



EUROPEAN PATENT ORGANIZATION

EUROPEAN PATENT ORGANIZATION—NEW LEGAL DEVELOPMENTS

In an effort to harmonize the European Patent Convention (EPC) with other international treaties, such as the Agreement on Trade-Related Aspects of Intellectual Property Rights and the Patent Law Treaty, the EPC has been revised by the Revision Act of November 29, 2000. The new Convention (the so-called EPC 2000) entered into effect on December 13, 2007.

One of the key aspects of the EPC 2000 was to transfer many provisions from the Convention (Articles of the EPC) to its Implementing Regulations (Rules of the EPC). The rationale behind this formality was to provide for more flexibility with respect to future changes. Specifically, the Rules of the EPC may be amended quite easily by the Administrative Council of the European Patent Organization, whereas changing the Articles of the EPC requires revision by way of a diplomatic conference by all contracting states to the EPC—a rather laborious and time-consuming act-drafting and ratification process.

The Implementing Regulations of the EPC have been amended by two decisions of the Administrative Council handed down on March 25, 2009 (CA/D 2/09 and CA/D 3/09). The changes, which will enter into effect on April 1, 2010, relate to the following:

- The time limit for filing divisional applications;
- Limitations regarding the European search; and
- The filing of mandatory responses to the International Preliminary Report on Patentability following European phase entry.

In addition to the recent fee changes that entered into effect on April 1, 2009, the recent decisions will have a considerable impact on future patent prosecution and patent portfolio strategies.

The most important aspects of the changes are summarized in the following:

1. NEW TIME LIMIT FOR FILING DIVISIONAL APPLICATIONS OF EUROPEAN PATENT APPLICATIONS

Current Regulation

In accordance with the current regulation, a divisional application may be filed as long as the parent application is pending, *i.e.*, up to (but not including) the date on which: (a) grant of the patent is mentioned in the European Patent Bulletin, or (b) the application is refused, withdrawn, or deemed to be withdrawn.

New Regulation

An applicant may file a divisional application relating to any pending earlier European patent application, provided that: (a) the divisional application is filed within 24 months of the Examining Division's first communication in respect of the earliest application for which a communication has been issued (voluntary divisional application); or (b) the divisional application is filed within 24 months of any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82 EPC (unity of invention), provided it was raising that specific objection for the first time. The new regulation, however, does not specify whether the subject matter of a divisional application has to correspond to subject matter identified as a separate invention in the Office Action objecting to lack of unity. Note that further processing will not be available for the aforementioned time limits.

This new regulation will enter into force on April 1, 2010.

Transitional Regulations

If the time limits for filing a divisional application have expired prior to April 1, 2010, a divisional application may still be filed within six months of that date, *i.e.*, until October 1, 2010. If the time limits for filing a divisional application are still running on April 1, 2010, they will continue to do so for not less than six months, *i.e.*, at least until October 1, 2010.



Consequences of the New Regulation

In summary, a divisional application may be filed within 24 months of the first communication in respect of the earliest application (Case a) or 24 months from any communication in which the Examining Division first raised unity objections (Case b). The following situations normally arise in practice:

Case 1: No unity objections are raised in examination proceedings.

Voluntary divisional applications may be filed only within 24 months of the Examining Division's first Office Action.

Case 2: Unity objections are raised in the first communication of the Examining Division.

Divisional applications may be filed only within 24 months of the Examining Division's first communication raising a nonunity objection.

Case 3: Unity objections are not raised until a later stage of the proceedings.

Divisional applications may be filed only within 24 months of the Office Action raising the lack-of-unity objection.

Advice: The filing of divisional applications (first, second, third, and subsequent-generation divisionals) will become much more limited and will be subject to the rather short time limit of two years set forth above. So it is advisable to review patent portfolios well before April 1, 2010, in order to file necessary or desired divisionals. Further, once a lack-of-unity objection is raised, we recommend deciding in a timely manner which subject matter shall be pursued in divisional applications.

2. EUROPEAN SEARCH WHERE A PLURALITY OF INDEPENDENT CLAIMS ARE PRESENT IN THE SAME CLAIM CATEGORY

Current Regulation

In accordance with current practice, a European search is performed for claims in an application containing more than one independent claim per claim category, where the claims are considered to fulfill the unity requirement.

A European patent application may exceptionally contain more than one independent claim in the same category (product, process, apparatus, or use) if the subject matter of the claims relates to a plurality of interrelated products, different uses of a product or apparatus, or alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim. Otherwise, a European patent application may contain only one independent claim for each category. This requirement is usually checked during substantive examination of the application.

New Regulation

If the European Patent Office (EPO) deems that the claims as filed contain more than one independent claim, wherein the independent claims are *not* in line with the exceptions mentioned above, the applicant is invited to indicate, within a period of two months, the claims on the basis of which the search is to be carried out. If the applicant fails to provide such an indication in due time, the search is carried out on the basis of the first claim in each category. In this context, it should be borne in mind that in case of unity objections, only the first invention or group of inventions is searched.

Also, the subject matter that may be pursued in the application is restricted. Specifically, unsearched subject matter, even if it has the general inventive concept in common, can be prosecuted only in a divisional application, provided that the time limit for filing divisional applications has not yet expired.

This new regulation will enter into force on April 1, 2010.

Transitional Regulations

The above new regulation shall apply to European patent applications for which the European search report or the

supplementary European search report is drawn up on or after April 1, 2010.

Consequences of the New Regulation

The EPO will request applicants to file claim sets containing only one independent claim per claim category (or a plurality of independent claims in the same category that fall under one of the exceptions discussed above). Otherwise, the search is carried out only for the subject matter of the first claim in each category. For unsearched subject matter, one or more divisional applications will have to be filed within the new time limit.

Advice: Review and amend the order of the claims where necessary, to ensure that the most important subject matter is searched. Also, reduce the number of independent claims per category, where applicable. For all pending European patent applications, as well as European regional phase applications that have not yet been searched by the EPO, this check should be done *from now on*, since in some cases the transitional regulations will apply if the European search report is not established before April 1, 2010.

3. MANDATORY RESPONSE TO SEARCH REPORTS ESTABLISHED BY THE EPO

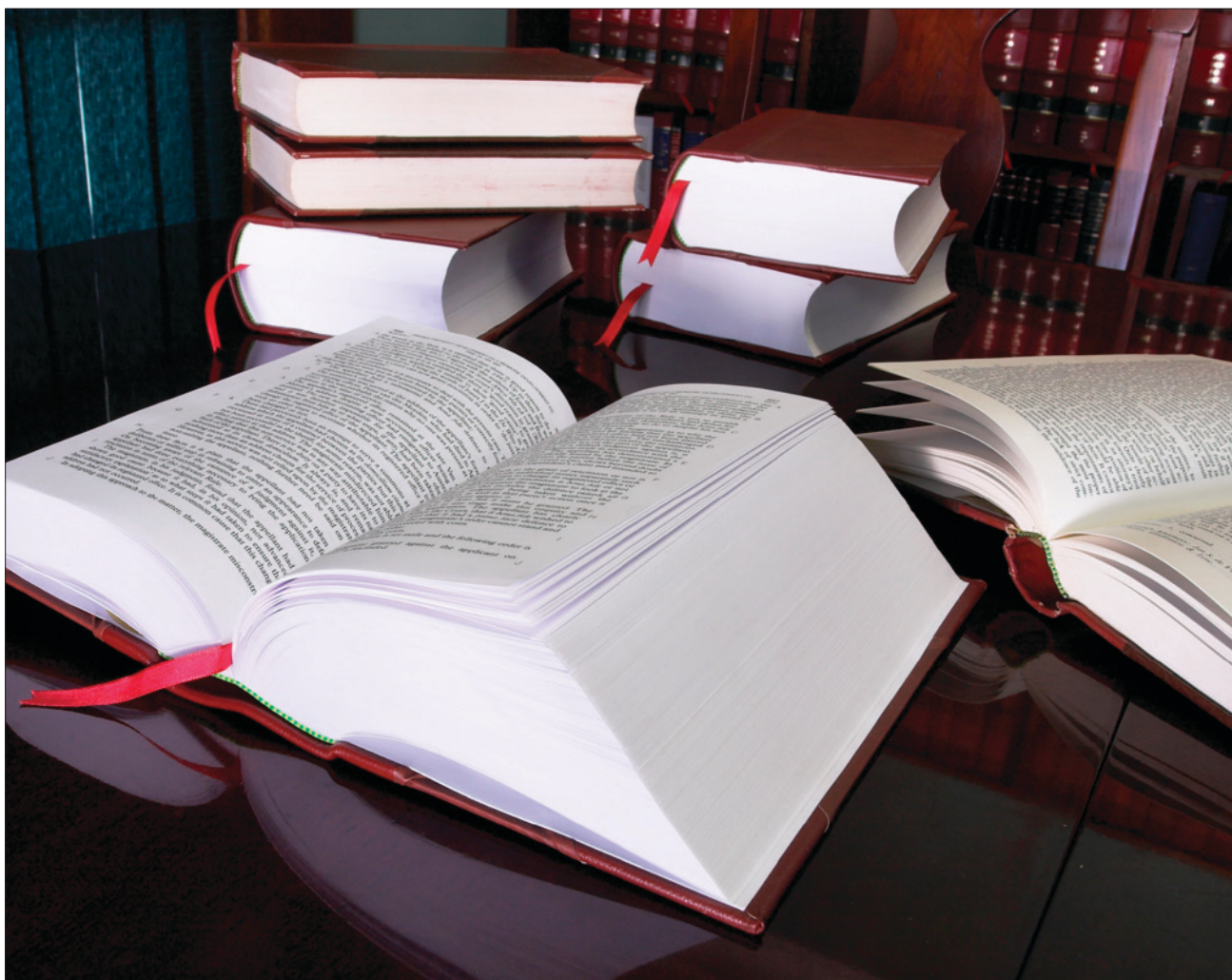
Current Regulation

In accordance with the current regulation, the applicant may respond to a European search report by providing arguments and/or claim amendments. If no such response is filed, the first Office Action in substantive examination proceedings usually refers to the objections raised in the opinion accompanying the European search report.

When entering the regional phase before the EPO from a Patent Cooperation Treaty (PCT) application, the applicant has the opportunity, for example, to voluntarily amend the claims in response to the formal communication under Rules 161/162 EPC, which issues shortly after the application enters the regional stage in Europe (Euro-PCT application).

New Regulation

Under the new regulation, in many cases, responses become mandatory. Otherwise, the application will be deemed to be withdrawn. The details are as follows:



European Patent Applications: *The EPO draws up an extended European search report.*

The EPO shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the search report and to amend the description, claims, and drawings up to six months after the date on which the European Patent Bulletin mentions the publication of the search report. If the applicant neither complies with nor comments on said invitation, the application shall be deemed to be withdrawn.

Euro-PCT Application: *The EPO draws up a supplementary European search report.*

If a supplementary European search report is drawn up on a Euro-PCT application, the EPO shall give the applicant the opportunity to comment on the search report and, where appropriate, invite him to correct any deficiencies noted in

the opinion accompanying the search report and to amend the description, claims, and drawings within the period specified, indicating whether he wishes to proceed further with the application. If the applicant neither complies with nor comments on said invitation, the application shall be deemed to be withdrawn.

Euro-PCT Application: *The EPO does not perform an additional search.*

If the EPO has acted as the International Searching Authority and, where a demand under Article 34 PCT was filed, as the International Preliminary Examining Authority for a Euro-PCT application as well, it shall give the applicant the opportunity to comment on the written opinion of the International Searching Authority or the International Preliminary Examination Report and, where appropriate, invite him to correct any deficiencies noted in the written opinion or in the International Preliminary Examination Report and to

amend the description, claims, and drawings within a period of *one month* from the respective communication under Rules 161/162 EPC. If the applicant does not comply with or comment on said invitation, the application shall be deemed to be withdrawn. However, further processing is possible if the above time limit of one month is not met.

This new regulation will enter into force on April 1, 2010.

Transitional Regulations

The above new regulation shall apply to European patent applications for which the European search report or the supplementary European search report is drawn up on or after April 1, 2010.

Consequences of the New Regulation

It will become mandatory to file a response to search reports established by the EPO. Otherwise, the application is deemed to be withdrawn.

Advice: Be prepared to file a response to a search report established by the EPO. In particular, in case of Euro-PCT applications where the EPO acted as the International Searching Authority, arguments and/or amendments in response to the written opinion of the International Searching Authority or the International Preliminary Examination Report will have to be filed within a period of one month from the respective communication. In the latter case, in view of the short time limit available under Rules 161/162 EPC, it is advisable to start drafting a response as early as possible and preferably prior to entry into the regional phase in Europe.

4. EPO FEE INCREASE EFFECTIVE APRIL 1, 2009

The EPO increased its fees effective April 1, 2009; the major changes are as follows:

a. Designation fees:

Flat fee of €500 for designation of all EPC member states instead of €85 per contracting state (maximum €595).

b. Claims fees:

The claims fees (currently €200 for the 16th claim and each one thereafter) will increase considerably for each claim exceeding 50. The new fees are as follows:



- 16th to 50th claim: €200 per claim;
- 51st and subsequent claims: €500 per claim.

Advice: Review claims prior to filing European patent applications and reduce the number of claims, such as by inserting multiple dependencies if possible. Further, consider reordering the claims (see below). Care should be taken regarding the order of the claims. For Euro-PCT applications entering the European regional phase, where the EPO is supposed to draw up a supplementary search report, we recommend mentioning those claims first that are the most relevant, since in the case of lack of unity, no additional searches will be carried out by the EPO—only the invention first mentioned in the claims will be searched and examined. Further invention(s) indicated in the search report will have to be pursued in divisional application(s).

c. Additional fee for applications comprising more than 35 pages:

Currently for lengthy applications, additional fees for each page exceeding 35 are payable only upon grant of the patent. As of April 1, 2009, an additional page fee of €12 per page is due upon filing (not counting the pages of a sequence listing; the fee for grant and printing will then drop to a flat fee of €790).

Advice: Reduce the overall number of pages by using a different font, such as Arial Narrow 11; justified alignment; and minimal margins (top 2.0 cm, left 2.5 cm, right 2.0 cm, bottom 2.0 cm) where possible.

Although the amendments to the Implementing Regulations of the European Patent Convention will not enter into effect until about a year from now, applicants and practitioners should prepare themselves in a timely manner for these changes. We recommend reviewing patent portfolios well before the deadlines for filing divisional applications for important subject matter not yet examined or excluded from pending applications because of lack of unity. We also recommend changing working habits in order to be able to quickly adapt to the efforts of the EPO to streamline examination proceedings.

LAWYER CONTACT

MUNICH

Dr. Martin Weber
+49 89 206 042 200
mweber@jonesday.com

Thomas K. Ritter, Ph.D.
+49 89 206 042 200
tritter@jonesday.com

Andreas Zeller
+49 89 206 042 200
azeller@jonesday.com

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