

A more flexible approach at the European Patent Office?

17 December 2014

By Toby Thompson of FB Rice

The European patent system is known for its procedural complexity and strict assessment of requirements to obtain patent protection, but recent changes suggest a desire to improve ease of use for applicants. The most recent rule change, in relation to search procedure for PCT applications entering the EP regional phase, was introduced in November 2014 and is a positive step towards increasing flexibility.

Europe is a major market for many technology companies, and obtaining strong European patent protection forms an important part of their IP strategy. However, the process of obtaining a European patent can be complex, and the European Patent Office (EPO) is considered to be amongst the strictest of the major patent offices in their assessment of some requirements for obtaining patent protection.

Over the past 18 months, though, a number of procedural changes have increased flexibility for users of the European Patent system. The most recent change (to Rule 164 EPC) was in respect of search procedure for PCT applications entering the European regional phase, and was introduced from November 2014. In the case where an objection is raised concerning lack of unity (i.e. that the claims of a patent application cover multiple inventions), an opportunity is now being provided by the EPO to request additional searches and then prosecute any of the searched inventions. The previous procedure was more restrictive, leading to situations where the only way of obtaining protection for unsearched inventions involved filing divisional applications. The change is particularly helpful for situations where a commercial product evolves following filing of a patent application, and the focus of the patent claims then needs to change. It is also helpful in allowing applicants to assess the likelihood of obtaining protection for different inventions contained in a patent application, before incurring costs associated with filing divisional applications.

Other changes in recent times include changes to European grant procedure (under Rule 71 EPC), such that when proposing claim amendments following approval of a specification text by the Examining Division, it is no longer necessary to prepare and file translations of the amended claims before the amendments are approved by the EPO. In addition, the previous 24 month time limit for filing divisional applications following issue of particular EPO communications has been removed, after Rule 36 EPC was amended with effect from 1 April 2014. European divisionals may now be filed at any time whilst an earlier application is still pending.

As mentioned above, EPO Examiners are often strict in their approach to the assessment of requirements for obtaining patent protection, such as added matter (i.e. whether amendments made to a patent application after filing add new information, which is prohibited). Whilst this is still very much the case, there have also been small signs of movement away from an overly rigid approach. For example, commentary added to the latest version of the EPO Guidelines for Examination, the Manual used by European Examiners, states that:

“when assessing the conformity of the amended claims to the requirements of Art. 123(2), the focus should be placed on what is really disclosed to the skilled person...the examiner should avoid disproportionately focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole.”

This follows a decision by an EPO Board of Appeal in case T2619/11 to overturn an Examining Division decision rejecting an application for added matter in respect of the content of the dependent claims. In that case, which concerned a plasma torch, original claim 1 had been amended to incorporate features from one dependent claim and was considered to be allowable by the Examining Division. However, the resulting combination of features in some of the remaining dependent claims was not, with the Examining Division commenting that the relevant claims as originally filed were not inter-dependent. In allowing the appeal against that decision, the Board of Appeal emphasised that the patent application is directed to a technical audience rather than to a philologist or a logician. As is now echoed in the Guidelines, the Board commented that it was artificial to focus disproportionately on the structure of the claims rather than on what was really disclosed by the documents as filed.

It remains to be seen whether European practice on added matter will change significantly, and it is expected that the EPO's assessment of allowability of amendments will remain strict, but any movement away from a rigid approach will be positively received by applicants.

Overall, the majority of these recent changes to European procedure and practice are positive steps, and any changes which increase flexibility and reduce costs for applicants will be welcomed.