

Due to the decisions of the Administrative Council of March 25, 2009 amending the Implementing Regulations to the European Patent Convention CA/D 2/09 and CA/D 3/09, the following changes come into force on April 1, 2010:

Subject Matter:	New / Amended EPC Rule:	Practical Changes:	Comments:
<p>European divisional applications: new deadline for filing divisionals within 2 years from the first relevant office action</p>	<p>amended Rule 36(1) and (2)</p>	<ul style="list-style-type: none"> ➤ Divisional application filed on applicant's own initiative: 24 months from the first communication* by the EPO examining division concerning the parent application or any earlier application ➤ Divisional application filed in response to a non-unity objection: 24 months from the communication in which the non-unity objection is raised for the first time by an EPO examining division ➤ These time limits are not extendable and further processing is not available. <p>* "Examining division's first communication" is a communication under Article 94(3), Rule 71(1), (2), Rule 71(3) EPC. The notification of the search opinion does not cause this 24 months period to start.</p>	<p><u>Transitional provisions:</u> If the time limits have expired before April 1, 2010, a divisional application may still be filed within six months of that date, i.e. until October 1, 2010. If the time limits are still running on April 1, 2010, they will continue to do so for not less than six months.</p> <p>Please check:</p> <ul style="list-style-type: none"> ☞ applications with the first office action ("Examining division's first communication") or the office action wherein unity-objection was raised for the first time, dated <u>before or on</u> October 1, 2008 for filing a div. appl. until the deadline of October 1, 2010 ☞ applications with the first relevant office action dated <u>on or after</u> October 2, 2008 for filing a div. appl. within 24 months from the date of the first relevant office action
<p>Unity objections: new restrictions on the number of independent claims which will be searched / new deadline of 2 months for response</p>	<p>new Rule 62a</p> <p>amended Rule 63</p> <p>amended Rule 64(1)</p>	<ul style="list-style-type: none"> ➤ If the EPO considers that an application contains more than one independent claim in the same category, the EPO will invite the applicant to indicate within a period of two months the claims, on which the basis of the search is to be carried out. ➤ Without an indication of the applicant, the search would be carried out on the basis of the first claim in each category. ➤ Further processing will not be available. ➤ The Examination division will later on invite the applicant to restrict the claims to the actual subject-matter searched. ➤ In the case of non-unity and clarity objections, the applicant will be invited to file within a period of two months a statement indicating the subject-matter to be searched. ➤ The applicant will be invited to pay a further search fee for each invention involved, within a time period of two months to cover the other inventions. 	<p>The new rule 62a will apply to all EP applications where the European Search Report or Supplementary European Search Report has not been issued on April 1, 2010.</p> <p>Please revise the claim-set for the following exceptions:</p> <ul style="list-style-type: none"> ☞ claims related to a plurality of interrelated products ☞ claims related to different uses of a product or apparatus ☞ claims related to alternative solutions to a particular problem where it is not suitable to cover these alternatives in a single claim

Subject Matter:	New / Amended EPC Rule:	Practical Changes:	Comments:
<p>Response to the extended European Search Report / Written Opinion of the EPO: new: applicant has to file a response to the search opinion</p>	<p>direct EP filing - EPO as ESA new Rule 70a(1)</p> <p>Euro-PCT appl. - other ISA new Rule 70a(2)</p> <p>Euro-PCT appl. - EPO as ISA amended Rule 161</p> <p>amended Rule 137</p>	<ul style="list-style-type: none"> ➤ Currently there is no obligation to respond to the search opinion. Under the new rule the applicant will be invited to comment the extended European Search Report and file a response to the opinion accompanying the European Search Report. ➤ If no response will be filed, the application will be deemed to be withdrawn. ➤ The deadline for replying a comment to the extended European Search Report will be six months from the mention of publication in the European Patent Bulletin. ➤ If a Supplementary European Search Report is drawn up on a Euro-PCT-application, the applicant will have to comment the extended European Search Report within the time limit for confirming to proceed with examination, which is currently set at two months from issue of the invitation. ➤ The EPO invites the applicant to comment the Written Opinion of the International Searching Authority, or the International Preliminary Examination Report, and to make respective corrections or amendments, within a period of one month from the communication. ➤ If the applicant will not comply or does not comment the invitation, the application will be deemed to be withdrawn. ➤ The applicant may also amend the description, claims and drawings of his own, in accordance with his response to the search opinion (response to communication under Rule 70a or Rule 161). 	<p>The new rules apply for all applications, where the Search Report (or Supplementary Search Report) or the communication under current Rule 161 has not been issued before April 1, 2010.</p> <p>Please note: ☞ It is recommended to prepare a response to the objections raised in the Written Opinion or International Preliminary Examination Report already when entering the European Phase, because the one month deadline to respond to the respective invitation from the EPO is pretty short.</p>