



Briefing

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Important new deadlines for filing European divisional applications

On 1 April 2010 the rules governing the filing of divisional applications at the European Patent Office (EPO) will be changing. At present it is possible to file a divisional application at any time up to grant of the parent application. Moreover, it is possible to ‘cascade’ divisionals since a pending divisional application may itself be divided even if the original parent has already been granted. The new rules introduce much-reduced time limits for the filing of divisional applications, in particular restricting the “voluntary” filing of divisional applications to a relatively early stage of prosecution of the earliest parent application. Key points are:

- From 1 April 2010, the first substantive communication from the Examining Division received for an application will start a two-year period for the filing of any divisionals that relate to that application.
- Where a divisional application is to be filed based on an existing divisional application, the two-year period runs from the first Examination Division communication on the earliest application (i.e. the original parent application). Thus the filing of a ‘cascade’ of divisionals will be curtailed.
- By way of exception, where an Examination Report on an application (whether the original parent or a divisional) raises a unity objection for the first time, a new two-year period is started from the date of that Examination Report.
- Under the transitional provisions, where the period of two years from the first communication from the Examining Division has already elapsed before 1 October 2010, the deadline for filing any divisional application from any pending application will be 1 October 2010.

The amended rules leave various questions unanswered. Further details of how the rules will be implemented in practice will become apparent from revised Guidelines for Examination, which we understand are currently being prepared by the EPO. We

recommend that you start now to review your pending European applications to see whether you may need to file any divisional applications. Clients with substantial European portfolios, in particular, may wish to consider filing divisional applications well before 1 October 2010. In addition to spreading the cost, that may avoid the inevitable delays in the EPO following the expected filing of many divisional applications under the transitional provisions as the deadline of 1 October 2010 approaches.

Compulsory reply to European Search Reports

On 1 April 2010 changes will be made to rules governing the search and examination procedure at the European Patent Office (EPO). The result of those changes is that search reports from the EPO will become more like examination reports, with the applicant required to submit a response within a set, potentially quite short, period of time.

Currently the EPO issues with search reports a written opinion on patentability. If the applicant does not respond to the written opinion, the first examination report simply refers to that written opinion. Key points of the new rules are:

- The applicant will be set a fixed period in which to respond to the written opinion. Failure to respond in time will result in the application being deemed withdrawn. The period will be inextensible.
- For Euro-PCT applications where the EPO did not draw up the International Search Report (ISR), the EPO issues a Supplementary European Search Report, which includes a written opinion. Under the new rules the reply to the written opinion will be due within the period (typically two months) set by a subsequent EPO communication inviting the applicant to confirm their desire to proceed with the Application.
- For Euro-PCT applications where the EPO did draw up the ISR, a written opinion is included with the ISR. Except where the Applicant has responded to the written opinion in the context of International Preliminary Examination carried out by the EPO, the period set for reply will be the one-month period under

Rule 161 EPC currently allowed for amending the application after entry to the European phase.

- For direct European applications, there will be a period of 6 months for reply to the European Search Report and accompanying written opinion, calculated from publication of the European Search Report and thus coinciding with the period for requesting examination.
- The new rules will apply to ordinary European applications in respect of which the European Search Report has not been issued by 31 March 2010 and any Euro-PCT application in which the communication under Rule 161 EPC has not been issued by 31 March 2010.

The rule changes will mean that there is a need to provide at an earlier stage amendments and/or arguments that may be appropriate in the light of cited documents. In many cases the period set will be short (one or two months). In the light of these changes, it will be advisable to consider any search report prepared by the EPO promptly with a view to preparing any arguments and/or amendments within the above timescales. In the case of Euro-PCT applications in respect of which the EPO prepared the ISR, it will be necessary to prepare the response when, or very shortly after, entering the European regional phase, and you may wish to start considering any ISRs prepared by the EPO which have recently been received or are received in future with a view to having any arguments and/or amendments ready shortly after entry to the European phase.

UK case law – Paris Convention priority – need to resolve ownership issues

The High Court has decided that, in order for a priority claim in a UK patent to be valid, the applicant(s) of the later-filed application from which the UK is derived need to be the same as the applicant(s) for the priority application or be the successor(s) in title for *all* of the applicant(s) of the priority application.

Edwards Life Sciences AG v. Cook Biotech Incorporated related to a European (UK) patent

derived from a PCT application, which claimed priority from a US provisional application. The US provisional was filed, as required by US law, in the name of the inventors (of which there were three). The PCT application was filed solely in the name of a company who, at the relevant time, employed only one of the inventors listed as applicants in the US provisional. The other two inventors assigned their rights in the invention to the PCT applicant only after the PCT application had been filed. The High Court decided that the priority claim was not valid because the PCT applicant was not, when the PCT application was filed, the successor in title for all of the applicants of the priority application (the PCT applicant was merely successor in title for the one inventor which it employed). The Court rejected arguments that the priority claim was valid because the PCT applicant was successor in title of one of the applicants of the priority application.

This decision highlights the need, where an International or European patent application is to be filed in a different name to the priority application (as is often the case for US priority applications which are filed in the names of the inventors), for ownership issues to be resolved prior to filing the International or European patent application. The ownership of rights of all applicants listed on priority applications should be considered and remedial action taken before filing any priority-claiming International or European applications. This case confirms that the UK court's view is in line with EPO Board of Appeal case law concerning entitlement to priority in the EPO.

Change in official Fees at OHIM

The anticipated change in the fee structure for Community Trade Mark Applications came into effect on 1 May 2009. Under the new system, there has been a small increase in the official Filing Fee, but the official Registration Fee has now been abolished, meaning that the total fees for obtaining a Community Registration have been reduced by €700. In a recent statement, the President of OHIM, Wubbo de Boer, said "We hope that the very significant drop in the cost of Community trade marks will encourage companies to continue to protect their future right to market their brands freely in Europe".

The advantages of filing Community Trade Mark Applications rather than designating the Community under the Madrid Protocol are well known, but now for a short time there is yet another advantage. In line with the new OHIM fee structure, there will from 12 August

2009 be a corresponding reduction in the official fees for a designation of the European Community in a Madrid Protocol Application. However, the old fee structure will continue to apply for any new Madrid Protocol Applications designating the European Community which are filed prior to that date. During the interim period, Applicants may prefer to file Community Trade Mark Applications directly at OHIM so as to benefit from the reduction in fees, rather than covering the Community via the Madrid route.

San Marino joins the EPC

The European Patent Convention entered into force for San Marino on 1 July 2009. San Marino can be designated in a European patent application having a filing date on or after 1 July 2009 and, in an International (PCT) application, can be included in the list of states for which a European patent is sought. It is not possible to designate San Marino retroactively in applications having a filing date before 1 July 2009.

The accession of San Marino to the EPC brings the number of Contracting States to thirty-six, comprising all of the European Union countries plus Switzerland, Liechtenstein, Turkey, Monaco, Iceland, Croatia, Norway, former Yugoslav Republic of Macedonia and, of course, San Marino.

San Marino is a small independent republic lying wholly within the borders of Italy having a population of about 30,000; Italian is the official language and thus validation of European patents in San Marino will likely be pursued only for patents being validated in Italy.

If you have any questions regarding any of the above matters, please do not hesitate to email or telephone your usual contact at Abel & Imray, or email us at ai@patentable.co.uk with "AI Briefing" in the subject line.

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