

Practice Note - February 2010

Summary of new EPO procedure concerning searches, responding to search opinions and the filing of amendments

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Preamble

The EPO is seeking to speed up the passage of applications through its search and examination procedures. To that end, certain measures are being introduced to streamline aspects of search and examination, with a view to reducing the time frame and scope which was previously available to applicants for making amendments, and with a view to rationalising the subject-matter which forms the basis of EPO searches.

Specifically, important changes are being introduced concerning the way in which EPO searches are carried out and concerning the requirement to supply responses to all EPO search opinions. In addition, the EPO is limiting the statutory provision which permits applicants to make amendments to their European applications.

The time for adapting to the new changes is fast approaching: they will take effect from **1st April 2010**. This note provides a summary of the new measures.

I. Restricted extent of EPO searches

Under certain circumstances, official correspondence may be issued before an EPO search is carried out, with the aim of restricting the extent of the search or with the aim of clarifying the subject-matter to be searched.

[One independent claim per claim category \(new Rule 62a EPC\)](#)

The EPO will not normally search more than one independent claim in any category.

Where an application contains multiple independent claims in any category, before carrying out a search, the EPO may invite the applicant to provide a statement within a time period of two months which indicates which claims are to be made the subject of the search or which challenges the finding. The applicant will be expected to indicate a set of claims to be searched which contains no more than one independent claim in each category. The search will then be restricted accordingly.

If the statement is not timely filed or does not overcome the deficiency, then the search will be performed in relation to the first set of claims in each category. The applicant will later be invited to restrict the claims accordingly.

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Unclear subject-matter (amended Rule 63 EPC)

In cases where the EPO finds the subject matter presented in a specification is unclear to the extent that no meaningful search can be performed, the applicant will be invited to file within a time period of two months, a statement indicating the subject-matter to be searched.

If the statement is not filed or does not overcome the deficiency, then a search report may be issued in the form of a partial search report, the scope of which is decided by the EPO. The applicant will later be invited to restrict the claims accordingly.

Deemed lack of unity (amended Rule 64 EPC)

In cases where a lack of unity is raised at the search stage, a partial search report will be drawn up in respect of the first claimed invention. Applicants will be notified of the partial search and will be invited to pay, within a period of two months, one or more additional search fees in respect of subject-matter which is not considered to relate to the single [searched] invention. The search report will limit itself to those parts of the application in respect of which search fees have been paid.

Note that the opportunity to pay additional search fees is not afforded to European Regional Phase applications for which a Supplementary Search is carried out by the EPO (see Rule 164(1) EPC)

The new provisions concerning searches will take effect in relation to search reports drawn up from 1st April 2010 onwards. In relation to all situations outlined above, applicants should note that during substantive examination the claims will be required to be restricted to the subject-matter which has been searched. Unsearched matter will have to be divided out into one or more divisional applications (see new procedures concerning divisional filings).

II. Responding to EPO Search Opinions

Applicants will be expected to respond to the comments and objections which are included in search opinions issued by the EPO with its search reports, whether in relation to EP direct applications or in relation to Euro-PCT applications.

EP direct applications (new Rule 70a EPC):

A written response to an extended European Search Report must be filed before the expiry of six months from publication of the search report (same time limit as for requesting substantive examination).

Failure to respond to the extended European Search Report will result in the application being deemed to be withdrawn. *Further Processing* is available

Euro-PCT applications:

In the case of European applications in the Regional Phase of the PCT, two scenarios exist:

1. International Phase EPO search (new Rule 161(1) EPC)

Where a search in the International Phase was carried out by the EPO acting as the International Search Authority (ISA), or where the EPO has performed a Supplementary International Search, a response to the written search opinion issued with the search report must be supplied to the EPO within a time-limit of one month from a notification from the EPO inviting the applicant to respond to the search opinion. This notification will be issued shortly after entry into the European regional phase.

Contact your attorney for more information on divisionals

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2. Regional Phase EPO search (new Rule 70(a)(2) EPC)

Where a Supplementary European Search Report in the Regional Phase is issued by the EPO, a response to the search opinion which is issued with the Supplementary European Search Report must be submitted before the expiry of the time limit which is set by the EPO for indicating that it is desired to proceed further with the substantive examination of the application. This time limit is expected to be a period of six months from notification of the Supplementary Search Report with its search opinion.

In both cases outlined above, a failure to duly submit the required response to the search opinion will result in the application being deemed to be withdrawn. *Further Processing* is available. The information sent to applicants concerning the intended publication of the application will draw attention to the need to reply to the EPO's search opinion (amended Rule 69 EPC).

The new provisions concerning responding to search opinions will take effect in relation to search reports drawn up from 1st April 2010 onwards.

III. Requirements and restrictions concerning the filing of amendments

The voluntary amendment opportunity afforded to applicants under Article 123(1) EPC has been restricted.

Under the new provisions (amended Rules 137(2) and (3) EPC), the opportunity to make voluntary amendments to an application is restricted to the time period for filing a response to an EPO search opinion. Any further amendment to an application requires the consent of the EPO Examining Division.

Nevertheless, in those cases where a Supplementary European Search is to be performed after entry of an application into the European Regional Phase, an opportunity to make claim amendments will continue to be available within one month of an invitation under new Rule 161(2) EPC.

With this measure, the EPO's obligation to permit the applicant to amend its application is henceforth deemed to be discharged by virtue of applicants being required to respond to EPO search opinions.

Amendments may not relate to unsearched matter (amended Rule 137(5) EPC)

As mentioned under section I above, there is now an express prohibition on introducing claim amendments during examination which are directed to subject-matter which was excluded from the scope of an EPO search.

Furthermore, in [normal] cases for which an EPO search was carried out in full, features which are introduced into claims by amendment (e.g. features taken from the specification) may be objected to if they do not combine with the originally claimed subject-matter to form a single inventive concept.

Requirement to indicate a basis for amendments (amended Rule 137(4) EPC)

It is now a formal requirement that applicants must indicate a basis in the originally filed application for amendments which are made. Failure to do so will elicit an invitation to remedy the deficiency within a time period of one month from such notification.

IV. Future requirement to supply results of earlier searches

From 1st January 2011 onwards, the EPO will require applicants to supply the results of official searches performed in respect of earlier filings from which priority is claimed by a European or Euro-PCT application. Applicants will be expected to supply any such search reports upon EPO filing or regional phase entry, or without delay once they become available. A time limit of two months may be set by the EPO within which applicants must furnish earlier search reports or a statement to the effect that no such reports are available.

Future Practice

The new EPO provisions discussed in this note place the burden of ensuring a faster procedure overwhelmingly upon applicants, whose flexibility is being significantly limited in certain respects.

- The new EPO searching practice will generally require applications to be presented with a set of claims headed up by a single independent claim in any category (method/apparatus).
- Prompt action will be needed in case the EPO issues an invitation to specify the intended extent of a search or in case additional search fees are requested.
- Where a search is restricted to certain claims only, the application will need to be restricted accordingly and later amendments may not relate to unsearched features. There may be a more frequent need to promptly file divisional applications in such cases.
- It will henceforth be necessary to treat EPO search opinions as examination communications, requiring a prompt and full response.
- Applicants will no longer benefit from a right to amend their applications outside the time limits for making any response to an EPO search opinion.
- In cases where an EPO International Search Report is issued, it will generally be necessary to consider what response to make well in advance of entry into the European Regional Phase.
- It is the manifest intention of the EPO for the substantive examination procedure to be shortened ("*streamlined*"). Applicants should not expect to be given multiple opportunities to file claim amendments during substantive examination before the EPO.

Further note

This note provides a summary of salient aspects of the rule changes in respect of EPO searches, search opinions and the filing of amendments before the EPO. It does not provide a complete guide in all circumstances which may arise. We recommend that you seek ongoing advice from your representative on a case-by-case basis, especially where it appears that unusual circumstances prevail.

References:

Official Journal of the EPO 5/2009, page 299-304
Notice from the EPO dated 15th October 2009
Notice from the EPO dated 27th October 2009 (CA/D 20/09)
Notice from the EPO dated 28th October 2009 (CA/D 18/09)
New Rules 62a, 63, 64, 70a, 70b, 137, 141 and 161 EPC