

## EFFECTS OF THE NEW RULES NOW IN FORCE AT THE EPO FOR EUROPEAN REGIONAL PHASE PATENT APPLICATIONS – EPO CARRIED OUT THE INTERNATIONAL SEARCH

New rules at the EPO entered into force on 1 April 2010. As we have reported previously, these new rules place restrictions on the subject matter that will be searched by the EPO and require objections raised by the EPO to be addressed at an earlier stage in the proceedings before the EPO.

Here we set out the changes in procedure for international (PCT) applications entering the regional phase at the EPO where the international search was carried out by the EPO. We also set out the practical consequences of these changes for prosecuting these applications at the EPO.

We recommend early review of applications being filed at the EPO to allow appropriate preparation and action to be taken in time, which will be key to effectively managing these applications under the new rules.

### What is the new procedure?

- **Mandatory response to objections raised by the EPO in the international phase within a short time limit set soon after regional phase entry**

The EPO's "Communication under Rule 161" generally issues soon after the application enters the regional phase at the EPO. Under the new rules, this communication is also an invitation to file comments and/or amendments addressing objections raised by the EPO in the written opinion (WO/ISA, and repeated in the international preliminary report on patentability, IPRP/Chapter I) or, if a demand for international preliminary examination was filed, in the international preliminary report on patentability (IPRP/Chapter II).

The communication sets a **one month time limit** for response. This time limit is **not extensible**. If comments and/or amendments addressing the objections are not filed in time, the application will be deemed to be withdrawn, although more time for filing a response is available by using "further processing" at additional cost.

If, however, comments and/or amendments addressing the objections have already been filed earlier (in the international phase and then maintained on entry into the regional phase, or on entry into the regional phase), then it is expected that these will be deemed to be a relevant response.

If there are no objections in the WO/ISA or IPRP then a response is not required.

- **Last opportunity for voluntary amendment**

This **one month time limit** for response is also the last opportunity to file voluntary amendments.

After this time, the Applicant no longer has the right to file voluntary amendments, with any later-filed amendments requiring the consent of the Examining Division. With the overall stated aim of the new rules being to make examination of applications more efficient, we may expect Examining Divisions to be less willing to consent to later voluntary amendments.

- **Amendments and their basis in the application as filed must be identified**

Where amendments are filed and the EPO considers that this requirement is not met, under the new rules it may invite the Applicant to correct the deficiency.

The invitation sets a **one month time limit** for response. This time limit is **not extensible**. If the deficiency is not corrected in time, the application will be deemed to be withdrawn, although more time for filing a response is available by using "further processing" at additional cost.

- **Payment of claims fees due**

The claims on file at the EPO at expiry of this one month time limit determine how many claims fees are payable at this time. Claims fees are payable where there are more than 15 claims. This requirement is unchanged under the new rules.

### What are the effects in practice?

- Action is required at a significantly earlier stage in proceedings before the EPO and within a much shorter time limit than Applicants are used to, and must take account of both the EPO's view and the Applicant's requirements for the application

There is therefore only a short period of time after entering the regional phase at the EPO in which to consider and prepare (i) comments and/or amendments addressing objections raised by the EPO in the WO/ISA or IPRP, and (ii) any voluntary amendments, especially of the claims, to ensure that the application is directed to the desired subject matter.

In preparing amended claims, careful attention to the number of claims is also required to avoid the cost of claims fees becoming prohibitively high.

Use of "further processing" to gain more time for filing amended claims and paying the corresponding claims fees may also be prohibitively costly in view of the 50% surcharge for claims fees.

### What action should Applicants now take?

- Early review of the EPO's objections in the WO/ISA or IPRP and early consideration of voluntary amendments:  
preferably by the time the application enters the regional phase
- Early preparation of comments and/or amendments for response to the objections and/or of voluntary amendments:  
preferably to accompany instructions for entering the application into the regional phase, rather than waiting for the one month time limit for response to be set

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

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