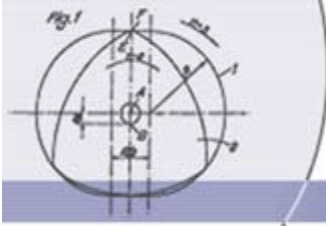


Pfenning, Meinig & Partner GbR
Patent Attorneys and Lawyers

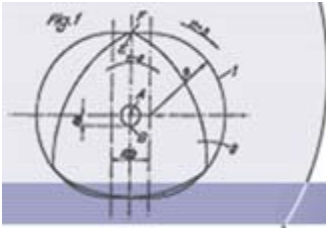
Update on EPC changes

Dr. Helmut Reitzle
Dr. Benedikt Lehmann-Dronke
Pfenning, Meinig & Partner GbR



Update on EPC changes

- New contracting states
- New time limits for filing divisional applications
- Scope of the European search and consequences
- Response to the EESR or to the written opinion of the ISA
- New fees (designation and page fees)



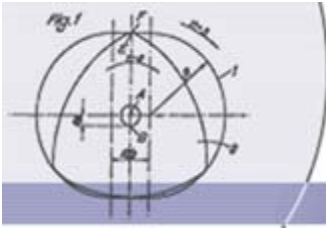
Contracting States EPC

Latest accessions:

- Macedonia (January 1, 2009)
- San Marino (July 1, 2009)

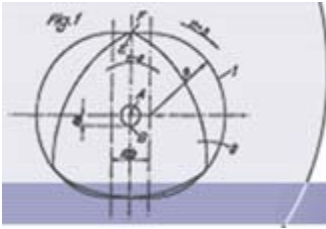
Currently 36 contracting states and
3 extension states (AL, BA, RS)





New time limits for filing divisional applications

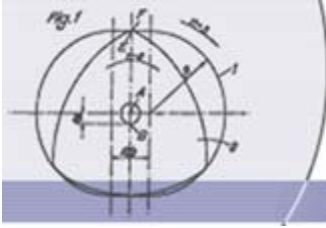
- Currently, divisional applications can be filed **as long as the parent application is pending**, i.e. by the day before the publication of the grant of the patent
- New **Rule 36 EPC** will result in a significant change
- New Rule 36 EPC will come into effect on **April 1, 2010** and also affect pending applications



New time limits for filing divisional applications

New Rule 36 EPC (entering into force on April 1, 2010):

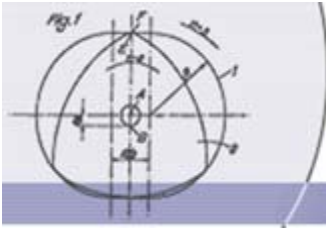
- Divisional applications on the **applicant's own initiative** (*voluntary divisional applications*) have to be filed within a period of 24 months from the Examining division's first communication in respect of the earliest application (which can be the parent or, in case of a "chain" of applications, an even earlier application)
- Divisional applications filed in **reaction to a non-unity objection** (*mandatory divisional applications*) have to be filed within 24 months from the communication raising that specific objection for the first time
- Time limits also apply to **applications pending on April 1, 2010** but the time limits will not expire before **October 1, 2010**



New time limits for filing divisional applications

Recommendations

- Applicants should review their portfolio of patent applications, identifying what they want to protect and whether they will need to file divisional applications
- As the new Rule 36 will also refer to pending applications, applicants should be aware of applications for which the term of two years expires shortly after October 1, 2010
- Applicant and representative have to ensure for such cases that divisional applications are filed in time



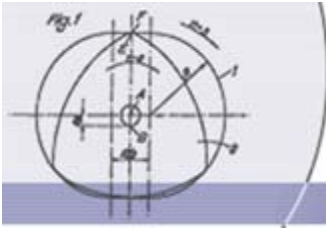
Restricted scope of the European search

New Rule 62a EPC (entering into force on April 1, 2010)

- (1) If the European Patent Office considers that the claims as filed do not comply with Rule 43, paragraph 2*, it shall invite the applicant to indicate, within a period of two months, the claims complying with Rule 43, paragraph 2, on the basis of which the search is to be carried out. If the applicant fails to provide such an indication in due time, the search shall be carried out on the basis of the first claim in each category.
- (2) The Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified.**

* Rule 43(2) EPC: With very few exceptions, a European patent application may not contain more than one independent claim in each category.

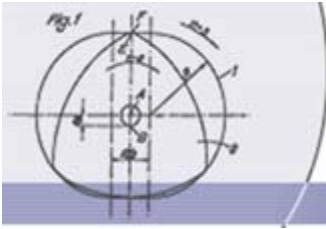
** Amended Rule 137(5) EPC: Amended claims may not relate to subject-matter not searched in accordance with Rule 62a.



Restricted scope of the European search

Recommendations

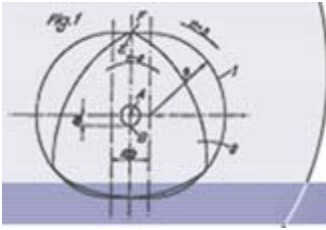
- When filing a European patent application or when entering the European phase of a PCT application, the applicant should make sure that the application contains not more than one independent claim in each category.
- In the case of a PCT application entering the European phase and being subjected to a supplementary search by the EPO, the application may be amended correspondingly within the time limit of one month from the communication according to Rule 161 EPC.



Response to the EESR or written opinion of the ISA

New Rule 70a EPC (entering into force on April 1, 2010)

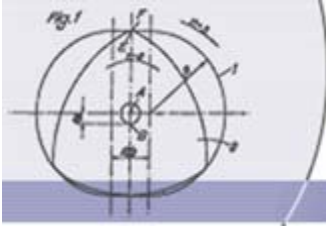
- (1) In the opinion accompanying the European search report the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period referred to in Rule 70, paragraph 1 [i.e. within six months after the publication of the ESR].
- (2) In the cases referred to in Rule 70, paragraph 2 [i.e. if examination is requested before the ESR is issued], or if a supplementary European search report is drawn up on a Euro-PCT-application, the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period specified for indicating whether he wishes to proceed further with the application [6 months in practice].
- (3) Non-compliance and no response \implies **application shall be deemed to be withdrawn**



Response to the EESR or written opinion of the ISA

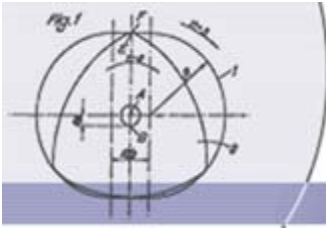
New Rule 161 EPC (entering into force on April 1, 2010)

- (1) If the European Patent Office has acted as the International Searching Authority and, where a demand under Article 31 PCT was filed, also as the International Preliminary Examining Authority for a Euro-PCT application, it shall give the applicant the opportunity **to comment on the written opinion of the International Searching Authority or the International Preliminary Examination Report** and, where appropriate, invite him to correct any deficiencies noted in the written opinion or in the International Preliminary Examination Report and to amend the description, claims and drawings **within a period of one month** from the respective communication. **If the applicant does not comply with or comment on an invitation in accordance with the first sentence, the application shall be deemed to be withdrawn.**
- (2) Where the European Patent Office draws up a supplementary European search report on a Euro-PCT application, the application may be amended once within a period of one month from a communication informing the applicant accordingly. The application as amended shall serve as the basis for the supplementary European search.



Response to the EESR or written opinion of the ISA

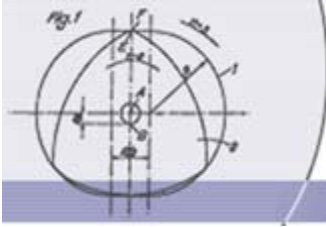
- If the EPO has been ISA or IPEA, a response within only one month after the R 161 communication is **mandatory** to overcome objections raised in the written opinion of the ISR or in the IPER
- Otherwise (if a EESR is issued), a response to the written opinion accompanying the ESR needs to be filed within a time limit of six months after the publication of the ESR (EP direct) or after a communication inviting the applicant to do so (Euro-PCT)
- The due term for filing a response to the R 161 communication is only **one month**



Response to the EESR or written opinion of the ISA

Recommendations

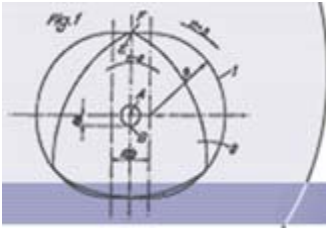
- The term of one month after the R 161 communication, in particular, is often not sufficient to prepare a response in agreement with the applicant
 - ⇒ Foreign applicants should prepare comments on the written opinion of the ISR or the IPER **when entering the European phase** (31 months)
- Thus, the European representative can start preparing a response before the R 161 communication is issued



Designation fee

Previous system (before April 1, 2009)

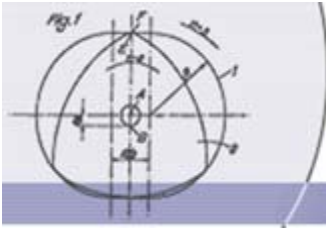
- Before April 1, 2009, individual designation fees had to be paid for each contracting state
- With payment of 7 designation fees all contracting states were designated
- European Patents could only be validated in designated states



Designation fee

New system (from April 1, 2009)

- A **flat designation fee of 500 €** has to be paid to cover all contracting states of the EPC (currently 36 states)
- However, Art. 79(3) EPC still permits the withdrawal of a designation of a particular state during prosecution
- It is maintained that the designation fee is due:
 1. For a direct European application six months after the publication of the EPO search report and
 2. For a EP phase of a PCT application within 31 months from the priority date

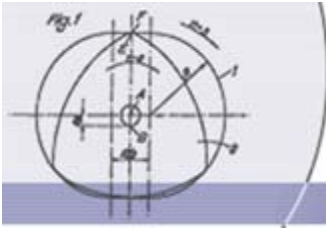


Designation fee

The designation fee, once paid, will not be refunded if the applicant withdraws the application

Recommendation

- ⇒ For a direct European Application, it is recommended **to pay the designation fee shortly before the end of the due term** of six months after the publication of the EPO search report



Additional fee

- An additional fee has been introduced by the EPO which is a page fee for applications with **more than 35 pages**
- This fee has to be paid with filing the EP application or entering the EP phase
- The amount of the fee is **12 € per page** exceeding 35 pages
- The additional fee applies to applications filed on or after **April 1, 2009**