

## EPO to get tough on applications having multiple independent claims

From 1st April 2010, the European Search Report will be limited to a single independent claim in each category.

### Background

Rule 43(2) EPC requires that, without prejudice to the requirement of unity of invention, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject matter of the application involves one of the following:

- a plurality of interrelated products;
- different uses of a product or apparatus; or
- alternative solutions to a particular problem where it is inappropriate to cover these alternatives by a single claim.

### Current procedure

Currently, if the European examiner considers that the claims of a European application do not meet the requirements of Rule 43(2), an objection is made under Article 84 EPC (clarity), either in the Extended European Search Report and/or in the first communication from the Examining Division, and the applicant is able to make appropriate amendment to the claims.

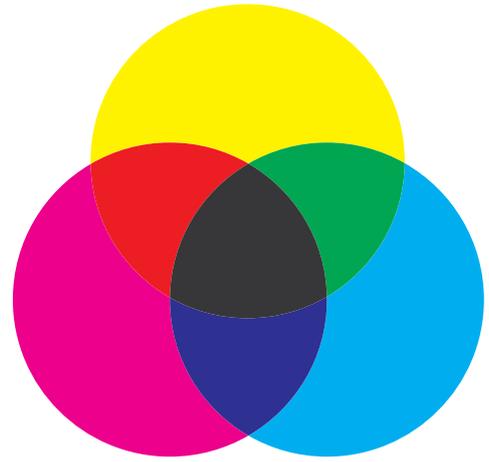
### New procedure

However, from 1st April 2010, if the European examiner considers that the claims as filed do not comply with Rule 43(2) EPC, the EPO will not provide the search report (or, in relation to PCT applications entering the European Regional Phase, the supplementary search report if required) in respect of the entire claim set.

Under new Rule 62a EPC, the EPO will invite the applicant to indicate, within a period of two months, the claims complying with Rule 43(2) on which the search is to be carried out. Further processing is specifically ruled out in respect of this time limit.

If the applicant fails to respond to this invitation, the search will be carried out on the basis of the first independent claim in each category.

It is important to note that it is not possible to amend the claims in response to the invitation under Rule 62a. Rule 137(1) EPC specifically excludes amendment of the European patent application before receipt of the European search report. Therefore, the applicant can only indicate the claims complying with Rule 43(2) on which the search is to be carried out in respect of the claims on file.



Subsequently, during substantive examination, the Examining Division will invite the applicant to restrict the claims to the subject matter searched. Amended Rule 137(5) excludes amendment of the claims during examination to include any subject matter not searched in accordance with Rule 62a.

Furthermore, unlike the present situation where the application is considered to lack unity, it appears that there will not be the option to pay one or more further search fees to enable a search report to be drawn up in respect of the entire claim set.

This rule change is, therefore, very significant and could cause considerable problems for any application drafted with [multiple independent claims](#).

## Immediate action recommended

New Rule 62a will apply to European patent applications for which the European search report or the supplementary European search report is drawn up on or after 1st April 2010.

It is, therefore, [strongly recommended](#) that any new European application filed from now onwards comply with Rule 43(2) on filing, to ensure that, if the search report has not been established prior to 1st April 2010, it will not fall foul of new Rule 62a.

Furthermore, for PCT applications entering the European Regional Phase, the claims should be reviewed and amended either prior to entry into the European Regional Phase or in response to the communication under Rule 161 EPC.

## Need advice?

Carpmaels & Ransford would be pleased to review claims prior to European filing or European regional phase entry and recommend any amendment necessary such that Rule 43(2) is complied with.

For more information, please contact [email@carpmaels.com](mailto:email@carpmaels.com).

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