

The effects of the EPC

The second round of amendments to the European Patent Convention Implementing Regulations is imminent

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The second set of amendments to the European Patent Convention (EPC) 2000, which come into force on 1st April 2010, will have unexpected and serious consequences for all applicants. The amendments relate to three major parts of the EPC:

- Divisional applications.
- Reply to search reports.
- Reply to international search reports.

Divisional applications

The relevant changes relating to the filing of divisional applications under the requirements of amended Rule 36 of the EPC concern:

- The time limit for filing.
- The language of filing.

Time limit

Two requirements must be met:

- A divisional application may be filed only on the basis of a pending earlier application.
- The period for voluntary or mandatory division under Rule 36(1)(a)/(b) of the EPC must not yet have expired.

A voluntary division may be filed before the expiry of a 24-month period starting from the Examining Division's first communication under Article 94(3) and Rule 71(1), (2) or (3) of the EPC in respect of the earliest application for which the communication has been issued. A mandatory division may be filed before the

expiry of a 24-month period starting from any communication in which the Examining Division has objected that the earlier application did not meet the requirements of Article 82 (unity of invention), provided that this is the first time the specific objection has been raised.

In case of a mandatory division, a new 24-month period can be triggered only by a communication from the Examining Division in which a new, different non-unity objection has been raised.

General matters

The 10-day rule set out in Rule 126(2) of the EPC applies for the purpose of calculating the 24-month time limit. The 24-month time limit is excluded from further processing. Only re-establishment of rights is available.

Transitional provisions

If the 24-month time limit expires before 1st April 2010, a divisional application may still be filed (from a pending parent application) within six months of that date (ie, until 1st October 2010) (see Figures 1 and 2).

Language

The divisional application must be filed in the language of the proceedings of the pending earlier application. Where the earlier (parent) application of the divisional application was not filed in an official language of the European Patent Office (EPO), the divisional application may be filed in the filing language of the earlier application, in which case a translation into the language of the proceedings of the earlier application must be filed within two months of filing the divisional application.

Reply to search reports

If an application contains a plurality of

independent claims of the same category, then before the EPO starts the search it will send the applicant an invitation to clarify the subject matter of the application (Rule 43(2) and new Rule 62a of the EPC).

The applicant must indicate within two months of the invitation the claims on which the search should be based. If the applicant responds in time, the search will be carried out on the basis of the indicated claims. However, if the applicant fails to do so, the search will be carried out on the basis of the first independent claim in each category. In the examination proceedings the claims are limited to the searched subject matter. However, if the subject matter of an application does not allow a meaningful search to be carried out (ie, a “complex” application), Rule 63 of the EPC applies and the applicant receives an invitation to file, within a period of two months, a statement indicating and explaining the subject matter to be searched (eg, an indication of a part of the description that can be used to interpret the claims). Otherwise, the EPO draws up a partial search report or no search is carried out at all.

New Rule 70a of the EPC applies to all direct European patent applications with an extended European search report and to European Patent Cooperation Treaty applications where the EPO is not acting as the international search authority with a supplementary European search report. Under Rule 62 of the EPC, the applicant must reply to the search opinion if it is negative.

According to new Rule 70a(1) of the EPC (search opinion), the EPO will invite the applicant to comment on the extended European search report, correct any deficiencies noted in the opinion annexed to the extended European search report (ie, amend the claims) and amend the description, if necessary.

The applicant must respond within a period of six months after publication of the European search report (Rule 70(1) of the EPC).

In case the examination fee was paid before the extended European search report was issued, new Rule 70a(2) of the EPC (European patent direct application) applies; under Rule 70(2) of the EPC, the EPO will invite the applicant to state within a specific period (usually six months after publication of the report) whether he wishes to proceed further with the European patent application.

If a supplementary European search report has been drawn up for a European

Figure 1

Filing of divisional applications
Here: “voluntary division” Rule 36(1) (a) EPC

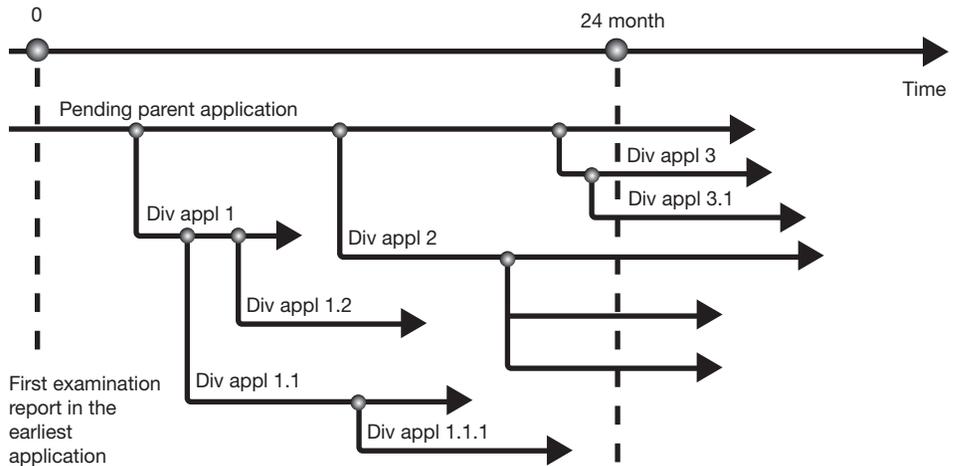
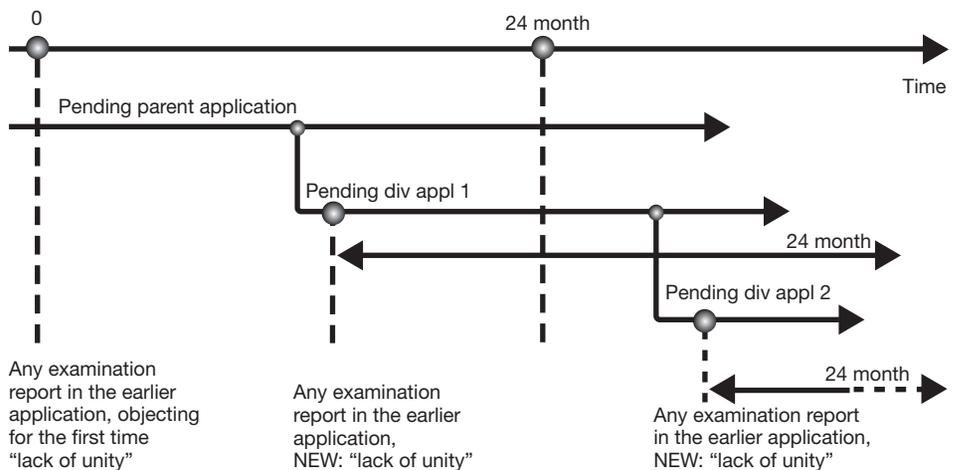


Figure 2

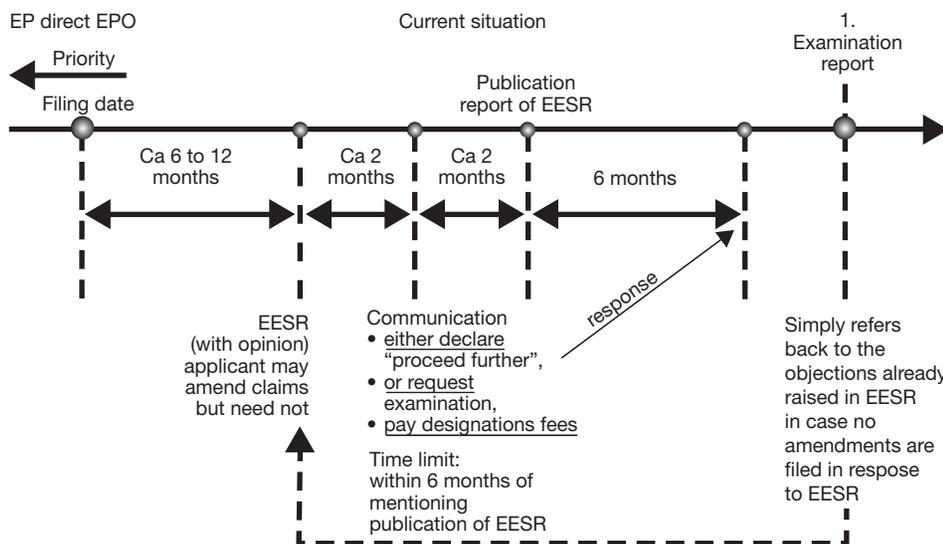
Filing of divisional applications
Here: “mandatory division” Rule 36(1) (b) EPC



Patent Cooperation Treaty application, the EPO will invite the applicant to respond within a period of six months from notification of the relevant communication (Rule 70(2) and Rule 70a(2) of the EPC).

New Rule 70a(3) of the EPC applies if the applicant fails to comply with the invitation under Rule 70a(1) or (2) to remedy defects or make amendments, and also fails to comment on the search opinion, with the result that the application is deemed to be withdrawn. However, further processing under Article 121 of the EPC is available.

Figure 3



deadlines under Article 94(2) and Rules 70(1) and 70a(1) of the EPC (see Figures 3 and 4).

Reply to international search reports

Amended Rule 161 of the EPC applies to European Patent Cooperation Treaty applications on entry into the European phase before the EPO if:

- The EPO acted as the international search authority and issued the international search authority written opinion.
- The EPO acted as international search authority and international preliminary examination authority and issued the international preliminary report on patentability.

If the written opinion or the international preliminary report is negative, the applicant must respond.

According to amended Rule 161(1) of the EPC, no response to the written opinion or international preliminary report is required if the amendments or comments responding to it or amendments under Article 19 of the Patent Cooperation Treaty were already filed when entering the European phase. The same applies for voluntary amendments carried out under Rule 159(1)(b) of the EPC.

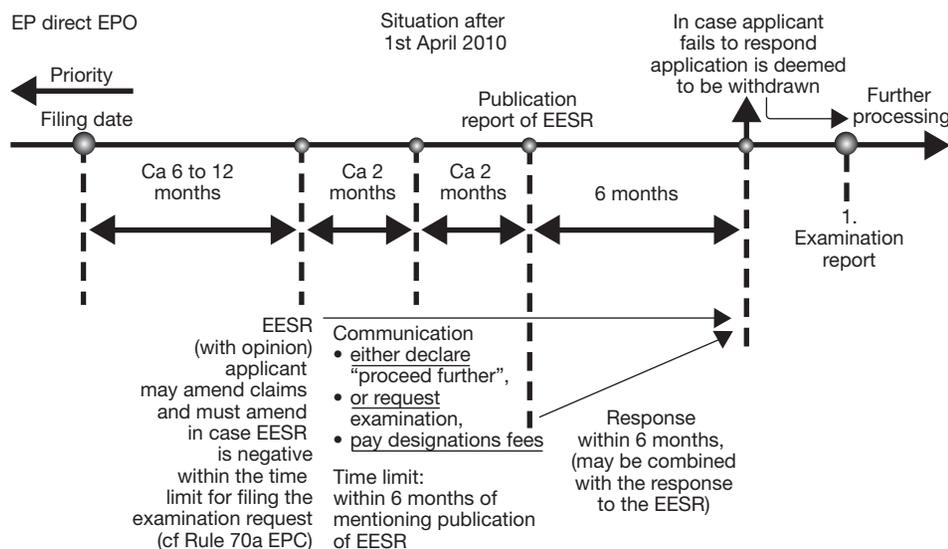
However, a response to the international preliminary report is required if the amendments under Article 19 or Article 34 of the European Patent Cooperation Treaty have already been taken into account by the EPO as international search authority and international preliminary examination authority when drawing up the international preliminary report.

The applicant must comment on a negative written opinion or international preliminary report within one month of the communication under Rule 161(1) of the EPC. If the applicant fails to respond within the time limit, the application will be deemed to be withdrawn. However, further processing under Article 121 of the EPC is available.

Amended Rule 161(2) of the EPC applies to European Patent Cooperation Treaty applications for which a supplementary European search report is drawn up, where the applicable law is unchanged. The procedure after issuance of a supplementary search report is ruled by Rule 70a(2) of the EPC.

According to amended Rule 137(2) of the EPC, there is only one opportunity for own volition amendment – that is, in response to communications under Rule 70a or Rule

Figure 4



Furthermore, new Rule 70a of the EPC provides that where the examination fee has been paid early and a voluntary waiver to confirm maintenance of the application has been filed (Rule 70(2) of the EPC), Rule 70a does not apply as no search opinion will be issued. Instead, a first examination report (communication under Article 94(3) of the EPC) will be issued.

According to amended Rule 69 of the EPC, the EPO must notify the applicant of the date on which publication of the European search report will be mentioned in the European Patent Bulletin and of the

“ The new rules and procedures place an increased burden on applicants ”

161 of the EPC (being aware of the time limits) or, if communications under Rule 70(2) of the EPC have been waived, until the response to the first examination report (communication under Article 94(3) of the EPC). Under amended Rule 137(3) of the EPC, any later amendments are possible only with the consent of the Examining Division. Furthermore, amended Rule 137(4) of the EPC requires that the applicant identify all amendments and indicate the basis thereof in the original application. If the applicant fails to do so, the Examining Division may issue a communication inviting it to remedy the omission within a non-extendable period of one month. If the applicant fails to respond within that period, the application is deemed to be withdrawn.

Current Rule 137(4) of the EPC becomes the first sentence of Rule 137(5). The new second sentence applies where subject matter has been excluded from the search. Thus, amended claims may not relate to subject matter which has not been searched (under Rules 62a and 63 of the EPC) (see Figures 5 and 6).

With the amendments coming into force there will be another increase in the official fees, following the fee increase brought in by the first part of the amendment, which introduced the following:

- An extra fee of €200 (to increase to €210) for each claim exceeding claim 15.
- An extra fee of €500 (to increase to €525) for each claim exceeding claim 50.

The new rules and procedures place an increased burden on applicants. Along with the accompanying fee increases, they may lead some to question whether it is worth seeking patent protection through the EPO. This could lead to a significant decrease in the number of new and pending applications that the office is asked to handle. **iam**

Figure 5

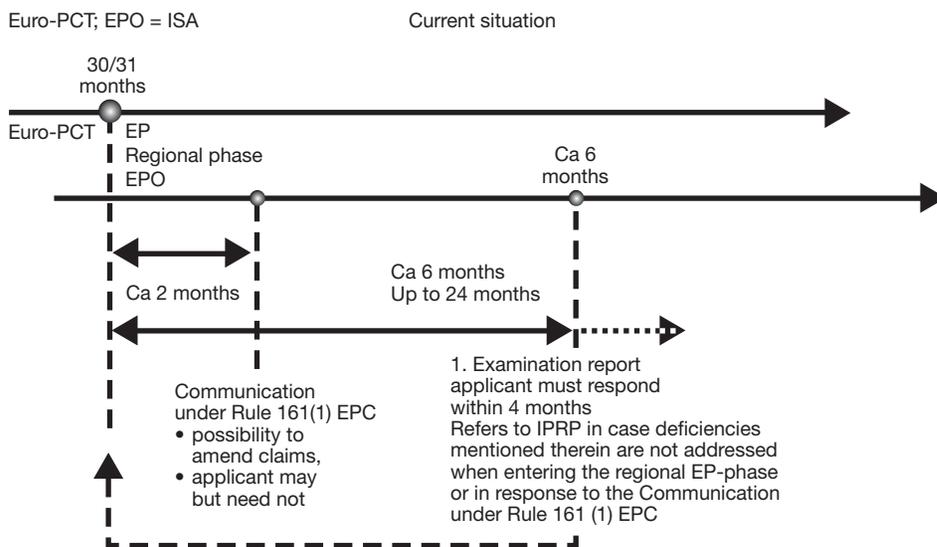
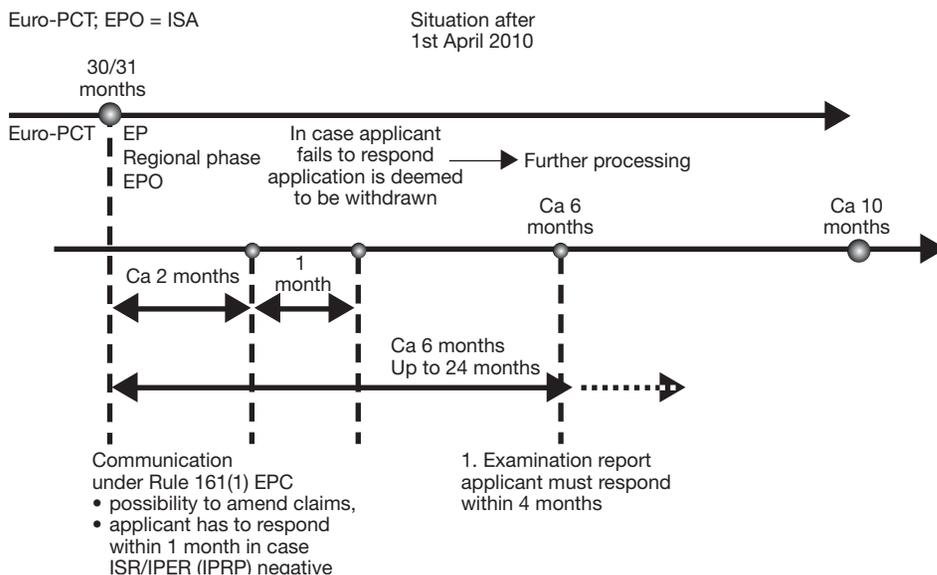


Figure 6





Paul-Alexander Wacker is a founding partner of Kuhnen & Wacker IP firm, which is well known for landmark cases (ie, the famous *EPILADY* case) and is one of Germany's leading IP firms. Mr Wacker has studied heavy current technology, computer-integrated manufacturing, telecommunications and computer technology. He graduated from the Technical University of Munich with a master's degree in electrical engineering in 1970 and was awarded a further master's degree in economics in 1972. He qualified as a patent attorney in 1975.

For many years Mr Wacker has lectured at universities, international conferences and IP seminars in Germany and abroad. He has gained a reputation for counselling clients on German, European and worldwide IP strategy and valuation.

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