

**SIGNIFICANT CHANGES IN THE PROSECUTION  
OF EUROPEAN PATENT APPLICATIONS  
Effective April 1, 2010**

Amended rules of the European Patent Convention with a major impact on procedural aspects enter into force on April 1, 2010. The new rules apply to European applications filed both before and after April 1, 2010.

In brief, the new rules:

- impose heavy restrictions on the filing of divisional applications;
- reduce the possibilities of having more than one independent claim searched; and
- make it compulsory to reply to objections raised in an opinion accompanying a search report drawn up by the European Patent Office (EPO), setting in some cases very tight time limits for replying to such objections.

The main changes are outlined in the following. Please take into account that this information is very general in nature and does not constitute legal advice. Should you have an inquiry on a particular case or situation, please feel free to contact us.

**Filing of divisional applications**

The practice that divisional applications may be filed at any time up to the grant of a parent application will be restricted.

According to the new rules, any voluntary divisional application (not arising from an objection of lack of unity from the EPO), must be filed within 24 months from a first examination report (communication under Art. 94(3) EPC) issued by the EPO in the earliest European application in the patent application family. The *earliest application* is the parent, grandparent, or any earlier ancestor: thus it is not possible to extend the time limit by a sequential filing of divisional applications.

In the event that the EPO determines for a first time there to be a lack of unity of invention under Article 82 EPC during the prosecution of a European patent application, new Rule 36(1)(b) sets a time limit of 24 months from such communication to file divisional applications to pursue other inventions.

Other existing conditions for filing a divisional application, for example that the parent application from which it is divided must still be pending, are maintained.

A transitional period is available for any application pending on April 1, 2010, on which a first communication has already been issued. In instances where the time limits have already expired or are already running on April 1, 2010, the time limit to file divisional applications will expire on October 1, 2010 (or later, if the 24 months expire later).

## **Search restrictions**

Under the new rules it will be more difficult to have several independent claims, or claims having too broad a scope, searched in the European search stage.

The EPO allows only a single independent claim (subject to Rule 43(2)) in each of the following categories: product, process, apparatus and use. Under current practice, objections under this rule are dealt with during the examination phase. New Rule 62a makes compliance with Rule 43(2) necessary at a much earlier stage, namely before a search is carried out by the EPO. For example, if a set of claims includes more than one independent claim in a category (e.g. apparatus), and even if there is unity of invention between them, the applicant may be invited to indicate which one of the claims should be searched. If the applicant fails to reply, the EPO will search the first independent claim in each category. It will not be possible in this case to pay further search fees in order to have other independent claims searched.

In the event that the EPO considers that a full search cannot be made because the claims are too broad or otherwise unclear, under new Rule 63 it will first issue a communication inviting the applicant to state the subject-matter to be searched. If the applicant fails to reply, a declaration of no-search or a partial search will then be issued.

Subject matter which has not been searched will not be examined, and cannot serve as the basis for later amendments. Unsearched subject matter will have to be removed from the claims and, if desired, prosecuted in a divisional application.

The new restriction is independent from a finding of lack of unity. If in the search stage the EPO raises an objection of lack of unity, the current practice of issuing a partial search report and giving the applicant the opportunity to pay further search fees is maintained.

## **Reply to objections raised in an EPO search report**

Under previous practice, an applicant was not required to respond to any objections arising in an opinion accompanying a European search report. The search opinion was meant to express the preliminary view of the examiner on the patentability of the claims as filed and required no action by the applicant. If the applicant chose not to respond to the search opinion, the same opinion would later be reintroduced in the first examination report.

Under the new rules it is now mandatory to reply to the objections raised in a search opinion drawn up by the EPO, in the same way as if it was an examination report by filing arguments and/or appropriate amendments.

This applies to both direct European applications and Euro-PCT applications entering the European regional phase. The time limit available for filing a reply differs depending on the situation, as explained in the following:

**a) Direct European patent applications**

If any deficiencies in the application are noted in the opinion accompanying the European Search Report, the applicant must comment and, where appropriate, correct any deficiencies within the same time limit that is available for requesting examination (6 months from publication of the search report).

The new rules apply to European applications already pending for which the European Search Report is issued on or after April 1, 2010.

**b) Euro-PCT applications, where the EPO was the International Searching Authority (ISA) and/or the International Preliminary Examining Authority (IPEA)**

Shortly after entry into the European regional phase, the EPO will issue an invitation to respond to the Written Opinion of the International Search Report (or, if a demand was filed, to the International Preliminary Examination Report). The applicant will have a time limit of one month after such invitation to file an appropriate response.

The deadline is the same as the one that was previously applicable for voluntarily amending the set of claims after entering in the regional phase (communication under Rule 161 EPC). Thus, in practice, there will be in general less than two months after entry into the European regional phase for addressing the objections raised in the international phase.

The new procedure applies to applications for which a communication under Rule 161 is issued on or after April 1, 2010.

**c) Euro-PCT applications where the EPO was not the International Searching Authority (ISA)**

In such cases, the EPO will draw up a Supplementary Search Report after entry in the European regional phase.

Under the new rules, the applicant must file comments and/or amendments to address objection raised in the Supplementary Search Report within a time limit of 6 months after an invitation to confirm the request for examination

The amended rules apply to Euro-PCT applications for which the EPO Supplementary Search Report is issued on or after April 1, 2010.

For all three situations above, if the mandatory reply to the EPO search opinion is not filed in due time, the application is deemed withdrawn. However, further processing of the

application may be requested by paying a fee and simultaneously filing the mandatory reply within 2 months after notification of the loss of rights.

## **Voluntary amendments**

The same time limits for replying to the EPO search opinion apply also to any voluntary amendment the applicant may want to introduce in the claims, description and/or drawings. This deadline for voluntary amendments applies also when the search opinion raises no objections.

Under the new rules, this is in fact the only opportunity to make amendments to the application without the consent of the examiner.

## **Further information**

Official information on the EPC rule changes may be found on the European Patent Office website, at:

- [http://archive.epo.org/epo/pubs/oj009/10\\_09/10\\_4819.pdf](http://archive.epo.org/epo/pubs/oj009/10_09/10_4819.pdf) (Notice from EPO regarding divisional applications)
- [http://archive.epo.org/epo/pubs/oj009/11\\_09/11\\_5339.pdf](http://archive.epo.org/epo/pubs/oj009/11_09/11_5339.pdf) (Notice from EPO regarding search restrictions and reply to search opinion)
- <http://www.epo.org/patents/law/legal-texts/guidelines-2010.html> (Revision of the Guidelines for Examination - Draft version)

Clients of ZBM Patents will be informed on a case-by-case basis of the specific deadlines for filing divisional applications and for replying to objections raised in an opinion accompanying an EPO search report.

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