



EUROPEAN PATENT LAW CHANGES (EFFECTIVE FROM APRIL 1, 2010)

From April 1, 2010, a number of law changes will come into effect at the European Patent Office (EPO). These include:

- the introduction of new deadlines for filing divisional applications;
- a compulsory response to the Search Report in most instances; and
- other changes affecting amendments, non-unity objections and complex application objections.

Divisional Applications

From April 1, 2010, new time limits for filing divisional applications will be set at two years from the issuance of the first Office Action.

Presently, a divisional application may be filed at any time while the parent application is pending. From April 1, 2010, divisional applications may only be filed within a two year period starting from the date of the first issued Office Action (see Appendix – Example I). A notification of the search report is not considered to be an Office Action.

For a chain of divisional applications, the two year period runs from the date of the first Office Action on any of the applications in the chain, which will typically be the earliest application, i.e. the “grandparent” application (see Appendix – Example II).

There is, however, one exception. If a non-unity objection is raised for the first time in a second or subsequent Office Action, then the two year period will run from the date of that second or subsequent Office Action (see Appendix – Example III).

This law change will have effect for all patent applications pending on or filed after April 1, 2010. Under transitional provisions, if the two year period for filing a divisional has already expired on April 1, 2010, or will expire within six months of April 1, 2010, then a divisional application may be validly filed until October 1, 2010 (see Appendix – Example IV).

In view of this imminent change, it may be useful to review your pending cases to identify applications from which you may wish to file divisional applications. Please contact us if you would like us to assist you with this matter.

Compulsory Response to Search Report

From April 1, 2010, it will become compulsory to respond to the Search Report if the Examiner has expressed a 'negative' opinion by raising objections in the Written Opinion accompanying Search Report. If the Examiner has expressed a 'positive' opinion, then no response is required.

There are different time limits for filing the response which depend on the type of European application that has been filed. There are three possible scenarios:

1. ***Direct EP filing***
The response must be filed within six months of the date of publication of the search report. (This corresponds to the current deadline for requesting examination).
2. ***EP-PCT when EPO was the International Searching Authority (ISA):***
The response must be filed within one month from the date of the Rule 161 communication, which is currently issued by the European Patent Office upon entry into the European phase, inviting the Applicant to file voluntary amendments.
3. ***EP-PCT when EPO was not the ISA:***
The response must be filed within the period specified by the EPO for indicating whether the Applicant wishes to proceed further with their application. This period is set by the EPO in a communication which is issued shortly after drawing up the supplementary search report and the period is usually set at six months from the date of the communication, although may be set as short as two months.

In cases where a response is compulsory but is not filed in time, the application will be deemed to be withdrawn.

In view of these short deadlines, we suggest that a response to the search report be drafted upon receipt of the search report, particularly in EP-PCT cases where the EPO was the ISA.

Number of Independent Claims in the same claim category

Where the EPO raises an objection concerning the number of independent claims in the same category, before the search report is drawn up, the Applicant will now be given an opportunity to address this objection.

The EPO usually only allows for one independent claim in each claim category (process, use, product and apparatus). Previously, if the search Examiner believed that there was more than one independent claim in a category, there was nothing that could be done at the search stage and an objection could only be raised during the Examination stage. From April 1, 2010, before carrying out the search, the EPO will invite the Applicant to justify the number of independent claims and/or to nominate which independent claim (per category) is to be searched within a period of two months. If no nomination is made, the first independent claim per category appearing in the set of claims will be searched. Unsearched claims will have to be subsequently deleted and may only be pursued in divisional applications if possible (see above).

In light of the short deadline for dealing with such an objection, we recommend careful consideration of the type and number of independent claims included in any European patent application.

Complex Applications

Where the Examiner is unclear as to what to search due to the complexity of the application, the Applicant will now be given an opportunity to send a clarifying statement to the Examiner, before the search report is drawn up, so as to direct the search Examiner to the subject they wish to have searched.

Currently, for complex applications such as unclear applications and applications which lack support, the search Examiner states that no meaningful search or only a partial search can be carried out, and a reasoned declaration is issued in support of this decision. From April 1, 2010, the EPO will issue a communication inviting the Applicant to file a clarifying statement indicating the subject-matter to be searched within a period of two months. If no clarifying statement is filed, the search Examiner will issue a reasoned declaration as before.

Non-Unity Objections

Where the search Examiner has raised a non-unity objection for a patent application, the time period for paying further search fees has been extended from one month to a period of two months.

No more amendments as a matter of right during the Examination procedure

Previously during the Examination procedure, an amendment could be made as a matter of right in response to the first Office Action, whilst further amendments were at the discretion of the Examiner. This opportunity to provide an amendment as a matter of right has been deleted and now all amendments during the Examination procedure are at the discretion of the Examiner.

The amendment as a matter of right in response to the search report remains.

APPENDIX

Example I

Patent application EP-1 is currently pending. The first Office Action which issues for EP-1 is dated April 6, 2010. The deadline for filing any divisional applications from EP-1 is therefore April 6, 2012, two years from the date of the first issued Office Action.

Example II

Patent application EP-1 is filed. Patent application EP-2, a divisional application of EP-1 is filed a few days later. Finally, patent application EP-3, a divisional application of EP-2 is filed two years later. In this way, EP-2 is the parent of EP-3 and EP-1 is the parent of EP-2 and the grandparent of EP-3.

The first Office Action issues for EP-1 and is dated May 10, 2010. The first Office Action for EP-2 is dated April 6, 2010, i.e. before the first Office Action for EP-1, and, the first Office Action for EP-3 is dated May 9, 2012. The deadline for filing any divisional applications from EP-1, EP-2, or EP-3 is April 6, 2012, two years from the date of the first issued Office Action.

Please note that the time limit for filing a divisional application from EP-3 expires before any Office Action has issued for EP-3.

Example III

Patent Application EP-1 is currently pending. The first Office Action for EP-1 is dated April 6, 2010. A response is filed and a second Office Action is issued by the Examining Division and is dated April 20, 2011. The second Office Action raises a Unity of Invention objection that had not been previously raised. The deadline for filing any divisional applications from EP-1 is now April 20, 2013, two years from the date of the Office Action which raised the Unity of Invention objection for the first time.

Example IV

Patent Application EP-1 is pending on April 1, 2010. The first Office Action for EP-1 was dated May 10, 2008. The deadline for filing any divisional applications from EP-1 is extended until October 1, 2010 under the transitional provisions.