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SUBJECT: Amendments to the Implementing Regulations to the EPC

SUBMITTED BY President of the European Patent Office

ADDRESSEES: 1. Administrative Council (for decision)
2. Committee on Patent Law (for information)

SUMMARY

In the context of the "Raising the Bar" initiative, amendments to the Implementing Regulations to the EPC are proposed with a view to improving the quality of incoming patent applications and streamlining the grant procedure.

This document is based on CA/PL 14/08 Rev. 1 dated 16.1.2009, but takes account of the results of the discussion in the Patent Law Committee. To make it easier to follow the gist, the consequent amendments vis-à-vis CA/PL 14/08 Rev. 1 are marked with grey hatching in Parts I and II. In particular, a period of two months is now provided for in Rules 62a, 63 and 64 EPC and the wording of Rules 70a(3) and 161(1), second sentence, EPC has been revised.

TABLE OF CONTENTS

Subject	Page
PART I	1
I. INTRODUCTION	1
II. MULTIPLE INDEPENDENT CLAIMS: INSERTION OF RULE 62a	1
III. CLARIFICATION OF COMPLEX APPLICATIONS	4
IV. ADAPTATION OF THE PERIOD IN RULE 64 EPC	7
V. OBLIGATORY RESPONSE TO THE SEARCH OPINION	8
A. RESPONSE TO THE EXTENDED EUROPEAN SEARCH REPORT	8
B. PRINCIPLE TO BE EXTENDED TO WORK DONE BY THE EPO ACTING AS ISA OR IPEA	10
VI. AMENDMENT OF RULE 69 EPC	13
VII. IDENTIFICATION OF AMENDMENTS - PROPOSED RULE 137(4) EPC	13
VIII. CONSEQUENTIAL AMENDMENTS TO RULE 137 EPC	14
IX. TRANSITIONAL REGIME	16
X. COMMENTS ON THE DRAFT DECISION	16
XI. REQUEST	16
PART II	17

PART I

I. **INTRODUCTION**

1. In the framework of the Strategic Renewal Process the "Raising the Bar" domain developed proposals for improving the quality of incoming patent applications (in particular, by encouraging applicants to use the European formula for drafting patent applications) and streamlining the grant proceedings.

To induce applicants to comply already at the search stage with the requirements of clarity and conciseness of claims laid down in Article 84 EPC it is proposed that,

- where an application contains an unallowable number of independent claims, the search be focused on one independent claim per category; and
- where a patent application does not comply with the EPC to such an extent that it is impossible to carry out a meaningful search, the applicant be invited to clarify the subject-matter to be searched.

To streamline grant proceedings, it is proposed to

- make a response by the applicant to the search opinion obligatory; and
- require that amendments made during grant proceedings and the basis for such amendments in the application as filed be identified.

The proposed changes require the insertion of new Rules into the Implementing Regulations but also some consequential amendments of existing Rules.

II. **MULTIPLE INDEPENDENT CLAIMS: INSERTION OF RULE 62a**

2. Rule 43(2) EPC provides that

"Without prejudice to Article 82, 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) a plurality of interrelated products,
- (b) different uses of a product or apparatus,

(c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim."

This rule implements two requirements of Article 84 EPC, clarity and conciseness of the claims.

3. The requirement of conciseness of claims enshrined in Article 84 EPC is normally seen as a formal requirement. However, it is also of great importance for the public by providing legal certainty about the scope of protection. Rule 62a EPC as proposed below, point 5, would, by reasonably limiting the number of independent claims as of the filing of the application, contribute to more clearly define the potential scope conferred by an application already at the search stage instead of postponing such delimitations to the substantive examination or even the grant stage.
4. The Office considers the amendment necessary as an increasing number of incoming applications contains multiple independent claims in the same category and does not fall within the scope of the exceptions referred to in Rule 43(2) EPC. Search and examination in respect of these applications causes considerable problems. In particular, the risk is high that such applications are ultimately limited to something which was not actually searched. Also checking compliance of later amendments with Article 123(2) EPC can become very problematic.
5. Rule 43(2) EPC is currently not enforceable at the search stage with the consequence that the search examiner, confronted with multiple independent claims in one or more categories, is obliged to draw up a search report on an application which in this form cannot be granted unless the exceptions mentioned in Rule 43(2) EPC apply in the specific case. To remedy this situation and to enhance the efficiency of grant proceedings, it is proposed to insert after Rule 62 EPC a **new Rule 62a EPC** reading:

Rule 62a

Applications containing a plurality of independent claims

(1) If the European Patent Office considers that the claims as filed do not comply with Rule 43, paragraph 2, it shall invite the applicant to indicate, within a period of two months, the claims complying with Rule 43, paragraph 2, on the basis of which the search is to be carried out. 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 category.

(2) The Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified.

6. If the applicant replies in time to the invitation under proposed Rule 62a(1), the search can be focused on the gist of the invention. If no reply is received in time, the search report will be drawn up on the basis of the subject-matter of the first independent claim in each category. However, the applicant may contest the objection under Rule 62a either in his response to the search division or before the examining division. If the search examiner can be convinced, or the examining division finds, that the objection was not justified the search will be (re-)done accordingly.
7. Proposed Rule 62a(2) in conjunction with proposed Rule 137(5), second sentence, EPC, ensures that no patent will be granted with claims directed to unsearched subject-matter. Whereas proposed Rule 137(5), second sentence, EPC, relates to amendments made during the grant procedure which are under the control of the Examining Division, Rule 62a(2) EPC is necessary to avoid that originally filed claims relating to the unsearched subject-matter remain in the application. If the applicant does not follow the invitation under Rule 62a(2) EPC, the application would not meet all requirements of the EPC and may be refused under Article 97(2) EPC.
8. It should be emphasised here that the proposed Rule 62a will not change the current practice with respect to Rule 43(2) EPC. There are technical fields - like biotechnology, telecommunication and computers - where filing several independent claims in the same category is justified and falls under the exceptions mentioned in Rule 43(2) EPC. What proposed Rule 62a EPC will change is the earliest point in time for raising an objection under Rule 43(2) EPC: The latter is shifted from the end of the search phase, the issuance of the extended European search report, to the start of the search phase.
9. **With the proposed two-month period**, the search report can be available when the application is published. To ensure that this strict time frame can be respected, it is **proposed to exclude further processing in respect of the period under Rule 62a**. This implies that re-establishment of rights will be available.

10. The procedure in proposed Rule 62a EPC may be compared with the procedure under Rule 64 EPC governing objections of non-unity. In that context, the Enlarged Board of Appeal pointed out that an applicant who fails to pay the further search fees for a non-unitary application when requested to do so by the Search Division cannot pursue that application for the subject-matter in respect of which no search fees have been paid. Such an applicant must file a divisional application in respect of such subject-matter if he wishes to seek protection for it (see G2/92, OJ EPO 1993, 591). It should be noted here, that proposed Rule 62a EPC does not provide for the payment of further search fees if a respective objection is raised by the EPO because search fees relate to inventions, not to individual claims.

III. CLARIFICATION OF COMPLEX APPLICATIONS

11. The term "complex application" is used to refer to applications which pose significant problems both in search and substantive examination. These problems are mainly due to the way in which the claims are drafted. Generally, an application is regarded as being complex if it is lacking support, clarity or conciseness to such an extent that no meaningful search is possible.
12. The proposed amendment to Rule 63 EPC aims at improving to the extent possible search and examination of such applications by inviting the applicant to submit before search a statement indicating the subject-matter to be searched. Amendments of the application will not yet be admitted in accordance with Rule 137(1) EPC. Thus, an appropriate response to an invitation under Rule 63 could be, in particular, a statement
- indicating that part of the description, e.g. a specific embodiment, which can be used for interpreting the claims, or
 - consisting of an improved claims wording which would become a formal amendment to overcome the deficiency in the response to the extended European search report.

Present wording

Rule 63 Incomplete search

If the European Patent Office considers that the European patent application does not comply with this Convention to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed, it shall either issue a reasoned declaration to that effect or, as far as is practicable, draw up a partial search report. The declaration or the partial report shall be considered, for the purposes of subsequent proceedings, as the European search report.

Proposed wording

Rule 63 Incomplete search

(1) If the European Patent Office considers that the European patent application **fails to such an extent to** comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall **invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched.**

(2) If **the statement under paragraph 1 is not filed in due time, or if it is not sufficient to overcome the deficiency noted under paragraph 1, the European Patent Office shall** either issue a reasoned declaration stating that the European patent application **fails to such an extent to** comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed or, as far as is practicable, draw up a partial search report. The **reasoned** declaration or the partial **search** report shall be considered, for the purposes of subsequent proceedings, as the European search report.

(3) When a partial search report has been drawn up, the Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified.

13. In the ideal case, the applicant's statement removes completely the deficiencies under Article 84 EPC and a complete search report can be drawn up. Alternatively, the partial search report will be drawn up in the light of the applicant's submissions, so that it will be up to the applicant to delimit the subject-matter to be searched. There might however remain cases where - even in the light of such clarifications by the applicant - the EPO can only issue a reasoned no-search declaration. This could occur, for instance, when the applicant's statement refers to subject-matter having no basis in the application as filed. The extended European search report would mention this. The objection will, however, be reviewed during substantive examination.
14. The proposed Rule 63 EPC enables the applicant to submit statements more clearly defining the subject-matter to be searched in cases where a normal search cannot be carried out. However, because the search report should, as a rule, be drawn up in time for publication together with the application **further processing in respect of the period referred to in proposed Rule 63(1) EPC will be excluded**. This implies that **re-establishment of rights will be possible**.
15. Proposed Rule 63(3) EPC is based on the same reasoning as Rule 62a(2) EPC (see above, point 7).

IV. ADAPTATION OF THE PERIOD IN RULE 64 EPC

16. Rules 62a, 63 and 64 EPC ought to lay down the same periods. It is therefore proposed that Rule 64 EPC be amended to give the applicant a period of two months in which to pay further search fees:

Rule 64

European search report where the invention lacks unity

(1) If the European Patent Office considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial search report on those parts of the application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that, for the European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period to be specified, which shall neither be shorter than two weeks nor exceed six weeks. The European search report shall be drawn up for the parts of the application relating to inventions in respect of which search fees have been paid.

(2) Any fee paid under paragraph 1 shall be refunded if, during the examination of the European patent application, the applicant requests a refund and the Examining Division finds that the communication under paragraph 1 was not justified.

Regel 64

European search report where the invention lacks unity

(1) If the European Patent Office considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial search report on those parts of the application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that, for the European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period [...] of two months. The European search report shall be drawn up for the parts of the application relating to inventions in respect of which search fees have been paid.

Unchanged

17. Further processing in situations covered by Rule 64 had already been impossible under EPC 1973 and has been ruled out by Rule 135(2) EPC since the entry into force of EPC 2000.

V. OBLIGATORY RESPONSE TO THE SEARCH OPINION

A. RESPONSE TO THE EXTENDED EUROPEAN SEARCH REPORT

18. One of the purposes of introducing the opinion accompanying the European search report in 2005 was to speed up the examination procedure by providing a product corresponding to the examiner's first communication already at search stage. This has been achieved only in part yet, because if the applicant does not respond to that opinion he is sent an automated first communication shortly after the request for examination is filed. On the other hand, if the applicant would respond to the opinion on or before filing his request for examination (or the indication of the intent to proceed further with the application under Rule 70(2) EPC), a decision on the grant of the patent could be reached earlier.
19. Under the current legal framework there is no mandatory reply to the opinion accompanying the European search report. Consequently, while some applicants already act as advised in the Guidelines for Examination others prefer to delay their reply and thus the advantages aimed at by the introduction of the extended European search report are lost. It is therefore proposed to insert a **new Rule 70a EPC** in Chapter IV - "Examination by the Examining Division" - of Part IV of the Implementing Regulations which would read:

Rule 70a

Response to the extended European search report

(1) In the opinion accompanying the European search report the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period referred to in Rule 70, paragraph 1.

(2) In the case referred to in Rule 70, paragraph 2, or if a supplementary European search report is drawn up on a Euro-PCT application, the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period specified for indicating whether he wishes to proceed further with the application.

(3) If the applicant does not comply with or comment on an invitation in accordance with paragraph 1 or 2, the application shall be deemed to be withdrawn.

20. Whereas on the legal level the search and the examination phase of a European patent application are still to be distinguished, this distinction is softened up on the practical level since the full implementation of BEST. Thus, the legal basis for the proposed concept of an obligatory response to the search opinion is Article 92 in conjunction with Article 94 EPC. These provisions refer to the Implementing Regulations as far as procedural details of the search, the request for examination and the examination are concerned. On this basis, the Implementing Regulations already provide or - after an adoption of the proposed amendments - will provide that
- no amendments are allowable before the applicant receives the search report (this corresponds to the current legal situation which remained unchanged since 1977);
 - the request for examination shall be accompanied by the response to the opinion attached to the search report (unless the latter is positive and no reaction is necessary); this new requirement is expected to substantially shorten processing times;
 - amendments on the applicant's own volition must be filed together with the request for examination and later amendments may only be made with the consent of the examining division (this is in line with Article 123(1), second sentence, EPC).
21. The applicant will have six months to comment upon the extended European search report and, in particular, to respond to any objections raised. For Euro-direct-applications this follows from Rule 70a(1) EPC referring to the time limit for filing the request for examination laid down in Rule 70(1) EPC.
22. If the fee for examination was already paid before transmission of the European search report, i.e. a valid request for examination has already been filed, the Office invites the applicant in accordance with Rule 70(2) EPC to indicate within a period to be specified, whether he wishes to proceed further with the application. According to the Guidelines for Examination, Part A-VI, 2.3, a time limit of six months should be given from the date of the publication of the mention of the search report in the European Patent Bulletin.

23. Following a decision of the Legal Board of Appeal (J 8/83, OJ EPO 1985, 102), it is the practice of the Office to send the invitation provided for in Rule 70(2) EPC (Guidelines for Examination, Part A-VII, 5.3) also in case a supplementary European search report is to be drawn up on a Euro-PCT-application. The six months time limit should also be applicable in this case.
24. If the European patent application in accordance with the proposed new Rule 70a(3) EPC is deemed to be withdrawn, **further processing can be requested.**
25. The above procedure would only be used if the opinion attached to the search report is negative. Where no objections are raised, and the applicant is therefore not invited to correct any deficiencies or to amend the claims, description or drawings, no reply is necessary. This would be expressed in the opinion itself. However, the applicant may file amendments at this stage on his own initiative (see VIII below, proposed Rule 137(2) and point 38).
26. As a consequence of the new obligation of the applicant also Rule 137 governing amendments of the European patent application must be adapted to the new procedure (see VIII below).

B. PRINCIPLE TO BE EXTENDED TO WORK DONE BY THE EPO ACTING AS ISA OR IPEA

27. The principle outlined above should also be implemented for Euro-PCT-applications. For Euro-PCT cases where the EPO was the ISA and prepared a WO-ISA, the applicant should be obliged to file a substantive response within the time limit for filing the latest set of amendments, currently laid down in Rule 161 EPC. Under the Rules, amended as proposed here, the right to file amendments within a one-month period triggered by a communication of the EPO would follow from proposed Rule 161(1) EPC (amendments in response to the international search report and the written opinion by the ISA) and proposed Rule 137(2) EPC (amendments by the applicant of his own volition).
28. Again, failure to respond in time to the communication under Rule 161(1) EPC would result in the deemed withdrawal of the application (Rule 161(1), second sentence, EPC). Further processing is possible.

29. Any amendments filed under Art. 19 PCT could be considered as a substantive response to the WO-ISA, only where these are to be the basis of the further examination at the EPO.
30. If the applicant requested International preliminary examination and the EPO was both the ISA and the IPEA, the same rules should apply. On entry into the European phase a reply to the IPER would be required from the applicant within the period set under proposed Rule 161(1) EPC.
31. The one-month period provided for in proposed Rule 161(1) may appear short. However, it should be taken into account that
- there is a need for coordinating this time limit with the time limit under Rule 162(2) EPC (payment of claims fees) and the time limit relating to the right to amend the application on entry into the regional phase (Articles 28 and 41 and Rules 52.1(a) and 78.1(a) PCT, current Rule 161 and proposed Rule 161(1) in conjunction with proposed Rule 137(2) EPC),
 - for practical reasons the combined communication under Rule 161(1) and 162 EPC can only be issued 1-2 months after entry into the regional phase,
 - when entering the European phase at the end of the 31-month period, the written opinion of the ISA is known to the applicant since some 12 months.
32. The procedural situation addressed in proposed Rule 161(2) EPC corresponds to the situation under current Rule 161 EPC in so far, as the applicant has an opportunity to amend his application on entry into the European phase. The procedure after issuance of the supplementary European search report is governed by Rule 70a(2) EPC.

33. To implement the procedure outlined above, Rule 161 EPC should be amended as follows:

Present wording

Proposed wording

Rule 161

Rule 161

Amendment of the application

Amendment of the application

Without prejudice to Rule 137, paragraphs 2 to 4, the application may be amended once, within one month from a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under Article 153, paragraph 7.

(1) If the European Patent Office has acted as the International Searching Authority and, where a demand under Article 31 PCT was filed, also as the International Preliminary Examining Authority for a Euro-PCT application, it shall give the applicant the opportunity to comment on the written opinion of the International Searching Authority or the International Preliminary Examination Report and, where appropriate, invite him to correct any deficiencies noted in the written opinion or in the International Preliminary Examination Report and to amend the description, claims and drawings within a period of one month from the respective communication. If the applicant does not comply with or comment on an invitation in accordance with the first sentence, the application shall be deemed to be withdrawn.

(2) Where the European Patent Office draws up a supplementary European search report on a Euro-PCT application, the application may be amended once within a period of one month from a communication informing the applicant accordingly. The application as amended shall serve as the basis for the supplementary [...] European search.

VI. AMENDMENT OF RULE 69 EPC

34. To give applicants reliable information on the starting point of the periods under Rule 70(1) and 70a(1) EPC, it is proposed that the information on the date of publication in the European Patent Bulletin of the mention of the publication of the European search report be made legally binding.

Present wording Rule 69

Information about publication

(1) The European Patent Office shall inform the applicant of the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention to Rule 70, paragraph 1, and Article 94, paragraph 2.

(2) The applicant may not invoke the omission of the communication under paragraph 1. If a later date of publication is specified in the communication, that later date shall be the decisive date as regards the period for filing the request for examination, unless the error is obvious.

Proposed wording Rule 69

Information about publication

(1) The European Patent Office shall inform the applicant of the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention to Rule 70, paragraph 1, [...] Article 94, paragraph 2 **and Rule 70a, paragraph 1.**

(2) [...] If a [...] date of publication is specified in the communication **under paragraph 1 which is later than the actual date of publication**, that later date shall be the decisive date as regards the periods **referred to in Rule 70, paragraph 1, and Rule 70a, paragraph 1, unless the error is obvious.**

VII. IDENTIFICATION OF AMENDMENTS - PROPOSED RULE 137(4) EPC

35. The most common quality problem identified in granted patents is contravention of Article 123(2) EPC, which is assumed to be in part due to difficulties which examiners have in assessing the basis for amendments. These difficulties arise in particular because of the amount of effort which is required to identify all of the amendments when these are extensive, and to identify their basis in long applications.

36. Therefore it is proposed to enforce the application of a provision which is already contained in the Guidelines for Examination, E-II, 1, namely that the applicant identifies the amendments and explains their basis in the original application. Experience with those applicants and representatives who already follow the requirement of the Guidelines is that this greatly assists the examiner.
37. A respective provision can be inserted in Rule 137 as its paragraph 4 (for the proposed wording, see VIII below). The now proposed procedure that the Examining Division may send a communication to the applicant with a short and not extendable time limit if amendments are not identified or the basis for them is not indicated allows to take into account the specific circumstances of the case. If no response is filed in due time, the application will be deemed withdrawn under Article 94(4) EPC.

VIII. CONSEQUENTIAL AMENDMENTS TO RULE 137 EPC

38. As under the current grant procedure, the applicant is not allowed to amend his application before the search. Article 123(1) EPC provides that the applicant shall be given at least one opportunity to amend the application of his own volition. The applicant's right to amend the application of his own volition after receipt of the examiner's first communication is shifted to the procedural stage of response to the opinion accompanying the European search report, or, where applicable, the WO-ISA or the IPER (see proposed wording of Rule 137(2) EPC).
39. The former paragraph 4 of Rule 137 becomes paragraph 5 but must be supplemented by a sentence addressing the situation of subject-matter which is not searched in accordance with Rules 62a or 63 EPC. If the claims were restricted under proposed Rule 62a(2) EPC, amendments based on unsearched subject-matter may also not be derived from the description in a later stage of the grant proceedings. The subject-matter not searched in accordance with Rule 62a or 63 EPC may, however, be further pursued in divisional applications which must be filed within the time limit laid down in proposed Rule 36(1)(a) EPC (see CA/145/08 Rev. 2, CA/145/08 Rev. 2 Add. 1).

Present wording

Rule 137 Amendment of the European patent application

(1) Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application unless otherwise provided.

(2) After receipt of the European search report, the applicant may, of his own volition, amend the description, claims and drawings.

(3) After receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend once the description, claims and drawings, provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division.

Proposed wording

Rule 137 Amendment of the European patent application

(1) *unchanged*

(2) [...] Together with any comments, corrections or amendments made in response to communications by the European Patent Office under Rule 70a, paragraph 1 or 2, or Rule 161, paragraph 1, the applicant may amend the description, claims and drawings of his own volition.

(3) No further amendment may be made without the consent of the Examining Division.

(4) When filing any amendments referred to in paragraphs 1 to 3, the applicant shall identify them and indicate the basis for them in the application as filed. If the Examining Division notes a failure to meet either requirement, it may request the correction of this deficiency within a period of one month.

(4) Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.

(5) Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. **Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63.**

IX. TRANSITIONAL REGIME

40. The transitional provisions do balance the Office's interest in a quick implementation of the proposals and the justified interest of the applicants to be informed well in advance before the entry into force of the revised provisions. The proposed solutions for implementing the above proposals can be found in Article 2 of the draft decision annexed to this document.

X. COMMENTS ON THE DRAFT DECISION

41. The draft decision now also contains the exclusions from further processing in respect of the periods in Rules 62a and 63 EPC, which previously had featured only in the draft decisions in CA/145/08 and CA/145/08 Rev. 1 concerning divisional applications.

Subject to the Administrative Council's agreement to the proposed amendment of Rule 36 EPC (see CA/145/08 Rev. 2, CA/145/08 Rev. 2 Add. 1), the draft decision contained in this document also covers the exclusion of further processing in respect of the periods referred to in those documents.

XI. REQUEST

42. The Administrative Council is requested to approve the draft decision in Part II.

PART II

Draft

DECISION OF THE ADMINISTRATIVE COUNCIL
of [date of decision]
amending the Implementing Regulations to the
European Patent Convention

THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN PATENT ORGANISATION,

Having regard to the European Patent Convention (EPC), and in particular Article 33(1)(c) thereof,

On a proposal from the President of the European Patent Office,

Having regard to the opinion of the Committee on Patent Law,

[Taking account also of Article 1, point 3, of today's decision CA/D ***/09 concerning divisional applications]

HAS DECIDED AS FOLLOWS:

Article 1

The Implementing Regulations to the EPC shall be amended as follows:

1. The following new Rule 62a shall be inserted in Part IV, Chapter II:

"Rule 62a

Applications containing a plurality of independent claims

(1) If the European Patent Office considers that the claims as filed do not comply with Rule 43, paragraph 2, it shall invite the applicant to indicate, within a period of two months, the claims complying with Rule 43, paragraph 2, on the basis of

which the search is to be carried out. 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 category.

(2) The Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified."

2. Rule 63 shall be amended to read as follows:

"Rule 63
Incomplete search

(1) If the European Patent Office considers that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed, it shall invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched

(2) If the statement under paragraph 1 is not filed in due time, or if it is not sufficient to overcome the deficiency noted under paragraph 1, the European Patent Office shall either issue a reasoned declaration stating that the European patent application fails to such an extent to comply with this Convention that it is impossible to carry out a meaningful search regarding the state of the art on the basis of all or some of the subject-matter claimed or, as far as is practicable, draw up a partial search report. The reasoned declaration or the partial search report shall be considered, for the purposes of subsequent proceedings, as the European search report.

(3) When a partial search report has been drawn up, the Examining Division shall invite the applicant to restrict the claims to the subject-matter searched unless it finds that the objection under paragraph 1 was not justified. "

3. Rule 64, paragraph 1, shall be amended to read as follows:

"(1) If the European Patent Office considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial search report on those parts of the application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the

applicant that, for the European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within a period of two months. The European search report shall be drawn up for the parts of the application relating to inventions in respect of which search fees have been paid."

4. Rule 69 shall be amended to read as follows:

"Rule 69
Information about publication

(1) The European Patent Office shall inform the applicant of the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention to Rule 70, paragraph 1, Article 94, paragraph 2, and Rule 70a, paragraph 1.

(2) If a date of publication is specified in the communication under paragraph 1 which is later than the actual date of publication, that later date shall be the decisive date as regards the periods referred to in Rule 70, paragraph 1, and Rule 70a, paragraph 1, unless the error is obvious. "

5. The following new Rule 70a shall be inserted in Part IV, Chapter IV:

"Rule 70a
Response to the extended European search report

(1) In the opinion accompanying the European search report the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period referred to in Rule 70, paragraph 1.

(2) In the case referred to in Rule 70, paragraph 2, or if a supplementary European search report is drawn up on a Euro-PCT-application, the European Patent Office shall give the applicant the opportunity to comment on the extended European search report and, where appropriate, invite him to correct any deficiencies noted in the opinion accompanying the European search report and to amend the description, claims and drawings within the period specified for indicating whether he wishes to proceed further with the application.

(3) If the applicant neither complies with nor comments on an invitation in accordance with paragraph 1 or 2, the application shall be deemed to be withdrawn."

6. Rule 135, paragraph 2, shall be amended to read as follows:

"(2) Further processing shall be ruled out in respect of the periods referred to in Article 121, paragraph 4, and of the periods under Rule 6, paragraph 1, Rule 16, paragraph 1(a), Rule 31, paragraph 2, [Rule 36, paragraphs 1(a), 1(b) and 2]¹, Rule 40, paragraph 3, Rule 51, paragraphs 2 to 5, Rule 52, paragraphs 2 and 3, Rules 55, 56, 58, 59, 62a, 63, 64 and Rule 112, paragraph 2."

7. Rule 137 shall be amended to read as follows:

"Rule 137

Amendment of the European patent application

(1) Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application unless otherwise provided.

(2) Together with any comments, corrections or amendments made in response to communications by the European Patent Office under Rule 70a, paragraph 1 or 2, or Rule 161, paragraph 1, the applicant may amend the description, claims and drawings of his own volition.

(3) No further amendment may be made without the consent of the Examining Division.

(4) When filing any amendments referred to in paragraphs 1 to 3, the applicant shall identify them and indicate the basis for them in the application as filed. If the Examining Division notes a failure to meet either requirement, it may request the correction of this deficiency within a period of one month.

¹ The text in square brackets has been included in the text of the draft decision subject to the Administrative Council's agreement to the proposed restrictions regarding divisional applications (see CA/145/08 Rev. 2 and CA/145/08 Rev. 2 Add. 1).

(5) Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept. Nor may they relate to subject-matter not searched in accordance with Rule 62a or Rule 63."

8. Rule 161 shall be amended to read as follows:

"Rule 161
Amendment of the application

(1) If the European Patent Office has acted as the International Searching Authority and, where a demand under Article 31 PCT was filed, also as the International Preliminary Examining Authority for a Euro-PCT application, it shall give the applicant the opportunity to comment on the written opinion of the International Searching Authority or the International Preliminary Examination Report and, where appropriate, invite him to correct any deficiencies noted in the written opinion or in the International Preliminary Examination Report and to amend the description, claims and drawings within a period of one month from the respective communication. If the applicant does not comply with or comment on an invitation in accordance with the first sentence, the application shall be deemed to be withdrawn.

(2) Where the European Patent Office draws up a supplementary European search report on a Euro-PCT application, the application may be amended once within a period of one month from a communication informing the applicant accordingly. The application as amended shall serve as the basis for the supplementary European search."

Article 2

(1) The provisions mentioned in Article 1 of this decision shall enter into force on 1 April 2010.

(2) New Rule 62a, Rule 63 as amended by Article 1, paragraph 2, of this decision, new Rule 70a and Rule 137 as amended by Article 1, paragraph 7, of this decision shall apply to European patent applications for which the European search report or the supplementary European search report is drawn up on or after 1 April 2010.

(3) Rule 161 as amended by Article 1, paragraph 8, of this decision shall apply to European patent applications where a communication under current Rule 161 has not been issued before 1 April 2010.

Done at Munich, [date of decision]

For the Administrative Council
The Chairman

Benoît BATTISTELLI