Changes to EPO Practice from 1st April 2010

A number of changes to the Rules governing prosecution of European Patent Applications and International (PCT) Patent Applications entering the EPO regional phase (Euro-PCT applications), came into force on 1 April 2010. This note sets out some of the changes and discusses their effect on practice from the applicant's viewpoint.

To which applications do the new rules apply?

As set out in more detail below, the new Rules apply to some European patent applications which were pending on 1 April 2010 as well as to applications filed, or entering the regional phase, on or after this date.

The most important of the new Rules are now discussed in turn.

New restrictions on the filing of divisional applications

Previously, a divisional application could be filed at any time before grant of the parent application. There was also nothing to prevent an applicant filing a divisional application derived from an earlier application which was itself a divisional application, leading to so-called chains of applications.

Under the new Rules, strict time limits were introduced for the filing of divisional applications. They significantly restrict an applicant's opportunities to file divisional applications, in particular chains of divisional applications. Applicants can no longer wait until an application nears grant before deciding whether to file a divisional application, but have to make such decisions at a much earlier stage during prosecution.

Under the new Rules, a divisional application must still be filed whilst the parent application is pending. In addition, it must be filed within 24 months from the first communication by the EPO examining division concerning the parent application or any earlier application in the chain (if the parent application is itself a divisional application), or within 24 months from a communication in which a specific non-unity objection is raised for the first time by an EPO examining division, if that period expires later.

No extension of these time limits is possible, and further processing is not available.

The new time limits do not start to run until a communication issues from an EPO examining division. Non-unity objections raised during the search phase or in the international phase do not therefore start the non-unity time limit running; this time limit only starts to run if an EPO examining division later agrees that there is a lack of unity. Entering the regional phase on or after 1 April 2010, applicants are advised to work to a notional deadline of two years from regional phase entry for filing any divisional application, to ensure that decisions regarding filing of any divisional applications are taken well before the actual deadline expires.

These new Rules apply to all divisional applications filed on or after 1 April 2010.
New restrictions on the number of independent claims which will be searched

Previously, the EPO could raise an objection of lack of clarity during examination if an application contained more than one independent claim in the same claim category unless one of the following exceptions applied: (a) the claims relate to a plurality of interrelated products, (b) the claims relate to different uses of a product or apparatus, or (c) the claims relate to alternative solutions to a particular problem and it is not appropriate to cover these alternatives in a single claim.

Under the new Rules, if the EPO finds that an application contains more than one independent claim in the same category and none of the above exceptions applies, then it will not search all the independent claims in that category. Instead, it invites the applicant to indicate within a period of two months which independent claim should be searched, or to explain how one of the above exceptions does in fact apply, failing which the EPO will only search the first such claim in each claim category.

Examination can then only be based on the independent claim(s) which have been searched. No amendment of the claims are allowed in response to the invitation, and later amendment during prosecution to include the unsearched claims are prohibited.

Applications may still contain a number of independent claims provided that they are in different claim categories (product, process, medical use etc), or that they fall within one of the specific exceptions outlined above. Applicants are advised to include only one independent claim in each claim category when drafting new applications, and to use multiple claim dependencies to ensure that all possible combinations of preferred features are covered by the dependent claims as filed. Using multiple claim dependencies will also provide basis under EPO practice for combining the features of different dependent claims if required during prosecution.

The new Rule applies to all EP applications where the European Search Report or Supplementary European Search Report had not issued on 1 April 2010. A Supplementary European Search Report is issued on all Euro-PCT applications for which the EPO was not the International Search Authority.

Incomplete Searches

Previously, if the EPO considered that an application failed to such an extent to comply with the provisions of the EPC that it was impossible to carry out a meaningful search, it either issued a reasoned declaration to that effect or, if practicable, drew up a partial search report.

Under the new Rules, the EPO gives applicants an opportunity to comment at this stage rather than automatically issuing a declaration or a partial search report. Thus, if the EPO considers it is impossible to carry out a meaningful search it invites the applicant to indicate, within a period of two months, what subject-matter should be searched. No amendment of the claims is allowed at this stage: the applicant is simply able to indicate what subject matter should be searched.

If no response is filed to this invitation, or the response is insufficient to overcome the deficiencies which led to issue of the invitation, the EPO will issue a declaration or partial search report as previously.
Examination can then be based only on the subject matter which was searched: later amendment to claim unsearched subject matter is prohibited.

The new Rule applies to all EP applications where the European Search Report or Supplementary European Search Report had not issued on 1 April 2010.

Mandatory Response to the Extended European Search Report or Supplementary European Search Report

Previously, Search Reports on European patent applications and Supplementary European Search Reports on Euro-PCT applications are accompanied by a preliminary opinion on both formal and substantive issues. There was no obligation to respond to the search opinion, and many applicants purposely chose not to do so but to instead await issue of a communication from the Examining Division. If the objections had not been dealt with in the meantime, the first Communication from the Examining Division normally simply referred back to the search opinion and invited the applicant to respond to any objections raised therein.

Under the new Rules, applicants are invited to file a response to the search opinion. If no response is filed, the application is deemed to be withdrawn. Applicants are therefore obliged to respond to the objections in the search opinion before the substantive examination formally takes place.

The new Rule applies to all applications where the Search Report or Supplementary European Search Report had not issued before 1 April 2010.

For a direct European filing, the deadline for replying to the search opinion is the same as the deadline for requesting examination (i.e. within six months from mention of publication of the search report in the European Patent Bulletin). Further processing of this deadline is available.

For a Euro-PCT application, the time limit for filing a response to the Supplementary Search Report is the same as the time limit for confirming that the applicant wishes to proceed with examination. The invitation to so confirm normally issues very soon after issue of the Supplementary Search Report, and a six month period is set for confirming that the applicant wishes to proceed with examination and filing a response to the Supplementary Search Report. Further processing of this deadline is available.

Mandatory Response to the Written Opinion of the EPO as ISA

Previously, in respect of all Euro-PCT applications, the EPO issued a Communication under Rule 161 shortly after regional phase entry inviting the applicant, if desired, to amend the application before commencement of prosecution. European prosecution was then based on the application as amended.

Under the new Rule 161, the EPO continues to issue such a communication on all Euro-PCT applications where a Supplementary Search Report is to be drawn up (i.e. all Euro-PCT applications where the EPO was not the ISA). If amended claims are filed, the supplementary search is based on the claims as amended. If no amended claims are filed, the supplementary search is based on the claims existing on regional phase entry (subject to the provisions regarding the number of independent claims which will be searched referred to above).
For Euro-PCT applications where the EPO acted as ISA, the Communication under new Rule 161 invites the applicant to respond to any objections raised in the Written Opinion of the ISA, or the IPRP if a Demand was filed and the EPO was also the IPEA, within a period of **six months**, although further processing of this deadline is available.

A response to the Rule 161 Communication is only obligatory if no response and/or amendments to the application were filed after issue of the written opinion/IPRP, during the International phase or on regional phase entry. This new Rule 161 applies to all Euro-PCT applications where a Communication under current Rule 161 had not issued before 1 April 2010.

**Restrictions on Voluntary Amendment**

Previously, applicants had the right to make voluntary amendments to an application after receipt of the European Search Report and again after receipt of the first communication from the examining division. Subsequent amendments could only be made with the consent of the examining division.

Under the new Rules, the right to make voluntary amendments to an application is restricted. Thus, applicants only have the right to make voluntary amendments to an application when replying to the search opinion or the Communication under Rule 161. Any amendments at a later stage in the proceedings can only be made with the consent of the examining division. Applicants will also be expected to explicitly identify all amendments being made, together with their basis in the application as originally filed. If either requirement is not met, the EPO may request correction of the deficiency with a one month period.

The new Rule regarding amendments applies to all EP applications where the European Search Report or Supplementary European Search Report had not issued on 1 April 2010.

**Further information**

For further information on the above changes, please contact either Dr Annabel Beacham or your usual contact using the details below.