

DRAFT EPO GUIDELINES - EARLY ELECTION OF MATTER TO BE SEARCHED - EARLY SEARCH RESPONSES

The EPO has issued draft guidelines concerning the amended rules that will apply to all European applications for which the EPO search report or supplementary search report is drawn up on or after 1 April 2010, and to Euro-PCT applications for which an invitation to amend the application under Rule 161 EPC is issued on or after 1 April 2010. The draft guidelines are available at:

<http://www.epo.org/patents/law/legal-texts/guidelines-2010.html>

(see Part A, Chapter VII, Section 7; Part B, Chapter VIII, Sections 3, 4, 5; Part B, Chapter XII, Sections 1, 2, 9; Part C, Chapter III, Section 3.3, Part C, Chapter VI, Section 3.5; Part C, Chapter VI, Sections 5.6, 5.7)

The amended rules can be seen at:

<http://www.epo.org/patents/law/legal-texts/decisions/archive/20090325a.html>

A related notice can be found at:

<http://www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20091015.html>

The main effects of the amended rules are to require early election of what is to be searched and to require responses to Search Opinions. This may present an opportunity for applicants to prosecute European applications more efficiently and economically. It may present a challenge to applicants in that they may need to make early decisions about their applications.

The draft guidelines set out the different effects the amended rules will have on procedures for direct European applications (i.e. European applications not based on PCT applications) and Euro-PCT applications. The effects on Euro-PCT applications depend on whether the EPO was the International Search Authority (ISA)/International Preliminary Examination Authority (IPEA). The accompanying diagrams outline the procedures, up to the first examination report, which will apply to (1) Direct European applications, (2) Euro-PCT applications for which the EPO was not ISA/IPEA and (3) Euro-PCT applications for which the EPO was ISA/IPEA.

(A) New Rule 62a may represent the most significant change. The EPO can require the applicant, when multiple independent claims in one category are present, to elect only one of those claims for search*. Other independent claims in the category will not be searched. (Claims dependent on the elected independent claim will be searched, at least in connection with the elected independent claim.)

(B) Amended Rule 63 EPC may offer an opportunity for applicants to obtain a useful search report, rather than a negative declaration that no search, or only a partial search, is possible. Amended Rule 63 provides the applicant with an opportunity to identify matter to be searched before a negative declaration is issued.

(C) Amended Rule 64 EPC makes no significant change to procedures in relation to issues of non-unity of invention. For direct European applications the period for requesting additional searches will be two months instead of the present one month term.

The draft guidelines indicate that amended Rules 62a, 63 and 64 may be applied by the EPO in any combination.

New Rule 70(a) EPC and amended Rule 161 EPC make responses to Search Opinions compulsory. For many applicants, compulsory responses to Search Opinions likely will not present a challenge. Many applicants already respond to Search Opinions voluntarily.

[*The presence of multiple independent claim in one category is not always objectionable, though non-objectionable exceptions are restricted. Under Rule 43(2) EPC "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".]

Search Phase

Exam Phase



