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## IMPORTANT CHANGES TO EUROPEAN PATENT PRACTICE

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As of 1 April 2010, the European law covering a number of practical aspects will be changing. The following changes have been announced and a guidance note has been published by the EPO regarding how some of the wording of some of these new rules might be interpreted.

## **1. Divisional applications – reduced time to file**

Potentially the most important change is the reduction, in most cases, of the time available in which to file a divisional application. Under the current rules, a divisional application may be filed at any time while the application from which it divides is pending. Under the new rules, the filing of divisional applications will still only be allowed from applications which are pending but additionally the filing of the divisional must be:

- a) within 24 months of the Examining Division's first communication in respect of the earliest application from which a communication has been issued (a so called "voluntary divisional"), and/or
- b) within 24 months from a communication in which the Examining Division has raised a lack of unity objection, providing it was raising that specific objection for the first time (a so called "mandatory divisional").

In the situation of a voluntary divisional, "the Examining Division's first communication" refers to the first exam report, not the search report, even when the search report is accompanied by a written opinion that sets out objections. Also, in a situation where there is to be more than one divisional application in a family, the 24 month deadline runs from the date of the earliest exam report on the earliest of the applications in the family; this may therefore be a "grandparent" application rather than the direct "parent" application from which the divisional is filed.

In the situation of a mandatory divisional, a new 24 month period is allowed for filing a divisional application if a new objection relating to a lack of unity of invention is raised by the Examining Division. The intention is therefore that if an applicant is forced to delete subject matter due to a unity objection being raised, the possibility of protecting that subject matter through a divisional application is preserved, regardless as to how much time has elapsed since the first exam report on the earliest case in the family.

Some practitioners have considered the possibility of triggering such a new 24 month period by deliberately redirecting claims to a new invention. However in view of other new rules relating to the extent to which claims can be voluntarily redirected (see below), this will probably not be possible and it is certainly not safe to rely upon this tactic.

For any "real" new lack of unity objections raised by the Examining Division, in particular where a new piece of prior art cited by the examiner results in a previously unidentified lack of unity objection, then this part of the new rules will take effect and the 24 month period will be reset.

In a situation where there is more than one possible amendment to address an objection raised during examination, it might be worthwhile including all of these options as alternatives in the amended claims. If the European Examiner feels that these alternatives lack unity, and therefore requires a number of these to be deleted from the claims, a new 24 month period will then be started for filing divisional applications for the deleted subject matter provided that unity between these alternatives has not previously been mentioned. However, care should be taken that the revised claims as submitted meet the requirements of clarity and conciseness.

There will be a grace period for filing divisional applications from existing European applications where the deadlines under the new rules will have expired before 1 April 2010. In such cases, a divisional application may be filed until 1 October 2010. This grace period will also apply to any existing applications in which the new divisional deadline expires in the period from 1 April 2010 to 1 October 2010. Accordingly, when the new rules come into effect on 1 April 2010, any applicant for a pending European patent application is guaranteed at least 6 months from then within which to file divisional applications.

There might be a surge of divisional filings towards the end of September 2010 and we would therefore recommend that, if possible, divisional applications are considered for filing sooner than this because we do not know whether the e-filing servers and fax machines will be able to cope with demand.

## **2. Compulsory response to the search report**

Under the current rules it is not necessary to file a response to a search report. This will change under the new law, when a substantive response to the written opinion accompanying the European search report will become compulsory.

For directly filed European patent applications where no examination request has been filed prior to receiving the search report, the deadline for filing this compulsory response will be six months from the date of publication of the search report.

For directly filed European patent applications where an examination request has been filed prior to receipt of the search report, the response to the search report must be within the time period set by the EPO for confirming the examination request. This time period will probably be a two or four month time period, which is extendable up to a total of six months, from the EPO communication. However, a six month non-extendable deadline running from the publication of the search report could instead be set.

The same situation will apply for those European patent applications filed out of the PCT where a supplementary search report and accompanying written opinion is drawn up.

For European patent applications filed out of the PCT where the EPO was the International searching authority (ISA) a supplementary search report is not drawn up. In this case, the written opinion accompanying the International search report (which becomes the International Preliminary Report on Patentability under Chapter I) will need to be addressed, unless International Examination has been requested, in which case the issues to be addressed will be those set out in the International Preliminary Report on Patentability under Chapter II. The EPO will require the filing of a substantive response to the International Preliminary Report on Patentability shortly after entry into the regional phase. The deadline will be set by the communication that currently issues to set a one month deadline in which to file voluntary amendments to the claims.

If the EPO was not the International searching authority, there will continue to be a chance to amend the claims prior to the supplementary search report, by filing amended claims at the time of entering the regional phase or in response to the communication inviting voluntary amendments.

In the mandatory response to the search report, as well as addressing the objections set out in the written opinion by arguments and/or amendment, it is also permissible to make amendments to the description, claims and/or drawings of the applicant's own volition.

This change will come into effect as follows:

**a) Directly filed European patent applications**

All applications where the search report has not yet issued as at 1 April 2010

**b) European patent applications filed out of the PCT where the EPO was not ISA**

All applications where the supplementary search report has not issued as at 1 April 2010

**c) European patent applications filed out of the PCT where the EPO was ISA**

All applications where the voluntary amendments communication has not yet issued as at 1 April 2010.

Consideration could be given to filing European patent applications out of the PCT where the EPO is ISA well in advance of 1 April 2010, with the intention that the voluntary amendments communication should then have issued before 1 April 2010 and therefore the requirement for a response at an early stage is avoided.

It is worth noting that under the new regime, for European applications filed out of the PCT, especially those where the EPO was ISA, the European application could well be the first application out of the family of patent applications for a given invention to require a substantive response. This could lead to a change of focus, given that it is common for the strategy developed in dealing with the first substantive response to be used as a template for how to proceed in other countries in due course.

For those applicants having a choice of ISAs when filing a PCT application, the effect of having the EPO as ISA should be borne in mind. Under the new regime a European application filed out of the PCT where the ISA was the EPO will of require a substantive response at a very early stage; for some cases this might be a positive whilst for others it might be something that is to be avoided if possible.

### **3. Voluntary amendments**

Although it will remain possible to make amendments to the description, claims and/or drawings of the applicant's own volition, the last stage at which this will be permissible is in the mandatory response to the search report.

Therefore the possibility of making voluntary amendments up to the time of filing a response to the first examination report will be removed. Any voluntary amendments during the examination proceedings will be entirely at the Examiner's discretion. Amendments that can be said to address Examiner's objections do of course remain permissible.

### **4. Providing basis for amendments**

If amendments are made to the application with little or no guidance for the examiner as to where basis for the amendments can be found in the originally filed application, the new rules will allow the examiner to bounce the response back to the applicant without considering any substantive issues. The examiner will set a deadline of one month, within which the applicant will need to point out basis for the amendments before any substantive issues are considered.

In general, basis for any amendments will need to be clearly indicated to the examiner with every response in order to ensure that substantive issues are properly considered by the examiner and to minimise unnecessary expense in dealing with extra EPO communications relating solely to basis objections. Clearly it is generally good practice to provide basis for any



amendments that are made – it is in an applicant’s best interests that there is clear and unambiguous basis for any amendments to enhance the strength of any granted patent.

Hopefully examiners will not use this rule change overly strictly in order to avoid having to discuss substantive issues. However, in case this happens, it becomes even more important to ensure at the time of drafting that the words of the specification are framed in such a way that they can be lifted directly into the claims if necessary, in view of the fact that European examiners will usually look for literal corresponding sections of text in the original application to support any amendments made. It is not always easy to envisage what changes might need to be made during prosecution, but if this thought is kept in mind, some problems will be avoided.

## **5. Blocking unsearched subject matter from claims**

It is not so much a new rule, as a reinstatement of existing EPO practice, that amended claims may not relate to unsearched subject matter which does not combine with the originally claimed invention to form a single general inventive concept. Examiners are likely to become stricter in enforcing this particular rule since it dovetails with the new rules relating to the time limit for filing divisional applications mentioned above. It should not be possible to intentionally trigger a new 24 month period in which to file divisional applications by switching the claims of the application towards a completely new invention since the EPO will be able to refuse any such intentional amendments on the grounds that the amended claims may not relate to unsearched subject matter relating to a different invention.

It becomes even more important than at present to identify all inventions existing in a single application, and make sure they are searched, or are made the subject of divisional applications, relatively early during prosecution.

## **6. One independent claim per category**

Applications containing more than one independent claim in a particular category (product, process, use) will be more strictly scrutinised at the search stage. In such cases, the EPO will ask the applicant (within a two month deadline) to specify which of the independent claims is to be searched or to explain why the independent claims meet the exceptional circumstances under which more than one independent claim in a given category can be permitted. If the applicant provides no answer, the EPO will automatically search the claims which are mentioned first in the application.

This change will be potentially beneficial for applicants when there is a lack of unity between a number of independent claims in the same category, since at the moment the EPO simply searches the claim set associated with the first mentioned independent claim without taking into account the applicant’s wishes.

## **7. Impossible search**

Where the EPO believes that it is impossible to carry out a meaningful search due to failure to comply with the EPC (e.g. in cases where a claim is particularly unclear, lacks conciseness or relates to subject matter excluded from patentability), a two month deadline will be set within which the applicant is required to provide a statement indicating the subject matter to be searched. There is, as yet, no guidance as to what form this statement might take, or whether it might later be used in prosecution by the examiner (or by the applicant) in order to provide a limitation on interpretation of the claims, or to require amendment of the claims. If no such statement is filed, the EPO will issue a reasoned communication saying that it is impossible to carry out a search, or draw up a partial search report if they believe it is possible to search only some of the subject matter.

## Summary

The EPO has effectively transformed the European search report into an exam report; there is a deadline for response and this response provides the final opportunity for the applicant to amend the application of its own volition. The overall effect should be that there is to be an acceleration of prosecution of EP applications, unless the EPO begins to slow down the rate at which search reports are generated.

When entering the European regional phase from a PCT application, if the EPO is the ISA it will be good practice to have a response to the written opinion available immediately.

With regard to divisional applications, it is worth reviewing existing European patent applications now to determine whether any divisional applications will be necessary, for example where a number of inventions are provided in the same application.

Going forward, it will be advisable to make an evaluation of whether or not divisional applications are likely to be required at a relatively early stage during prosecution, for example at the same time as a response to the first exam report is drawn up.