



NEW EPO RULES FORCE APPLICANTS TO MAKE EARLY CHOICES

Much earlier responses on substantive matters will be needed under new EPO rules that are due to come into effect on 1 April 2010. These changes could have a very significant impact on the drafting and prosecution of PCT applications being filed now. The changes mean that decisions on divisional applications, the claims to pursue and what amendments to make in view of any objections will have to be taken much earlier than under the existing rules.

Shorter time limits for filing divisional applications

There will be much more restrictive time limits on when divisional applications can be filed. For example, it may only be possible to file divisional applications within two years of the first communication from the EPO examiner on the earliest European application in a family, for example a parent or even "grandparent" application. The new rules apply to all divisionals filed after 1 April 2010, but there will be a six month transitional period from 1 April 2010 in which it will be possible to file divisional applications on cases where the deadline under the new rules would otherwise have expired. Details are set out in the accompanying "Divisionals" newsletter. We will be reviewing cases next year, but please let your usual contact at Potter Clarkson know if you already think that you may wish to file any divisional applications under the transitional provisions.

Early mandatory responses to opinions accompanying EPO searches

The new rules set very short time limits for responding to objections that have previously been raised in opinions accompanying search reports issued by the EPO. Details are set out in the accompanying "Early decisions" newsletter. As an example, for an ex-PCT application for which the EPO was the ISA, the applicant will typically have to respond to the written opinion within one month of being invited to do so by the EPO. It is likely that the invitation will be issued promptly after entering the regional phase at the EPO. Similarly, for an ex-PCT application for which the International Searching Authority (ISA) was the USPTO, the applicant will typically have to respond to the opinion accompanying the EPO's supplementary search by the deadline for confirming that they wish to proceed with the application, which is generally around two to three months after the supplementary search report is issued. If we haven't heard from you within a month of sending you a supplementary search report we will contact you to agree any further action.

Early selection of the subject matter to be searched

Other rule changes mean that the EPO can set a deadline of two months for clarifying the subject matter to be searched or for selecting which of multiple independent claims in one category (product, process, apparatus or use) are to be searched. In practice, the excess claims fees due for claims over 15 also make it desirable to make an early decision on which claims to pursue. Again, details are set out in the accompanying "Early decisions" newsletter.

Accordingly, decisions and responses on substantive matters will be required very soon after entering the regional phase at the EPO. We will endeavour to alert you to potential concerns before

filing the European application, as well as keeping you informed of any objections raised by the EPO.

Clearly, these changes will bring forward decisions on what scope of protection to pursue. Your usual contact at Potter Clarkson will be able to provide you with more detailed advice on how best to proceed in these new circumstances.

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The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Potter Clarkson LLP. All comments contained here are of a general nature and full professional advice should be sought on any specific problem. Please note that all our Newsletters can be found on our website: www.potterclarkson.com.

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