



Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

New Rules of the EPC

Jens Horstmannshoff

October 2010

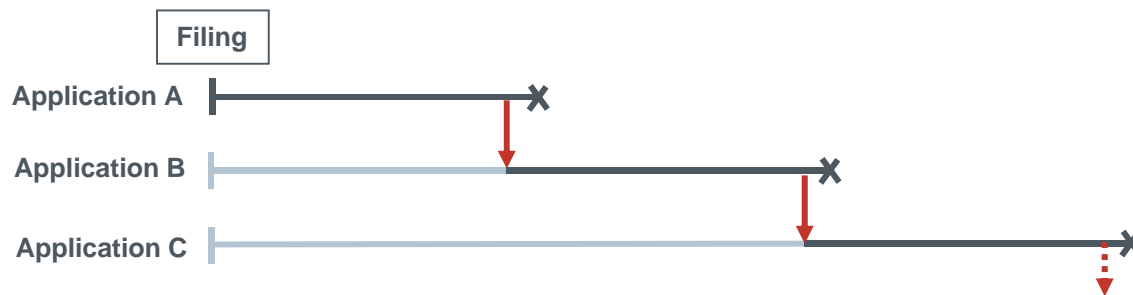


Overview

- New rules of the European Patent Convention (EPC) from April 2010 ("Raising the bar"):
- Divisional applications filing periods
- New search procedure
- Mandatory response to search opinions

Divisional Applications - Previous Procedure

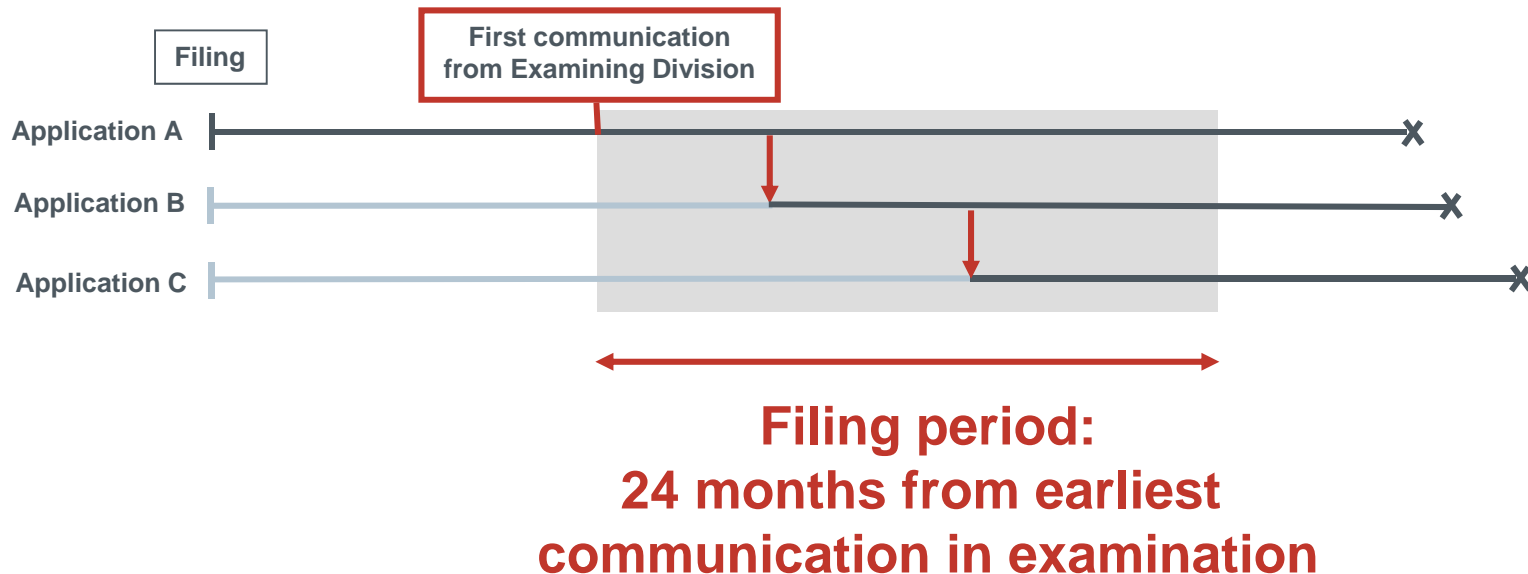
- General:
 - Applicant may file divisional applications (Article 76(1) EPC)
 - Content may not extend beyond the content of parent application
 - Divisional has filing date i.e. priority of "parent" application
- Previous divisional filing procedure:
 - May be filed for any pending "parent" patent application



=> Applications can be pending for a long time
=> Legal uncertainty for competitors (G01/05)

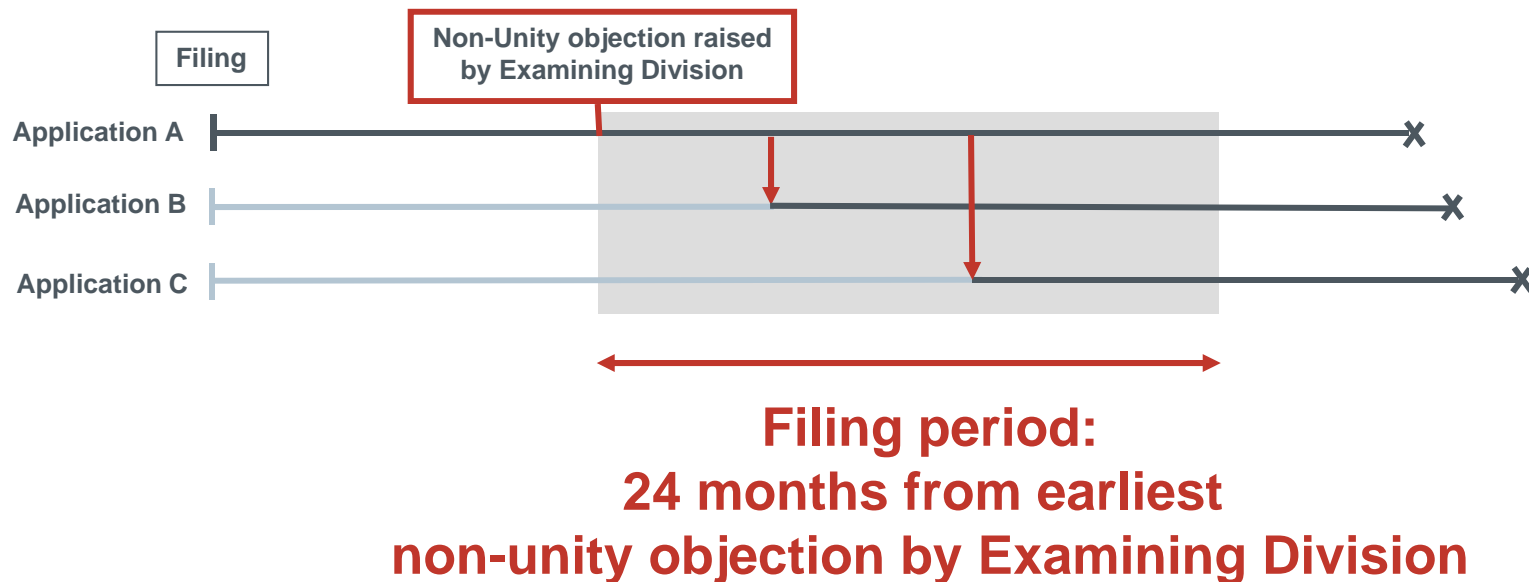
Divisional Applications - New Procedure (I)

- Additional requirement for filing divisionals:
 - One of the following filing periods must not have expired:
 - Voluntary division filing period (Rule 36(1)(a) EPC)
 - Mandatory division filing period (Rule 36(1)(b) EPC)
- Voluntary division filing period (Rule 36(1)(a) EPC):



Divisional Applications - New Procedure (II)

- Requirement of Unity (Article 82 EPC, Rule 44 EPC):
 - Application shall relate only to one invention or to group of inventions linked by a single general inventive concept
 - Additional inventions must be erased
 - May be filed as divisional applications => mandatory division
- Mandatory division filing period (Rule 36 (1)(b) EPC):



Search - Number of Independent Claims (I)

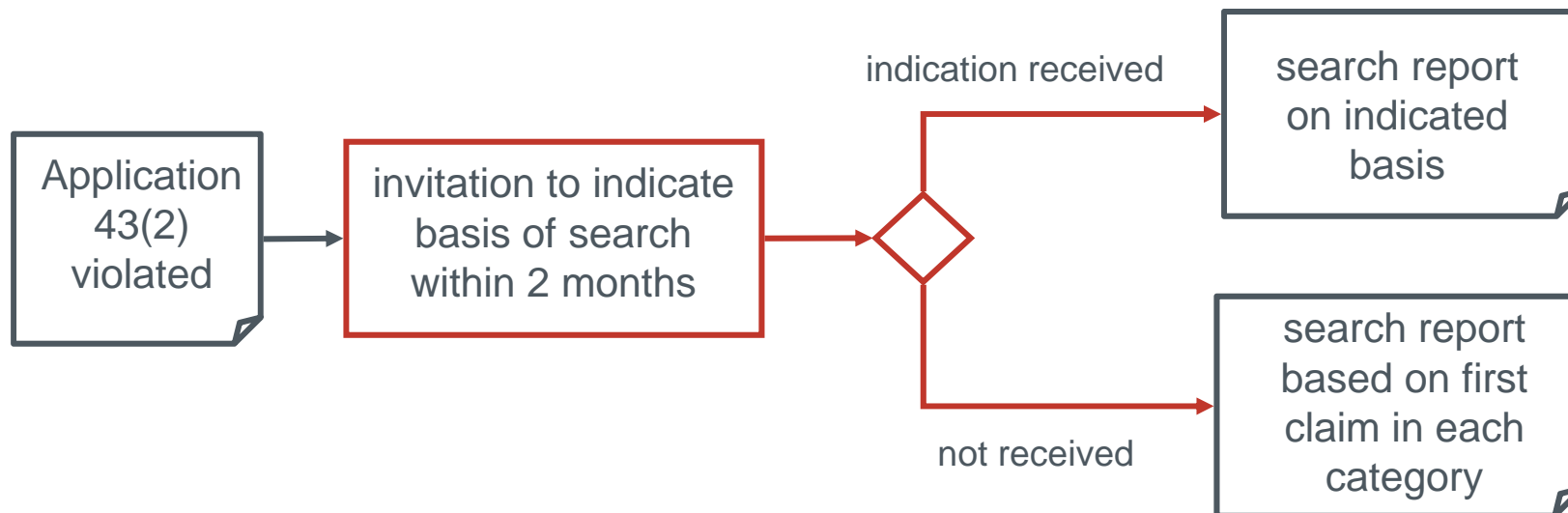
- **Requirement: Number of independent claims (Rule 43(2) EPC):**
 - Only one independent claim per category (apparatus, method ...)
 - Exceptions:
 - Plurality of interrelated products (e.g. transmitter- receiver)
 - Different uses of a product or apparatus
 - Alternative solutions to a particular problem where inappropriate to cover them in a single claim

=> Desired scope of protection might be unclear if
Rule 43(2) EPC is not respected

- **Previous procedure for applications violating Rule 43(2) EPC:**
 - No interaction between search examiner and applicant
 - Incomplete search
 - Examination phase: claims must be restricted to searched subject-matter according to Rule 43(2) EPC

Search - Number of Independent Claims (II)

- New search procedure since April 2010 (Rule 62a (1) EPC):



- Examination (Rule 62a (2) EPC):
 - Applicant is invited to restrict claims to searched subject-matter
 - Exception: Rule 43(2) EPC objection was not justified
 - Unsearched subject-matter may not be added to claims in the procedure (Rule 137(5) EPC)

Search - No Meaningful Search Impossible (I)

- **Further requirements:**

- Certain subject-matters are excluded or are not regarded as inventions e.g. business methods, computer programs, presentation of information or methods for treatment (Articles 52(2)(3) and 53 EPC)
- Claims must be clear, concise and supported by the description (Article 84 EPC)
- Application must disclose invention sufficiently clear and complete to be carried out by skilled person (Article 83 EPC)

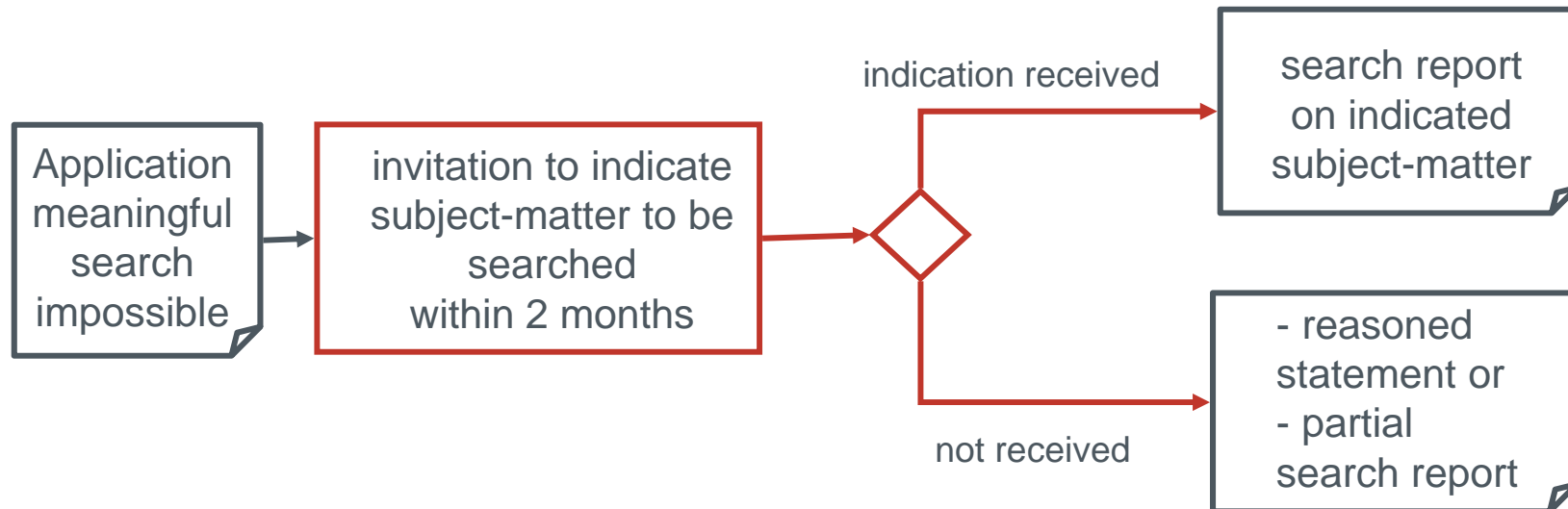
=> Meaningful search might be impossible

- **Previous procedure:**

- No interaction between search examiner and applicant
- Incomplete search or no search with reasoned declaration
- Examination phase: claims must be restricted to searched subject-matter or potential additional search report

Search - Meaningful Search Impossible (II)

- New search procedure since April 2010 (Rule 63 (1)(2) EPC):



- Examination
 - Partial search report or reasoned declaration are considered as search report (Rule 63(2) EPC):
 - Applicant is invited to restrict claims to searched subject-matter (Rule 63(3))
 - Exception: Rule 63(1) EPC objection was not justified (Rule 63(3))
 - Unsearched subject-matter may not be added to claims in the procedure (Rule 137(5) EPC)
 - Potential additional search report

Response to Search Report and Search Opinion (I)

- Previous procedure:
 - European applications and Euro-PCT:
 - Upon receipt of search report and negative search opinion
 - Direct request for examination
 - No response to negative search opinion necessary
 - => original search opinion was resent as first communication
 - PCT with EPO as ISA:
 - Upon receipt of international search report and negative WO-ISA or IPER
 - Entry in to European Phase
 - No response to negative WO-ISA or IPER necessary
 - => Reference to WO-ISA or IPER was sent as a first communication

=> Slow and inefficient procedure

Invitation to Respond to Extended European Search Report New Rule 70a EPC

- Euro direct and Euro-PCT with Supplementary European Search Report
- Search Opinion (Rule 62 EPC) is **negative**

New Rule 70a(1) EPC

- Period = 6 months from mention of publication of the search report in European Patent Bulletin (Rule 70(1) EPC)

New Rule 70a(2) EPC

- In case of Rule 70(2) EPC or Euro-PCT with supplementary European search report
- Period for EP: = as for 70a(1) EPC;
- Period for Euro-PCT = 6 months from notification of relevant communication
- Failure to comply in due time to communication under 70a(1) or (2) EPC = application deemed withdrawn
- In case examination fee has been paid early and voluntary waiver to confirm maintenance of application filed (Rule 70(2) EPC) then Rule 70a EPC does not apply as no written opinion issued. Instead a communication under Article 94(3) EPC is issued.

Obligatory Response to Negative WO-ISA / IPER Amended Rule 161 EPC

Amended Rule 161(1) EPC

- On entry into European phase
 - EPO = ISA: obligatory response to WO-ISA
 - EPO = ISA & IPEA: obligatory response to IPER
- **No response required if:**
 - Amendments or comments responding to the WO-ISA or under Rule 159(1)(b) EPC (also after IPER) or amendments under Article 19 PCT maintained on entry into European phase
- **Response required if:**
 - Amendments under Article 19 or 34 PCT **already considered** by EPO as ISA & IPEA in **IPER**
- Time limit = 1 month from communication under Rule 161(1) EPC
- Failure to comply in due time = application deemed withdrawn

Amended Rule 161(2) EPC

- Procedure after issuance of supplementary search report is ruled by Rule 70a(2) EPC

Questions?

- Email: jhorstmannshoff@epo.org

