



December 1, 2009

# Update in EP practice

Nicolas Delorme

[nicolas.delorme@germainmaureau.com](mailto:nicolas.delorme@germainmaureau.com)

French and European Patent Attorney



## What is changing

### What has changed

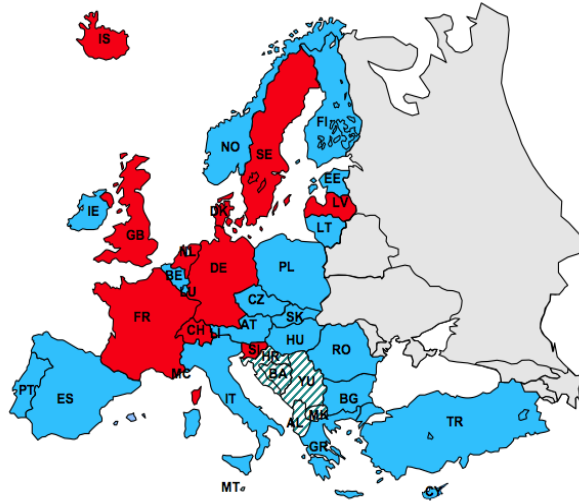
- London Agreement
- Fee changes

### What is changing

- Divisional rules
- Response required at the Search Stage
- Multiple independent claims
- Complex applications
- Identification of amendments



## London Agreement



3



## London Agreement

- The London Agreement significantly reduces costs for validation in London Agreement member states that would previously have required a full translation
- The London Agreement states represent 44% of the population and 59% of the GDP of the EPC member states
- No sign of extra countries signing up at this time

4



## Fee Changes

Recent changes have significantly altered the fees payable on EP applications:

- Altered (higher) claims fees
- Increased maintenance fees
- Single designation fee
- Excess pages fee payable on filing



## Claim Fees

- Claims 1 to 15: “free”
- Claims 16+: € 200 per claim  
35 claims means € 4000 in claim fees
- Claims 51+: € 500 per claim



## Maintenance Fees

From 1 April 2008:

- maintenance fees increase by up to 56%
- 5th year from € 450 to € 700
- 10th year from € 1065 to € 1350
- Also, late fee rises from 10% to 50% of missed fee



## Single Designation Fee

Automatic designation of all states  
for a single designation fee

- Single designation fee of € 500
- no option for fewer designations for cost or tactical reasons



## Excess Pages Fee

- For every page over 35 at filing
- €12 per page
  - Used to be paid at grant, so you used to only pay for what you received, but now you pay for what you're requesting



## Fee Changes Summary

- Financial penalty for many claims
  - Worth reducing the number of claims at EP national/Euro-pct filing
- Further incentive to prosecute quickly
- Less flexibility for designations
- Financial penalty for long spec
  - If there is extraneous material in application consider deleting before filing if, e.g. divisional filing



## EPO Rule Change - Divisionals (1)

- Old rule 36 EPC:
  - Can file a divisional based on any pending earlier EP application
  - Including where earlier application itself a div
- But EPO consider divisionals being abused
  - Especially before Oral Proceedings
- EPO (like USPTO) keen to limit use of divisionals to continue prosecution endlessly



## EPO Rule Change –Divisionals (2)

Change to Rule 36 EPC applying from April 1<sup>st</sup> , 2010

The EPO will introduce a cut-off date for the filing of divisional Application which will have to be filed:

- *Within 24 months from the first examination report issued on the parent application (in the case of a sequence of divisionals, the first examination report in any application of the sequence will trigger the time limit for all of them)*
- *Within 24 months from a non-unity objection raised for the first time in an examination report.*



### EPO Rule Change – Divisionals (3)

- Impact on all divisional filings:  
Applicant needs to consider at earlier stage whether divisional required
- If a first examination report was issued on an application on or before April 1, 2008, the cut-off deadline to file a divisional application is October 1, 2010.



### Mandatory Response at the Search Stage Euro-direct

It will be mandatory to file a response to the Search opinion within the period for paying designation and examination fees (ie 6 months from publication of the search report).



## Mandatory Response at the Search Stage Euro-PCT (1)

For Euro-PCT application where EPO has acted as ISA or IPEA, it will become obligatory to file a response within **one month** of receiving a communication from the EPO following entry into EP phase.



## Mandatory Response at the Search Stage Euro-PCT (2)

For Euro-PCT application where EPO has not acted as ISA or IPEA, the EPO draws up a supplementary Search Report with a Search Opinion, it will become mandatory to file a response to the Search Opinion. A time period (typically 4 months) will be set for doing so.



## Multiple Independent Claims

An EP application may not contain more than one independent claim in the same category (product, process, apparatus and use).

This rule will be enforced at the Search Stage.

Applicants will be given 2 months to select which claims are to be searched.



## Complex Applications

In case of complex applications i.e. application lacking support, clarity or conciseness to an extent that no meaningful search can be drawn up, the EPO will invite the Applicant to clarify the subject matter to be searched.

The Applicant will have to file a response in a 2 month period.



## Identification of Amendments

The EPO has a very strict approach towards « added matter » Thereby limiting any amendment beyond the strict and literal content of the application as filed.

As from April 1<sup>st</sup>, 2010, it will be mandatory to identify amendments and explain their basis in the application as filed.

Failure to do so will result in a one month deadline for supplying the information.



## Conclusion

The EPO wants well focused and short applications (penalty for applications Having more than 35 pages and/or more than 15 claims) and a quick prosecution (shorter and earlier prosecution deadlines)



Thank you for your attention

Nicolas Delorme  
[nicolas.delorme@germainmaureau.com](mailto:nicolas.delorme@germainmaureau.com)  
French and European Patent Attorney