

### **A communication under Amended Rule 161 EPC**

#### **Is it the starting gun for the divisional application time limit and is a response mandatory?**

A communication under Rule 161 EPC invites the applicant to correct any deficiencies noted in the Written Opinion of the International Search Authority (WO-ISA), the International Preliminary Examination Report (IPER) or the Supplementary International Search Report (SISR) and to amend the description, claims and drawings within a period of one month from the respective communication.

The amendments to Rule 161 EPC have caused some confusion since they came into effect on 1 April 2010. The confusion has stemmed from (a) whether the communication under Rule 161(1) EPC warranted a mandatory response and (b) whether the date of the communication under Rule 161(1) EPC kick-started the calculation of the 24-month time limit under Rule 36(1) EPC for filing a divisional application (due to the fact that the communication under Rule 161(1) EPC is issued by the examining division). For the sake of brevity, we shall hereinafter refer to the communication under Rule 161(1) EPC as the “161 Communication”.

#### **Is a 161 Communication a communication within the meaning of amended Rule 36(1) EPC**

The abundance of confusion surrounding the 161 Communication and the 24-month time limit for filing a divisional application under Rule 36(1) EPC is that the Examining Division issues the 161 Communication. In order to address a multitude of enquiries, the EPO published a Notice (<http://www.epo.org/patents/law/legal-texts/journal/informationEPO/archive/20100629a.html?updates=law>) stating that the 161 Communication “is not a substantive communication within the meaning of amended Rule 36(1) EPC and therefore does not cause the time limit for the filing of voluntary or mandatory divisional applications to start”. The statement is based on the interpretation that the time limit begins when a communication from the examining division contains its own opinion as to whether the application or the invention to which it relates meet the requirements of the EPC – which the 161 Communication does not. However, this interpretation has not been tested – yet!

Therefore, a 161 Communication would appear not to kick-start the 24-month time limit for filing a divisional application.

### **When is a response to a 161 Communication mandatory?**

The 161 Communication may be issued on three different EPO forms: (1) EPO Form 1226A, (2) EPO Form 1226B, and (c) EPO Form 1226C. Each form indicates the position the applicant is in with regard to whether or not a response is mandatory. The circumstances dictating which form is issued have raised many permutations.

(1) **Form 1226A**: A 161 Communication is issued on EPO Form 1226A in the instance where the EPO is the ISA, no amendments were filed upon entry to European Regional Phase or under Article 19 and/or Article 34 PCT, and a negative WO-ISA or EPO IPER is received.

The applicant **is required** to respond to this communication within the one-month time limit or else the application is deemed to be withdrawn. (Please note that further processing under Article 121 and Rule 135 EPC or requesting a decision pursuant to Rule 112(2) EPC is available.) This applies to a 161 Communication and WO-ISA or EPO IPER issued **after** 1<sup>st</sup> April 2010.

According to the EPO, if a positive WO-ISA or IPER was issued before 1 April 2010 (before the new 161 Communication came into effect), and a Rule 161 Communication on Form 1226A is issued thereafter, ***no response*** is necessary. However, if the WO-ISA or IPER was negative, a response **is required** within the one-month time limit.

(2) **Form 1226B**: The applicant is ***not required*** to respond to a 161 Communication issued on EPO Form 1226B for a PCT-EP application, in the instance where the EPO is the ISA and (i) amendments were filed upon entry to European Regional phase, or (ii) a positive WO-ISA or EPO IPER was received.

(3) **Form 1226C**: A 161 Communication is issued on EPO Form 1226C in the instance where (i) the EPO is **not** the ISA or (ii) where the EPO draws up a supplementary European search report on a Euro-PCT application. The applicant is ***not required*** to respond to this communication.