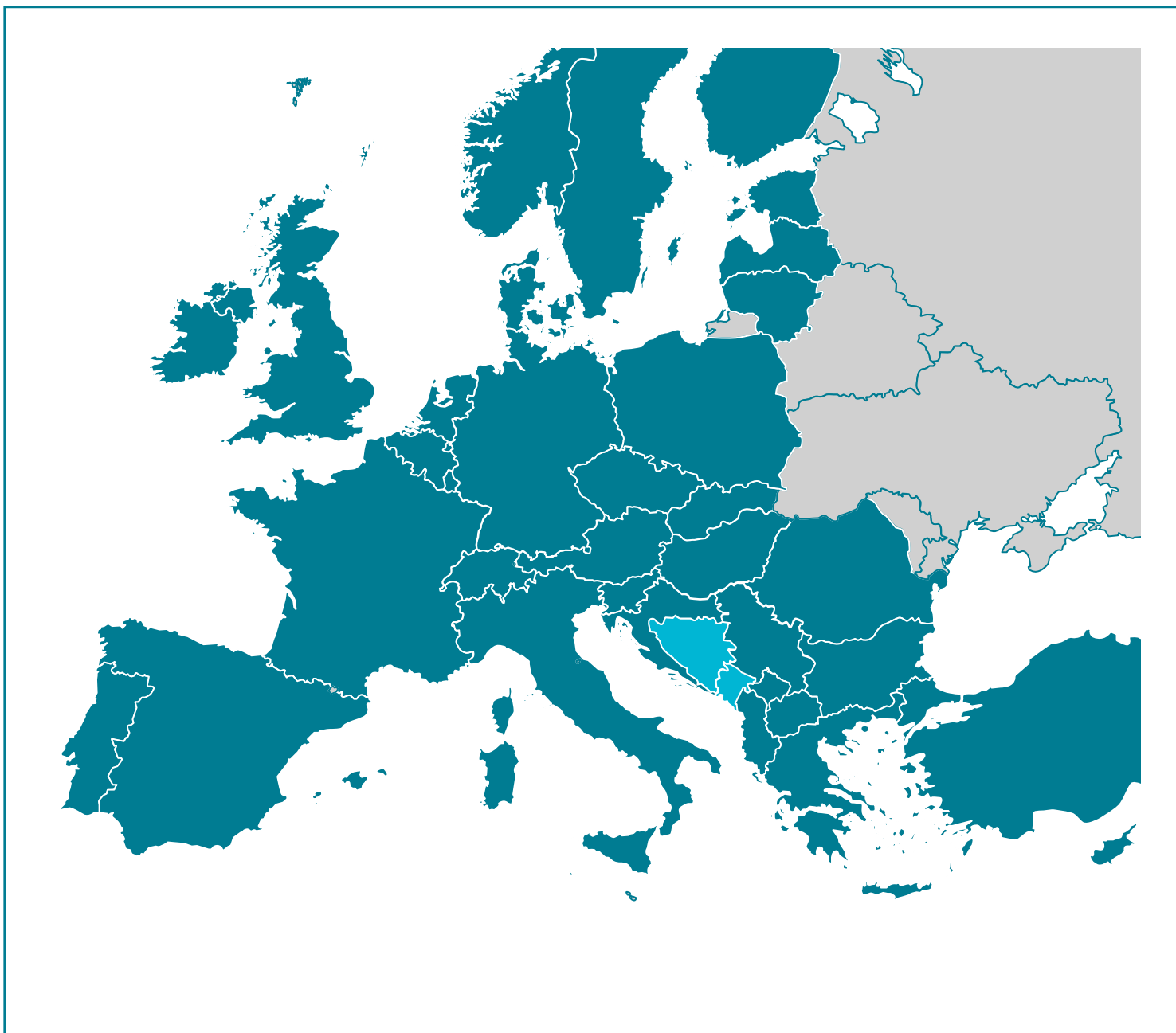




OFFICE FREYLINGER

PATENT AND TRADEMARK ATTORNEYS



EUROPEAN PATENTS

Legislative changes at the EPO as of 1 April 2010 - Part II: Prosecution [updated April 2014]

EUROPEAN PATENTS

Changes as of 1 April 2010 - Part II: Prosecution [April 2014]

Since 1 April 2010, the prosecution of European Patent applications has noticeably changed with the declared aim of streamlining patent grant proceedings.

These changes particularly affect the early stages of an application by requiring earlier substantive action from the Applicant, i.e. before search (1), during search (2 and 3), after search (4), on EP entry (5) and at the beginning of the examination (6).

Further changes (7) relating to the grant procedure entered into force on 1 April 2012.

1. Before search - Multiple independent claims in the same claim category (Rule 62a)

Former Practice

Rule 43(2) EPC provides that a European patent application may 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 interrelated products,
- (b) different uses of a product or apparatus,
- (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

Formerly, no formal objection to the number of independent claims in each claim category was raised at the time of the search. In fact, as long as the multiple independent claims satisfied the unity requirements of Art. 82 EPC, the subject matter therein was searched in its entirety.

Changes as of 1 April 2010

According to **Rule 62a**, if there is more than one independent claim in a category and the EPO considers that the subject matter of these claims does not fall under one of the exceptions of Rule 43(2), the EPO should invite the Applicant to indicate, within a period of **2 months**, which independent claim in each category is to be searched.

If the Applicant fails to reply, the search will be carried out on the basis of the first independent claim in each category.

Practical implications

One difficulty here is that Applicants will be required to choose between independent claims in the absence of any knowledge of the prior art.

Most importantly, unlike in the case of lack of unity (see below), no additional search fees can be paid to have this subject matter searched. As a consequence, during examination, the EPO will require the Applicant to restrict the claims to the subject matter searched unless it finds that the objection under Rule 43(2) was not justified.

This is further emphasized by amended Rule 137(5) which, at the examination stage, explicitly prevents amendments that are based on unsearched subject matter.

Hence, protection for unitary but unsearched subject matter will need to be sought by filing a divisional application.

2. During search - Clarification (Rule 63 EPC)

Former Practice

In the past, if the search division considered that an application did not comply with the EPC to such an extent that it was impossible to carry out a meaningful search, it issued a reasoned declaration to that effect, or alternatively, decided by itself which subject matter was to be searched and prepared a corresponding partial search report (Rule 63 EPC).

The declaration or the partial search report was then considered, for the purposes of subsequent proceedings, as the European search report.

Changes as of 1 April 2010

Rule 63 introduces a measure that allows the EPO to contact Applicants during search phase to seek clarification about what must be searched.

More specifically, under current Rule 63, where the EPO considers that it is impossible to carry out a meaningful search, the Applicant will be invited to submit a statement indicating the subject matter to be searched. Such a statement may e.g. indicate a part of the description that may be used for interpreting the claims, or an improved claim wording that would later become a formal amendment.

Practical implications

Great care must be taken when filing such a statement because it is likely to limit the scope of the claims, without a possibility to later broaden the scope of the claims during substantive examination (since unsearched subject matter cannot serve as a basis for amendment).

EUROPEAN PATENTS

Changes as of 1 April 2010 - Part II: Prosecution [April 2014]

3. During search - Lack of unity (Rule 64 EPC)

Former practice

If the Search Division considered that a direct European Patent application did not meet the requirement of unity of invention of Article 82 EPC, it drew up a partial search report for the invention first mentioned in the claims and invited the Applicant to pay an additional search fee for each further invention to be searched.

The time limit for paying the additional fee(s) was set between 2 and 6 weeks, at the discretion of the Search Division.

Changes as of 1 April 2010

Under current **Rule 64**, the period in which the Applicant can pay further search fees for inventions other than the first invention to be searched is set to **2 months**.

Please note that in case of a Euro-PCT application, for which a Supplementary European Search Report is drawn up, only the invention or group of inventions first mentioned in the claims is searched. Non-unitary subject matter not covered by the Supplementary European Search Report can only be pursued via one or more divisional applications.

4. After search - Compulsory reply to European Search Reports and Written opinions (Rule 70a)

Former practice

Previously, although voluntary amendments could be made after receiving the search report, there was no obligation to respond at the search stage. In fact, from the entry into force of the EPC, search and examination had always been very different and clearly separate stages, wherein search was passive with very limited interaction between EPO and Applicants, leaving all substantive matter to be dealt with for examination.

Changes as of 1 April 2010

Currently, if deficiencies are noted in the Search Report, **Rule 70a** will require a substantive response addressing the objections raised therein to be filed **within 6 months** of the invitation under R.70a(1) or of the mention of publication of the search report R.70a(2). If the Applicant does not comply with these provisions, the application will be deemed to be withdrawn (R.70a(3)). Further processing under Art. 121 EPC is available as a remedy.

Practical implications

These changes should shorten the prosecution proceedings by a few months, as the Applicant can no longer await the receipt of the first examination report to address the objections.

5. On EP entry - Compulsory reply to IPRP (Ch. I or II) if drawn up by EPO (Rule 161 EPC)

Former practice

According to former Rule 161, the Applicant was allowed to amend an International application on entry into the European regional phase. Such amendments were entirely optional and did therefore not need to address any objection raised by the ISA or IPEA. Rule 161, as in force until 31 March 2010, made no difference between applications for which the EPO acted during International phase and applications dealt with by other ISA or IPEA.

Changes as of 1 April 2010 and 1 May 2011

Current **Rule 161(1) EPC** makes mandatory the substantive response addressing all objections raised in the IPRP drawn up by the EPO within **6 months** from the invitation pursuant to Rule 161(1). Failure to comply with these provisions or to comment on the invitation will result in the application being deemed to be withdrawn. Further processing under Art. 121 EPC is available as a remedy.

For applications for which the EPO did neither act as ISA nor as IPEA, current **Rule 161(2)** stipulates that the application may be amended once within a period of **6 months** from the invitation and that these amendments will serve as a basis for the supplementary European search report. Accordingly, for applications for which the EPO did not act as ISA or IPEA, there is no change of the procedure following the communication pursuant to Rule 161-162.

Practical implications

Applicants not using the EPO as ISA and IPEA do not have to file a substantive response to their IPRP, but they may or may not amend the application. Furthermore, after receipt of the supplementary search report, the Applicant will have a second opportunity to file a voluntary amendment within the period of Rule 70a, although this response will be mandatory (see Item 4. above).

It is important to know that the EPO will only start examining the Euro-PCT application (R.161(1)), resp. the supplementary search (R.161(2)) after the expiry of the 6-month time limit. If the Applicant wishes to accelerate the proceedings, he may waive the R.161(1), resp. (2) communication either on entering the EP phase or later. However, a valid waiver requires that all fees have been paid on EP entry.

EUROPEAN PATENTS Changes as of 1 April 2010 - Part II: Prosecution [April 2014]

6. During examination - Limited amendments (Rule 137 EPC)

Former practice

Until 31 March 2010, the Applicant was allowed to amend the application of his own volition after receipt of the first examination report, provided the amendment did not introduce unsearched subject matter that did not combine with the originally claimed invention to form a single general inventive concept. Further amendments needed the consent of the Examining Division.

Changes as of 1 April 2010

As of 1 April 2010, current **Rule 137(3)** makes any amendment at this stage subject to the consent of the Examining Division.

Furthermore, **Rule 137(4)** renders mandatory the identification and indication of the basis thereof within the application as filed. On failure to provide such information, the Examining Division may request the correction of that deficiency within 1 month.

Finally, **Rule 137(5)** explicitly excludes any amendments relating to subject matter unsearched according to Rule 62a and Rule 63.

Practical implications

The most significant point in Rule 137 EPC is that of Rule 137(3) which implies that Applicants only have one guaranteed opportunity to amend their application of their own volition; namely, as outlined in Rule 137(2) EPC, under Rule 70a or Rule 161 (see above).

After this, the examiner is not obliged to accept any voluntary amendments. As a precautionary measure, it is recommended to always request oral proceedings, even in the reply to the search opinion.

Rule 137(4) EPC codifies into law that the Applicant must both identify and indicate the basis for every amendment. In case the Examining Division notes a failure to meet either requirement, it may request the correction of this deficiency within 1 month.

Finally, Rule 137(5) EPC expressly forbids claim amendments that cover subject matter not searched under Rule 62a or Rule 63 EPC as presented above.

7. Changes to the grant procedure (Rule 71 and Rule 71a EPC)

Former practice

Until 1 April 2012, R.71(3) stipulated that the Applicant had to file a translation of the claims in the two other official languages of the EPO and pay the fees within a period of 4 months. By filing of the translations and paying the fees, the Applicant implicitly approved the text for grant.

While this practice is simple if the Applicant approves the text as provided with the communication under R.71(3) (Text intended for grant), it is less adapted to cases where the Applicant wishes to file amendments. In such a case, he had to provide the amendments and their translation without having certainty that these amendments were allowable. If the amendments were not allowed or at least all allowed, he also needed to provide correspondingly amended translations.

Changes as of 1 April 2012 and practical implications

Former R.71(3)-(11) have been replaced by R.71(3)-(7) and added R.71a(1)-(6) EPC with the aim to also simplify the procedure if the Applicant actually wants to make amendments.

In fact, if the Applicant does not wish to make amendments and he thus approves the text intended for grant, the former practice will not change: he will only need to file the required translations and to pay the fee for grant and publishing within the same period of 4 months (R.71(3) and (5) EPC).

If, on the other hand, he does not approve the text as intended for grant, he does not pay the fee and does not file the translations, but instead he files a reasoned response by requesting the amendment (and/or correction) of the communicated text or even by keeping the latest version of the text submitted earlier.

If the Examining Division approves all the amendments and/or corrections, it will issue a new R.71(3) communication with again a 4 month time limit to pay the fees and file the translations. If not, the Examining Division will resume the examining proceedings (amended R. 71(6) EPC).

R.71a(1)-(6) EPC concern the conclusion of the grant procedure after agreement on the text for grant has been reached.

OFFICE FREYLINGER PROPOSES TO:

- check whether the claims respond to the requirements of the EPC with respect to potential multiple independent claims in the same category and unity of invention and, upon request, provide advice on possible amendments;
- make you aware of the compulsory response to the search report and prepare an appropriate reply within the time limit based on your comments and instructions;
- remind you to forward all relevant documents to us as early as possible if we were not in charge of the case during the international phase; and
- study the application and any objections raised in order to prepare a suitable response in reply to the Rule 161 EPC communication.

Do not hesitate to contact us for additional information or documentation.

Decision of the Administrative Council of 25 March 2009 (CA/D 3/09) and of 26 October 2010 (CA/D 2/10)
 Legislative changes:
 Rule 62a, Rule 63, Rule 70a, Rule 137 [Entry into force: 1 April 2010]
 Rule 71, Rule 71a [Entry into force: 1 April 2012]