

CA/PL 6/00

Orig.: English

Munich, 27.01.2000

SUBJECT: Revision of the EPC: Articles 94, 95, 96 and 97

DRAWN UP BY: President of the European Patent Office

ADDRESSEES: Committee on Patent Law (for opinion)

SUMMARY

This document contains a proposal to amend Articles 94 and 97 and delete Articles 95 and 96 EPC, so as to simplify the procedure and shift the more detailed arrangements to the Implementing Regulations wherever possible.

I. INTRODUCTION

A. AMENDMENT OF ARTICLE 94 AND DELETION OF ARTICLES 95 AND 96 EPC

1. Under the proposed new version of Article 94 EPC, the practical arrangements for filing the request for examination would be regulated in the Implementing Regulations rather than the Convention itself.
2. The filing of the written request currently prescribed in Article 94(1) EPC was originally intended to serve as an express indication of the applicant's wish to initiate the second step of the grant procedure. In practice, however, it has proved to be superfluous: since 1981, the request has been included as a precrossed box in the Request for Grant form, to ensure that applicants do not forget it after the search. In other words, it is routinely made upon filing the application, and the applicant initiates the examination phase simply by paying the examination fee. It is therefore proposed that the Implementing Regulations should state that the request for examination is deemed filed once the fee has been paid. The examination-fee requirement is enclosed in square brackets in view of the proposal that a general legal basis for charging fees be created in Article 126 EPC (see CA/PL 8/00).
3. Another reason for dispensing with the "written-request" requirement is that it may be a trap for PCT applicants on entry into the regional phase before the EPO. If such an applicant clearly indicates that he wants to proceed with the application, by paying all applicable fees (including the examination fee), but fails to file in due time a written request for examination or to use the EPO form for entry into the regional phase (which again contains a precrossed box for the formal request), he can save his application only by paying a heavy surcharge under Rule 85b EPC. If he does not react in time to the communication under Rule 85b EPC, his application is irrevocably lost, as re-establishment of rights is not available (Article 122(5) EPC, cf. J 8/94, OJ EPO 1997, 17). The EPO cannot interpret payment of the examination fee as an implicit written request for examination (J 12/82, OJ EPO 1983, 221).
4. The details for carrying out the examination procedure (including the legal consequences of any shortcomings on the applicant's part) would be moved from Article 96(2) and (3) EPC to the Implementing Regulations. If it is considered necessary for the article to contain a legal basis for this transfer, the paragraph 2 text proposed in square brackets could be included (cf. CA/PL 5/00, point 4). As the Implementing Regulations would also cover the situation currently described in Article 96(1) EPC, Article 96 can be deleted in its entirety.

5. All time limits applicable would be contained in the Implementing Regulations. It is not proposed at this stage to change the time limit for filing a request for examination. The situation could however change in the future, eg in the light of developments in the PCT system. The limitation on the Administrative Council's powers currently laid down in Article 95 in conjunction with Article 33(1)(a) EPC is therefore no longer appropriate. Accordingly, it is proposed that Article 95 too be deleted.
6. Under the proposal, the distinction (currently drawn in Articles 94 and 96 EPC) between initiation and conduct of the examination procedure would no longer exist. Article 94 EPC is therefore now headed "Examination of the European patent application".

B. AMENDMENT OF ARTICLE 97 EPC

7. Article 97(1) EPC would remain unchanged, merely becoming paragraph 2. New paragraph 1 would transfer to the Implementing Regulations the formal requirements to be fulfilled before the examining division can decide to grant the patent. These would be the same as those currently foreseen in Article 97(2) EPC, but the proposal offers greater flexibility in adjusting to future developments. If, for example, the Office were to decide to distribute granted patents only electronically in future, a printing fee would no longer be appropriate.
 8. The provisions governing the date on which grant takes effect (ie paragraphs 4, 2nd sentence, 5 and 6) are deleted from the Convention. With the other grant formalities being transferred to the Implementing Regulations, this matter too is more appropriately regulated at a lower legislative level.
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II. PROPOSED AMENDMENTS

Present wording

Article 94

Request for examination

(1) The European Patent Office shall examine, on written request, whether a European patent application and the invention to which it relates meet the requirements of this Convention.

(2) A request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request shall not be deemed to be filed until after the examination fee has been paid. The request may not be withdrawn.

(3) If no request for examination has been filed by the end of the period referred to in paragraph 2, the application shall be deemed to be withdrawn.

Proposed wording

Article 94

Examination of the European patent application

(1) **At the request of the applicant [which shall be subject to the payment of a fee]** the European Patent Office shall examine whether **the** application and the invention to which it relates meet the requirements of this Convention. If no request for examination has been **made in due time**, the application shall be deemed to be withdrawn.

[(2) The procedure to be followed in filing a request under paragraph 1 and in carrying out that examination, and the legal consequences of the applicant failing to observe an applicable time limit or to comply with any other requirement, shall be laid down in the Implementing Regulations].

Article 95

Deleted

Extension of the period within which requests for examination may be filed

- (1) The Administrative Council may extend the period within which requests for examination may be filed if it is established that European patent applications cannot be examined in due time.
- (2) If the Administrative Council extends the period, it may decide that third parties will be entitled to make requests for examination. In such cases, it shall determine the appropriate rules in the Implementing Regulations.
- (3) Any decision of the Administrative Council to extend the period shall apply only in respect of applications filed after the publication of such decision in the Official Journal of the European Patent Office.
- (4) If the Administrative Council extends the period, it must lay down measures with a view to restoring the original period as soon as possible.

Article 96

Deleted

Examination of the European patent application

(1) If the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate, within a period to be determined, whether he desires to proceed further with the European patent application.

(2) If the examination of a European patent application reveals that the application or the invention to which it relates does not meet the requirements of this Convention, the Examining Division shall invite the applicant, in accordance with the Implementing Regulations and as often as necessary, to file his observations within a period to be fixed by the Examining Division.

(3) If the applicant fails to reply in due time to any invitation under paragraph 1 or paragraph 2, the application shall be deemed to be withdrawn.

Article 97

Refusal or grant

(1) The Examining Division shall refuse a European patent application if it is of the opinion that such application or the invention to which it relates does not meet the requirements of this Convention, except where a different sanction is provided for by this Convention.

(2) If the Examining Division is of the opinion that the application and the invention to which it relates meet the requirements of this Convention, it shall decide to grant the European patent for the designated Contracting States provided that:

(a) it is established, in accordance with the provisions of the Implementing Regulations, that the applicant approves the text in which the Examining Division intends to grant the patent;

Article 97

Grant or refusal

(1) If the Examining Division is of the opinion that the **European patent** application and the invention to which it relates meet the requirements of this Convention, it shall decide to grant the European patent for the designated contracting states provided that **the requirements laid down in the Implementing Regulations have been fulfilled. [The procedure to be followed and the legal consequences of the applicant failing to observe an applicable time limit or to comply with any other requirement shall be laid down in the Implementing Regulations].**

(2) If the Examining Division [...] is of the opinion that **the European patent** application or the invention to which it relates does not meet the requirements of this Convention, **it shall refuse that application unless** a different sanction is provided for by this Convention.

(b) the fees for grant and printing are paid within the time limit prescribed in the Implementing Regulations;

(c) the renewal fees and any additional fees already due have been paid.

(3) If the fees for grant and printing are not paid in due time, the application shall be deemed to be withdrawn.

(4) The decision to grant a European patent shall not take effect until the date on which the European Patent Bulletin mentions the grant. This mention shall be published at least 3 months after the start of the time limit referred to in paragraph 2 (b).

(5) Provision may be made in the Implementing Regulations for the applicant to file a translation, in the two official languages of the European Patent Office other than the language of the proceedings, of the claims appearing in the text in which the Examining Division intends to grant the patent. In such case, the period laid down in paragraph 4 shall be at least five months. If the translation has not been filed in due time, the application shall be deemed to be withdrawn.

(6) At the request of the applicant, mention of grant of the European patent shall be published before expiry of the time limit under paragraph 4 or 5. Such request may only be made if the requirements pursuant to paragraphs 2 and 5 are met.

(3) **Deleted**

(3) The decision to grant a European patent shall not take effect until the date on which the European Patent Bulletin mentions the grant. [...]

(5) **Deleted**

(6) **Deleted**