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EPO Rule amendments of 1st May 2011 (Rules 161 and 162 EPC) could be disadvantageous for those requiring accelerated prosecution

New Rules 161 and 162 EPC came into force on 1st May 2011 and the new procedures could have an impact on the strategies employed by applicants when entering the European phase.

The rule changes affect the term for:

- filing amendments to the description, claims and drawings; and/or
- commenting on the written opinion of the International Searching Authority (ISA) where the EPO has acted as the ISA or IPEA; and/or
- paying claims fees for each claim in excess of 15 claims.

The term has now been set to six months from notification of the communication under Rule 161 and 162 EPC (previously the term had been a single month).

These changes will mean that applicants will have more time to deal with the requirements of Rule 161 and 162 EPC and many will welcome these rule changes.

However applicants should also be aware that these changes have the potential to represent a barrier to those who wish to expedite patent prosecution. The problem for such applicants is that, where a Rule 161/162 communication is issued, the EPO will deem the requirements of Rule 161 and 162 are fulfilled **at the end of the six month deadline** and, only after the deadline has passed, will the application be sent to the Search Division for a supplemental search (where the EPO was not the ISA) or to the Examining Division (where the EPO was the ISA). This will have the effect of slowing down prosecution. This is regardless of when a response to the Rule 161 and 162 communication is filed.

An applicant can only avoid this delay by **waiving** his right to the communication pursuant to Rules 161 and 162 EPC when entering the European regional phase. Such a waiver will mean that the application will be more promptly forwarded to the Search Division or Examining Division (as appropriate). It should be borne in mind that the applicant, if making the waiver, must also make any amendments to the claims; pay any excess claims fees; and, if required, comment on the written opinion of the ISA when entering the European regional phase.

HGF believes that most applicants will welcome this extra time to deal with issues covered by Rules 161 and 162. Nevertheless those applicants requiring expedited prosecution must now take into account that they should proactively waive a right to the Rule 161/162 communication, file any amendments, pay any excess claims fees and respond to the written opinion of the ISA **when entering the regional phase**.

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