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Review of Recent Rule Changes at the European Patent Office

James Gray

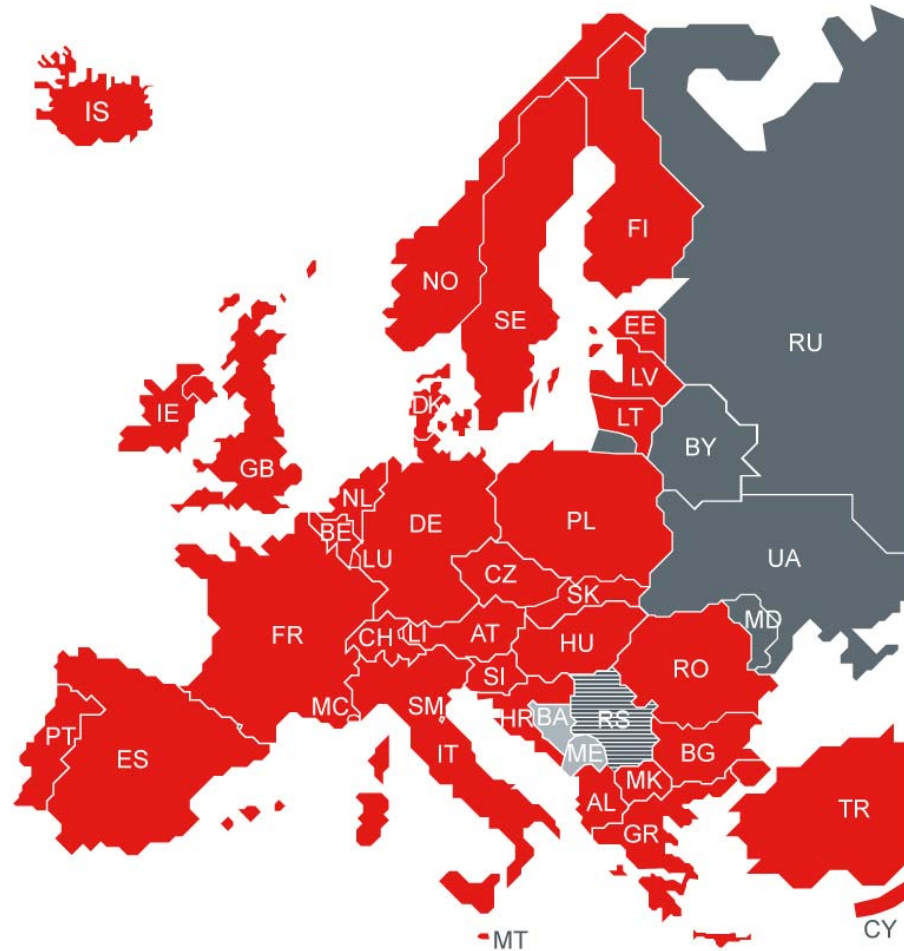
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Topics

- Brief recap of the European Patent System
- Review of the rule changes
- Future changes

The European Patent System

- European Patent Office established 1977
- Offices in Munich, Berlin, Vienna and the Hague
- Three official languages
- 37 Contracting states
- 3 Extension states



The European Patent System

- Filing
 - Direct EP
 - EP Regional Phase Entry
- Search
- Examination
- Grant
- Validation
- Opposition

Rule Changes - EPO aims

- Earlier focus on scope of protection sought
- Ensure appropriate documents for examination
- Reduce the need for additional searching
- Concentrate examination on searched subject matter
- Faster examination
- Restrict the filing of divisional applications

2008/2009 Changes

- Revision of excess claims fees
 - Euro 200 (210) for each claim in excess of 15
 - Euro 500 (525) for each claim in excess of 50
- Introduction of page fees upon filing
 - Euro 12 (13) for each page in excess of 35
- Introduction of single designation fee
 - Euro 500 (525)

2010 Changes - Search

- Clarification of subject matter to be searched
 - Multiple independent claims in same category
 - Applicant invited to limit to single independent claim in each category
 - 2 month time limit - no extension
 - Challengeable

2010 Changes - Search

- Clarification of subject matter to be searched
 - Where claims deemed too broad or unclear
 - Applicant invited to file a statement indicating subject matter to be searched
 - 2 month time limit - no extension
 - Failure to respond results in partial search or a declaration that no search is possible

2010 Changes - Search

- Consequences
 - Subject matter that has not been searched will not be examined
 - Amendments to claims in examination cannot relate to unsearched subject matter
 - Early review of claims essential

2010 Changes - Amendment

- Amendments - indication of basis
 - All amendments must be identified and basis given
 - Failure results in invitation from EPO
 - 1 month time limit
 - No response results in application being deemed withdrawn

2010 Changes - Amendment

- Limitation of opportunity to voluntarily amend application
 - Euro-PCT (EPO=ISA) in response to Rule 161 communication
 - Direct EP or Euro-PCT (EPO not ISA) when responding/commenting upon European search report
 - Further amendments require consent of the Examiner

2010 Changes - Euro-PCT

- Obligatory response to WO-ISA/IPER where EPO is ISA
- Time limit 1 month from Rule 161 communication - no extension
- No response = application deemed withdrawn
- Bear in mind amendment restrictions

International Phase	<p>ISA = EPO</p> <p>Negative Written Opinion</p> <p>↓</p>	<p>ISA = EPO</p> <p>Positive Written Opinion</p> <p>↓</p>	<p>ISA ≠ EPO</p> <p>↓</p>
Regional Phase	<p>Amendments filed on Regional Phase Entry?</p> <div> <div> <p>YES ↗</p> <p>Rule 161 Comm. FORM 1226B</p> <p>↓</p> <p>Response Optional 1 MONTH</p> <p>Final Opportunity for Voluntary Amendments</p> </div> <div> <p>↘ NO</p> <p>Rule 161 Comm. FORM 1226A</p> <p>↓</p> <p>Response Mandatory 1 MONTH</p> <p>Loss of Rights if No Response Filed</p> </div> </div>	<p>Amendments filed on Regional Phase Entry?</p> <div> <div> <p>YES ↗</p> <p>Rule 161 Comm. FORM 1226B</p> <p>↓</p> <p>Response Optional 1 MONTH</p> <p>Final Opportunity for Voluntary Amendments</p> </div> <div> <p>↘ NO</p> <p>Rule 161 Comm. FORM 1226A</p> <p>↓</p> <p>Response Optional 1 MONTH</p> <p>Form states response is mandatory but it is not. HOWEVER, it is recommended to write to the EPO to point out that WO was positive. In addition, if the WO contained <u>any</u> objections, (even formal matters), respond to these NOW.</p> </div> </div>	<p>↓</p> <p>Rule 161 Comm. FORM 1226C</p> <p>↓</p> <p>Response Optional 1 MONTH</p>

2010 Changes - Direct EP

- European search report accompanied by search opinion
- Previously response voluntary - now mandatory
- Deadline same as for requesting examination
- Similar provisions for Euro-PCT where supplementary search report produced

2010 Changes - Divisionals

- Previous rule:
 - The applicant may file a divisional application relating to any pending earlier European patent application

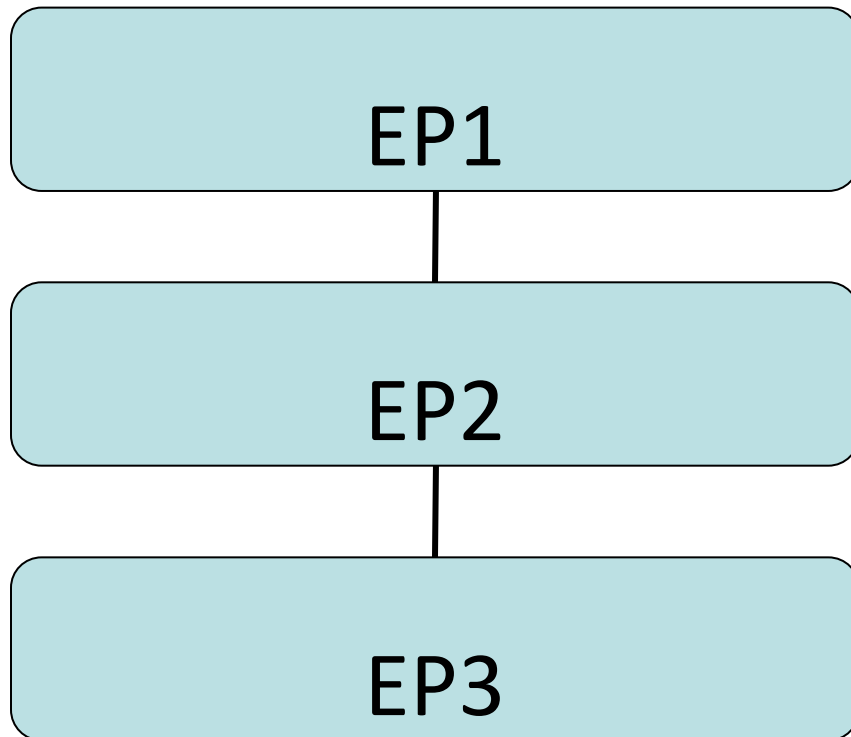
2010 Changes - Divisionals

- New rule:
 - The applicant may file a divisional application relating to any pending earlier European patent application, provided that at least one of the following periods has not yet expired:
 - the period for voluntary division under Rule 36(1)(a) EPC, or
 - the period for mandatory division under Rule 36(1)(b) EPC, where applicable

2010 Changes - Divisionals

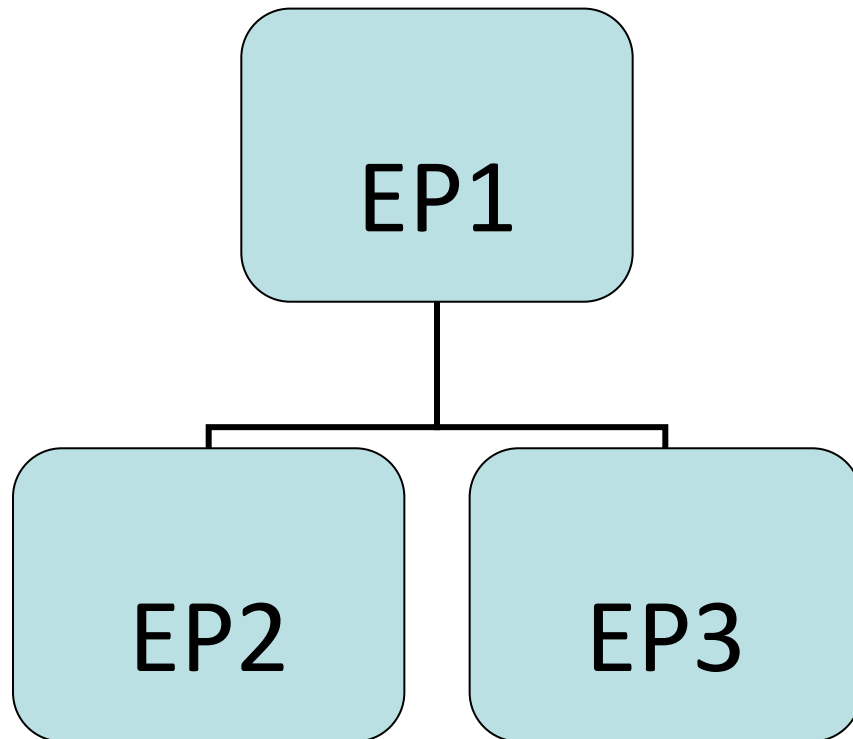
- Voluntary Divisional
 - Deadline - 24 months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued
 - Can be first OA or Intention to Grant communication

Voluntary Divisional



- Chains
- Voluntary div deadline to file EP3 is set by earliest communication from Examining Division on **EP1 or EP2**

Voluntary Divisional



- Branched
- Voluntary div deadline for filing EP3 is set by first communication from Examining Division on **EP1 only**
- Not the whole family, just the chain
- Therefore **divide from the earliest pending application available**

2010 Changes - Divisionals

- Mandatory Divisional
 - filed on the basis of a pending earlier application before the expiry of a time limit of 24 months from any communication in which the Examining Division raises a particular non-unity objection under Art.82 EPC for the first time

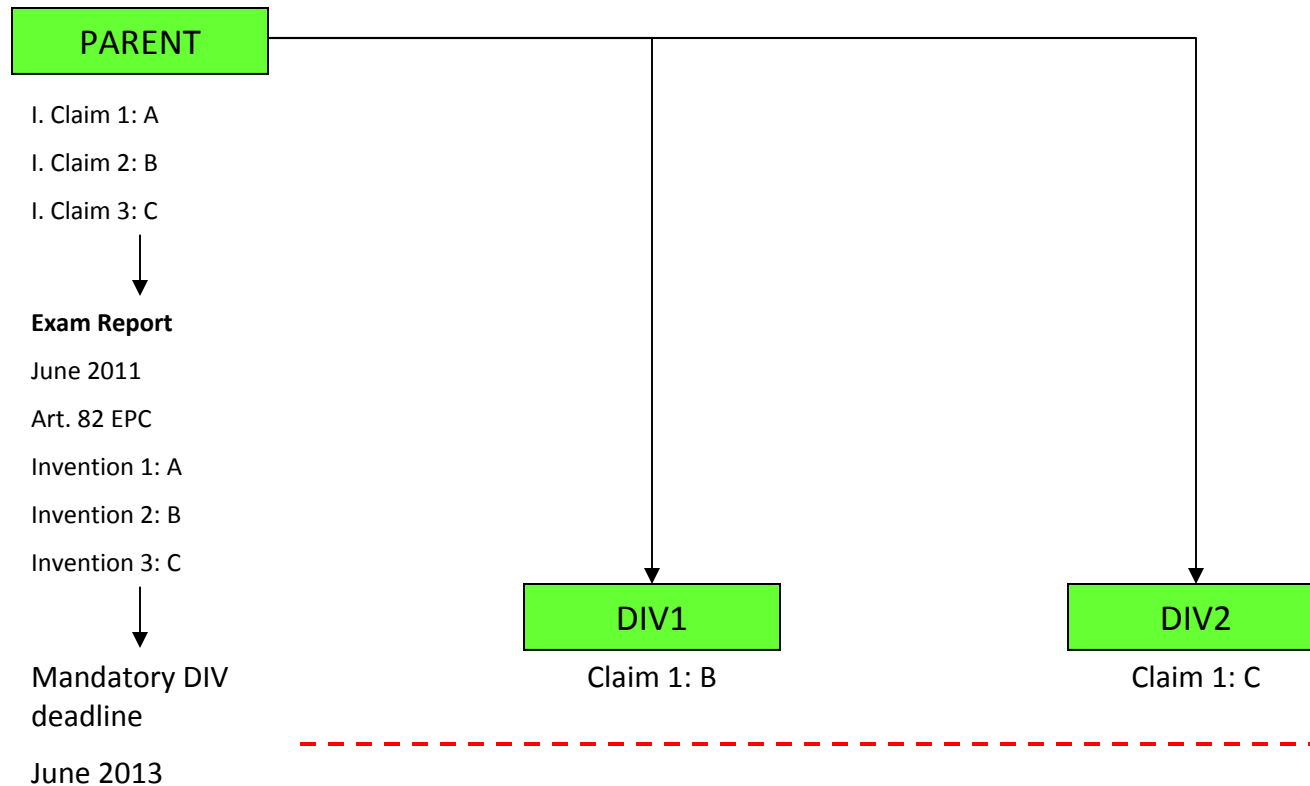
2010 Changes - Divisionals

- The 24 month time limit can only be triggered by a communication from the Examining Division in which a new, different non-unity objection is raised
- Triggers include: Office Action, Summons to Oral Proceedings and personal or telephone interview

Mandatory Divisional Applications

New Rule 36(1)(b) EPC

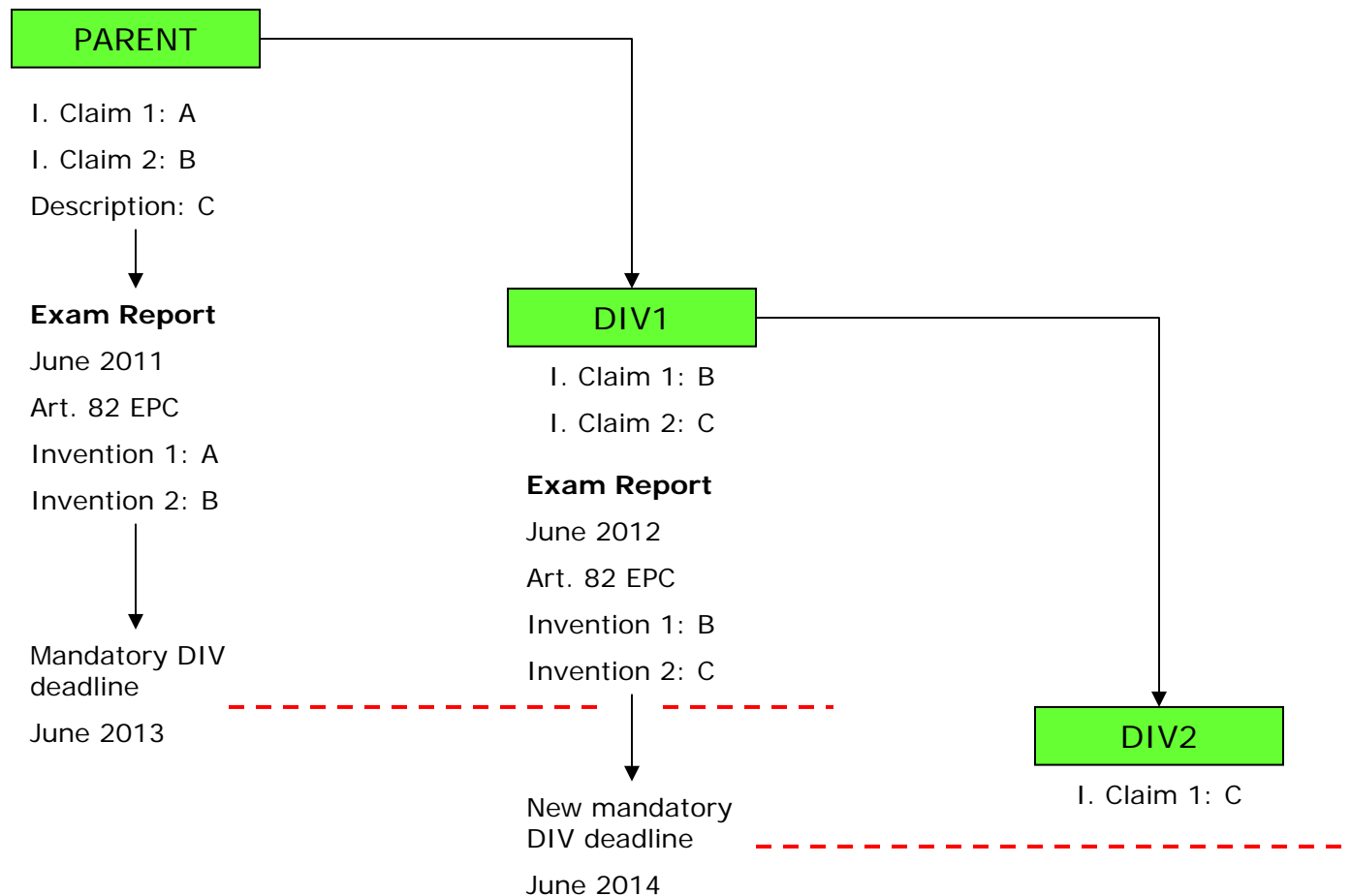
"Mandatory divisionals"



Mandatory Divisional Applications

New Rule 36(1)(b) EPC

"Mandatory divisionals"



Mandatory Divisional

- Do not assume that an objection of lack of unity can be forced and hence a mandatory divisional deadline created
- The EPO can raise objection of lack of clarity or multiple claims in same category instead, and the applicant cannot object to their choice of ground of objection

2010 Changes - Divisionals

- The new rules entered into force on 1 April 2010
- The transitional provisions extend any expired or pending deadlines to 1 October 2010
- Are the EPO ready?

2011 Rule Change

- Requirement to file a copy of the results of any search carried out by the authority with which the priority application was filed
- Upon filing of EP application or upon entry to EP Regional Phase, or without delay after the search results have been made available to the Applicant
- Entry into force - 1st January 2011

2011 Rule Change

- If search results are not on file with the EPO by the time that the Examining Division assumes responsibility for the Application, then an invitation to file results or make statement as to why results are not available is issued
- Non-compliance - Application deemed withdrawn

Oral Proceedings by Video Conference

- Available for Examining Division Oral Proceedings
- Undertaken at the discretion of the Examining Division
- Possibility for multi-way conferencing

Summary

Thank you

Questions?

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