

New Rules at the EPO

The EPO has recently announced a number of new rules which will enter into force on 1 April 2010. As well as restrictions on the filing of divisional applications, reported separately, the new rules place formal restrictions on the number of claims which will be searched, in an attempt to force applicants to file applications having only a single independent claim in each category at the outset. The new rules also make it compulsory to address objections raised during an EPO search at an earlier stage, and reduce the opportunities for voluntary amendments.

Search restrictions

Multiple independent claims

The EPO allows only a single independent claim in each category (product, process, apparatus, use), except under certain limited circumstances (Rule 43(2) EPC). Under current practice, objections under this rule are dealt with during examination.

A newly introduced rule (Rule 62a) makes compliance with this requirement necessary at a much earlier stage i.e. before the search is carried out by the EPO. If the EPO considers that the requirements of Rule 43(2) are not met, it will invite the applicant to indicate which independent claims (one per category) should be searched. If no reply is given, only the first independent claim in each category will be searched.

Incomplete search

At present, if the EPO considers that the claims are too broad or unclear, it may refuse to perform a complete search. If this situation arises, the EPO makes a declaration that no meaningful search can be performed or issues a partial search report.

Under new Rule 63, if the EPO considers that a full search cannot be made it will first issue a communication inviting the applicant to file a 'statement' indicating the subject-matter to be searched. If the statement is not filed, or is considered deficient, a declaration or partial search will then be issued, as before.

Effect of the restrictions

Subject matter which has not been searched due to the above rules will not be examined. It will have to be removed from the application, unless the examiner can be convinced that the refusal to search it was not justified.

The formal restriction on multiple independent claims is independent of any consideration of unity of invention. It is not possible to pay further search fees in order to have other independent claims searched.

Amendments to the claims during examination will also be restricted, since amendments may not relate to unsearched subject matter, including subject matter which was excluded from the search under these new rules. There is therefore a risk that the right to prosecute subject matter from additional independent claims which the EPO has refused to search will

effectively be lost (unless a divisional application is filed, the opportunity for which will be restricted by the new rules).

Reviewing the claims which are to be searched and amending, if necessary, before the search may therefore be advisable. Ideally, a single independent claim in each category should be filed, which is either a broad overarching claim encompassing the subject matter of all of the independent claims or, if this is not possible, a claim including several alternatives. We can advise on this for particular cases if required.

- *Amendment of direct EP applications*

There is no opportunity to amend the application before the search report is issued; review of the claims to prepare for EPO search should therefore be done before filing.

- *Amendment of Euro-PCT applications (EPO not ISA)*

For these applications a supplementary European search is performed; the above rules will also apply to this supplementary search. The claims can be amended on entry to the European regional phase; there is then a single further opportunity to amend the claims before the European supplementary search, within a short deadline.

- *Amendment of Euro-PCT applications (EPO was ISA)*

No supplementary European search is performed and so the new rules will not apply directly to these applications. The EPO will enforce restrictions on independent claims and the scope of the claims in examination, however.

Responding to objections raised during an EPO Search

Direct EP applications – responding to the European Search Opinion

The European Search Report is accompanied by a Search Opinion, which is the preliminary view of the examiner on the patentability of the claims as filed. Up to now, it has not been necessary to respond to this Search Opinion, although it is possible to file amendments and/or arguments in response. If no response is filed, the first examination report merely refers to the Search Opinion.

Under the new rules, however, it will be mandatory to reply to the Search Opinion by correcting the deficiencies noted therein, or by commenting on the points raised. Such a response must be filed by the deadline for requesting examination (6 months

from publication of the search report). Failure to respond will result in the application being deemed to be withdrawn.

Euro-PCT applications (EPO was not ISA) – responding to the Supplementary European Search Report (SESR)

For Euro-PCT applications for which the EPO was not the ISA, a response to the SESR and Search Opinion, with amendment and/or comment, will likewise be mandatory. The deadline will be the end of the period specified for indicating whether the application is to proceed to examination. The EPO have indicated that this period will be set to be the same as for direct applications (i.e. 6 months from invitation). Failure to respond will result in the application being deemed to be withdrawn.

Euro-PCT applications (EPO was ISA) - responding to the WOISA/IPRP

For international applications for which the EPO was the ISA or the IPEA, no supplementary European Search Report is issued.

Under the new rules, an invitation to respond to the WOISA or, if a demand was filed, to the IPRP, will be issued shortly after entry to the European regional phase. If no reply is filed in due time, the application will be deemed withdrawn.

The time limit for responding to this invitation is quite short (one month). Failure to respond in time will result in the application being deemed to be withdrawn. This short deadline means that it will be advisable to start preparing comments and/or amendments in light of the WOISA before the invitation is issued i.e. before or shortly after entering the regional phase.

However, if claim amendments and/or comments which address the objections raised in the WOISA have been filed in the international phase, it is possible that no further response will be required by the EPO (provided that these claims amendments are maintained on entry into the European regional phase and have not already been considered by the EPO as the ISA or IPEA).

Similarly, a further response may not be required if amended claims and arguments, addressing the WOISA objections, are filed on entry to the European regional phase.

Other changes

Amendments – identification of basis

The new rules introduce an explicit requirement to identify any amendments made, and the basis for them in the application as filed. If this is not done when the amendment is made, the applicant will be invited to remedy this deficiency within one month.

This new rule is unlikely to change practice very much: generally speaking, we already identify the amendments made and basis for them when filing them at the EPO.

Amendments – removal of an opportunity for voluntary amendment

The new rules have also removed one opportunity for the applicant to make voluntary amendments. At present, amendments can be made as of right between receipt of the search report and the first examination report, and also in response to the first examination report. Under the new regime, the applicant will be able to make voluntary amendments when responding to the Search Opinion or WOISA, as described above, but permission for any further amendments will be at the discretion of the EPO.

Entry into force

The new rules will come into force on 1 April 2010. This will affect existing applications as follows:

- *Direct EP applications* - The search restrictions and the requirement to reply to the extended Search Report will apply to all applications for which the European search report is drawn up on or after 1 April 2010.
- *Euro-PCT applications (EPO was not ISA)* - The search restrictions and requirement to reply to the supplementary European search report (SESR) will apply to all applications for which the SESR is drawn up on or after 1 April 2010.
- *Euro-PCT applications (EPO was ISA)* - The invitation to respond to the WOISA and IPRP will be issued for all Euro-PCT applications for which a communication under current Rule 161 (inviting amendment of the claims) has not yet been issued on 1 April 2010.

Given the usual timescale for searching at the EPO, this means that the new rules may apply to applications already awaiting search at the EPO, as well as to applications filed at or entering the EPO from now on.

If you would like further advice about how the new rules may affect you, please contact us.

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