

Briefing

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EUROPEAN PATENT CONVENTION: NEW IMPLEMENTING RULES



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On 1 April 2010 amended Implementing Rules to the European Patent Convention (EPC) have entered into force. The amendments relate to the filing of divisional applications, to multiple-independent claims, to "complex applications" and to responses to the so-called "Extended European Search Report" (EESR). The new rules will significantly change the daily work of patent practitioners and should be kept in mind when drafting and prosecuting European applications and international PCT applications that enter the regional European phase (so-called "Euro-PCT" applications) before the European Patent Office (EPO).

I. Time limit for divisional applications

This amendment will probably have the most influential effect on applicants' filing and prosecution strategy. It is no longer possible to file a divisional application at any time during pendency of a parent application. An application is pending if it is not (deemed) withdrawn or refused, and, if it is allowable, up to but not including the date on which the mention of the grant is published under Article 97(3) EPC in the European Patent Bulletin.

Under amended Rule 36 EPC now two requirements must be met when filing a divisional application:

- (i) the earlier application must be **pending**
 - and
 - (ii) for a **voluntary division** the divisional application must be filed before the expiry of a time limit of **24 month** from the Examining Division's first substantial official action under Article 94(3) EPC in respect of the earliest application (Note: "earliest" refers to the first "parent application" within a sequence of divisionals)
- or
- for a **mandatory division** the divisional application must be filed before the expiry of a time limit of **24 month** from the Examining Division's first specific non-unity objection to the earlier application (Note: "earlier" refers to the immediate parent application within a sequence of divisionals, i.e. which is itself a divisional)

The above 24-month period for a voluntary division limits the use of a divisional

as a fallback line before oral proceedings or as a "backup" if an opposition against the parent patent is expected. It is also no longer possible to create sequences of divisionals with unamended descriptions in order to keep the original disclosure pending as long as possible, for example for a later tailoring of the claims to an infringing product.

Non-observance of the 24-month time limits cannot be remedied by requesting further processing of the application under Article 121 EPC since these time limits are excluded in Rule 135(2) EPC. Re-establishment of rights under Article 122 EPC is possible, however, it must be proven convincingly to the EPO that the requester has exercised all due care so that this is an unreliable remedy.

Transitional provisions

There is a "grandfather rule" for pending applications for which the 24-month time limit already has expired before 1 April 2010. A divisional may still be filed within 6 months, i.e. until **1 October 2010**. If the 24-month time limit is still running on 1 April 2010 it will continue to do so for not less than 6 months, i.e. it will not expire before 1 October 2010.

Advice to applicants

Applicants should review the status of their pending EP applications and, if voluntary divisional applications may be required, they should consider filing divisionals by 1 October 2010 at the latest.

II. Multiple independent claims in the application

Under Rule 43(2) EPC an EP application may contain more than one independent claim in the same category (product, method, apparatus or use) only if the invention involves:

- a plurality of interrelated products
- different uses of a product or apparatus
- alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

Hitherto it was not possible for the EPO to enforce Rule 43(2) EPC at the search stage, such limitation of the number of independent claims could be postponed until the substantive examination or even the grant phase. Search examiners encountering several independent claims in one or more categories (often applications originating from the USA) had to draw up a search report on a set of claims that in this form could not be granted.

With new Rule 62a EPC the situation has changed. If the EPO considers that the claims as filed do not comply with Rule 43(2) EPC it can require the applicant to indicate, within a period of **2 months**, the claims on the basis of which the search is to be carried out. If the applicant fails to provide such an indication in due time, the search will be carried out on the basis of the first independent claim in each category.

Applicant may challenge a Rule 62a objection either in a reply to the Searching Division or later on before the Examination Division. If the search examiner is persuaded by the reply, or if the Examining Division finds that the objection was unjustified, the search will be carried out on an unlimited basis.

At the examination stage non-searched subject-matter must be removed from the claims (Rule 62a(2) EPC) and cannot be used later on for amending claims (Rule 137(5) EPC). Protection for such subject-matter can only be obtained by filing a divisional application within the time limits of Rule 36 EPC.

Non-observance of the 2-month time limit cannot be remedied by requesting further processing of the application under Article 121 EPC since this time limit is excluded in Rule 135(2) EPC. Re-establishment of rights under Article 122 EPC is possible.



III. Complex applications

According to amended Rule 63 EPC, in the case of so-called "complex applications", i.e. applications with insufficient enabling disclosure and/or claims lacking clarity, conciseness and support by the description to such an extent that no meaningful search of the prior art is possible, applicants will be invited at the search stage to file, within a **2-month** period, a statement indicating the subject-matter to be searched. The statement may indicate parts of the description which can be used for interpreting the claims, such as specific embodiments. The application itself cannot be amended at this stage according to Rule 137(1) EPC. If the statement is not filed in due time, or is not sufficient to overcome the deficiencies, the EPO will either issue a reasoned declaration that a search is not possible, or, as far as practicable, draw up a partial search report.

Non-observance of the 2-month time limit cannot be remedied by requesting further processing of the application under Article 121 EPC, since this time limit is excluded in Rule 135(2) EPC. Re-establishment of rights under Article 122 EPC is possible.

Advice to applicants

The statement must be drafted very carefully, because it will limit the extent of the search. Since non-searched subject-matter must be removed from the claims in the examination stage (Rule 63(3) EPC) and cannot be used later on for amending claims (Rule 137(5) EPC), such statement can limit the scope of protection.

IV. Mandatory reply to negative Extended European Search Report (EESR)

Hitherto there was no obligation for the applicants to reply to a negative preliminary opinion on patentability issued with the EESR drawn up for an EP application or with the supplementary EESR drawn up for a Euro-PCT application. Now, according to new Rule 70a EPC, applicants will be required to submit a response to a negative EESR for

- EP applications within **6 months** after the date on which the European Patent Bulletin mentions the publication of the EESR
- Euro-PCT-applications within the period for indicating the applicant's intention to proceed further with the application. A 6-month period is envisaged by the EPO, but has not been specified yet in the "Guidelines for Examination".

The above will be the only opportunity for applicants to amend the description and claims of their own volition. Later voluntary amendments can only be made with the examiner's consent. Amendments which are required to correct deficiencies noted in an official action of the EPO, i.e. which are mandatory, will be admitted. If the deadline is missed, the application will be deemed withdrawn. However, further processing of the application may be requested.

V. Mandatory response to the PCT Search Report for applications where the EPO acted as ISA or IPEA

If the EPO under the Patent Cooperation Treaty (PCT) has acted as International Searching Authority (ISA) or International Preliminary Examining Authority (IPEA), applicants in the regional European phase now must reply to a negative ISA Written Opinion or a negative IPEA International Preliminary Report on Patentability (IPRP). Amended Rule 161(1) EPC specifies a **1-month** period, triggered by a respective EPO communication.

The above will be the only opportunity for applicants to amend the description and claims of their own volition. Later voluntary amendments can only be made with the examiner's consent. Amendments which are required to correct deficiencies noted in an official action of the EPO, i.e. which are mandatory, will be admitted. If the deadline is missed, the application will be deemed withdrawn. However, further processing of the application may be requested.

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Advice especially to US applicants

In view of the above short 1-month period US applicants which have used the EPO as ISA or IPEA for their international PCT applications should consider to provide their European representatives with detailed instructions for replying to negative ISA Written Opinions or negative IPRPs already when entering the EP regional phase.

VI. Amendments to the claims

Already under the previous EPO examination practice the applicant was requested to identify all amendments and to indicate the basis for them in the original application. Under amended Rule 137(4) EPC this is now a "must", and if the applicant fails to do so the Examining Division may request the correction within a **1-month** period. If the applicant fails to reply in due time, the application will be deemed withdrawn. However, further processing of the application may be requested.

This briefing is made as of 20 April 2010. It is intended as general guidance only and it is not a substitute for detailed advice in specific circumstances. Therefore no responsibility is accepted by Heisse Kursawe Eversheds for any errors and omissions, and no one should act upon such information without appropriate professional advice after a thorough examination of the particular situation.

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