

EPO Rule Changes to Expedite Patent Prosecution

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The European Patent Office (EPO) recently announced rule changes aimed at reducing the burden on patent examiners and expediting patent prosecution. The new rules, effective April 10, 2010, call for the applicant to assist the examiner in focusing on the subject matter that is to be prosecuted earlier in the course of the European regional phase.

Mandatory response to European Search Reports

At this time, the EPO does not require the applicant to respond to the patentability objections included in search reports. The new rules will require a full response within six months of the publication of the search report if no request for examination has been filed. If a request for examination has been filed, the response must be filed within two months of an EPO communication inviting response. If the applicant fails to meet either response deadline, the application will be considered withdrawn, although it may be revived by further processing.

Mandatory response to Written Opinions and International Preliminary Examination Reports

When the EPO is the International Search Authority for a PCT application, a search is not carried out in the European regional phase. In this instance, a response to objections raised in the written opinion during the international phase must be filed soon after the European regional phase commences. A one-month deadline for filing the response will be set and the applicant will be required to pay claims fees concurrently.

Mandatory identification of the basis for all amendments to the application

The EPO will now also require that the applicant identify and provide the basis in the original application for all amendments to the application. If the applicant fails to do this, the EPO will set a one-month deadline to comply. The application will be considered withdrawn if the applicant further fails to meet the one-month deadline; however, the application can be revived with further processing.

Identification of subject matter to be searched

Where the EPO determines that errors in the application prevent a proper search, the examiner will require that the applicant clarify what must be searched. An incomplete search report or a declaration of

no search will be issued if the applicant does not meet the clarification requirement.

Multiple independent claims

If an application contains several independent claims, the examiner will contact the applicant to determine which claims should be searched. The EPO will only search the first claim in each category (i.e., product, method, use) if the applicant fails to respond.

Limits on divisional applications

The EPO will implement a 24-month time bar for the filing of divisional applications. Currently, a divisional application may be filed so long as the parent case is pending. The new 24-month time bar will be applied in two ways. If the EPO does not raise a unity of invention rejection, then any divisional application must be filed within two years of the first communication from the examining division. If a unity of invention rejection is raised, then the divisional application must be filed within two years of the first communication that raises the unity of invention rejection.

Advice

The new rule changes will expedite patent prosecution in the EPO. There may be further clarification of the rules before they are implemented in 2010. However, applicants will need to modify their current prosecution strategies to identify the intended allowable subject matter early in the course of prosecution, if not before filing.

If you have any questions regarding the issues discussed in this LawFlash, please contact any of the following Morgan Lewis attorneys:

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