



NOTARBARTOLO & GERVASI

New EPC rules: "Raising the bar"

The EPO's policy of "**Raising the bar**" will bring some important changes to the European patent practice as from **April 1st, 2010**. The European Patent Office (EPO) will implement several new rules that will have a major impact in the EURO-direct and EURO-PCT patent applications.

1. Divisional applications

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

As of 1 April 2010, 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).

There is a period of grace of 6 months available for filing divisional applications where the 24 month period has already expired or will expire before **1 October 2010**.

The customary practice of filing divisional applications at any time before grant of the parent application is not possible any more. Furthermore, when drafting patent applications containing "hidden" non-claimed inventions, applicants should be aware that said subject-matter can be claimed only by filing a divisional application within the above mentioned 24-month time limits.

In light of the above, we therefore suggest to review all pending European patent applications to identify subject matter for which a divisional application should be filed before the end of the grace period, **October 1, 2010**.

2. Multiple independent claims in one category

By introducing this new measure, the EPO intends to streamline the activities of the search division. 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.

If no indication of claims to be searched is provided within the two-month time limit:

- 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);
- 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.

3. Complex applications

The EPO considers "Complex applications" applications claiming subject-matter:

- Lacking 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.

Under the current practice, complex applications would lead the search division to issue a declaration that it is not possible to carry out a meaningful search (Old R.63 EPC).

As of 1 April 2010, the Division will invite the applicant within a time limit of two months to submit a statement indicating the subject matter to be searched (New R. 63(1) EPC). Failure in responding with completeness to the invitation would cause the Search Examiner to draw up a partial search report or a declaration of non-meaningful search. However, 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.

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

4.1 European patent applications, 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 may be remedied with further processing.

4.2 Euro-PCT application, PCT applications entering into the EP regional phase

Two different scenarios will apply:

- European Patent Office has performed the search (ISA) and, if applicable, also the preliminary examination (IPEA). Shortly after the European phase entry, the applicant will receive a 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). If no response is filed within the required time limit, the application is deemed to be withdrawn. Missing this time limit may be remedied with further processing.
- EPO has not acted as ISA. A Extended European Supplementary search report (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 months from the EPO communication requesting so. Once the EESSR has been issued the applicant will be requested, as above, within a time limit of one month, to comment on and/or file amendments in reply to the written opinion issued with the EESSR (R.70a(2) EPC). Missing this time limit may be remedied with further processing.

In summary

EP patent application should be restricted in future to a more focused subject-matter, division of "mammoth" applications will be greatly restricted.

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 about 5% which applies for all fees paid on or after April 1, 2010.**

Should you have any further questions, please do not hesitate to contact our patent attorneys.

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