

CLIENT INFORMATION SEPTEMBER 2009

Amendments to the Implementing Regulations to the EPC

The Administrative Council of the European Patent Organisation has decided to amend the Implementing Regulations to the European Patent Convention (EPC)¹. The amendments will enter into force on 1 April 2010. The intention is to streamline the procedures before the EPO with regard to filing of divisional applications, searches carried out by the European Patent Office (EPO), replies to extended European search reports, and amendments to Euro-PCT applications.

The consequence of the amendments to the Implementing Regulations is that in future, the Applicant has to decide earlier to which part of the application the search and the examination are to be limited.

Term for Filing Divisional Applications

At present, a divisional application can be filed of any European patent application (which may be a divisional application itself) as long as the European patent application is still pending (i.e. not granted or rejected). This right is now severely restricted.

According to amended Rule 36 EPC, Applicants need in future get accustomed to a term of 24 months from the first examination communication as a time limit for a divisional application. The term for all further generations of divisional applica-

tions is also calculated on the basis of the date of the first examination communication issued in the parent application.

A further possibility for filing a divisional application still exists only in those cases in which the Examining Division raises an objection as to unity for the first time on a later date. Such an objection then opens a new time frame of 24 months for filing a divisional application.

The further processing after expiration of the 24-month term is excluded in both cases (Rule 135 EPC has been amended accordingly).

Amended Rule 36 EPC affects all currently pending and future European patent applications. For European patent applications for which the first examination communication was issued prior to 1 October 2008, the transitional date of 1 October 2010 shall apply as a last possible date for filing a divisional application. For all first examination communications issued on a later date, the 24-month term shall apply.

Subject Matter of the European Search in Case of Several Independent Claims in One Category

Rule 43 (2) EPC stipulates that several independent claims in the same category are only allowed if they relate to a plurality of interrelated products, to different uses of a product or apparatus, or to alternative solutions to a particular problem.

¹ Decisions CA/D 2/09 and CA/D 3/09 of 25 March 2009

In case a European patent application includes several independent claims in the same category (product, process, apparatus or use) which meet the requirements as to unity of Art. 82 EPC but violate Rule 43 (2) EPC, the EPO—in derogation from previous practice—will in future no longer carry out the search on the basis of all of these claims.

According to new Rule 62a EPC, as from 1 April 2010, the Applicant is requested to indicate within a term of two months on which claims the search is to be based. If the Applicant fails to make such an indication, the search is carried out on the basis of the first claim for each category. There is no possibility to have the search based on further claims by paying additional search fees.

Mandatory Response to the Extended European Search Report

At present, it is left to the applicant's discretion to respond to the Extended European Search Report (EESR).

According to new Rule 70a EPC, a response to the EESR is mandatory, although at that time examination has usually not even been requested. As from 1 April 2010, the EPO will request the Applicant to remedy the deficiencies cited in the EESR within the term for filing the examination request (six months after publication of the search report). In case the Applicant fails to respond to this request, the application shall be deemed to be withdrawn.

If the examination request was already filed before the communication of the search report, the EPO will invite the Applicant to declare whether he wishes to proceed further with the application. The response to the EESR has then to be made within the term set in this invitation.

The same applies to Euro-PCT applications on which a supplementary EESR has been drawn up.

Amendments to Euro-PCT Applications

A further constraint results from amended Rule 161 EPC for Euro-PCT applications for which the EPO has acted as the International Searching Authority (ISA) or as the International Preliminary Examining Authority (IPEA) in the international phase. In the regional phase of these applications, the EPO will in future invite the Applicant to comment on the International Search Report or the International Preliminary Examination Report and to remedy the deficiencies found.

The term for these comments is only one month. In case no comments are submitted, the application shall be deemed to be withdrawn.

Therefore, it is in future advisable to deal with the objections raised by the EPA acting as ISA or IPEA in good time, preferably already before entering the European phase, in order to avoid any time pressure.

Amended Rule 161 shall apply to all Euro-PCT applications for which a notification according to previous Rule 161 has not been issued before 1 April 2010.

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Should you consider it appropriate to take action based on our information, we recommend that you contact us for a detailed legal consultation in which all circumstances of a particular case can be taken into account.

Any questions you may have in connection with the topic of this newsletter will be gladly answered by Jürgen Strass (J.Strass@prinz.eu).

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