



EPO Proposals concerning multiple independent claims - rule 62a

EPO paper CA/PL 14/08

Comments

1. While we realise that the EPO wishes to limit the scope of search by strict enforcement of rule 43(2) (one independent claim per category except in particular circumstances), the proposed new rule 62a and its relationship with other rules (especially 63, 64 and 137(5)) will cause unreasonable problems for applicants.
2. The scope of draft rule 62a(1), particularly the phrase “on the basis of the first claim in each category” is unclear. Does this mean that other claims will be ignored? Presumably it is intended to ignore other independent claims, and the features they contain where these differ from those in the first claim, though this is not wholly clear from the wording. But what of dependent claims? Will there be due regard for description and drawings or not? Does the rule comply with Article 92EPC?
3. The wording of and the very tight time limit under rule 62a(1) appear to preclude discussion with the search examiner as to which independent claims should be permitted. This will be a serious problem, since it can be expected that search examiners will often object even where rule 43(2) is complied with. Later review by the examining division is unlikely to result in a change of heart, since the same examiner will normally be involved, a change of heart would mean extra work and the applicant by that stage no longer has a right to amend (see change proposed in rule 137(3)). Thus the applicant may be faced with arbitrary and unreasonable limitations on what can be claimed.
4. The position of rule 62a, earlier than rules 63 (incomplete search) and 64 (search report where there is lack of unity) suggests that search examiners are likely to apply this rule first, without considering non unity under rule 64 and providing applicants with an opportunity to request further search. The complications that this will cause vis a vis the filing of divisional applications are discussed in a companion paper.
5. Even where the opportunity to request further search is offered, it is likely that the searches will not cover all relevant aspects of each invention since some of these will lie in claims not searched. This is likely to lead to problems at the amendment stage in view of the proposed addition to rule 137(5), which precludes amended claims which, although fairly based on the application as filed and complying with the requirement to form a single general inventive concept (as required by the present version of the rule), relate to subject matter not searched.
6. Thus a few words proposed to be added to a searched claim in order to avoid prior art for example, supported by the description and appearing in an unsearched claim will not be allowed. This is an unreasonable and damaging consequence of the proposed changes.

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7. The removal of the right to amend after the examiner's first communication is also very much a change for the worse. It is often not until this communication has been received and studied that an application can be realigned to provide the proper protection for the invention. Shifting this right under draft rule 70a to the earlier procedural stage of response to the opinion accompanying the search report will prevent this potential need from being met.
8. The time limit of one month in draft rule 161 to respond to the written opinion of the ISA or the preliminary examination report is set at the very minimum prescribed by the PCT and is inadequate. Bearing in mind also that the EPO can be late in delivering opinions and preliminary examination reports, there should be a minimum period between the issue of these opinions and reports and the invitation to amend.

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