No more limitations on PCT work

Applications in all fields of technology from all PCT member countries will be considered by the EPO as International Searching Authority (ISA).

Significant differences in the patenting approach in Europe and the US have in the past prompted the EPO to refuse PCT search requests originating from the US in certain technical fields. More recently the EPO has reversed this policy, accepting to act as the ISA e.g. for biotechnological inventions in US-originating PCT applications. The last of these so-called “limitations of competence”, by which the EPO declined to handle US-originating applications for business methods, is to be abolished from 1 January 2015.

Why did the EPO previously refuse to act as ISA for US business method patent applications?
In 2002, the EPO acting as ISA decided not to search international applications containing claims relating to business methods that were filed by US applicants with either the United States Patent and Trademark Office (USPTO) or the International Bureau (IB) as receiving Offices. Applications containing claims relating solely to pure business methods are not searched by the EPO in view of their exclusion from patentability and, as most such applications generally originated in the US, it was felt appropriate to apply this limitation only to US applicants.

Why the change now?
Twelve years later, the situation has considerably changed in view of recent developments in US case law (e.g. Bilski v. Kappos and Alice Corp. v. CLS Bank) which are considerably reducing the number of applications of US origin containing pure business methods. Furthermore, today’s applications relating to business methods often also include some technical features which could indeed be patentable and thus searchable. This evolution affects all patent applications irrespective of whether they are filed under the PCT or under the EPC, and irrespective of where in the world they originate.
Will the change affect the EPO’s granting practice?

There is no change whatsoever to the EPO’s rigorous approach to examination. In particular, the Notice from the EPO dated 1 October 2007 concerning business methods remains applicable (see OJ EPO 2007, 592). Business methods as such are not patentable under the European Patent Convention. The existing practice in Europe is well-established on the basis of case law (see G 3/08 and T 0154/04). Under the current practice, in the case of Euro-direct applications containing some claims relating to business methods, the EPO performs a search with respect to the other parts of the application which relate to technical content; the same is true for international applications filed by non-US applicants, as well as for US applicants applying to the EPO directly (not via the PCT).

So what is changing?

By lifting its “limitation of competence”, i.e. by removing a bar to searching PCT applications in a particular field, the EPO guarantees equal treatment for all applicants irrespective of their nationality or place of residence and irrespective of whether the EP or the PCT route is chosen. The EPO as ISA will, in all cases where the subject-matter of the application involves technical means, consider the application and provide a search report for those parts of it which are more than mere business methods.

US applicants filing their international applications with the USPTO or IB as receiving Offices as of 1 January 2015 will be able to select the EPO to act as their ISA without restrictions. As stated above, the lifting of the limitation is not to be understood as any change in our legislation or examination practice with regard to the exclusion from patentability of business methods as such (Article 52(2) EPC). Just like the established procedure under the EPC, the EPO acting as ISA would issue a no-search declaration whenever an application relates only to a business method as such.