



Extra care needed in the arrangement of claims for European patent applications derived from PCTs

When a PCT patent application enters the regional phase before the European Patent Office, unless the EPO itself acted as the International Searching Authority, a Supplementary European Search is carried out.

In such cases, should the EPO determine that the claims of the application relate to more than one inventive concept, it will now search only the invention that occurs first in the claims. The application will subsequently have to be restricted to that invention, and the other inventions deleted. The only way to pursue the inventions that are not searched will be by means of divisional applications.

This practice of the EPO is governed by new Rule 164 of the EPC, introduced with the advent of EPC 2000, the revision of the European Patent Convention that came into force on 13 December 2007.

Previous practice was more lenient to the applicant. Where a finding of lack of unity of invention was made, the EPO would previously search the first invention, but then give the applicant the option of paying one or more additional search fees in order to have other inventions searched. The applicant could then decide which of the searched inventions to pursue in the application, while retaining the right to pursue the others in divisional applications. It was not necessarily the first claimed invention that had to be pursued to grant.

This change of practice by the EPO means that it is now more important than ever that the claims of a PCT application are reviewed when entering the application

into the EPO regional phase. In any case where an objection of lack of unity of invention is expected (for instance, where such a finding has been made by the International Searching Authority), it is crucial that the invention for which protection is most desirable is placed first in the claims presented to the EPO. In addition, as before, consideration should be given to the number of claims, so as to eliminate unnecessary excess claims fees (which will also increase substantially with effect from 1 April 2008).

Rule 164 EPC states that the new practice will apply where "the European Patent Office considers that the application ... [does] not meet the requirements of unity of invention". It is to be hoped that the EPO will make an independent assessment of that issue, and will not necessarily follow the findings of the International Searching Authority (eg the USPTO).

An opportunity to amend the claims of a PCT application that has entered the regional phase is always given by the EPO, through an invitation issued, usually within a month or two of regional phase entry, under Rule 161 of the EPC. The issue of unity of invention, and of appropriate ordering of the claims, should be addressed when responding to that invitation.

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NB : The information in this note is for general guidance only, and is not a substitute for professional advice.