

Ard Ellens and Jan Kevelam of Nederlandsch Octroobureau explain how new rules at the European Patent Office may trap the unwary patent applicant

EPC rules – no longer business as usual

From April 1 2010, the Administrative Council of the European Patent Organisation will raise several bars. First, the bar for filing a divisional application (a divisional) to a pending European application will be raised. This is because the EPO believes that some applicants have abused the divisionals system. Secondly, the Office has decided to take a number of measures that will affect multiple-independent claims and responses to the European search report to streamline the examination process and reduce the backlog (as well as to improve the quality of patent applications).

These two sets of changes are discussed in more detail below. The key message for patent practitioners is this: Do not continue business as usual but instead anticipate the new rules when drafting and prosecuting a European patent application (including PCT applications that enter the regional European phase).

Changes to divisionals

The opportunities for filing a divisional European patent application will be limited. Applicants will no longer have the opportunity to file a divisional at any time during pendency of a (divisional) application.

At the moment, the only constraint when filing a divisional is that it must have basis in the pending earlier application (EPC Art 76(1)). Unlike in the US, a continuation-in-part (CIP) is not an option under the European Patent Convention (EPC). The examination of a divisional before the EPO is independent of the fate of divisional family members.

Use of divisionals

Divisionals are used to claim non-unitary subject matter of a parent application (see the Paris Convention, Art 4G(1)). However, divisionals may also be filed just before grant of a parent application as a precautionary measure in case an opposition against the parent patent is expected. Further, divisionals may be filed shortly before oral proceedings during examination proceedings. When oral proceedings fail, instead of appealing the negative decision, the divisional can be prosecuted and the examination starts all over again. Divisionals may also be filed to keep an application pending while the claims of the divisional can still be tailored to an infringing product or process.

In the past, the Board of Appeal has tried to limit the filing of divisionals. For instance, in its decision T1158/01 the validity of the second generation divisional was held to be dependent upon the validity of the first generation divisional filing. This and other decisions have led to confusion about the rights of applicants when it comes to filing divisionals.

However, the Enlarged Board decision G1/05 (see EBA rules on validity of divisional applications in *Managing IP*, October 2007) clarified this situation. In short, there were no fundamental restrictions other than those contained in Article 76(1) EPC. The G1/05 decision was welcomed by the patent community since it clarified the rights of applicants.

Abuse of divisionals

However, in G1/05 the Board of Appeal also said that it was “unsatisfactory that sequences of divisionals each containing the same broad disclosures of the original

Ard Ellens



Ard Ellens is an associate partner of Nederlandsch Octroobureau. As a Dutch and European patent attorney he practices in the area of chemistry, in particular at the interface of chemistry, physics and mechanics. Ard obtained a PhD in (solid state) chemistry from Utrecht University. After his PhD he worked as a post-doc at the University of Berne and as a R&D scientist for Osram in Munich. Ard joined Nederlandsch Octroobureau in 2001.

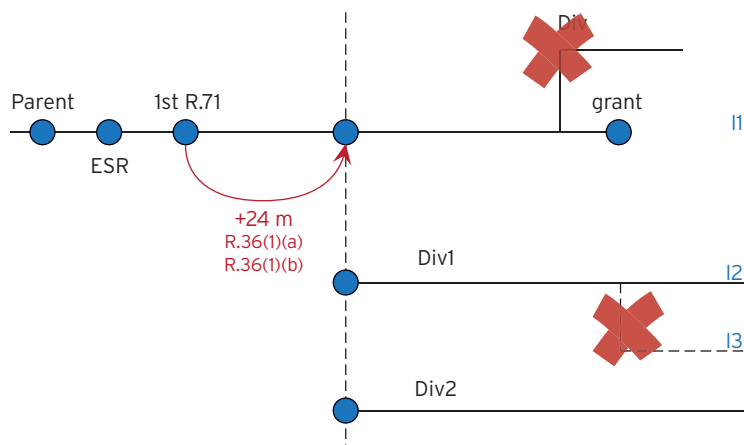
Jan Kevelam



Jan Kevelam is a trainee with Nederlandsch Octroobureau and sat the EQE in Spring 2009 for the first time. He has a technical background in organic chemistry and coating technology. Jan holds a PhD in chemistry from the University of Groningen (1998) and has worked both within and for the foods and detergents industry.

Figure 1

Implications of new R.36(1)

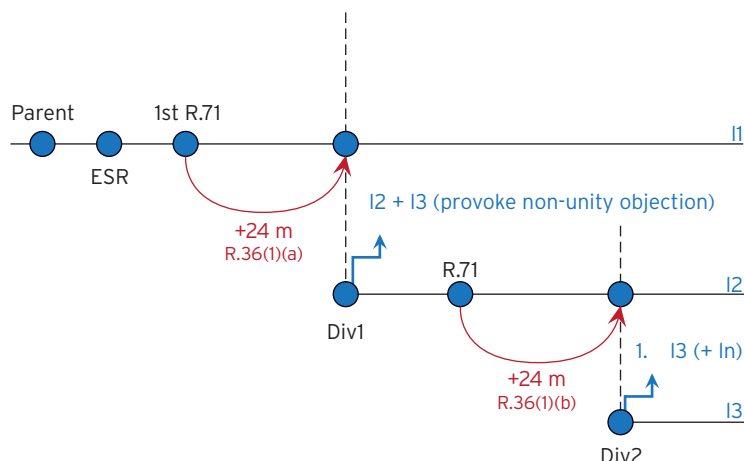


Further, irrespective of the above 24-month period, a non-unity objection raised by the examiner for the first time provides a further option for filing a mandatory divisional, if any, which has to be filed within (again) a 24-month period of the communication in which the non-unity objection was raised (amended Rule 36(1)(b) EPC). The amended rules apply to all divisionals filed on or after April 1 2010. There will be a six-month transitional period. The new situation is illustrated in Figure 1.

In Figure 1, a parent application, apparently describing and claiming at least three inventions (I1-I3) is filed. After receipt of the first Office Action (Rule 71) for this earliest application, 24 months remain for filing divisionals (div1/div2) to the other inventions. The brilliant idea of the attorney to file a divisional just before grant or examination oral proceedings after the 24-month period is blocked. Note also that a further divisional cannot be split off from, for instance, I2 outside the Rule 36(1)(a) time limit (of the earliest application).

Figure 2

Implications of new R.36(1)



Remedies

Filing a divisional within the 24-month time limit with deliberate non-unitary claims may provide a means to keep subject matter pending longer. This possible escape from the strict interpretation of the rules is schematically indicated in Figure 2.

In Figure 2, a parent application is filed, apparently containing at least three inventions, but only claiming the first invention I1. Within the 24-month term, a divisional (div1) is filed, claiming inventions I2 and I3. This should provoke a (new) non-unity objection, from which a new 24-month term starts. This option seems to have been foreseen by the legislator (CA/145/08 (E)), and in case of abuse of this option, further legislation may be expected from the EPO.

patent application, by means of at least an unamended description, should be pending for up to twenty years". It went on to say that it would be for "the legislator to consider where there are abuses and what the remedy could be".

New rules

The time of the legislator has now come. In CA/D 2/09, the Administrative Council decided that as of April 1 2010 the freedom to file a divisional will be limited. A 24-month term, calculated from the first Examination Office Action of the earliest application is set for filing a voluntary divisional (amended Rule 36(1)(a) EPC). Thus, this 24-month time limit is set for each future divisional of the earliest application. Here, the Administrative Council uses the freedom provided by the Paris Convention in Art 4G(2). Note that the start of the 24-month time limit is the first office action of the examining division and not the Extended European Search Report (EESR).

Impact for applicants

Applicants, including overseas applicants, should be aware that in the near future a divisional can no longer be filed at any time during pendency of an application. Old habits such as filing a divisional just before oral proceedings in examination or just before grant will belong to the past! This rule change will have a big impact on divisional filing strategies. Knowing that the European search report gains more weight from April 1 2010 (see below), it seems that the receipt of the European search report should also trigger exploring what subject matter (if any) may have to be pursued in later divisionals. Further, this rule change includes a new time limit to be monitored.

Focus on the search report

In CA/D 3/09, the Administrative Council implemented regulations to further raise the bar for applicants. These regula-

tions consider focusing the search report on a clear and concise claims set, and a mandatory response to the opinion provided with the search report.

Multiple independent claims

The EPC currently provides that, besides some exceptions, a European patent application may only contain one independent claim in the same category (Rule 43(2)). However, it appears that the EPO is unable to enforce this rule at the search stage, although many US applications are (still) filed with a plurality of independent claims.

To remedy this situation, in case the claims do not comply with Rule 43(2), the applicant must indicate, within a period of two months, those claims on the basis of which the search is to be carried out (new Rule 62a(1)). Note that if the two-month time limit of Rule 62a(1) is missed this cannot be remedied by a request for further processing under Article 121. However, if the applicant fails to provide such an indication in due time, the search will be carried out on the basis of the first independent claim in each category.

Further, the examining division will invite the applicant to restrict the claims to the subject matter searched unless it finds that the objection under paragraph 1 was not justified (new Rule 62a(2)).

Importantly, parallel measures will be taken to prohibit the re-introduction of non-searched subject matter later in the procedure (new Rule 137(5)). Protection for any independent claim which had to be removed under Rule 62a may likely be obtained only by filing a divisional. However, as indicated above, the timeframe may be limited.

The applicant may contest any objections made by the search division and, if successful, the search will be performed (again) accordingly.

As a consequence of new Rule 62a, applicants should ensure that their set of claims complies with Rule 43(2).

Complex applications

The term “complex application” is used by the EPO to refer to applications that lack support, clarity or conciseness to an extent that no meaningful search is possible. Applications whose claims are unclear seem to be problematic for the EPO, especially because applicants may clarify the claims during substantive examination, and provided Rule 137(4) is met, require that an additional search still has to be performed.

To prevent the examiner from having to perform an additional search, in cases where the search division is confronted with unclear claims, the applicant will be requested to submit (within a period of two months) a statement indicating the subject matter to be searched (amended Rule 63 EPC). The legal consequence for non-compliance, as well as provisions for legal remedies, has been aligned with those for Rule 62a. Thus, any subject matter which has not been covered by a (partial) search report and which falls under the prohibitions of Rule 63(1) cannot be reinstated later in the procedure. Further processing is excluded. However, provided especially that the conditions of Rule 36 (see above) are met, the subject matter could be protected by filing a divisional.

Mandatory response to the search opinion

One purpose of introducing the opinion accompanying the European search report in 2005 was to speed up the examination procedure by providing an opinion corresponding to the

examiner’s first communication already at the search stage. However, in the opinion of the EPO, (too) many applicants prefer to delay their reply. Therefore a response to the search opinion will be made mandatory. Three situations are distinguished:

- For Euro-direct applications, the applicant is given the opportunity to comment on the extended European search report and, where appropriate, invited to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and

It appears that the new rules jointly act to severely restrict the degree of freedom that the applicant has

drawings within the period referred to in Rule 70(1) (that is, the six-month time limit after publication of the search report for paying the designation and examination fees. See also new Rule 70a(1)).

- For EURO-PCT applications, where the EPO has acted as ISA, the applicant will receive an invitation to comment on the Written Opinion (Ch I) or the International Preliminary Examination Report (Ch II), where appropriate, within a time limit of one month from a Rule 161 communication. See also amended Rule 161.
- For any EURO-PCT applications for which a supplementary European search report is issued (that is, for which the EPO did not act as ISA, 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 supplementary European search report and to amend the description, claims and drawings within the period specified for indicating whether he wishes to proceed further with the application. (See also new Rule 70a(2)).

The legal consequence for either not complying with the request to correct any deficiencies noted by the EPO or not providing a response to the search report is that the application is deemed withdrawn (see Rule 70a(3) and Rule 161). Although further processing will be available, the search report effectively gains the importance and status of a first office action.

The urgency of the mandatory response is further enhanced. Together with any comments, corrections or amendments made in response to communications by the EPO under Rule 70a (1) or (2), or Rule 161(1), the applicant may amend the description, claims and drawings of his own volition (see amended Rule 137(2)). Amended Rule 137(3) further adds that this may be the one and only chance for making any amendment without the consent of the examination division. Furthermore, the basis for the amendments should be indicated by the applicant (amended Rule 137(4)).

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Advice to EURO-PCT applicants

In view of the above-mentioned legislative initiatives, if the EPO acts as ISA, we will likely advise PCT applicants to file a Demand for International Preliminary Examination, appointing the EPO as IPEA, and try to obtain a positive report for the most important, possibly restricted set of claims. If the EPO acting as IPEA would issue a positive International

Preliminary Examination Report (IPER), then the EURO-PCT application could likely proceed to grant straight away, without the burden of having to file a response to the Written Opinion shortly after entry. For any remaining subject matter, protection may be sought by filing a divisional application.

In any other case, for example where the USPTO or other non-European agency acted as ISA, trying to obtain a positive IPER is not necessarily helpful for achieving successful entry in the European phase, since the EPO will likely re-do most if not all of the examination by itself. In particular, the EPO will perform a supplementary search based on a set of claims put forward by the applicant under Rule 161.

Especially in view of amended Rule 63, such claims preferably comply with the criteria of clarity and conciseness, so as to obtain a meaningful search to the greatest extent possible. Remember that any claim for which no meaningful search is established cannot be reinstated in the same application. The applicant is further reminded there is very limited time to provide a set of claims in accordance with Rule 161 (that is, only one month).

Thus, we recommend that the applicant seek the assistance of a European patent attorney well before converting a PCT application to Europe.

What to do next

In summary, we recommend (potential) applicants: (1) start to consider a divisional not as an escape but as a favour, (2) file an application at the EPO (including national phase entry) which meets the requirements of Rule 43(2) EPC as to multiple independent claims, and (3) start to consider the Search Report of the EPO as first Office Action. Especially for US applicants, (4) it is recommended to have your claims reviewed by a European representative well before filing (or entry).

Established in 1888, Nederlandsch Octrooibureau is one of the larger firms of intellectual property consultants in The Netherlands, providing specialist advice in the field of intellectual property. The key members of staff are patent attorneys, trademark attorneys and lawyers, who act on behalf of clients in applying for, and obtaining, patent, trademark and design rights in The Netherlands, Benelux, European Union and other countries. They also advise on scope of protection, infringement, validity, invalidity, licences, software protection and copyright. Clients include many Dutch, foreign and multinational organisations engaged in a wide variety of commercial activities and specialist fields. Nederlandsch Octrooibureau has offices in The Hague, Ede and Eindhoven and employs a staff of 120.

The Hague Office
 J.W. Frisolaan 13
 2517 JS The Hague
 P.O. Box 29720
 2502 LS The Hague
 The Netherlands
 Phone: +31 (0)70 3312 500
 Fax: +31 (0)70 3527 528

Ede Office
 Bennekomseweg 43
 6717 LL Ede
 Phone: +31 (0)318 707 000
 Fax: +31 (0)318 707 007

Eindhoven Office
 Kennedyplein 236
 5611 ZT Eindhoven
 Phone: +31 (0)40 239 37 40
 Fax: +31 (0)40 239 37 50

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