

EFFECTS OF THE NEW RULES NOW IN FORCE AT THE EPO FOR EUROPEAN REGIONAL PHASE PATENT APPLICATIONS – AN AUTHORITY OTHER THAN THE 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 an authority other than the EPO such that the EPO will carry out a supplementary European search. 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.

BEFORE THE SUPPLEMENTARY EUROPEAN SEARCH

What is the new procedure?

Under the new rules, search restrictions applicable to the supplementary European search mean that certain requirements must be met before the EPO carries out the search. There are three ways in which the EPO will try to restrict its search:

- **1 Only a single independent claim in each category**

The EPO allows only a single independent claim in each category (product, process, apparatus or use), except under certain limited circumstances. Where the EPO considers that this requirement is not met, it will invite the Applicant to indicate which one independent claim for each category should be searched.

The invitation sets a **two month time limit** for response. This time limit is **not extensible** and “further processing” is not available. If the Applicant does not reply, the EPO will search only the first independent claim in each category.

It is possible to challenge such an objection, either in reply to the invitation or during examination. If the challenge is successful, the EPO will not limit the search.

- **2 Incomplete search – claims too broad or unclear**

Where the EPO considers that claims are too broad or unclear for a meaningful search to be carried out, it will invite the Applicant to file a statement indicating the subject matter to be searched.

The invitation sets a **two month time limit** for response. This time limit is **not extensible** and “further processing” is not

available. If a statement is not filed or is not deemed sufficient, the EPO will either not carry out a search or will search only part of the claimed subject matter.

It is possible to challenge such an objection, either in reply to the invitation or during examination. If the challenge is successful, the EPO will carry out a complete search.

- **3 Independent consideration of unity of invention**

The formal review of the claims at 1 and 2 above is independent of consideration of unity. Where the EPO finds that the claims lack unity, it will carry out the search only on the basis of the invention appearing first in the claims. The EPO does not allow the Applicant to pay for an additional search. This partial search will be done without warning by the EPO and applies even if there was no lack of unity objection in the international phase, and the lack of unity objection is raised for the first time by the EPO at this stage. This possibility is unchanged under the new rules.

What are the effects in practice?

- **Possible loss of the right to pursue subject matter in the application**

Subject matter that has not been searched will not be examined. There is therefore a risk that subject matter of claims which the EPO has excluded from the search will be lost for the application. Unsearched subject matter may be pursued only in a divisional application, noting that the new rules also impose time limits for filing divisional applications (please see our separate information sheet on the new rules for divisional applications).

What action should Applicants now take?

- Review claims before the search
- Amend claims if necessary to ensure:
 - (i) there is only a single independent claim in each category; and
 - (ii) that the most important subject matter appears first in the claims

Where there are multiple independent claims in a category, consider amending to a single claim, for example, by combining alternatives in a single claim or making one claim dependent on another, as applicable.

Even if no lack of unity was found in the international phase, consider re-ordering or amending the claims such that the most important independent claim appears first in the claims, or if a claim recites alternatives, that the most important alternative appears first in the claim.

The EPO's "Communication under Rule 161" inviting the Applicant to file amendments, especially of the claims, is unchanged for these applications where the EPO carries out a supplementary search. The communication generally issues soon after the application enters the regional phase at the EPO and sets a one month time limit for response.

Amended claims may therefore be filed on entering the regional phase or up until expiry of this one month time limit. The claims on file at expiry of this time limit form the basis of the supplementary European search and determine how many claims fees are payable at this time, which is unchanged under the new rules.

AFTER THE SUPPLEMENTARY EUROPEAN SEARCH

What is the new procedure?

- **Mandatory response to objections raised by the EPO during the supplementary European search**

Under the new rules, the EPO invites the Applicant to file comments and/or amendments addressing objections raised by the EPO in the European search opinion which accompanies the supplementary European search report (together called the extended European search report).

The time limit for response is the **six month time limit** set for the Applicant to indicate that the application is to proceed further. 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 there are no objections in the European search opinion then a response is not required.

- **Last opportunity for voluntary amendment**

This **six 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.

What are the effects in practice?

- **Action is required at an earlier stage in proceedings before the EPO than Applicants are used to, and must take account of both the EPO's view and the Applicant's requirements for the application**

Already at the search stage, therefore, Applicants must consider and prepare (i) comments and/or amendments addressing objections raised by the EPO in the European search opinion, and (ii) any voluntary amendments, especially of the claims, to ensure that the application is directed to the desired subject matter. Note that amended claims filed at this stage may not relate to unsearched subject matter.

What action should Applicants now take?

- **Early review of the EPO's objections in the European search opinion and consideration at the same time of voluntary amendments**
- **Preparation of comments and/or amendments for response to the objections and/or of voluntary amendments in good time within the six month time limit for response**

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

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