be accelerated because Applicants will have to file a first response much earlier; this will result in bringing forward prosecution costs.

5. Mandatory Response to the PCT Written Opinion where the EPO was the ISA or IPEA

5.1 The Rules

5.1.1 Under the new regulations¹⁹, for a Euro-PCT application, if the EPO was the International Searching Authority (ISA) or International Preliminary Examination Authority (IPEA), then following entry of the application into the European regional phase the Applicant will have to respond to any objections raised in the Written Opinion of the ISA/IPEA. This will have to be done before expiry of a one month period that will be set in an EPO communication for each application under amended Rule 161 EPC.

5.1.2 Amendments/comments on the Written Opinion of the ISA which were filed on entry into the European phase are deemed to be a relevant response, so there is no need to reply to the Rule 161(1) EPC communication. The same applies to amendments filed under Article 19 PCT and are maintained on entry into the European phase. However, amendments under Article 19/34 PCT which have been taken into account by the EPO when drawing up the International Preliminary Report on Patentability (IPRP) cannot be regarded as the required response to the Rule 161 EPC communication, and Applicants must therefore respond to the IPRP.

5.1.3 Failure to file a Response within the one month period will result in the deemed withdrawal of the application. It will be possible, however, to remedy the failure to file a Response within the one month period using the EPO's Further Processing procedure.

5.1.4 This regulation change will apply to applications for which the communication under

Rule 161 EPC has not been issued by the EPO by 1st April 2010.

5.2 What does this mean for Applicants?

5.2.1 Again, the requirement to respond to objections originally raised during the international phase at the very start of the EP prosecution process will bring prosecution costs forward and force Applicants to decide how they wish to proceed with their application much earlier.

5.2.2 If the EPO is the ISA or IPEA for a PCT application, and the Applicant has decided that this application is to enter the EP regional phase, it is therefore suggested that these Applicants should consider how they wish to deal with objections raised in the Written Opinion of the Report from the ISA/IPEA as soon as possible. Ideally, Applicants will know how they want to reply to the objections by the deadline for entering the EP regional phase, in order to facilitate the meeting of the one-month deadline for filing a Response.

6. Amendments

6.1 The Rules

6.1.1 Currently, Applicants have the right to make voluntary amendments to an application after issuance of the search report and in response to the first examination report.

6.1.2 Under the new regulations²⁰, Applicants will only have the right to make voluntary amendments either:

- in response to the EESR (as discussed in paragraph 4 above); or
- in response to a communication under Article 161 EPC (as discussed in paragraph 5 above).

6.1.3 Further, the Applicant will be required to identify all amendments made to the application and to point to basis for the amendment in the application as filed. Failure to comply with this regulation will result in the issuance of a

¹⁹ Rule 161 EPC

²⁰ Rule 137 EPC

deficiency notice and the Applicant will be given one month to correct the deficiency. Further processing will be available if the one month deadline is missed.

6.1.4 The regulation change will apply to pending applications for which the European search report or supplementary search report is drawn up on or after 1st April 2010.

6.2 What does this mean for Applicants?

6.2.1 It is already well known that the EPO is very strict in preventing the addition of matter to an application. Whilst the EPO currently encourages Applicants to identify amendments and associated basis in the application as filed, by making it mandatory to do so, this will place an additional onus on the Applicant but should result in a general acceleration of the prosecution procedure.

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