

Key Recent EPO Law Changes

- the unwary will get less protection

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Recent and future changes to the EPC

- EPC 2000 entered into force on 13 December 2007
- Changes to fee structure on 1 April 2009
- Further major changes introduced on 1 April 2010

EPC 2000 - Unity of invention for Euro-PCT applications

- As of 13 December 2007, the opportunity to have **multiple inventions searched** is limited to the **international phase**.
- It will **no longer** be possible to have **additional searches** on any pending Euro-PCT applications.
- Further inventions can only be searched by filing **divisional applications**.

EPC 2000 - Unity of invention for Euro-PCT applications

- Where the EPO is the International Search Authority, the applicant can pursue only one invention covered by the International Search Report.
- Prior to substantive examination, the claims have to be restricted to a single invention

EPC 2000 - Unity of invention for Euro-PCT applications

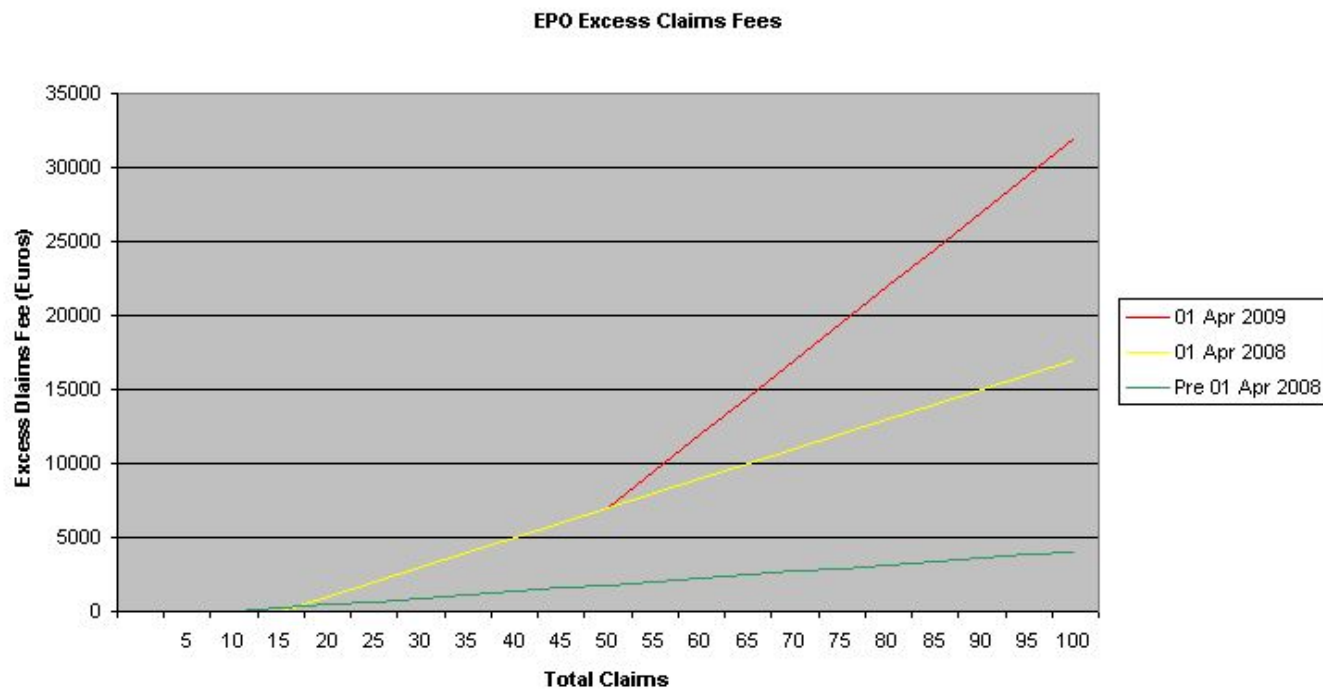
- Where the EPO is not the ISA, a supplementary search report (SSR) will be prepared by the EPO on the **first** mentioned invention **only** (Rule 164 EPC)
- The claims that are the subject of the SSR are the claims that will be examined.
- Need to decide at point of entry into regional phase which claims are wanted

EPC 2000 - Central Limitation and Revocation

- The **patentee** can request **revocation or limitation** of a European patent at the EPO (article 105a)
- No need to provide reasons for request.
- For limitation, the EPO will conduct a limited examination of the request for compliance with rules relating to clarity, support, and added matter, and to ensure claims are narrower
- A request for limitation will **not** be accepted whilst **an opposition is pending**.

Fee changes – 1 April 2009

- Excess claims fees have become very expensive:
 - €210 for each of claims 16-50
 - €525 for each of claims 51+



Fee changes – 1 April 2009

- Filing requires an additional €13 for each page over 35.
- Grant fee does not include additional page fee for those applications where page fee was paid on filing
- Worth considering length of specification and number of claims when filing and entering regional phase

Fee changes – 1 April 2009

- Flat designation fee of €525 covers all states.
 - individual designations can be withdrawn but no reduction in fees results

Extension states are still designated separately – explicit instructions needed by EPO attorneys eg no extension states (fee per state €102) - Albania, Bosnia and Herzegovina, Montenegro or Serbia

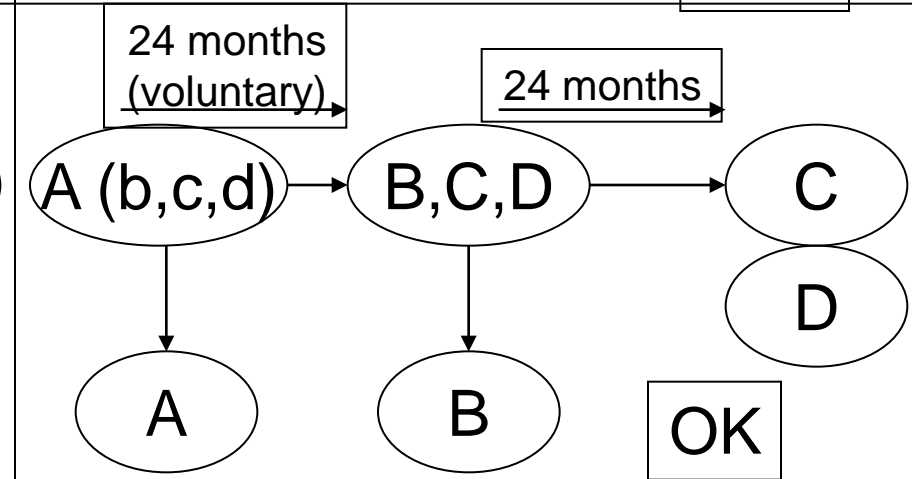
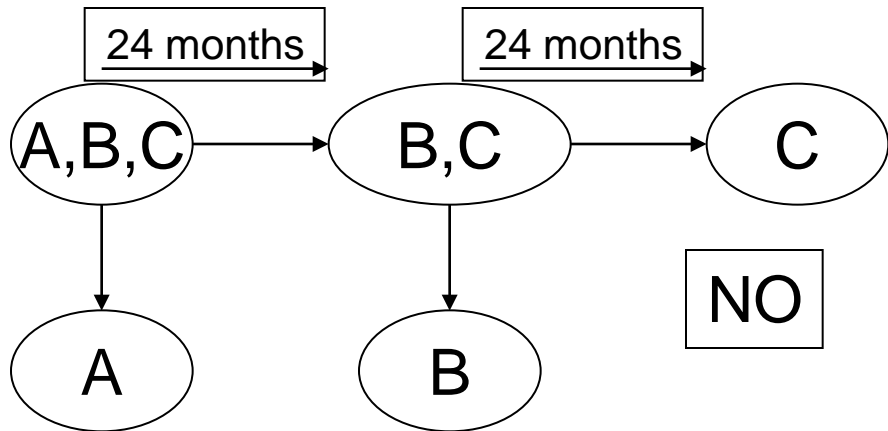
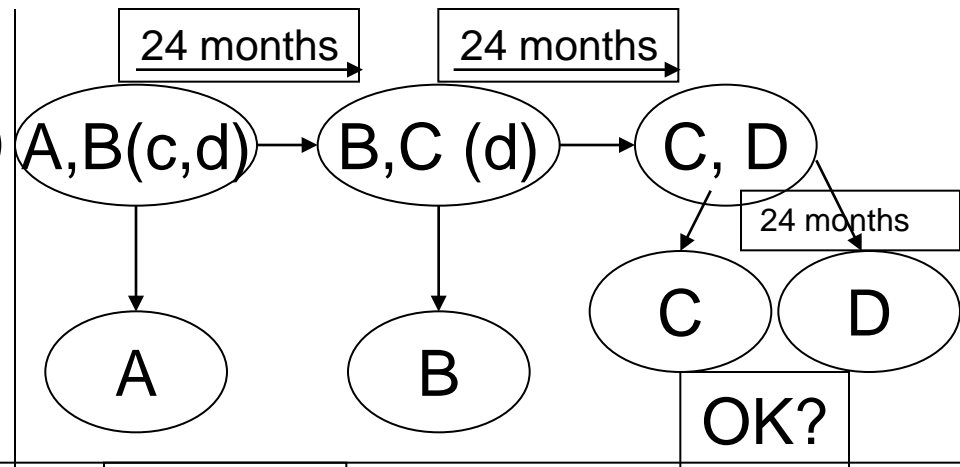
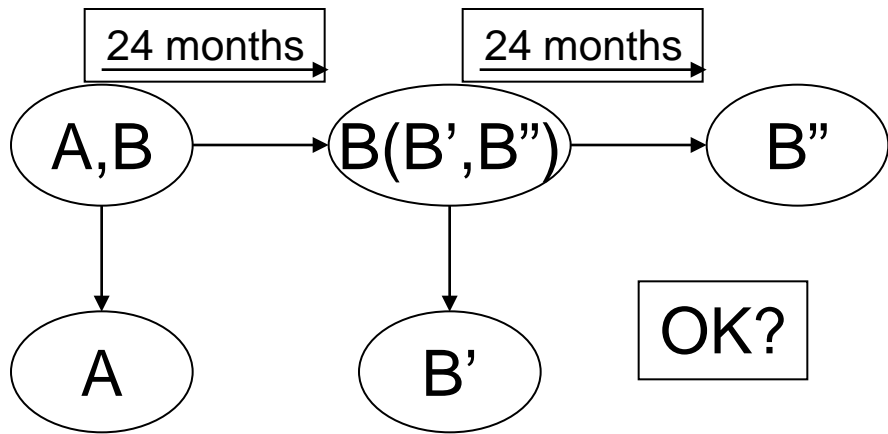
Divisional Applications – 1 April 2010 (Rule 36 EPC)

- Divisionals must be filed within **2 years** from the first communication in respect of the earliest application – *interpreted as first substantive examination report on the parent application*
- Divisionals can still be filed up to **2 years** from any subsequent non-unity objection when the specific objection is raised for the first time (specific objection? Any non-unity objection or a specific non-unity objection to an invention?)
- For all applications pending on 1 April 2010, divisionals can still be filed before **1 October 2010** if the other deadlines have expired

Divisional Applications – Strategic considerations

- Subject matter discovered late in proceedings to be important and worth a divisional application – may be too late
- Amendments filed in response to exam reports are allowed at the discretion of the examiner – claims to multiple inventions to force a non-unity objection may not be accepted
- Possible to obtain more time by filing a divisional with multiple claimed inventions – so long as the claims were not in the parent and no objection to non-unity was raised for those claims
- Cascaded divisionals are only possible if the examiner raises a new non-unity objection

Divisional Applications – Strategic considerations



Multiple independent claims – 1 April 2010 Rule 62a EPC

- The EPO will only carry out a search on one independent claim in each category (apparatus, method *etc.*)
- The applicant will be given a chance to choose which claims are searched before the search is carried out. If no choice is made the search will be conducted on the first claim in each category.
- During examination the applicant will be required to restrict the claims to the searched subject matter
 - It is possible to argue at this stage that the requirement is unjustified

Multiple independent claims – 1 April 2010 Rule 43(2) EPC

- Multiple independent claims are allowed if (and only if) the subject matter of the application involves one of the following:
 - (a) a plurality of interrelated products
 - (b) different uses of a product or apparatus
 - (c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives in a single claim
- This is not new – what will change is that the search report will be limited and it may not be possible to get other claims searched and examined.

Multiple independent claims – 1 April 2010 Rule 63 EPC

- If the EPO considers that the claims are unclear and it is impossible to carry out a meaningful search, the applicant must file a statement indicating the subject matter to be searched
- If the statement is not filed or does not overcome the objection a partial search or just a statement arguing why a search could not be carried out will be issued.

Multiple independent claims – Strategic considerations Interaction of Rule 36 and 62a

- How does this new rule interact with non-unity (divisionals) rules?
- Scenario
 - Multiple independent claims to multiple inventions
 - First office action requires selection of one set of claims to be searched –opportunity to get other claims searched?
 - Search report issued
 - First exam report does not raise non-unity – 2 years for voluntary divisional
- Could force non-unity search by having an apparatus claim for one invention and a method claim for another, or by concatenating claims using OR (however, this may cause EPO to object that the claims cannot be searched – Rule 63!)

Extended search report – 1 April 2010

- The EPO issues an opinion on patentability with the search report (Rule 62 EPC)
- There is deadline for response of 6 months from the publication of the search report if deficiencies are noted (this is the deadline for requesting examination). If no response is filed the application will be deemed withdrawn (Rule 70a(1) EPC)
- Will need to consider substantive issues much earlier in procedure

Ex-PCT applications – 1 April 2010

- For an ex-PCT application on which a Written Opinion or IPRP was drawn up by the EPO, an official letter will issue shortly after entry into the regional phase giving a deadline of two months to correct any deficiencies and confirm the examination is to proceed (Rule 70a(2) EPC)
- Entry into the regional phase must therefore be accompanied by a genuine attempt to meet all objections raised by the EPO during the international phase

Ex-PCT applications – 1 April 2010

- For an ex-PCT application on which a Written Opinion or IPRP was not drawn up by the EPO, a supplementary search report with a search opinion will be issued by the EPO (Rule 70a(2) EPC)
- The EPO will issue an official letter giving a deadline of two months to correct any deficiencies and confirm the examination is to proceed (Rule 70a(2) EPC)
- If no response is filed the application will be deemed withdrawn.

Amendments – 1 April 2010 Rule 137 EPC

- Prior to 1 April 2010, amendments could be made to the application under Article 123 so long as the amendment has 'unambiguous basis in the application as originally filed'.
- It is mandatory to identify to the examiner the basis for the amendments
- If this is not done the examiner will issue a communication setting a one month deadline to do so.
- If no response is filed the application is deemed withdrawn.

Impact on Drafting of PCT Applications

- Claim numbers need to be considered carefully
- Independent claims need to be limited
- Need EPO style claims not US style claims
- (Note – at EPO regional phase, the subject matter of claims for which fees are not paid is deemed abandoned. Question over the legal status of the subject matter. Ensure claim language is in the description to enable claims to be reintroduced eg in a divisional based on the description)

Impact on Prosecution of PCT Applications

- Selection of ISA is important
- EPO provides a quality search and use of the EPO will save money if EPO is to be filed
- If USPTO used as ISA and no non-unity raised (full search report). If EPO considered claims relate to multiple inventions it will just search the first (or ask for claims to be selected for searching). Hence no opportunity to get other inventions searched to assess whether divisional applications are desirable (remember EPO divisionals are expensive – all fees and back renewal fees have to be paid)

Summary

- The changes in EPO need to be considered when drafting and filing PCT applications
- Include the text of the claims in the description if there are a large number of claims
- Beware multiple independent claims
- Choose ISA and claim order carefully
- Be aware of new divisional rules – plan for it
- Seek the advice of your European attorney before entering the regional phase

Q & A

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