

EPO Releases Details of Transitional Provisions

The European Patent Office (EPO) has issued an Official Notice providing further details of the anticipated transitional provisions that will be implemented in relation to the new EPC 2000.

The transitional provisions fall under eight headings:

- Election of prosecution under the new law
- Claiming priority
- Failure to comply with time limits
- Non-unitary applications
- PCT reservations
- Applications for limitation or revocation
- Reviews of Board of Appeal Decisions
- Translation of priority documents



The transitional provisions relating to the last three topics are of little or no practical interest to most readers and so they will not be discussed below for the sake of conciseness. However, if you would like to know more about any of these, please contact us and we will be happy to help.

1. Election to Prosecute Under the New Law

1.1 It will be possible to request that a new patent application be accorded a filing date that is the date of entry into force on the new EPC 2000 law.

1.2 The only conditions are:

1.2.1 The request cannot be made more than one month before the entry into force of the EPC 2000.

1.2.2 The application must comply with the requirements of Article 80 EPC 2000 in conjunction with Rule 40 EPC 2000 [the conditions for according a filing date].

1.3 The above facility and conditions also apply to divisional patent applications with the additional condition that the parent application must still be pending at the date of filing of the divisional patent application.

2. Claiming Priority and WTO

2.1 It will be possible to file applications that claim priority from applications filed in any state that is a WTO member.

3. Failure to Comply with Time Limits

3.1 Where a failure to comply with a time limit leads to a loss of rights, the EPO will apply the remedies available under EPC 2000 if they are more favourable than the remedies available under the version of the EPC currently in force (EPC 1973).



- 3.2 One particularly important example is the further processing remedy. Here, the EPO has decided to start sending out “modified” communications even before the EPC 2000 enters into force where a 2 month period for a request for further processing expires on or after the date of entry into force of the new EPC 2000. The effect of this practice is that Further Processing under the new regime will be available for all applications pending on the date of entry into force of the EPC 2000.

4. PCT Reservations

- 4.1 The EPO has indicated that it plans to withdraw all *reservations* filed under Rule 49.6 PCT when EPC 2000 enters into force.

5. Searches

- 5.1 This provision relates to International patent applications where the International Search Authority (ISA) deems an application to relate to a number of inventions not linked by a common inventive concept OR where the EPO was not the ISA for the application.

- 5.2 Whereas, previously, upon entry into the Regional Phase before the EPO, an applicant would be given a further opportunity to have any additional inventions searched [assuming the EPO Search Division agreed with the view of the ISA regarding unity of invention] provided the relevant additional fees were paid, this will no longer be possible. Similarly, where the EPO was not the ISA, a so-called Supplementary search was carried out by the EPO. Now, however, only the first invention will be searched by the EPO and if the application is deemed to contain more than one invention, the other inventions will have to be pursued through divisional patent applications.

- 5.3 This is particularly important for any PCT applications that are due to enter the Regional Phase before the EPO on or after the date of entry into force of the EPC 2000 and where the ISA has found disunity of invention.

- 5.4 In such cases, we would recommend early entry into the Regional Phase as soon as possible before the entry into force of the EPC 2000. As a result of early entry, the application will be treated under the pre-EPC 2000 regime and applicants may therefore be afforded the additional opportunity of having the additional inventions searched. However, the EPO have given no guarantees in this respect. As mentioned above, after EPC 2000 comes into force, searching of additional inventions will no longer be possible.

6. Date of Entry into Force

- 6.1 In the Notice, the EPO gave a very brief hint that the most likely date of entry into force of the EPC 2000 will remain 13 December 2007. Previously, it had been suggested that the EPC 2000 could enter into force as early as 1 December 2007.

The above information is intended to be of a general nature and should not be taken as legal advice. If you have any specific questions, please do feel free to contact one of our advisors at mail@laudens.com for further information.

