

Changes to EPC Implementing Regulations

In Administrative Council Decisions CA/D 2/09 and 3/09, the EPO has recently announced significant changes to the EPC implementing regulations, which will likely affect the applicant's practice in filing and prosecuting EP applications. The new provisions will enter into force on **1 April 2010**.

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(1) Divisional Applications

According to amended Rule 36 EPC, the EPO will introduce a cut-off date for the filing of voluntary divisional applications, which will need to be filed:

- *within 24 months from the first examination report issued on the parent application (in the case of a sequence of divisionals, the first examination report in any application of the sequence will trigger the time limit for all of them); or*
- *within 24 months from a non-unity objection raised for the first time in an examination report.*

These time limits will not be extendable. If a time limit is missed, the only remedy will be a request for reestablishment of rights.

The new provision will apply to the filing of divisional applications on or after 1 April 2010. If a Rule 36 time limit expires before 1 April 2010, a divisional application may still be filed within six months, i.e. up to 1 October 2010. If a Rule 36 time limit is running on 1 April 2010, it will continue to do so for not less than six months.

Applicants should review the status of their pending EP applications and, if voluntary divisional applications may be required, they should consider filing divisionals by 1 October 2010. This deadline is final if the first examination report was issued on the earliest application of the sequence on or before 1 April 2008.

(2) Plurality of Independent Claims, and Clarity and Conciseness of the Claims

Applicants will be invited to comply at the search stage with the requirements of clarity and conciseness of the claims, and in particular:

- *the EPO search will be focused on only one independent claim per category; and*
- *in the case of "complex applications", applicants will be invited to clarify the subject-matter to be searched.*

As concerns multiple independent claims, Rule 43(2) EPC provides, with few exceptions, that a European patent application may not contain more than one independent claim in the same category (product, process, apparatus or use). Currently, compliance with these requirements is examined only at the substantive examination stage.

According to new Rule 62a EPC, in cases where Rule 43(2) EPC is not complied with, at the search stage the EPO will invite the applicant to elect, within a two-month period, one independent claim per category on which the search is to be carried out. In the absence of a timely reply, only the first independent claim in each category will be searched. Substantive examination will then be carried out only on the searched subject-matter; any unsearched claims will need to be deleted, possibly to be pursued by filing a divisional application.

Applicants should adopt the practice of drafting a minimum number of independent claims for European patent applications, or amending the claims accordingly when entering the EP phase of a PCT application (any deleted claims should be copied in the description for possible future use).

According to amended Rule 63 EPC, in the case of "complex applications", that is applications lacking support, clarity or conciseness to such an extent that no meaningful search of the prior art is possible, applicants will be invited at the search stage to submit a statement clarifying the subject-matter to be searched, e.g. by indicating specific embodiments which may be used to interpret the claims or by supplying improved claim wording. If the applicant does not submit a timely statement, or if such statement is not considered sufficient to overcome the deficiencies, the search examiner will issue a reasoned declaration that a search is not possible, or a partial search report. At the Examination stage, the applicant will be invited to restrict the claims to the searched subject-matter.

The new provisions will apply to European patent applications for which the European search report or the supplementary European search report is drawn up on or after 1 April 2010.

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(3) Mandatory Response to the Extended European Search Report

According to new Rule 70a EPC, applicants will be required to submit a response to the extended European search report in the period for filing the request for examination, i.e. up to six months after the publication of the European search report.

A response will also be mandatory in case of supplementary European search report drawn up in a Euro-PCT application, and the response will have to be filed within the period for indicating the applicant's intention to proceed further with the application.

The above will be the only opportunity for applicants to amend the description and claims of their own volition; later amendments will only be made with the Examiner's consent. If the deadline is missed, "further processing" will be available.

The new rule will apply to European patent applications for which the extended European search report or the European supplementary search report is drawn up on or after 1 April 2010.

(4) Mandatory Response to the PCT Report for Applications where EPO acted as ISA or IPEA

Applicants will be invited to reply to the objections raised in Written Opinions or International Preliminary Reports on Patentability issued by the EPO in Euro-PCT applications. According to amended Rule 161 EPC, the reply will have to be filed within a one-month period, triggered by a communication of the EPO.

This will be the only opportunity for applicants to amend the application and claims of their own volition; later amendments will only be made with the Examiner's consent. Failure to respond will result in the deemed withdrawal of the application, but "further processing" will be available.

The new rule will apply to Euro-PCT applications where a communication under current Rule 161 has not been issued before 1 April 2010.

In view of the above changes, when foreign associates or affiliates instruct their European patent attorneys to enter the EP regional phase of a PCT application where the EPO acted as ISA or IPEA, they should also consider providing at the same time detailed instructions for replying to the objections raised in the PCT report; this will facilitate the meeting of the one-month deadline. "Further processing" will be available, in case the deadline is missed.

(5) Identification of Amendments

As is well known, the EPO presently adopts a very strict approach towards "added-matter" and the requirements of Art. 123(2) EPC, according to which an application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. Pursuant to amended Rule 137(4) EPC, it will be mandatory for applicants to identify amendments and explain their basis in the original application. Failure to comply will result in a short deadline (one month) being set for supplying the information; if no response is filed in due time, the application will be deemed withdrawn ("further processing" will be available).

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Main Changes to the EPC Implementing Regulations

RULE 36: EUROPEAN DIVISIONAL APPLICATIONS

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
(1) The applicant may file a divisional application relating to any pending earlier European patent application	(1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that: (a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or (b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82 EPC, provided it was raising that specific objection for the first time
(2) A divisional application shall be in the language of the proceedings for the earlier application and shall be filed with the European Patent Office in Munich, The Hague or Berlin	(2) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin
(3) and (4) unchanged	(3) and (4) unchanged

RULE 57: EXAMINATION AS TO FORMAL REQUIREMENTS

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
If the European patent application has been accorded a date of filing, the European Patent Office shall examine, in accordance with Article 90, paragraph 3, whether: (a) a translation of the application required under Article 14, paragraph 2, or under Rule 40, paragraph 3, second sentence, has been filed in due time;	Unchanged (a) a translation of the application required under Article 14, paragraph 2, under Rule 36, paragraph 2, second sentence , or under Rule 40, paragraph 3, second sentence, has been filed in due time;
(b)-(j) unchanged	(b)-(j) unchanged

RULE 62A EPC: APPLICATIONS CONTAINING A PLURALITY OF INDEPENDENT CLAIMS

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
	(1) If the European Patent Office considers that the claims as filed do not comply with Rule 43, paragraph 2, it shall invite the applicant to indicate, within a period of two months, the claims complying with Rule 43, paragraph 2, on the basis of which the search is to be carried out. If the applicant fails to provide such an indication in due time, the search shall be carried out on the basis of the first claim in each category. (2) The Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified

RULE 63: INCOMPLETE SEARCH

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
If the European Patent Office considers that the European patent application does not comply with this Convention to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed, it shall either issue a reasoned declaration to that effect or, as far as is practicable, draw up a partial search report. The declaration or the partial report shall be considered, for the purposes of subsequent proceedings, as the European search report	(1) If the European Patent Office considers that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched (2) If the statement under paragraph 1 is not filed in due time, or if it is not sufficient to overcome the deficiency noted under paragraph 1, the European Patent Office shall either issue a reasoned declaration stating that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed or, as far as is practicable, draw up a partial search report. The reasoned declaration or the partial search report shall be considered, for the purposes of subsequent proceedings, as the European search report. (3) When a partial search report has been drawn up, the Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified

RULE 70A EPC: RESPONSE TO THE EXTENDED EUROPEAN SEARCH REPORT

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
	<p>(1) In the opinion accompanying the European search report the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period referred to in Rule 70, paragraph 1</p> <p>(2) In the case referred to in Rule 70, paragraph 2, or if a supplementary European search report is drawn up on a Euro-PCT-application, the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period specified for indicating whether he wishes to proceed further with the application</p> <p>(3) If the applicant neither complies with nor comments on an invitation in accordance with paragraph 1 or 2, the application shall be deemed to be withdrawn</p>

RULE 135: FURTHER PROCESSING

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
(1) unchanged	(1) unchanged
(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 64 and Rule 112, paragraph 2.	(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, Rule 36, paragraphs 1(a), 1(b) and 2 , Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 62a, 63, 64 and Rule 112, paragraph 2.1
(3) unchanged	(3) unchanged

RULE 137: AMENDMENT OF THE EUROPEAN PATENT APPLICATION

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
(1) Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application unless otherwise provided.	(1) unchanged
(2) After receipt of the European search report, the applicant may, of his own volition, amend the description, claims and drawings.	(2) Together with any comments, corrections or amendments made in response to communications by the European Patent Office under Rule 70a, paragraph 1 or 2, or Rule 161, paragraph 1, the applicant may amend the description, claims and drawings of his own volition
(3) After receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend once the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division.	(3) No further amendment may be made without the consent of the Examining Division (4) When filing any amendments referred to in paragraphs 1 to 3, the applicant shall identify them and indicate the basis for them in the application as filed. If the Examining Division notes a failure to meet either requirement, it may request the correction of this deficiency within a period of one month
(4) Amended claims may 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.	(5) Amended claims may 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. Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63

RULE 161: AMENDMENT OF THE APPLICATION

<i>Present rule</i>	<i>Rule from 1 April 2010</i>
Without prejudice to Rule 137, paragraphs 2 to 4, the application may be amended once, within one month from a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under Article 153, paragraph 7.	<p>(1) If the European Patent Office has acted as the International Searching Authority and, where a demand under Article 31 PCT was filed, also as the International Preliminary Examining Authority for a Euro-PCT application, it shall give the applicant the opportunity to comment on the written opinion of the International Searching Authority or the International Preliminary Examination Report and, where appropriate, invite him to correct any deficiencies noted in the written opinion or in the International Preliminary Examination Report and to amend the description, claims and drawings within a period of one month from the respective communication. If the applicant does not comply with or comment on an invitation in accordance with the first sentence, the application shall be deemed to be withdrawn</p> <p>(2) Where the European Patent Office draws up a supplementary European search report on a Euro-PCT application, the application may be amended once within a period of one month from a communication informing the applicant accordingly. The application as amended shall serve as the basis for the supplementary European search</p>