

Recent and Future Changes in Patent Prosecution before the European Patent Office

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Summary of Important Changes

- Decreased time limits for filing divisional applications
- New fee structure
- Requirements for responding to Search Reports and Written Opinions

The changes are intended to deal with issues currently being tackled by the European Patent Office (EPO) within its "Raising the Bar" Project, namely improving overall quality of the patenting process and enhancing legal certainty for third parties, while ensuring that legitimate rights and expectations of applicants are fully served. Generally, the changes apply to directly-filed European patent applications and international applications entering the regional phase before the EPO.

Divisional Applications

Presently, divisional applications can be filed at any time during the pendency of the parent application. Also, a divisional application can itself be the basis for a further divisional. Under the new rules, additional time limits will apply and voluntary divisional applications (i.e., on applicant's own initiative) must be filed within 24 months from the Examining Division's first office action in the earliest application. Mandatory divisional applications (i.e., those in response to a lack of unity objection) must be filed within 24 months from the office action in which the lack of unity objection is first raised.

The new rules apply to all divisional applications filed on or after April 1, 2010, including divisional applications filed off of currently pending applications. For applications where the 24-month time limit will have already expired as of April 1, 2010, or is close to expiry, a 6-month grace period is provided for filing the divisional application. **Thus, it is advisable for applicants to review their patent portfolios as soon as possible to identify whether any divisional applications need to be filed before the October 1, 2010 grace period ends.**

New Fee Structure

For applications filed or entering regional phase on or after April 1, 2009, the excess claims fee for the 16th through 50th claim will remain EUR 200 per claim. However, the fee for the 51st and each subsequent claim will be raised to EUR 500 per claim. Thus, it is important for applicants to review the claim set for European patent applications and, if appropriate, to limit the number of claims e.g. by utilizing multiple-dependent claim format.

The EPO has also increased the filing fee for applications with pages in excess of 35. The cost for the 36th and each subsequent page of the application will be EUR 12. In return, the corresponding additional printing fee for the 36th and each subsequent page, which previously fell due at the time of grant, will not apply any longer for those applications.

Search Reports and Written Opinion Responses

Presently, responding to certain Search Reports and Written Opinion is voluntary. Beginning on April 1, 2010, responding to the Extended European Search Report for applications filed directly in the EPO will become obligatory. In addition, for international applications where the EPO acted as the International Searching Authority (ISA), the applicant will be required to respond to the Written Opinion or International Preliminary Examination Report shortly after entry into the European phase. Finally, for Euro-PCT applications where the EPO did not act as the ISA, the applicant will be required to respond to the Supplementary European Search Report.

In summary, it is important for applicants to consult their patent counsel to determine how these changes may affect their patent rights.

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