

**REDUCTION OF PCT WORK CARRIED OUT BY THE EPO FOR
UNITED STATES APPLICANTS**

Change of practice from 1 March 2002

In an effort to reduce its workload, the EPO has invoked certain parts of its treaty with WIPO, such that it will no longer be formally competent to conduct international *searches* or examination on certain patent applications in the fields of biotechnology or business methods, nor to conduct international *examination* in the field of telecommunication. The respective fields are defined by reference to specified international classes.

The change affects PCT applications filed at the USPTO or IB by a US national or resident as applicant (even if there are also non-US applicants). It comes into effect for applications filed on or after 1 March 2002 as far as searching is concerned, and applications for which a Demand is filed on or after 1 March 2002 as far as examination is concerned.

It appears that, if a search request or demand is filed on or after 1 March 2002, selecting the EPO as the ISA/IPEA in circumstances in which the EPO is not competent, then the search or examination, as appropriate, will be done by the USPTO.

The EPO notice can be viewed in full at its website (specifically at www.european-patent-office.org/epo/president/e/2001_12_11_e.htm).

Advice

For applications in the areas of biotechnology, business methods and telecommunications, the application and/or Demand should be filed before 1 March 2002, if search/examination at the EPO is particularly desired.

Alternatively, our US clients will probably wish to choose the USPTO for searching and examination of PCT applications in these technical areas.

Please contact Richard Bassett for further information.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. 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 at www.eric-potter.com.