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NEW EPC REGULATION ON PROSECUTION OF EUROPEAN PATENT APPLICATIONS AND DIVISIONAL APPLICATIONS

New Rules will be applied at the EPO as from April 1st, 2010 on some important aspects of the prosecution of European patent applications.

The main changes relate to the search procedure (A), the answer to the European search report (B) and the prosecution of divisional applications (C).

A/ THE NEW SEARCH PROCEDURE:

According to the new Rules, substantive objections will be issued at an early stage before beginning the search and before sending the European search report.

If such an objection is raised by the search examiner; a short period of two months will be given to the applicant to take position and possibly amend the claims of the application. It will not be possible to extend this short period of two months and no request for further processing will be admitted.

1 – Multiple independent claims in the same category (new Rule 43(2))

Rule 43, paragraph 2 forbids multiple independent claims of the same category, for example more than one independent device claim or more than one independent method claim in the same application.

Consequently if a European patent application contains more than one claim in the same category, the EPO will issue an early invitation requesting the applicant to indicate on which claims the search should be carried out.

If the applicant gives no indication within the allowed two months time period, the EPO will carry out the search on the basis of the first claim in each category and all the other claims will not be searched.

2 – Excessively broad claims (new Rule 63)

In case of excessively broad claims, the EPO may consider that it is impossible to carry out a meaningful search on the basis of the subject matter claimed or on part of said subject matter. In that case, the EPO will issue an early invitation requesting the applicant to indicate which subject matter is to be searched. If an answer is not filed within the two months time period allowed or is not sufficient to overcome the deficiency, the EPO will issue a reasoned declaration explaining why it considers impossible to carry out a meaningful search on the basis of all or some subject matter claimed. No search report or only a partial search report will be issued.

Again all other claims will remain unsearched.

3 – Lack of unity (new Rule 64(1))

If the EPO considers that the European patent application does not comply with the requirement of unity of the invention, it shall draw up a partial search report on those parts of the application which relate to the first invention mentioned in the claims. The EPO will then inform the applicant that further search fees must be paid in respect of the other inventions if the European search report is to cover all the inventions claimed.

If no answer is filed by the applicant within the two months time period allowed, the European search report shall be drawn up for the part of the application relating to the invention in respect of which the search fees have been paid.

All other inventions will remain unsearched.

4 – Conclusion

It is clear that the purpose of those new Rules is to oblige the applicant to focus at an early stage to the most important aspects of his invention. The danger for the applicant is however important since new Rule 137(5) indicates that: "*Amended claims may not relate to subject-matter not searched ...*"

This means that during subsequent prosecution of the application it will not be possible to introduce, in a claim under examination, features and subject matter of other claims which have not been submitted to a search. Consequently, any claim not subjected to the search will be definitively lost for the applicant unless he has still the possibility to file a voluntary divisional application.

B/ MANDATORY ANSWER TO THE EUROPEAN EXTENDED SEARCH REPORT

According to the new Rule 64(1), it will be mandatory for the applicant to file comments to the opinion of the search examiner accompanying the European search report.

In some way the EPO wishes to consider that the opinion of the search examiner is the equivalent of a communication of the Examining Division.

The time period for answering to the opinion of the search examiner will be of six months (the same time period as for answering to a communication of the Examining Division - including extension of time), starting from the publication of the search report.

Similarly as for a communication of the Examining division, the application will be deemed to be withdrawn if no answer is filed in due time to the European search report.

According to Rule 69, the EPO issues a communication which is sent to the applicant, indicating the date at which the European search report shall be published. According to an amended new Rule 69, the EPO will remind the applicant of the deadline to answer to the search report, the deadline to file the request of examination, the deadline to confirm the wish of the applicant to pursue the examination if examination request was filed at the filing of the application. For all those requirements the deadline will be the same i.e. six months from the date of publication of the European search report.

And if the EPO would forget to send such communication or send it to a wrong address or indicate a date of publication which would not exactly correspond to the effective date of publication, the applicant will be able to rely on the date indicated on this communication or to use the omission of the communication as an excuse for not performing the said requirements, including the answer to the European search report, within the prescribed time limit.

The different possible situations

The situation will be different depending on the date at which the applicant files the request for examination. It will be also different whether the application is a direct EP application or a PCT application for which entry into regional European phase has been performed.

1/ If the applicant did not request examination together with filing of the application, he will have the possibility of requesting examination within the time period of six months after publication of the search report and at the same time answer to the European search report.

2/ If the applicant has requested the examination before receipt of the search report and particularly at the filing of the application, the EPO will give to the applicant the opportunity to answer to the search report and to confirm his intention to pursue the prosecution of the application within the same time period of six months after publication of the search report.

Also, if upon request of examination, the applicant has received a first communication of the Examining Division, the answer to the European search report will be considered by the EPO as a valid answer to said first communication of the Examining Division.

A single answer will thus be sufficient in that case to satisfy the EPO and to avoid that the application is deemed to be withdrawn.

3/ If the applicant has requested the examination at the filing of the application and has waived his right to receive a communication from the EPO after despatch of the European search report asking whether he wishes to proceed further, no search opinion will be issued.

Instead, a first communication of the Examining Division will be sent to the applicant with a time period for answer, usually four months, extendable for two further months.

4/ In the case of a PCT application for which the international search report and possibly the international examination report, were not prepared by the EPO, the opinion of the European search examiner will accompany the Supplementary search report which is prepared by the EPO. The applicant will have to answer to this opinion within the same six months time period beginning however from receipt of the invitation to

indicate whether the applicant wishes to proceed further with the application (Rule 161). If no answer is filed against the objections stated in the opinion, the application will be deemed to be withdrawn exactly as if a notification of the Examining division would not be answered.

5/ In the case of a PCT application for which the EPO has acted as International search authority or possibly also as International examination authority, the international search report is drawn up by the EPO before entry into the regional phase at the EPO.

In such a case, after entry into the regional phase, the EPO will issue a communication giving the applicant the opportunity to comment on the written opinion accompanying the International search report or the International examination report previously established during the international prosecution phase. If necessary, the examiner will invite the applicant to amend the description, the claims and the drawings.

However, in that case, the deadline for filing said comments and/or amendments to the application will be only one month from the invitation sent to the applicant to confirm his wish to pursue the application (Rule 161 EPC).

If the applicant files no comment in answer, the application will be deemed to be withdrawn.

It is clear that this situation is particularly troublesome since the time period of one month is extremely short.

What comments and which answer should be filed to the European search report?

It must be admitted that, apart from the situation where the applicant has waived his right to receive an invitation from the EPO to confirm his wish to continue the prosecution, the Examining division is not yet in charge of the case since examination has not yet began at the time of receipt of the search report together with the opinion of the search examiner.

However, only the examiner has the power of the inviting the applicant to file observations and/or amendments the claims and the power to reject the application if an incomplete answer is filed.

Consequently, the opinion of the search examiner cannot be legally considered as a communication of the Examining division and the requirement to answer to the opinion of the search examiner can only be a formal requirement.

Therefore, the applicant is under no obligation to overcome the substantive objections mentioned in the opinion of the search examiner. The only completely requirement is to file comments which can be formal comments and possibly to correct the most relevant deficiencies in the application. A short answer to the search report dealing with formal objections and possibly novelty and inventive step in general lines should be sufficient to satisfy the requirement newly introduced for answering to the European search report and thus avoiding that the application be deemed as withdrawn.

Remedy if no answer is filed

According to the new Rules if no answer is filed, the application should be deemed to be withdrawn.

However, in that case further processing is opened to the applicant. Therefore a request for further processing together

with the payment of the relevant fee can be filed within two months from the communication received from the EPO according to which the application is deemed to be withdrawn.

The timing of the amendments to the application

According to the new Rules, there will be only one possibility for the applicant to file amendments to the application of his own volition and this is together with the answer to the European search report.

The second possibility which existed up to now to file amendments without the authorisation of the examiner also in answer to the first official action of the Examining division will disappear.

Therefore the examiner may refuse in the future to accept amendments in the claims or introduction of additional claims to the application thus leaving to the applicant the only possibility to file a divisional application for the amended or supplemental claims he wanted to introduce. However, the time limit for filing voluntary divisional applications will also be limited as explained below.

Entry into force

The new provisions will enter into force on April 1st, 2010 and are therefore applicable for all search reports received on or after that date.

The date of filing or priority of the relevant application is not the relevant date for applying the new provisions.

C/ DIVISIONAL APPLICATIONS

The end of the freedom

At the present time, it is possible to file voluntary divisional applications at any time before grant of the parent case. It is therefore possible to file a divisional application from a pending divisional application even if the parent case is already granted and without any time limitation.

The EPO has considered that this could lead to abuses. Applicants could, for example, maintain a pending divisional application for several years so as to continue prosecuting different types of claims, possibly broader claims without having to go on appeal.

The new Rule 36 has the purpose of changing this procedure and rendering the voluntary filing of divisional applications particularly difficult and limited in time.

According to the new Rule 36 namely, a voluntary divisional application can only be filed if the parent application is still pending and if the divisional application is filed within a maximum time period of 24 months beginning from receipt of the first official action in the earliest application.

This first notification of the Examining division is not the opinion of the search examiner accompanying the European search report. However it may be a notification of allowance under Rule 71(3) EPC in case of direct allowance. It may also be the confirmation of a telephone conversation held during an informal interview between the applicant or his representative and the examiner.

The earliest application is the initial application which, in case of a series of divisional applications may be the parent or the grant parent application.

In view of this new Rule it will be advisable to consider the possibilities of filing one or more divisional applications before the end of the 24 months time period after the first official action of the Examining division. This will be particularly useful if the attitude of the examiner seems particularly negative toward the patentability of the invention.

In order to be on the safe side it could be advisable to answer quickly to the first notification of the Examining division so as to have the chance of receiving a second official action within the 24 months period beginning from the first official action. In that case the applicant would have a clearer picture of the situation before deciding to file one or more divisional applications as a safety measure.

Further processing is ruled out in respect of the period of 24 months provided in Rule 36. Therefore this period of 24 months cannot be postponed and only possible reestablishment of rights can be considered.

Strategy for the transitional period

A transitional period will be opened until October 1st, 2010 (i.e. six months after the entry into force of the new regulation on April 1st, 2010).

Until October 2010, it will be possible to file voluntary divisional applications for pending applications for which the 24 months period after the first official action has already expired or will expire before October 1st, 2010.

It is therefore advisable to review all the pending cases and determine whether divisional applications should be filed before October 1st, 2010 to safeguard the interests of the applicant.

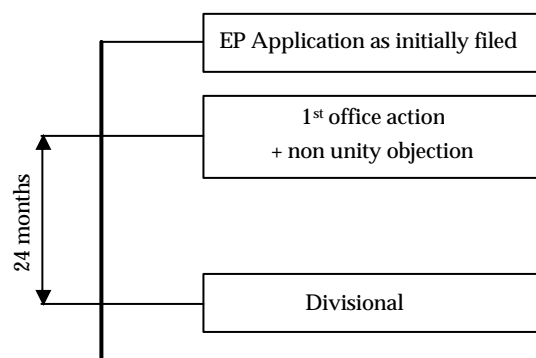
Mandatory divisional applications

In case of a non unity objection raised by the Examining division, the applicant will be given the opportunity to file a divisional application which can be considered as a "mandatory divisional application".

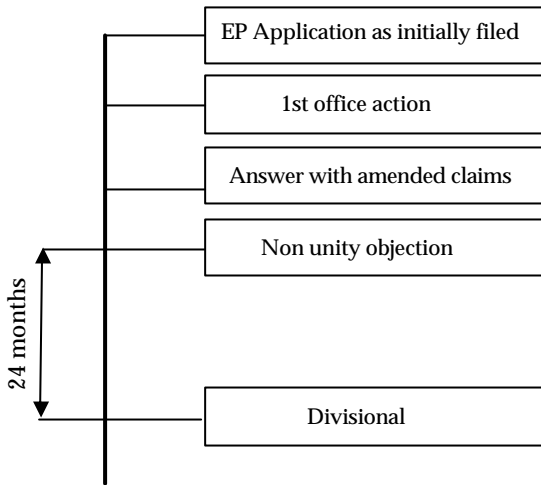
In that case the deadline for filing said mandatory divisional application is of 24 months after the communication of the Examining division objecting the non unity of the application provided such non unity objection is raised for the first time.

This means that if a second non unity objection is raised at a subsequent time for a different reason, a new time period of 24 months will be opened to the applicant for filing a new mandatory divisional application. The following examples illustrate various situations in this regard.

Example 1

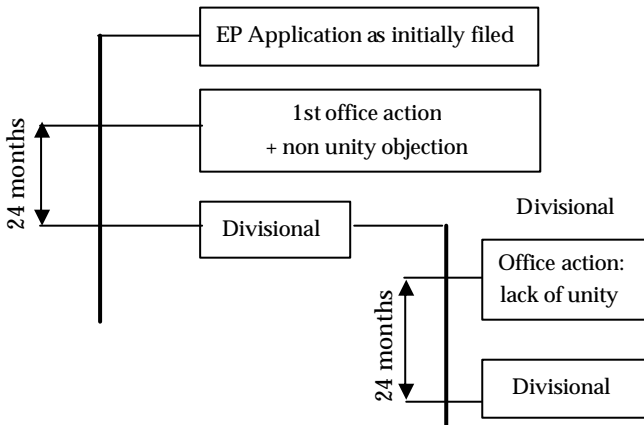


Example 2



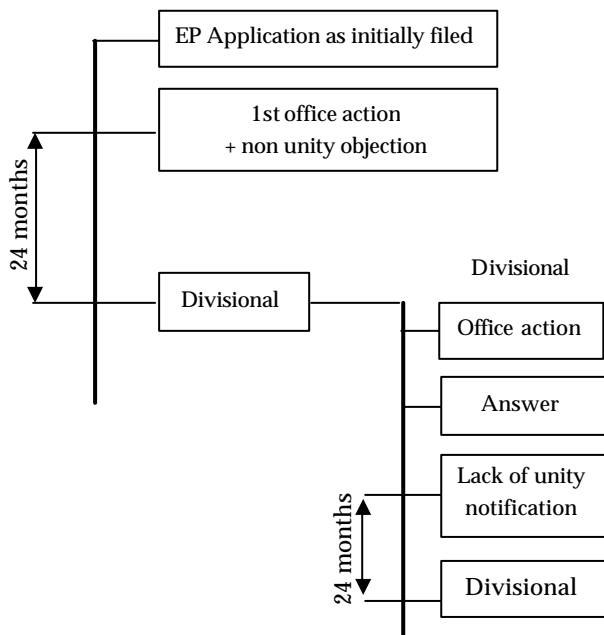
Example 3

Main case



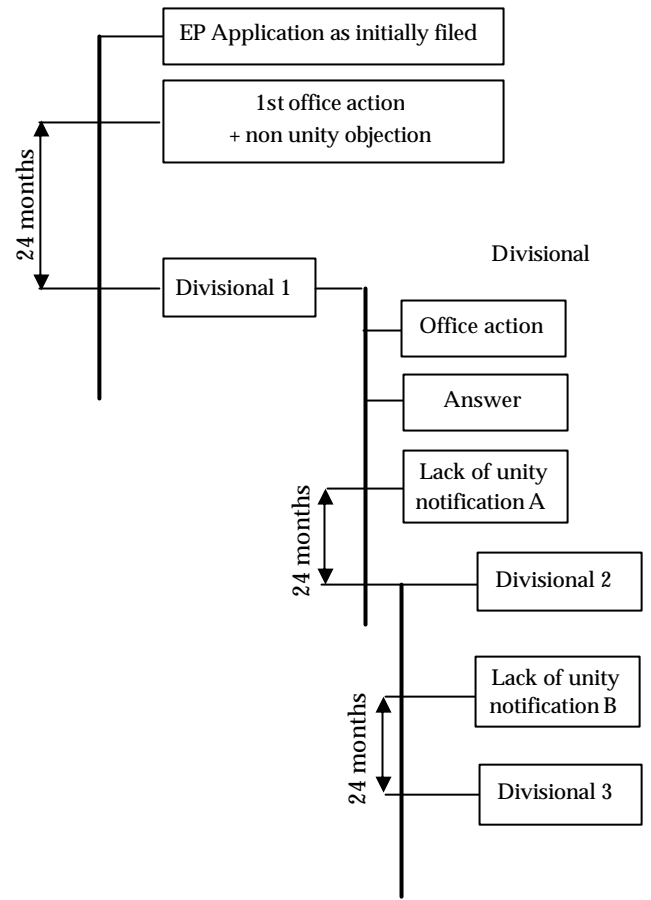
Example 4

Main case



Example 5

Main case



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