

Upcoming Changes to European Patent Examination Procedures

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Recently, the European Patent Office (EPO) announced changes to the rules of the European Patent Convention (EPC) as part of the EPO's initiative to speed up patent examination. The new EPC rules, which will be effective on April 1, 2010, will drastically restrict how a patent applicant is able to file divisional patent applications and will increase the patent applicant's obligations to provide information to the EPO during patent examination.

More specifically, these rule changes implement: (1) time limits for filing divisional European patent applications; (2) compulsory responses to European search reports and written opinions of the EPO acting as the International Searching Authority (ISA) in European patent applications; (3) a requirement that the basis in the original text of a European patent application be provided for all amendments; (4) restrictions on a patent applicant's right to make voluntary amendments; (5) a requirement, for European patent applications containing more than one independent claim in the same category, that patent applicants identify which claims are to be searched; and (6) a requirement, for claims the EPO considers too broad or unclear on which to carry out a meaningful search, that the patent applicant indicate which subject matter should be searched.

In view of the typical wait time for patent search and examination at the EPO, the new rules may apply to European patent applications already awaiting search at the EPO, as well as to European patent applications filed at the EPO or entering the European regional phase from a Patent Cooperative Treaty (PCT) patent application from now on.

Time Limits for Filing Divisional Applications

Currently, divisional European patent applications may be filed up until the granting of a parent patent application. Cascading divisional European patent applications may be filed indefinitely. These current provisions are analogous to U.S. "divisional" and "continuation" application practice.

Under the new Rule 36 EPC, patent applicants will no longer be able to file an unlimited number of cascading divisional patent applications while a European patent application is pending. Under the new rule, if there is not an objection for lack of unity of invention in the European patent application, the time limit for a voluntary filing of a divisional patent application is two years from the issuance of the first examination report on the parent application in the patent family. If there has been an objection for lack of unity of invention, then the time limit for a mandatory filing of a divisional application is two years from the objection for lack of unity of invention.

Though the new rule will be introduced April 1, 2010, there will be a six-month transitional period until October 1, 2010. During the transitional period, divisional applications may be filed from European patent applications where the new time limits would have expired before October 1, 2010. As the new rule applies to pending European patent applications, it would be prudent to review all pending European patent applications in light of the rule changes. Depending on each European patent application's status and its related cases, the filing of a divisional patent application before October 1, 2010 may be warranted to avoid loss of an otherwise available filing or claiming strategy.

Compulsory Responses to European Search Reports and Written Opinions of the EPO

Currently, patent applicants do not have to reply to search reports from the EPO or written opinions issued by the EPO during the international phase of PCT patent applications. The rule changes, however, do require compulsory responses to (1) objections raised in opinions included in European search reports and (2) written opinions of the EPO acting as the ISA for PCT patent applications that have entered the European regional phase. The response cannot be a nominal response, but must be a full response to the objections and may include amendments to the patent application.

The requirement of a response to a European search report applies to both extended search reports in European patent applications filed at the EPO and supplementary search reports in European patent applications resulting from entry into the European regional phase of a PCT patent application. The deadline for responding to an extended search report depends on whether a request for examination has been filed. If a request for examination has not been filed, the deadline will be six months from the publication date of the search report. If a request for examination has been filed, the deadline will be two months from the date of the extended search report. No extensions of time for response will be available. If a patent applicant fails to respond to a European search report, the application will be deemed withdrawn, but may be revived upon “further processing.”

In the case of a PCT patent application in which the EPO is the ISA, a search is not carried out for the European regional phase patent application and no supplementary European search report is issued. Thus, a response to a written opinion of the PCT patent application will be required shortly after entry into the European regional phase by an invitation issued from the EPO. The deadline for response will be one month. If a patent applicant fails to respond, the application will be deemed withdrawn, but may be revived upon “further processing.” Given the short period of time for responding, it would be advisable to have a response ready at the time of entry into the European phase. Moreover, European patent prosecution may be initially less expensive if the EPO was not designated as the ISA during the PCT stage, since an immediate response to a non-EPO search report will not be required upon European entry.

Amendment and Search Restrictions

Under the new rules, a patent applicant must provide the basis in the original text for all amendments to the application. If the applicant does not do so, then the EPO will invite the applicant to provide the basis for the amendments and set a one-month deadline. If a patent applicant fails to provide the requested information, the application will be deemed withdrawn, but may be revived upon “further processing.” This rule change likely will not change current European patent practice very much, because amendments and the basis for them are typically filed in European patent applications.

In addition, the new rules restrict the right to make voluntary amendments to a European patent application. Currently, voluntary amendments may be made after receipt of a search report and again after receipt of the first examination report in a European patent application. Under the new rules, patent applicants will only have the right to make voluntary amendments to a European patent application when replying to a search report or a supplementary search report. Amendments later in the examination proceedings may only be made with the consent of the examining division.

In European patent applications that contain more than one independent claim of the same category (i.e., product, process, apparatus, use), the new rules will require patent applicants to identify which one of those independent claims are to be searched. The deadline for providing this information will be two months. If the patent applicant does not provide this information, then the EPO will search only the first

claim in each category. This rule change will allow patent applicants to provide more direction to the EPO to search the subject matter that is of most interest to them.

In European patent applications that the EPO considers as having claims that are too broad or unclear, the EPO may refuse to perform a complete search. If this situation arises, the EPO will make a declaration that no meaningful search can be performed and will invite the applicant to indicate which subject matter should be searched. The deadline for providing this information is two months. If the patent applicant fails to provide this information, then the EPO will issue a partial search report or a declaration that they cannot carry out any meaningful search. This rule change will also help patent applicants direct the EPO to search the subject matter of most interest to them.

Overall, the European patent practice changes going into effect next year will generally increase the cost of patent prosecution in Europe and place a greater burden for affirmative actions upon applicants for the timely filing of continuations and responses. However, the new requirements of the EPO may provide an opportunity for patent applicants to more actively direct search and examination of the subject matter of most interest to them, and possibly result in their obtaining a grant of European patent rights quicker.

Applicants for European patents are advised to work closely with patent counsel to effect smooth transitions for their pending and future cases under the new rules. In particular, the related patent applications of all European patent applications should be reviewed for possible divisional patent application filings. In addition, the claims of those European patent applications should be reviewed for possible amendment before they are searched by the EPO to avoid a hasty amendment or loss of an opportunity to amend the claims altogether.



If you have any questions regarding this article, please feel free to contact any of the attorneys listed below or the Sutherland attorney with whom you regularly work.

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