

## Amendments to the EPC: International Applications Entering the European Regional Phase - Consideration of Unity by the European Patent Office

An amended version of the European Patent Convention, EPC 2000, entered into force on 13 December 2007.

The Implementing Regulations (Rules) accompanying the EPC were also revised involving some further substantial amendments. One of the most significant amendments relates to International (PCT) applications entering the regional phase at the European Patent Office (EPO) which are found by the EPO to lack unity. This amendment governs all PCT applications pending at the time of the EPC 2000 entry into force in addition to all PCT applications filed on or after that time. It applies to all pending European regional phase applications for which the EPO finds a lack of unity and had not issued an invitation to pay further search fees by the time of the EPC 2000 entry into force.

### SUMMARY OF PREVIOUS SITUATION

Under previous practice, where the EPO found that a European regional phase application lacked unity, the applicant always had the opportunity to request (and pay for) searches in respect of any of the inventions identified.

This meant that an applicant could always choose which invention claimed in its International application to pursue at the EPO, irrespective of what happened during the International phase.

#### Changes under EPC 2000

**EPC 2000 removes this opportunity to request further searches in the regional phase at the EPO.**

Instead, examination of a European regional phase application will only be based on either:

(1) **the invention appearing first in the claims at the time of the supplementary European search<sup>1</sup>**, where an authority other than the EPO carried out the International search - the applicant may amend the claims to ensure that the invention it wishes to pursue appears first in the claims either on entering the regional phase at the EPO, or in response to the invitation to file amended claims that is issued by the EPO shortly after regional phase entry; or

(2) **one invention that was searched during the International phase<sup>1</sup>**, where the EPO carried out the International search - the applicant will be invited to choose one invention for examination where more than one invention was searched during the International phase.

#### Action required by applicants

The applicant, therefore, has to consider which invention it wishes to pursue in the European regional phase at the time of:

(1) **regional phase entry** (or shortly thereafter), where an authority **other** than the EPO was responsible for the International search, by ensuring that the invention of choice appears first in the claims (either on entry to the European regional phase or in response to the EPO invitation to file amended claims); or

(2) **the International search**, where the **EPO** is responsible for the International search, by ensuring that the invention of choice (or all inventions which it might wish to choose from) are searched.

Accordingly, the timing for this decision is earlier than applicants have been used to, particularly so in cases where the EPO handles the International search.

#### Further consequences

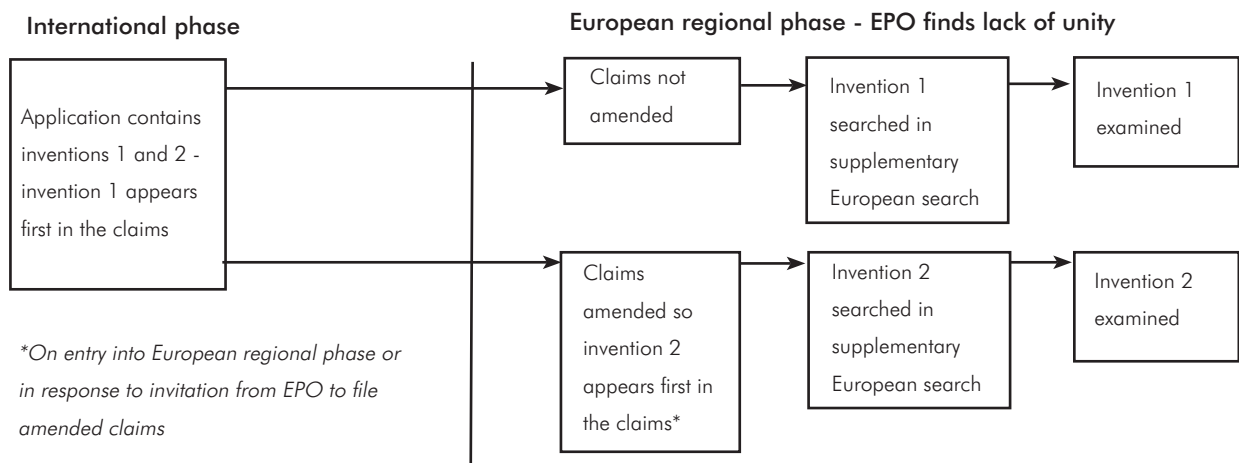
An applicant can take action at the appropriate time, as indicated above, only where it is aware that the application may lack unity, for example, where a lack of unity is raised in the International search report.

However, where an authority other than the EPO carried out the International search, a lack of unity objection may arise for the first time in the European regional phase.

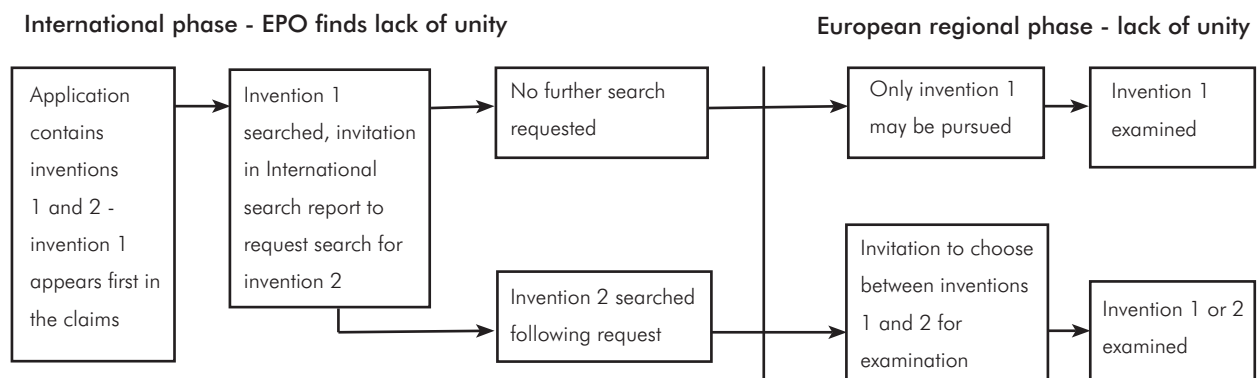
In such a scenario, without any forewarning from the International search stage, an applicant is left with only one option for the European regional phase application, which is to pursue the invention first mentioned in the claims as determined by the EPO<sup>1</sup>.

We recommend, therefore, that applications for which an authority other than the EPO carried out the International search are reviewed by a European Patent Attorney at the time of entry into the regional phase at the EPO. Action may then be taken as necessary to ensure that the subject matter of greatest interest appears first in the claims.

**(1) European regional phase applications where an authority other than the EPO handles the International search**



**(2) European regional phase applications where the EPO handles the International search**



<sup>1</sup>In each case, other invention(s) may still be pursued in divisional application(s). As was previously the case, if the lack of unity objection is successfully argued against during examination, then all unified subject matter may then be pursued in the same application.

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**London**  
33 Gutter Lane  
London  
EC2V 8AS  
Tel: 020 7776 5300  
Fax: 020 7776 5399

**Bristol**  
22-24 Queen Square  
Bristol  
BS1 4ND  
Tel: 0117 945 1234  
Fax: 0117 926 5692

**Manchester**  
Bridgewater House  
Whitworth Street  
Manchester M1 6LT  
Tel: 0161 247 7722  
Fax: 0161 247 7766

**Cambridge**  
Newham House  
Cambridge Business Park  
Cambridge CB4 0WZ  
Tel: 01223 420383  
Fax: 01223 423792