



EARLY RESPONSES NEEDED UNDER NEW EPO RULES

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 which 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.

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. These objections can variously take the form of 'extended search reports', International Preliminary Reports on Patentability (IPRPs) or Written Opinions from the International Search Authority (WO/ISAs).

For a direct European application, the applicant will have to respond to the opinion accompanying the search report by the deadline for requesting or confirming examination, i.e. by six months from the publication date of the European search report; or if examination has already been requested, by the deadline set by the EPO for the applicant to confirm that they wish to proceed. Otherwise, the application will be deemed withdrawn.

On an ex-PCT application for which the International Searching Authority (ISA) was not the EPO (for example where the ISA was the USPTO), the EPO issues a supplementary search report, accompanied by a patentability opinion. The applicant will have to respond to that opinion by the deadline for requesting examination or 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. Otherwise the application will be deemed withdrawn.

For an ex-PCT application for which the EPO was the ISA, the applicant will typically have to respond to the written opinion (or IPRP, if the EPO has issued one) within one month of being invited to do so by the EPO. Otherwise the application will be deemed withdrawn. It is likely that the invitation will be issued promptly after entering the regional phase at the EPO.

Thus, if the EPO is chosen as ISA then it is likely that the applicant will have to respond very soon after entering the regional phase at the EPO, though to objections that may have been raised several months before. The objections and response should ideally be considered during the International phase as there will be very little time to do so after entering the regional phase.

If instead the USPTO (for example) is the ISA then a response may not be required quite so soon, but there may be only a few months between receiving the EPO's search report and objections and having to respond. Accordingly, if we have not heard from you within a month of sending a supplementary search report to you then we will contact you to decide on any further action.

Early selection of the subject matter to be searched

Other rule changes mean that the EPO can refuse to search more than one independent claim in

each category (product, process, apparatus or use). The applicant will have two months from an invitation from the EPO to choose which claims to have searched and/or to explain why it is acceptable to have more than one independent claim in each category; otherwise, only the first claim in each category will 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.

Further rule changes mean that the EPO can also set a two month deadline for the applicant to clarify the subject matter to be searched if the EPO considers that it is not possible to carry out a meaningful search for some or all of the claimed subject matter. Otherwise the EPO will decide on the subject matter to search, which could limit the subject matter that is ultimately examined.

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.

Drafting considerations

Existing Rule 164 already works against applicants who use the PCT route but do not select the EPO as the ISA, since the EPO can deem there to be a lack of unity when carrying out its supplementary search report even though no lack of unity was found by the ISA (e.g. the USPTO), or where non-unity is found and not all possible additional search fees are paid in the International Phase. In this situation, the EPO will search only the first-mentioned invention, and there is no opportunity to pay additional search fees for other inventions. If the examiner then maintains the non-unity objection, the unsearched claim(s) can be prosecuted only in a divisional application, potentially at great expense. (And, due to rule changes effective April 2010 on which we are alerting you separately, the divisional(s) would have to be filed much earlier than at present.)

Hence, it is very important, if you suspect that there could be a non-unity objection, for the PCT application to be drafted with the most important invention claimed first. It could still be important to include all inventions of potential interest in the claims. Moreover, if the EPO finds a lack of unity in a broad independent claim, it will just search the first subsidiary claim that, in its opinion, represents a single invention. It is therefore important to bear this in mind when drafting sub-claims in the PCT application.

The EPO rules changes discussed above also reinforce these points. If multiple definitions of the invention are included during drafting then a choice between them will have to be made early during European prosecution.

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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