
Newsletter 3/2009

Changes at the EPO II – Response to Search Opinion

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Introduction

With its Decision of March 25, 2009 the Administrative Council of the European Patent Office (EPO) amended the Implementing Regulations to the European Patent Convention (EPC).

Due to these new regulations, applicants will be required to present a clear and concise set of claims on which the Search Report will be based.

Further, applicants are required to provide a mandatory response to the opinion provided with the Search Report.

1. Multiple Independent Claims

The EPC currently provides that, in general, a European patent application may only contain one independent claim in the same category. US applications, in particular, are often filed with a variety of independent claims per category frequently provoking a unity objection.

Under the new Rules, in particular Rule 62a (1) EPC, if the claims do not comply with these requirements, applicants must indicate, within a 2-months time limit after a corresponding invitation, those claims on the basis of which the search is to be

carried out. This 2-month time limit is not extendable and cannot be remedied by a request for further processing under Art. 121 EPC.

If the applicant does not respond to a Communication under new Rule 62a(1) EPC, 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 Rule 62a (1) EPC was not justified.

It is to be noted that, in connection with new Rule 137(5) EPC, non-searched subject-matter may not be used as a basis for claim amendments later in the procedure. Thus, protection for any independent claim or subject-matter which has had to be removed under new Rule 62a (1) EPC may only be obtained by filing a divisional application. For the new regulations for filing divisional applications, please refer to our Newsletter 2/2009.

2. Non-compliance with the EPC

If the EPO considers that the European patent application fails to comply with the

EPC to such an extent that it is impossible to carry out a meaningful search, it shall invite the applicant to file within a period of two months a statement indicating the subject-matter to be searched (new Rule 63(1) EPC).

If the applicant does not respond to a Communication under new Rule 63(1) EPC, the Search Division either issues a reasoned declaration that no meaningful search can be carried out, or carries out a partial search on the basis of some of the subject-matter claimed (new Rule 63(2) EPC).

When a partial Search Report is drawn up, the Examining Division will invite the applicant to restrict the claims to the subject-matter searched, unless it finds that the objection under Rule 63(1) EPC was not justified.

3. Mandatory Response to the Search Opinion

Since 2005, the European Search Report has been accompanied by a Written Opinion corresponding to the Examiner's first Communication. Under current EPC, the applicant can decide whether he will respond to this opinion or not. Due to new Rule 70a and amended Rule 161 EPC, a response to the Search Opinion will be made mandatory. Three situations are differentiated:

- As regards **direct European applications**, the applicant is given the opportunity to comment on the extended European Search Report and, if appropriate, is invited to correct any deficiencies noted in the Search Report. The applicant may amend the description, claims and drawings. The time limit for responding is **six months** from publication of the Search Report.
- As regards **EURO-PCT applications** where the EPO has acted as International Search Authority (ISA) or International Preliminary Examination Authority (IPEA), the applicant will receive an invitation to comment on

the Written Opinion (Chapter I) or the International Preliminary Examination Report (Chapter II), where appropriate, within a time limit of **one month** from a Communication pursuant to amended Rule 161(1) EPC. Amendments or comments on the Written Opinion of the ISA which are filed on entry into the European phase or amendments filed under Article 19 PCT which are maintained on entry into the European phase are deemed to be a relevant response to the Rule 161(1) EPC communication. However, amendments or comments considered when drawing up the International Preliminary Examination Report (IPER) cannot be regarded as the requisite reply. Applicants must therefore respond to objections in the IPER in reply to the Rule 161(1) EPC communication.

- For any **EURO-PCT application** for which a supplementary European Search Report is issued, the applicant may - as hitherto - amend the application of his own volition within a time limit of one month from a Communication pursuant to amended Rule 161(2) EPC. The supplementary Search Report will be based on the amended documents. The Search Division shall give the applicant the opportunity to comment on the opinion accompanying the Search Report and, where appropriate, invite him to correct any deficiencies noted in the opinion (new Rule 70a(2) EPC). The time limit for responding to a Communication under new Rule 70a(2) EPC is expected to be **six months** from issuance of the supplementary Search Report.

The legal consequences for either not complying with the request to correct any deficiencies or for not providing a response to the Search Report or the Rule 161 EPC communication is that the application is deemed withdrawn (Rules 70a (3) and 161 (1) EPC). In these cases further processing will be available.

These new regulations apply to all applications where the extended/supple-

mentary European Search Report or the Communication under Rule 161 EPC is issued as of April 1, 2010.

Together with any comments, corrections or amendments made in response to the Search Report, the applicant may amend the description, claims and drawings of his own volition according to amended Rule 137 (2) EPC. However, new Rule 137 (3) EPC adds that this may be the one and only chance for making amendments without the consent of the Examination Division.

Thus, there is the possibility that if the Examining Division does not accept amendments submitted in response to the Search Opinion and if the Examining Division is not willing to offer a further possibility for amendments, the application will be refused with the first Communication issued by the Examining Division. Although this situation is not very likely, it is strongly recommended to auxiliarily request oral proceedings in response to the first Communication from the Examining Division as a precautionary measure.

4. Summary

As from April 1, 2010 a response to the objections in the search report will be mandatory. Non-compliance with these

new regulations will result in the application being deemed to be withdrawn.

If the EPO does not act as ISA/IPEA, PCT applicants will have two possibilities of amending the application after entry into the European phase, the first after receipt of the Communication under amended Rule 161 EPC, the second after receipt of the supplementary European Search Report. Thus, for this path the decision of how to act at the EPO will have to be taken at a later point of time, whereas the time span to act is shorter. In any case, the most relevant inventions should be first mentioned in the claims to make sure that they will be searched by the EPO.

If the EPO acts as ISA/IPEA, PCT applicants should bear in mind that there is **only one month** for providing a set of claims in response to a Communication under amended Rule 161(1) EPC. Thus, applicants should carefully watch international proceedings which will enter into the EP regional phase after April 1, 2010.

Finally, due to amended Rule 137(3) EPC, it is not guaranteed that amendments to an application will be allowed after receipt of the first Communication from the Examining Division. Thus, we recommend that applicants seek our assistance well before the PCT application enters into the European phase.