

To our clients and friends:



INTELLECTUAL PROPERTY ALERT

JANUARY 10, 2008

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EPO Gets Tough on Complex Applications

On 14 December 2007, the Administrative Council of the European Patent Organisation announced significant increases in the official fees for European patent applications with effect from **1 April 2008** that will mainly affect complex applications comprising numerous claims or lengthy prosecution.

As from 1 April 2008, the claims fee for "excess claims" is being increased by more than 400%.

Currently, applicants must pay €45 for each claim in excess of the 10th. As of 1 April 2008, this fee is being increased by more than 400% to €200 per claim in excess of the 15th, which for applications comprising 24 or more claims may make it more economical for applicants to pursue two separate applications in parallel instead of a single case, leaving aside the effect of annual maintenance fees that must be paid for the 3rd and each subsequent year while a European patent application is pending before the EPO.

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|---|------|
| Claims fee for the 11th and each subsequent claim (present situation) | €45 |
| Claims fee for the 16th and each subsequent claim (from 1 April 2008) | €200 |
| Claims fee for the 51st and each subsequent claim (from 1 April 2009) | €500 |

The maintenance fees too are being dramatically increased, with the maintenance fees for the fourth and fifth years in particular being increased from €425 and €450 to €500 and €700 respectively.

Evidently the message from the Administrative Council is that applicants should keep their applications short in terms of the number of claims and

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should seek expeditious prosecution of them to avoid lengthy pendencies.

In a move clearly designed to penalize late payers of annuities, the additional fee for late payment of a maintenance fee is also being increased from 10% to 50% of the relevant fee.

Worse is yet to come. With effect from **1 April 2009**, while the payment of separate designation fees for each designated state (up to a maximum of seven times the fee) will be eliminated in favour of a single designation fee of €500 for all EPC contracting states, applicants filing very large numbers of claims will be penalized even further with an excess claims fee of €500 for the 51st and each subsequent claim.

Renewal Fees for European Patent Applications

| | |
|---------------------------------------|-------|
| For the third year | €400 |
| For the fourth year | €500 |
| For the fifth year | €700 |
| For the six year | €900 |
| For the seventh year | €1000 |
| For the eighth year | €1100 |
| For the ninth year | €1200 |
| For the 10th and each subsequent year | €1350 |

In view of these imminent fee increases, our clients are strongly advised to seek advice from us as to how the number of claims in their European patent applications may be reduced to ameliorate the effects of the increases.

In this regard, we would remind our clients that in Europe, it is only necessary to include dependent claims to features of an invention that, taken in combination with the claim(s) from which they depend, are new and form the basis for an inventive step (*i.e.*, are not obvious) in relation to the prior art. In this sense, dependent claims that merely add trivial, routine or otherwise obvious features to a preceding claim are generally unhelpful in European prosecution.

Naturally, in some cases, it might be desirable to claim specific embodiments in view of licensing or other contractual arrangements, but in general the inclusion of claims of this kind that are not essential for the patenting process as such should be avoided wherever possible.

Having regard to the strictness with which post-filing amendments are examined by EPO examiners for conformity with the EPCa.123(2), which provides that a European patent application may not be amended to extend

beyond the contents of the application as originally filed, it remains crucially important to ensure that the application as a whole contains direct and unambiguous basis for any amendments that might be made during the course of examination. While the EPO is evidently discouraging applicants from filing applications with numerous claims, applicants should continue to ensure that such direct and unambiguous basis for possible claim amendments may be found within the description.

Applicants are also advised to prosecute their European applications as expeditiously and efficiently as possible in order to avoid paying unnecessary maintenance fees.

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