



LATEST IP UPDATE FROM POTTER CLARKSON

GETTING IN SHAPE FOR THE NEW EPO RULES

New European Patent Office (EPO) rules will come into effect on 1 April 2010, as we set out in our newsletters of July 2009. This newsletter follows up with actions that you can take now, particularly for ex-PCT applications that are due to enter the European regional phase at the EPO in the next few months.

Under the new rules, much earlier responses on substantive matters will be needed than have been required up to now. Entering the regional phase before the new rules come into effect may minimise the effects of the rules changes on an application. Even if early entry is not desirable for a particular application, we can alert you to potential difficulties so that you have longer to consider your options.

Early selection of the subject matter to be searched

Under the new rules 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.

- We can review proposed claim sets with you so that you can decide what you want to have searched well before the pressure of a short and non-extendible deadline.

The EPO will also be able to set a two month deadline for clarifying the subject matter to be searched if the EPO does not believe it 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.

- We can advise you in advance on areas in which we may need to clarify the subject matter to be searched.

Further, regardless of whether an objection to a lack of unity of invention was made during the International Phase by an International Searching Authority other than the EPO, the EPO can decide that the claims of an ex-PCT application lack unity of invention; or even that differing subject matters within a single independent claim lack unity. The EPO will then search only the first mentioned 'invention' that they identify in the claims. Hence, a relatively trivial Claim 2 might be deemed to be 'the first invention', resulting in the search being directed to that feature. There would be no opportunity to pay additional search fees for other 'inventions'. In theory, the examiner would be obliged to carry out an additional search without charge if we succeeded in arguing against a finding of lack of unity; however, success is generally unlikely. It would be possible to pursue the remaining subject matter only by filing one or more divisional applications, at considerable extra expense.

- We can advise you in advance if we think that there might be a non-unity objection, so that you have the opportunity to reorder the claims or options within a claim.

Early mandatory responses to opinions accompanying EPO searches

The new rules set potentially 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 an ex-PCT application in 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. Probably the invitation will be issued promptly after entering the regional phase at the EPO, so the applicant might probably have to respond very soon after expiry of the 31-month entry deadline to objections that may have arisen 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.

- We can review proposed claim sets with you so that you can think about

arguments/amendments well before the pressure of a very short and non-extendible deadline.

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 must respond to that opinion by the deadline for requesting examination or for confirming that the application will continue. Otherwise the application will be deemed withdrawn. The EPO has suggested that future deadlines may be six months (but with extensions of time generally not possible), so the timings may not be quite so pressured.

- We will review how the situation develops in practice and keep you informed.

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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Park View House
58 The Ropewalk
Nottingham NG1 5DD
United Kingdom

T: +44 (0) 115 9552211
F: +44 (0) 115 9552201
E: info@potterclarkson.com
W: www.potterclarkson.com