

Rule 161: Compulsory reply to the IPRP and EESR

Since 1st April 2010, applicants have had to be immediately ready to respond to the international preliminary report on patentability (IPRP) on European regional phase entry if the EPO acted as International Searching Authority.

Background

On 25th March 2009, the Administrative Council of the EPO decided to amend the Implementing Regulations of the EPC in the following respect. From 1st April 2010 onwards, for international applications where the EPO acted as International Searching Authority (ISA), the applicant has had to file a substantiated reply to the international preliminary report on patentability (IPRP), assuming that the IPRP notes deficiencies in the application. The reply is due very shortly after European regional phase entry.

Similar changes have been introduced for direct European filings: it is now compulsory to address any deficiencies that are identified in the written opinion that is contained within the extended European search report.

These changes reflect a very clear desire on the part of the EPO to *accelerate* the examination process.

Although the procedure is being implemented at the sole initiative of the EPO, it may not be without advantages also for the applicant, in certain circumstances at least. For instance, the opportunity to address deficiencies

noted in the IPRP may allow a reduction in the number of excess claims fees payable on regional phase entry. In addition, it is to be expected that the process of obtaining a granted patent will be expedited.

The new procedure for international applications has been implemented by an amendment to Rule 161 EPC.

Previous procedure

Previously, a communication under Rule 161 EPC was issued shortly after European regional phase entry, giving the applicant an opportunity to amend the application, if desired, within a period of one month.

This communication was issued in all cases, and any response to it was entirely optional and had no bearing on the applicant's right to amend the application at least once during substantive examination before the EPO.

If the EPO acted as ISA during the international phase, the first communication on substantive examination, when it issued, typically referred back to any deficiencies noted in the IPRP, and invited the applicant to address these and to amend the application if appropriate within a specified time period (usually four months, extensible by two).

New Procedure

Applications where the EPO acted as ISA

A communication under revised Rule 161 EPC is now issued shortly after European regional phase entry that invites the applicant to respond to any deficiencies noted in the IPRP, and to amend the application if appropriate, within a period of one month. Failure to respond to the invitation will lead to the application becoming deemed withdrawn, although the further processing procedure is available.

Furthermore, as the issue of this communication and the response to it is essentially viewed as the first round of examination, any subsequent amendment of the application in later proceedings will only be allowed at the discretion of the Examining Division. The response to the communication under Rule 161 EPC is now the **only** time at which the applicant can make amendments of its own volition.

Applications where the EPO did not act as ISA

In this circumstance, the initial procedure remains largely unchanged from what happened previously, in that the communication under revised Rule 161 EPC simply gives the applicant the opportunity to amend the application, if desired, within a period of one month. However, when the supplementary



European search report is established (on the basis of the amended claims if any were filed), a response to the enclosed written opinion is now mandatory in the event that the EPO considers any deficiencies in the application to exist. The standard period for responding is within six months.

Divisional deadline

Despite initial concerns that the Rule 161 communication would be deemed the first communication issued by the Examining Division for the purposes of calculating the 24 month period for filing divisional applications, it has now been confirmed that this is not the case.

A significant change in our practice is needed

For international applications where the EPO acted as ISA, we are requesting that our clients provide us with instructions for responding to the IPRP **at the same time** as providing us with their instructions for effecting regional phase entry. Alternatively, of course, we would be pleased to review IPRPs in advance of European regional phase entry and to provide suggestions for response if desired. However, given the very short response period, we will need advance warning of any such request in order that an appropriate submission to the EPO can be prepared.

Need advice?

Please do not hesitate to contact us for more detailed advice at email@carpmaels.com.

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