

Amendments to the implementing regulations of the European Patent Convention

The EPO has made significant amendments to the implementing regulations of the European Patent Convention, intended to streamline the grant procedure and, in general, applicants will, in future, be required to address substantive objections raised by the EPO much earlier in the procedure.

In summary:

- a) Search Reports (including International Search Reports issued by the EPO acting as ISA) will be regarded more like office actions with a patentability report examination and it will be mandatory for applicants to reply.
- b) The EPO is willing the applicant to reduce the number of independent claims before a search is performed. Moreover, if claims are deemed too broad or too unclear to be searched, the EPO is willing the applicant to clarify them.
- c) The opportunity to make voluntary amendments will be more limited.
- d) The EPO will require applicants to explain basis in the application as filed for the amendments – should the applicant not file an explanation, the application is deemed to be withdrawn.

The amended regulations will enter into force on 01.04.2010. Under the transitional provisions, some applications filed before 01.04.2010 will also be affected.

Mandatory Responses to International Search Reports Issued by the EPO

In the present procedure, the EPO does not issue a Supplementary Extended European Search Report for EURO-PCT applications if it was responsible for preparing the International Search Report (ISR) in the International phase. In such cases, the applicant may respond to the written opinion of the ISR by filing amendments on entry to the regional phase and/or shortly afterwards in response to an invitation under Rule 161 EPC.

Under the **amended rules**, for this type of application, the invitation under Rule 161 EPC will **require** the applicant to respond to any objections in the written opinion of the ISR within a period of **one month** from the date of the invitation. If a Demand has been filed in the International phase, and the EPO has also prepared the International Preliminary Examination Report (IPER), the invitation will instead relate to the IPER.

No response will be necessary if the applicant has filed amendments on entry to the regional phase. Similarly, no response will be necessary if the applicant has filed

amendments in the International phase which have been maintained on entry to the regional phase (unless the EPO has prepared an IPER taking the amendments into account).

Extensions to the term for responding to the ISR (or IPER) will not generally be available. Applications will be deemed to be withdrawn if no response is filed in time, although such cases may be reinstated as of right within an additional, specified period of two months by use of the “further processing” procedure.

The **amended rules** on mandatory responses to ISRs will apply to applications for which the invitation under Rule 161 EPC is issued on or after 01.04.2010.

The rules on mandatory responses to ISRs will not apply in relation to EURO-PCT applications for which the EPO has **not** prepared the ISR. On such cases the EPO will continue to prepare a Supplementary Extended European Search Report.

Claims for European Search Reports

The claims of a European patent application must generally be limited to a single independent claim for each category (device, method, etc.), except for some special circumstances listed in Rule 43(2) EPC.

Under the **new rules** (particularly Rule 62a), if the EPO considers that the above-mentioned requirement is not met for a European application to be searched, it shall invite the applicant to indicate claims which meet the requirement and on which the search is to be carried out within a period of **two months** from the date of the invitation. The applicant is not permitted to reply by amending the claims, and is instead expected simply to select a subset of the claims as filed.

Extensions to the term for replying to the invitation will not be allowed and the “further processing” procedure will not be applicable. If no response is filed in time, the EPO will carry out the search on the basis of the first independent claim in each category.

Under the amended rules, the EPO will also be able to issue a similar invitation asking the applicant to file a statement setting out the subject-matter to be searched if it considers that the claims are so broad or unclear that no meaningful search could otherwise be carried out.

These **new rules** will apply to applications for which the European Search Report is prepared on or after 01.04.2010.

Mandatory Responses to Extended European Search Reports

Under European procedure, an Extended European Search Report (or Supplementary Extended European Search Report) is issued for all direct filings at the EPO and for all EURO-PCT filings for which the EPO has not drafted and issued the ISR.



Under the **new rules** (particularly Rule 70a), for direct filings at the EPO, the applicant will be invited to respond to the search opinion within the period of six months (Rule 70(1)) starting from the publication date of the European search report (this also remains the deadline for requesting substantive examination). For EURO-PCT filings for which the EPO has not prepared the ISR, the applicant will be invited to respond to the search opinion within a period of six months from the date of the invitation. No such invitation will be made, however, where the search opinion is entirely positive.

Extensions to the term for responding to the search opinion will not generally be available. Applications will be deemed to be withdrawn if no response is filed in time, although such cases may be reinstated as of right within an additional period of at least two months through use of the “further processing” procedure.

The **new rules** in relation to replying to Extended European Search Reports will apply to applications for which the Extended European Search Report is prepared on or after 01.04.2010.



Amendments of European Patent Applications

Under the current rules, the applicant may amend a European patent application voluntarily at any time between receipt of the European search report and the first office action, and once more after receipt of the first office action.

The **amended rules** will be much more restrictive. Under the amended rules, the applicant will only be able to amend the application voluntarily in the one month term set for response to the invitation under Rule 161 EPC (for EURO-PCT applications on which the EPO has prepared the ISR) or in the term set for response to the extended European search report (for all other applications). Subsequent amendments will only be allowed with the consent of the Examiner, for example to address specific objections raised in the examination procedure.

The **amended rules** also require that amendments filed at any time in the procedure, including on entry to the regional phase for an EURO-PCT application, must be **explicitly identified** and accompanied **by an indication of their basis in the application as filed**. If these requirements are not met, the Examiner may demand that this information is provided within a period of **one month**. Applications will be deemed to be withdrawn if no response is filed in time, although such cases may be reinstated as of right within an additional, specified period of two months by use of the “further processing” procedure.

The **new rules** in relation to amendments will apply to applications for which the Extended European Search Report is prepared on or after 01.04.2010.