
More Changes at the European Patent Office

Further changes are occurring at the European Patent Office. Rules which came into force on 1st April 2010 have been amended, and still further changes coming into effect in the future require the filing of prior art cited elsewhere and alter the approved format for medical use claims.

We explain below:

- New Information Disclosure requirements coming into force from 1st January 2011
- The new format for medical use claims required from 29th January 2011
- The most significant new procedures dating from 1st April 2010. These have been subject to changes.

New Information Disclosure Requirements

There are two parts to the new information disclosure requirements:

- **During examination**, the EPO will be able to require the applicant to provide details of prior art cited by other Patent Offices on corresponding applications. A non-extendable two month period will be set for response. Our understanding is that this information will be requested on individual cases rather than as a routine measure.
- An applicant **claiming priority** for a European Patent application will be obliged to file a copy of the results of any search carried out on the priority application(s). The copy of the search results submitted must be a copy of the official document issued by the relevant Patent Office, which may be a search report or an examination report. The citations are not required.

The search results should when possible be filed with the European patent application or when entering the European Regional Phase of a PCT application. If the search

results are not provided, the EPO will set a two month period to file the search results or to provide a statement that no results are available.

We understand that under this provision no copies of search reports will be needed where the search report was drawn up by the EPO (whether on a European application, a PCT application or a national application for Belgium, Cyprus, France, Greece, Italy, Luxembourg, Malta, Netherlands or Turkey). In addition, the United Kingdom Intellectual Property Office proposes to send copies of search results to the EPO directly.

These changes come into force on 1st January 2011.

Medical Use Claim Format

The EPO requires medical use claims to be set out in particular formats which are deemed to comply with its provisions against patenting of medical methods. For many years it has accepted claims directed to a second or further medical use of a composition of the so-called “Swiss-type” format, that is, “Use of [composition] in the preparation of a medicament for the treatment of [disease]”.

Now a simpler claim format for second and further medical uses can be employed, that is, “[Composition] for use in the treatment of [disease]”. This format was previously acceptable for first medical uses only.

Following a recent decision of the Enlarged Board of Appeal of the EPO, Swiss-type claims will no longer be accepted, and the EPO will invite the applicant to remove any such claims from the application.

This will apply for applications having a priority date of 29th January 2011 or later.

Rules which came into force on 1st April 2010

The most significant rule changes effective from 1st April 2010 are:

Response to Written Opinion and Voluntary Amendment

It is now mandatory to respond to the written opinion accompanying a search report on a European patent application by the following deadlines:

- i For direct European applications, by the deadline for requesting examination (six months from publication of the search report).
- ii For the European Regional Phase of PCT applications for which the EPO was not the International Searching Authority, within a deadline set after the supplementary search report and written opinion are issued. In general, the EPO has set a six-month period for this.
- iii For European regional phase applications for which the EPO was the ISA or IPEA, within a one-month period set shortly after entry into the European regional phase. Under a further rule change coming into effect on 1st May 2011, this period is to be changed to six months. The change will not apply to communications issued before that date.

Any voluntary amendments must also be filed by these deadlines. Later voluntary amendments can only be made with the Examiner’s consent.

Divisional Applications

There is now a non-extendable deadline for filing voluntary divisional applications of 24 months from the Examining Division’s first communication in respect of the earliest application for which a communication has been issued. In a change to this rule, having retrospective effect, the EPO has clarified that the relevant first communication is an examination report or a notice of allowance.

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