

## European Patent Office Rules Set to Change on April 1, 2010

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In a development that will require careful consideration by patent applicants and practitioners, the European Patent Office will be implementing a number of changes in patent practice beginning on April 1, 2010.

The overall effect of these changes will be to make European patent prosecution more compact, requiring patent applicants to make early decisions about what subject matter is important to pursue in Europe and to pursue separate inventions in separate patent applications.

### RESTRICTIONS ON DIVISIONAL APPLICATIONS

Most notably, in the first of the rules changes, voluntary divisional applications can only be filed within two years from the first Office Action issued in the first European application that is filed in a given patent family. Thus, where previously an applicant could string together European patent applications over a period of many years as a chain of divisional applications off a first application, it will now be necessary to file all divisional applications relatively early in prosecution.

Under transitional provisions, the two year term will be extended so that it does not expire before October 1, 2010. This means that October 1, 2010 will be the due date for filing any and all divisional applications in patent families having a first action prior to October 1, 2008.

### SINGLE GENERAL INVENTIVE CONCEPT

Another change to the European rules prohibits the amendment of claims to include material that was not the subject of the initial search and which does not form a "single general inventive concept" with the original group of claims. Such claims would have to be filed in divisional applications. Taken together with the first rule change, this rule adds pressure to an applicant to file as many European divisional applications as are necessary early in prosecution to protect subject matter that the applicant wishes to claim.

### LIMITS ON INDEPENDENT CLAIMS

A further rule change will require applicants in most situations to have only one independent claim per category in a given European application; for example, only one independent system claim, one independent method claim and one independent use claim. Applicants may need to file divisional applications where more than one independent claim of each type is needed. Existing rules on double patenting should be considered where divisional applications are filed.

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### EARLY REPLY TO OBJECTIONS RAISED IN INTERNATIONAL STAGE

Significantly, the new rules will require applicants to reply early during European prosecution to objections raised in search reports. In particular, where an applicant has entered Europe as the regional stage of an international application filed under the Patent Cooperation Treaty (PCT) and in which the European Patent Office has acted as the International Searching Authority, the applicant will have only one month to reply to a communication that is issued early in prosecution by the European Patent Office regarding objections raised during the international stage. Because of this rule, applicants who use the European Patent Office as the International Searching Authority should consider evaluating the objections raised during the international stage as early as possible. Also, where there are multiple claims of the same category, the PCT communication may be limited to the first, so the claims to be examined in the primary application should be presented first. Others may have to be filed in divisional applications.

### CLAIMS FEES PREVIOUSLY INCREASED

In addition to the new rule changes, the European Patent Office has already increased official fees that are based on the number of claims in the application, setting the fees at an additional 200 Euros per claim over 15 claims, and an additional 500 Euros per claim over 50 claims. This provides a further incentive to applicants to make prosecution compact in Europe, focusing each application on key features of an inventive concept.

### CONSIDER STRATEGY IN LIGHT OF NEW RULES

The new European rule changes are complex and have many features in addition to those discussed above. Because of the need to consider strategies carefully and in consultation with European patent attorneys, we encourage those who have patent applications on file in Europe, or who plan to do so, to seek advice early on how best to navigate these rule changes to the applicant's advantage.

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