

Amendments of Implementing Regulations to the EPC as of April 1st, 2010

C) Requirement to respond earlier in the Examination

a) Response to European search reports (Rule 70a EPC)

Currently, an applicant does not have to reply to a written opinion as part of a search report issued by the EPO. From April 1, 2010, the applicant will be required to respond to objections raised in the written opinion sent with a European search report. A written opinion is included to extended European search reports, raised on European patent applications filed at the EPO, and supplementary European search reports, raised in the European regional phase of an international application where the EPO was not the International Search Authority for the international application.

The time limit for responding to an extended European search report will be

- **6 months** from the publication date of the search report, if a request for examination has not been filed;
- a time limit specified by the EPO, if a request for examination has already been filed.

b) Compulsory response to written opinions and international preliminary examination reports (Rule 161 EPC)

If the EPO was responsible for the international phase of an application, it does not carry out a search for the European application. For those applications, the applicant will have to file a response shortly after entry into the European regional phase. The EPO will set a **1 month** time limit to file the response to any objections in the written opinion raised in the international phase of the application.

Until now the amendment of claims at the time of entering the regional European phase was voluntary.

Amended Rule 161 EPC sets now a very short deadline for making sometimes extensive amendments in regard to clarity, number of independent claims, unity, technical character, support by the description, novelty and inventive step so that Applicants should start to prepare such amendments well before entering the regional European phase.

The European Patent Office has introduced several new Rules which will enter into force on April 1st, 2010 and which shall accelerate the European examination procedure. Thus it is recommended that Applicants should start to prepare a European regional phase filing well before the expiry of the 31 months deadline for entering the regional European phase of a PCT application.

Disclaimer

This information letter contains general information about the amendments of Implementing Regulations to the EPC which could be of interest to our clients and foreign firms and their clients. This is not a legal advice. Additionally, the actual implementation of the amendments by the EPO has not been fully clarified as yet. Therefore, we cannot provide and take over any warranty and liability for the provided information and for the consequences following any action made due to the information provided in these letters.

Please do not hesitate to contact us for further information and also a legal advice or expert opinion which might be charged according to our regular schedule of fees.