



PATENTS

EPC: SUMMARY OF THE EPC RULES CHANGES WHICH ENTERED INTO FORCE ON APRIL 01, 2010.

As already mentioned in our newsletter of January 2010, the EPO has introduced a series of changes as from April 01, 2010, essentially aimed at expediting examination. These changes have a substantive impact on the prosecution of applications. Here is a summary of these changes:

Amended Rule	Brief description
Rule 62a (new)	More than one independent claim in the same category: before carrying out the search, the examiner can invite the applicant to proceed to a claim election.
Rule 63	If no meaningful search of the application can be carried out (lack of clarity, insufficiency of disclosure,...), the examiner will invite the applicant to indicate the subject-matter to be searched.
Rule 137 (new paragraph 5)	Subject-matter which has not been searched due to the application of Rules 62a and 63 EPC (above) cannot be prosecuted in the application.
Rules 70a (new) and 161	For Euro-PCT applications where the EPO was ISA, a response to the search opinion must be filed at an early stage prior to entering the examination phase.
Rule 137, paragraph 4	The applicant must identify any amendments and indicate their basis in the original application documents.
Rule 36	Time limit and language requirements for divisional applications.
Rule 64	Time limit of two months for payment of additional search fee in case of non-unity.

RULES 161 AND 137(2) EPC

Since April 01, 2010, the applicant of a PCT application which entered the European phase (so called Euro-PCT application) and where the EPO acted as International Search Authority (ISA) must now provide a response to the written opinion issued by the EPO as ISA (WO-ISA) in reply to a communication according to Rule 161 EPC issued at the very beginning of the regional phase, i.e. prior to substantive examination. It has to be noted that the Rule 161 EPC communication does **not** trigger the time limit for the filing of voluntary or mandatory divisional applications according to Rule 36 EPC.

The above mentioned procedure does not apply however to all Euro-PCT applications. Indeed, the following different situations can be distinguished:

EPO has acted as ISA: The EPO gives the applicant the opportunity to comment on the written opinion of the ISA (or the IPER if the EPO was IPEA) and, where appropriate, invites him to correct any deficiencies noted therein and to file amendments within a period of one month from the respective communication.

- If the WO-ISA (or IPER) was positive, a response to the Rule 161(1) EPC communication is not compulsory (R 137(2) and (3) EPC).
- If amendments or comments have been filed at the entry into the regional phase, the response to the Rule 161(1) EPC communication is not compulsory (R 137(2) and (3) EPC).
- In the other cases the response to the Rule 161(1) EPC communication is compulsory. If the applicant does not respond in due time, the application will be deemed to be withdrawn.

EPO has not acted as ISA: A supplementary search report will be drawn up by the EPO on the Euro-PCT application. Like before, the application may be amended once within a period of one month from the communication pursuant to R 161(2) EPC. The application as amended serves as the basis for the supplementary European search. Failure to respond to this communication will not result in any sanction. However, the applicant will be required to respond to a written opinion accompanying the supplementary European search report for such an application at a later stage (R 70a EPC).

RULE 70a EPC (NEW)

For a Euro-PCT application, after having received the supplementary European search report, the applicant will receive a communication according to Rule 70(2) EPC requesting him to indicate whether he wishes to proceed further with the application within a period to be specified. The applicant must now additionally respond to the written opinion accompanying the search report within the time period set under the Rule 70(2) EPC communication. Failure to respond to the search opinion within the applicable period results in the application being deemed to be withdrawn.

For a Euro-direct application (i.e. no regional phase of PCT application) where the request for examination can be filed within 6 months from publication of the European search report, the applicant must now additionally respond to the written opinion accompanying the European search report within the time period set for requesting examination.

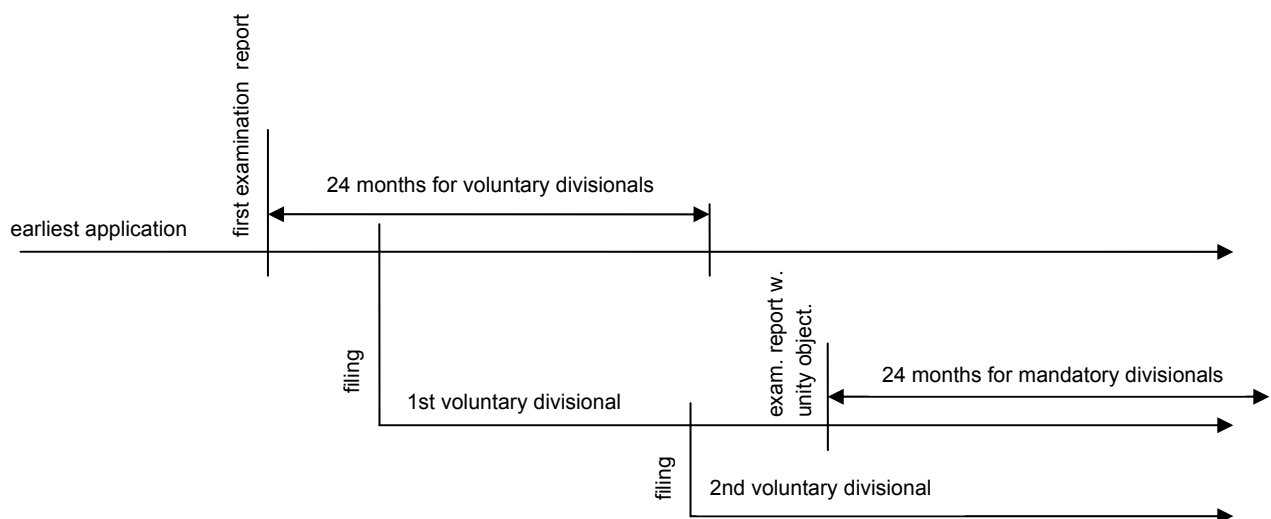
RULE 36 EPC

When may a divisional application be filed?

Two requirements must be met:

- (i) the application to be divided must be pending (i.e. active but not yet granted); and
- (ii) within a delay of two years (or 24 months) from issuance of
 - a. the first examination report in respect of the earliest application (i.e. the parent application), for a voluntary division (similar to a continuation at the USPTO); or
 - b. any examination report in respect of the application to be divided comprising a unity objection raised for the first time, for a mandatory division.

Here is a time related representation of the prosecution life of a first (earliest) application and two voluntary divisional applications, illustrating the conditions a and b above.



EPC: EXTENSION OF EUROPEAN PATENTS TO MONTENEGRO

The EPO has signed with Montenegro an agreement on the extension of European patents. This agreement has entered into force on March 01, 2010. It will therefore be possible to extend to Montenegro the protection conferred by European patent applications filed on or after that date.

EPC: ALBANIA HAS BECOME THE 37th MEMBER STATE OF THE EUROPEAN PATENT ORGANISATION ON MAY 1st 2010.

European patent applications filed on or after May 01, 2010 will include automatically the designation of Albania. It is not possible to retroactively designate Albania in European or PCT

applications filed before that date. However, since Albania was an extension state before becoming a full member state, for applications filed before May 01, 2010, the extension to Albania might still be available.

EPC: SERBIA WILL BECOME THE 38th MEMBER STATE OF THE EUROPEAN PATENT ORGANISATION ON OCTOBER 1st 2010.

European patent applications filed on or after October 01, 2010 will include automatically the designation of Serbia. It is not possible to retroactively designate Serbia in European or PCT applications filed before that date. However, since Serbia is an extension state before becoming a full member state, for applications filed before October 01, 2010, the extension to Serbia might still be available.

EPC: BENOÎT BATTISTELLI ELECTED EPO PRESIDENT

Mr BASTISTELLI is a French national and is the former Director General of the French National Institute of Industrial Property (INPI). His five-year term as President has begun on July 01, 2010. The new President will continue the work of his predecessor on the two key projects for the EPO which are the introduction of a European Union patent and the development of a European patent litigation system.

EPC: CASE LAW FROM THE EPO ENLARGED BOARD OF APPEAL ISSUED ON FEBRUARY 2010.

G1/07: Dangerous invasive imaging methods are excluded from patentability.

Summary:

A claimed imaging method, in which, when carried out, maintaining the life and health of the subject is important and which comprises or encompasses an invasive step representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a substantial health risk even when carried out with the required professional care and expertise, is excluded from patentability as a method for treatment of the human or animal body by surgery pursuant to Article 53(c) EPC.

A claim which comprises a step encompassing an embodiment which is a "*method for treatment of the human or animal body by surgery*" within the meaning of Article 53(c) EPC cannot be left to encompass that embodiment.

The exclusion from patentability under Article 53(c) EPC can be avoided by disclaiming the embodiment, it being understood that in order to be patentable the claim including the disclaimer must fulfill all the requirements of the EPC and, where applicable, the requirements for a disclaimer to be allowable as defined in decisions G1/03 and G2/03 of the Enlarged Board of Appeal.

Whether or not the wording of the claim can be amended so as to omit the surgical step without offending against the EPC must be assessed on the basis of the overall circumstances of the individual case under consideration.

A claimed imaging method is not to be considered as being a *"treatment of the human or animal body by surgery"* within the meaning of Article 53(c) EPC merely because during a surgical intervention the data obtained by the use of the method immediately allows a surgeon to decide on the course of action to be taken during a surgical intervention.

G2/08: Dosage regime for a medicament is patentable even if it is the only novel feature.

Summary:

Where it is already known to use a medicament to treat an illness, Article 54(5) EPC does not exclude this medicament to be patented for use in a different treatment by therapy of the same illness.

Such patenting is also not excluded where a dosage regime is the only feature claimed which is not comprised in the state of the art.

Where the subject matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so called Swiss-type claim as instituted by decision G5/83.

TRILATERAL: PATENT PROSECUTION HIGHWAY (PPH) PILOT PROGRAM

PCT-PPH: A new PPH pilot program using PCT work has been launched on January 29, 2010 for a period of 2 years ending on January 28, 2012. In summary, where one of the Trilateral Office (EPO, JPO and USPTO) is the (first) Office acting as ISA or as ISA and IPEA, and where the PCT application contains claims that are determined to be patentable/allowable by the (first) office as ISA or IPEA, the applicant may request accelerated examination at the other offices when the application has entered the national phase before these offices.

Requirement for requesting participation in the PCT-PPH pilot program at the EPO:

- Either the JPO or the USPTO has been the ISA. Where a Demand was filed, one of these offices has been the IPEA as well.
- The PCT application has at least one claim determined by the ISA or when applicable, by the IPEA to be patentable/allowable in the sense that it is novel, inventive and industrially applicable.
- All the claims in the application on file upon the entry into the European phase or as amended within the Rule 161 EPC time limit must sufficiently correspond to the claims deemed patentable/allowable by the ISA or the IPEA.
- The application has entered the European phase on or after January 29, 2010, but substantive examination has not yet begun.
- The applicant must file a request for participation in the PPH pilot program and submit a copy of the written opinion of the ISA (WO-ISA) and if applicable of the IPEA, and a copy

of all non-patent literature cited in the WO-ISA or IPER, unless these documents are already available to the EPO.

Where the request for participation in the PCT-PPH pilot program is granted, the EP application will be advanced out of turn for supplementary European search and substantive examination. This means that the EPO makes every effort to issue the search report as soon as possible and to issue the first examination report within 3 months of receipt of the application by the Examining Division. During the prosecution the EPO aims to send all subsequent communications within 3 months of receipt of the applicant's reply.

The requirement to participate in the EPO and JPO PPH pilot program (January 29, 2010 to January 28, 2012) or in the EPO and USPTO PPH pilot program (September 29, 2008 to September 30, 2010) for applications claiming the priority of national applications are nearly the same as for the PCT-PPH pilot program.

PCT: EPO HAS BECOME A SUPPLEMENTARY INTERNATIONAL SEARCH AUTHORITY (SISA) ON JULY 01, 2010.

As already mentioned in our previous newsletter of January 2010, the possibility for applicants to request a SIS has been introduced on January 1, 2009 in accordance with PCT Rule 45bis. The purpose of SIS is to allow applicants to reduce the risk of being faced with new citations during the national phase, mainly due to the increasing range of languages in which prior art is disclosed. The SISA may offer a search which is focused on documentation in languages in which they specialize, while other may offer a full search covering their entire documentation.

The supplementary search fee to have the supplementary international search (SIS) carried out by the EPO is 2,628 CHF and is to be paid to the International Bureau together with the SIS handling fee of 200 CHF. The review fee (in case of non unity) is 790 EUR. The languages accepted for SIS when the EPO acts as SISA, are English, French and German. The subject-matter that can be searched corresponds to the subject-matter searched under the European patent grant procedure. The EPO acting as SISA will not conduct any search on international applications filed by a US national or resident with the USPTO as Receiving Office where such application contains one or more claims relating to business methods. Nucleotide and/or amino acid sequence listings must be furnished in electronic form. The EPO has waived the requirement that a separate power of attorney is to be submitted.

PCT: AMENDMENTS TO THE PCT REGULATIONS AS FROM JULY 1st 2010

For any international application where amendments are made on or after July 1, 2010, the new PCT Rules 46.5, 66.8 and 70.2 are to be followed.

- Applicants must indicate the basis for the amendments in the application as filed when the amendments are made under PCT Article 19 (Chapter I) (new R 46.5 PCT) or PCT Article 34 (Chapter II) (new R 66.8 PCT).

- If the letter indicating the basis for the amendments in the application as filed is missing, the international preliminary report on patentability by the IPEA may be established as if the amendments had not been made (new R 70.2(c-bis) PCT).

Scope of SIS for any international application for which SIS request is made on or after July 1, 2010:

- According to amended Rule 45bis.5 (g) and (h) PCT, if the search is entirely excluded by a limitation specified in the Agreement under Article 16(3)(b) PCT, the search request is considered not to have been made, and if, due to a limitation specified in the Agreement, the search is limited to certain claims only, the supplementary international search report must indicate it.
- According to amended Rule 45bis.9(c) PCT, a searching Authority may limit the total number of claims on which a supplementary international search will be carried out.

EURO-PCT APPLICATIONS: REQUIREMENTS OF THE EPO WITH REGARD TO THE DEPOSITS OF MICROORGANISMS AND OTHER BIOLOGICAL MATERIAL

For Euro-PCT applications the information related to the deposits of microorganisms and other biological material must be submitted during the international phase to the International Bureau within the applicable time limit under PCT Rule 13bis.4. The failure to meet this time limit cannot be remedied upon entry into the European phase neither by re-establishment of rights nor by further processing. As a result, the application may have to be refused by the EPO for insufficient disclosure.

EURO-PCT APPLICATIONS: NEW REQUIREMENT FOR ENTRY INTO THE REGIONAL PHASE

The EPO may require the address, nationality and residence of the applicant if they have not been furnished in the "Request" part of the international application.

BUDAPEST TREATY: LUXEMBOURG HAS BECOME THE 73th STATE PARTY TO THE BUDAPEST TREATY

The accession of Luxembourg to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure has entered into force on July 29, 2010.

IP INFORMATION: WIPO Launches WIPO GOLD: <http://www.wipo.int/wipogold/en/>.

WIPO GOLD is an online resource which provides a gateway to WIPO's global collections of searchable intellectual property data.

TRADEMARKS

MADRID PROTOCOL: ACCESSION BY ISRAEL

On May 31, 2010, the Government of Israel deposited with the Director General of the World Intellectual Property Organization (WIPO) its instrument of accession to the Madrid Protocol Concerning the International Registration of Marks. The Madrid Protocol will enter into force, with respect to Israel, on September 1, 2010. This brings the number of Contracting Parties of the Protocol to 82 and the total number of Contracting Parties of the Madrid system to 85.

DESIGNS

1999 ACT: NORWAY HAS BECOME THE 38th CONTRACTING PARTY TO THE 1999 ACT ON JUNE 17, 2010.

Where Norway is designated in an international registration the maximum period for the deferment of the publication of an industrial design is six months from the filing date or, where priority is claimed, from the priority date. The maximum duration of protection provided for by the legislation of Norway in respect of industrial designs is 25 years.

The accession of Norway to the 1999 Act also increases the total number of contracting parties to the Hague Agreement to 57.

HAGUE AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF INDUSTRIAL DESIGNS: CHANGE IN THE AMOUNT OF THE INDIVIDUAL FEE FOR EUROPEAN UNION.

From June 01, 2010, the official designation fee for the designation of the European Union with any international application is 89 CHF for each design, and 44 CHF for the renewal of each design.

MEET US

HOW TO PROTECT YOUR BRAND?

On September 29, 2010, Didier Lecomte will be lecturing at an event organized by Marketers Luxembourg on how to protect your brand. More details at http://www.marketers.lu/index.php?option=com_gigcal&task=details&gigcal_gigs_id=152&Itemid=60.

PATENT SEARCH AND WATCH

On October 14 and 15, 2010, Didier Lecomte will be lecturing in Paris on patent search and patent watch. The program of the conference can be found on our web site at http://www.ip-lecomte.com/seminar_patent_monitoring_2010_2.pdf.