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Two Steps Forward and One Back – The Latest Amendments Decided by the Administrative Council of the EPO

Thorsten Bausch (Hoffmann Eitle) · Tuesday, March 8th, 2011

With the recent decisions of the EPO Administrative Council CA/D 2/10 and CA/D 12/10 of 26 October 2010, the provisions originally intended to expedite the examination proceedings before the EPO and to reduce the average time needed by the EPO for grant will be relaxed. One of these amendments will enter into force soon, i.e. on May 1, 2011 (see also Derk Visser's contribution of 12 November 2010 to this Blog). Both decisions are to be welcomed as they institute applicant-friendly changes.

On April 1, 2010 a number of wide-ranging changes intended to reduce the duration of prosecution at the EPO entered into force. One of the changes concerned the so-called mandatory response to objections raised by the EPO in the European search opinion (ESO) or, in the case of Euro-PCT applications, in the international preliminary report on patentability (IPRP). Specifically, the Administrative Council amended Rule 161 EPC making it mandatory to respond to any objections raised in an international search or examination report when the responsible body for drawing up that report was the EPO. This rule change greatly added to the pressure involved with Euro-PCT applications since, at present, the time limit connected with Rule 161 is only a non-extendable one-month time limit. Since the European representative usually does not receive the application and relevant documents until shortly before entry into the European regional phase, and a Communication pursuant to Rule 161 EPC can be expected to follow shortly thereafter, a time limit of only one month for fully responding to any international objections puts both applicants and representatives under severe time constraints.

Meanwhile, the EPO has realized how difficult it is to file a proper response within this one-month time limit. Hence, in its decision CA/D 12/10, the Administrative Council decided to extend this one month time limit to a period of six months. It is noteworthy that all Euro-PCT applicants will benefit from this change since it is not restricted to those Euro-PCT applications where the EPO was ISR or IPEA. The new six-month period will apply to those Euro-PCT applications where a Communication pursuant to Rules 161 and 162 EPC is issued on 1 May 2011 or thereafter.

A second change of similar practical significance will enter into force on 1 April 2012. This will concern the procedure after the Examining Division has notified the applicant of its intention to grant a patent pursuant to Rule 71(3) EPC. In the Communication pursuant to Rule 71(3) EPC, the EPO sets a four-month time limit for the payment of the fee for grant and publishing and for the filing of a translation of the claims in the two official languages of the EPO other than the language of the proceedings. If, according to the currently applicable procedure, the applicant disagrees with

the claims proposed for grant by the EPO and requests amendments or the correction of errors, he files a translation of the claims as amended or corrected. According to unofficial information from the EPO, this seems to apply to about 15% of all cases. If it then turns out that the Examining Division refuses to consent to the amendments or corrections suggested by the applicant, further translations of the version then agreed upon by all parties will have to be filed. This procedure not only causes extra costs for the applicant, but is also error-prone since it can be difficult to ascertain whether the previous Communication pursuant to Rule 71(3) EPC was set aside and/or which deadlines apply.

For this reason, the EPO Administrative Council decided on 26 October 2010 in its decision CA/D 2/10 to split up the procedure pursuant to Rule 71 into (a) cases where the text proposed by the Examining Division is accepted by the applicant without changes and (b) cases where amendments or corrections are requested. If according to the new procedure the applicant requests reasoned amendments or corrections to the communicated text or retains the latest text submitted by him, i.e. the text version without proposals by the EPO, the Examining Division shall issue a new Communication under Rule 71(3) if it gives its consent. Otherwise it shall resume the examination proceedings.

By this change the EPO returns in part to the procedure according to Rule 51 EPC 1973 (= Rule 71 EPC 2000) applicable before 1 July 2002 (EPO OJ 2001, 488). Under these provisions, the Examining Division had to establish first the Applicant's approval of the text on the basis of which the Examining Division intended to grant a patent (Rule 51(4) EPC 1973) before it invited the Applicant to pay the fees for grant and printing and to file the translations of the claims (Rule 51(6) EPC 1973).

The new change to Rule 71 now decided by the Administrative Council is a welcomed change since it contributes to legal certainty, simplifies the procedure and will reduce costs in a significant number of cases.

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