

PROCEDURAL CHANGES AT THE EUROPEAN PATENT OFFICE

Summary

This circular concerns new rules coming into force on 1 April 2010 which are designed to speed up prosecution before the European Patent Office. The changes bring forward the point at which applicants must address substantive issues in the EPO, in particular by requiring applicants to respond to search opinions provided with search reports drawn up by the EPO.

Rule 70a: Obligatory response to the search opinion

New Rule 70a introduces a requirement to respond to the search opinion which accompanies search reports from the EPO. If no response is filed to the search opinion the European patent application will be deemed withdrawn. The time limits for the filing of the response are as follows:-

1. For all European patent applications (including divisionals), other than E/PCT applications, a response to the search opinion will need to be filed within 6 months of the date of publication of the search report, i.e. the same term as the term for payment of the examination, designation and extension fees.
2. For an E/PCT application where the EPO did not act as the International Search Authority (ISA) and has therefore drawn up an extended supplementary search report, the deadline for filing a response to the search opinion will be the same 6 month deadline (non-extendable) set for confirming the request for substantive examination after issuance of the search report .
3. For an E/PCT application where the EPO acted as the ISA, it will be necessary to file a response to:
 - (a) the search opinion that accompanies the International Search Report, or
 - (b) the International Preliminary Examination (IPE) Report if the EPO has conducted IPE on the relevant International application.

Where the EPO has acted as ISA, the response deadline will be 1 month from the date of issue of the Rule 161 Communication. The Rule 161 Communication issues shortly after an International application has entered the European regional phase and invites an applicant to make amendments, in particular amendments to the claims, and to pay any outstanding excess claims fees. This term of 1 month is not extendable but further processing under Article 121 EPC is available.

Rule 137: Amendments

Under amended Rule 137(2) an applicant is given one opportunity to amend the description, claims and drawings of his own volition at the same time as responding to the search opinion. All subsequent amendments, including any amendments made in the response to the first examination report, will be allowed only at the discretion of the Examining Division.

Amended Rule 137(4) also requires an applicant to identify the basis for any amendments in the application as originally filed. If basis is not provided, the applicant will be set a 1 month non-extendable term in order to provide the basis.

Subject matter to be searched: Rule 62a: multiple independent claims

New Rule 62a EPC relates to a situation where the application includes multiple independent claims of the same type, e.g. multiple independent product claims or multiple independent process claims. Current Rule 43(2) EPC allows this only if the subject matter of the application involves one of the following:

1. A plurality of interrelated products, examples being a transmitter and receiver, a plug and socket, a protein and its encoding nucleic acid or an intermediate and final chemical product;
2. Different uses of a product or apparatus, for example, second or further medical uses of a compound; or
3. Alternative solutions to a particular problem where it is inappropriate to cover these alternatives by a single claim, for example, two or more processes for the manufacture of a product.

This requirement is in addition to the requirement that there be unity of invention.

Under new Rule 62a EPC, if the EPO finds that these requirements are not met, the applicant will be invited to identify within a 2 month (non-extendable) term those claims complying with Rule 43(2) EPC on which the search should be based. In practice this may mean identifying a single independent claim to be searched. If no response is filed to this invitation, the search will be carried out by the EPO on the basis of the first claim presented in each category.

Subject matter to be searched: Rule 63: Incomplete search

New Rule 63 EPC relates to a situation where the EPO is unable to carry out a meaningful search, for example because claim 1 is considered to be not sufficiently clear. Under current EPO practice, the EPO limits the scope of the search without consulting the applicant if the EPO considers that it is unable to carry out a meaningful search.

Under new Rule 63 EPC, if the EPO considers that it is impossible to carry out a meaningful search, the EPO will invite the applicant to indicate within 2 months (non-extendable) the subject matter that should be searched. If no reply is filed to the invitation, or if the EPO still considers that it is not practicable to draw up a search report for the subject matter specified by the applicant, the EPO will conduct its search on the basis of some or all of the subject matter claimed or issue a reasoned declaration to the effect that it is impossible to carry out a search.

Limitation of claims to searched subject matter

A significant practical point is that, in general, the EPO will be requiring the claims to be limited to searched subject matter (unless the objection under Rule 62a or 63 was unjustified). Also claim amendments made during prosecution may not introduce:

- a) subject-matter not searched in accordance with Rules 62a or 63; or
- b) unsearched subject-matter directed to a different invention.

Applicants also need to bear in mind that the normal current "escape route" of filing a divisional to protect unsearched subject matter might be cut-off by the new 24 month deadline for divisionals.

Entry into force of the new Rules

The new rules enter into force on 1 April 2010. They will apply to any European patent application for which the European search report or supplementary European search report is drawn up on or after 1 April 2010, or (where the EPO acted as the ISA) a Rule 161 Communication issues on or after 1 April 2010.