

New EPC rules: “Raising the bar”

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Raising the bar when

New EPO's policy "Raising the bar"

- important changes to the EP practice as from April 1st, 2010.
- new rules → a major impact
 - EURO-direct and
 - EURO-PCT patent applications.



Divisional applications

Filing divisional applications is only allowed for **pending** applications which satisfy the newly introduced 24 month time limit.

Divisional application(s) can only be filed within 24 months from:

- the issuance of the very first communication from the Examining Division in the parent application (for a voluntary divisional, Rule 36(1)(a) EPC), or
- from the first ***non-unity objection*** by the Examining Division in the pending patent application (for a mandatory divisional, Rule 36(1)(b) EPC).



Divisional applications

EXCEPTION

- period of grace of 6 months where the 24 month period has already expired or will expire before **1 October 2010**.

PRACTICE BEFORE

Filing divisional applications at any time before grant of the parent application is not possible any more.

HIDDEN NON-CLAIMED INVENTIONS

Subject-matter can be claimed only by filing a divisional application within the above mentioned 24-month time limits.



EPO intention →streamlining the search.

Rule 43(2) EPC and new Rule 62a EPC.

- Multiple independent claims in the same category (product, apparatus, process or use) will not only be objected during examination (Rule 43(2) EPC), but as well by the search examiner during the search phase (Rule 62a EPC).
- The Search examiner may require the applicant to indicate, within a period of two months from notification, only one independent claim from each category to be searched.



Effects:

- no indication of claims to be searched is provided
 - ❖ the search will be carried out only on the first independent claim of each category (R.62a(1) EPC);
 - ❖ the Examining Division will require restriction to the subject-matter searched, unless it finds out that the objection was unjustified (R.62a(2) EPC);
 - ❖ Unsearched subject matter cannot be re-introduced later in the procedure (R.137(5) EPC);



REMEDY

The only way to save the claimed subject-matter of the additional non-searched independent claims is filing one or more divisional applications.

This measure will have a strong impact on the US-style claim-drafting.



“Complex applications” when subject-matter:

- Lacks technical character under Art. 52(2) and (3) EPC, e.g. business methods;
- Excluded from patentability under Art. 53 EPC, e.g. commercial exploitation, contravening morality, plant or animal variety or biological methods for their production, or method for medical treatment or diagnosis;
- Not-complying with clarity and sufficiency of disclosure requirements, Art. 84 and 83 EPC.



Current practice:

the search division issues a declaration that it is not possible to carry out a meaningful search (Old R.63 EPC).

New practice:

Search Division invitation to submit, within a time limit of two months, a statement indicating the subject matter to be searched (New R. 63(1) EPC).



Failure in responding:

- Search Examiner to draw up a partial search report or
- a declaration of non-meaningful search.

- Unsearched subject-matter will need to be excised from the application and cannot be used as basis for amendments.
- Unsearched yet potentially patentable subject matter will need to be the subject of a divisional application.



Mandatory response to the search opinion (R.70a EPC).

EURO-direct EP applications

For the search report published on or after 1 April 2010, it will be required to react to objections raised in the search report within a time limit, which correspond with the limit for filing the request for examination, i.e. six-months from publication of the search report.

Missing this time limit renders the application deemed to be withdrawn

Missing this time limit may be remedied with further processing.



Mandatory response to the search opinion (R.70a EPC).

Euro-PCT application,

Two different scenarios will apply:

1. EPO → ISA and, if applicable, also IPEA.

- ❖ communication requiring the applicant, within a time limit of one month, to comment on and/or file amendments in reply to the written opinion issued with the search report, or
- ❖ where applicable, to the preliminary report on patentability (R.70a(1) EPC).
- ❖ No response → application deemed to be withdrawn. Missing this time limit may be remedied with further processing.



Mandatory response to the search opinion (R.70a EPC).

Euro-PCT application,

2. EPO has not acted as ISA.

- ❖ EESSR has to be drawn up by the EPO;
- ❖ amendments to the claims (e.g. claims reduction) and/or description could be done within one month from the EPO communication requesting so.
- ❖ EESSR issued → time limit of six months, to comment on and/or file amendments in reply to the written opinion issued with the EESSR (R.70a(2) EPC).
- ❖ No response → application deemed to be withdrawn. Missing this time limit may be remedied with further processing.



In summary

1. EP patent application should be restricted in future to a more focused subject-matter, division of “mammoth” applications will be greatly restricted.
2. The granting procedure would be more rapid and the number of applications will increase, IP budgets need to be reviewed considering
 - the need for more applications to be filed at an earlier stage and
 - **the fees increase of 5% which applies for all fees paid on or after April 1, 2010.**



Questions?



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Thank you for the attention

