

**Amendments of Implementing Regulations to the EPC  
as of April 1<sup>st</sup>, 2010**

**B) Difficulties in issuing a complete search**

**a) Amended Rule 62 EPC**

If the European Patent Office considers that an application contains more than one independent claim of the same category (product, process, use or apparatus (Rule 43 (2) EPC), it will invite the applicant to indicate within a period of **two months** which claims should be subject of the search. The applicant may also provide convincing arguments that the claims fall within the exceptions of Rule 43(2) EPC (a plurality of interrelated products; different uses of a product or apparatus; alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim). If the applicant fails to provide such an indication in due time, the search will be carried out on the basis of the first independent claim in each category.

**b) Amended Rule 63 EPC**

If the European Patent Office regards the claims as lacking support, conciseness or clarity, a meaningful search cannot be performed. Therefore only a partial search report will be issued. The applicant will be invited to comment this decision in a response period of **two months**. The applicant may provide convincing arguments that a complete research can be carried out and may indicate the subject matter of the search.

**c) Concerning both amendments**

A new drafting of claims is not allowed before a search report is issued (Rule 137(a) EPC). In general only one declaration will be sent by the search division. If the search division is not convinced by the applicant's arguments, the search report will indicate the reasons why the search was restricted. The applicant will be requested to remove all subject matter which was excluded from the search. However it is possible to argue against the decision of the search division during the examination procedure. This will cause the examination division to consider the decision of the search division.

Thus, especially US Applicants which commonly file several independent claims per claim category should amend the claims when entering the regional European phase of a PCT application.

The two months deadline set by the European search division is quite short and may be insufficient for providing convincing arguments.

The amendments of Rules 62 and 63 EPC drastically increase the formal requirements on European patent applications and claim drafting.

Applicants which are used to draft several independent claims per claim category should try to identify the most important independent claim and should look for possibilities to make at least some of the independent claims dependent on said most important claim keeping in mind that multiple dependent claims are allowed in Europe.

#### **Disclaimer**

This information letter contains general information about the amendments of Implementing Regulations to the EPC which could be of interest to our clients and foreign firms and their clients. This is not a legal advice. Additionally, the actual implementation of the amendments by the EPO has not been fully clarified as yet. Therefore, we cannot provide and take over any warranty and liability for the provided information and for the consequences following any action made due to the information provided in these letters.

Please do not hesitate to contact us for further information and also a legal advice or expert opinion which might be charged according to our regular schedule of fees.