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Carlson, Gaskey & Olds
Intellectual Property Developments

SPECIAL BULLETIN

Upcoming changes from the European Patent Office (“EPO”) will impact European patent application expenses and practice. Some of the changes reduce costs while others may significantly increase expenses. Notable details of the changes are summarized below.

EUROPEAN PATENT OFFICE INCREASES EXCESS CLAIM FEES

Effective April 1, 2008, the EPO will charge an excess claim fee of EUR200 per claim in excess of fifteen claims. Currently, the EPO charges EUR45 per claim in excess of ten claims. Effective April 1, 2009, there will also be a fee of EUR500 per claim in excess of fifty claims.

For Paris Convention and PCT National Phase applications, an applicant can pay fees for excess claims at filing or after filing. If the fees are not paid, the excess claims will be deemed never to have been filed.

Given the increased per claim fee, applicants might consider limiting their EPO filings to 15 claims. Extra claims may be deleted prior to filing an EP application, with consideration to whether deleting the claims might impact support issues that could later arise. An applicant may also consider whether using multiple dependent claims will

reduce the number of claims before filing with the EPO.

Effective April 1, 2009, the per country designation fee will also be replaced with a flat fee of EUR500. The current fee is EUR85 per country, with designation fees deemed paid for all countries once seven times the fee is paid. Thus, applicants that normally designate five or fewer countries will be paying more, and applicants that normally designate six or more will be paying less.

The full fee schedules for the April 1, 2008 effective date and the April 1, 2009 effective date can be found through the EPO website at links [Fee Schedule 4/1/08](#) and [Fee Schedule 4/1/09](#).

EUROPEAN PATENT CONVENTION AMENDMENTS

Recently, numerous changes to the European Patent Convention went into effect. Some notable changes include:

- Ability to claim priority up to two months after the one-year deadline if the deadline was missed despite "all due care required by the circumstances."
- Ability to add or correct priority claim within four months of filing, up to sixteen months from the earliest priority date claimed (however, the priority deadline is still twelve months).
- A prior application filed but not published before another application's filing date will be prior art for novelty analysis in all EP states (not just states designated in common). This is effective for all European applications filed on or after December 13, 2007.
- For EPO applications that are regional phase applications of a PCT application in which the EPO carried out the search, the EP application must proceed only based upon the invention (or inventions) searched by the EP in the PCT. No additional searches will be performed by the EP without filing a divisional application. For EP applications from PCT applications not searched by the EPO, the EPO will search only the invention first mentioned in the claims. Any unsearched applications must be pursued in divisional applications. Thus, for PCT applications with an EP search, Applicants should consider choosing to pay to have the additional inventions searched during the international stage.

Additional information is available through the EPO website at the link [EPC Amendment](#).

LONDON AGREEMENT PROVIDES SUBSTANTIAL COST SAVINGS

The London Agreement is expected to take effect in the first half of 2008. Under the London Agreement, certain countries have agreed to dispense with translation of the European Patent description into their national language in the validation phase. In particular, Austria, Belgium, France, Germany, Ireland, Luxembourg, Monaco, Switzerland and the United Kingdom will no longer require

translation of the description. Additionally, Netherlands, Sweden and Denmark will accept European Patent descriptions in English. This will provide a substantial cost reduction in the validation phase.

Additional information is available through the EPO website at the link [London Agreement](#).

CARLSON, GASKEY & OLDS

A PROFESSIONAL CORPORATION

Todd W. Barrett
Karin H. Butchko
John E. Carlson
Anthony P. Cho
Benjamin J. Coon
David J. Gaskey

400 WEST MAPLE ROAD
SUITE 350
BIRMINGHAM, MI 48009

Telephone 248.988.8360
Facsimile 248.988.8363

William S. Gottschalk
Matthew L. Koziarz
Kerrie A. Laba
Theodore W. Olds, III
John M. Siragusa
David L. Wisz

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