

NEWSLETTER 12/2009**Changes Concerning European Patent Applications**

This is to report on several changes in the proceedings before the European Patent Office and their bearings on our clients. These changes affect everyone seeking to obtain a European patent. They apply to all patent applications for which the European Search Report or the Supplementary European Search Report is issued as from April 1, 2010.

1) Background

The changes are the outcome of the initiative „Raising the Bar” launched by the European Patent Office. This initiative aims at improving the quality of the applications submitted with the European Patent Office. Accordingly, also the procedure of granting a patent is to be tightened.

As is widely known, the Administrative Council of the European Patent Organisation is entitled to change the rules of the European Patent Convention and in the present case has done so. The changes concern the Search, the Search Report, and divisional applications.

2) Issuance of the European Search Report

Aiming at allowing for a mentioning of the most relevant documents with regard to the scope of protection sought in the Search Report, new Rule 62a has been introduced and Rule 63 amended. Accordingly, the European Patent Office whilst conducting the search may ask the applicant to clarify the scope of the search within a term of two months.

New Rule 62a deals with multiple independent claims. Under this new rule the applicant is given an opportunity – within a period of two months - to indicate which claims he wishes to be searched. 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 claim category.

3) Response to Comment on European Search Report

Common practice for a while has been to provide a comment as to patentability together with the Extended European Search Report. This now gains in significance, as the Office according to new Rule 70a may ask the applicant to respond to this comment. If the applicant refrains from submitting such response, the patent application is considered to have been withdrawn.

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According to amended Rule 161 it is provided for a mandatory response to the PCT Search Report in case the EPO was International Search Authority. In view of the PCT time line, amended Rule 161 will be relevant for PCT reports that are received now by the applicant or his agent during the international phase, which may very well be somebody else than the EP attorney who will handle the national phase before the EPO. The following is advisable: Upon receipt of the PCT report attorneys should (seek instructions from their clients to) prepare the response to be submitted upon or shortly after EP regional phase entry, as the time limit given in Rule 161 is one month only, for which reason it may be too late to start preparing a response only upon receipt of the Rule 161 communication.

Rule 161 as amended shall apply to European patent applications where a communication under current Rule 161 has not been issued before April 1, 2010.

This measure for tightening the patent granting proceedings is favourable for applicants seeking an expeditious grant of a patent. Those who for tactical reasons so far have consciously sought lengthy patent granting proceedings, have to get used to providing their comments more promptly. This also includes that the patent claims have to be adapted more promptly to the prior art. Those who so far for tactical reasons preferred to observe the further development of their product and then tailor the patent claims accordingly, or else, those who sought to wait for a possible infringement, in order to then apply for a suitable patent, no longer can proceed in this way.

According to amended Rule 137 amendments to the patent application may only be made with the consent of the Examining Division. How this rule will be applied in practice remains to be seen. An applicant, however, should be prepared to no longer be granted an unlimited number of cycles of Office Action and response preceding the possible grant of a patent.

4) Divisional Applications

The Administrative Council of the European Patent Organisation also changes Rule 36. Now a term is set for the filing of divisional applications: For filing a divisional application on his/her own accord the applicant is granted only up to 24 months as from the date of the first Office Action of the Examining Division as to the earliest application for which an Office Action was actually issued. The term "earliest application" in this connection refers to an application in a possible sequence of original application and divisional applications.

If the time limits provided for in amended Rule 36 have expired before April 1, 2010, a divisional application may still be filed within six months of that date (October 1, 2010). If they are still running on April 1, 2010, they will continue to do so for not less than six months (October 1, 2010).

This measure aims at curtailing the practice of filing an excessive number of

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divisional applications, in order to pursue the proceedings under unaltered conditions, which is perceived as abusive.

The applicant therefore has an interest in pressing ahead with the proceedings as much as possible him/herself, in order to be able to make a decision within the 24 months whether or not a divisional application is necessary or not. We would like to point out to our clients that due to this change a divisional application no longer can be regarded as substitute for a continuation application, as it is common in the United States of America.

5) Inventive Step and Expert

In order to consistently apply the standard for patentability set by the Office, the expert from whose perspective the sufficient disclosure as well as the inventive step is judged, is defined as follows:

The expert may consist of a multidisciplinary group of persons, e.g. a team. It may be expected of him/her that he seeks suggestions from related fields and general technical areas. He/she is informed about the general common standard of knowledge. He/she is concerned with the steadily progressing development in his/her technical field. These features of the expert will be contained in the Guidelines for Examination as from April 2010. It may well be the case that the definitions as to what the expert is and is capable of, are intended to raise the bar for patentability.

An applicant therefore has to reckon with an increased involvement in inventive step discussions with the Examining Division and that the outcome of these discussions more frequently is to his/her disadvantage.

Dr. Alexander Laub
European Patent Attorney

Dr. Alfons Hofstetter
European Patent Attorney

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HOFSTETTER, SCHURACK & SKORA
Patent Attorneys and Lawyers
www.hsspatent.de

Balanstraße 57
D-81541 München
Germany
+49-(0)89-4509180
muc@hsspatent.de

Marsiliusstraße 20
D-50937 Köln
Germany
+49-(0)221-9411593
koeln@hsspatent.de