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Imminent EPO Rule Changes will increase onus and burden on Applicants

Starting 1 April 2010, new Rules will be implemented by the EPO with no transitional period. The new Rules form part of the drive to substantially accelerate patent prosecution and to minimise burden on EPO Examiners.

The main intention of the amendments is to require applicants to focus at a very early stage of prosecution on allowable subject matter which they intend to prosecute to grant. For many applicants this will mean earlier than expected substantive review of an application, the relevant prior art documents and any objections raised by the EPO. We recommend that Applicants review their pending or prospective International patent applications which are due to enter the regional phase after December 2009, to ascertain how the new regime will affect their patent prosecution strategies.

Mandatory response to European Search Opinions

All Search Reports issued by the EPO are now accompanied by an opinion which provides an outline of any patentability objections. Currently an applicant is not obliged to reply to these objections. From 1 April 2010, if no request for examination has been filed, the applicant will be given a six month period following the publication of the search report in which to file a full response. On the other hand, if a request for examination has been filed, the deadline for filing a full response will be only two months from the issue of an EPO communication inviting response. If the applicant fails to respond to the EPO before any of the new deadlines the application will be deemed withdrawn and recoverable only by "further processing".

Applicants who file directly at the EPO might wish to consider delaying the filing of a request for examination in order to benefit from the longer six month response period.

Mandatory response to Written Opinions and International Preliminary Examination Reports

For those cases in which the EPO is the International Searching Authority for a PCT application, the EPO will require a response to any objections in the Written Opinion (ISA-WO) shortly after entry into the European regional phase. The EPO will set a one month deadline to file a full response and, in the same communication, invite the applicant to pay claims' fees.

Given the short deadline, a response to any objections raised in the Written Opinion will generally need to be considered even before the deadline for entry of the regional phase. We will be happy to advise on dealing with the objections as soon as you receive your International Search Report and Written Opinion from the EPO as ISA.

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Mandatory identification of basis for all amendments to the application.

The new Rules stipulate that an applicant must identify and provide basis in the original text for all amendments to the application. A one month deadline will be set if this information is found to be lacking.

The clear intention of these rule changes is to reduce the workload of the EPO examiners by removing steps currently available and useful to applicants who wish to delay substantive prosecution. For example, the issue of a first EP Examination Report that simply refers to the ISA-WO/IPER previously issued by the EPO.

From the perspective of companies with slow-moving projects, this seems disadvantageous since they may not know what direction the application will take at such an early stage in prosecution. Since the EPO will not require a response to any International Written Opinions or Examination Reports produced by other Patent Offices, applicants may want to carefully reconsider their motivation in selecting the EPO as ISA.

Two other changes are proposed which differ in nature from those set out above. These changes are not mandatory and it is ultimately up to the applicant whether or not to comply.

Clarification of important subject matter to be searched

Where an application contains deficiencies such that a proper search cannot be conducted, EPO examiners will contact the applicant's representative during the search phase in order to seek clarification of what must be searched. Absent a reply, the EPO will issue an incomplete search report or a declaration of no search.

This change should be of help to certain applicants who might otherwise be faced with unexpected restriction of the search and consequential involuntary constraint on the subject matter which can be examined.

Multiple independent claims

Where an application contains several independent claims, the EPO examiner will contact the applicant's representative to ascertain which claims are to be searched. Absent a reply, the EPO will search only the first claim in each category (product, method, use).

Divisional applications

The recently announced changes in divisional practice have been previously reported <http://www.hgf.com/pdf/briefingnotes/hgfbriefingnote310309.pdf>. As from 1 April 2010, the EPO will introduce a 24 months' time bar on filing of divisional applications. Whether the new time bar and prohibition on "rolling divisionals" results in fewer divisional applications overall will remain to be seen.

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