



1. Introduction

The rules for prosecution of patent applications before the European Patent Office will be amended as from April 1, 2010. The rule changes are in two categories. The first relates to divisional applications and has been adopted as a result of what has been perceived by some as a problem with the present procedure in that it allows applicants to maintain divisional applications pending for a prolonged period thereby resulting in a lack of certainty for the public. The second category of changes aims to speed up prosecution and reduce the examiner's burdens by providing more teeth to the requirement of the European Patent Convention that claims must be "concise". The second set of changes could be particularly challenging for those who are used to drafting claims with multiple independent claims in the same category.

Many of the changes now being effected build upon those that came into effect four years ago for applications filed on or after July 1, 2005 or, in the case of PCT European regional phase entries, PCT applications filed on or after July 1, 2005. For such applications, the European Search Report or, in the case of a PCT application where the EPO did not carry out the International Search Report, the EPO's Supplemental Search Report has been in the form of what the EPO refers to as an "extended search report" and included an opinion on patentability of the invention claimed and possibly other comments on the application. The applicant has been entitled to respond to these. If the applicant has not done so the first official communication from the Examining Division has normally been a request that the applicant provides a response to the comments made in the extended search report. In cases where the EPO carried out the International Search Report, a similar written opinion has accompanied the International Search Report and has been treated by the EPO in the same way.

2. Changes in Divisional Practice.

At present it is possible to file a divisional application at any time while the parent application is pending and, as long as no additional subject matter is added along the way, to have cascades of divisionals filed successively as long as each application in the cascade is filed while its parent is still pending.

From April 1, 2010, new Rule 36 provides that, in addition to the requirement that it must be filed while its immediate parent is still pending, a divisional application, irrespective of whether it is being filed voluntarily or in response to a lack of unity objection will in general only be permitted within specified time limits. Thus in general a

divisional will have to be filed within 24 months of the first official communication from the Examining Division on the application being divided or, if this is itself a divisional, the first official communication from the Examining Division on any ancestor application. Communications from the Search Division reporting searches, even though accompanied by written opinions, do not trigger these terms.

One exception to the general rule exists in that if a lack of unity issue is first raised after the Examining Divisions' first official communication, then a divisional may be filed within 24 months of the first communication raising a lack of unity objection. In addition to normal "official actions" such communications may, according to an official notice of the EPO, include minutes of personal or telephone interviews, annexes to summons to oral proceedings or even oral proceedings themselves.¹

The new rules will apply to any divisional filed after April 1, 2010. For situations in which the new time limit has already commenced, if it expired by April 1, 2010, there will be a further six months available. If the term expires after April 1, 2010, it will be extended up to October 1, 2010 if it would otherwise expire earlier.

Examples (unless a divisional is being filed in response to a lack of unity objection first raised by the Examining Division in an official communication after the first such communication, in which case the 24 month term runs from that communication):

First official communication from Examining Division

May 1, 2009
March 1, 2008
September 1, 2008

Last date for divisional

May 1, 2011
October 1, 2010
October 1, 2010

It will not be possible to request further processing to revive the possibility of filing a divisional if the term has been missed.²

RECOMMENDATION:

Review all pending European applications to determine whether a lack of unity objection has been raised, but on which no divisional application has yet been filed and also whether there may be other reasons why a divisional may be desirable.

1. Notice from EPO dated 20 August 2009 [2009] OJ EPO 481.

2. Rule 135(2) as amended.



Notes:

1. This change will probably end the practice of filing a divisional application prior to oral proceedings or an appeal hearing in case the application is rejected and the applicant wishes to make a further attempt at convincing the EPO that the application contains allowable subject matter.

2. The procedure under Rule 64(1) whereby if the Search Division believes that more than one invention is claimed it will carry out a search on the first invention claimed and invite the applicant to pay additional search fees for any additional inventions it wants searched remains unchanged except that the term for response to such an invitation has been changed to two months. In view of the changes discussed in Section 3.1 below, it may be that in the future such additional searches will be needed more frequently than hitherto to avoid the risk that examiners will view amendments proposed during prosecution as relating to “unsearched subject matter”.

3. Changes related to Expediting Examination

These come in five forms:

- 1) changing the treatment of applications containing multiple independent claims at filing;
- 2) changing the requirements for making comments on issues raised in search reports;
- 3) changing the procedure to be followed if the EPO does not believe that a meaningful search can be effected on the claims as filed;
- 4) changing the last date at which voluntary amendments can be filed *and*
- 5) requiring applicants to point out the support in the original application for any amendments made.

3.1 Changes Relating to Multiple Independent Claims

EPO Rule 43(2) provides that a European patent application has been able to contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

- (a) a plurality of inter-related products;
- (b) different uses of a product or apparatus;
- (c) alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim.

New rule 62a which comes into effect on April 1, 2010 provides that before carrying out a search if the EPO believes that the claims do not comply with Rule 43(2) it shall give the applicant two months within which to explain why the requirements of Rule 43(2) are met or designate the independent claims on which examination is to be carried out. If the applicant fails to respond within two months, the search will be carried out on the first independent claim presented in each category.³ An official notice of the EPO dated October 15, 2009⁴ points out that the applicant retains the right to challenge objections under Rule 62a either in a reply to the Search Division or to the Examining Division and if either of these divisions is persuaded by the challenge, a full search will be carried out. Once examination is commenced, the Examining Division will “invite” the applicant to delete unsearched claims. In the notice of October 15, it is noted that failure to respond to this invitation may result in the application being refused under Article 97(2) EPC.

RECOMMENDATION:

Review all applications where direct filing in the EPO is contemplated to make sure that claims are in the best form before filing. Review all pending PCT applications which are likely to enter the European Regional Phase to place claims in best order in international phase before having to deal with the new EPO requirements. Unfortunately it is not possible to amend a European Application before the Search is carried out⁵ and so for European applications that have already been filed in the EPO which are not proceeding under the PCT, all that will be possible is to respond to the new communication.

Note:

This new rule could create problems in prosecution in view of the provision in renumbered Rule 137(5) that applications may not be amended to include unsearched subject matter. In an official notice of October 15, 2009⁶, it is pointed out

3. Rule 62a.
4. [2009] OJ EPO 533.
5. Rule 137(1)
6. [2009] OJ EPO 533.



Where the claims have been limited under Rule 62a or 63⁷ amendments based on non-searched subject matter can no longer be derived from the description at a later stage of the grant procedure. The subject matter excluded from the search under Rule 62a or Rule 63 EPC may, however, be prosecuted in divisional applications which must be filed by the deadline laid down in Rule 36(1)(a) EPC.⁸

The new limitations on when divisional applications may be filed may hamper the ability that exists currently to deal with the “unsearched subject matter” problem by filing a divisional and so provides a further impetus to placing the claims in the best form possible before filing or before entry into the European Regional phase.

3.2 Responding to the Search Report

Three situations arise:

- 1) where the filing is a direct filing in the EPO,
- 2) where the application is a Euro-PCT application where the International Search Report was issued by an International Search Authority other than the EPO *and*
- 3) where the application is a Euro-PCT application and the International Search Report was issued by the EPO.

3.2.1 Direct EP Filings

From April 1, 2010, it will be necessary for the applicant to respond to comments made in the Extended Search Report issued under Rule 62 on non-PCT applications either within the period for requesting examination (six months from publication in the European Patent Bulletin of the publication of the search report) or, if a valid examination request has already been filed, within a period specified by the EPO⁹ in a communication inviting the applicant to indicate whether the applicant wishes to proceed with the application. Failure to do so will result in the application being deemed to be withdrawn.¹⁰ Any such deemed withdrawal can be remedied by requesting further processing.¹¹

3.2.2 Euro-PCT Applications where International Search was not by EPO

For Euro-PCT applications, in cases where the International Search was not carried out by of the EPO, the EPO carries out its own Supplementary Search (including its opinion on patentability) before starting substantive examination.¹² Before doing so, the EPO will inquire

whether the applicant wishes to amend the claims before the search is carried out.¹³ When this Supplementary Search is completed it is sent to the applicant with an enquiry as to whether he still wishes to proceed with the application in the light of the search results.¹⁴ If the applicant fails to advise the EPO that he wishes to continue with the application or to comment on issues raised, the EPO will deem application to be withdrawn.¹⁵ Any such deemed withdrawal may be remedied by requesting further processing. If the application is withdrawn, the examination fee will be refunded.¹⁶ From April 1, 2010 the applicant will be “invited” to correct any deficiencies noted in the supplemental search report and comment on the search report within the period set for advising as to whether the applicant still wishes to proceed with the application.¹⁷

3.2.3 Euro-PCT Applications where International Search was by EPO or the EPO has Carried out a Supplemental International Search under PCT Rule 45 bis

As from April 1, 2010, unless comments have already been made in the International phase, if the International Search Report or a Supplemental International Search

-
7. See Section 3.3 below.
 8. See Section 2 above.
 9. The notice of October 15, 2009 referred to above indicates the period for response will normally be six months.
 10. New Rule 70a.
 11. Rule 135(2) as amended.
 12. EPC Article 153(7). For International Applications filed on or after July 1, 2005, the supplemental search report is accompanied by an opinion on whether the requirements of the European Patent Convention have been met by the application and the invention.
 13. This is effected by a combined “Communication under Rules 161 and 162” which invites the applicant to amend the claims before a search is carried out and to pay any missing claims fees. Claims fees are payable on the claims as they exist after amendment.
 14. EPC Rule 70(2).
 15. New Rule 70a(3). The official notice of October 15, 2009 referred to above indicates that the applicant will normally be given six months within which to respond to issues raised in the Supplemental Search Report.
 16. Rules relating to Fees. Article 11. If the applicant indicates that he wishes to withdraw the application after the file has been transferred to the Examining Division but before the Division has started work, a refund of 75% of the examination fee may be available. A Notice dated October 22, 2009 ([2009] OJ EPO 542) explains how the 75% refund possibility will be applied in the light of new Rule 70a and amended Rule 161.
 17. New Rule 70(a)(2).



Report¹⁸ was issued by the European Patent Office, it will also be necessary to file comments and/or amendments relating to the issues raised in the Search Report within a one month term from receipt of an invitation to do so.¹⁹ If the applicant fails to file such comments the application will be deemed to be withdrawn, although such deemed withdrawal may be remedied by requesting further processing. This is also the applicant's last opportunity to make a voluntary amendment on a Euro-PCT application.²⁰

RECOMMENDATION:

In view of the short time limits that may apply to responding to invitations to comment on search reports, particularly those issued by the EPO, it would be desirable to start preparation of comments on applications promptly after receipt of such reports.

3.3 Procedure to be Followed when EPO believes no Meaningful Search can be Carried Out.

Rule 63 is amended with effect from April 1, 2010 to provide that if the EPO does not believe that it is possible to carry out a meaningful search, it will invite the applicant to specify what should be searched and to permit the Examination Division to invite the applicant to limit the claims to what has been searched. A two month term (which will not be amenable to further processing) will be set for a response. Previously the rule required that the EPO simply issued a declaration that no meaningful search could be carried out or that it carried out a partial search.

Note: The change is needed because of the change noted below that the last date on which an applicant can make a voluntary amendment is that of reply to the search report rather than reply to the first official communication from the Examining Division. The official notice of October 15, 2009 referred to above indicates that one way to respond to an invitation under Rule 63 would be to make an informal submission of the claims that one wishes to have searched and then make a formal submission of such claims in response to the search report.

3.4 Last date for Voluntary Amendment

Up to April 1, 2010, Rule 137 generally precludes amending the description, claims or drawings before the search report has issued and that amendments at the applicant's volition may be made after receipt of the search report and at the same time as responding to the first office action. From April 1, 2010 the applicant's last chance to make a voluntary amendment without the examiner's consent will be when filing a response to the search report. Subsequent amendments may be made only with the consent of the Examining Division. Rule 137(4), which will be renumbered as Rule 137(5), provides that amendments shall not relate to unsearched subject matter "which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept." Additionally from April 1, 2010, this rule is amended so that it will not be possible to amend claims to include subject matter that was not searched either as a result of it being related to an independent claim that was unsearched because more than one such claim was present in a single category or as a result of the EPO's decision that it was unable to make any meaningful search on the subject matter in question.

18. See Decision of Administrative Council of October 27, 2009 (CA/D 20/09). The EPO has previously announced its intention to start acting as an International Supplementary Search Authority during 2010, but has not yet started to act in this role.

19. New Rule 70a(2) and Rule 161 as amended. The official notice of October 15, 2009 indicates that amendments made under PCT Article 19 which are maintained on entry into the European regional phase and amendments made on entry into the European regional phase will be considered as complying with the requirement for a response to issues raised by the EPO in the International Search Report. On the other hand, if the EPO has additionally acted as an International Preliminary Examination Authority and has considered amendments and comments on the issues raised in the Search Report in formulating an International Preliminary Examination Report, a further response by the applicant to the Rule 161 communication will be required.

20. Rule 137(3).



3.5 Need to Indicate Support for any Amendments Made During Prosecution

As from April 1, 2010, it will be necessary to specify the support on the specification for any amendment at the time of making the amendment.²¹

General Recommendation

Preparation of applications for filing in the European Patent Office and of PCT applications intended to enter the European Regional Phase will require special consideration to make sure that claims are initially drafted in such a way as to ensure that all relevant subject matter is searched while ensuring compliance with Rule 43(2) relating to independent claims, in general restricting the claims to one independent claim per category. Under the new rules, the opportunities to fix matters later are considerably reduced. If multiple independent claims do have to be used, the most important claim should be presented first. Furthermore, when drafting the claims, it also needs to be borne in mind that 1) the excess claims fees in Europe are now €200 per claim from 15 to 50 and €500 per claim for each claim in excess of 50²² and 2) the total number of claims must be reasonable with respect to the nature of the invention claimed.²³ There have been cases where examiners have

regarded the number of claims as being excessive and simply refused to examine them despite payment of appropriate claims fees. It should, however, also be borne in mind that the claims in the EPO are permitted to include optional and preferred features as well as having multiple dependencies and that in some cases it may be possible to draft a sub claim to a modification of a claim on which it depends which would not be permitted in the United States because of the requirements of 35 USC 112 paragraph 4.

Additionally, it becomes even more important than before to review the International Search Report and Written Opinion accompanying it on PCT applications where regional phase entry in the EPO is contemplated to make sure that if the application can be improved, such steps are taken prior to entry into the European regional phase.

21. New rule 137(4).

22. Rule 45.

23. Rule 43(5).

