



EUROPEAN PATENT PRACTICE: RECENT DEVELOPMENTS

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PROBLEM OF EPO WORKLOAD

	<u>Filed</u>	<u>Granted</u>
1987	46,000	20,000
1992	59,000	30,400
1997	73,000	39,600
2002	106,000	47,300
2006	135,000	62,780
2007	140,725	54,700

Plus PCT searches and preliminary examinations,
which take priority

RESPONSE

“Mastering the Workload” (1)

Plan of 2002.

- Search Opinions with Search Reports
- BEST (Bringing Examination and Search Together)
- Shift Effort Towards the Start of the Process

By 2008

- All Searches had Opinion as well.
- Most Examiners could do BEST.

“Mastering the Workload” (2)

- EPO claim that searches and examination reports are now much more timely. (Which may be true, but second examination reports can take ages).
- There are still complaints and backlogs.
- Recently filed cases processed ahead of older ones.
- From this came recent fee changes.

CLAIMS FEES CHANGES 2008 (1)

Prior to April 2008:-

- EUR 45 fee on each claim beyond the tenth

After 1 April 2008:-

- EUR 200 (now 210) on each claim beyond the fifteenth

CLAIMS FEES CHANGES 2008 (2)

- Thus, on 31 March 2008, 25 claims would cost
 $15 \times 45 = \text{EUR } 675$ in fees
- On 1 April 2008, cost became
 $10 \times 200 = \text{EUR } 2,000$ in fees
(are now EUR 2,100)

CLAIMS FEES CHANGES 2009

Claims fees

- In addition to the EUR 200 for 16th claim onwards introduced April 2008, there was from 1 April 2009 a

- 500 EUR –
(now 525 EUR)

fee for each claim beyond 50.

NEW FEES 2009

Page fees

- payable on application (previously at the grant stage) at EUR 12 (now 13) per page beyond 35
- the number is of description, claims, abstract, drawings, but not sequence listings
- in an E/PCT it is calculated on the text of the published PCT application unless you amend on entry, in which case it is then counted on the pages in the section of the application (or its translation) which is amended.

CONSEQUENCES

- Pre-filing consideration and amendment is much more likely to be economic and is now normal.
- Sub-claims “compacted”, alternatives introduced.
- Some consequent examination difficulty, lack of clarity point may be raised – do not be too greedy.
- EPO claims fee income collapses.

AN EXAMPLE OF COMPACTION

1. A life-giving elixir solution containing soluble extracts of peanuts, lemons and fish-oil.

- 16 - wherein the solution has a pH of 7
- 17 - wherein the solution has a pH less than 7
- 18 - wherein the solution has a pH more than 7

becomes

- 16 - wherein the solution has a pH equal to, less than or more than 7.

Saving EUR 420 fees

OTHER 2009 FEE CHANGES

Designation Fees

Previous system:

- Designation fees of EUR 80 for each state to a maximum of seven: all states deemed designated when seven are paid

Current system, from 1 April 2009:

- A single fixed designation fee of EUR 500 (NOW 525) payable
- All states will be automatically designated
- Extension state system unchanged (EUR 102 each)

RAISING THE BAR

A project underway for 2-3 years now, responding to:

- the criticism of lack of “legal certainty” in granted and pending situations
- revocations by national courts
- criticism of trivial or badly examined patents
- complaints about “abusive” divisionals
- concerns about applicant behaviour

RAISING THE BAR

AIM - IMPROVE QUALITY AND EFFICIENCY

- Inventive step conformity efforts
- Stricter on business methods and software following Boards of Appeals decisions
- New requirements of applicants in four areas – procedural changes intended to assist and hasten examination

Will this help?

- or could they just do their job better?
- no need for new tools?
- costly for applicants, ill-judged, counter-productive?

APRIL 2010 CHANGES (1)

1. Obigatory response to search opinion (New Rule 70a)

(i) On “straight” Es (no previous search made) response to SO due within 6 months of publication of SR, same as for requesting examination

(ii) On E/PCTs, having EPO as ISA and perhaps IPEA (thus, normally, having an EPO Search and SO before regional phase entry is due) response to SO due within ONE month of the Rule 161 communication (Letter 1226) which invites amendment following E phase entry

(iii) On E/PCTs not having EPO as ISA or IPEA (therefore having an international search which will be supplemented by EPO supplementary search and SO) response due when confirming examination request, i.e. 6 months after SSR and Opinion

APRIL 2010 CHANGES (2)

The Letter 1226 on E/PCT (1)

In practice:-

- A letter of this type (1226) is received shortly after Euro phase entry on all cases.
- Which one you get depends on the ISA and, if it was the EPO, the nature of the Search Opinion.
- These letters start an opportunity to amend (within a one month period) following Euro phase entry.

Letter 1226 on E/PCT (2)

1226A - used when the EPO was ISA and the SO was “negative” i.e. novelty or obviousness points were identified and no amendment made on regional phase entry. You must respond and the term is one month.

1226B - used when the EPO was ISA and the SO was “positive” or where a response has already been filed on entry to the regional phase. They send this even if a response was filed which did not address SO objections. Response is not mandatory, because they think (perhaps wrongly) that the SO issues have been addressed, but it is possible.

Letter 1226 on E/PCT (3)

1226C - where the EPO was not the ISA. No response is required though you may wish to take the opportunity to amend if you have not already. Where EPO was not ISA, they then perform a Supplementary Search, and issue an opinion, and you must reply to that by the time of requesting/confirming examination, within six months of its publication.

Letter 1226 on E/PCT (4)

- In this last case, 1226C, i.e. EPO was not ISA, replying to the 1226 letter is not your one permitted amendment “as of right” – see Rule 137 discussed below. Where EPO was ISA (1226A, 1226B) the response does count as your one “as of right” chance.
- Of course, in all three situations you could have already amended on E-phase entry, which would in effect be a “free-hit”, not your one chance “as of right”, though nothing happens between then and the 1226 letter.

Letter 1226 on E/PCT (5)

- Note the urgency of the situation where EPO was ISA. Be prepared to consider and amend at very short notice if your PCT has EPO as ISA etc.
- The International search by the EPO may arrive rather late.
- Case deemed withdrawn if this is not complied with. Treat like an Exam Report.
- Further processing is available within 2 months of the EPO communication notifying the omission.

But as a consequence

- Selecting EPO for search has drawbacks.

APRIL 2010 CHANGES (2)

2. Amendments

Rule 137 amended.

- There is now ONE opportunity to amend description, claims, drawings of own volition, otherwise it can only be at examiner's discretion (Rule 137(2), (3)).

The reply to the search opinion discussed above will be that opportunity, where previously the reply to the first exam report was that opportunity.

- Note importance of response in reply to certain versions of 1226 – may be the only chance.
- Not clear how strict examiners may be, best to prepare for the worst.

Limitation on amendment.

- Amended claims can only relate to searched subject matter (Rule 137(5)) (unless within the inventive concept of the originally claimed invention).
- in particular matter not searched under Rule 62a or Rule 63.

APRIL 2010 CHANGES (3)

3. Searching

a. Of multiple independent claims

- By new Rule 62a if there are non-allowable multiple independent claims – in the meaning of Rule 43(2) – you will be given two months to say which you want searched, with the first presented being the default if you do not reply.
- Note this is not a disunity objection and if continued in examination will not provoke a divisional window (see below), although you may well be in one. Also note you cannot pay an additional fee for a further search in this situation. All you can do with unsearched claims under Rule 62a is divide and have them searched in a divisional.
- Be aware, during later examination you cannot (due to Rule 137(5)) pursue or limit to unsearched subject matter without dividing – but you may be too late for that (again see below).
- This last can arise even if you do not have Rule 62a problems.

Searching continued (1)

b. Incomplete search

- By new Rule 63, where no meaningful search is possible the EPO can ask for an indication of what they should search (reply due in two months), and absent a reply will do what they can, but that may be nothing.
- You can reply; be careful not to “add matter”.
- This is seen as a good chance to influence the search in the right direction if the claims are a mess.
- Again be aware that in examination you can not limit to unsearched matter, a poor set of claims which does not represent the invention and does not lead to a proper search may thus be disastrous.

Searching continued (2)

Related points

- If the EPO also indicates (in addition to a Rule 63 point) that there is non unity under Article 82.
- In a “straight” EPA, Rule 64 applies giving two months to request search of further inventions.
- But in a E/PCT having non unity you can not do this as Rule 164 does not allow an additional supplementary search (Supplementing the International Search) to be made on a further invention in these cases. In this situation you should delete and if you wish divide.
- The above procedure does not apply when EPO is acting as PCT authority, so if you have non unity or multiple independent claim issues in a PCT for which the EPO is ISA, you can have further inventions searched, by the EPO under PCT, when you are in the international phase, but not once you have entered the Euro phase.

APRIL 2010 CHANGES (4)

4. Divisionals

- New Rule 36(1) took effect 1 April 2010. It is retrospective, establishing time periods for voluntary divisionals which may have been set running by an exam report already issued, although no due date can be before 1 October 2010.
- Previously, so long as a parent was pending you could divide it. The problem seemed to be that the process could be eternal, and was abused in connection with OPs.
- Now, under 36(1)(a) the period for filing Div as of right expires 24 months after first exam report under Article 94(3)/Rule 71(1) or (3) on the case concerned or, apparently – the wording is not clear - on any other case in the same “family”.
- Also under 36(1)(b) you can divide within 24 months of any exam communication raising a specific A82 non unity objection for the first time.
- No Further Processing is available on this, and of course the parent must be pending.

Divisionals continued (1)

- The above point may be combined with the potential problem of wishing to limit to unsearched matter, including matter which the EPO say they have not searched even though you might believe they had done, or should have done. You can not at that stage have supplementary searches so division will be only way to keep prospects alive – but the divisional chance will have timed out if examination of the family has been slow.
- Unsearched matter is the new “killer point”, under Rule 137(5) you may not use it to limit claims.

Divisionals continued (2)

Consequence

- Must think harder sooner, term may be running already, many people expect heavy filings just before October 2010.
- Doubts about situations such as simultaneously filed related cases which each start a family or group.
- Doubts about the interpretation of the rule as regards meaning of “group”.

Divisionals continued (3)

Worries

- Delays by EPO after first exam report, two years is not uncommon, so need to monitor progress of examined pending cases particularly if, for example, one has argued against a non unity objection.
- Failure by EPO to raise non unity when they should have done so. They may fail to set off a term of the second type. For example an objection might be raised under the new multiple claim rule (see above R43(2)) when really it should or could have been one of non unity. Or they might refuse to enter amendments which would provoke the non unity objection you expect, Rule 137(2).

Divisionals continued (4)

Advice

- We suggest at least filing PACE requests if there is any prospect of need to divide. Hope this speeds things up sufficiently to bring matters to a head early enough.
- It is safest not to resist, just divide (if you can afford it) and if you argue your non-unity point and win the divisional can be dropped.

COMING NEXT?

- Obligation to provide results of searches on original applications for which priority is claimed.
- More changes at the grant stage. The EPO may allow, once again, discussion of exact language before you need to file claim translations, while, if you agree with the claims proposed, continuing with the one-step process.
- Run PCT the same way, with similar claims fees and an equivalent to Rule 62a.

ANNEX

New Rules effective from 1 April 2010

Rule 70a

Response to the extended European search report

- (1) In the opinion accompanying the European search report the European Patent Office 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 European search report and to amend the description, claims and drawings within the period referred to in Rule 70, paragraph 1.
- (2) In the case referred to in Rule 70, paragraph 2, or if a supplementary European search report is drawn up on a Euro-PCT-application, the European Patent Office 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 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.
- (3) If the applicant neither complies with nor comments on an invitation in accordance with paragraph 1 or 2, the application shall be deemed to be withdrawn.

New Rules effective from 1 April 2010 (1)

Rule 137(2)

Amendment of the European patent application

- (2) Together with any comments, corrections or amendments made in response to communications by the European Patent Office under Rule 70a, paragraph 1 or 2, or Rule 161, paragraph 1, the applicant may amend the description, claims and drawings of his own volition.
- (3) No further amendment may be made without the consent of the Examining Division.

New Rules effective from 1 April 2010 (3)

- (4) When filing any amendments referred to in paragraphs 1 to 3, the applicant shall identify them and indicate the basis for them in the application as filed. If the Examining Division notes a failure to meet either requirement, it may request the correction of this deficiency within a period of one month.

- (5) Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63.

New Rules effective from 1 April 2010 (3)

Rule 62(a)

Applications containing a plurality of independent claims

- (1) If the European Patent Office considers that the claims as filed do not comply with Rule 43, paragraph 2, it shall invite the applicant to indicate, within a period of two months, the claims complying with Rule 43, paragraph 2, 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 shall be carried out on the basis of the first claim in each category.
- (2) The Examining Division shall 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 Rules effective from 1 April 2010 (2)

Rule 63

Incomplete search

- (1) If the European Patent Office considers that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched.

New Rules effective from 1 April 2010 (2)

Rule 63 continued

- (2) If the statement under paragraph 1 is not filed in due time, or if it is not sufficient to overcome the deficiency noted under paragraph 1, the European Patent Office shall either issue a reasoned declaration stating that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed or, as far as is practicable, draw up a partial search report. The reasoned declaration or the partial search report shall be considered, for the purposes of subsequent proceedings, as the European search report.
- (3) When a partial search report has been drawn up, the Examining Division shall 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 Rules effective from 1 April 2010 (4)

Rule 36(1)

(1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that:

(a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued, or

(b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.

The End

Thanks for your attention



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