



## "Raising the Bar": Changes of European patent law

The European Patent Office (EPO) has recently launched the initiative "Raising the Bar" with the intention to improve the quality of incoming patent applications and streamline the grant procedure. However, the initiative "Raising the Bar" mainly establishes barriers and obstacles for the applicant thereby complicating the prosecution of European patent applications. For example, the EPO has introduced time limits for filing divisional patent applications and raised the claims fees. In the meantime, further changes have been adopted which will be explained in the following.

### I. New Rule 62a EPC

According to the effective Rule 43 (2) EPC, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

- a plurality of interrelated products, e.g. plug and socket, transmitter and receiver,
- different uses of a product or apparatus,
- alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

Therefore, the effective regulation already restricts the number of independent claims to generally one independent claim in each category (product, process, apparatus or use).

The new Rule 62a EPC additionally provides that, in case of several independent claims, the EPO can ask the applicant to choose one of the independent claims for the subsequent prior art search. Then, the EPO restricts the prior art search to the elected independent claim, while the subject matter of other independent claims is not searched so that these claims generally cannot be pursued on the further procedure. The reason for this amendment of the implementing regulations is that the EPO wants to stop the trend towards larger patent applications including different inventions.

### II. Amendment of Rule 63 EPC

According to the former regulation, the EPO can restrict the prior art search to those claims which are sufficiently clear, while the other claims can be excluded from the prior art search, so that these claims generally cannot be pursued in the further procedure.

The new Rule 63 EPC provides that the EPO can ask the applicant to file a statement indicating the subject-matter to be searched. Then, the prior art search can be restricted according to the statement of the applicant. For example, if the applicant clarifies the subject-matter to be

searched, the prior art search will be conducted with regard to the clarified subject-matter.

### III. Amendment of Rule 64 EPC

In case of a lack of unity of invention, the EPO already had the opportunity to demand the payment of additional search fees according to Rule 64 EPC. The amendment of Rule 64 EPC extends the official term for payment of the additional search fees from 2-6 weeks to 2 months.

### IV. Amendment of Rule 70a EPC

According to the former regulation, the applicant was not obliged to respond to the extended European search report. Therefore, the applicant could wait for the first office action issued by the Examining Division.

The new Rule 70a EPC defines an obligation for the applicant to respond to the extended European search report, if any objections are raised therein. Otherwise, the application is deemed to be withdrawn.

If the applicant, when receiving the extended European search report, has already made an examination request, the EPO will fix a term for responding to the extended European search report.

However, if the applicant has not yet made an examination request when receiving the extended European search report, the applicant is obliged to respond to the extended European search report during the official term for filing the examination request.

### V. Amendment of Rule 137 EPC

When filing any amendments of the application documents (e.g. amended claims), new Rule 137 EPC defines that the applicant shall identify the amendments and indicate the basis for them in the application as filed. If the Examining Division notes a failure to meet this requirement, it may request the correction of this deficiency within a period of one month.

### VI. Amendment of Rule 161 EPC

Rule 161 (1) EPC deals with European regional phases of PCT applications in cases where the EPO has acted as the International Searching Authority (ISA) and/or or the International Preliminary Examining Authority (IPEA). In these cases, Rule 161 (1) EPC now defines that the EPO invites the applicant to respond to any objections raised in the international search report (ISR) or the international preliminary examination report (IPEA) within one month. If the applicant fails to comply with this requirement, the application is deemed to be withdrawn.

This is very dangerous since the official term of month is generally not sufficient for making a decision about the further procedure. Therefore,

the applicant should decide on the further procedure when initiating the European regional phase.

#### VII. Entering into force

The new Rules 62a and 70a and the amended Rules 63, 69, 137 and 161 enter into force on April 1, 2010.

The new Rules 62a, 63, 70a and 137 EPÜ are applicable for all European patent applications for which the European search report has not yet been established on April 1, 2010.

Finally, new Rule 161 is applicable for all European patent applications, for which no official communication under former Rule 161 has been delivered before April 1, 2010.

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