Europäisches Patentamt
European Patent Office
Office européen des brevets

Guidelines for Examination in the European Patent Office

March 2022

ISBN 978-3-89605-284-1

Published by the European Patent Office (EPO)
Directorate 5.2.1 – Patent Law
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Germany
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ISBN 978-3-89605-284-1

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General Part

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1. Preliminary remarks

In accordance with Art. 10(2)(a) of the European Patent Convention (EPC), the President of the European Patent Office (EPO) had adopted, effective as at 1 June 1978, the Guidelines for Examination in the European Patent Office.

These Guidelines are updated at regular intervals to take account of developments in European patent law and practice. Usually, updates involve amendments to specific sentences or passages on individual pages, in order to bring the text into line with patent law and EPO practice as these continue to evolve. It follows that no update can ever claim to be complete. Any indication from readers drawing attention to errors as well as suggestions for improvement are highly appreciated and may be sent by email to: patentlaw@epo.org.

The **binding** version of the Guidelines for Examination in the European Patent Office is published by the EPO in searchable HTML format on the internet at epo.org.

Both the HTML and PDF versions of the Guidelines contain:

(a) a non-exhaustive alphabetical keyword index;

(b) an index of computer-implemented inventions (CII), with a collection of direct hyperlinks to the relevant chapters in the Guidelines;

(c) a full list of the sections that have been amended, together with the corresponding hyperlinks.

In the HTML publication, modifications can be viewed by ticking the "Show modifications" box in the upper right corner, which displays inserted text with a green background and deleted text in red strikethrough font. For sections in which no changes have been made, the tick box is greyed out.

2. Explanatory notes

2.1 Overview

The main body of these Guidelines comprises the following eight parts:

Part A:	Guidelines for Formalities Examination
Part B:	Guidelines for Search
Part C:	Guidelines for Procedural Aspects of Substantive Examination
Part D:	Guidelines for Opposition and Limitation/Revocation Procedures
Part E:	Guidelines on General Procedural Matters
Part F:	The European Patent Application
Part G:	Patentability
Part H:	Amendments and Corrections

Part A deals with the procedures for formalities examination mainly with regard to grant proceedings. Part B deals with search matters. Parts C and

D relate to procedures to be followed in examination and opposition proceedings, respectively.

Part E deals with general procedural matters relevant to several or all of the stages in procedures before the EPO, including Euro-PCT applications. Part F deals with the requirements which the application must fulfil other than patentability, in particular unity of invention (Art. 82), sufficiency of disclosure (Art. 83), clarity (Art. 84) and the right to priority (Art. 87 to Art. 89). Part G deals with the requirements of patentability provided for in Art. 52 to Art. 57, in particular exclusions from patentability (Art. 52(2) and Art. 53), novelty (Art. 54), inventive step (Art. 56) and industrial application (Art. 57). Part H deals with the requirements relating to amendments and corrections. It relates in particular to questions of admissibility (Rule 80 and Rule 137) and compliance with Art. 123(2) and (3), Rule 139 and Rule 140.

The following notices relating to this and other recent updates have been published in the Official Journal of the European Patent Office:

Re March 2022 update:	
Re March 2021 update:	OJ EPO 2021, A6
Re November 2019 update:	OJ EPO 2019, A80
Re November 2018 update:	OJ EPO 2018, A73
Re November 2017 update:	OJ EPO 2017, A75
Re November 2016 update:	OJ EPO 2016, A76
Re November 2015 update:	OJ EPO 2015, A74
Re November 2014 update:	OJ EPO 2014, A88
Re September 2013 update:	OJ EPO 2013, 447
Re June 2012 update:	OJ EPO 2012, 420
Re April 2010 update:	OJ EPO 2010, 230
Re April 2009 update:	OJ EPO 2009, 336
Re December 2007 update:	OJ EPO 2007, 589
Re June 2005 update:	OJ EPO 2005, 440
Re December 2003 update:	OJ EPO 2003, 582
Re October 2001 update:	OJ EPO 2001, 464
Re February 2001 update:	OJ EPO 2001, 115
Re June 2000 update:	OJ EPO 2000, 228

Each part of the Guidelines is divided into chapters, each subdivided into numbered sections that may be further divided into subsections. Cross-references to other sections include the relevant letter of that part, followed by the chapter number (a Roman numeral) and then the section or subsection number (thus, e.g. C-V, 4.6, would be used if it were desired to refer to subsection 4.6 of chapter V of Part C).

Marginal references to articles and rules without further identification indicate the Articles or Rules of the European Patent Convention as the legal basis for what is stated in the text. It is believed that such references avoid the need for extensive quotation from the EPC itself.

Any references to persons made in the Guidelines are to be understood as being gender-neutral.

2.2 Abbreviations

In the Guidelines, the following abbreviations are used:

EPC	European Patent Convention
EPO	European Patent Office
OJ EPO	Official Journal of the European Patent Office
Art.	Article
RFees	Rules relating to Fees
WIPO	World Intellectual Property Organization
PCT	Patent Cooperation Treaty
ISA	International Searching Authority
WO-ISA	Written Opinion of the International Searching Authority
IPEA	International Preliminary Examining Authority
IPRP	International Preliminary Report on Patentability
IPER	International Preliminary Examination Report
EESR	Extended European Search Report
ESOP	European Search Opinion (Rule 62)
ADA	Arrangements for deposit accounts
AAD	Arrangements for the automatic debiting procedure
BNS	back-file conversion numerical system
rec.	Recital
Prot. Art. 69	Protocol on the Interpretation of Art. 69 EPC
Prot. Centr.	Protocol on the Centralisation of the European patent system and on its introduction (Protocol on Centralisation)
EU	European Union
EVL	Electronic virtual library

References to the European Patent Convention (EPC) are references to the European Patent Convention as amended by the Act revising the EPC of 29 November 2000 and the decision of the Administrative Council of 28 June 2001 adopting the new text of the European Patent Convention (OJ EPO Special editions No. 4/2001, pages 56 *et seq*; No. 1/2003, pages 3 *et seq*; No. 1/2007, pages 1 to 88) and the Implementing Regulations as adopted by decision of the Administrative Council of 7 December 2006 (OJ EPO Special edition No. 1/2007, pages 89 *et seq*) and as subsequently amended by decisions of the Administrative Council of 6 March 2008 (OJ EPO 2008, 124), 21 October 2008 (OJ EPO 2008, 513), 25 March 2009 (OJ EPO 2009, 296 and OJ EPO 2009, 299), 27 October 2009 (OJ EPO 2009, 582), 28 October 2009 (OJ EPO 2009, 585), 26 October 2010 (OJ EPO 2010, 568, 634 and 637), 27 June 2012 (OJ EPO 2012, 442), 16 October 2013 (OJ EPO 2013, 501, and 503), 13 December 2013 (OJ EPO 2014, A3 and A4), 15 October 2014 (OJ EPO 2015, A17), 14 October 2015 (OJ EPO 2015, A82 and A83), 30 June 2016 (OJ EPO 2016, A100), 14 December 2016 (OJ EPO 2016, A102), 28 June 2017 (OJ EPO 2017, A55), 29 June 2017 (OJ EPO 2017, A56), 13 December 2017 (OJ EPO 2018, A2), 28 June 2018 (OJ EPO 2018, A57), 28 March 2019 (OJ EPO 2019, A31), 12 December 2019 (OJ EPO 2020, A5), 27 March 2020 (OJ EPO 2020, A36), 15 December 2020 (OJ EPO 2020, A132 and OJ EPO 2021, A3.

Where necessary, reference is made to the European Patent Convention of 5 October 1973 as amended by the act revising Article 63 EPC of 17 December 1991 and by the decisions of the Administrative Council of 21 December 1978, 13 December 1994, 20 October 1995, 5 December 1996, 10 December 1998 and 27 October 2005.

The reference to articles and rules – and their paragraphs – of EPC 2000 will be as follows: "Article 123, paragraph 2" will be: "Art. 123(2)", "Rule 29, paragraph 7" will be: "Rule 29(7)". Articles and rules of EPC 1973, of the PCT and articles of the Rules relating to Fees are referred to in a similar way, e.g. "Art. 54(4) EPC 1973", "Art. 33(1) PCT" and "Art. 10(1) RFees" respectively. Only where deemed appropriate, i.e. in order to avoid confusion, will references to articles and rules of the EPC be provided with the extension "EPC 2000".

Decisions and opinions of the Enlarged Board of Appeal will only be referred to with their capital letter and their number, e.g. "G 2/88". Decisions of the technical boards of appeal and the Legal Board of Appeal will be referred to in the same way, e.g. "T 152/82", "J 4/91" and "T 169/88". It is noted that all decisions and opinions of the Enlarged Board of Appeal and all decisions of the boards of appeal of the EPO are published on the internet (epo.org).

The arrangements for deposit accounts and their annexes, including the arrangements for the automatic debiting procedure plus explanatory notes, are published from time to time as Supplements to the Official Journal of the EPO, which are available on the EPO website (epo.org).

3. General remarks

These Guidelines provide guidance in respect of the practice in proceedings before the EPO in accordance with the European Patent Convention and its Implementing Regulations (see section 5).

The search and examination practice and procedure as regards PCT applications in the international phase are not the subject of these Guidelines, but are dealt with in the **PCT International Search and Preliminary Examination Guidelines**, which are available on the WIPO website (wipo.int). Whenever considered appropriate, options given in the latter Guidelines and the way they are dealt with by the European Patent Office when acting as Receiving Office, International Searching Authority, Supplementary International Searching Authority or International Preliminary Examining Authority are the subject of separate notices published in the Official Journal of the EPO and on the EPO website. Please also consult the Guidelines for Search and Examination at the EPO as PCT Authority, which are available on the EPO website. It is important to note that, in respect of international applications filed under the PCT that are subject to proceedings before the EPO, the provisions of the PCT and its Regulations apply, supplemented by the EPC. In case of conflict the provisions of the PCT prevail (Art. 150(2) EPC).

The present Guidelines are addressed primarily to examiners and formalities officers of the EPO, but are also intended to serve the parties to

the proceedings and patent practitioners as a basis for illustrating the law and practice in proceedings before the EPO. As a general rule, party to the proceedings denotes the applicant, the patent proprietor or the opponent and, if the party is represented, its representative (see A-VIII, 1).

The Guidelines cannot cover all possible occurrences and exceptions in every detail, but must be regarded as general instructions that may need to be adapted to the individual case.

The application of the Guidelines to individual European patent applications or patents is the responsibility of the formalities officers and examiners. As a general rule, parties may expect the EPO to act in accordance with the Guidelines until such time as they – or the relevant legal provisions – are amended. Notices concerning such amendments are published in the Official Journal of the EPO and on the EPO website.

It should be noted also that the Guidelines do not constitute legal provisions. For the ultimate authority on practice in the EPO, it is necessary to refer firstly to the European Patent Convention itself including the Implementing Regulations, the Protocol on the Interpretation of Article 69 EPC, the Protocol on Centralisation, the Protocol on Recognition, the Protocol on Privileges and Immunities and the Rules relating to Fees, and secondly to the interpretation put upon the EPC by the boards of appeal and the Enlarged Board of Appeal.

Where a decision or an opinion of the Enlarged Board of Appeal is referred to, this is to inform the reader that the practice described has been adopted to take account of the decision or opinion referred to. The same applies to decisions of the Legal Board of Appeal or technical boards of appeal.

In case of diverging decisions of the Legal Board of Appeal or technical boards of appeal, EPO examiners and formalities officers will, as a rule, follow the common practice as described in the Guidelines, which applies until further notice. Furthermore, the Guidelines reflect only those decisions of the boards of appeal incorporated into the EPO's general practice due to their general procedural significance; they do not take into account any deviating decisions taken in the individual case, given that the binding effect referred to in Art. 111(2) applies to that specific case only.

As regards search, the EPO also carries out searches for national patent applications from certain countries. The instructions in Part B apply in the main also to such searches.

These Guidelines do not deal with proceedings relating to unitary patent protection (Regulations (EU) No 1257/2012 and 1260/2012, OJ EPO 2013, 111 and 132).

4. Work at the EPO

The setting up of the EPO represented a major step forward in the history of patents. Its reputation depends on all employees, regardless of nationality, working harmoniously together and giving of their best. But it is

on the search, examination and opposition, more than anything else, that the EPO will be judged by the patent world.

Employees of the EPO work with colleagues who not only speak a different language but also come from a different patent background with different training. Some may also have had experience in their national patent office. It is therefore important to mention that all employees in the EPO are working under a common system as laid down in the EPC. The Guidelines will support them in applying the same standards.

One of the purposes of the Guidelines is also to make clear how the areas of responsibility are distributed among the different departments, e.g. the Receiving Section, the examining or opposition divisions, in order to harmonise the working processes and to avoid duplicate work.

It should not be forgotten that the reputation of the EPO depends not only on the quality of the work it provides but also on the timeliness with which it delivers its work products. The EPC imposes various time limits on the parties. The European patent system will be judged a success only when examiners and other employees also operate within reasonable time frames.

Finally, it should hardly need stating that all European applications and patents, regardless of their country of origin and the language in which they are written, receive equal treatment. An international patent system can be credible only if all trace of national bias is absent.

5. Summary of the processing of applications and patents at the EPO

The processing of a European application and of a European patent is carried out in a number of distinct steps which may be summarised as follows:

(i) the application is filed with the EPO or a competent national authority;

(ii) the Receiving Section examines the application to determine if a date of filing can be accorded to the application;

(iii) the Receiving Section carries out the formal examination of the application;

(iv) if the Receiving Section has established that the application complies with the formal requirements, the search division draws up an extended European search report (EESR), a copy of which is forwarded to the applicant;

(v) the application and the search report are published by the EPO either together or separately;

(vi) on receipt of a request for examination from the applicant, or, if the request for examination has been filed before the search report has

been transmitted to the applicant, on confirmation by the applicant that he desires to proceed further with the European patent application, the application is subjected to substantive examination and any necessary formal examination before a European patent is granted by the examining division;

(vii) provided the requirements of the EPC are met, a European patent is granted for the states designated;

(viii) the specification of the European patent is published by the EPO;

(ix) within nine months from publication, any person may give notice of opposition to the European patent granted; after examining the opposition, the opposition division decides whether to reject the opposition, maintain the patent in amended form or revoke the patent;

(x) the patent proprietor may request limitation or revocation of the granted European patent; the examining division will decide on this request;

(xi) if the European patent is amended, the EPO publishes a new specification of the European patent amended accordingly.

A European patent application may also be filed via the PCT route ("Euro-PCT application – entry into the European phase"). For further details, see E-IX, and subsections.

Any decision by the Receiving Section, an examining division, an opposition division or the Legal Division which adversely affects a party is appealable and, thus, subject to review before a board of appeal of the EPO. With the exception of important aspects relating to interlocutory revision, the appeals procedure is not dealt with in these Guidelines.

6. Contracting states to the EPC

The following states are contracting states* to the EPC (date of effect of the ratification in brackets):

Albania	(1 May 2010)
Austria	(1 May 1979)
Belgium	(7 October 1977)
Bulgaria	(1 July 2002)
Croatia	(1 January 2008)
Cyprus	(1 April 1998)
Czech Republic	(1 July 2002)
Denmark[1]	(1 January 1990)
Estonia	(1 July 2002)
Finland	(1 March 1996)

* An up-to-date list of the contracting states to the EPC is published each year in issue No. 4 of the Official Journal of the EPO.

1 The EPC does not apply to Greenland and the Faroe Islands.

France[2]	(7 October 1977)
Germany	(7 October 1977)
Greece	(1 October 1986)
Hungary	(1 January 2003)
Iceland	(1 November 2004)
Ireland	(1 August 1992)
Italy	(1 December 1978)
Latvia	(1 July 2005)
Liechtenstein	(1 April 1980)
Lithuania	(1 December 2004)
Luxembourg	(7 October 1977)
Malta	(1 March 2007)
Monaco	(1 December 1991)
Netherlands[3]	(7 October 1977)
Republic of North Macedonia	(1 January 2009)
Norway	(1 January 2008)
Poland	(1 March 2004)
Portugal	(1 January 1992)
Romania	(1 March 2003)
Serbia	(1 October 2010)
San Marino	(1 July 2009)
Slovak Republic	(1 July 2002)
Slovenia	(1 December 2002)
Spain	(1 October 1986)
Sweden	(1 May 1978)
Switzerland	(7 October 1977)
Turkey	(1 November 2000)
United Kingdom[4]	(7 October 1977)
(total: 38)	

7. Extension to and validation in states not party to the EPC

Currently it is possible to extend the European patent to two extension states and in four validation states not party to the EPC. For further details, see A-III, 12, and subsections.

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2 The EPC applies to the territory of the French Republic, including the overseas territories.

3 The EPC is also applicable to Sint Maarten, Curaçao, Bonaire, Sint Eustatius and Saba, but not to Aruba.

4 The EPC is also applicable to the Isle of Man. For further information on the registration of European patents (UK) in crown dependencies, UK overseas territories and Commonwealth countries, see OJ EPO 2018, A97.

Part A

Guidelines for Formalities Examination

Contents

Chapter I – Introduction

1. Overview

This Part A of the Guidelines deals with the following:

(i) the requirements and procedure relevant to the examination as to formalities of European patent applications (Chapters A-II to VI);

(ii) formalities matters of a more general nature which can arise during the application procedure or the post-grant stage (Chapters A-VII and VIII),

(iii) the presentation and execution of drawings and figurative representations accompanying a European patent application (Chapter A-IX);

(iv) fee questions (Chapter A-X);

(v) inspection of files, communication of information contained in files, consultation of the Register of European Patents and issuance of certified copies (Chapter A-XI).

2. Responsibility for formalities examination

Rule 10
Rule 11(3)

The matters covered by this Part A are directed to the formalities staff of the EPO whether they be in The Hague, Munich or Berlin. They are directed primarily to the Receiving Section which is specifically responsible under the EPC for ensuring that the formal requirements for European patent applications are adhered to. Once the application is transferred to the examining division, the latter accepts responsibility for the formalities of the application, although it should be understood that reference to the examining division is intended to cover the formalities officer to whom this work is entrusted (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6, the Decision of the President of the EPO dated 23 November 2015, OJ EPO 2015, A104, and the Decision of the President of the EPO dated 14 June 2020, OJ EPO 2020, A80).

3. Purpose of Part A

The formalities staff should note that this Part A of the Guidelines is intended to provide them with the knowledge and background which it is felt will assist them in carrying out their functions in a uniform and expeditious manner. It does not, however, provide authority for ignoring the provisions of the EPC and in that regard specific attention is directed to paragraph 3 of the General Part of the Guidelines.

4. Other Parts relating to formalities

It is not the intention that the formalities staff should concern themselves with only this Part A of the Guidelines. It is expected that they will have to refer frequently to the other Parts and in particular Part E.

Chapter II – Filing of applications and examination on filing

1. Where and how applications may be filed

European patent applications must be filed in writing. They may be filed by delivery by hand, by postal services (see A-II, 1.1) or by means of electronic communication (see A-II, 1.2). *Rule 1* *Rule 2(1)*

1.1 Filing of applications by delivery by hand or by postal services

European patent applications may be filed by delivery by hand or by postal services at the EPO's filing offices in Munich, The Hague or Berlin. The EPO's sub-office in Vienna is not a filing office, nor is the Brussels Bureau. Art. 75(1) Rule 35(1)

The opening hours of the filing offices of the EPO were published in the Notice from the EPO dated 14 February 2018, OJ EPO 2018, A18. Dates on which at least one of them is not open to receive documents are likewise announced at regular intervals in the Official Journal of the EPO (see also E-VIII, 1.4). The filing offices of the EPO may remain open during public holidays observed in the contracting states in which they are located. Since mail is not delivered on these days (see also E-VIII, 1.4), applications may be filed by delivery by hand or using other permitted means of filing (see A-II, 1.2; A-II, 1.3).

The EPO filing offices in Berlin and Munich (only the PschorrHöfe building, see the Decision of the President of the EPO dated 3 January 2017, OJ EPO 2017, A11) are equipped with automated mail-boxes, which may be used at any time. The automated mail-box facility is currently not available at the filing offices at Munich's Isar building and The Hague. Outside office hours documents may be handed in to the porter.

European patent applications (with the exception of divisional applications, see A-IV, 1.3.1, and applications according to Art. 61(1)(b), see A-IV, 2.5) may also be filed at the central industrial property office or other competent authority of a contracting state if the national law of that state so allows (see A-II, 1.6).

1.2 Filing of applications by means of electronic communication

1.2.1 Filing of applications by fax

Applications may also be filed by fax with the filing offices of the EPO or with the competent national authorities of those contracting states which so permit, namely – at present – Austria (AT), Bulgaria (BG), Czech Republic (CZ), Denmark (DK), Finland (FI), France (FR), Germany (DE), Greece (GR), Iceland (IS), Ireland (IE), Liechtenstein (LI), Luxembourg (LU), Monaco (MC), Norway (NO), Poland (PL), Portugal (PT), San Marino (SM), Slovakia (SK), Slovenia (SI), Spain (ES), Sweden (SE), Switzerland (CH) and United Kingdom (GB). For further details, see the latest version of the brochure "National Law relating to the EPC".

Where a document transmitted by fax is illegible or incomplete, the document is to be treated as not having been received to the extent that it

is illegible or that the attempted transmission failed and the sender must be notified as soon as possible (see the Decision of the President of the EPO dated 20 February 2019, OJ EPO 2019, A18).

If a European patent application is filed by fax, a written confirmation is required only where the documents are of inferior quality. In this case, the EPO will invite the applicant to supply such documents within a period of two months (Rule 2(1)). If the applicant fails to comply with this invitation in due time, the European patent application will be refused. To prevent duplication of files, applicants are asked to indicate on the paper version of the application documents the application number or fax date and the name of the authority with which the documents were filed and to make it clear that these documents represent "confirmation of an application filed by fax".

1.2.2 Filing of applications in electronic form

European patent applications and international (PCT) applications may also be filed with the EPO in electronic form (see the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42) using either

(i) EPO Online Filing (OLF), by packaging and submitting the documents using the software provided by the EPO (see the Decision of the President of the EPO dated 21 September 2020, OJ EPO 2020, A105), unless the use of other software is permitted. Filings using OLF may be made online or on electronic data carriers accepted by the EPO. At present, the data carriers permitted are CD-R discs conforming to the ISO 9660 standard and DVD-R or DVD+R discs (see the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42);

(ii) Online Filing 2.0; or

(iii) the EPO web-form filing service.

Other documents may also be filed electronically in proceedings under the EPC (see the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42).

European patent applications may also be filed in electronic form with the competent national authorities of those contracting states which so permit.

1.3 Filing of applications by other means

The filing of European patent applications by other means such as **email** is at present not allowed (see also the Notice dated 12 September 2000, OJ EPO 2000, 458).

1.4 Subsequent filing of documents

For the subsequent filing of documents, see A-VIII, 2.5.

1.5 Debit orders for deposit accounts held with the EPO

Point 5.1.2 ADA
Point 5.6.1 ADA

For European patent applications debit orders for the fees due must be filed in an accepted electronic format (see A-X, 4.2.3), irrespective of how the application itself is filed. If an application is filed with a competent national

authority (Art. 75(1)(b)) on paper, a paper debit order on mandatory Form 1020 for the fees intended to be paid is exceptionally accepted if it is included with that application on the date of filing (see the Arrangements for deposit accounts (ADA), Supplementary publication 4, OJ EPO 2019). Paper Form 1020 is not accepted if filed direct with the EPO. For the abolition of payments by cheque, see A-X, 2.

1.6 Forwarding of applications

Art. 77(1)
Rule 37(1)

The central industrial property office of a contracting state is obliged to forward to the EPO, in the shortest time compatible with national law concerning the secrecy of inventions, applications filed (see A-II, 3.2) with that office or with other competent authorities in that state (for debit order enclosures, see A-II, 1.5).

Art. 77(3)
Rule 37(2)
Art. 135(1)(a)

A time limit of six weeks after filing is specified for the onward transmission to the EPO of applications the subject matter of which is obviously not liable to secrecy, this time limit being extended to four months or, where priority has been claimed, to fourteen months after the date of priority, for applications which require further examination as to their liability to secrecy. It should be noted, however, that an application received outside the specified time limits, either six weeks or four months, must be processed provided the application is received in Munich, The Hague or Berlin before the end of the fourteenth month after filing or, where appropriate, after the date of priority. Applications received outside this last mentioned time limit are deemed to be withdrawn. Reestablishment of rights and further processing in respect of the period under Rule 37(2) are not possible, since the loss of rights does not result from a failure of the applicant to observe a time limit (see J 3/80), but a request for conversion under Art. 135(1)(a) may be filed (see A-IV, 6).

Rule 134(2)

If the time limit referred to in Rule 37(2) expires on a day on which there is an interruption or subsequent dislocation in the delivery or transmission of mail within the meaning of Rule 134(2), the time limit will extend to the first day following the end of the period of interruption or dislocation.

1.7 Application numbering systems

1.7.1 Applications filed before 1 January 2002

For applications filed **before** 1 January 2002, the following numbering system applies:

The application number consists of nine digits. The first two digits (from left to right) of the application number indicate the filing year. The last (ninth) digit is a check digit. The third digit or third and fourth digits of the application number indicate(s) the place of filing.

The remaining digits are used for consecutively numbering the applications in the order in which they come in at the place of filing.

International applications filed under the Patent Cooperation Treaty (PCT) and designating "EP" (Euro-PCT applications) receive the digit "7", "8" or "9" as the third digit.

1.7.2 Applications filed on or after 1 January 2002

For applications filed **on or after** 1 January 2002, the following numbering system applies:

The application number consists of nine digits. The first two digits (from left to right) of the application number indicate the filing year. The last digit is a check digit. The remaining six digits in between are used for consecutively numbering the applications in the order in which they arrive at the place of filing, starting from the lowest number within a specific range of six-digit numbers. The specific range reflects the place of filing. Where applicable, the range is subdivided into two ranges in order to distinguish between paper and online filings.

For international applications designating "EP" (Euro-PCT applications), the dedicated range for the above-mentioned six-digit number within the application number uses "7", "8" or "9" as the third digit and does not reflect the place and method of filing.

A list of the number ranges introduced in 2002, along with, where appropriate, the corresponding places of filing, is published in OJ EPO 2001, 465.

2. Persons entitled to file an application

Art. 58

A European patent application may be filed by any natural or legal person, or anybody equivalent to a legal person by virtue of the law governing it.

Art. 60(3)

For the purposes of proceedings before the EPO, the applicant shall be deemed to be entitled to exercise the right to the European patent.

Art. 59
Art. 118

The application may be in the name of one person or several persons may be named as joint applicants. The application may also be filed by two or more applicants designating different contracting states. It may arise that a first applicant designates one group of contracting states and a second designates a different group of contracting states, while both applicants jointly designate a third group of contracting states. If the applicants for a patent are not the same for different contracting states they will be regarded as joint applicants in proceedings before the EPO (see A-III, 4.2.1 and 11.1 as to when and under what circumstances the matter dealt with in this paragraph need be considered during the formalities examination).

Art. 61(1)

If it is adjudged that any person other than the applicant is entitled to the grant of a European patent that person has the option of prosecuting the application as their own application in place of the applicant (see A-IV, 2).

3. Procedure on filing

3.1 Receipt; confirmation

Rule 35(2)

The authority with which the application is filed – either the EPO (Munich, The Hague or Berlin) or the competent national authority – must mark the documents making up the application with the date of receipt and issue a receipt to the applicant. The receipt must be issued without delay and include at least the application number, the nature and number of the

documents and the date of their receipt. The receipt should also include the applicant's or representative's file reference number or any other information which would be helpful in identifying the applicant. The receipt of European patent applications filed online will be acknowledged electronically during the submission session. Where it becomes apparent that such acknowledgment was not successfully transmitted, the authority with which the application is filed will promptly transmit the acknowledgment by other means where the necessary indications furnished to it so permit (see Art. 13 of the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42). The EPO will in principle no longer issue an acknowledgement of receipt by fax (see the Decision of the President dated 20 February 2019, OJ EPO 2019, A18, and the Notice from the EPO dated 20 February 2019, OJ EPO 2019, A15). If still requested under exceptional circumstances, e.g. non-availability of the EPO's electronic filing tools, the service will be provided free of charge.

3.2 Filing with a competent national authority

If the application is filed with a competent national authority, that authority must without delay inform the EPO of receipt of the documents making up the application and indicate the nature and date of receipt of the documents, the application number and any priority date claimed. It is recommended that the competent national authority should indicate as well the applicant's or representative's reference number where such has been indicated. In practice, the above-mentioned information is provided to the EPO by the forwarding of the application itself, unless national security checks by the national office delay the forwarding of the application, in which case a separate notice is sent by that office to the EPO.

Rule 35(3)

When the EPO has received an application which has been forwarded by the central industrial property office of a contracting state, it notifies the applicant, indicating the date of receipt at the EPO. Once this communication has been received, all further documents relating to the application must be sent directly to the EPO.

Rule 35(4)

Where an application is not received at the EPO from the central industrial property office of a contracting state before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority and is consequently deemed to be withdrawn (see A-II, 1.6), the applicant must be notified accordingly; all fees must be refunded, including any fees paid in advance of their due date.

Art. 77(3)
Rule 37(2)
Rule 112(1)

4. Examination on filing

4.1 Minimum requirements for according a date of filing

The EPO examines applications to determine whether they meet the minimum requirements for according a date of filing (since this occurs before the examining division assumes responsibility, this check is carried out by the Receiving Section). These requirements are satisfied where the documents filed contain:

Art. 90(1)
Rule 10(1)

(a) an indication that a European patent is sought;

Rule 40(1)(a)

Rule 40(1)(b) (b) information identifying the applicant or allowing the applicant to be contacted; and

Rule 40(1)(c) (c) a description or reference to a single previous application.

It is not necessary that the applicant provide any claims in order to obtain a date of filing. If the application is filed without claims, but satisfies all requirements for obtaining a date of filing, the applicant will be requested to provide at least one claim later according to Rules 57(c) and 58 (see A-III, 15).

Where the description is filed by reference to a previously filed application (see A-II, 4.1.3.1), the reference must contain the following information in order for the application to qualify for a filing date according to Rule 40(2):

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

(iv) an indication that this reference replaces the description and any drawings.

Rule 1 To be accorded a date of filing, these documents do not have to meet any particular requirements as to form or presentation. It is essential, however, that the documents be sufficiently legible to enable the information to be discerned.

4.1.1 Indication that a European patent is sought

Use of the prescribed request for grant form or the software provided by the EPO for electronic filing (see A-II, 1.2.2) best provides "the indication that a patent is sought" as referred to in A-II, 4.1(i) (see also A-III, 4).

4.1.2 Information concerning the applicant

For the purposes of establishing a date of filing, information must be supplied which:

(i) identifies the applicant or

(ii) allows the applicant to be contacted.

If there are multiple applicants, for the purposes of establishing a filing date, the above information only has to be supplied concerning one of them. Any kind of information which allows the applicant to be contacted will be considered to fulfil requirement (ii), as for example:

(a) the name and address of the applicant's representative

(b) a fax number

(c) a PO box number

(d) a phone number.

If the information supplied is sufficient to establish a date of filing but is not sufficient for the EPO to establish whether or not the applicant requires a representative according to Art. 133(2), the procedure outlined in A-III, 16 will be followed.

In deciding whether or not the above information concerning the applicant satisfies the above requirements, the EPO will take into account all data contained in the documents filed (see J 25/86). Objection should not be raised at this stage with regard to the status of the applicant or the entitlement to apply, or where, in the case of joint applicants, there is doubt as to the contracting states designated by the individual applicants.

4.1.3 Description

The contents of the description do not require close scrutiny – it is sufficient to identify a document (or documents) which appear(s) to include a description. If instead of filing a description, the applicant has filed a reference to a previously filed application, see A-II, 4.1.3.1.

4.1.3.1 Reference to a previously filed application

Instead of filing application documents, the applicant can file a reference to a previously filed application according to Rule 40(1)(c). The previously filed application relied on for the reference does not need to be claimed as priority.

Details required on the date of filing

Rule 40(2)

According to Rule 40(2), in order to qualify for a date of filing, the applicant must indicate the following details on the filing date:

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

(iv) an indication that this reference replaces the description and any drawings.

The previous application referred to may also be an application for a utility model.

Copy of the previously filed application

Rule 40(3)
Rule 53(2)

The applicant must supply a copy of the previously filed application certified as correct by the authority with which that application was filed within two months of the filing date (Rule 40(3)). However, according to Rule 40(3), last sentence, this requirement is dispensed with where the previously filed application is already available to the EPO under the conditions specified by the President. According to the Notice from the EPO dated 14 September 2009, OJ EPO 2009, 486, a certified copy does not need to

be filed where the previously filed application is a Euro-direct application or an international one filed with the EPO as receiving Office under the PCT. In all other cases, a certified copy of the previously filed application to which reference is made must be filed within the time limit under Rule 40(3).

Where the previously filed application referred to is the claimed priority application, only one certified copy needs to be filed in order to satisfy both the requirements relating to the filing date (Rule 40(3)) and those relating to the priority claim (Rule 53(1), see A-III, 6.7).

For divisional applications filed by reference, see A-IV, 1.3.1.

Rule 40(3)

Translation of the previously filed application

If the previously filed application is not in an official language of the EPO, the applicant must also file a translation into one of those languages within two months of the filing date (Rule 40(3)). If the translation of the previously filed application is already available to the EPO, a copy of this will be included in the file free of charge and the applicant will not need to file it (Rule 40(3)).

Note that where the previously filed application is in a language according to Art. 14(4) (an official language of a contracting state to the EPC), the application may qualify for a reduction of the filing fee, provided that the applicant is entitled according to Rule 6(3) in conjunction with Rule 6(4) to (7) (see A-X, 9.2.1 and 9.2.2). The reduction applies even in cases where the description is filed by reference to a previously filed application according to Rule 40(1)(c), where the previously filed application is in a language specified in Art. 14(4) but the claims are filed after the date of the filing in accordance with Rule 57(c) and Rule 58 and in an official language of the EPO. This is because the essential element for establishing a filing date (the provision of a description, see Rule 40(1)(c)) has been provided in a language giving rise to the entitlement to the reduction (see G 6/91, *mutatis mutandis*).

The claims

Applicants also have the option of indicating that they wish the claims of the previously filed application to take the place of claims in the application as filed. Such an indication must be made on the date of filing, preferably by crossing the appropriate box in the request for grant (EPO Form 1001). If this indication is made, then the claims of the previously filed application will form the basis for the search, and will satisfy the requirement of Rule 57(c), so that an invitation under Rule 58 to file claims later will not be issued.

If the applicants do not refer to the claims of the previously filed application, but only to the description and any drawings thereof, they may at the same time as filing the reference (i.e. on the date of filing), file a set of claims. If they do not do so, they will be invited by the EPO to file claims (see A-III, 15).

4.1.4 Deficiencies

If the EPO (Receiving Section) notes either of the following deficiencies:

Art. 90(1) and (2)
Rule 55
Rule 112(1)

– Rule 40(1)(a) – no indication that a European patent is sought, or

– Rule 40(1)(c) – no description or reference to a previously filed application,

either of which prevents the application being accorded a date of filing, it communicates this to the applicants and invites them to remedy the deficiency within a non-extendable period of two months from notification of a communication under Rule 55. If the requirements of Rule 40(1)(a) or Rule 40(1)(c), as applicable, are not met at the end of this period, the application will not be dealt with as a European patent application. The EPO will notify the applicant accordingly under Rule 112(1). In reply, the applicant may file a request for a decision under Rule 112(2) (see E-VIII, 1.9.3) or request re-establishment of rights under Art. 122 and Rule 136 (see E-VIII, 3).

If none of the available means of redress is filed on time, any fees paid are refunded. If the applicant wishes to pursue a European patent application, all documents relating to the purported European patent application will have to be re-filed. Any such newly filed European patent application will be accorded as the date of filing the date on which all the requirements of Rule 40 are fulfilled.

Deficiency under Rule 40(1)(b)

In the event that the information concerning the applicants is missing or does not enable the EPO to contact them (Rule 40(1)(b)), a communication concerning the deficiency cannot be sent. The European patent application will not come into existence unless the applicants correct this deficiency of their own motion within two months of the date of receipt of the original documents. In this case, the date of filing is the date on which all the requirements of Rule 40 are met.

Filing by reference to a previous application

Where the application is filed by reference to a previously filed application and the EPO (Receiving Section) notes that any of the following information is missing:

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

(iv) an indication that this reference replaces the description and any drawings

then it proceeds as above and invites the applicant to remedy the deficiency within a two-month time limit (Rule 55). If the applicant does not remedy the deficiencies in due time, the application is not treated as a European application.

If the applicant does not provide the certified copy of the previously filed application within two months of filing the application (Rule 40(3)) and this is not already available to the EPO (see A-II, 4.1.3.1), then a communication according to Rule 55 will be sent to the applicant, requesting that the certified copy be filed within a non-extendable period of two months. If the applicant does not provide the certified copy in due time, the application is not treated as a European application. Where a translation of the application is required and this is not provided within the above time limit, the procedure given in A-III, 14 is followed. The filing date is unaffected by a missing translation.

4.1.5 Date of filing

The date of filing accorded to the application is the date the application meets the requirements of Rule 40 and is either:

(i) the date of receipt at the EPO or competent national authority; or

(ii) the date, not later than the two-month period referred to in Rule 55, on which the applicant rectifies any deficiencies. In the latter case, the applicant is informed of the date of filing accorded to the application.

Case (ii) is subject to one exception. Where the application is filed by reference to a previously filed application and the applicant fails to file the certified copy of the previously filed application within two months of the filing date as required by Rule 40(3), an invitation is sent to the applicant to file it within a period of two months from a communication according to Rule 55. If the applicant files the certified copy within this two-month period, the application maintains its original date of filing, provided that all other requirements for acquiring a date of filing have been met.

The date of filing may also change in cases where the applicant inserts parts of the description or drawings after the date of filing (see A-II, 5).

5. Late filing of missing drawings or missing parts of the description

5.1 Late filing of missing drawings or missing parts of the description – on invitation

Art. 90(1)
Rule 56(1)
Rule 56(4)(a)

The application is examined on filing to check that it is entitled to a date of filing. If during this check the EPO notes that parts of the description, or drawings appear to be missing, it shall invite the applicant to file the missing parts within a time limit of two months from the invitation. If the applicant does not reply to this invitation in time, then all references to the missing parts are deemed to be deleted. It is to be noted that the applicant may not invoke the omission of the invitation under Rule 56(1).

5.2 Late filing of missing drawings or missing parts of the description – without invitation

Applicants may also file missing parts of the description, or missing drawings, of their own motion (without being invited to do so by the EPO) within two months of the date of filing. If the applicant does not file the missing parts within this period, all references to the missing parts are deemed to be deleted. However, if the applicant is invited by the EPO to file the missing parts, the period under Rule 56(1) takes precedence (see A-II, 5.1). *Rule 56(2)* *Rule 56(4)(a)*

If, within two months of the original date of filing, the applicants notice that they have neglected to include drawings and/or parts of the description in the application as originally filed, it is advisable to file these as soon as possible of their own motion according to Rule 56(2), since if the EPO does not invite them to file the missing parts, then any possibility for them to file them later ends two months after the original date of filing.

5.3 The filing date changes

If the applicant files missing parts of the description, or drawings, in accordance with the procedures explained in A-II, 5.1 or 5.2, then the date of filing changes to the date on which the missing parts are received at the EPO. The applicant is informed of the new date of filing. This is subject to the exception explained in A-II, 5.4. *Rule 56(2)*

A "drawing" means a single numbered figure. Only whole figures will be accepted according to Rule 56, even where only a part of the original figure was missing.

5.4 Missing parts based on the priority application, no change in filing date

If the applicant files missing parts of the description, or drawings, after the date of filing in accordance with the procedures explained in A-II, 5.1 or 5.2, the date of filing does not change, provided that the following criteria are satisfied: *Rule 56(3)*

(i) the missing parts are filed within the applicable time limit*

(ii) the application claims priority (see A-II, 5.4.1)

(iii) the applicant requests that the late-filed parts be based on the claimed priority in order to avoid a change in the date of filing, and does so within the applicable time limit* (see A-II, 5.4.1)

(iv) the late-filed parts of the description, or drawings, are completely contained in the priority application (see A-II, 5.4.2)

(v) the applicant files a copy of the priority application within the applicable time limit*, unless such copy is already available to the EPO under Rule 53(2) (see A-II, 5.4.3) *Rule 56(3)(a)*

(vi) where the priority application is not in an official language of the EPO, the applicant files a translation into one of these languages *Rule 56(3)(b)*

within the applicable time limit*, unless such a translation is already available to the EPO under Rule 53(3) (see A-II, 5.4.4)

Rule 56(3)(c)

(vii) the applicant indicates where in the priority application and, if applicable, where in its translation, the late-filed missing parts of the description, or drawings, are completely contained, and does so within the applicable time limit* (see A-II, 5.4.2).

*For the applicable time limit see whichever of A-II, 5.1 or 5.2 applies.

Where criterion (i) is not satisfied, the late filing of those parts is deemed not to have been made and all references thereto in the application are deemed to be deleted under Rule 56(4)(a) (see A-II, 5.1 and 5.2). In this case the filing date does not change, but the late-filed parts are not introduced into the application either.

Rule 56(2)

If the request according to Rule 56(3) does not comply with one or more of the above requirements (ii)-(iv), then according to Rule 56(2) the date of filing will change to the date on which the EPO received the late-filed missing parts of the application. The EPO will send a communication informing the applicant of this according to Rule 56(2).

Rule 56(5)

If the request according to Rule 56(3) does not comply with one or more of the above requirements (v)-(vii), then according to Rule 56(5) the date of filing will change to the date on which the EPO received the late-filed missing parts of the application. The EPO will send a communication informing the applicant of this according to Rule 56(5).

5.4.1 Late-filed missing parts when priority is claimed

In the context of a request under Rule 56(3) the EPO will check that the requirements for the priority claim are met (see A-III, 6).

Where the applicant files a request under Rule 56(3) (see A-II, 5.4), the priority claim in question must have been in existence no later than the filing of this request. To this end, the applicant can file a simultaneous request, contained in one single submission:

(i) to insert a new priority claim not present when the application was filed according to Rule 52(2), and

(ii) to base late-filed missing parts of the description, or drawings, on that priority claim according to Rule 56(3)

This is subject to the proviso that the above simultaneous request respects both the time limit according to Rule 52(2) for insertion of a new priority claim (see A-III, 6.5.1) and the applicable time limit for making the request according to Rule 56(3) (see whichever of A-II, 5.1 or 5.2 applies). If this is the case, then the requirement under Rule 56(3) that priority be claimed is met (see A-II, 5.4(ii)).

Alternatively, the applicant may file submission (i) earlier (again, provided that it is filed within the time limit according to Rule 52(2)) and then

subsequently file submission (ii) (again, provided that it complies with the applicable time limit). However, it is not possible to file request (ii) before request (i), because in this case request (ii) would be filed at a time when there is no priority claim, and it would not meet the requirements of Rule 56(3).

5.4.2 The missing parts are completely contained in the priority application

In cases where no translation of the priority application is required and both the European patent application and the priority application are in the same official language, the requirement that the late-filed parts of the application are "completely contained" in the priority application is met only if the parts of the priority application identified by the applicant according to Rule 56(3)(c) contain the same drawings, with the same annotations or, for late-filed parts of the description, contain the same text.

If a translation of the priority application is required, then the requirement that the late-filed parts of the application are "completely contained" in the priority application is met only if the parts of the translation identified by the applicant according to Rule 56(3)(c) contain the same drawings, with the same annotations or, for late-filed parts of the description, contain the same text.

In addition to the requirement that the missing drawings or the missing parts of the description be identical to the corresponding drawings or parts of the priority application, they must also be inserted in the description in a manner which does not result in the presence of additional technical content. Drawings of low visual quality are not considered missing in the sense of Rule 56 and can, therefore, not be remedied under this provision (see J 12/14).

Final assessment of the "completely contained" requirement falls within the responsibility of the examining division (see C-III, 1).

5.4.3 Copy of the priority application

The copy of the priority application which is required for the request according to Rule 56(3) does not need to be certified. However, if the applicants do provide a certified copy in the context of their request according to Rule 56(3), they will not need to provide it again in the context of their priority claim according to Rule 53(1).

Where a copy of the priority document is already available to the EPO under Rule 53(2) in accordance with the conditions laid down by the President, the applicant does not need to file it. See also A-III, 6.7.

5.4.4 Translation of the priority application

Where a translation of the priority application is already available to the EPO under Rule 53(2), the applicant does not need to file it.

In cases where the priority application is in an official language of the EPO and the European application is in a different official language of the EPO, there is no requirement for the applicant to file a translation of the priority

application according to Rule 56(3)(b). However, since the language of the priority and of the European applications differ, the requirement that the newly introduced drawings (if they contain annotations) or parts of the description are "completely contained" in the priority application (Rule 56(3)) is not met.

This can be overcome by the applicant's supplying within the applicable time limit (see whichever of A-II, 5.1 or 5.2 applies), either:

(i) a translation from the official language of the priority application into the official language of the European application of those parts of the priority application identified by the applicant as completely containing the missing parts of the description, or drawings (Rule 56(3)(c)), or

(ii) a declaration indicating that the late-filed missing parts of the description, or drawings, are an exact translation of the parts of the priority application identified by the applicant according to Rule 56(3)(c).

The entire priority application does not need to be translated, since this translation is required to satisfy the "completely contained" requirement of Rule 56(3), not the translation requirement of Rule 56(3)(b).

5.5 Withdrawal of late-filed missing drawings or missing parts of the description

Rule 56(2) and (4)

Where applicants file missing parts of the description, or drawings, and make no request to base these late-filed parts on a claimed priority, they are informed of the new date of filing in a communication from the EPO (see A-II, 5.3). Within one month of this communication, the applicants may withdraw the late-filed parts of the application and if they do so, the re-dating of the application is deemed not to have been made and all references to the missing parts of the description, or drawings, are deemed to be deleted. The EPO will inform the applicants of this.

Rule 56(2), (4) and (5)

Where applicants file missing parts of the description, or drawings, and request that these late-filed parts be based on a claimed priority, but the requirements of Rule 56(3) are not met within the applicable time limit, the date of filing changes to the date on which the late-filed parts of the application are received at the EPO (Rule 56(2) or (5)). The applicants are informed of the new date of filing in a communication from the EPO. Within one month of this communication, they may withdraw the late-filed parts of the application (Rule 56(6)); if they do so, the re-dating of the application is deemed not to have been made and all references to the missing parts of the description, or drawings, are deemed to be deleted (Rule 56(4)). The EPO will inform the applicants of this.

Where references to a missing figure, e.g. "see Fig. 4", are deemed to be deleted, then reference signs cited in the context of that reference are also deemed to be deleted, although any technical information in the reference which is still technically meaningful without the reference may be retained: e.g. "see Fig. 4, a distillation column (1), provided with a condenser (2)"

becomes "a distillation column provided with a condenser". The publication of the application (see A-VI, 1.3) in such a case will contain the application documents as originally filed, without the references being physically deleted.

If the late-filed missing parts of the application do not satisfy the physical requirements of Rule 49, the EPO will not request the applicant to correct this deficiency according to Rule 58, until the one-month period for withdrawing them has expired without the applicant having withdrawn them (see A-III, 3.2.2).

Chapter III – Examination of formal requirements

1. General

1.1 Formal requirements

The formal requirements that an application has to meet are the subject of an examination by the Receiving Section. These requirements relate to the following: *Art. 90(3)* *Rule 57*

(i) representation;

(ii) signature

(iii) physical requirements of the application;

(iv) abstract;

(v) request for grant;

(vi) claim to priority;

(vii) designation of inventor;

(viii) translations, where required;

(ix) the presence of at least one claim;

(x) filing and search fees

1.2 Further checks

In addition to the above, it is necessary for the Receiving Section to:

(i) carry out a preliminary check of the description and claims in order to ensure that the title of the invention, which will appear in the published application, is in general accord with the requirements of Rule 41(2)(b) *Rule 41(2)(b)*

(ii) check whether any claims fees due have been paid (see also A-III, 9) *Rule 45(1) and (2)*

(iii) check whether the certificate of exhibition under Rule 25 has been filed where the invention has been displayed under Art. 55(1)(b) (see also A-IV, 3) *Art. 55(1)(b)* *Rule 25*

(iv) check whether in the case of European patent applications relating to biological material the information pursuant to Rule 31(1)(c) and (d) is complete (see also A-IV, 4) *Rule 31*

(v) check whether in the case of an application with nucleotide and/or amino acid sequences a prescribed sequence listing has also been filed (see also A-IV, 5 and the Decision of the President of the EPO *Rule 30*

dated 28 April 2011, OJ EPO 2011, 372, and the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542).

The requirements of the above paragraphs and the procedure to be followed when the requirements are not met are considered in subsequent sections of this Chapter.

2. Representation

2.1 Requirements

The formalities officer must ensure that the requirements with regard to representation as set out in A-VIII, 1 are met. The main points to be considered are:

Art. 133(2) (i) the necessity for applicants who have neither a residence nor principal place of business in a contracting state to be represented by an authorised professional representative or by an authorised legal practitioner fulfilling the requirements of Art. 134(8);

Art. 133(3) (ii) that, where an applicant having residence or principal place of business in a contracting state is represented by an employee, the employee is authorised; and

Rule 152 (iii) that the authorisation, if any is required (see A-VIII, 1.5 and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1), is in order, duly signed (see A-VIII, 3.2 and A-VIII, 3.4) and is filed in due time.

2.2 Non-compliance

The effect of non-compliance with the provisions with regard to representation and the action to be taken by the formalities officer in dealing with any deficiency are considered in A-III, 16.

3. Physical requirements

3.1 General remarks

Art. 90(3) Every application that is subject to formal examination is examined for compliance with the requirements as to form set out below. Non-compliance with the requirements is considered in A-III, 16.

3.2 Documents making up the application, replacement documents, translations

It is the responsibility of the Receiving Section to ensure that the documents making up the application, i.e. request, description, claims, drawings and abstract, meet the requirements of Rule 49(2) to (9) and (12) and, with regard to drawings, the requirements of Rule 46, to the extent necessary for the purpose of a reasonably uniform publication of the application under Rule 68(1). This equally applies to any supplementary document filed as an appendix to the description. When evaluating the quality of the application documents and their suitability for electronic and direct reproduction, the Receiving Section's objective must be to ascertain the discernibility of all details originally disclosed in the documents received

on the date of filing. Furthermore, the Receiving Section should not draw the attention of the applicant to any deficiencies related to the content of the application, namely those under Rule 46(2)(i) or (j) or 49(9), fourth sentence (see also A-III, 16.1).

With regard to those requirements in relation to which some technical knowledge may be needed, such as those of Rule 46(2)(f) and (h), the Receiving Section should, in case of doubt, consult and take the advice of the search division. The Receiving Section should also consider taking action when the search division draws its attention to a deficiency which it had overlooked. It should be noted that, in accordance with Rule 46(3), flow sheets and diagrams are to be considered as drawings.

If the formal requirements of Rule 46 and Rule 49 are not met, the applicant is invited to remedy this deficiency within a non-extendable two-month period (Rule 58 and Rule 50(1)). If this deficiency is not remedied in due time, the application is refused (Art. 90(5)).

Rule 10
Art. 94(1)
Rule 46

Once the examining division assumes responsibility for the application, it also becomes responsible for formal matters. It should pay particular attention to the more technical requirements of Rule 46 and Rule 49, including in particular the above-mentioned requirements under Rule 46(2)(i) and (j) and Rule 49(9), fourth sentence, and those laid down in Rule 49(10) and (11).

Rule 1
Rule 49(2)
Rule 50(1) and (2)
Rule 86

Replacement documents, including the amendment of granted patents (Rule 86), and translations in an official language of documents filed under the provisions of Art. 14(2) or (4) are subject to the same requirements as the documents making up the application. As a consequence, they must be typed or printed. Submissions containing handwritten amendments to application or patent specification documents are formally deficient and need to be corrected (see OJ EPO 2013, 603; however, see also E-III, 8.7 and OJ EPO 2016, A22, as well as H-III, 2.2).

In examination proceedings the invitation to correct formal deficiencies is sent by the formalities officer on behalf of the examining division (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6).

In the event of deficiencies under Rule 30, the Receiving Section must invite the applicant to remedy them within a non-extendable two-month period. If this deficiency is not remedied in due time, the application is refused by the Receiving Section under Rule 30(3) (see the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372, and the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542; see also A-IV, 5).

The particular requirements for drawings are dealt with in A-IX.

3.2.1 Physical requirements of applications filed by reference to a previously filed application

If the application is filed by reference to a previously filed application according to Rule 40(1)(c) (see A-II, 4.1.3.1), where no translation is required, the certified copy of the previously filed application required under Rule 40(3) must satisfy the physical requirements. If the previously filed application is not in an official language of the EPO, only the translation required under Rule 40(3) must satisfy the physical requirements, provided that the authenticity of the contents of the original is not impugned and that the original is of sufficient quality to allow good reproduction (Rule 49(12)).

3.2.2 Physical requirements of late-filed application documents

Where claims are filed after the date of filing (see A-III, 15) or where missing parts of the description, or drawings are inserted after the date of filing (see A-II, 5), all of these late-filed application documents must also satisfy the physical requirements. Consequently, the EPO will carry out two separate checks, first on the physical requirements of the original application documents, and second on any late-filed claims or missing parts of the description, or drawings. Any deficiencies will only be communicated when the complete application documents are on file.

In the event that late-filed missing parts of the description, or drawings result in a change of the date of filing, the applicant can withdraw the late-filed parts of the description, or drawings up to one month after being notified of the change in filing date (Rule 56(6)). Consequently, if the late-filed missing parts of the description, or drawings:

(i) contain deficiencies with regard to the physical requirements, and

(ii) result in a change of the date of filing

then the EPO will wait until the one-month period for their withdrawal has expired and will then send a communication according to Rule 58 in respect of these deficiencies, if the applicant has not withdrawn them in due time.

3.3 Other documents

Rule 50(2)

All documents other than those making up the application shall be typewritten or printed with a margin of about 2.5 cm on the left-hand side of each page.

4. Request for grant

4.1 General remarks

Rule 41(1)

The request for grant must be made on the appropriate EPO form (EPO Form 1001), even though the request (the indication that a patent is sought, referred to in A-II, 4.1(i)) need initially be in no particular form. The form is available via the EPO website on the internet (epo.org) and, with the exception of the web-form filing service, is also included in the software provided by the EPO for electronic filing (see A-II, 1.2.2).

Whenever a new version of the request for grant form is issued, attention is drawn to this fact in the Official Journal of the EPO. It is recommended always to use the latest version.

4.2 Examination of the request for grant form

The Receiving Section examines the request to ensure that it contains the information listed in Rule 41(2). The request form provides for the entry of that information. The petition for the grant (Rule 41(2)(a)) is an integral part of the form. The applicant must be allowed to correct deficiencies in the request to the extent indicated in A-III, 16.

4.2.1 Information on the applicant

The request must contain, in the manner specified in Rule 41(2)(c), the name, address and nationality of the applicant and the state in which that party's residence or principal place of business is located. Where the application is filed by more than one applicant, the requirement must be satisfied for each applicant. At this stage in the proceedings, the formalities officer will consider the entitlement of the person named as applicant to apply for a patent (A-II, 2).

Applicants (whether natural or legal persons) whose residence or principal place of business is in an EPC contracting state and who act without a professional representative can use an address for correspondence other than their residence. The address for correspondence must be the applicant's own address and be in an EPC contracting state. For that address to be used in proceedings before the EPO applicants must explicitly inform the EPO that it is to be used as the address for correspondence, preferably by entering it in the Box marked "Address for correspondence" of EPO Form 1001 (see the Notice from the EPO dated 4 September 2014, OJ EPO 2014, A99). Post cannot be sent to a different (natural or legal) person, since that requires a valid form of representation under Art. 133 and 134.

4.2.2 Signature

The request must be signed by the applicant or the appointed representative. If there is more than one applicant, each applicant or their appointed representative must sign the request. For further details as to the signature of the request, see A-VIII, 3.2 to 3.4.

Rule 41(2)(h)

4.2.3 Further requirements laid down by Rule 41(2)

The provisions of Rule 41(2)(b), (e), (f) and (g), dealing respectively with the title of the invention, divisional applications, Art. 61 applications and claim to priority are considered under these headings in subsequent sections of this Chapter and in A-IV.

5. Designation of inventor

5.1 General remarks

Every application must designate the inventor. The designation is incorporated in the software provided by the EPO for electronic filing (see A-II, 1.3). When filing on paper, the designation is filed in a separate document where the applicant is not the inventor or the sole inventor;

Art. 81
Rule 19
Rule 41(2)(j)

otherwise the designation must be effected in the request for grant form (EPO Form 1001) by placing a cross in the appropriate box in Section 22. Where the designation is effected in a separate document, a trilingual form available from the EPO website should preferably be used (EPO Form 1002).

5.2 Waiver of right to be mentioned as inventor

Rule 20(1)
Rule 143(1)(g)
Rule 144(c)
Art. 129(a)

Inventors designated by the applicant may address to the EPO a written waiver of their right to be mentioned as inventor in the published European patent application and the European patent specification, in which case their name is not mentioned in the published European patent application, the European patent specification, the Register of European Patents (Rule 143(1)(g)) and, consequently, the European Patent Bulletin, always provided that the waiver is received in time. Moreover, in accordance with Rule 144(c), the designation of the inventor as well as the waiver is then excluded from file inspection pursuant to Art. 128(4).

5.3 Designation filed in a separate document

Rule 19(1)

Where the designation is filed in a separate document it must contain the family name, given names and country and place of residence of the inventor. The place of residence is the city or municipality, i.e. not the province or region, where the inventor permanently resides and should preferably include the postal code (see the Notice from the EPO dated 22 February 2021, OJ EPO 2021, A12). The country and place of residence may also be that of the applicant (e.g. a company). Furthermore, the designation must contain the statement, referred to in Art. 81, indicating the origin of the right to the patent and the signature of the applicant or the appointed representative.

In the case of assignment, the words "by agreement dated ..." suffice, in the case of inventions by employees a mention that the inventor(s) is/are employee(s) of the applicant(s) and in the case of succession a mention that the applicant(s) is/are heir(s) of the inventor(s).

The designation of inventor must be signed by the applicant or the appointed representative. With regard to the signature, the provisions set out in A-VIII, 3.2 to A-VIII, 3.4, apply.

Rule 19(2)

The EPO does not verify the accuracy of the information given in the designation of the inventor.

If the designation of inventor is filed subsequently, the requirements set out in A-VIII, 3.1 apply.

5.4 Deficiencies

Art. 90(3) to (5)
Art. 93(1)
Rule 60(1)
Art. 121

Where a designation is not filed, or where the designation filed is deficient (e.g. inventor's name or country or place of residence or the signature of the applicant is missing) so that it cannot be considered as validly filed, the applicant is informed that the European patent application will be refused if the deficiency is not remedied within the period prescribed under Rule 60(1), which is within 16 months of the date of filing or, if priority is claimed, of the date of priority. This time limit is deemed to have been met if

the information is communicated before completion of the technical preparations for publication (see A-VI, 1.2). Where the applicant has requested early publication and, accordingly, technical preparations for publication are completed before expiry of the 16-month time limit, the applicant can still file the designation within the said time limit (see J 1/10). If the deficiencies are not rectified in due time, the application is refused and the applicant is notified accordingly (as regards divisional applications, see A-IV, 1.5). Further processing is possible according to Art. 121 and Rule 135 (see E-VIII, 2).

5.5 Incorrect designation

An incorrect designation may be rectified provided a request is received accompanied by the consent of the wrongly designated person and by the consent of the applicant for or the proprietor of the patent where the request is not filed by that party. If a further inventor is to be designated, the consent of the inventor(s) previously designated is not necessary (see J 8/82). The provisions of A-III, 5.3 apply to the corrected designation *mutatis mutandis*. Rectification may also be requested after the proceedings before the EPO are terminated.

Rule 21(1)

Where an incorrect designation has been rectified and where the incorrect designation was entered in the European Patent Register or published in the European Patent Bulletin, its rectification or cancellation shall also be published therein. Rectification of the designation of an inventor falls within the responsibility of the Legal Division (see the Decisions of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600 and 601).

Rule 21(2)

6. Claim to priority (see also F-VI)

6.1 General remarks

The applicant for a European patent is entitled to and may claim the priority of an earlier first application where:

(i) the previous application was filed in or for a state or WTO member recognised as giving rise to a priority right in accordance with the provisions of the EPC (see also A-III, 6.2);

Art. 87(1), (2) and (5)

(ii) the applicant for the European patent was the applicant, or is the successor in title to the applicant, who made the previous application;

(iii) the European application is made during a period of twelve months from the date of filing of the previous application (see, however, A-III, 6.6); and

(iv) the European application is in respect of the same invention as the invention disclosed in the previous application (see also A-III, 6.4 and F-VI, 1), which must be the "first application" (see F-VI, 1.4 and 1.4.1).

As concerns (i) above, the previous application may be an application for a patent or for the registration of a utility model or for a utility certificate.

However, a priority right based on the deposit of an industrial design is not recognised (see J 15/80).

Art. 87(3) So long as the contents of the previous application were sufficient to establish a date of filing, it can be used to determine a priority date, irrespective of the outcome (e.g. subsequent withdrawal or refusal) of the application.

As concerns (ii) above, the transfer of the application including the priority right (or of the priority right as such) must have taken place before the filing date of the later European application and must be a transfer valid under the relevant national provisions. Where the previous application was filed by joint applicants, all these applicants must be amongst the applicants of the later European patent application or have transferred their rights in the priority application to the applicant of the later European patent application (see T 844/18). Proof of the transfer can be filed later.

However, in the case of joint applicants filing the later European patent application, it is sufficient if one of the applicants is the applicant or successor in title to the applicant of the previous application. There is no need for a special transfer of the priority right to the other applicant(s), since the later European application has been filed jointly. The same applies to the case where the previous application itself was filed by joint applicants, provided that all these applicants, or their successor(s) in title, are amongst the joint applicants of the later European patent application.

As concerns (iii) above, the priority period starts on the day following the date of filing of the first application (Art. 4C(2) Paris Convention and Rule 131(2)). Accordingly, where a priority claim relates to an application filed on the same day as the European application, it will be disregarded (see, however, also A-III, 6.6).

6.2 Applications giving rise to a right of priority

Applications giving rise to a right of priority referred to in A-III, 6.1(i) are those filed at industrial property offices:

Art. 87(1) (a) of or acting for states party to the Paris Convention for the Protection of Industrial Property,

Art. 87(1) (b) of or acting for any member of the World Trade Organisation (WTO), or

Art. 87(5) (c) not subject to either the Paris Convention or the Agreement establishing the WTO, but where:

(i) that authority recognises that a first filing made at the EPO gives rise to a right of priority under conditions and with effects equivalent to those laid down in the Paris Convention, and

(ii) the President of the EPO issues a communication indicating this.

To date, no such communication referred to in (c)(ii) has been issued and so this does not as yet apply. Furthermore, the members of the WTO do not necessarily have to be states as such, but may also be intergovernmental bodies or regions with special status such as the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu.

In view of the wording of Art. 87(1) which refers to filings "in or for" any state party to the Paris Convention or member of the WTO, priority may be claimed of an earlier first filed national application, a previous European application, a previous application filed under another regional patent treaty or an international application filed under the PCT. This includes the US "provisional application for patent" (Notice from the President of the EPO dated 26 January 1996, OJ EPO 1996, 81). A list of the countries party to the Paris Convention is published on WIPO's website and is regularly published in the Official Journal of the EPO. Likewise a list of the members of the WTO is published on the website of the WTO, and this list is also regularly updated.

The decisions G 2/02 and G 3/02 previously excluded the possibility of claiming priority from an application filed at the industrial property authority of members of the WTO which were not also signatory states to the Paris Convention (Art. 87(1) EPC 1973). This exclusion no longer applies under the revised Art. 87(1).

6.3 Multiple priorities

The applicant may claim more than one priority based on previous applications in the same or different states and/or WTO members. Where multiple priorities are claimed, time limits which are calculated from the priority date run from the earliest date of priority and, as a result, the European application must be made within twelve months from the earliest priority date (see, however, A-III, 6.6); this applies if earlier applications have been filed in any of the industrial property offices mentioned in A-III, 6.2. *Art. 88(2)*

6.4 Examination of the priority document

The Receiving Section need not examine the content of the priority document. However, where it is obvious, e.g. from the title of the document, that the document relates to subject-matter quite different from that of the application, the applicant should be informed that it appears that the document filed is not the relevant document.

6.5 Declaration of priority

An applicant wishing to claim priority must file a declaration of priority indicating: *Art. 88(1)* *Rule 52(1)* *Rule 41(2)(g)*

(i) the date of the previous application, *Art. 90(4)*

(ii) the state or WTO member in or for which it was filed and

(iii) its file number.

The declaration of priority shall preferably be made on filing the European patent application (Rule 52(2)). In such a case the declaration of priority, indicating at least the date on which and the country for which the earlier application was filed, should be present in the request for grant form (Rule 41(2)(g)). However, if a priority claim is added or corrected after the request for grant form has been filed (see A-III, 6.5.1 and 6.5.2), the applicant will not be invited by the EPO to file a corrected request for grant.

The time limit for filing the certified copy of the priority document is the same as the time limit for making the priority claim (see A-III, 6.5.1 and 6.7). Consequently, where:

(a) the applicant supplies the certified copy on time, and

(b) the date and file number are indicated on the certified copy,

the requirements of Rule 52(1) are met.

6.5.1 Filing a new priority claim

Rule 52(2)

The declaration of priority should preferably be made on filing, but can be made up to 16 months from the earliest priority date claimed. That is to say, items (i)-(iii) mentioned in A-III, 6.5 can be supplied up to 16 months after the earliest claimed priority date. Where the priority claim is inserted after the filing date and causes a change in the earliest priority date, this 16-month period is calculated from that new earliest priority date in accordance with Art. 88(2).

The applicant cannot request further processing in respect of the time limit for introducing a new priority claim under Rule 52(2), since it is excluded by Rule 135(2).

6.5.2 Correcting an existing priority claim

Rule 52(3)

The applicant may correct the declaration of priority within 16 months from the earliest priority date. Where the correction causes a change in the earliest claimed priority date, this time limit is the earlier to expire of:

(i) 16 months from the earliest priority date as originally claimed.

(ii) 16 months from the earliest priority date as corrected.

However, this time limit cannot expire earlier than four months after the date of filing. Thus, if the originally claimed priority date is incorrect and precedes the date of filing by more than twelve months, the applicants will always have at least four months to correct this date, i.e. the same period as if they had claimed the correct priority date (and for example got the file number wrong) and claimed a full twelve-month priority period.

If the applicant files a request for correction later it may, exceptionally, be allowed if it is apparent on the face of the published application that a mistake has been made (see A-V, 3 and other sources therein).

6.5.3 Deficiencies in the priority claim and loss of the priority right

Four potential deficiencies exist with regard to the priority claim, namely: *Art. 90(4) and (5)*

(i) failure to indicate a date of the previous application or to indicate the correct date

(ii) failure to indicate a state or WTO member in or for which it was filed or to indicate the correct state or WTO member

(iii) failure to supply a file number

(iv) failure to indicate the correct file number.

Deficiencies (i) and (ii) can only be corrected in accordance with the procedures and within the time limit indicated in A-III, 6.5.2. Failure to correct either of these deficiencies in time results in the loss of the priority right in question according to Art. 90(5). Further processing does not apply to the time limit under Rule 52(3), since it is excluded by Rule 135(2).

However, where applicants have failed to indicate the file number of the previous application (deficiency (iii)), as required by Rule 52(1), before expiry of the 16-month time limit laid down in Rule 52(2), they are invited by the EPO to provide it within a two-month period under Rule 59. This period can be extended under Rule 132(2) (see E-IX, 2.3.5 for Euro-PCT applications), but further processing is ruled out by Rule 135(2). Failure to reply in time to this communication results in the loss of the priority right in question according to Art. 90(5). *Art. 90(4) and (5)* *Rule 59*

In the event that the applicant has failed to indicate the correct file number of the priority application (deficiency (iv)), a request for correction under Rule 139 can be filed (see A-V, 3).

6.6 Priority period

Where the date of a priority claim precedes the date of filing of the European patent application by more than twelve months, the applicant may be informed by the Receiving Section that there shall be no priority for the application unless he: *Art. 122* *Rule 133* *Rule 134* *Rule 136*

(i) indicates a corrected date lying within the twelve-month period preceding the date of filing and does so within the time limit according to Rule 52(3) (see A-III, 6.5.2), or

(ii) requests re-establishment of rights in respect of the priority period and does so within two months of the expiry of the priority period, and this request is subsequently granted (see paragraph below). This only applies where the applicant also filed the European application within the same two-month period.

Where priority is claimed from an application having the same date of filing as the European patent application (see A-III, 6.1), the EPO will inform the applicant that priority cannot be claimed from this application unless the priority date can be corrected (see A-III, 6.5.2).

Rules 133 and 134 apply to the priority period under Art. 87(1). In the event that the date indicated for the previous application is subsequent to or the same as the date of filing, the procedure set out in A-III, 6.5.2 also applies (with regard to the possibility of effecting correction of clerical or similar errors, see A-V, 3).

According to Art. 122 and Rule 136(1) it is possible to obtain re-establishment of rights in respect of the priority period (twelve months according to Art. 87(1)). The request for re-establishment must be filed within two months of expiry of the priority period (Rule 136(1)) and the omitted act, i.e. the establishment of a date of filing for the European application, must also be completed in this period (Rule 136(2)). For more details on requesting re-establishment of rights see E-VIII, 3.

6.7 Copy of the previous application (priority document)

Rule 53(1)
Art. 88(2)
Art. 90(4)

A copy of the previous application from which priority is claimed (priority document) must be filed before the end of the sixteenth month after the date of priority. Priority documents may be filed in paper form or electronically using OLF or Online Filing 2.0, provided the latter are in an accepted document format, have been digitally signed by the issuing authority and the signature is accepted by the EPO. Such electronic priority documents are currently being issued by the patent offices of the USA, Brazil, Portugal, Italy, Austria, France and Poland, with further offices expected to follow. Web-form filing must not be used for the electronic filing of priority documents (see the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42). A priority document may not be filed by fax (see the Decision of the President of the EPO dated 20 February 2019, OJ EPO 2019, A18). Where multiple priorities are claimed, the abovementioned time limit runs from the earliest date of priority.

The copy must be certified as an exact copy of the previous application by the authority which received the previous application and must also be certified by that authority as to its date of filing. This certification of the date may take the form of a separate certificate issued by that authority stating the date of filing of the previous application (Rule 53(1), second sentence) or may be an integral part of the priority document itself. The certification of the authenticity of the copy may also be a separate document or an integral part of the priority document.

It is also possible to file a copy of the previous application (priority document) on physical media other than paper, e.g. CD-R disc, provided that:

(a) the physical medium containing the priority document is prepared by the authority which received the previous application, such as to guarantee that its content cannot undetectably be altered subsequently;

(b) the content of the physical medium is certified by that authority as an exact copy of the previous application or the part contained therein; and

(c) the filing date of the previous application is also certified by that authority.

The certificate(s) may be filed separately in paper form. The submitted medium must be readable and free of computer viruses and other forms of malicious logic.

Rule 53(2)

At the request of the applicant, the EPO will include free of charge in the file of a European patent application a copy of the previous application from which priority is claimed retrieved via the WIPO Digital Access Service (DAS). DAS supports the automatic electronic exchange of priority documents within participating patent offices. Applicants may request the office of first filing (OFF) to make certified copies of previously filed patent applications available to the DAS system and then request offices of second filing (OSF) to retrieve the copies via DAS by indicating the DAS access code(s) corresponding to the previous application(s) (see the Decision of the President of the EPO dated 13 November 2021, OJ EPO 2021, A83, and the Notice from the EPO dated 22 February 2019, OJ EPO 2019, A27).

If a priority document cannot be retrieved via DAS or if the applicant has not requested retrieval via DAS, the EPO will include free of charge a copy of the previous application in the file of the European patent application

if the previous application is:

(i) a European patent application;

(ii) an international application filed with the EPO as receiving Office under the PCT;

(iii) a Chinese patent or utility model application

(iv) a Korean patent or utility model application, or

(v) a United States provisional or non-provisional patent application

No request is necessary to this end. In respect of Chinese, Korean and United States applications (items (iii) to (v) above), this only applies to European patent applications filed before 1 January 2022 and Euro-PCT applications entering the European phase before that date, and for which the required priority document can be included in the file of the application by 30 June 2023 (see Notice from the EPO dated 13 November 2021, OJ EPO 2021, A84). If the language of the previous application was not one of the official languages of the EPO, it may still be necessary to file the translation or declaration under Rule 53(3) (see A-III, 6.8).

Where the applicant has already supplied a copy of the priority document in the context of a request to base late-filed parts of the description or drawings on the claimed priority under Rule 56 (see A-II, 5.4(v)), the applicant does not need to file it again. However, if the copy already

provided was not certified as to its content and/or filing date, the applicant will need to provide the missing certification within the above time limit.

Art. 90(4) and (5)
Rule 59

If applicants fail to provide a certified copy of the priority document within the above-mentioned period (Rule 53(1)), the EPO will invite them to provide it within a two month period under Rule 59. This period can be extended under Rule 132(2) (see E-IX, 2.3.5 for Euro-PCT applications), but further processing is ruled out by Rule 135(2). If the applicant fails to provide it within this period, the priority right in question is lost (Art. 90(5)).

If a copy of the previous application cannot be included in the file, it will not be deemed duly filed under Rule 53(2). The EPO will inform applicants in good time and give them an opportunity to file the certified copy in accordance with Rule 53(1) (see the Decision of the President of the EPO dated 13 November 2021, OJ EPO 2021, A83, and the Notice from the EPO dated 13 November 2021, OJ EPO 2021, A84).

6.8 Translation of the previous application

Art. 88(1)
Rule 53(3)

Where the previous application claimed as priority is not in an official language of the EPO and the validity of the priority claimed is relevant to the assessment of the patentability of the invention concerned, the EPO shall invite the applicant for or proprietor of the European patent to file a translation into an official language of the EPO within a period specified. The duration of this period will vary depending on the stage of proceedings at which the invitation is sent (see the subsequent subsections).

6.8.1 Invitation to file the translation before examination

Where the search division notes that a translation of the previous application is required, the invitation to provide it according to Rule 53(3) may be sent at the same time as either item (i) or item (ii) below:

(i) the communication according to Rule 69(1) and Rule 70a(1) (where the applicant does not file the request for examination before the search report is transmitted – see A-VI, 2.1).

In this case, the time limit for providing the translation is the same as that for filing the request for examination, namely six months from the date of mention of the publication of the European search report according to Rule 70(1).

(ii) the communication according to Rule 70(2) (where the applicant files the request for examination before the (supplementary) European search report is transmitted - see A-VI, 2.3).

In this case the time limit for providing the translation is the same as that for filing the confirmation of the request for examination according to Rule 70(2):

(a) For applications not filed via the PCT, this is six months from the date of mention of the publication of the European search report (see A-VI, 2.3).

(b) For Euro-PCT applications subject to the preparation of a supplementary European search report (see B-II, 4.3.2), this is six months from the notification of the communication according to Rule 70(2) (see E-IX, 2.5.3).

In practice the invitation according to Rule 53(3) will be sent in a separate communication to the applicant and, in some cases, might not be despatched on exactly the same date as the applicable communication indicated in (i) or (ii) above. However, this will not affect the date of expiry of the period for providing the translation, since the relevant event used in its calculation (the mention of the publication of the European search report or the notification of the communication under Rule 70(2)) is not related to the notification of the invitation according to Rule 53(3). An exception applies where the communication under Rule 53(3) is notified less than two months before expiry of the resulting period; in that case the time limit for filing the translation will be considered extended until two months after the said notification, without prejudice to its possible extension under Rule 132(2) (see E-VIII, 1.6).

6.8.2 Invitation to file the translation in examination/opposition

The period set under Rule 132(2) for providing the translation in either examination or opposition proceedings will be four months. *Rule 132(2)*

If not sent earlier (see A-III, 6.8.1), an invitation according to Rule 53(3) may be sent in examination proceedings either alone or as an annex to a communication according to Art. 94(3). When sent as an annex to a communication according to Art. 94(3), the time limit set for reply to that communication will be the same as that for providing the translation (i.e. four months), even where the issues raised in the communication are minor (see E-VIII, 1.2).

For Euro-PCT applications where the EPO acted as the ISA or the Supplementary International Searching Authority (SISA, Rule 45*bis* PCT), an invitation according to Rule 53(3) may be sent by the examining division only after the period according to Rule 161(1) has expired (see E-IX, 3.2).

Since the proprietor of a European patent might not have previously been invited to file a translation (in the examination procedure or earlier as indicated in A-III, 6.8.1), in cases where the validity of the claimed priority becomes relevant in the assessment of patentability in opposition proceedings, the EPO may make the above invitation during the opposition procedure.

In examination and opposition proceedings, where the applicant or proprietor has been invited to provide the translation, no summons to oral proceedings will be sent until either the translation is provided or (in examination proceedings) the period for further processing in respect of the time limit according to Rule 53(3) has expired, whichever is the earlier.

In practice, the search, examining or opposition division dealing with the patent application or patent will inform the formalities officer that a

translation of the previous application is required and the formalities officer will then despatch the above communication.

6.8.3 Loss of rights and legal remedies

If the applicant for or proprietor of the European patent does not provide the translation in time, the right of priority is lost and the applicant or proprietor is informed accordingly (see A-III, 6.11). This has the effect that the intermediate document(s) will become prior art under Art. 54(2) or Art. 54(3), as applicable, and therefore relevant for the assessment of patentability. There is no further invitation to the applicant or proprietor to file the translation. However, in examination proceedings, further processing is available in case of failure to file the translation in time (see E-VIII, 2). Where appropriate, the applicant can also request a decision under Rule 112(2) (see E-VIII, 1.9.3).

Where translations of more than one previous application are requested and not provided in time, one further processing fee is due according to Rule 135(1) and Art. 2(1), item 12, RFees for each of these priorities. This applies even where the translations were requested in a single Rule 53(3) invitation.

In the event of failure to file the translation in time in opposition proceedings, the proprietor can request re-establishment of rights according to Art. 122 and Rule 136 (see E-VIII, 3). Further processing is not available to the patent proprietor in opposition proceedings. A decision according to Rule 112(2) may, however, be requested, if applicable (see E-VIII, 1.9.3).

6.8.4 Translation of previous application already filed

Where the applicant has already supplied a translation of the previous application in the context of a request to base late-filed parts of the description or drawings on the claimed priority under Rule 56 (see A-II, 5.4(vi)), the applicant does not need to file it again.

6.8.5 Voluntary filing of the translation of the previous application

Applicants for or proprietors of the European patent can file a translation of the previous application of their own motion at any time during examination or opposition proceedings before the EPO.

6.8.6 Declaration replacing the translation

Alternatively, a declaration that the European patent application is a complete translation of the previous application may be submitted within those same time limits (see also F-VI, 3.4 and D-VII, 2). The declaration may already be made by crossing the appropriate box in the request for grant form (EPO Form 1001). This declaration is only valid if the text of the European application as filed is an exact translation of the text of the previous application of which priority is claimed, meaning that nothing has been added or omitted vis-à-vis the text of the previous application. If the European application did not contain claims on the date of filing (see A-II, 4.1), the applicant can file these later (see A-III, 15). In such cases, for the declaration to be valid, the description of the European application must be an exact translation of the description of the claimed

priority, regardless of whether the latter contained claims on its filing date. However, where the European application contains claims on its date of filing and the previous application did not contain claims on its filing date or contained fewer claims on its filing date, the declaration is not valid. Furthermore, if the European application contains more or less text than is contained in the previous application as filed, such a declaration cannot be accepted. Where the declaration cannot be accepted for any of the above reasons, in order to comply with the requirement for filing a translation, a complete translation must be filed within the set time limit. A merely different arrangement of the various elements (i.e. the claims vs. the description) of the application does not affect the validity of such a declaration (for example, the claims are presented at the end of the application, whereas in the previous application they are at the beginning), nor does a different type of reference sign (e.g. Arabic rather than Roman numerals). However, a declaration is not acceptable if changes have been made within the parts of the application (e.g. different order of claims, added reference signs) or if sections of the application (e.g. listing of components, section headings and words in the drawings) are not identical to those in the previous application.

Where a European patent application claims multiple priorities, it will only in exceptional cases be a translation of the full text of one of the previous applications. In such cases, a declaration may be filed in respect of the identical previous application, while a complete translation of the other previous application(s) will have to be filed on request.

6.9 Non-entitlement to right to priority

A European patent application has no right to priority if:

(i) the application was not filed within the twelve-month period referred to in A-III, 6.1(iii) and the applicant has neither: *Art. 87(1)*

(a) corrected the priority date on time (see A-III, 6.5.2), such that the date of filing of the European application no longer exceeds the twelve-month priority period under Art. 87(1) or that the priority date is no longer the same as the date of filing (see A-III, 6.6), nor

(b) successfully requested re-establishment of rights in respect of the priority claim (see A-III, 6.6)

(ii) the previous application did not seek an industrial property right giving rise to a priority right (see A-III, 6.1); or *Art. 87(1)*

(iii) the previous application does not give rise to a priority right in respect of the state, WTO member or industrial property authority in or for which it was filed (see A-III, 6.1(i) and 6.2). *Art. 87(1) and (4)*

6.10 Loss of right to priority

The right to priority for a European patent application is lost where: *Art. 90(4) and (5)*

(i) the declaration of priority is not filed in due time (see A-III, 6.5.1); *Rule 53(3)*

(ii) the declaration of priority is not corrected in due time (see A-III, 6.5.2 and 6.5.3);

(iii) the certified copy of the previous application is not filed in due time (see A-III, 6.7); or

(iv) the translation of the previous application or the declaration referred to in A-III, 6.8.6 is not filed in due time in response to an invitation according to Rule 53(3) (see A-III, 6.8.3).

6.11 Notification

Rule 112(1)

The applicant is notified of any non-entitlement to, or loss of, a priority right. The computation of time limits that depend on the priority will take this new situation into account. This also applies where entitlement to a priority right is surrendered. The termination of a priority right has no effect on a time limit which has already expired (see also F-VI, 3.4 and E-VIII, 1.5). If the search has not yet been carried out, the Receiving Section notifies the search division of a loss of, or non-entitlement to, a priority date.

6.12 Copy of the search results for the priority or priorities

Rule 141(1)

An applicant claiming priority within the meaning of Art. 87 must file a copy of the results of any search carried out by the authority with which the previous application was filed together with the European patent application, in the case of a Euro-PCT application on entry into the European phase, or without delay after such results have been made available to him. This requirement also applies to priority claims which are subsequently withdrawn or lapse and to priority claims introduced or corrected after the filing date (see A-III, 6.5.1 and A-III, 6.5.2). The obligation under Rule 141(1) exists as long as the application is pending before the EPO. This requirement applies to all European and Euro-PCT applications filed on or after 1 January 2011 (OJ EPO 2009, 585). In the case of divisional applications, the relevant date is that on which the divisional application was received by the EPO (see A-IV, 1.2.1), not the filing date of the parent application. Where the copy is not provided to the EPO before the examining division assumes responsibility, the procedure is as set out in C-II, 5 and C-III, 6.

Where multiple priorities are claimed, the copy of the search results referred to above must be provided for all applications claimed as priority. If the search results are not drawn up in an official language of the EPO, no translation is required. The copy of the search results submitted must be a copy of the official document issued by the office where the previous application was filed. A simple listing of the prior art drawn up by the applicant will not suffice. Copies of the cited documents do not have to be provided (see the Notice from the EPO dated 28 July 2010, OJ EPO 2010, 410).

Rule 141(2)

The copy referred to in Rule 141(1) is deemed to be duly filed if it is available to the EPO and is to be included in the file of the European patent application under the conditions determined by the President. According to the Decision of the President of the EPO dated 5 October 2010, OJ EPO 2010, 600, these exceptions relate to cases where a search report

of the following type was drawn up by the EPO on an application whose priority is claimed:

(i) European search report (Art. 92)

(ii) international search report (Art. 15(1) PCT)

(iii) international-type search report (Art. 15(5) PCT)

(iv) search report prepared on behalf of a national office on a national application. As at October 2021, the EPO performs searches for the national offices of the following countries: Albania, Belgium, Croatia, Cyprus, France, Greece, Italy, Latvia, Lithuania, Luxembourg, Malta, Monaco, Netherlands, San Marino, United Kingdom.

Furthermore, the EPO includes in the file of a European patent application a copy of the search results referred to in Rule 141(1), thus exempting the applicant from filing said copy, where, based on an agreement with the national patent offices, the priority of a first filing made in one of the following states is claimed:

– Austria (see the Decision of the President of the EPO dated 19 September 2012, OJ EPO 2012, 540)

– People's Republic of China (see the Decision of the President of the EPO dated 8 April 2021, OJ EPO 2021, A38)

– Denmark (see the Decision of the President of the EPO dated 10 December 2014, OJ EPO 2015, A2)

– Japan (see the Decision of the President of the EPO dated 9 December 2010, OJ EPO 2011, 62)

– Republic of Korea (see the Decision of the President of the EPO dated 27 February 2013, OJ EPO 2013, 216)

– Spain (see the Decision of the President of the EPO dated 10 February 2016, OJ EPO 2016, A18)

– Sweden (see the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A39)

– Switzerland (see Decision of the President of the EPO dated 4 June 2019, OJ EPO 2019, A55)

– United Kingdom (see the Decision of the President of the EPO dated 9 December 2010, OJ EPO 2011, 62)

– United States of America (see the Decision of the President of the EPO dated 9 December 2010, OJ EPO 2011, 62)

Furthermore, for divisional applications, where the results of the search on the claimed priority have already been provided in respect of the parent application, the applicant need not provide them again in respect of the divisional application (see the Notice from the EPO dated 28 July 2010, OJ EPO 2010, 410).

7. Title of the invention

7.1 Requirements

Rule 41(2)(b)

The request for grant must contain the title of the invention. A requirement of Rule 41(2)(b) is that the title must clearly and concisely state the technical designation of the invention and must exclude all fancy names. In this regard, the following should be taken into account:

(i) personal names, fancy names, the word "patent" or similar terms of a non-technical nature which do not serve to identify the invention should not be used;

(ii) the abbreviation "etc.", being vague, should not be used and should be replaced by an indication of what it is intended to cover;

(iii) titles such as "Method", "Apparatus", "Chemical Compounds" alone or similar vague titles do not meet the requirement that the title must clearly state the technical designation of the invention;

(iv) trade names and trademarks should also not be used; the Receiving Section, however, need only intervene when names are used which, according to common general knowledge, are trade names or trademarks.

7.2 Responsibility

Rule 41(2)(b)

The ultimate responsibility for ensuring that the title accords with the provisions of the Implementing Regulations rests with the examining division. The search division will nevertheless take action and amend the title to avoid, if possible, the publication of applications having titles which obviously do not comply with the applicable EPC provisions (see also F-II, 3). In these cases, the EPO will of its own motion change the title, if this appears necessary (see OJ EPO 1991, 224).

The applicant is informed of whether the title proposed has been approved by the search division upon transmission of the European search report. The wording of the title (in the three official languages of the EPO), as approved by the search division, is notified by the communication announcing the forthcoming publication.

The title of the invention will be published and entered in the European Patent Register (Rule 143(1)(c)) in capital letters.

8. Prohibited matter

8.1 Morality or "*ordre public*"

Art. 53(a)
Rule 48(1)(a) and (2)

The application must not contain statements or other matter contrary to "*ordre public*" or morality. Such matter may be omitted when the application is published, the published application indicating the place and number of words or drawings omitted. (Where drawings are omitted regard should be had to the physical requirements of A-III, 3.2). The Receiving Section may check the description, claims and drawings to ascertain whether they contain offending matter. In order not to delay unduly the formalities examination, if carried out, this will entail a cursory examination to ensure that the application does not contain the following prohibited matter: statements constituting an incitement to riot or to acts contrary to "*ordre public*", racial, religious or similar discriminatory propaganda, or criminal acts and grossly obscene matter. The Receiving Section may also take action to prevent the publication of such matter where the search division draws its attention to such matter which it had overlooked. The applicant is notified of the material omitted. In practice, it will usually be the search division which brings the existence of such material in the application to the attention of the Receiving Section.

8.2 Disparaging statements

Rule 48(1)(b) and (3)

According to Rule 48(1)(b), the application must not contain statements disparaging the products or processes of any particular person other than the applicant, or the merit or validity of applications or patents of any such person. However, mere comparisons with the prior art are not to be considered disparaging *per se*. Statements clearly coming within this category that become evident from the cursory examination referred to in A-III, 8.1 or to which attention is drawn by the search division, may be omitted by the Receiving Section when publishing the application. In cases of doubt the matter should be left for consideration to the examining division. The published application must indicate the place and number of any words omitted and the EPO must furnish, upon request, a copy of the passage omitted. The applicant is again notified of the material omitted. (See also treatment of prohibited matter in proceedings before the examining division, F-II, 7).

9. Claims fee

Rule 45(1) to (3)
Rule 112(1)
Rule 37(2)
Art. 2(1), item 15, RFees

A European application which contains more than fifteen claims at the time of filing the claims (see the paragraph below) incurs payment of a claims fee in respect of each claim over and above that number. For applications filed and international applications entering the regional phase on or after 1 April 2009, a higher amount is payable for each claim in excess of 50. The claims' order is their sequence at their time of filing. If an application contains more than one set of claims, Rule 45 is only applicable for the set of claims containing the highest number of claims. If, as a result of claims having been deleted owing to non-payment of claims fees, the number of claims remaining in the set that originally incurred the fees is reduced with the result that another set then has the greatest number, the number of claims in the latter set has to be reduced to the same number as that remaining in the set originally incurring the fees (see J 8/84). The claims fees must be paid within one month after the claims are filed.

The claims may be filed at the following stages:

(a) on the European filing date (see A-II, 4.1.5)

(b) after the European filing date, in a timely response to a communication from the EPO indicating their absence under Rule 58 (see A-III, 15)

(c) after the European filing date, by applicants of their own motion before the EPO sends a communication according to Rule 58 (see A-III, 15)

Consequently, the claims fees must be paid within one month of whichever of the above dates of receipt applies.

If the claims fees have not been paid in due time, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication under Rule 45(2) pointing out the failure to observe the time limit. The applicant cannot waive this communication. If a claims fee is not paid within the period of grace, the claim concerned is deemed to be abandoned and the applicant is notified to that effect. The applicant cannot waive the communication under Rule 112(1) noting the deemed abandonment of claims under Rule 45(3). If the claims fees paid are insufficient to cover all the claims incurring fees (i.e. claim no. 16 onwards), and if when payment was made no indication was given as to which claims were covered by the fees paid, then the applicant is requested to specify which claims incurring fees are covered by the claims fees paid. The Receiving Section notifies the search division of claims that are deemed abandoned. Any claims fee duly paid is refunded only in the case referred to in Rule 37(2) (see A-II, 3.2, last paragraph).

In cases where:

(i) the application was filed by reference to a previously filed application (see A-II, 4.1.3.1), and

(ii) the applicant indicates on filing that the claims of this previously filed application take the place of claims in the application as filed,

the claims fees are due within one month of the filing date (since the claims of the previous application are effectively present on the European filing date). However, the EPO will not send the applicant a communication under Rule 45(2) with an invitation to pay any claims fees due, until the applicant has filed the copy of the previous application, within two months of the filing date (Rule 40(3)), since it is only at this point that the EPO will know how many claims there are and consequently, how many claims fees, if any, are due.

Features of a claim deemed to have been abandoned pursuant to Rule 45(3) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims (see J 15/88). However, applicants have the

possibility to pursue by filing a divisional application any (features of a) claim that is deemed abandoned due to non-payment of the claims fee in the procedure for the grant of a patent for the parent application.

Regarding Euro-PCT applications entering the European phase, see E-IX, 2.1.3 and E-IX, 2.3.8.

10. Abstract

10.1 General remark

Every application for a patent must contain an abstract. The effect of non-compliance with this requirement is dealt with in A-III, 16. *Art. 78(1)(e)* *Art. 90(3)* *Rule 57(d)*

10.2 Content of the abstract

The definitive content of the abstract is the responsibility of the EPO (see F-II, 2). In practice this responsibility lies with the search division, since the definitive content of the abstract must be determined and transmitted to the applicant along with the search report. Where it is confirmed by the search division that the abstract filed does not relate to the claimed invention, the applicant is informed that the document filed does not constitute an abstract and is invited to correct the deficiency (see A-III, 16). *Rule 66*

10.3 Figure accompanying the abstract

If the application contains drawings, applicants should indicate the figure (or exceptionally figures) of the drawings which they suggest should accompany the abstract. Where this requirement is not met, the search division decides which figure(s) to publish. For the further procedure see F-II, 2.4. *Rule 47(4)*

11. Designation of contracting states

11.1 General remarks

All contracting states party to the EPC at the filing date of the application shall be deemed to be designated in the request for grant of a European patent (for a list of the EPC contracting states, see the General Part of the Guidelines, section 6). Any other state entered on the request for grant must be disregarded (see for the designation of contracting states on the request for grant form, A-III, 11.2.2, 11.3.5 and 11.3.6). As indicated in A-II, 2, when the application is in the name of joint applicants, each may designate different contracting states; objection is to be raised during the course of the examination for formal requirements if there is any ambiguity as to the states designated by the individual applicants. *Art. 79(1)*

11.2 European patent applications filed on or after 1 April 2009

11.2.1 Designation fee; time limits

The designation of contracting states is subject to payment of a designation fee. *Art. 79(2)* *Rule 39* *Art. 149(1)*

For applications filed on or after 1 April 2009 this is a flat designation fee covering all EPC contracting states. Therefore, for these applications, the *Art. 2(1), item 3, RFees*

system of charging designation fees for individual designated states (see A-III, 11.3) no longer applies. For European divisional applications see also A-IV, 1.3.4 and 1.4.1.

Rule 39

For European patent applications, the designation fee must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.

Rule 17(3)
Rule 36(4)

For divisional applications and new applications under Art. 61(1)(b), the designation fee must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application or the new European patent application (see A-IV, 1.4.1).

For Euro-PCT applications entering the European phase on or after 1 April 2009, see A-III, 11.2.5.

11.2.2 Payment of designation fee

Rule 39(1)

The automatic designation of all the contracting states party to the EPC at the time of filing of the European patent application is effected by the filing of the application, whereas the designation fee may be paid later (see A-III, 11.2.1).

Art. 2(1), item 3, RFees

Payment of the designation fee covers all the contracting states, except those states the designation of which has been expressly withdrawn.

Art. 6(1) RFees

Such payment simply needs to be marked "designation fee" in order for the purpose of the payment to be established.

11.2.3 Consequences of non-payment of the designation fee

Rule 39(2)

Where the designation fee has not been paid by expiry of the period specified in Rule 39(1), the application is deemed to be withdrawn.

In this case, the EPO sends the applicant a communication under Rule 112(1) with notification of this loss of rights. In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 (see E-VIII, 2).

The loss of rights ensues on expiry of the normal period under Rule 39(1) and not upon expiry of the period for further processing (see G 4/98, *mutatis mutandis*).

For Euro-PCT applications entering the European phase on or after 1 April 2009, see A-III, 11.2.5.

11.2.4 Withdrawal of designation

Art. 79(3)
Rule 39(2) and (3)

Subject to the final sentence of this paragraph, the designation of one or more contracting states may be withdrawn by the applicant at any time up to the grant of the patent. Withdrawal of the designation of all the contracting states results in the application being deemed to be withdrawn and the applicant is notified accordingly.

In neither case is a validly paid designation fee refunded (see A-X, 10.1.1).

The designation of a contracting state may not be withdrawn as from the time when a third party proves to the EPO that they have initiated proceedings concerning entitlement and up to the date on which the EPO resumes proceedings for grant.

Rule 15

The applicant may withdraw designations when filing the European application, for example to avoid overlapping prior national rights with the priority application according to Art. 139(3). Timely payment of the designation fee will not cause those designations which have been withdrawn to be re-activated.

For European divisional applications see A-IV, 1.3.4.

11.2.5 Euro-PCT applications entering the European phase

For Euro-PCT applications entering the European phase, the designation fee must be paid within 31 months of the filing or priority date, if the time limit specified in Rule 39(1) has expired earlier.

Rule 159(1)(d)

According to Rule 160(1), if the designation fee for the Euro-PCT application entering the European phase is not paid within the basic period under Rule 159(1)(d), the European patent application (see Art. 153(2)) is deemed to be withdrawn. If the EPO finds that such deemed withdrawal of the European patent application has occurred, it notifies the applicant of this loss of rights according to Rule 112(1). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135.

Rule 160
Art. 153(2)

For the designation fee in relation to Euro-PCT applications entering the European phase, see also E-IX, 2.1.4 and E-IX, 2.3.11.

11.3 European patent applications filed before 1 April 2009

In this section reference is made to the relevant provisions that were in force until 31 March 2009, which remain applicable to European patent applications filed and Euro-PCT applications entering the European phase before 1 April 2009.

11.3.1 Designation fee; time limits

The designation of a contracting state is subject to payment of a designation fee. A single joint designation fee is payable for Switzerland and Liechtenstein. The designation fees are deemed paid for all contracting states upon payment of seven times the amount of one designation fee.

Art. 79(2)
Rule 39, in force until 31 March 2009

For European patent applications, the designation fees must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.

Art. 149(1)
Art. 2(2), item 3 and item 3a RFees

Rule 17(3), in force until 31 March 2009
Rule 36(4) in force until 31 March 2009

For divisional applications and new applications under Art. 61(1)(b) filed before 1 April 2009, the designation fees must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application or the new European patent application (see A-IV, 1.4.1).

For Euro-PCT applications entering the European phase before 1 April 2009, see A-III, 11.3.9.

11.3.2 Consequences of non-payment of designation fees

Rule 39(2), in force until 31 March 2009

Where the designation fee has not been paid in due time in respect of any designated state, the designation of that state shall be deemed to be withdrawn (see also A-III, 11.3.4).

If the designation fee for a particular contracting state is not paid in time, the EPO sends the applicant a communication under Rule 112(1) with notification of the deemed withdrawal of the designation in question according to Rule 39(2). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 in respect of this partial loss of rights (see E-VIII, 2). This communication is not sent if the applicant waives the right to receive it in respect of the state in question, by crossing the appropriate box in the request for grant form. By crossing this box, the applicant waived the right to further processing in respect of the designation or designations in question.

For Euro-PCT applications entering the European phase before 1 April 2009, see A-III, 11.3.9.

11.3.3 Amount paid insufficient

Art. 6(2), 1st sentence, RFees

If, during the period for requesting further processing, designation fees are paid without an additional sum sufficient to cover the amount of the further processing fee, it is first necessary to establish how many designation fees including the further processing fee are covered by the total sum paid for that purpose. The applicant must then be invited, pursuant to Art. 6(2), first sentence, RFees, to inform the EPO for which contracting states the designation fees plus further processing fee are to be used (see J 23/82, *mutatis mutandis*). For the subsequent procedure, see A-III, 11.3.7.

11.3.4 Application deemed to be withdrawn

Rule 39(3), in force until 31 March 2009

Where no designation fee is validly paid by expiry of the period specified in Rule 39(1), the application is deemed to be withdrawn.

If no designation fees are paid on time leading to a deemed withdrawal of the application under Rule 39(3), in force until 31 March 2009, the EPO sends the applicant a communication according to Rule 112(1) with notification of this loss of rights. In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 in respect of this total loss of rights (see E-VIII, 2).

Where the application is deemed to have been withdrawn because of failure to pay the designation fees, the loss of rights ensues on expiry of the normal period under Rule 39(1). Similarly, the deemed withdrawal of a

designation of a contracting state takes effect upon expiry of the normal period under Rule 39(1), and not upon expiry of the period for further processing (see G 4/98, *mutatis mutandis*). The applicant is notified of the loss of rights and can remedy it by requesting further processing according to the procedures explained in A-III, 11.3.2.

11.3.5 Request for grant form

The automatic designation of all of the contracting states party to the EPC at the time of filing of a European patent application is effected by the filing of the application, whereas the designation fees payable for an application filed before 1 April 2009 may be paid later.

Art. 79(1) and (2)

Applicants have time – until expiry of the period for paying the designation fees (Rule 39(1) and Rules 17(3) and 36(4)) – to decide which contracting states they actually want their patent to cover. This they do by paying the designation fees for those states, which may include an additional sum required to validate a request for further processing.

11.3.6 Indication of the contracting states

For European patent applications filed before 1 April 2009, the designation fees are deemed paid for all contracting states upon payment of seven times the amount of one designation fee. Such payment simply need be marked "Designation fees" in order for the purpose of the payment to be established.

Art. 2(2), item 3, RFees
Art. 6(1) RFees

If, on the other hand, the applicant intended to pay fewer than seven designation fees when filing the application, it was for that party to indicate the relevant contracting states in the appropriate Section of the request for grant form (EPO Form 1001, versions prior to April 2009). This helped to ensure that the designation fees paid were properly entered in the books. If designation fees are not paid within the basic time limit, a communication under Rule 112(1) is issued.

In response to the communication under Rule 112(1), the applicant may request further processing in respect of the lost designation(s). However, no Rule 112(1) communication will be sent and no further processing can be requested with regard to designations in respect of which the applicant waived these rights by crossing the appropriate box on the request for grant form or where the designation in question has been withdrawn.

For applicants taking part in the automatic debiting procedure, see also A-X, 7.2.

11.3.7 Amount payable

Art. 6(2), 1st sentence, RFees
Art. 8(2) 2nd sentence, RFees, in force until 31 March 2009
Rule 39(2), in force until 31 March 2009
Rule 112(1)

If, given the amount payable under the time limit in question, the sum paid for designation fees during the periods under Rule 39(1) or Rule 135(1) does not cover all the contracting states indicated in the request for grant form (EPO Form 1001), and the payer failed to indicate for which contracting states the fees are intended, then the payer is requested to indicate which states are to be designated, within a period stipulated by the EPO (see also A-III, 11.3.3). If the payer fails to comply in due time, then Art. 8(2) RFees applies: the fees are deemed to have been paid only for as many designations as are covered by the amount paid, in the order in which the contracting states have been designated (see J 23/82, *mutatis mutandis*). The designation of contracting states not covered by the fees are deemed withdrawn, and the applicant is notified of the loss of rights (see A-III, 11.3.4, paragraph 3, regarding the time at which loss of rights ensues).

11.3.8 Withdrawal of designation

Art. 79(3)
Rule 39(3)in force until 31 March 2009 and (4), in force until 31 March 2009
Rule 15

Subject to the final sentence of this paragraph, the designation of a contracting state may be withdrawn by the applicant at any time up to the grant of the patent. A validly paid designation fee is not refunded when a designation is withdrawn. Withdrawal of the designation of all the contracting states results in the application being deemed to be withdrawn and the applicant is notified accordingly. The designation of a contracting state may not be withdrawn as from the time when a third party proves to the EPO that they have initiated proceedings concerning entitlement and up to the date on which the EPO resumes proceedings for grant.

The applicant may withdraw designations when filing the European application, for example to avoid overlapping prior national rights with the priority application according to Art. 139(3). Timely payment of designation fees for designations which have been withdrawn, will not cause those designations to be re-activated. Furthermore, no Rule 112(1) communication will be sent in respect of a failure to pay designation fees for any designation which has been withdrawn.

11.3.9 Euro-PCT applications entering the European phase before 1 April 2009

Rule 159(1)(d)

For Euro-PCT applications entering the European phase, a designation fee with respect to each contracting state designated, up to a maximum of seven times the amount of one designation fee to designate all contracting states, must be paid within 31 months of the filing or priority date, if the time limit specified in Rule 39(1) has expired earlier. The principles laid down in A-III, 11.3.3, 11.3.6, 11.3.7 and 11.3.8, for European patent applications filed before 1 April 2009 apply to Euro-PCT applications in accordance with Art. 153(2), with the individual contracting states being indicated in the request for entry into the European phase (EPO Form 1200).

Rule 160, in force until 31 March 2009
Art. 153(2)

Pursuant to Rule 160(2), the designation of any contracting state for which no designation fee has been paid in time is deemed to be withdrawn. According to Rule 160(1), if no designation fee for the Euro-PCT application entering the European phase is paid at all within the basic period under Rule 159(1)(d), the European patent application (see Art. 153(2)) is

deemed to be withdrawn. If the EPO finds that such deemed withdrawal of the European patent application or the designation of a contracting state has occurred, it notifies the applicant of this loss of rights according to Rule 112(1). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135.

For designation fees in relation to Euro-PCT applications entering the European phase, see also E-IX, 2.1.3 and E-IX, 2.3.11.

12. Extension and validation of European patent applications and patents to/in states not party to the EPC

12.1 General remarks

At the applicant's request and on payment of the prescribed fee, European patent applications (direct or Euro-PCT) and thus patents can be extended to European states for which an extension agreement with the EPO has become effective (extension states). The same applies to requests for validation in European or non-European states for which a validation agreement has entered into force (validation states).

The states for which such requests may currently be filed are listed below:

(i) Extension may be requested for the following European states:

Bosnia and Herzegovina (BA)	since 1 December 2004
Montenegro (ME)	since 1 March 2010

The EPO's extension agreements with the **Republic of Slovenia** (entry into force: 1 March 1994), the **Republic of Romania** (15 October 1996), the **Republic of Lithuania** (5 July 1994), the **Republic of Latvia** (1 May 1995), the **Republic of Croatia** (1 April 2004), the **Republic of North Macedonia** (as the former Yugoslav Republic of Macedonia) (1 November 1997), **Albania** (1 February 1996) and the **Republic of Serbia** (1 November 2004) terminated when these countries acceded to the EPC with effect from 1 December 2002, 1 March 2003, 1 December 2004, 1 July 2005, 1 January 2008, 1 January 2009, 1 May 2010 and 1 October 2010 respectively. However, the extension system continues to apply to all European and international applications filed prior to those dates, and to all European patents granted in respect of such applications.

(ii) Validation may be requested for the following states (OJ EPO 2015, A20, OJ EPO 2015, A85, OJ EPO 2017, A85 and OJ EPO 2018, A16):

Morocco (MA)	since 1 March 2015
Republic of Moldova (MD)	since 1 November 2015
Tunisia (TN)	since 1 December 2017
Cambodia (KH)	since 1 March 2018

Extension and validation agreements are bilateral international treaties concluded between the European Patent Organisation and the state in

question. Within the territory of the state concerned, the effects of a European patent application for which an extension or validation request has been filed, or of a European patent which has been validated in an extension or validation state, are based on national law. The provisions of the EPC, its Implementing Regulations and the Rules relating to Fees do not apply to the extension and validation systems, unless and only to the extent that those provisions are referred to by the applicable national law. Thus, the EPC provisions concerning applicants' legal remedies and appeals do not apply in respect of any action taken by the EPO under the extension or validation procedure (see e.g. J 14/00, J 4/05 and J 22/10), e.g. where the extension or validation fee has not been paid within the applicable time limit indicated (A-III, 12.2). Similarly, no different claims, description or drawings are acceptable in respect of extension or validation states (see H-III, 4.4), as Rule 138 EPC does not apply to the extension and validation systems.

A request for extension to or validation for the above-mentioned states is deemed to be made with any European application filed after entry into force and, as to the former, before the termination of the respective extension agreements. This applies also to Euro-PCT applications provided that the EPO has been designated for a European patent **and** the extension or validation state has been designated for a national patent in the international application. The request is deemed withdrawn if the extension or validation fee is not paid within the prescribed time limit (see A-III, 12.2). It is by paying the extension or validation fee that the applicant decides to extend the application to an extension state or validate it in a validation state. The declaration in the appropriate section of the request for grant form (EPO Form 1001) or of EPO Form 1200 for entry into the European phase before the EPO, where the applicant is asked to state whether the extension or validation fee is intended to be paid, is merely for information purposes and intended to assist in recording fee payments.

A request for extension or validation in respect of a divisional application (see A-IV, 1) is deemed to be made only if the respective request is still effective in the parent application when the divisional application is filed.

12.2 Time limit for payment of extension and validation fees

Under the applicable national provisions of the extension and validation states, the extension or validation fee must be paid

(i) for European patent applications, within six months of the date on which the European Patent Bulletin mentions the publication of the European search report, or

(ii) for Euro-PCT applications, within the period for performing the acts required for entry of an international application into the European phase, or within six months of the date of publication of the international search report, whichever is the later.

If the fee for an extension or validation state has not been paid within the corresponding basic period (see items (i) and (ii) above), the applicant can still pay the extension or validation fee together with a 50% surcharge

(a) within a grace period of two months from expiry of the basic period for payment; or

(b) if the designation fee has not been paid, along with the filing of a valid request for further processing concerning the designation fee, within two months of notification of a communication of loss of rights with regard to the designation fee (see Notices from the EPO dated 2 November 2009, OJ EPO 2009, 603, and 5 February 2015, OJ EPO 2015, A19).

If the applicant fails to pay the extension or validation fee during the basic and the grace period, the request for extension or validation is deemed to be withdrawn. No communication of loss of rights is issued.

However, a noting of loss of rights related to the failure to pay the designation fee pursuant to Rule 39(2) or 159(1)(d) will draw the applicant's attention to the lack of payment of the extension or validation fee, where appropriate, triggering the time limit mentioned in item (b) above.

A request for re-establishment of rights according to Art. 122 and Rule 136 is not possible in respect of payment of the extension or validation fee.

12.3 Withdrawal of the extension or validation request

The request for extension or validation may be withdrawn at any time. It will be deemed withdrawn if the European patent application or the Euro-PCT application is finally refused, withdrawn or deemed withdrawn. A separate communication is not issued to the applicant. Validly paid extension or validation fees are not refunded.

12.4 Extension and validation deemed requested

Extension and validation are deemed to be requested in respect of all extension and validation states (see, however, A-III, 12.1, sixth paragraph, regarding Euro-PCT applications), and this is indicated in the published application, the European Patent Register and the European Patent Bulletin. Those states for which the extension or validation fees have been paid are subsequently indicated in the European Patent Register, the European Patent Bulletin and the published patent specification.

12.5 National register

Extension and validation states publish in their national register the relevant data relating to European patent applications and patents extending to their territory.

13. Filing and search fees

13.1 Payment of fees

The applicant is required to pay a filing fee and, subject to the exception mentioned below (see the note to point (iii) below), a search fee. The filing and search fees must be paid within the following periods: *Art. 78(2)*

(i) where neither (ii) nor (iii) applies, within one month of filing the European application *Rule 38*

Rule 36(3)
Rule 17(2)

(ii) for European divisional applications or European applications filed according to Art. 61(1)(b), within one month of filing the divisional or Art. 61(1)(b) application

Rule 159(1)

(iii) for Euro-PCT applications, within 31 months of the filing date or, where applicable, from the earliest claimed priority date*.

*Note that when a supplementary European search report is dispensed with by the EPO (see B-II, 4.3), no search fee is required for the Euro-PCT application (Rule 159(1)(e)).

Art. 90(3)
Rule 57(e)
Art. 78(2)
Rule 36(3)
Rule 17(2)

With regard to applications of types (i) and (ii), the EPO will check that these fees have been paid. If either fee is not paid on time, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1); the applicant can respond by requesting further processing according to Art. 121 and Rule 135.

Pursuant to Art. 2(1) RFees as amended by Decision of the Administrative Council of 13 December 2017 (OJ EPO 2018, A4), the amount of the filing fee depends on the method and format used for filing the European patent application or its translation, if applicable. However, where a fee level relates to a means of electronic communication or a particular electronic document format, that fee level will only apply when this means or this format, as referred to in Article 2(1) RFees, is made available. The date on which such fee level will apply is to be specified by the President of the Office (see Art. 2(4) RFees as adopted by Decision of the Administrative Council of 12 December 2018, OJ EPO 2019, A3, and the Notice from the EPO dated 24 January 2019, OJ EPO 2019, A6). At present, for European patent applications, the fee levels of the filing fee and of the fee for grant relating to the filing in character-coded format (DOCX) are not applied. The latest information on the applicable fee levels and amounts can be found on the EPO website (see also A-X, 1).

With regard to Euro-PCT applications (type (iii)), see E-IX, 2.1.4.

Rule 6(3) to (7)

For the reduction of the filing fee under the language arrangements, see A-X, 9.2.1 and 9.2.2.

13.2 Additional fee (if application documents comprise more than thirty-five pages)

Rule 38(2) and (3)
Art. 2(1), item 1a, RFees
Rule 46, Rule 49

This section relates only to applications filed and international applications entering the European phase on or after 1 April 2009 (see also the Notice from the EPO dated 26 January 2009, OJ EPO 2009, 118, and the supplement thereto, OJ EPO 2009, 338).

An additional fee is payable as part of the filing fee for European patent applications which are filed on or after 1 April 2009 and comprise more than thirty-five pages. The amount of the fee is calculated according to the number of pages over thirty-five. The language reduction under Rule 6(3) applies if the requirements of Rule 6(4), (6) and (7) have been met (see A-X, 9.2.1 and A-X, 9.2.2). The additional fee is payable within one month of the filing date of the application or of the date of filing a European

divisional application or a European application according to Art. 61(1)(b). If the application is filed without claims or by reference to a previously filed application, the additional fee is payable within one month of filing the first set of claims or one month of filing the certified copy of the application referred to in Rule 40(3), whichever expires later. The additional fee is calculated on the basis of the pages of the description, claims, any drawings and one page for the abstract, in the language of filing. Where formal deficiencies in the documents making up the European patent application need to be corrected, the number of pages complying with the physical requirements (see A-III, 3 and A-IX) is taken as the basis for calculation. In particular those deficiencies relating to the minimum margins (Rule 46(1), Rule 49(5)), the start on a new sheet of each document making up the application (Rule 49(4)), line-spacing and character size (Rule 49(8)) as well as the scale of drawings (Rule 46(2)(c)) potentially have an impact on the number of pages. Where this is the case, any additional fee due for the higher number of pages may be paid within two months of the invitation pursuant to Rule 58 drawing the applicant's attention to this requirement.

The pages of the request for grant (EPO Form 1001) and those forming part of a sequence listing within the meaning of Rule 30(1) are not counted, provided the sequence listing contained in the description complies with the applicable WIPO standard. If the application is filed by reference to a previously filed application, the pages of the certified copy, excluding those for the certification and for bibliographic data, are taken as the basis for the calculation. If the application is filed without claims, the additional fee takes account of the pages of the first set of claims filed.

For international (Euro-PCT) applications entering the European phase on or after 1 April 2009, the additional fee is payable as part of the filing fee within the 31-month period of Rule 159(1). It is calculated on the basis of the international application as published (even if published in a non-EPO language), any amended claims under Art. 19 PCT, which replace the claims as originally filed unless specified to the contrary (see OJ EPO 2017, A74), and one page for the abstract. If there is more than one page of bibliographic data, the further pages are not counted. The pages of the latest set of any amended documents (Art. 34 PCT, amendments filed upon entry) on which European phase processing is to be based (Rule 159(1)(b)) will also be taken into account where available to the EPO by the date of payment of the additional fee within the thirty-one months. Any amended pages are added to the calculation of the page fee unless the applicant clearly specifies, at the latest by the date of payment, the amended pages which are to replace the corresponding pages of the application as published (see also E-IX, 2.1.1). This information should preferably be given in the relevant section of the form for entry into the European phase, and in particular in the related table (see notes on EPO Form 1200). If the applicant explicitly states that application documents filed on entry into the European phase have merely been reformatted (so as to reduce the number of pages subject to payment of an additional fee) rather than substantively amended, the EPO disregards these reformatted application documents and does not accept them as the basis for calculation of the additional fee (see the Notice from the EPO dated

26 January 2009, OJ EPO 2009, 118, and the supplement thereto, OJ EPO 2009, 338).

Any replacement pages must be filed in an official language of the EPO. Where the international application has not been published in an official language of the EPO, the additional fee for any amended description or drawings will be based on the translation of the international application filed on entry into the European phase (see E-IX, 2.1.3). EPO Form 1200 is disregarded in the calculation of the additional fee.

In application of the general principles described above, for international applications comprising both erroneously filed application documents and correct application documents incorporated by reference (Rule 20.6 PCT in conjunction with Rule 20.5*bis*(d) PCT) (see C-III, 1.3), the additional fee must be paid for all application documents contained in the international publication. According to the abridged procedure outlined in C-III, 1.3, if, within the 31-month period for entering the European phase and before payment of the additional fee, the applicants declare their intention to renounce the correct application documents incorporated by reference under Rule 20.5*bis*(d) PCT, this renunciation is, for the calculation of the additional fee, equal to an amendment of the international application as published. Accordingly, those pages identified in the publication of the international application as "Incorporated by reference (Rule 20.6)" are deducted from the international application as published. The same principle applies if, within the 31-month period for entering the European phase, the applicants declare their intention to renounce the erroneously filed application documents and, thus, the initial date of filing. In that case, the erroneously filed pages are deducted from the international application as published as regards the calculation of the additional fee.

For international applications comprising both erroneously filed and correct application documents incorporated by reference under Rule 20.5*bis*(d) PCT, and where the applicants make use of the abridged procedure on entry into the European phase (see C-III, 1.3), the renunciation of either the correct application documents or of the erroneously filed ones within the 31-month period for entering the European phase and before payment of the additional fee is, for the calculation of the additional fee, equal to an amendment of the international application as published. Therefore, according to the general principles, the additional fee is based on the translation of those application documents that are maintained for the further proceedings (either the correct application documents incorporated by reference or the erroneously filed ones) (see the Notice from the EPO dated 14 June 2020, OJ EPO 2020, A81).

Example:

International application, published in English, containing 100 pages:

Abstract	1
Description	50
Claims	20
Drawings	20
claims, Art. 19 PCT	9

On entry into European phase, within the 31-month period, 10 pages of amended claims are filed to replace previous pages of claims, as indicated by the applicant in EPO Form 1200.

-> number of pages on which calculation is based: 100 - 20 (original claims) - 9 (Art. 19 PCT) + 10 (EP entry) - 35 (fee-exempt)

-> number of pages to be paid for: 46

Pages of amendments filed after the date of payment of the additional fee, in particular during the Rule 161(1) or Rule 161(2) period (see E-IX, 3), are not taken into account. Consequently, if amendments are filed at this stage which reduce the number of pages already paid for, no refund will be made.

If the additional fee is not paid on time, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1); the applicant can request further processing according to Art. 121 and Rule 135. The amount of the fee for further processing is computed according to the number of pages on file at expiry of the relevant period for which the additional fee, calculated as set out above, has not been paid. The amount of the fee for further processing in respect of the additional fee does not take into account the basic filing fee according to Art. 2(1), item 1, RFees, where this was paid on time. *Art. 78(2)*

13.3 Additional fee for divisional applications

Regarding the additional fee payable as part of the filing fee for divisional applications of second or subsequent generations filed on or after 1 April 2014, see A-IV, 1.4.1.1 and the Notice from the EPO dated 8 January 2014, OJ EPO 2014, A22. *Rule 38(4)* *Art. 2(1), item 1b, RFees*

14. Translation of the application

There are three situations in which a translation of the European application will be required: *Art. 14(2)* *Rule 6(1)*

(i) the European application was filed according to Art. 14(2) in a language which is not an official language of the EPO

(ii) the European application was filed by reference to a previously filed application which is not in an official language of the EPO (Rule 40(3))

(iii) the European divisional application was filed in the same language as the earlier (parent) application on which it is based, where this was not an official language of the EPO (Rule 36(2) – see A-IV, 1.3.3).

In all cases, a translation of the application must be filed at the EPO: in cases (i) and (ii) this must be done within two months of the date of filing according to Rule 6(1) (for type (i)) or Rule 40(3) (for type (ii)); in case (iii) it must be done within two months of the filing of the divisional application according to Rule 36(2).

Art. 90(3)
Rule 57(a)

The EPO will check that this requirement has been complied with. If the translation has not been filed, the EPO will invite the applicant to rectify this deficiency under Rule 58 within a period of two months in accordance with the procedure explained in A-III, 16.

Rule 58

Failure to file the translation on time in response to the invitation under Rule 58 results in the application being deemed to be withdrawn according to Art. 14(2). The EPO will then notify the applicant of this loss of rights according to Rule 112(1). The above time limits for supplying the translation under Rule 40(3), Rule 6(1) and Rule 36(2) are all excluded from further processing by Rule 135(2), as is the time limit for rectification of the failure to file the translation under Rule 58. Consequently, further processing is not possible in this case. However, the applicant may request re-establishment according to Art. 122 and Rule 136 for failure to comply with the time limit under Rule 58.

For translations in respect of international applications entering the European phase, see E-IX, 2.1.2.

15. Late filing of claims

Art. 80
Rule 40(1)

For the purposes of obtaining a date of filing it is not necessary for the European application to contain any claims. The presence of at least one claim is nonetheless a requirement for a European application according to Art. 78(1)(c), but a set of claims can be provided after the date of filing according to the procedure described below.

Art. 90(3) and (5)
Rule 57(c)
Rule 58

The EPO will check whether at least one claim is present in the application. If this is not the case, the EPO will issue an invitation under Rule 58 inviting the applicant to file one or more claims within a period of two months. If the applicant fails to do so within this period, the application is refused according to Art. 90(5). The applicant is notified of this decision according to Rule 111. Further processing for failure to observe the time limit under Rule 58 is excluded by virtue of Rule 135(2). The applicant may, however request re-establishment according to Art. 122 and Rule 136 or may appeal.

Where the application documents as originally filed did not include at least one claim, applicants may also file claims of their own motion after the date of filing, but before the EPO invites them to do so under Rule 58. In this case, no communication under Rule 58 will then be issued.

If the applicant does supply a set of claims in response to the invitation under Rule 58, the claims so filed must have a basis in the application documents (description and any drawings) provided on the date of filing (Art. 123(2)). This requirement will first be checked at the search stage (see B-XI, 2.2).

If the application was filed by means of a reference to a previously filed application in accordance with Rule 40(3) and the applicant indicated on the date of filing that the claims of the previously filed application were to take the place of claims in the application as filed (see A-II, 4.1.3.1), then, provided the previously filed application also contained claims on its date of filing, claims were present on the European date of filing and no communication under Rule 58 will be sent.

The above procedure also applies to divisional applications (Art. 76(1)) and applications filed in accordance with Art. 61(1)(b).

16. Correction of deficiencies

16.1 Procedure formalities officer

Where, during the examination for compliance with the requirements set out in earlier sections of this Chapter, it is noted that there are deficiencies which may be corrected, the formalities officer must give the applicant the opportunity to rectify each such deficiency within a specified period. A summary of the most common potential deficiencies at this stage of the procedure and the provisions governing their rectification is given below: *Art. 90(3)*

A-III, 2	Representation	Rule 58
A-III, 3	Physical Requirements	Rule 58
A-III, 4	Request for grant	Rule 58
A-III, 5	Designation of inventor	Rule 60
A-III, 6	Claim to priority	Rule 52(3), Rule 59
A-III, 9	Payment of claims fees	Rule 45
A-III, 10	Abstract	Rule 58
A-III, 13	Filing fee, including any additional fee, search fee	Rule 112(1), Rule 135
A-III, 14	Translation of the application	Rule 58
A-III, 15	Late filing of claims	Rule 58

The formalities officer should raise all formal objections that become evident from a first examination of the application in the appropriate communication, except that, as noted in A-III, 3.2, the Receiving Section should not draw the attention of the applicant to deficiencies under Rule 46(2)(i) and (j) or question the inclusion of tables in the claims (Rule 49(9), fourth sentence). It is likely that certain matters cannot be finally disposed of at this stage, e.g. filing of priority documents for which the period for filing has not expired, and further reports may be necessary. If the applicant is required to appoint a representative but has not done so, the formalities officer should in the first report deal only with this deficiency. Any request(s) for correction of other deficiencies will not be sent until a representative has been appointed, and will be sent to that representative.

16.2 Period allowed for remedying deficiencies

Rule 58

The period for remedying the following deficiencies is two months from a communication pointing them out according to Rule 58:

(i) non-appointment of a representative where the applicant has neither residence nor principal place of business in a contracting state - see A-III, 2 (regarding failure to file an authorisation where this is necessary, see A-VIII, 1.5 and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1);

(ii) documents making up the application not complying with physical requirements (see A-III, 3);

(iii) request for grant (with the exception of the priority criteria) not satisfactory (see A-III, 4);

(iv) abstract not filed (see A-III, 10);

(v) where required, translation of the application not filed (see A-III, 14)

(vi) no claims (see A-III, 15).

Art. 90(5)
Art. 14(2)

The period under Rule 58 is not extendable. If the above deficiencies under (i)-(iv) or (vi) are not rectified in time, the application is refused under Art. 90(5). If the deficiency under (v) is not rectified in time, the application is deemed to be withdrawn under Art. 14(2). According to Rule 135(2), further processing is excluded for all of the above losses of rights, which all arise from the failure to observe the time limit of Rule 58.

The following deficiencies are rectified under provisions other than Rule 58:

(vii) non-payment of the claims fees (Rule 45 - see A-III, 9);

(viii) priority document or file number of the previous application is missing (Rule 59 - see A-III, 6); and

(ix) non-payment of filing fee, including any additional fee, and search fee (see A-III, 13).

Rule 45

According to Rule 45(2), the period for remedying deficiencies with regard to the payment of claims fees under (vii) is one month from a communication pointing out their non-payment. Failure to correct this deficiency in time leads to the claims in question being deemed to be abandoned under Rule 45(3). Further processing applies to this loss of rights.

Art. 90(5)
Rule 59

Deficiencies under (viii) are to be corrected within a period of two months from a communication under Rule 59. This period can be extended under Rule 132(2) (see E-IX, 2.3.5 for Euro-PCT applications), but further processing is ruled out by Rule 135(2). Failure to correct this deficiency in time leads to the loss of the priority right.

Failure to pay the filing, additional or search fee on time results in the deemed withdrawal of the application according to Art. 78(2). This loss of rights ensues directly on expiry of the applicable time limit (see A-III, 13). A deficiency under (ix) can be corrected by requesting further processing. *Art. 78(2)*

Where appropriate, the search division is informed of any loss of rights.

Chapter IV – Special provisions

1. European divisional applications (see also C-IX, 1)

1.1 General remarks

Art. 76
Rule 36(1)

A divisional application may be filed relating to any pending earlier European patent application. A divisional application filed on the same day as the parent application is not considered as validly filed. The term "earlier application" is understood to mean an application filed at least one day before the divisional application and refers to the immediate application on which the divisional application is based ("parent application"). Where the earlier application is a Euro-PCT application, a divisional application can only be filed upon effective entry of the earlier application into the European phase (see E-IX, 2.4.1).

The divisional application is accorded the same date of filing as the parent application and has the benefit of any right of priority of the parent application in respect of the subject-matter contained in the divisional application (see A-IV, 1.2.1).

A European patent application may give rise to more than one divisional application. A divisional application may itself give rise to one or more divisional applications.

Where a divisional application is deemed not to have been validly filed due to non-fulfilment of one of the filing conditions (see also A-IV, 1.1.1 and 1.1.3), the applicant will be duly informed in a communication pursuant to Rule 112(1) stating that the application will not be processed as a European divisional application and providing the opportunity to apply for a decision on the EPO's findings under Rule 112(2) (see E-VIII, 1.9.3). Any fees paid will be refunded if the loss of rights becomes final.

1.1.1 Pendency of the earlier application

The parent application must be pending when a divisional application is filed. Reference is made in this regard to the observations made in decisions G 1/09 and J 18/09 as to what constitutes a pending application. In the case of an application being filed as a divisional application from an application which is itself a divisional application, it is sufficient that the latter is still pending at the filing date of the second divisional application.

An application is pending up to (but **not** including) the date that the European Patent Bulletin mentions the grant of the patent (OJ EPO 2002, 112). Rule 134 does not apply in this case. It is not possible to validly file a divisional application when the parent application has been finally refused, withdrawn or is deemed to be withdrawn (see also the paragraphs below).

If an application is **deemed to be withdrawn** due to the non-observance of a time limit (e.g. following failure to pay the filing fee (Art. 78(2)), to pay a renewal fee (Art. 86(1)), to pay the fee for grant and publishing or the claims fees, or to file the translation of the claims (Rule 71(7)) in due time),

the application is no longer pending when the non-observed time limit has expired.

In the event of non-payment of a renewal fee by the due date (Rule 51(1)), the application is pending up to the last day of the six-month period for payment of the renewal fee with an additional fee (Rule 51(2), first sentence), and a divisional application may still be filed during this period – even if the fees are ultimately not paid. Deemed withdrawal of the application takes effect on expiry of the six-month period (Rule 51(2), second sentence).

Once the application is deemed to be withdrawn, a divisional application can only be validly filed if the loss of rights, as communicated pursuant to Rule 112(1), is subsequently remedied. In such a case, the application is deemed to have been pending throughout.

Art. 112a(5)

Depending on the non-observed time limit, remedying the loss of rights may be effected either by means of an allowable request for further processing (see E-VIII, 2) or, where applicable, by a request for re-establishment of rights (see E-VIII, 3). Furthermore, if the findings in the notice of loss of rights are considered inaccurate, the applicant may also apply for a decision under Rule 112(2) (see E-VIII, 1.9.3). If the competent EPO body shares this opinion or if it gives an unfavourable decision which is subsequently overturned on appeal, no loss of rights has ever occurred and the application will have been pending throughout (see J 4/11, reasons 22). The same applies if the appeal decision is set aside by the grant of a petition for review and the appeal proceedings are re-opened under Art. 112a(5), with the consequence that the decision under Rule 112(2) is overturned.

If an application has been **refused** and no appeal has (yet) been filed, the application is still pending within the meaning of Rule 36(1) until expiry of the time limit for filing the notice of appeal (Art. 108), and a divisional application can be validly filed until expiry of this period (see G 1/09). Where the applicant does validly file a notice of appeal but fails to submit the written statement setting out the grounds of appeal, the refused application is pending until expiry of the time limit for filing the grounds of appeal under Art. 108 (see J 23/13). If the grounds of appeal are submitted in due time, the decision to refuse cannot take effect until the appeal proceedings are over. As the provisions relating to the filing of divisional applications also apply in appeal proceedings (Rule 100(1)), a divisional application may then be filed while such appeal proceedings are under way. If the appeal proceedings are re-opened under Art. 112a(5), the application will have been pending throughout.

If the parent application is **withdrawn** by the applicant, a divisional application can be filed up to (i.e. including) the date on which the declaration of withdrawal is received by the EPO.

While proceedings are stayed in accordance with Rule 14(1) (see A-IV, 2.2), the filing of divisional applications is not possible. Rule 14(1) constitutes a *lex specialis* with regard to the right to file a

divisional on a pending application provided for in Rule 36(1) (see J 20/05 and G 1/09, reasons 3.2.5).

In respect of a purported divisional application filed when the parent application is not pending, the EPO will issue a communication pursuant to Rule 112(1) (see A-IV, 1.1). The pendency of the earlier application is not a procedural deadline or time limit, which, in case of non-compliance, would lead to a loss of rights. Instead, it is a condition of a substantive nature for the filing of divisional applications (see G 1/09, reasons 3.2.3). Therefore, the provisions on re-establishment of rights and further processing do not apply to the filing of divisional applications (see J 10/01, reasons 15).

1.1.2 Sequences of divisional applications

A divisional application can also be an earlier application in the sense of Art. 76(1) for the purposes of one or more further divisional applications. The characterising feature of a sequence of divisional applications each divided out from its predecessor is that each member of the sequence claims as date of filing the date of the root application in which the subject-matter divided out in sequences of divisional applications was first disclosed (see G 1/05, G 1/06).

In a sequence of divisional applications, a first-generation divisional application is a divisional application based on an application which is not itself a divisional application, i.e. the root application. A second-generation divisional application is a divisional application based on a first-generation divisional application; and so on.

1.1.3 Persons entitled to file a divisional application

Only the applicant or, in the case of multiple applicants, all applicants on record on the earlier application may file a divisional application. This means that, in the case of a transfer of an application, a divisional application may only be filed by or on behalf of the new applicant(s) if the transfer was duly registered and therefore effective vis-à-vis the EPO (Rule 22) at the filing date of the divisional application. A purported divisional application that is not filed in the name of the applicant(s) of the parent application will not be processed as a European divisional application. The EPO will inform applicants by issuing a communication pursuant to Rule 112(1) (see A-IV, 1.1).

1.2 Date of filing of a divisional application; claiming priority

1.2.1 Date of filing

A European divisional application may be filed in respect of subject-matter which does not extend beyond the content of the parent application as filed. Provided this requirement is met, the divisional application is deemed to have been filed on the date of filing of the parent application and enjoys that application's priority (see A-IV, 1.2.2).

Art. 76(1), 2nd sentence

A divisional application filed in due form, i.e. meeting the requirements of Art. 80 and Rule 40(1) (see A-II, 4.1 *et seq.*), is accorded the same date of filing as the parent application, being that of the root application in case of a sequence of divisional applications. The question of whether it is confined

Art. 63(1)
Art. 80
Rule 40(1)

to subject-matter contained in the parent application is not decided until the examination procedure (see C-IX, 1.4 *et seq.*). The term of a patent granted for a European divisional application is 20 years from its date of filing, i.e. the date of filing of the root application.

Since Rule 40(1) does not require that a European application contain any claims on its date of filing, the same applies to a European divisional application. The applicant can file the claims after the filing of the divisional application according to the procedures detailed in A-III, 15. This may be done after the parent application is no longer pending, provided that the requirements of Rule 40(1) were satisfied with regard to the divisional while the parent application was still pending. If the claims of the parent application are included in the description of the divisional application, these are to be clearly identified as part of the description (see F-IV, 4.4).

1.2.2 Priority claim of a divisional application

Art. 76(1) Rule 53(2) and (3)

A priority claimed in the parent application also applies to the divisional application, provided that the parent application's priority claim has not been lost or withdrawn by the date the divisional application is filed; it is not necessary to claim it formally a second time. The priority claim can be withdrawn in respect of the divisional application (F-VI, 3.5, E-VIII, 8.2 and E-VIII, 8.3). However, this withdrawal will have no effect on the priority claim of the parent application. Similarly, any withdrawal of the priority claim of the parent application after the filing of the divisional application has no effect on the priority claim of the divisional application.

The applicant may, if so desired, claim fewer priorities in respect of the divisional application (where the parent application claims more than one priority – Art. 88(2)). To do so, the applicant must file a clear and unambiguous withdrawal of the priority claim or claims in question in respect of the divisional application (see the Notice from the EPO dated 12 November 2004, OJ EPO 2004, 591). In the absence of such a withdrawal, all priorities which have not lapsed in respect of the parent application when the divisional is filed also remain valid with respect to the divisional application. Furthermore, in the absence of such a withdrawal, all such priority claims remain valid for the divisional, even if the applicant provides an incorrect or incomplete priority claim when filing the divisional application.

If a certified copy and a translation of the previous application, if applicable (see A-VII, 3.3), have been filed in respect of the parent application before the divisional application is filed, it is not necessary to file the priority document and any translation again in respect of the divisional application. The EPO makes a copy of these documents and places them in the file of the divisional application (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, B.2).

If, when the divisional application is filed, a priority document has not been filed in respect of the parent application, it must be filed in respect of the divisional application and, if the priority claim of the parent application's remaining subject-matter is to be retained, in respect of the parent application also. Applicants can also inform the EPO, within the time limit

set for filing priority documents in the divisional application proceedings, that they have in the meantime submitted these documents in respect of the parent application. If the subject-matter of the divisional application relates only to some of the priorities claimed in the parent application, priority documents in respect of the divisional application need be filed for those priorities only.

This applies also as regards indicating the file number of the previous application. For the time limits for indicating the file number and for filing the priority documents, see A-III, 6.5, 6.5.3 and 6.7 *et seq*. *Rule 52(2)*

1.3 Filing a divisional application

1.3.1 Where and how to file a divisional application?

A divisional application must be filed by delivery by hand, by postal services or by fax with the EPO in Munich, The Hague or Berlin. It may also be filed using the EPO Online Filing software, the EPO case management system or the EPO Web-Form Filing service (see A-II, 1.2.2). *Rule 36(2)* *Rule 35(1)*

The filing of a European divisional application with a national authority has no effect in law; the authority may however, as a service, forward the European divisional application to the EPO. If a competent national authority chooses to forward the application, it is not deemed received until the documents have reached the EPO.

The divisional application may be filed by reference to a previously filed application. The procedures are as provided for in Rule 40(1)(c), (2) and (3) (see A-II, 4.1.3.1). Where the divisional application is filed by reference to an international application which has effectively entered the European phase (see A-IV, 1.1) and was not filed with the EPO as receiving Office, a certified copy of the international application originally filed with the PCT receiving Office must be filed (OJ EPO 2009, 486).

1.3.2 Request for grant

The request for grant of a patent must contain a statement that a divisional application is sought and state the number of the parent application. It should also mention which generation of divisional application is being filed (Rule 38(4), Art. 2(1), item 1b, RFees). If the request is deficient, as can arise if there is no indication that the application constitutes a divisional application, although some of the accompanying documents contain an indication to that effect, or if the number is missing, the deficiency may be corrected in the manner indicated in A-III, 16. *Rule 41(2)(e)*

1.3.3 Language requirements

As indicated in A-VII, 1.3, a divisional application must be filed in the language of the proceedings of the parent application. Alternatively, if the earlier (parent) application was filed in a language other than an official language of the European Patent Office, the divisional application may be filed in that language. In this case a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application (see A-III, 14). *Rule 36(2)*

1.3.4 Designation of contracting states

Art. 76(2)
Rule 36(4)

All contracting states designated in the earlier application at the time of filing a European divisional application are deemed to be designated in the divisional application (see also G 4/98). If no designations have been withdrawn in respect of the parent application, then all contracting states adhering to the EPC at the date of filing of the parent are automatically designated in the divisional application when it is filed. Conversely, contracting states, the designations of which have been withdrawn in respect of the parent application at the time of filing the divisional application, cannot be designated in respect of the divisional application.

If the parent application was filed before 1 April 2009, and the time limit for payment of the designation fees has not yet expired for the parent application when the divisional application is filed, and no designations have been withdrawn in respect of the parent application, then all contracting states adhering to the EPC at the date of filing of the parent are automatically designated in the divisional application when it is filed. Conversely, contracting states, the designations of which have been withdrawn or deemed to be withdrawn in respect of the parent application at the time of filing the divisional application, cannot be designated in respect of the divisional application.

The flat designation fee payable for divisional applications filed on or after 1 April 2009 does not cover contracting states the designations of which have been withdrawn or deemed to be withdrawn at the time of filing the divisional application.

1.3.5 Extension and validation states

All extension and validation states designated in the earlier application at the time of filing of a European divisional application are deemed to be designated in the divisional application. For more details regarding the designation of these states, see A-III, 12.1.

1.4 Fees

1.4.1 Filing, search and designation fee(s)

Rule 36(3) and (4)
Art. 79(2)

The filing fee and search fee for the divisional application must be paid within one month of filing the European patent application (basic time limit). For the additional fee due for any pages in excess of thirty-five, see A-III, 13.2. For the additional fee due for divisional applications of second or subsequent generations, see A-IV, 1.4.1.1. The designation fee(s) must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the divisional application.

The search fee must be paid even if a further search fee has already been paid under Rule 64(1) in respect of the search report on the parent application for the part of the application which was lacking in unity and which is now the subject of the divisional application (for reimbursement of the search fee see A-IV, 1.8).

If, within the applicable time limit, the filing, search or designation fees have not been paid, the application is deemed to be withdrawn. The EPO informs the applicant of these losses of rights by issuing a communication under Rule 112(1). The applicant can request further processing according to Art. 121 and Rule 135.

Rule 36(3) and (4)

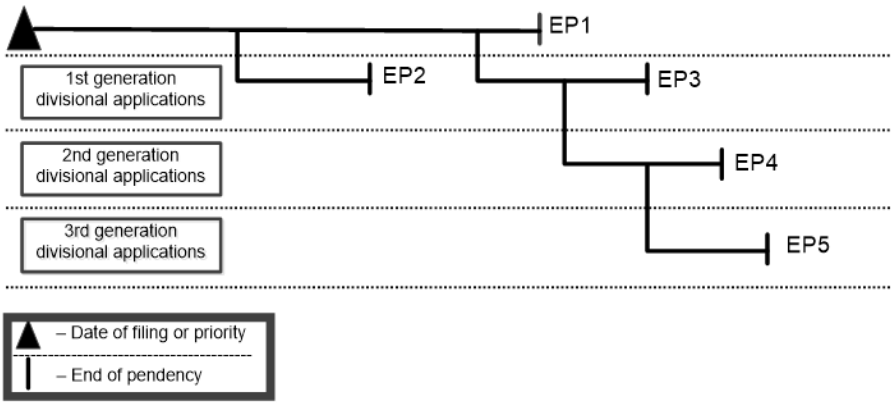
For divisional applications filed before 1 April 2009, see for the deemed withdrawal of single designations or of the application and applicable remedies A-III, 11.3.2 and 11.3.4.

1.4.1.1 Additional fee for divisional applications of second or subsequent generations

An additional fee is payable as part of the filing fee for divisional applications of second or subsequent generations filed on or after 1 April 2014 (see the Notice from the EPO dated 8 January 2014, OJ EPO 2014, A22). The amount of the fee varies depending on the generation to which the divisional application filed belongs (see A-IV, 1.1.2). First-generation divisional applications are not subject to the additional fee. From the second to the fifth generation the amount of the fee grows progressively. For the fifth and subsequent generations it becomes a flat fee (Art. 2(1), item 1b, RFees).

Rule 38
Art. 2(1), item 1b, RFees

Example:



In this example, no additional fee would be due in respect of EP2 and EP3, as they are first-generation divisional applications. The amount of the additional fee for second-generation divisional applications would apply to EP4, and the amount for third-generation divisional applications would apply to EP5.

The additional fee is part of the filing fee for divisional applications of second and subsequent generations. Therefore, it must be paid within the same period as the filing fee, and the same provisions apply in case of non-payment in due time (see A-IV, 1.4.1). Likewise, the reduction of the filing fee under the language arrangements applies to this additional fee, provided that the requirements laid down in Rule 6(4) to (7) are complied with (see A-X, 9.2.1 and 9.2.2).

1.4.2 Claims fees

Rule 45(1)

If, at the time of filing the first set of claims, the divisional application comprises more than fifteen claims, a claims fee is payable in respect of each claim over and above that number (see A-III, 9). Claims fees are payable even if in the parent application they were paid in respect of claims relating to the subject-matter now the subject of the divisional application (see A-III, 9).

1.4.3 Renewal fees

Art. 86(1)
Art. 76(1)
Rule 51(3)
Art. 2(1), item 5, RFees

For the divisional application, as for any other European patent application, renewal fees are payable to the EPO. They are due in respect of the third year and each subsequent year, calculated from the date of filing of the earlier (parent) application, being that of the root application in case of a sequence of divisional applications. Pursuant to Art. 76(1) in conjunction with Rule 51(3), the date of filing the parent application is also the date from which the time limits for payment of the renewal fees for the divisional application (Art. 86(1)) are calculated. If, when the divisional application is filed, renewal fees for the parent application have already fallen due, these renewal fees must also be paid for the divisional application and fall due when the latter is filed (see also A-IV, 1.1.1). The period for payment of these fees is four months after the filing of the divisional application. If not paid in due time, they may still be validly paid within six months of the date on which the divisional application was filed, provided that at the same time the additional fee of 50% of the renewal fees paid late is paid.

Rule 51(3)
Art. 2(1), item 5, RFees

If, within the four-month period referred to above, a further renewal fee falls due or a renewal fee falls due for the first time, it may be paid without an additional fee within that period. It may otherwise still be validly paid within six months of the due date, provided that at the same time the additional fee of 50% of the renewal fee paid late is paid. When calculating the additional period the principles developed by the Legal Board of Appeal should be applied (see J 4/91).

Further processing for failure to pay renewal fees on time is excluded by virtue of Rule 135(2). However, re-establishment is possible. In the case of applications for re-establishment of rights in respect of renewal fees falling due on filing of the divisional or within the four-month period laid down in Rule 51(3), second sentence, the one-year period prescribed by Rule 136(1) starts to run only after the six months under Rule 51(2) have expired.

Example:

25.03.2008:	date of filing of parent application;
11.01.2011:	filing of divisional application and due date of renewal fee for the third year;
31.03.2011:	due date of renewal fee for the fourth year;
11.05.2011:	expiry of four-month period under Rule 51(3);
11.07.2011:	expiry of six-month period under Rule 51(2) in respect of the renewal fee for the third year;
30.09.2011:	expiry of six-month period under Rule 51(2) in respect of the renewal fee for the fourth year;
11.07.2012:	expiry of one-year period under Rule 136(1) in respect of the renewal fee for the third year;
01.10.2012:	expiry of one-year period under Rule 136(1) in respect of the renewal fee for the fourth year (extended under Rule 134(1)).

For other examples see A-X, 5.2.4.

1.5 Designation of the inventor

The provisions of A-III, 5.4 apply with regard to the designation of the inventor, except that, where the designation of the inventor has not been provided or is deficient (i.e. it does not comply with Rule 19), the applicant will be invited to provide or correct it within a two-month period specified by the EPO (see E-VIII, 1.6). The divisional application requires a separate designation, independent of the parent application on which it is based. *Rule 60(2)*

1.6 Authorisations

The provisions of A-VIII, 1.5 and 1.6 apply with regard to authorisations in respect of the divisional application. If, according to these provisions, the representative has to file an authorisation, they may act on the basis of an individual authorisation filed in respect of the parent application only if it expressly empowers them to file divisional applications.

1.7 Other formalities examination

Other than for matters referred to in A-IV, 1.1 to 1.6, the formal examination of divisional applications is carried out as for other applications. The provisions of Rule 30 apply with regard to divisional applications relating to nucleotide or amino acid sequences filed after 1 January 1993 (see A-IV, 5).

1.8 Search, publication and request for examination of divisional applications

Divisional applications are searched, published and examined in the same way as other European patent applications.

The search fee is refunded if the conditions of Art. 9(2) of the Rules relating to Fees are met (see the Decision of the President of the EPO dated

17 November 2017, OJ EPO 2017, A94, for divisional applications for which the search is completed on or after 1 December 2017).

The divisional application is published in accordance with Art. 93(1). The filing or priority date taken for calculation of the eighteen-month period for publication is the date of filing or the earliest priority date claimed (see A-IV, 1.2.1). Since this period has usually already expired when the divisional application is filed, the technical preparations for publication are completed as soon as all formal requirements with respect to the divisional application have been fulfilled. The applicant is informed of the intended publication date (see also A-VI, 1.1).

The time limit for filing the request for examination begins to run with the date on which the European Patent Bulletin mentions the publication of the search report concerning the divisional application.

2. Art. 61 applications and stay of proceedings under Rule 14

2.1 General

Art. 61(1)
Rule 16

It may be adjudged by decision of a court or competent authority (hereinafter "court") that a person referred to in Art. 61(1), other than the registered applicant, is entitled to the grant of a European patent. This third party may, within three months after the decision has become final, provided that the European patent has not yet been granted, in respect of those contracting states designated in the European patent application in which the decision has been taken or recognised or has to be recognised on the basis of the Protocol on Recognition annexed to the European Patent Convention:

Art. 61(1)(a)

(i) prosecute the application as their own application in place of the applicant (see A-IV, 2.4 and 2.7);

Art. 61(1)(b)

(ii) file a new European patent application in respect of the same invention (see A-IV, 2.5 and 2.7); or

Art. 61(1)(c)

(iii) request that the application be refused (see A-IV, 2.6 and 2.7).

In a case where the application is no longer pending due to its having been withdrawn, refused or being deemed to be withdrawn, the third party can still file a new European patent application in respect of the same invention, in accordance with Art. 61(1)(b) (see G 3/92).

2.2 Stay of proceedings for grant

Rule 14(1)

If a third party provides proof to the EPO that they have opened proceedings against the applicant for the purpose of seeking a judgement that they are entitled to the grant of the European patent the EPO will stay the proceedings for grant unless the third party communicates to the EPO in writing their consent to the continuation of such proceedings. This consent is irrevocable.

Proceedings for grant may not be stayed before the publication of the European patent application. In the case of a Euro-PCT application

proceedings may only be stayed after expiry of the time limit for entry into the European phase.

Furthermore, Rule 14(1) only refers to national entitlement proceedings which result directly, i.e. generally and automatically, in decisions mentioned in Art. 61(1) and it does not refer to proceedings initiated before a court of a non-contracting state (see J 6/03, r.21). Jurisdiction and the recognition of decisions regarding the right to the grant of a European patent for EPC contracting states are governed by the Protocol on Recognition, which under Art. 164(1) is an integral part of the EPC. Arbitration awards may be recognised, provided that they may automatically be recognised by all designated contracting states, e.g. pursuant to the New York Convention on the Recognition and Enforcement of Foreign Arbitral Awards of 10 June 1958.

The dates on which proceedings are stayed and resumed will be entered in the European Patent Register (Rule 143(1)(s)). They will also be communicated to the parties.

For the stay of opposition proceedings, see D-VII, 4.1.

2.2.1 Responsible department

Sole responsibility for procedures where the applicant is not entitled lies with the Legal Division of the EPO (see the Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). *Art. 20*

2.2.2 Date of the stay of proceedings

A stay of proceedings under Rule 14(1) takes immediate effect as from the date the EPO is provided with satisfactory evidence that national proceedings have been instituted against the applicant seeking a decision within the meaning of Art. 61(1) (J 9/12).

The requirements for effectively initiating court proceedings are governed by national law (J 7/00).

2.2.3 Legal nature and effects of the stay

The stay of proceedings is a preliminary procedural measure sui generis which is justified as a preventive measure to preserve the third party's possible rights to the patent in dispute and which takes immediate effect (J 28/94, J 15/06). In particular, the stay of the grant proceedings is ordered by a communication of the EPO without having heard the applicant. However, the applicant may, in view of the said communication, request the issuance of an appealable decision.

Stay of proceedings implies that the legal status quo existing at the time of the suspension is maintained, i.e. neither the EPO nor the parties can validly perform any legal acts while proceedings are suspended (J 38/92). In particular, the applicant is not allowed to withdraw either the European patent application or the designation of any contracting state (Rule 15). Likewise, no divisional application can be filed during the stay of proceedings (J 20/05 and J 9/12).

An automatic debit order ceases to be effective on the day on which a stay of the proceedings under Rule 14 takes effect (see Point 13.1(e) AAD, Annex A.1 to the ADA, Supplementary publication 5, OJ EPO 2017). Therefore, after resumption of proceedings a new automatic debit order is needed, if the applicant wishes to continue using the automatic debiting procedure.

2.2.4 Interruption of time limits

Rule 14(4)

The time limits in force at the date of stay other than time limits for payment of renewal fees are interrupted by such stay. The time which has not yet elapsed begins to run as from the date on which proceedings are resumed. However, the time still to run after the resumption of the proceedings must not be less than two months. As far as renewal fees are concerned, they continue to fall due during the period of stay. Also, in accordance with Rule 14(4), the period for the payment of the renewal fee with an additional fee provided for in Rule 51(2) is not interrupted.

Example: The European Patent Bulletin mentions the publication of the European search report on 15 March 2017. Proceedings are stayed on Friday, 5 May 2017 and resumed on Friday, 18 August 2017. At the resumption of proceedings, the six-month period from the date of the mention of the publication of the search report for payment of the examination fee (Rule 70(1)) does not begin to run again in its entirety but only for the days and months not yet elapsed. This time must not be less than two months (Rule 14(4)).

The six-month period starts on the day following the publication of the search report, in accordance with Rule 131(2), i.e. on 16 March 2017, and ends on 15 September 2017. The period that is already running when proceedings are stayed on 5 May 2017 ends on 4 May 2017.

The period that has elapsed between 15 March 2017 and 4 May 2017 is one month and 19 days. The remaining period to run after the resumption is more than two months.

Calculation of the remaining non-elapsed period:

On the day of suspension, 5 May 2017, the first month of the running period has passed and so have 19 days of the second month. Thus, on that day, 11 days and four months remain (from 5 May 2017 to 15 May 2017 inclusive and from 15 May 2017 to 15 September 2017 inclusive). This non-elapsed period must be added to the date of resumption in order to calculate the deadline for payment of the examination fee.

Resumption is on 18 August 2017. All time limits start running again as from and including this day (Rule 131(2) does not apply):

After adding first the remaining days and then the remaining months, it is necessary to check whether the last day falls on a day on which the EPO receives mail according to Rule 134(1): calculating 11 days from and including 18 August 2017 results in 28 August 2017. Adding four months to that gives 28 December 2017 as the end of the time limit for payment of the

fee. Since the EPO was closed from Monday, 25 December 2017 to Monday, 1 January 2018, the period is extended to 2 January 2018 in accordance with Rule 134(1).

2.2.5 Resumption of the proceedings for grant

The date of resumption of proceedings, as well as the legal basis for the resumption is to be communicated to the third party and the applicant. *Rule 14(3)*

2.2.5.1 Resumption after final decision in entitlement proceedings

Grant proceedings will be resumed where evidence is provided that a final decision within the meaning of Art. 61(1) has been taken, unless a new European patent application under Art. 61(1)(b) has been filed for all the designated contracting states. If the decision is in favour of the third party, the proceedings may not be resumed earlier than three months after the decision has become final, unless the third party requests the resumption. *Rule 14(2)*

2.2.5.2 Resumption regardless of the stage of entitlement proceedings

The Legal Division may also order the resumption of grant proceedings regardless of the stage reached in the proceedings against the applicant. In this case, it is at the discretion of the Legal Division to decide whether the proceedings are to be continued. This discretion is to be exercised with due regard to the interests of the parties. In particular, the outcome of the court proceedings in the first instance and the duration of the stay of proceedings before the EPO are to be taken into consideration, as well as an evident abuse of proceedings, e.g. in the form of delaying tactics. *Rule 14(3)*

2.3 Limitation of the option to withdraw the European patent application

As from the time when a third party proves to the EPO that they have initiated proceedings concerning entitlement (see A-IV, 2.2) and up to the date on which the EPO resumes the proceedings for grant (see A-IV, 2.2.5), neither the European patent application nor the designation of any contracting state may be withdrawn. *Rule 15*

2.4 Prosecution of the application by a third party

If any third parties wish to avail themselves of the possibility open to them under Art. 61(1)(a) (see A-IV, 2.1(i)), they must declare their intention in writing to the EPO in due time. They then take the place of the erstwhile applicant. The proceedings for grant are continued from the point reached when they were stayed or when the declaration was filed by the third party (see A-IV, 2.2). *Art. 61(1)(a)*

2.5 Filing a new application

A new European patent application under Art. 61(1)(b) must be filed in paper or electronic form at The Hague, Munich or Berlin offices of the EPO. It is not possible to file an application according to Art. 61(1)(b) with the competent authorities of a contracting state. *Art. 61(1)(b)* *Art. 76(1)*

The new application is in many other respects treated as a European divisional application and corresponding provisions apply. In particular, the

following provisions relating to divisional applications apply *mutatis mutandis*:

Art. 61(2)

(i) accordance of the date of filing of the earlier application and entitlement to priority date – see A-IV, 1.2;

(ii) information in the request for grant – see A-IV, 1.3.2;

Rule 17(2) and (3)
Rule 45(1)

(iii) filing, search, designation and claims fees – see A-IV, 1.4.1 and 1.4.2;

(iv) designation of inventor – see A-IV, 1.5.

(v) language requirements – see A-IV, 1.3.3.

Rule 51(6)

However, arrangements for renewal fees are different. For the year in which the new application is filed and for the years beforehand, no renewal fees are payable.

In other respects the formal examination is carried out as for other applications.

If it is adjudged that a third party is entitled to the grant of a European patent for only some of the contracting states designated in the earlier application, and the third party files a new application for these states, for the remaining states the earlier application continues to be in the name of the earlier applicant.

Rule 17(1)

The earlier application is deemed to be withdrawn on the date of filing of the new application for the contracting states designated therein in which the decision has been taken or recognised.

2.6 Refusal of the earlier application

Art. 61(1)(c)

If the third party requests under Art. 61(1)(c) that the earlier application be refused, the EPO must accede to this request. The decision is open to appeal (Art. 106(1)).

2.7 Partial transfer of right by virtue of a final decision

Rule 18(1)

If by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, Art. 61 and Rules 16 and 17 apply to such part.

3. Display at an exhibition

3.1 Certificate of exhibition; identification of invention

Art. 55(1)(b) and (2)
Rule 25

Where an applicant states when filing an application that the invention which is the subject of the application has been displayed at an official or officially recognised international exhibition falling within the terms of the Convention on international exhibitions, that applicant must file a certificate of exhibition within four months of the filing of the European patent

application. The exhibitions recognised are published in the Official Journal. The certificate, must:

(a) have been issued during the exhibition by the authority responsible for the protection of industrial property at that exhibition;

(b) state that the invention was exhibited at the exhibition;

(c) state the opening date of the exhibition and the date of the first disclosure, if different from the opening date of the exhibition;

(d) be accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.

3.2 Defects in the certificate or the identification

The Receiving Section acknowledges receipt of the certificate and identification of the invention. The Receiving Section draws the applicant's attention to any manifest defects in the certificate or the identification in case it is possible to rectify the deficiencies within the four-month period allowed. The applicant is notified according to Rule 112(1) if the certificate or identification is not furnished within the time allowed. The applicant may request further processing in respect of this loss of rights according to Art. 121 and Rule 135.

4. Applications relating to biological material

4.1 Biological material; deposit thereof

In accordance with Rule 26(3), "biological material" means any material containing genetic information capable of reproducing itself or being reproduced in a biological system. *Rule 26(3)*

Where in relation to an application concerning biological material an applicant states having deposited in accordance with Rule 31(1)(a) the biological material with a depositary institution recognised for the purposes of Rules 31 and 34, the applicant must, if such information is not contained in the application as filed, submit the name of the depositary institution and the accession number of the culture deposit and, where the biological material has been deposited by a person other than the applicant, the name and address of the depositor, within whichever of the following periods is the first to expire: *Rule 31(1)(c) and (d)* *Rule 31(2)*

(i) within a period of sixteen months of the date of filing of the European patent application or the date of priority, this time limit being deemed to have been met if the information is submitted before completion of the technical preparations for publication of the European patent application; *Rule 31(2)(a)*

(ii) if a request for early publication of the application according to Art. 93(1)(b) is submitted, up to the date of such submission; or *Rule 31(2)(b)*

(iii) if it is communicated that a right to inspection of the files pursuant to Art. 128(2) exists, within one month of such communication. *Rule 31(2)(c)*

Art. 83

The above time limit according to Rule 31(2) is excluded from further processing by Rule 135(2). Furthermore, Art. 122 is also not applicable, because a lack of disclosure cannot be remedied by way of re-establishment under Art. 122 (see the Notice from the EPO dated 7 July 2010, OJ EPO 2010, 498).

Rule 31(1)(d)

Moreover, when the depositor and applicant are not identical, the same time limit applies for submitting a document satisfying the EPO that the depositor has authorised the applicant to refer to the deposited biological material in the application and has given unreserved and irrevocable consent to the deposited material being made available to the public in accordance with Rule 33(1) and (2) or Rule 32(1). The depositor's authorisation for the applicant to refer to the deposit and the consent to the material being made available to the public must have existed as from the filing date of the application in question. For a recommended wording for this declaration, see paragraph 3.5 of the above-mentioned Notice from the EPO. For Euro-PCT applications, the document referred to above must be provided to the International Bureau before completion of the technical preparations for international publication (see Notice from the EPO dated 7 July 2010, OJ EPO 2010, 498, points II.7 to II.8).

Note, however, that where the depositor is one of several applicants the document referred to in Rule 31(1)(d) is not required (see the above-mentioned Notice).

Rule 33(6)

The depositary institution must be one appearing on the list of depositary institutions recognised for the purposes of Rules 31 to 34, as published in the Official Journal of the EPO. This list includes the depositary institutions, especially the International Depositary Authorities under the Budapest Treaty. An up-to-date list is regularly published in the Official Journal.

The applicant is strongly recommended to file the deposit receipt issued by the depositary institution with the EPO since this document indicates in particular the depositor and shows the information required under Rule 31(1)(a) and (c). This information enables the EPO to certify any requests for the issuance of a sample (see A-IV, 4.2 and A-IV, 4.4) and the examining division to establish whether the application satisfies the requirements under Article 83 (see also F-III, 6.2 and F-III, 6.3). A deposit receipt must be filed for each sample of biological material disclosed in the application and deposited under the Budapest Treaty for the purposes of Rule 31 EPC. The deposit receipt may be filed as long as proceedings before the EPO are pending.

4.1.1 New deposit of biological material

Rule 34

If biological material deposited according to Rule 31 ceases to be available from the recognised depositary institution, an interruption in availability shall be deemed not to have occurred if:

(i) a new deposit of that material is made in accordance with the Budapest Treaty

(ii) a copy of the receipt of that new deposit issued by the depositary institution is forwarded to the EPO within four months of the date of the new deposit, stating the number of the European patent application or patent.

The non-availability may occur because, for example:

(a) the material has degraded such that it is no longer viable, or

(b) the authority with which the original deposit was made no longer qualifies for that kind of material, either under the Budapest Treaty or under bilateral agreements with the EPO.

In either case (a) or (b) above, a new deposit must be made within three months of the depositor's being notified of the non-availability of the organism by the depositary institution (Art. 4(1)(d) Budapest Treaty). This is subject to the exception, where:

– the non-availability of the deposit is for the above reason (b), and

– the depositor does not receive the above notification from the depositary institution within six months after the date on which it is published by the International Bureau that the depositary institution is no longer qualified in respect of the biological material in question.

In this exceptional case, the new deposit must be made within three months from the date of the said publication by the International Bureau (Art. 4(1)(e) Budapest Treaty).

If, however, the original deposit was not made under the Budapest Treaty, but rather at a depositary institution recognised by the EPO by virtue of a bilateral agreement, the above-mentioned six-month period is calculated from the date when the EPO publishes the fact that the depositary institution in question is no longer qualified to accept deposits of the biological material in question under that bilateral agreement.

4.1.2 The application was filed by reference to a previously filed application

Where the application was filed by reference to a previously filed application in accordance with the procedures described in A-II, 4.1.3.1 and the previously filed application referred to already satisfied the requirements of Rule 31(1)(b) and (c) on its date of filing, these requirements will also be satisfied in respect of the European application.

If the information on the deposited biological material present in the previously filed application as filed does not satisfy Rule 31(1)(c), the EPO will not know this until the applicant files the certified copy and any required translation of the previously filed application (at the latest within two months of the date of filing – Rule 40(3)). Even where the certified copy and any translation required are filed up to two months from the date of filing, if the requirements of Rule 31(1)(c) are not satisfied, the time limit for rectification of this deficiency according to Rule 31(2) is unaffected (see A-IV, 4.2).

4.2 Missing information; notification

Art. 97(2)
Rule 31
Art. 83

When the Receiving Section notices that the information required under Rule 31(1)(c) (indication of the depositary institution and the accession number of the culture deposit) or the information and the document referred to in Rule 31(1)(d) (authorisation to refer to the deposit and the consent to it being made available) is not contained in or has not yet been submitted with the application, it should notify the applicant of this fact as this information can only be validly submitted within the time limits specified in Rule 31(2). In the case of missing information pursuant to Rule 31(1)(c), the deposit must be identified in the patent application as filed in such a way that the later submitted accession number can be traced back without ambiguity. This can normally be done by indicating the identification reference given by the depositor within the meaning of Rule 6.1(a)(iv) of the Budapest Treaty (see G 2/93). Where the depositary institution and/or the accession number is/are missing in the application on the date of filing but the applicant provides the information within the applicable time limit (Rule 31(2)), the missing information about the depositary institution and/or the accession number is published on the front page of the published European patent application (see A-VI, 1.3).

The applicant is also informed when a deposit with a recognised depositary institution is referred to but no receipt from the depositary institution has been filed (the applicant is advised to provide this receipt when filing the application, if possible - see the Notice from the EPO dated 7 July 2010, OJ EPO 2010, 498). Filing the receipt is an essential requirement, among other things, for identifying the depositor, whose name needs to be established before the EPO may certify a third party's request for the issuance of a sample of the deposited material (see also A-IV, 4.1). Any further action, i.e. establishing whether the information available satisfies the requirement of sufficiency of disclosure, is a matter for the examining division. See also F-III, 6, in particular F-III, 6.3(ii), as regards the examining division's treatment of applications relating to biological material. If the examining division is of the opinion that the invention is not sufficiently disclosed due to a lack of information concerning the biological material that constitutes the subject of the invention, it may refuse the European patent application (see F-III, 3). The time limit according to Rule 31(2) for supplying the information required by Rule 31(1)(c) and (d) is excluded from further processing by Rule 135(2).

4.3 Availability of deposited biological material to expert only

Rule 32(1)

Under Rule 32(1)(a) and (b), until the date on which the technical preparations for publication of the application are deemed to have been completed, the applicant may inform the EPO that, until the publication of the mention of the grant of the European patent or, where applicable, for twenty years from the date of filing if the application has been refused or withdrawn or is deemed to be withdrawn, the availability referred to in Rule 33 is to be effected only by the issue of a sample to an independent expert nominated by the requester.

The above communication must take the form of a written declaration addressed to the EPO. This declaration may not be contained in the description and the claims of the European patent application, but may be

given in the appropriate section of the request for grant form (EPO Form 1001).

If the declaration is admissible, it is mentioned on the front page when the European patent application is published (see also A-VI, 1.3).

For Euro-PCT applications published in the international phase in an official language of the EPO, the applicant must request the expert solution to the International Bureau before completion of the technical preparations for international publication, preferably using Form PCT/RO/134 (see the Notice from the EPO dated 7 July 2010, OJ EPO 2010, 498). For Euro-PCT applications not published in the international phase in an official language of the EPO, the applicant may request the expert solution under Rule 32(1) before completion of the technical preparations for publication of the translation of the international application required under Rule 159(1)(a) (see the above-mentioned Notice from the EPO).

If the applicant duly informs the EPO under Rule 32(1), the biological material is issued only to an independent expert nominated by the requester. The requirements and obligations applying to experts are laid down by the President of the EPO and are deemed to be fulfilled by signing the relevant declaration on a dedicated form provided by the EPO (see the Decision of the President of the EPO dated 10 July 2017, OJ EPO 2017, A60, and the Notice from the EPO dated 10 July 2017, OJ EPO 2017, A61). Expert nominations must be accompanied by a declaration whereby the experts undertake to comply with the pertinent requirements and obligations and that they know of no circumstances which might give rise to justified doubts as to their independence or which might conflict in any other way with their function as expert.

Rule 32(2)

4.4 Requests for samples of biological material

As from the date of publication of a European patent application relating to biological material, the biological material deposited in accordance with Rule 31 will be made available on request to any person having the right to inspect the files (see A-XI, 1). Such availability will be effected by the issue of a sample to the person making the request or, where the applicant has so requested, to an expert nominated by the requester (see A-IV, 4.3). The EPO makes available on its website the forms to be used for obtaining samples of biological material deposited under the Budapest Treaty which the EPO is asked to certify under Rule 33(4).

Rule 33

The EPO's certification of the request signals to the depositary institution that, based on its verification of the status of the application/patent and the related data in the EPO records, it may issue a sample of the biological material to the requester or the expert, as applicable. The EPO is exempted from verifying and assessing the expert's suitability and independence (OJ EPO 2017, A60).

After certification, the EPO will send the request to the depositary institution and copies to the applicant or proprietor of the European patent and to the certified party. It is up to the certified party to pay the fees requested by the recognised depositary institution direct to them.

5. Applications relating to nucleotide and amino acid sequences

Rule 57(j)
Rule 30(1)
Rule 30(2)
Art. 123(2)

If nucleotide and amino acid sequences within the meaning of Rule 30(1) are disclosed in the European patent application, they are to be represented in a sequence listing which conforms to the applicable WIPO standard. Each nucleotide or amino acid sequence which extends over the minimum length as defined in the standard and which is disclosed in the application documents (including drawings) needs to be listed in the sequence listing, even if the sequence is only a fragment of another disclosed sequence. The sequence listing should, where it is filed together with the application, be placed at the end of the application. The sequence listing must be filed in electronic form. Where the European patent application is filed online, the electronic sequence listing in the required format is to be attached. The sequence listing must not be filed on paper or in PDF format. However, if it is, the sequence listing on paper or in PDF format must be identical to that in electronic format. In this case, the applicant or the appointed representative must submit a statement of identity, even though the sequence listing on paper or in PDF format will be disregarded in the further procedure. See the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372, and the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542.

Attention is drawn to new WIPO Standard ST.26 for sequence listings that will apply to applications filed on and after 1 July 2022. Detailed information on the changes in practice required by this new standard will be published in the Official Journal of the EPO well in advance.

Where a sequence listing is filed or corrected after the filing date, the applicant is required to submit a statement that the sequence listing so filed or corrected does not include matter which goes beyond the content of the application as filed. Sequence listings filed subsequent to the date of filing are not part of the description and, therefore, not published with the European patent application.

For applications referring to sequences which belong to the prior art see F-II, 6.1.

For the purposes of publication and file inspection, standard-compliant sequence listings submitted on the date of filing in TXT format are converted by the EPO. If, due to its excessive volume, a sequence listing cannot be included in the electronic file in converted form, the electronic file will refer to this technical limitation and to the option of obtaining a copy of the sequence listing in electronic form on written request (see the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542, and the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372).

Art. 90(3)
Rule 30(3)

The Receiving Section will inform the applicant of any deficiencies as to the sequence listing or as to the necessary statements and issue an invitation to remedy the deficiencies and pay a late furnishing fee within a non-extendable period of two months. The late furnishing fee compensates for the administrative efforts of issuing the communication under Rule 30(3) and delaying the transmission of the application to the search division until

after availability of a standard-compliant sequence listing. The late furnishing fee therefore does not have to be paid if the standard-compliant sequence listing is filed after the date of filing but before the Receiving Section has issued the communication under Rule 30(3). If the requirements of Rule 30 in conjunction with the Decision of the President of the EPO dated 28 April 2011 are not complied with in due time, where appropriate following the invitation to do so from the Receiving Section, which includes the payment of the late furnishing fee, the application will be refused according to Rule 30(3). This also applies if a sequence listing is subsequently filed in the required electronic format but still contains deficiencies with respect to the Standard. Such deficiencies will not prompt the EPO to issue another invitation under Rule 30(3), triggering a new period of two months, unless the previous invitation did not draw the applicant's attention to such remaining deficiencies (see J 7/11).

The applicant may request further processing of the application (see E-VIII, 2). *Art. 121* *Rule 135*

5.1 Sequence information filed under Rule 56

The possibility of filing a sequence listing as a missing part of the description is, as a rule, limited to very rare conditions. The principle of Rule 56 is that it must be obvious from the application documents as filed that part of the description appears to be missing (see A-II, 5.1). Very few cases fulfil the conditions for parts of the description being missing in the form of a sequence listing. Rule 56, for example, is applicable where the description quotes sequence identifier numbers (SEQ ID Nos.) but the sequences are not further disclosed in the description. Although in such case the disclosure is missing in the form of a sequence listing, the Receiving Section is not expected to identify such omissions as qualifying for Rule 56, and according to Rule 56(1) the applicant may not invoke the non-issuance of a communication under Rule 56(1) or (2). However, applicants may file the missing parts of the description relating to sequences of their own motion within two months of the date of filing according to Rule 56(2) (see A-II, 5.2).

According to Rule 57(j), any late-filed sequence information will be checked for compliance with Rule 30(1) in conjunction with the rules laid down by the President of the EPO.

If the late-filed sequence information or sequence listing does not conform to the requirements of Rule 30(1) in conjunction with the rules laid down by the President of the EPO, then the communication under Rule 30(3) is sent to the applicant (see A-IV, 5).

If, on the other hand, the late-filed sequence information includes a standard-compliant sequence listing according to the requirements of Rule 30(1), no Rule 30(3) communication will be sent. In such a case the late furnishing fee under Rule 30(3) does not fall due.

The above applies regardless of whether or not the late-filed parts of the description result in a change of the date of filing (see A-II, 5.3) or if the late-filed missing parts can be based on the claimed priority, allowing the

original date of filing to be maintained (see A-II, 5.4). If, however, the late-filed parts of the description result in a change of the filing date, any communication according to Rule 30(3) which might be required will only be sent after the one-month period for the withdrawal of the late-filed parts has expired without the applicant having withdrawn them (see A-II, 5.5).

In the case where the applicant inserts a sequence listing into the description as a late-filed part of the description according to Rule 56, the sequence listing so added, whether standard-compliant or not, is considered part of the description on the date of filing (regardless of whether or not this has changed) and, consequently, is published with the European patent application.

The rare possibility to file a sequence listing as a late-filed missing part must, however, be clearly differentiated from those cases where the application as filed contains:

– the complete sequence information in the body of the description, but no standard-compliant sequence listing;

– a sequence listing which does not contain all sequences disclosed in the application documents;

– a sequence listing that does not comply with the applicable WIPO standard.

In such cases, Rule 30 applies and the applicant will be invited under Rule 30(3) to file a standard-compliant sequence listing.

5.2 Sequence listings of an application filed by reference to a previously filed application

Where the application is filed by reference to a previously filed application (see A-II, 4.1.3.1), and that previously filed application contained sequence listings on its date of filing, then those sequence listings form part of the application as originally filed. This is subject to the exception that, where the sequences only appear in the claims and not in the description or drawings of the previously filed application, and the applicant did not include the claims of the previously filed application in the reference, then those sequences are not included in the European application as originally filed and a sequence listing must be filed separately. If in such a case the sequence listing is filed on the date of filing of the European application, it is published with the European patent application.

A sequence listing complying with the applicable WIPO standard that was filed in the previously filed application after the date of filing is not part of the description (Rule 30(2)) and, therefore, not included in the reference to the description and any drawings under Rule 40(1)(c). Consequently, the applicant must file a standard-compliant sequence listing for the European patent application separately.

Where the previously filed application is not available to the EPO, it will not be possible to carry out the check according to Rule 57(j) on the

compliance of the sequence listing with Rule 30(1) until the applicant files the certified copy and any translation required, which must be done within two months of the date of filing (Rule 40(3)). If, after receipt of the certified copy and translation, where applicable, the examination by the Receiving Section reveals that the sequence listing contained therein does not comply with Rule 30(1) in conjunction with the rules laid down by the President of the EPO, the European Patent Office will send a communication according to Rule 30(3) inviting the applicant to correct any deficiencies and pay the late furnishing fee (see A-IV, 5).

If the previously filed application referred to is a European application or an international application filed with the EPO as receiving Office, and the sequence listing contained therein satisfied the requirements of Rule 30 or Rule 5.2 PCT **on its date of filing** then all the requirements of Rule 30(1) are satisfied automatically on the date of filing of the European application filed by reference to this application.

If the previously filed application was filed with any other office, the applicant will have to ensure that all the requirements of Rule 30(1), in conjunction with the rules laid down by the President of the EPO, are met. In particular, the applicant must consider that any electronic standard-compliant sequence listing filed on the date of filing of the previously filed application will in most cases not be part of the certified copy under Rule 40(3) issued by the filing office. This means that if the previously filed application referred to is not a European patent application or an international application filed with the EPO as receiving Office, even where it contains a written sequence listing conforming to the applicable WIPO standard, the applicant will still have to provide a standard-compliant sequence listing to the EPO and, where applicable, a statement that the information in electronic form is identical to the written sequence listing, in order to satisfy the requirements of Rule 30(1) in conjunction with the rules laid down by the President of the EPO. The same applies where the previously filed application was a European application or an international application filed with the EPO as receiving Office, but where one or more of the elements required to satisfy the requirements of Rule 30(1) or Rule 5.2 PCT in conjunction with the applicable WIPO standard were not present on the date of filing. If this is not the case, the procedure in A-IV, 5 will be followed (a communication under Rule 30(3) will be sent).

5.3 Sequence listings of a divisional application

As an independent European patent application, a divisional application must also satisfy the requirements of Rule 30 in conjunction with the decision of the President of the EPO dated 28 April 2011 on the filing of sequence listings, OJ EPO 2011, 372 (see G 1/05, reasons 3.1). Without prejudice to the requirements of Art. 76(1), second sentence, if a sequence listing is to form part of the description of the divisional application, it must be submitted together with the other documents making up the divisional application, unless reference is made to a previously filed application containing a sequence listing as part of the application (Rule 40(1)(c)). However, an applicant who has filed a standard-compliant sequence listing under Rule 30 with regard to the earlier application (parent application) is exempted from having to submit said sequence listing if it is intended to be

used for search purposes only (i.e. not as part of the description) in respect of the divisional application. At the request of the applicant when filing the divisional application (EPO Form 1001, Box 38.3) or in reply to a deficiency communication pursuant to Rule 30(3), the EPO will add a copy of the standard-compliant sequence listing filed in conjunction with the earlier application for search purposes only (i.e. not as part of the application) to the dossier on the divisional application (OJ EPO 2013, 542, see also A-IV, 5).

6. Conversion into a national application

Art. 135

The central industrial property office of a contracting state must apply the procedure for the grant of a national patent or another protective right provided for by the legislation of this state at the request of the applicant for or the proprietor of the European patent under the circumstances specified in Art. 135(1). If the request for conversion is not filed within the three-month period specified in Rule 155(1), the effect referred to in Art. 66 will lapse (i.e. the European application will cease to be equivalent to a regular national filing in the designated contracting states).

Art. 135(2)
Rule 155(2) and (3)

The request for conversion is to be made to the EPO, except where the application is deemed withdrawn pursuant to Art. 77(3); in this case the request is filed with the central industrial property office with which the application was filed. That office shall, subject to the provisions of national security, transmit the request directly to the central industrial property offices of the contracting states specified therein, together with a copy of the file relating to the European patent application. If the central industrial property office with which the application was filed does not transmit the request before the expiry of twenty months from the filing date, or if claimed, from the priority date, then Art. 135(4) applies (i.e. the effect of Art. 66 lapses).

Art. 135(3)
Rule 155(2)

If a request for conversion is filed with the EPO, it must specify the contracting states in which the application of national procedures is desired and be accompanied by a conversion fee. In the absence of the fee the applicant or proprietor is notified that the request will not be deemed to be filed until the fee is paid. The EPO transmits the request to the central industrial property offices of the specified contracting states accompanied by a copy of the files relating to the European application or patent.

Chapter V – Communications concerning formal deficiencies; amendment of application; correction of errors

1. Communications concerning formal deficiencies

After a formalities examination, the Receiving Section or, where appropriate, the examining division issues one or more communications to the applicant if the application is found to be formally defective, identifying all the particular requirements of the EPC which the application does not satisfy and, in the case of deficiencies which can be corrected, will invite the applicant to correct such deficiencies within specified periods (see A-III, 16). For the exceptional case where communications do not detail all deficiencies, see A-III, 16.1. The applicant will be notified of the consequences, e.g. application deemed withdrawn, priority right lost, which result from the deficiencies or failure to take appropriate action within due time.

In general, depending on the deficiency in question, either:

(i) a time limit will be specified by the EPO, subject to Rule 132, for meeting the objection, e.g. an invitation to supply the priority document or priority file number under Rule 59, or

(ii) a fixed time limit will apply, e.g. two months for correcting deficiencies under Rule 58.

For further details see E-VIII, 1. If a deficiency is not rectified within due time, then the legal effects that are envisaged will apply.

2. Amendment of application

2.1 Filing of amendments

Rule 58
Rule 137(1) and (2)
Art. 123(1) and (2)
Rule 68(4)

Prior to the receipt of the European search report the applicant may amend the application only if invited by the Receiving Section to remedy particular deficiencies, including the case where no claims are present in the application as originally filed, wherein the applicant must rectify this deficiency by filing a set of claims in response to a communication according to Rule 58 (see A-III, 15). After receipt of the European search report and before receipt of a first communication from the examining division, i.e. also during the period in which the application may still be with the Receiving Section, applicants may of their own volition amend the description, claims and drawings (Rule 137(2)). Furthermore, where a search opinion accompanies the search report under Rule 62(1), the applicant must respond to it by filing observations and/or amendments (see B-XI, 8 for details and exceptions to this requirement). However, the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (regarding the publication of claims thus amended in response to the European search report under Rule 137(2), see also A-VI, 1.3).

2.2 Examination of amendments as to formalities

Rule 58
Rule 137(1)

The Receiving Section examines amendments, filed before the receipt of the search report, for formal requirements. Such amendments must remedy the deficiencies notified by the Receiving Section. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies and this requirement makes it necessary for the Receiving Section to compare any amended description, claims and drawings with those originally filed. Where, for example, a fresh description is filed to replace an earlier description that was objected to on account of non-compliance with the physical requirements, the Receiving Section must compare both descriptions and the objection is not met until there is identity of wording. However, identity of wording with the application documents as originally filed is not a requirement for amendments rectifying the following deficiencies:

(i) filing at least one claim according to Rule 58, where no claims existed on filing (see A-III, 15) (these claims must still satisfy the requirements of Art. 123(2), but this check is carried out by the search and examining divisions);

(ii) the filing of missing parts of the description, or drawings according to Rule 56 (see A-II, 5).

Amendments which extend beyond the remedying of deficiencies and which are filed prior to receipt of the search report may be taken into consideration in the subsequent procedure provided that, on receipt of the search report, the applicants declare that they wish them to be maintained.

Examination as to formalities of amendments filed after the receipt of the search report and before the application is transferred to the examining division is the responsibility of the Receiving Section.

The procedure for effecting amendments is dealt with in H-III, 2.

3. Correction of errors in documents filed with the EPO

Rule 139

Linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. Requests for such corrections may be made at any time, provided that proceedings are pending before the EPO (see J 42/92). However, if the error to be corrected concerns items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction, the request for correction must be filed as soon as possible, and at least in time that it could be incorporated in the publication of the European patent application. With regard to correction of priority claims, specific provisions apply, with a view to protecting the interests of third parties, which allow the applicant to correct priority claims and lay down a time limit for doing so (see Rule 52(3) and A-III, 6.5.2). This ensures that corrected priority information is available when the application is published. The applicant can only correct the priority claim later than this date, in particular after publication of the application, under certain limited circumstances, where it is apparent on the face of the published application that a mistake has been made. See J 2/92, J 3/91 and J 6/91 as well as J 11/92 and J 7/94. Each of these

decisions indicated situations under EPC 1973 in which the correction of priority data too late for a warning to be published with the application could be allowed. These same situations apply *mutatis mutandis* under EPC 2000 to the acceptance of requests to correct priority claims after the end of the time limit according to Rule 52(3). Regarding correction of the date indicated for the previous filing, see also A-III, 6.6.

Rule 139, 2nd sentence

If the error is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else could have been intended than what is offered as the correction. Such a correction may be effected only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see G 3/89 and G 11/91; see also H-VI, 2.2.1). The documents to be considered in assessing whether or not the correction is allowable are those of the application as originally filed, including any late-filed missing parts of the description, or drawings filed according to Rule 56, regardless of whether this resulted in a change of the date of filing (see A-II, 5 *et seq*). However, claims filed after the filing date in response to an invitation according to Rule 58 (see A-III, 15) cannot be used in assessing the allowability of the request.

It is in particular not allowable to replace the complete application documents (i.e. description, claims and drawings) by other documents which the applicant had intended to file with the request for grant (see G 2/95). The examining division decides on the request for correction. If a request for correction is pending before termination of the technical preparations for publication, a reference to the request is published on the front page.

In the case of electronic filing of European patent applications, the technical documents (description, claims, abstract and drawings) may be attached in their original format, provided this format is one listed in the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42. Pursuant to this decision, these technical documents may also be attached in a format other than those listed, provided that the applicant informs the EPO, when filing the application, where the EPO can reasonably acquire the corresponding software. If, on the date of filing, the documents making up the European patent application are available both in the format provided by the EPO Online Filing software and in another admissible format in accordance with the above-mentioned decision, the documents in the latter format can also be used in order to determine whether a request for correction of the description, claims, or drawings is allowable.

Chapter VI – Publication of application; request for examination and transmission of the dossier to examining division

1. Publication of application

1.1 Date of publication

Art. 93(1)

The application is published as soon as possible after the expiry of a period of eighteen months from the date of filing or, where priority is claimed, from the earliest priority date. Upon request from the applicant, the application may, however, be published before that date, provided that the filing and search fees have been validly paid and there are no formal deficiencies in the application documents (see A-III, 1.1 and 16). If the application is in order for grant before expiry of the eighteen-month period, see C-IV, 7.1 and C-VI, 3.

If the applicant abandons the priority date, then the publication is deferred provided that the notification of the abandonment is received by the EPO before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day five weeks before the end of the eighteenth month from the date of priority, if priority is claimed, or from the date of filing, if the priority is abandoned or if no priority is claimed (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.1). The applicant is informed about the termination of the technical preparation for publication, and also of the publication number and intended publication date. Where the notification of abandonment of the priority is received after that time, publication, if it has not already taken place, takes place as if the priority date applied, although a notice as to the abandonment of the priority will appear in the European Patent Bulletin (see F-VI, 3.5). The same procedure is followed when the priority right is lost under Art. 90(5) (see A-III, 6.10).

1.2 No publication; preventing publication

Rule 67(2)

The application is not published if it has been finally refused or deemed withdrawn or withdrawn before the termination of the technical preparations for publication (see A-VI, 1.1). These preparations are considered terminated at the end of the day five weeks before expiry of a period of eighteen months from the date of filing or priority (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.1). The application is, however, published if, upon termination of the technical preparations for publication, a request for a decision under Rule 112(2) has been received but no final decision has yet been taken (see OJ EPO 1990, 455) or if there is a pending request for re-establishment of rights under Art. 122 and Rule 136(1).

If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed. The EPO will however try (in accordance with the principles of J 5/81) to prevent publication on a case-by-case basis if the stage reached in the publication

procedure permits this without undue effort (see Notice from the EPO dated 25 April 2006, OJ EPO 2006, 406).

Rule 15

The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80). EPO Form 1018, available for download from epo.org free of charge, ensures that the declaration fulfils the requirement to be unambiguous, also in respect of any conditions for withdrawal. Using this form for withdrawing the European patent application is therefore highly recommended (see also the Notice from the EPO dated 12 August 2019, OJ EPO 2019, A79). The applicant is bound by an effective declaration of withdrawal (see C-V, 11), but may make it subject to the proviso that the content of the application is not made known to the public. This takes into account the procedural peculiarity that the applicant who makes the declaration of withdrawal later than five weeks before the date of publication cannot know whether publication can still be prevented. However, neither the application nor the designation of a contracting state may be withdrawn as from the time a third party proves that they have initiated proceedings concerning entitlement and up to the date on which the EPO resumes the proceedings for grant (see also E-VIII, 8).

1.3 Content of the publication

Rule 68(1), (3) and (4)
Rule 20
Rule 32(1)

The publication must contain the description, the claims and any drawings as filed, including any sequence listing filed on the date of filing, and including any late-filed missing parts of the description, or drawings filed according to Rule 56 (see A-II, 5), provided that the latter were not subsequently withdrawn (see A-II, 5.5), and specify, where possible, the person(s) designated as the inventor(s). If the claims were filed after the date of filing according to the procedures explained in A-III, 15, this will be indicated when the application is published (Rule 68(4)).

The publication also indicates as designated contracting states all states party to the EPC on the date the application was filed, unless individual states have been withdrawn by the applicant before the termination of the technical preparations for publication. When a European application filed before 1 April 2009 is published, the states for which protection is actually sought may not yet be known, because the time limit under Rule 39(1) for paying the designation fees is still running. Those definitively designated – through actual payment of designation fees – are announced later in the Register of European Patents and the European Patent Bulletin (see Information from the EPO, OJ EPO 1997, 479). For European divisional applications, see A-IV, 1.3.4.

Rule 68(2) and (4)
Rule 66

The publication also contains any new or amended claims filed by the applicant under Rule 137(2), together with the European search report and the abstract determined by the search division if the latter are available before termination of the technical preparations for publication. Otherwise the abstract filed by the applicant is published. The search opinion is not published with the European search report (Rule 62(2)). It is however open to file inspection (see A-XI, 2.1). If the EPO has received a communication from the applicant under Rule 32(1) ("expert solution"), this too must be mentioned (see the Notice from the EPO dated 7 July 2010,

OJ EPO 2010, 498). Further data may be included at the discretion of the President of the EPO.

With the exception of documents which have to be translated, originals of documents filed are used for publication purposes where these documents meet the physical requirements referred to in A-VIII, 2; otherwise, the amended or replacement documents meeting these requirements are used. Application documents that are of such bad quality that any improvement would result in an extension of the subject-matter as originally filed are published as filed. Prohibited matter may be omitted from the documents before publication, the place and number of words or drawings omitted being indicated (see A-III, 8.1 and A-III, 8.2). Documents incorporated in an electronic file are deemed to be originals (Rule 147(3)).

Rule 139

If a request for correction under Rule 139 of errors in the documents filed with the EPO is allowed, it must be incorporated in the publication. If upon termination of the technical preparations for publication a decision is still pending on a request for correction of items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction, this must be mentioned on the front page of the publication (see the case law in A-V, 3), as must a request for correction of errors in the description, claims or drawings (see A-V, 3).

The correction of errors occurring in the process of publication of the European patent application can be requested at any time (see H-VI, 3). Complete republication of the application will take place where appropriate.

1.4 Publication in electronic form only

All European patent applications, European search reports and European patent specifications are published in electronic form only, on a publication server (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.3, and OJ EPO 2005, 126) which is accessible via the EPO website (epo.org).

1.5 Separate publication of the European search report

If not published with the application, the European search report is published separately (also electronically).

2. Request for examination and transmission of the dossier to the examining division

2.1 Communication

Rule 69(1) and (2)

The Receiving Section communicates to the applicant the date on which the European Patent Bulletin mentions the publication of the European search report and draws attention to the provisions with regard to the request for examination as set out in Art. 94(1) and (2) and Rule 70(1). In the unlikely event that the communication wrongly specifies a later date than the date of the mention of the publication, the later date is decisive as regards the time limit for filing the request for examination (see A-VI, 2.2 and C-II, 1) and also for responding to the search opinion (see B-XI, 8 and A-VI, 3) unless the error is obvious. In the communication, the applicant is also informed that the designation fee(s) must be paid within six months of

the date on which the European Patent Bulletin mentions the publication of the search report (see A-III, 11.2 and 11.3).

Rule 70a(1)

Where the time limit under Rule 70(1) is that within which the applicant must reply to the search opinion (i.e. where Rule 70(2) does not apply), the invitation under Rule 70a(1) is sent in a combined communication with the communication according to Rule 69(1) (see C-II, 3.3).

2.2 Time limit for filing the request for examination

Art. 94(1) and (2)
Rule 70(1)

The 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 for examination is not deemed to have been filed until the examination fee has been paid (see C-II, 1). If the applicant does not file the request for examination, including the payment of the examination fee, within the above time limit, then the procedure explained in A-VI, 2.3 applies.

Art. 78(1)(a)
Rule 41(1)

The mandatory request for grant form (EPO Form 1001) contains a written request for examination. To confirm the written request, the applicant only needs to pay the examination fee within the time limit under Rule 70(1).

Art. 11(a) RFees

Applicants may also pay the examination fee as from the date of filing and prior to receipt of the European search report. In that case the Receiving Section invites them pursuant to Rule 70(2) to indicate within six months from the date of the mention of the publication of the search report in the European Patent Bulletin whether they desire to proceed further with their application (see C-II, 1.1). If, after receipt of the European search report, the applicant decides not to pursue the application and does not react to the invitation pursuant to Rule 70(2), the application will be deemed withdrawn pursuant to Rule 70(3), and the examination fee will be refunded in its entirety (see A-VI, 2.5).

Point 6.1(c) AAD

If the applicant has filed an automatic debit order, the examination fee will normally be debited at the end of the six-month period. For cases in which the applicant wishes the application to be transmitted earlier to the examining division, see the AAD in Annex A.1 of Supplementary publication 5, OJ EPO 2017.

Rule 70(1)

The request for examination may not be withdrawn.

Regarding Euro-PCT applications entering the European phase, see E-IX, 2.1.4 and E-IX, 2.5.2.

2.3 Legal remedy

Art. 94(2)
Rule 112(1)

If the request for examination is not validly filed by paying the examination fee before expiry of the period under Rule 70(1), the application is deemed to be withdrawn and the applicant is notified accordingly. In response to this communication concerning loss of rights, the applicant can request further processing in accordance with Art. 121 and Rule 135 (see E-VIII, 2).

If the applicants have validly filed a request for examination before the European search report has been transmitted to them, the Receiving Section invites them according to Rule 70(2) to indicate within six months from the date of the mention of the publication of the search report in the European Patent Bulletin whether they desire to proceed further with their application. If they fail to respond to this request in time, the application is deemed to be withdrawn and the applicants are notified accordingly. In this case, the applicants may also avail themselves of the legal remedy under Art. 121 and Rule 135 (further processing of the application). Regarding reimbursement of the examination fee, see A-VI, 2.2 and A-X, 10.2.3. C-VI, 3 describes the procedure in respect of a categorical request for examination, as provided for in Rule 10(4), where the applicant waives the right to the communication according to Rule 70(2).

Rule 70(2) and (3)
Rule 112(1)
Art. 121

Regarding Euro-PCT applications entering the regional phase, see E-IX, 2.1.3 and E-IX 2.5.2.

2.4 Transmission of the dossier to the examining division

If the Receiving Section finds that the request for examination was filed in due time, or the desire to proceed further with the application was indicated in due time (Rule 70(2)), it transmits the application to the examining division. Otherwise, it will notify the applicant of the loss of rights which has occurred (see Rule 112(1)).

Art. 16
Art. 18(1)
Rule 10

The dossier as transmitted to the examining division contains the following:

(i) all documents filed in relation to the application, including priority documents, translations and any amendments;

(ii) any certificate filed in relation to display at an exhibition (see A-IV, 3) and any information furnished under Rule 31 when the application relates to biological material (see A-IV, 4);

(iii) the European search report, if applicable the search opinion, the content of the abstract as drawn up by the search division, and the internal search note, if any;

(iv) copies of documents cited in the search report, and two copies of the publication document(s);

(v) the applicant's response to the search opinion (see B-XI, 8) or to the WO-ISA, supplementary international search report or IPER prepared by the EPO (see E-IX, 3.2 and E-IX, 3.3.4); and

(vi) all relevant correspondence.

The Receiving Section will direct attention to any aspects of the application which require urgent attention by the examining division, e.g. any letters which have to be answered before the application is examined in its proper turn.

2.5 Refund of examination fee

Art. 11 RFees

The examination fee is refunded:

(i) in full if the European patent application is withdrawn, refused or deemed to be withdrawn before substantive examination has begun (Art. 11(a) RFees); or

(ii) at a rate of 50% if the European patent application is withdrawn after substantive examination has begun and

– before expiry of the (extended) time limit for replying to the first invitation under Art. 94(3) issued by the examining division proper or,

– if no such invitation has been issued, before the date of the communication under Rule 71(3) (Art. 11(b) RFees).

As concerns (i) above, this applies to all European patent applications which are withdrawn, refused or deemed to be withdrawn on or after 1 July 2016. As concerns (ii) above, this applies to all European patent applications for which substantive examination began on or after 1 November 2016 (see the Decision of the Administrative Council of 29 June 2016, OJ EPO 2016, A48). For all applications for which substantive examination began before that date, Art. 11 RFees as in force before 1 November 2016 continues to apply, which means that there will be no refund if the application is withdrawn, refused or deemed to be withdrawn at this stage of proceedings.

Communications under Art. 94(3) "issued by the examining division proper" (see also C-III, 4) are all communications indicating that the application does not meet the requirements of the EPC and referring to deemed withdrawal under Art. 94(4) in case the deficiencies are not duly remedied. These include the following: invitations under Rule 137(4), minutes of consultations by phone or in person, accompanied by an invitation to remedy deficiencies, communications relating to the 'completely contained' criterion pursuant to Rule 56(3), or summons to oral proceedings pursuant to Rule 115(1) to which a communication complying with the requirements of Art. 94(3) and Rule 71(1) is annexed. In contrast, communications addressing purely formal deficiencies and issued by formalities officers as part of the duties entrusted to them, even if issued on the basis of Art. 94(3), do not constitute communications under Art. 94(3) "issued by the examining division proper". Likewise, communications issued by the examining division itself on some other legal basis, such as Rule 164(2)(a), Rule 53(3) or Art. 124, have no bearing on the period for a withdrawal qualifying for the 50% refund (see the Notice from the EPO dated 30 June 2016, OJ EPO 2016, A49).

An applicant unsure whether substantive examination has begun and wanting to withdraw the application only if sure to receive the 100% refund may make withdrawal contingent upon the refund ("conditional" withdrawal). The date of the start of examination (C-IV, 7.1) is indicated by means of EPO Form 2095 in the public part of the dossier and is thus open

to file inspection in the European Patent Register after publication of the patent application. If EPO Form 2095 is not on file, substantive examination is deemed to have started on the date on which the first communication from the examining division proper is issued (e.g. a communication under Art. 94(3), Rule 71(3) or any other legal basis as mentioned above). Before publication, the EPO will provide the applicant with the relevant information upon request, or this information can be accessed electronically via the My Files service. For more details see OJ EPO 2013, 153.

2.6 Reduction in examination fee

Where applicants having their residence or principal place of business within the territory of a contracting state having an official language other than English, French or German and nationals of that state who are resident abroad make use of the options provided for under Art. 14(4), the examination fee is reduced under certain circumstances (Rule 6(3) to (7) in conjunction with Art. 14(1) RFees) (see A-X, 9.2.1 and 9.2.3).

Art. 14(4)
Rule 6
Art. 14(1) RFees

3. Response to the search opinion

The applicant is required to respond to the search opinion within the time limit under Rule 70(1) or, if a communication under Rule 70(2) is sent (see C-II, 1.1), within the time limit under Rule 70(2). If the applicant fails to respond to the search opinion on time, the application is deemed to be withdrawn (Rule 70a(3)). For more details see B-XI, 8.

Rule 70a

Chapter VII – Languages

1. Admissible languages on filing

1.1 General

European patent applications can be filed in any language. However, if filed in a language other than an official language of the EPO (English, French or German), a translation into one of the official languages must be filed within two months of the date of filing (Rule 6(1)). Although filing in any language is in principle possible, there may be limitations due to the applicable national law for applications filed at a central industrial property office or the competent national authority under Art. 75(1)(b).

Art. 14(1) and Art. 14(2) Rule 6(1)

In the case of applications filed in "an admissible non-EPO language" (see below in A-VII, 3.2), a reduction of the filing fee is allowed for certain categories of applicants (see A-X, 9.2.1 and A-X, 9.2.2).

Rule 6(3) to (7)

1.2 Filing by reference

Where the description is filed by reference to a previously filed application (see A-II, 4.1.3.1) and the latter is not in an official language of the EPO, the applicant must also file a translation into one of those languages within two months of the date of filing.

Rule 40(3)

1.3 European divisional applications; Art. 61 applications

European divisional applications must be filed in the language of the proceedings of the earlier (parent) application. Alternatively, if the earlier (parent) application was not in an official language of the EPO, the divisional application may be filed in the language of the earlier (parent) application. In this case a translation into the language of the proceedings of the earlier application must be filed within two months of the filing of the divisional application.

Rule 36(2)

The same applies to the filing of a new European patent application under Art. 61(1)(b).

Art. 61(2)

1.4 Invitation to file the translation

Where the translation is not filed in time, the EPO will invite the applicant to rectify this deficiency within a non-extendable period of two months. Failure to file the translation in due time in response to this invitation results in the application being deemed to be withdrawn under Art. 14(2), and in this case further processing is ruled out (see A-III, 14).

Art. 90(3) Rules 57 and 58

2. Language of the proceedings

The official language of the EPO (English, French or German) in which the application is filed, or into which it is subsequently translated, constitutes the "language of the proceedings".

Art. 14(3)

The language of the proceedings is the only language used by EPO departments in written proceedings on that application (see G 4/08).

Rule 3(2)

Where European patent applications are filed in one of the official languages of the EPO, or after they have been translated into one of them, the description, claims and drawings can only be amended in that official language, which is the language of the proceedings.

Any claims filed after the date of filing will need to be filed in the language of the proceedings.

Example: If an application is filed without claims in Japanese and is then translated into English, the claims will need to be filed in English. Subsequent amendments to the application will also have to the filed in English.

3. Derogations from the language of the proceedings in written proceedings

3.1 Parties' written submissions

Rule 3(1)

With the exception of amendments to the European patent application or European patent, any party may use any of the EPO's three official languages in written proceedings before the EPO.

3.2 Admissible non-EPO languages

Art. 14(3) and Art. 14(4)

Natural or legal persons having their residence or principal place of business within an EPC contracting state having a language other than English, French or German as an official language, and nationals of that state resident abroad, may file documents which have to be filed within a time limit in an official language of that state ("admissible non-EPO language"). For example, an Italian or Swiss applicant may file a reply in Italian to a communication from the examining division issued under Art. 94(3).

Rule 6(2)

A translation of a document filed in an admissible non-EPO language into an official language of the EPO must be filed within a non-extendable period of one month (Rule 6(2)). However, if the document is a notice of opposition or appeal, or a petition for review (Art. 112a), the period extends to the end of the opposition or appeal period or the period for petition for review, if this period expires later. The translation can be into any of the EPO's official languages, regardless of the language of the proceedings.

3.3 Priority document

Rule 53(3)

Where the certified copy of the previous application whose priority is claimed (priority document) is not in an official language of the EPO, a translation into one of those languages need only be filed at the invitation of the EPO. This invitation is issued only where the validity of the priority claim is relevant to determining the patentability of the invention concerned. The translation may be replaced by a declaration that the European patent application is a complete translation of the previous invention.

See A-III, 6.8 for more information on the translation of priority documents.

3.4 Documents filed as evidence

Documents which are to be used as evidence may be filed in any language. This applies to all proceedings before the EPO and, especially, to publications (for instance, an extract from a Russian periodical cited by an opponent to show lack of novelty or lack of inventive step). However, the department dealing with the case may require a translation of the document or relevant parts thereof in one of the official languages of the EPO, at the choice of the person filing the document. If the document is filed by the applicant in pre-grant proceedings, the EPO should require a translation of the document or relevant parts thereof, unless the examiners are fully competent in the language concerned. In opposition proceedings the same principles apply, taking into account the interests of all parties. The time limit for filing the translation will be specified by the competent EPO department on a case-by-case basis. It will depend on the particular language concerned and on the length of the document or relevant parts thereof, taking into account the provisions of Rule 132 (see E-VIII, 1.2). If the required translation is not filed in due time, the EPO may disregard the document in question.

Rule 3(3)

3.5 Third-party observations

Third-party observations (E-VI, 3) must be filed in writing and in one of the EPO's official languages. Supporting documents, e.g. prior-art citations, can be written in any language.

Rule 114(1)

If the third-party observations and/or prior art are not in an official language of the EPO (Art. 14(1) EPC), the EPO may invite the third party, if identifiable, to submit a translation of the observations and, where appropriate, of the cited prior art in an official language within a period according to Rule 132.

4. Derogations from the language of the proceedings in oral proceedings

This subject is dealt with in E-V.

Rule 4

5. Documents filed in the wrong language

Documents making up the European patent application can only be filed in the wrong language on the occasion of its amendment, since the application can originally be filed in any language (see A-VII, 1.1). In such a case, as well as if any other document is not filed in the prescribed language or any required translation is not filed in due time, the document is deemed not to have been filed. The person who has filed the document will be notified accordingly by the EPO. Even though deemed not to have been filed, the document concerned will become part of the file and therefore accessible to the public according to Art. 128(4).

Art. 14(1)

In the event of failure to file a translation of the filed documentary evidence upon invitation in due time, the documents in question may be disregarded by the EPO.

Rule 3(3)

Where submissions accompanying the performance of a procedural act subject to a time limit (e.g. filing the designation of the inventor, filing a certified copy of the earlier application for which priority is claimed or filing

the translation of the priority document under Rule 53(3)) are not filed in an official language of the EPO, they will be included in the file without note being taken of their content.

Rules 79(1) and 114(2)

Observations by third parties and notices of oppositions will be communicated to the applicant or the patent proprietor even if they are deemed not to have been filed.

6. Languages of publication

Art. 14(5) and (6)

European patent applications are published only in the language of the proceedings, whereas specifications of European patents are published in the language of the proceedings together with translations of the claims in the other two official languages.

7. Correction and certification of the translation

Art. 14(2)

Any error in the translation filed can be corrected at any time during proceedings before the EPO, i.e. during pre-grant proceedings and also during opposition proceedings, bringing the translation into conformity with the application as filed in the original language (e.g. with the originally filed Japanese-language application). This applies similarly to translations filed for Euro-PCT applications upon entry into the European phase (see E-IX, 2.1.2). However, correction of the translation during opposition proceedings will not be allowed if it contravenes Art. 123(3), i.e. if it implies an amendment of the claims which extends the protection conferred.

Rule 7
Art. 70(2)

Unless evidence is provided to the contrary, the EPO will assume, for the purposes of determining whether the subject-matter of the European patent application or European patent extends beyond the content of the application as filed (Art. 123(2)), that the translation filed under Art. 14(2) or Rule 40(3) is in conformity with the original text of the application (e.g. in Japanese). The text of the application as filed however remains the basis for determining the allowability of amendments under Art. 123(2) or the content of the disclosure for the purposes of Art. 54(3) (see G-IV, 5.1).

Rule 5

The EPO has the discretion to require the filing of a certificate that a translation supplied corresponds to the original text, within a period to be specified (see E-VIII, 1.2 and E-VIII, 1.6). An invitation to file the certificate may only be made where the EPO has serious doubts as to the accuracy of the translation. Failure to file the certificate in due time will lead to the document being deemed not to have been received unless the EPC provides otherwise. This partial loss of rights is subject to further processing under Art. 121 and Rule 135.

Certification is not in principle required in respect of the translations of the claims into the other two official languages required under Rule 71(3).

8. Authentic text of the application or patent

Art. 70(1)
Art. 14(8)

The text of an application or patent in the language of the proceedings is the authentic text. It therefore follows that the translation of the claims of the patent specification required by Art. 14(6) is for information only.

Chapter VIII – Common provisions

1. Representation

1.1 General principles

Subject to the next sentence, no person may be compelled to be represented by a professional representative in proceedings before the EPO; this holds for all parties to such proceedings, e.g. applicants, proprietors, opponents. A party (natural or legal person) who has neither residence nor principal place of business in a contracting state must be represented by a professional representative; the party must act through a professional representative in all proceedings, other than in filing the application (which includes all acts leading to the assignment of a date of filing) or initiating the European phase within the applicable time limit (see E-IX, 2.3.1). To "be represented" is to be interpreted as meaning due representation, including not only notice of the appointment of a professional representative but also, where applicable, the filing of authorisations of the appointed representative (see A-VIII, 1.6).

Art. 133(1) and Art. 133(2) Art. 90(3) Rule 152

Parties having their residence or principal place of business in a contracting state may also act directly before the EPO, even if they have appointed a professional representative (see A-VIII, 1.2), an employee (see A-VIII, 1.3) or a legal practitioner (see A-VIII, 1.5) to act on their behalf. When conflicting instructions are received from parties and their representative, each will be advised of the other's action.

Should opponents who are party to the proceedings and do not have either residence or principal place of business within the territory of one of the contracting states fail to meet the requirement set out under Art. 133(2) in the course of the opposition procedure (e.g. the representative withdraws from the opposition case or the appointed representative is deleted from the list of professional representatives), they are requested to appoint a new representative. Irrespective of whether they do so, the EPO will nevertheless inform opponents of the date and location of any oral proceedings and draw to their attention that if they appear only by themselves they are not entitled to act before the division.

1.2 Representation by a professional representative; list of professional representatives

Representation of natural or legal persons in proceedings before the EPO may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO. See, however, also A-VIII, 1.5. The Legal Division has sole responsibility for entries in and deletions from the list of professional representatives (see Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). A group of professional representatives registered with the EPO under the name of an association may be appointed collectively to represent a party under that name (see OJ EPO 2013, 535). In such a case, each member of the association may perform procedural acts on behalf of the party, while correspondence from the EPO, according to Rule 130, is addressed to the association rather than one particular member. Parties are recommended

Art. 134(1)

to clearly specify whether they wish to appoint the association or an individual representative belonging to that association (see also A-VIII, 1.7).

1.3 Representation by an employee

Art. 133(3)
Art. 134(1)
Rule 152

Parties having their residence or principal place of business in a contracting state are not obliged to be represented by a professional representative in proceedings before the EPO. They may, irrespective of whether they are legal or natural persons, act through an employee, who need not be a professional representative but who must be authorised (see A-VIII, 1.6, and A-VIII, 1.7).

1.4 Common representative

Art. 133(4)
Rule 151(1) and (2)

Joint applicants, joint proprietors of patents and more than one person giving joint notice of opposition or intervention may act through a common representative. If the request for the grant of a European patent, the notice of opposition or the request for intervention does not name a common representative, the party first named in the relevant document will be considered to be the common representative. The common representative can thus be a legal person. However, if one of the parties is obliged to appoint a professional representative and has done so, this representative will be considered to be the common representative acting on behalf of all parties. In such a case, no other party can act as common representative. However, if the first named party in the document has appointed a professional representative, that representative will be considered to be acting on behalf of all parties. If the European patent application or patent is transferred to more than one person, and such persons have not appointed a common representative, the preceding provisions will apply. If such application is not possible, the EPO will require the parties to appoint a common representative within a two-month period specified by the EPO (see E-VIII, 1.6). If this request is not complied with, the EPO will appoint the common representative.

For Rule 151 to apply, each party or their duly authorised representative must have signed the document (request for grant, notice of opposition, etc.) giving rise to their participation (see also A-III, 4.2.2 and A-VIII, 3.2 and 3.4). Otherwise the party cannot take part in the proceedings, nor therefore be represented by a common representative.

1.5 Representation by a legal practitioner

Art. 134(1) and
Art. 134(8)

Representation in proceedings under the EPC may also be undertaken in the same way as by a professional representative (see A-VIII, 1.2) by any legal practitioner qualified in one of the contracting states and having their place of business within such state, to the extent that they are entitled, within the said state, to act as a professional representative in patent matters. Legal practitioners entitled to act as representatives before the EPO are not entered on the list of professional representatives (see J 18/99). However, they are registered in an internal database administered by the Legal Division (see OJ EPO 2013, 600).

1.6 Signed authorisation

Rule 152

Representatives acting before the EPO must on request file a signed authorisation (see A-VIII, 3.2) within a two-month period specified by the

EPO (see E-VIII, 1.6). Both individual and general authorisations within the meaning of Rule 152(4) serve the same purpose. For general authorisations, the indication of the registration number is equivalent to the filing of the authorisation itself. The filing of an authorisation is distinct from the appointment of a representative for a specific case. If the requirements of Art. 133(2) are not fulfilled, the same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation.

Professional representatives who identify themselves as such will be required to file a signed authorisation only in certain cases, in particular if there is a change of representative (see Art. 1(2) of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1). No authorisation is required where a professional representative other than the appointed one (and not being a member of the same association or law firm) performs a procedural act on behalf of a party to proceedings, e.g. filing a reply to the communication under Rule 71(3), provided that it is apparent from the submission that the professional representative is acting at the request of that party without the intention to take over representation. In case of doubt as to a professional representative's entitlement to act on behalf of a party, the EPO may require the filing of an authorisation (see Art. 1(3) of the above-mentioned decision).

However, a legal practitioner entitled to act as a professional representative in accordance with Art. 134(8) or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, must always file a signed authorisation (see Art. 2 and Art. 3 of the above-mentioned decision) to be in a position to validly perform procedural acts. In Euro-PCT proceedings, persons representing clients in these capacities are not required to file signed authorisations if they have already filed an authorisation expressly covering proceedings established by the EPC with the EPO as receiving Office, ISA or IPEA. Where a representative is appointed to act on behalf of the applicant in several of that party's applications, it is not necessary to file an individual authorisation for each application (see A-VIII, 2.4). A clear indication of the applications concerned is sufficient; the EPO will make sure that a copy of the authorisation is included in all of the files concerned.

The authorisation can also be filed by the applicant. This also applies where the applicant is obliged to be represented, as fulfilling the requirement to be represented is not itself a procedural step under Art. 133(2) to which the rule of obligatory representation applies.

An association of representatives can be authorised to represent a party before the EPO within the meaning of Art. 134(1) (Rule 152(11)). A party appointing several representatives can authorise them collectively as an association instead of having to authorise each of them individually, provided that the association in question is registered with the EPO (OJ EPO 2013, 535). Where invited to file an authorisation by way of an exception, a reference to that registration number in the authorisation will suffice.

An authorisation remains in force until its termination is communicated to the EPO. Transfer of representation or termination of authorisation can, subject to certain conditions, be effected electronically by the representative using the My Files service (see the Decision of the President of the EPO dated 26 April 2012, OJ EPO 2012, 352). The authorisation will not terminate upon the death of the person who gave it unless the authorisation provides to the contrary (Rule 152(9).

1.7 General authorisation

Art. 133(2) Rule 152(2), (4), (7), (8) and (9)

An authorisation may cover more than one application or patent. Also, a general authorisation enabling a representative to act in respect of all the patent transactions of the party making the authorisation may be filed. A corresponding procedure applies to the withdrawal of an authorisation.

However, the filing of a general authorisation is distinct from the appointment of a representative for a specific case. The party granting a general authorisation is not bound to appoint one of the representatives listed therein in any specific procedure before the EPO. Nor does a general authorisation allow the EPO to assume, without any additional information, that a person listed therein should be appointed as a representative in a specific case (see J 17/98). Therefore, in a specific case, a party wishing to appoint the representative(s) listed in a general authorisation must notify the EPO accordingly by referring to the general authorisation number already registered.

1.8 Invitation to file authorisation and legal consequence in case of non-compliance

Rule 152(2) and (6) Rule 132

Where the appointment of a legal practitioner entitled to act as professional representative in accordance with Art. 134(8), or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, is communicated to the EPO without an authorisation being filed, the representative is invited to file the authorisation within a two-month period specified by the EPO (see E-VIII, 1.6). Where a party having neither residence nor principal place of business within a contracting state has failed to fulfil the requirements of Art. 133(2) (see A-VIII, 1.1), the invitation will be sent directly to the party concerned. The same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. The period may be extended in accordance with Rule 132 on request by the representative or party as the case may be (see E-VIII, 1.6). If such authorisation is not filed in due time, any procedural steps taken by the representative other than filing a European patent application or initiating the European phase within the applicable time limit (see E-IX, 2.3.1) will, without prejudice to any other legal consequences provided for in the EPC, be deemed not to have been taken. The party is informed accordingly.

2. Form of documents

2.1 Documents making up the European patent application

The physical requirements which the documents making up the European patent application, i.e. request, description, claims, drawings and abstract, must satisfy are set out in Rule 49 and with regard to drawings in Rule 46.

In particular, when amending the application documents, amendments must be typed. Any submissions containing handwritten amendments to application documents – unless they involve graphic symbols and characters and chemical and mathematical formulae – are a formal deficiency under Rules 49(8) and 50(1). The President of the EPO may lay down further special formal or technical requirements for the filing of documents, in particular with regard to the filing of documents by means of electronic communication (Rule 2(1)). Notes on the preparation of OCR-readable patent applications were published in OJ EPO 1993, 59. In relation to the drawings, the particular requirements are dealt with in A-IX. The latter Chapter should, however, also be consulted with regard to the other documents mentioned, as the comments therein on the provisions of Rule 49 are of general application. Here, attention need only be drawn to Rule 49(7) which states that "the lines of each sheet of the description and of the claims shall preferably be numbered in sets of five, the numbers appearing on the left side, to the right of the margin".

2.2 Replacement documents and translations

Replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) or Rule 40(3) are subject to the same requirements as the documents making up the application. *Rule 49(1)* *Rule 50(1)*

2.3 Other documents

Documents other than those referred to in the previous paragraphs should be typewritten or printed with a margin of about 2.5 cm on the left-hand side of each page. *Rule 50(2)*

2.4 Number of copies

Documents relating to more than one application or patent (e.g. an individual or a general authorisation), or having to be communicated to more than one party, only need to be filed in one copy (see also A-VIII, 1.5). However, letters accompanying submitted documents (in particular EPO Form 1038) must be filed in one copy for each file to which the document they accompany relates.

For example, where two different applications share a common priority claim, the applicant only needs to file one copy of the priority document, but this must be accompanied by two different letters each relating to one or the other application (preferably two copies of Form 1038). Each letter (or EPO Form 1038) must be duly signed and indicate one or the other of the two application numbers in respect of which the priority document is being filed (see also A-VIII, 3.1).

2.5 Filing of subsequent documents

After a European patent application has been filed, documents as referred to in Rule 50 may be filed by delivery by hand, by postal services (see A-II, 1.1) or by means of electronic communication (see A-II, 1.2). These include filing by fax (see A-II, 1.2.1) and in electronic form by means of EPO Online Filing, Online Filing 2.0 and the EPO web-form filing service (see A-II, 1.2.2). Authorisations and priority documents are, however, excluded from filing by fax or using the EPO web-form filing service. For the means of filing accepted for priority documents, see A-III, 6.7. *Rule 2(1)*

The EPO web-form filing service must not be used to file any documents in respect of opposition, limitation and revocation proceedings as well as appeal proceedings and proceedings for review by the Enlarged Board of Appeal (see the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42).

If subsequent documents relating to European patent applications are filed by fax, written confirmation reproducing the contents of the documents filed by this means and complying with the requirements of the Implementing Regulations to the EPC must be supplied on invitation from the EPO within a period of two months from notification of that invitation. If the applicant fails to comply with this request in due time, the fax is deemed not to have been received (see the Decision of the President of the EPO dated 20 February 2019, OJ EPO 2019, A18).

Written confirmation is requested if the documents communicated by fax are of inferior quality.

Art. 14(4)
Rule 6(2)

If in a fax a party avails itself of Art. 14(4), the subsequent copy must be filed in the same language as the fax, in which case the copy is deemed to have been received on the date of filing of the fax. The period under Rule 6(2) for filing the translation under Art. 14(4) begins on the day following the date of filing of the fax.

Subsequent documents may not be filed on diskette or by email, telegram or similar means (see also the Notice dated 12 September 2000 concerning correspondence with the Office via email, OJ EPO 2000, 458). However, during telephone consultations and during interviews and oral proceedings held by videoconference, documents filed subsequently as referred to in Rule 50, including authorisations, must be filed by email (for more details see the Decision of the President of the EPO dated 13 May 2020, OJ EPO 2020, A71; see also E-III, 8.5.2).

3. Signature of documents

3.1 Documents filed after filing the European patent application

Rule 50(3)
Art. 133

All documents other than annexes filed after filing the European patent application must be signed by the person responsible. The principles of Art. 133 are that only the applicant or the authorised representative may act in the European patent grant procedure (see A-VIII, 1.6). Documents filed after filing the European patent application may therefore be effectively signed only by these persons.

Documents such as the priority document or the translation thereof must be accompanied by a cover letter or at least bear a note on the document itself that it is addressed to the EPO, duly signed by a person authorised to act before the EPO. This also applies, for example, to the designation of inventor if this has been signed by an applicant with neither residence nor principal place of business in one of the contracting states to the EPC. As regards the authorisation, see A-VIII, 1.6. The signature of the entitled person confirming performance of a written act of procedure helps to clarify the state of the proceedings. It shows whether the act of procedure has

been validly performed, and also prevents circumvention of the provisions relating to representation. EPO Form 1038 (Letter accompanying subsequently filed items) may also be used as a separate letter. A separate form must be used for each file (see the Notice from the EPO dated 8 November 1990, OJ EPO 1991, 64). The same applies when, instead of using EPO Form 1038, the applicant submits an accompanying letter with the document in question (see also A-VIII, 2.4). In the case of electronic filing, several documents for a file can be attached on a single Form 1038E.

EPO Form 1037 can be used for the subsequent filing, all at the same time, of items that relate to several applications, but without signature. EPO Form 1037 is only an acknowledgment. Its use is particularly recommended for subsequent filing of documents already bearing the required signature (such as replies to communications).

Rule 50(3)

If the signature is omitted on a document not falling within the meaning of A-VIII, 3.2, the EPO must invite the party concerned to sign within a fixed time limit. This also applies if the document in question bears the signature of an unentitled person (e.g. the secretary of an authorised representative), a deficiency which for the purposes of the time limits under way is treated as equivalent to omission of the signature of an entitled person. If signed in due time, the document retains its original date of receipt; otherwise it is deemed not to have been received. Likewise, documents filed electronically must be signed by an entitled person, although they may be transmitted using a smart card issued to another person. See also A-VIII, 3.2 below.

3.2 Documents forming part of the European patent application

In addition to the documents referred to in A-VIII, 3.1 above, certain documents forming part of the application must be signed. These documents include the request for grant, the designation of the inventor and, where applicable, the authorisation of a representative. In the case of electronic filing of a European patent application, a facsimile image of the signer's handwritten signature, a text-string signature or an enhanced electronic signature may be used to sign the aforementioned documents (Art. 12 of the Decision of the President of the EPO dated 14 May 2021, OJ EPO 2021, A42).

With the exception of the authorisation of a representative, the documents may be signed by an authorised representative instead of the applicant.

3.3 Form of signature

A rubber stamp impression of a party's name, whether a natural or legal person, must be accompanied by a personal signature. Initials or other abbreviated forms will not be accepted as a signature. Where the party concerned is a legal person, a document may in general be signed by any person who purports to sign on behalf of that legal person. The entitlement of a person signing on behalf of a legal person is not checked by the EPO, except where there is reason to believe that the person signing is not authorised and in that case evidence of authority to sign should be called for.

Where a document is filed by fax, the reproduction on the facsimile of the signature of the person filing the document will be considered sufficient. The name and position of that person must be clear from the signature (see the Decision of the President of the EPO dated 20 February 2019, OJ EPO 2019, A18).

In the case of electronic filing of documents using EPO Online Filing, the signature may take the form of a facsimile signature, a text-string signature or an enhanced electronic signature. Where documents are filed using Online Filing 2.0 or the EPO web-form filing service, the signature may take the form of a facsimile signature or a text-string signature. A facsimile signature is a reproduction of the filing person's signature. A text string signature is a string of characters, preceded and followed by a forward slash (/), selected by the signatory to prove their identity and intent to sign. An enhanced electronic signature is an electronic signature issued or accepted by the EPO (see OJ EPO 2021, A42).

3.4 Joint applicants

Rule 151(1)

If there is more than one applicant (see A-VIII, 1.3), each applicant or their appointed representative must sign the request for grant and, where applicable, the appointment of the common representative. This also applies if one of the applicants is considered the common representative pursuant to Rule 151(1), first sentence. However, the common representative may sign the designation of inventor and all documents filed after the filing of the application pursuant to Rule 50(3). Authorisations on behalf of more than one applicant must be signed by all applicants.

Chapter IX – Drawings

This Chapter of the Guidelines deals with the requirements to be met by drawings contained in the application or patent. However, it should be noted that the comments on the provisions of Rule 49 apply generally to the documents making up the European patent application and documents replacing them.

Rule 49
Rule 50

1. Graphic forms of presentation considered as drawings

1.1 Technical drawings

All types of technical drawings are considered drawings within the meaning of the EPC; these include, for instance, perspectives, exploded views, sections and cross-sections, details on a different scale, etc. Drawings also cover "flow sheets and diagrams", under which are subsumed functional diagrams and graphic representations of a given phenomenon which express the relationship between two or more magnitudes.

Rule 46(3)

There are also other graphic forms of presentation which may be included in the description, claims or abstract, in which case they are not subject to the same requirements as drawings. The forms concerned are chemical and mathematical formulae and tables. These are dealt with in A-IX, 11. They may nevertheless be submitted as drawings, in which case they are subject to the same requirements as drawings.

Rule 49(9)

1.2 Photographs

The EPC makes no express provision for photographs; they are nevertheless allowed where it is impossible to present in a drawing what is to be shown and provided that they are directly reproducible and fulfil the applicable requirements for drawings (e.g. paper size, margins, etc.). Colour photographs can be submitted but will be scanned, printed and made available via file inspection only in black and white. If colours are necessary for discerning details of the photographs submitted, these details may be lost when the photograph is made available in black and white via publication and file inspection. See also A-IX, 7.1.

Photographs (or copies thereof) are to be numbered like drawings (Rule 46(2)(h)) and briefly described in the description (Rule 42(1)(d)).

2. Representation of drawings

2.1 Grouping of drawings

All drawings must be grouped together on the sheets specifically for drawings and may in no event be included in the description, claims or abstract, even if these finish at the top of a page or leave sufficient room, and even if there is only one figure.

Rule 49(9)

2.2 Reproducibility of drawings

In accordance with Rule 49(2) the drawings must be so presented as to admit of electronic as well as of direct reproduction by scanning,

Rule 49(2)

photography, electrostatic processes, photo offset and micro-filming, in an unlimited number of copies.

2.3 Figure accompanying the abstract

As regards the figure, or exceptionally figures, to accompany the abstract, where a European patent application contains drawings, reference should be made to A-III, 10.3 and F-II, 2.3 and 2.4. The figure(s) illustrating the abstract must be the figure(s) most representative of the invention and must be chosen from the drawings accompanying the application. It is therefore not permissible to draw a special figure for the abstract which differs from the other figures in the application.

3. Conditions regarding the paper used

Rule 49(3) In the case of paper filings, drawings must be on sheets of A4 paper (29.7 cm x 21 cm) which must be pliable, strong, white, smooth, matt and durable (recommended paper weight: 80-120 g/m^2, see OJ EPO 1994, 74).

Rule 49(2) All sheets must be free from cracks, creases and folds. Only one side of the sheet may be used. The use of card is not allowed.

Rule 49(12) Each sheet must be reasonably free from erasures and must be free from alterations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

Any corrections made must be durable and permanent, so that they cannot give rise to any doubt. Special products for corrections, such as white masking fluid, may be used, provided they are indelible and comply with the other requirements under Rule 49(12).

Rule 49(4) The sheets must be connected in such a way that they can easily be turned over, separated and joined together again.

Permanent fastenings (for example, crimped eyelets) are not permitted. Only temporary fastenings (staples, paper clips and grips, etc.), which leave only slight marks in the margin, may be used.

4. Presentation of the sheets of drawings

4.1 Usable surface area of sheets

Rule 46(1) On sheets containing drawings, the usable surface area may not exceed 26.2 cm x 17 cm. These sheets may not contain frames round the usable or used surface. The minimum margins are as follows: top side: 2.5 cm; left side: 2.5 cm; right side: 1.5 cm; bottom 1 cm.

4.2 Numbering of sheets of drawings

Rule 49(6) All the sheets contained in the European patent application must be numbered in consecutive Arabic numerals. These must be centred at the top of the sheet, but not in the top margin.

Rule 46(1) The sheets of drawings must be numbered within the maximum usable surface area as defined in Rule 46(1). Instead of numbering the sheet in

the middle, it will, however, be acceptable for it to be numbered towards the right-hand side if the drawing comes too close to the middle of the edge of the usable surface. This numbering should be clear, for example in numbers larger than those used for reference numbers.

Rule 49(6) requires all application sheets to be numbered consecutively. According to Rule 49(4), the application consists of all the following documents: the request, the description, the claims, the drawings and the abstract. The numbering should preferably be effected by using three separate series of numbering each beginning with one, the first series applying to the request only and being already printed on the form to be used, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable only to the sheets of the drawings and commencing with the first sheet of such drawings. *Rule 49(4)*

There are no objections to including the description, claims, abstract and drawings in one series of numbering beginning with one. The series of numbering must then commence with the first sheet of the description.

5. General layout of drawings

The various figures on the same sheet of drawings must be laid out according to certain requirements as to page-setting and numbering, and figures divided into several parts must comply with particular requirements.

5.1 Page-setting

As far as possible all figures of the drawings should be set out upright on the sheets. If a figure is broader than it is high, it may be set out so that the top and bottom of the figure lie along the sides of the sheet with the top of the figure on the left side of the sheet. *Rule 46(2)(h)*

In this case, if other figures are drawn on the same sheet, they should be set out in the same way, so that all the figures on a single sheet lie along parallel axes.

Where the sheet has to be turned in order to read the figures, the numbering should appear on the right-hand side of the sheet.

5.2 Numbering of figures

The different figures must be numbered consecutively in Arabic numerals, independently of the numbering of the sheets. *Rule 46(2)(h)*

This numbering should be preceded by the abbreviation "FIG", whatever the official language of the application. Where a single figure is sufficient to illustrate the invention, it should not be numbered and the abbreviation "FIG" must not appear. Rule 46(2)(d) also applies to numbers and letters identifying the figures, i.e. they must be simple and clear and may not be used in association with brackets, circles, or inverted commas. They should also be larger than the numbers used for reference signs. *Rule 46(2)(d)*

An exception to Rule 46(2)(h) referred to above may be permitted only as regards partial figures intended to form one whole figure, irrespective of

whether they appear on one or several sheets. In this case the whole figure may be identified by the same number followed by a capital letter (e.g. FIG 7A, FIG 7B).

5.3 Whole figure

Rule 46(2)(h)

Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures.

Partial figures drawn on separate sheets must always be capable of being linked edge to edge, that is to say no figure may contain parts of another.

The case may arise where the parts of a whole figure are drawn on a single sheet following a layout different from that of the whole figure, e.g. a very long figure divided into several parts placed one above the other and not next to one another on a sheet. This practice is permitted. However, the relationship between the different figures must be clear and unambiguous. It is therefore recommended that a scaled-down figure be included showing the whole formed by the partial figures and indicating the positions of the sections shown.

6. Prohibited matter

Rule 48(1) and (2)

The provisions as to the omission of prohibited matter within the meaning of Rule 48(1)(a) (see A-III, 8.1 and F-II, 7.2) also apply to drawings.

Rule 48(1)(c)

Statements or other matter of the type referred to under Rule 48(1)(c) (see F-II, 7.4) which are likely to appear in drawings are in particular various kinds of advertising, e.g. where the applicant includes in the drawing obvious business or departmental markings or a reference to an industrial design or model, whether registered or not. By doing so, matter would be introduced which is clearly irrelevant or unnecessary, which is expressly prohibited by Rule 48.

7. Executing of drawings

7.1 Drawings of lines and strokes

Rule 46(2)(a)
Rule 49(2)

Rule 46(2)(a) sets certain standards for lines and strokes in the drawing, to permit satisfactory reproduction by the various means described in Rule 49(2).

The drawings must be executed in black. Colour drawings can be submitted but will be scanned, printed and made available via file inspection in black and white only (see also A-IX, 1.2 in respect of colour photographs). In respect of the content of priority documents issued by the EPO in such a case, see A-XI, 5.2.

In all cases the thickness of the lines and strokes must take into account the scale, nature, execution and perfect legibility of the drawing and of the reproductions.

Rule 46(2)(e)

All lines must be drawn with the aid of drafting instruments save those for which no instrument exists, e.g. irregular diagrams and structures.

7.2 Shading

The use of shading in figures is allowed provided this assists in their understanding and is not so extensive as to impede legibility.

7.3 Cross-sections

7.3.1 Sectional diagrams

Where the figure is a cross-section on another figure, the latter should indicate the position and may indicate the viewing direction.

Each sectional figure should be capable of being quickly identified, especially where several cross-sections are made on the same figure, e.g. by inscribing the words "Section on AB", or to avoid the use of lettering, by marking each end of the cross-section line on the diagram with a single Roman numeral. This number will be the same as the (Arabic) numeral identifying the figure where the section is illustrated. For example: "Figure 22 illustrates a section taken along the line XXII-XXII of Figure 21".

7.3.2 Hatching

A cross-section must be set out and drawn in the same manner as a normal view whose parts in cross-section are hatched with regularly spaced strokes, the space between strokes being chosen on the basis of the total area to be hatched. *Rule 46(2)(b)*

Hatching should not impede the clear reading of the reference signs and leading lines. Consequently, if it is not possible to place references outside the hatched area, the hatching may be broken off wherever references are inserted. Certain types of hatching may be given a specific meaning.

7.4 Scale of drawings

If the scale of the figure is such that all the essential details would not be clearly distinguished if the figure is reproduced, electronically or photographically, with a linear reduction in size to two-thirds, then the figure must be redrawn to a larger scale, and if necessary the figure should be split up into partial figures so that a linear reduction in size to two-thirds is still intelligible. *Rule 46(2)(c)*

The graphic representation of the scale of drawings in cases where its inclusion is considered useful must be such that it is still usable when the drawing is reproduced in reduced format. This excludes indications of size such as "actual size" or "scale ½", both on the drawings and in the description, in favour of graphic representations of the scale.

7.5 Numbers, letters and reference signs

Numbers, letters and reference signs and any other data given on the sheets of drawings, such as the numbering of figures, pages of the drawing, acceptable text matter, graduations on scales, etc., must be simple and clear, and not used in association with any brackets, inverted commas, circles or outlines whatsoever. Signs such as 6' and 35" are not regarded as including inverted commas and are therefore permitted. *Rule 46(2)(d)*

Numbers, letters and reference signs should preferably all be laid out the same way up as the diagram so as to avoid having to rotate the page.

7.5.1 Leading lines

Leading lines are lines between reference signs and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference sign and extend at least as far as the features indicated.

Rule 46(2)(a)

Leading lines must be executed in the same way as lines in the drawing, viz. in accordance with Rule 46(2)(a).

7.5.2 Arrows

Arrows may be used at the end of the leading lines provided that their meaning is clear. They may indicate a number of points:

(i) a freestanding arrow indicates the entire section towards which it points;

(ii) an arrow touching a line indicates the surface shown by the line looking along the direction of the arrow.

7.5.3 Height of the numbers and letters in the drawings

Rule 46(2)(g)

Under Rule 46(2)(g), a minimum size of 0.32 cm is required for all numbers and letters used on the drawings so that their reduction in size to two-thirds remains easily legible.

The Latin alphabet should normally be used for letters. The Greek alphabet is to be accepted however where it is customarily used, e.g. to indicate angles, wavelengths, etc.

7.5.4 Consistent use of reference signs as between description, claims and drawings

Rule 46(2)(i)

Reference signs not mentioned in the description and claims may not appear in the drawing, and vice versa.

Reference signs appearing in the drawing must be given in the description and the claims taken as a whole. As regards use of these signs in the claims, reference should be made to F-IV, 4.19.

Rule 49(12)

Features of a drawing should not be designated by a reference in cases where the feature itself has not been described. This situation may arise as a result of amendments to the description involving the deletion of pages or whole paragraphs. One solution would be to strike out on the drawing reference signs which have been deleted in the description. Such corrections would have to be made in accordance with Rule 49(12).

Where for any reason a figure is deleted then of course the applicant or proprietor ought to delete all reference signs relating solely to that figure appearing in the description and claims.

In the case of applications dealing with complex subjects and incorporating a large number of drawings, a reference key may be attached to the end of the description. This key may take whatever form is appropriate and contain all the reference signs together with the designation of the features which they indicate. This method could have the advantage of standardising the terminology used in the description.

7.5.5 Consistent use of reference signs as between drawings

The same features, when denoted by reference signs, must, throughout the application, be denoted by the same signs. *Rule 46(2)(i)*

There would be considerable confusion if a single feature were allocated different reference signs in the various drawings. However, where several variants of an invention are described, each with reference to a particular figure, and where each variant contains features whose function is the same or basically the same, the features may, if this is indicated in the description, be identified by reference numbers made up of the number of the figure to which it relates followed by the number of the feature, which is the same for all variants, so that a single number is formed, e.g. the common feature "15" would be indicated by "115" in Fig. 1 while the corresponding feature would be indicated by "215" in Fig. 2. This system has the advantage that an individual feature and the figure on which it is to be considered can be indicated at the same time. It can also make complex cases involving many pages of drawings easier to read. Instead of the common reference sign being prefixed by the number of a figure, it may, when the individual variants are described with reference to particular groups of figures, be prefixed by the number of the particular variant to which it relates; this should be explained in the description.

7.6 Variations in proportions

Elements of the same figure must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure. *Rule 46(2)(f)*

As a preferred alternative to a difference in proportion within one figure for the purpose of achieving the necessary clarity, a supplementary figure may be added giving a larger-scale illustration of the element of the initial figure. In such cases it is recommended that the enlarged element shown in the second figure be surrounded by a finely drawn or "dot-dash" circle in the first figure pinpointing its location without obscuring the figure.

8. Text matter on drawings

It should first be noted that Rule 46(2)(d) and (g) also applies to text matter on the drawings. *Rule 46(2)(d) and (g)*

For indications of the type "section on AB", see A-IX, 7.3.1.

The drawings must not contain text matter, except, when absolutely indispensable, a single word or a few words. As flow sheets and diagrams are considered as drawings (see A-IX, 1.1), text must be kept to an absolute minimum. *Rule 46(2)(j)*

Where text matter is deemed indispensable for understanding the drawing, a minimum of words should be used, and a space free of all lines of drawings should be left around them for the translation.

As regards the justification for text matter on drawings, see F-II, 5.1.

9. Conventional symbols

Rule 49(10)

Known devices may be illustrated by symbols which have a universally recognised conventional meaning, provided no further detail is essential for understanding the subject-matter of the invention. Other signs and symbols may be used on condition that they are not likely to be confused with existing conventional symbols, that they are readily identifiable, i.e. simple, and providing that they are clearly explained in the text of the description.

Different types of hatching may also have different conventional meanings as regards the nature of a material seen in cross-section.

10. Amendments to drawings

Amendments of the drawings are permitted, as well as of the other documents. These amendments may be made at the request of the party concerned or at the request of the EPO. The amendments may concern either clerical errors or more substantial changes.

Amendments to drawings are, in general, subject to the same rules as apply in respect of amendments to other application documents and therefore do not require further analysis here. Reference may be made to A-III, 16, A-V, 2, B-XI, 8, C-III, 2, C-IV, 5, Part H, in particular H-II, 2 and H-III, 2.

Art. 123(2)

The general rule governing the admissibility of amendments, which the examiner must always bear in mind, is that they must not extend the content of the application as filed, i.e. they must not have the effect of introducing new material.

If drawings which depart substantially from the physical requirements laid down in the Rules are filed in order to establish a particular date of filing or retain a priority date, the Receiving Section will permit such drawings to be amended or replaced so as to provide drawings complying with the Rules, provided that it is clear that no new material is thereby introduced into the application. In view of this proviso, applicants should take care that any "informal" drawings which they file clearly show all the features necessary to illustrate the invention.

11. Graphic forms of presentation not considered as drawings

11.1 Chemical and mathematical formulae

Rule 49(8)

In exceptional cases, chemical or mathematical formulae may be written by hand or drawn if necessary, but it is recommended that appropriate aids such as stencils or transfers be used. For practical reasons, formulae may be grouped together on one or more sheets annexed to the description and paginated with it. It is recommended in such cases that each formula be

designated by a reference sign and the description should contain references to these formulae whenever necessary.

The chemical or mathematical formulae must employ symbols in general use and must be drawn in such a way that they are completely unambiguous. Figures, letters and signs which are not typed must be legible and identical in form in the various formulae, irrespective of the document in which they appear. *Rule 49(11)*

Chemical or mathematical formulae appearing in the text of the application or patent must have symbols, the capital letters of which are at least 0.21 cm high. Where they appear on sheets of drawings, these symbols must be at least 0.32 cm high. *Rule 49(8)* *Rule 46(2)(g)*

All mathematical symbols used in a formula which appears in a description, in an annex or on sheets of drawings must be explained in the description, unless their significance is clear from the context. In any case, the mathematical symbols used may be collated in a list.

11.2 Tables

11.2.1 Tables in the description

For the sake of convenience, the tables may also be grouped together in one or more sheets annexed to the description and paginated with it. *Rule 49(9)*

If two or more tables are necessary, each should be identified by a Roman number, independently of the pagination of the description or drawings or of the figure numbering, or by a capital letter, or by a title indicating its contents, or by some other means.

Each line or column in a table must begin with an entry explaining what it represents and, if necessary, the units used.

It should be remembered that the characters must satisfy the requirements of Rule 49(8) and that Rule 49(5) regarding the maximum usable surface areas of sheets applies to tables as well. *Rule 49(5) and (8)*

11.2.2 Tables in the claims

The claims may include tables if this is desirable in view of the subject-matter involved. In this case, the tables must be included in the text of the relevant claim; they may not be annexed to the claims nor may reference be made to tables contained in or annexed to the description. Rule 43(6) stipulates that the claims may refer to other application documents only where this is absolutely necessary (see F-IV, 4.17). The mere desire to eliminate the need to prepare further copies does not constitute absolute necessity. *Rule 49(9)*

Chapter X – Fees

1. General

Various fees have to be paid for a European patent application, renewing a European patent and obtaining legal remedies. Fees may also need to be paid by third parties, as is the case, for example, for the issue of certified copies of documents or the certified extract from the European Patent Register (see OJ EPO 2019, A15). Fees may be validly paid by any person. The amounts of the fees, the ways in which they are to be paid and the date of payment are determined in the Rules relating to Fees (RFees). Guidance for the payment of fees, expenses and prices with information about:

– the current version of the Rules relating to Fees and the schedule of fees;

– important implementing rules to the Rules relating to Fees;

– the payment and refund of fees and expenses;

– other notices concerning fees and prices; and

– international applications, including Euro-PCT applications entering the European phase,

as well as the amounts of the principal fees for European and international applications and an extract from the Rules relating to Fees is published at regular intervals in the Official Journal. Information relating to fees and methods of payment, including the EPO bank account for payments in euro, can also be found on the EPO website (epo.org) under: Applying for a patent/Fees.

The EPC and the Implementing Regulations thereto lay down the time limits for paying fees and the legal consequences of non-compliance with the time limits. The time limits for payment and the legal consequences of non-payment are dealt with in the Chapters of the Guidelines covering the respective stages of the procedure. The methods of payment, the date on which payment is considered to be made, due dates, particulars concerning the purpose of payments and reimbursement of fees are all dealt with below.

2. Methods of payment

Fees may be paid in the following ways: *Art. 5 RFees*

(i) by payment or transfer to a bank account held by the EPO;

(ii) by debiting a deposit account opened in the records of the EPO in Munich (see A-X, 4.2 and 4.3);

(iii) by credit card (see A-X, 4.4);

(iv) by requesting re-allocation of a refund (see A-X, 10.4).

3. Currencies

Art. 5 RFees
Point 1 ADA

The fees due to the EPO shall be paid in euro. A debit order shall be in euro.

4. Date considered as date on which payment is made

4.1 Payment or transfer to a bank account held by the European Patent Organisation

Art. 7(1), (3) and (4) RFees

The date on which the amount is actually entered in the European Patent Organisation's bank account is considered as the date on which payment is made. It is therefore possible for the day following the payment or transfer to be considered as the date on which payment is made or an even later date in the event of delays within the bank. However, payment may still be considered to have been made in due time, despite being paid late, if the payment or transfer has been effected before expiry of the time limit for payment in a contracting state and if evidence to this effect has been provided (see A-X, 6). For the steps required for the efficient processing of payments made by bank transfer, see the Notice from the EPO dated 13 July 2021, OJ EPO 2021, A61.

4.2 Deposit accounts with the EPO

4.2.1 General remarks

Art. 7(2) RFees

The Arrangements for deposit accounts (hereinafter abbreviated to "ADA") and their annexes are updated on a regular basis, either in their entirety or in part, whenever a change or clarification of the scope of practice is required. A consolidated version of the ADA was last published as Supplementary publication 4, OJ EPO 2019. The ADA can also be found on the EPO website (epo.org) under: Applying for a patent/Fees.

A distinction must be drawn, in connection with deposit accounts, between:

Point 3 ADA

(i) payments to replenish deposit accounts; and

Point 1 ADA

(ii) payments of fees in connection with proceedings under the EPC or the PCT.

4.2.2 Payments to replenish a deposit account

Point 3.2 ADA

Payments to replenish a deposit account are to be made in euro to the EPO bank account. Payments in a different currency will only be accepted if freely convertible. However, the deposit account will always be credited in euro (the only currency in which these accounts are kept) after conversion at the current rate of exchange.

Point 3.4 ADA

Repayments of deposit account balances can only be remitted to the deposit account holder. For this purpose, the deposit account holder must submit to the EPO a signed request containing all bank details necessary for the transfer.

4.2.3 Debiting the deposit account

Debiting occurs on the basis of an electronic debit order signed by the account holder or the authorised representative. The signature may take the form of a text string signature, a facsimile signature, an enhanced electronic signature or authentication with smart card if payment is made via Online Fee Payment or Central Fee Payment in Online services. The debit order may be a debit order for individual fees for one or more applications, i.e. a single or batch debit order, or an automatic debit order for a specific patent application (see A-X, 4.3). *Point 5.1.1 ADA*

The debit order for European patent applications must be filed in an electronically processable format (XML) via one of the following: *Point 5.1.2 ADA* *Point 5.1.3 ADA*

– EPO Online Filing using EPO Forms 1001E, 1200E, 2300E or 1038E; or

– Online Filing 2.0 using EPO Forms 1001E, 1200E or 1038E; or

– Online Fee Payment in Online services; or

– Central Fee Payment in Online services.

See also the Decision of the President of the EPO dated 13 July 2021, OJ EPO 2021, A60, and the Notice from the EPO dated 13 July 2021, OJ EPO 2021, A61.

Debit orders submitted in any other way, e.g. on paper, by fax, via the web-form filing service or using a different format such as a PDF attachment, are invalid and thus will not be carried out (for an exception, see A-II, 1.5).

If any of the accepted means of filing debit orders is unavailable at the EPO on the last day for paying a particular fee, the payment period will be extended to the first day thereafter on which all such means as are available for the type of application concerned can be accessed again. Payment periods are also extended in the event of a general unavailability of electronic communication services, or other like reasons within the meaning of Rule 134(5) (see the Notice from the EPO dated 22 October 2020, OJ EPO 2020, A120). *Rule 134(1) and (5)* *Point 5.5 ADA*

When using the EPO's online filing services, selecting "deposit account" as the method of payment is a specific requirement when wishing to pay any selected fees.

A debit order may specify that a payment order is to be executed at a later date than the submission date. In that case, the payment date is deemed to be the execution date specified. Payment orders with a deferred execution date may be executed up to 40 days after the submission date. *Point 5.4.1 ADA*

A debit order must be carried out notwithstanding incorrect information given in it, if the intention of the person giving the order is clear (see T 152/82). The EPO corrects a debit order of its own motion, for

example, if there is a discrepancy between the type of fee intended to be paid and the corresponding amount due on the date of receipt of the debit order (see also A-X, 7.1.2). The party is informed of any such correction by means of a communication from the EPO providing a two-month period for objecting to it in the event of disagreement by the party. In that case, the fee will be debited as indicated in the (erroneous) debit order or, if applicable, any corrective booking carried out will be reverted. The principles outlined above, however, do not allow the correction of a debit order by adding any fee that is not indicated in it, even if, according to the status of proceedings, that fee is due on the date of receipt of the debit order.

Points 6.1, 6.2, 6.3 ADA

A debit order may be revoked in whole or in part by signed written notice from the person making the payment, preferably sent to support@epo.org by email or a contact form via the EPO website (epo.org). For a notice of revocation of the debit order to be effective, it must be received by the EPO no later than the date on which the debit order is received. This also applies in case of a deferred payment date, irrespective of the execution date specified.

Point 5.3 ADA

Payments via deposit account effected in Online Fee Payment and Central Fee Payment are validated, meaning that the debit order for a fee is automatically rejected if the fee falls within one of the following categories:

– renewal fees and fees for the transfer of rights made in respect of patent applications for which the loss of rights or the refusal has become final;

– renewal fees for granted European patents;

– renewal fees received before the earliest valid payment dates under Rule 51(1); and

– double-payments for fees that can be paid only once in the proceedings before the EPO.

See the Decision of the President of the EPO dated 19 February 2019, OJ EPO 2019, A20, and the Decision of the President of the EPO dated 13 July 2021, OJ EPO 2021, A60.

4.2.4 Date of receipt of the debit order; insufficient funds

Point 5.4.1 ADA
Point 5.6.2 ADA

Provided that there are sufficient funds in the deposit account on the date of receipt of the debit order by the EPO or on the execution date, that date will be considered as the date on which the payment is made.

This is also applicable where a debit order is filed together with an application filed under Art. 75(1)(b) with a competent national authority of a contracting state (see A-II, 1.6). If the debit order is not received at the EPO until after expiry of the period allowed for payment of fees which can be paid on filing, that period is deemed to have been observed if evidence is available or presented to the EPO to show that the debit order was filed with the competent authority of the contracting state at the same time as

the application, provided that sufficient funds were available in the account at the time the period expired.

If, on the date of receipt of the debit order or on the date specified as the execution date (point 5.4.1 ADA), the account does not contain sufficient funds to fully cover all the fees indicated for an application (shortfall), the fees are booked in ascending order of fee codes, as long as the funds allow. Once a debit order cannot be executed in full due to insufficient funds, no other debit order is booked until the account is duly replenished. The outstanding payment is considered to have been made on the date on which the deposit account is duly replenished. On the application of the ten-day fail-safe arrangement in case of late receipt of the replenishment payment at the EPO, see A-X, 6.2.2.

Point 5.2.2 ADA
Point 5.2.3 ADA

4.3 Automatic debiting procedure

A deposit account may also be debited on the basis of an automatic debit order signed by or on behalf of the account holder (automatic debiting procedure), in accordance with the Arrangements for the automatic debiting procedure (abbreviated to "AAD"). The AAD plus explanatory notes are published as Annexes A.1 and A.2 to the ADA in Supplementary publication 4, OJ EPO 2019; see also OJ EPO 2020, A77 and A78. The AAD can also be found on the EPO website (epo.org) under: Applying for a patent/Fees.

Point 7 ADA
Point 1 AAD
Point 12.1 AAD

An automatic debit order must be filed on behalf of the applicant or the patent proprietor or the appointed representative in an electronically processable format (XML), using the EPO Online Filing software, Online Filing 2.0 or via Online Fee Payment in Online services. An automatic debit order can be revoked via Online Fee Payment in Online services only. It may be revoked only for the proceedings as a whole.

An automatic debit order extends to all types of fees covered by the automatic debiting procedure and payable in respect of the proceedings specified in it. As the proceedings progress, each such fee is automatically debited and treated as having been paid in due time provided that the deposit account contains sufficient funds. The automatic debit order may not be restricted to specific types of fees.

In the case of multiple payments from the same deposit account, the EPO processes automatic debit orders before any other debit orders.

Points 5.2.1 and 5.2.3 ADA

Subject to that, debit orders are booked in ascending order of application number ("PCT" before "EP"), unless otherwise indicated.

4.4 Payment by credit card

Credit card as a method of payment is available since 1 December 2017 (see OJ EPO 2017, A72). Payment by credit card must be made via Central Fee Payment in Online services available on the EPO website (epo.org), using a credit card accepted by the EPO (American Express, Mastercard and Visa). Payment by credit card is deemed to have been made on the date on which the transaction is approved. The EPO bears any transaction-related charges. The requirements and arrangements for

Art. 5 RFees, *Art. 7 RFees*

payments by credit card are set out in detail in the Notice from the EPO dated 23 September 2021 (see OJ EPO 2021, A73).

5. Due date for fees

5.1 General

5.1.1 Due date

Art. 4(1) RFees
Rule 51(1), 2nd sentence

In the EPC, the term "due date" has a special meaning, namely the first day on which payment of a fee may be validly effected, not the last day of a period for such payment (see A-X, 6, "Payment in due time"). The due date for fees is generally laid down by provisions of the EPC or of the PCT. If no due date is specified, the fee is due on the date of receipt of the request for the service incurring the fee concerned.

A fee may not be validly paid before the due date. The only exceptions to that principle are:

(i) renewal fees, which may be validly paid before the due date (see A-X, 5.2.4), and

(ii) voluntary payment of fees in response to the communication under Rule 71(3) (where amendments are also filed in response to that communication, see C-V, 4.2).

Payments made before the due date which are not valid may be refunded by the EPO. If payment is made shortly before the due date, it is possible that the EPO will not return the payment. In this case, however, payment only takes effect on the due date. This does not apply to payments via deposit account of renewal fees made before the earliest valid payment dates under Rule 51(1) EPC, see A-X, 5.2.4.

5.1.2 Amount of the fee

When the fees are generally increased, the date of payment is set as the relevant date for determining the amount of the fees (see Art. 2 of the Decision of the Administrative Council of 5 June 1992, OJ EPO 1992, 344). Setting the date of payment as the relevant date makes it unnecessary as a rule to ascertain the actual due date for determining the amount of the fee. Fees cannot validly be paid before the due date (apart from the exceptions mentioned in A-X, 5.1.1(i) and (ii)).

5.2 Due date for specific fees

5.2.1 Filing fee and search fee

The filing and search fees are due on the day the European patent application is filed. They must be paid either within one month from that date (Rule 38(1), Rule 17(2), Rule 36(3)) or, for Euro-PCT applications, within 31 months of the filing date or, where applicable, from the earliest priority claimed (Rule 159(1)(c) and (e)). Where fees are paid before expiry of the 31-month period and early processing is not explicitly requested (see E-IX, 2.8), they will be retained by the EPO on the assumption that the applicant indeed wishes to pursue the European-phase processing of the

application on expiry of the 31-month period. See A-III, 13.1. For the additional fees payable as part of the filing fee, see A-III, 13.2 and A-IV, 1.4.1.1.

5.2.2 Examination fee and designation fee

The examination fee is due when the request for examination is filed. Since the latter is contained in the prescribed form for the request for grant (EPO Form 1001), the examination fee may be paid straight away on the date of filing of the European patent application if the application is filed with said prescribed EPO Form 1001. It may be paid up to expiry of the period laid down in Rule 70(1), namely within six months of the date of the mention of the publication of the European search report in the European Patent Bulletin.

The designation fee falls due upon publication of the mention of the European search report. It may be paid within six months of the mentioned date of publication (Rules 39(1), 17(3) and 36(4)). Where paid before the due date, e.g. upon filing of the application, the designation fee will however be retained by the EPO. These payments will only be considered valid as from the due date, provided that the amount paid corresponds to the amount payable on the due date (see A-X, 5.1.2).

For Euro-PCT applications, see E-IX, 2.1.4.

5.2.3 Fee for grant and publishing

The fee for grant and publishing falls due on notification of the communication under Rule 71(3) requesting that this fee be paid. Under Rule 71(4), the same applies for claims fees, unless they were already paid under Rule 45(1) and (2) or Rule 162(1) and (2).

5.2.4 Renewal fees

Renewal fees for a European patent application in respect of the coming year are due on the last day of the month containing the anniversary of the date of filing of the European patent application. *Rule 51(1)*

According to Rule 51(1) as amended with effect from 1 April 2018 (OJ EPO 2018, A2), the renewal fee in respect of the third year may be paid up to six months before it falls due. All other renewal fees may not be validly paid more than three months before they fall due.

Example A:

15.11.2016	Filing date
31.05.2018	Earliest date for valid payment of third-year renewal fee under Rule 51(1)
30.11.2018	Due date for third-year renewal fee under Rule 51(1)
31.08.2019	Earliest date for valid payment of fourth-year renewal fee under Rule 51(1)
30.11.2019	Due date for fourth-year renewal fee under Rule 51(1)

Example B:

15.07.2016	Priority date
14.07.2017	Filing date
31.01.2019	Earliest date for valid payment of third-year renewal fee under Rule 51(1)
15.02.2019	Expiry of 31-month period for the performance of all acts required under Rule 159(1)
31.07.2019	Due date for third-year renewal fee under Rule 51(1)
30.04.2020	Earliest date for valid payment of fourth-year renewal fee under Rule 51(1)
31.07.2020	Due date for fourth year renewal fee under Rule 51(1)

Renewal fee payments made before the permissible prepayment periods are not valid. If a debit order for a renewal fee is received via Online Fee Payment or Central Fee Payment before the earliest valid payment dates under Rule 51(1) EPC, it will be rejected at source by the validation functionality (see A-X, 4.2.3). If a payment is made too early either by filing a valid debit order via OLF and Online Filing 2.0 or by using any other payment method (i.e. bank transfer or credit card), the renewal fee will be refunded by the EPO according to the procedures laid down in A-X, 10.

Rule 51(2)
Rule 134

If the renewal fee has not been validly paid on or before the due date, it may still be validly paid within six months of the said date, provided that the additional fee is paid within this period. The additional fee can be paid until the last day of the sixth month following the month containing the anniversary of the date of filing (see J 4/91, reasons 2.7). This six-month period begins on the last day of the month referred to in Rule 51(1), first sentence, even if the circumstances described in Rule 134(1), (2) and (5) apply. Rule 134 is applicable to the calculation of the expiry of the six-month time limit for payment of the additional fee (see J 4/91, reasons 3.2). Whilst a notice draws the applicant's attention to the possibility under Rule 51(2) and Art. 2(1), item 5, RFees, the omission of such notification may not be invoked (see J 12/84 and J 1/89). For renewal fees for European divisional applications see A-IV, 1.4.3.

For Euro-PCT applications, if the renewal fee in respect of the third year would have fallen due earlier under Rule 51(1), it does not fall due until expiry of the 31st month, i.e. on the last day of the 31-month period under Rule 159(1). This deferred due date, and hence the expiry of another period (the 31-month period), forms the basis for calculating the additional period for payment of the renewal fee with an additional fee (see J 1/89, the principles of which apply). For example:

20.04.2016 (Wed)	Priority date
17.10.2016 (Mon)	Filing date
31.10.2018 (Wed)	Due date for third-year renewal fee under Rule 51(1)

20.11.2018 (Tue)	Expiry of 31-month period under Rule 159(1) = deferred due date for third-year renewal fee
20.05.2019 (Mon)	Last day for payment of the renewal fee (plus additional fee) since the six-month period under Rule 51(2) expires that day

If the applicant requests entry into the regional phase before the expiry of the 31-month period (see Art. 23(2) PCT and Art. 40(2) PCT), in order for the request to become effective the renewal fee in respect of the third year has to be paid if the fee has fallen due earlier under Rule 51(1). If the renewal fee is not paid on the date early processing is requested, the request for early processing will be effective only as from the date on which the renewal fee is paid (and all further requirements necessary on the latter date have been complied with) (see E-IX, 2.8).

Art. 86(1) and Art. 141(1)

The obligation to pay renewal fees terminates with the payment of the renewal fee due in respect of the (patent) year in which the mention of the grant of the European patent is published, see Art. 86(2). "Patent years" are calculated as from the date of filing of the application. The first patent year (Art. 86(1), Art. 141(1)) starts on the date of filing and ends on the same date of the following year. For the second and subsequent years, the patent year starts one day after the anniversary of the date of filing and ends on the same day as the date of filing of the following year.

Example of due date and time limits for payment:

15.12.2016 (Thu)	Priority date
02.07.2017 (Sun)	Filing date
31.01.2019 (Thu)	First day for validly paying third-year renewal fee (amended Rule 51(1); OJ EPO 2018, A2)
31.07.2019 (Wed)	Due date for third-year renewal fee under Rule 51(1)
31.01.2020 (Fri)	Last day for validly paying renewal fee plus additional fee (Rule 51(2)); see J 4/91, reasons 2.7
30.04.2020 (Thu)	First day for validly paying fourth-year renewal fee
31.07.2020 (Fri)	Due date for fourth-year renewal fee = last renewal fee to be paid to the EPO and last day for payment of this renewal fee without additional fee
04.11.2020 (Wed)	Mention of grant of the European patent in the European Patent Bulletin

Example of last renewal fee payable to the EPO:

21.01.2017 (Sat)	Filing date
22.01.2019 (Tue)	Start of third patent year
31.01.2019 (Thu)	Due date for third-year renewal fee (to be paid to the EPO)
31.10.2019 (Thu)	First day for validly paying fourth-year renewal fee

21.01.2020 (Tue)	Mention of grant of the European patent in the European Patent Bulletin
22.01.2020 (Wed)	Start of fourth patent year
31.01.2020 (Fri)	Due date for fourth-year renewal fee (no longer to be paid to the EPO; if already paid, to be refunded, see A-X, 10.1.1)

This means that, for the last renewal fee payable to the EPO, it is not the due date but the beginning of the respective patent year that is decisive. If the mention of the grant of the European patent is published on the anniversary of the date of filing, the renewal fee in respect of the next patent year, which has not yet begun, is no longer payable to the EPO but to the national authorities.

Rule 51(4) and (5)

Special provisions apply with regard to the due date for renewal fees in respect of cases where there is a successful request for re-establishment of rights under Art. 122 or a successful petition for review of a decision of the board of appeal under Art. 112a.

5.2.5 Claims fees

Claims fees are due upon the filing of the first set of claims, which may be the date of filing or which may occur later (see A-III, 9 and 15).

5.2.6 Fees for limitation/revocation, opposition, appeal, petition for review

All of these fees are due on the date that the document in question is filed (request for limitation, request for revocation, notice of opposition, notice of appeal and petition for review).

5.2.7 Fees payable for procedural and other requests

The fees necessary to be paid for procedural requests are due as provided for in the Implementing Regulations. These requests become effective by payment of the prescribed fee, which thus falls due on the date of filing of the request. This is the case, for example, for the fee for further processing (Art. 121, Rule 135(1), see also E-VIII, 2) and the fee for re-establishment of rights (Art. 122, Rule 136(1), see also E-VIII, 3). Similarly, the fees payable for other requests, such as the fee for the registration of transfers (Rule 22(2)) and the administrative fees laid down by the President of the EPO in accordance with Art. 3 RFees, for instance, for issuing a priority document (Rule 54) or a certificate for a European patent (Rule 74), fall due on the date of filing of the request.

6. Payment in due time

6.1 Basic principle

A fee is considered to have been paid in due time if the date of payment (see A-X, 4) fell on or before the last day of the relevant time limit – or the time limit extended pursuant to Rule 134.

6.2 Application of Art. 7(3) RFees and Art. 7(4) RFees

6.2.1 Requirements

Art. 7(3) and (4) RFees

If the payer provides evidence to the EPO that, within the period for payment of a given fee, they took in an EPC contracting state one of the following steps:

(i) effecting payment of the fee through a banking establishment; or

(ii) giving an order to a banking establishment to transfer the amount of the payment provided that there is a sufficient amount in the account on the date on which the time limit expires,

then they are considered to have observed the period for payment of the fee, even if the amount paid is received by the EPO after expiry of the period mentioned.

The EPO may request the person who made the payment to produce evidence, within a period to be specified by it, as to the date on which one of the conditions mentioned above was fulfilled in order for the period for payment of the fee to be considered observed.

6.2.2 Late replenishment of deposit accounts

Point 4.1 ADA

The conditions for considering a period for payment to have been observed even if the amount paid is received by the EPO after expiry of that period apply *mutatis mutandis* to payments to replenish deposit accounts. Hence, for the purpose of complying with a time limit for payment, the account is considered to have been replenished in time if the payer provides evidence that the steps referred to under A-X, 6.2.1(i) or 6.2.1(ii) to replenish the deposit account were taken before expiry of the payment period concerned.

6.2.3 Debit orders

For debit orders accompanying applications filed with a competent national authority, see A-II, 1.5 and A-X, 4.2.4.

6.2.4 Payment of fee at the normal fee rate

Where a fee can either be paid within a normal period at the normal fee rate or within the period for further processing with the requisite further processing fee, if the normal period for payment is considered to have been observed when applying Art. 7(3) RFees and Art. 7(4) RFees, the above-mentioned further processing fee need not be paid.

6.2.5 Amount of fee payable

As noted in A-X, 5.1.2, the amount of fee payable is always that applying on the date of payment (see also the transitional provisions in the Administrative Council decisions revising fees). Art. 7(3) and (4) RFees protects the applicant in the event of late payment from the legal consequences of expiry of the payment period, but not from the obligation to make up any differences resulting from an increase in the amount of fee in the meantime. For debit orders accompanying applications filed with a competent national office (Art. 75(1)(b)), see point 5.6.3 of the ADA (Supplementary publication 4, OJ EPO 2019).

6.2.6 Noting of loss of rights

Rule 112

If applicants who have been sent a communication under Rule 112(1) noting non-compliance with a time limit for payment claim that the payment was made in due time pursuant to Art. 7(1), (3) and (4) RFees, they must apply for a decision pursuant to Rule 112(2) and submit the requisite evidence.

7. Purpose of payment

7.1 General

7.1.1 Conditions for valid payment

There are two conditions for a fee payment to be valid:

(i) it must relate to pending proceedings; and

Art. 8 RFees

(ii) it must be made in due time, i.e. the date of payment (see A-X, 4) must be on or after the due date (see A-X, 5.1.1). In addition, for a time limit for payment to be deemed to have been observed, the full amount of the fee must have been paid in due time.

An essential condition for a valid payment to the EPO in the case of payment or transfer to the bank account held by the European Patent Organisation is that the amount is entered in that account. The payment is valid in respect of the amount entered. If an insufficient amount has been paid by mistake, it is not possible to rectify the error by having the shortfall paid subsequently deemed to be paid on the original date of payment. The same applies to payments made via credit card. Payment is a matter of fact whereby a certain amount is transferred to and put at the disposal of the EPO. It is not, therefore, a document filed with the EPO or a procedural declaration which may be corrected pursuant to Rule 139. However, the EPO may, where it is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment (Art. 8 RFees).

In the case of payment via deposit account the essential condition, in addition to those specified under points (i)-(ii) above, is that the debit order clearly specifies the purpose of payment by indicating the fee intended to be paid, thus authorising the EPO to debit the fee for this particular purpose. Furthermore, the EPO can only debit the full amount of the fee if there are sufficient funds in the deposit account. In respect of underpayments due to incorrect information given in a debit order, see A-X, 4.2.3. See also A-X, 7.1.2 concerning corrections of the purpose of payment.

7.1.2 Purpose of payment

Art. 6 RFees

A distinction must be drawn between these conditions for valid payment (see A-X, 7.1.1) and the indication of the purpose of the payment. Indication of the purpose of the payment serves to identify the proceedings for which the fee is intended (e.g. for fee payments, the application number) and the specific type of fee. If the purpose of the payments cannot immediately be established, the person making the payment will be

requested to communicate the purpose in writing within a specified period. If they comply with this request in due time, the payment and the original payment date remain valid. This is also the case when the clarification involves re-assigning the payment to another application. Otherwise the payment will be considered not to have been made. The boards of appeal have decided that if the purpose of the payment has evidently been given incorrectly, this deficiency is not prejudicial if the intended purpose can be established without difficulty from the remaining information. The inadvertent use of a fee by the EPO for a different purpose from that evidently intended by the person making the payment has no effect on the purpose intended by that person (see J 16/84). Similarly, a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear. Instructions to carry out the order must be given by the EPO department qualified to recognise what is clearly intended (see T 152/82).

In the case of changes to the purpose of payment not arising from Art. 6(2) RFees, the date of payment is the date of receipt of the request for the change.

7.2 Indication of the purpose of the payment in the case of designation fees

The following applies only to applications filed before 1 April 2009.

Art. 2(2), item 3, RFees
Art. 6(1) RFees

The designation fees are deemed paid for all contracting states upon payment of seven times the amount of one designation fee. Such payments simply need to be marked "designation fees" in order for the purpose of the payment to be established. If fewer than seven designation fees are paid and the payment agrees with the declaration in the appropriate section of the request for grant form (EPO Form 1001), payment should once again simply be marked "designation fees". However, if the payment differs from the intended payment as stated in the request form, the contracting states for which the payment is now intended should be indicated with the payment.

If there is no such indication and the amount paid is insufficient to cover all the contracting states mentioned in the appropriate section of the request form, the procedure under A-III, 11.3.7 applies.

If an automatic debit order has been issued (see the appropriate sections of EPO Form 1001), applicants must inform the EPO prior to expiry of the basic period under Rule 39(1) if they wish to pay designation fees for contracting states other than those indicated in the request form. If not, an amount equal to seven times the amount of one designation fee or the designation fees for the contracting states indicated in the request form is debited.

The same applies where EPO Form 1200 is used for entry into the European phase of a Euro-PCT application, if the application enters the regional phase before 1 April 2009.

7.3 Indication of the purpose of payment in the case of claims fees

7.3.1 Claims fees payable on filing the European patent application

Rule 45(1) If the applicant pays the claims fees for all the claims incurring fees, the indication "claims fees" suffices to identify the purpose of the payment. If the amount paid is insufficient to cover all the claims fees, the procedure under A-III, 9 applies.

7.3.2 Claims fees payable before the grant of the European patent

Rule 71(4) In the communication under Rule 71(3), the applicant may be requested to pay claims fees due before grant of the European patent. If the applicant fails to pay the fee for all the claims in due time, the application is deemed to be withdrawn (Rule 71(7)).

8. No deferred payment of fees, no legal aid, no discretion

The EPC makes no provision for deferring payment of fees (see J 2/78, reasons 3) or for granting legal aid. An indigent party still has the possibility of applying for legal aid from the competent national authority. However, the time limit for payment is not extended in such a case; a party claiming national legal aid must make the corresponding arrangements as early as possible so that they are in a position to pay the fee in due time. The EPO has also no discretion in waiving or refunding, without any legal basis, fees that have become due (see J 20/87).

9. Reduction of fees

9.1 General

Where a fee is reduced – in contrast to cases of fee refunds – the reduced rate may be paid instead of the full fee. The factual conditions for a reduction of the fee must be met on or before the day the period for payment expires.

9.2 Reduction under the language arrangements

9.2.1 Conditions

Art. 14(2) European applications can be filed in any language. If filed in a language other than an official language of the EPO, a translation must be furnished. Consequently, the languages which can be used for filing European applications fall into three categories:

(a) official languages of the EPO

(b) official languages of contracting states which are not official languages of the EPO, such as Dutch, Italian or Spanish (hereinafter "admissible non-EPO languages"), and

(c) all other languages, such as Chinese, Japanese or Russian.

Art. 14(4) Furthermore, documents which have to be filed within a time limit may also be filed in an "admissible non-EPO language" – if the applicant's residence or principal place of business is within the territory of a contracting state

having this as an official language or if the applicant is a national of such a contracting state. See A-VII, 1.1 and 1.2.

In the case of European patent applications filed on or after 1 April 2014, and of international applications entering the European phase on or after that date, a 30% reduction of the filing- and/or examination fee for certain categories of applicants is provided for (see the Notice from the EPO dated 10 January 2014, OJ EPO 2014, A23). In this regard, it is necessary to file the documents making up the application "as filed" and/or the request for examination in an admissible non-EPO language and to file the translation not earlier than simultaneously (see G 6/91). *Rule 6(3)* *Art. 14(1) RFees*

The categories of applicants eligible for the fee reductions are: *Rule 6(4)*

– small and medium-sized enterprises (SMEs),

– natural persons,

– non-profit organisations, universities and public research organisations,

whose residence or principal place of business is in an EPC contracting state with an official language other than English, French or German, and nationals of such states who are resident abroad.

The definition of SMEs is that contained in European Commission Recommendation 2003/361/EC of 6 May 2003 as published in the Official Journal of the European Union. Under the recommendation, an enterprise is considered to be any entity engaged in an economic activity, irrespective of its legal form. The category of micro, small and medium-sized enterprises is made up of enterprises which employ fewer than 250 persons, which have an annual turnover not exceeding EUR 50 million and/or an annual balance sheet total not exceeding EUR 43 million and for which no more than 25% of the capital is held directly or indirectly by another company that is not an SME. *Rule 6(5)*

The eligibility of the further entities listed in Rule 6(4) is subject to the following definitions:

(i) "Non-profit organisations" are organisations not allowed by their legal form or statutes, under the relevant law, to be a source of income, profit or other financial gain to their owners, or – if allowed to make a profit – there is a legal or statutory obligation to reinvest the profits made in the interest of the organisation.

(ii) "Universities" are to be understood as "classical" universities, meaning institutions of higher education and research, under the relevant law. However, comparable entities, such as secondary or higher education establishments, will be considered to be universities.

(iii) "Public research organisations" are entities such as universities or research institutes that are organised under public law and, irrespective of how they are financed, have the primary goal of conducting fundamental research, industrial research or experimental development and of disseminating the results by way of teaching, publication or technology transfer. All profits must be reinvested in carrying out these activities, in disseminating the results or in teaching.

Rule 6(7)

If there are multiple applicants, each one must be an entity or a natural person within the meaning of Rule 6(4) for the fee reduction to apply; it is however sufficient for only one of them to be entitled to use an admissible non-EPO language (Art. 14(4), Rule 6(3)).

Rule 6(6)

Applicants wishing to benefit from the reduction in the filing or examination fee under Art. 14(1) RFees must expressly declare that they are an entity or natural person covered by Rule 6(4) EPC.

Changes in the status of an entity under Rule 6(4) which occur after filing the declaration will not have a retroactive effect on fee reductions that were justified when granted.

The Office will conduct checks to ensure compliance with the eligibility criteria laid down in Rule 6(3) to (7). If those checks give rise to reasonable doubt during the course of the grant proceedings as to the veracity of the declaration given by the applicant, the EPO may request appropriate evidence.

Should it become apparent that an incorrect declaration has been filed, the fee would not be validly paid since it was reduced unjustifiably and the application may be deemed withdrawn under Art. 78(2) and/or 94(2). The same applies if no declaration has been filed. Where applicable, the loss of rights arising from an incorrect or missing declaration may be remedied by filing a request for further processing under Art. 121 and Rule 135 – subject to making good the underpayment and paying the fee for further processing (see E-VIII, 2) – or by requesting a decision under Rule 112(2) (see E-VIII, 1.9.3).

In respect of European patent applications, oppositions, appeals, petitions for review or requests for limitation or revocation filed before 1 April 2014, and international applications having entered the European phase before that date, the fee reduction in force until then was applied.

9.2.2 Reduction of the filing fee

In the case of the filing of the European application, the presence of a description is necessary for the accordance of a date of filing (Rule 40(1)(c)), but claims are no longer required for this. According to J 4/88, only the description and claims needed to be in this language to qualify for the fee reduction (not the request for grant for example). However, since claims are no longer required for a date of filing, the essential element is now the description.

Consequently, the filing fee is reduced if the European patent application (i.e. at least the description) is filed in an admissible non-EPO language.

Where the application is filed by reference to a previously filed application (see A-II, 4.1.3.1), and the previously filed application referred to is in an admissible non-EPO language, and the applicant satisfies the eligibility criteria mentioned in A-X, 9.2.1, then the applicant is also entitled to the reduction in the filing fee. For the purposes of the reduction, it does not matter whether or not the applicant requested that the claims of the previously filed application take the place of the claims in the application as filed (see above).

The reduction of the filing fee is also applicable to divisional applications if the parent application was filed in an admissible non-EPO language (see A-IV, 1.3.3 and A-X, 9.2.1) and the divisional application is filed in the same admissible non-EPO language as the earlier application (Rule 36(2) and Rule 6(3)), provided that the other requirements for the reduction are met (see above) and a translation is filed in time (see A-X, 9.2.1).

Since the additional fees payable if the application comprises more than thirty-five pages, or if it is a second- or further generation divisional application, form part of the filing fee, the reduction applies also to them.

9.2.3 Reduction of the examination fee

Art. 14(4)
Rule 6

Applicants eligible for the fee reduction will be allowed a reduction in the examination fee if the request for examination is filed in an admissible non-EPO language. EPO Forms 1001 (Request for grant of a European patent) and 1200 (Entry into the European phase) contain drop-down menus/pre-printed boxes where the request for examination in an admissible non-EPO language and the declaration under Rule 6(6) can be selected/entered. In these cases, the filing of a translation of the request is not necessary, since the written request for examination in the three EPO official languages is pre-crossed in the same forms. Wordings for the request-for-examination in the admissible non-EPO languages are listed on the EPO website. Where the request for examination in an admissible non-EPO language is filed subsequent to EPO Form 1001 or EPO Form 1200, a translation of the request for examination in the procedural languages must be re-filed (see G 6/91). Subsequent documents related to examination proceedings need not be filed in the admissible non-EPO language.

If the conditions for the reduction of the examination fee where the EPO has drawn up the international preliminary examination report are also fulfilled, see A-X, 9.3.2.

9.3 Special reductions

9.3.1 Reduction of the search fee for a supplementary European search

Art. 153(7)

The search fee for a supplementary European search report is reduced by a fixed amount for PCT applications for which the Patent Office of Austria, Finland, Spain, Sweden or Turkey, the Nordic Patent Institute or the

Visegrad Patent Institute was the International Searching Authority or where one of these offices prepared the supplementary international search report (see the Decisions of the Administrative Council of 27 October 2011, OJ EPO 2011, 616; of 25 October 2012, OJ EPO 2012, 584; of 16 December 2015, OJ EPO 2016, A2; of 28 June 2017, OJ EPO 2017, A57; and of 12 December 2019, OJ EPO 2020, A3).

It is to be noted that where the requirements for fee reduction are fulfilled the fee reduction is granted only once, i.e. for the supplementary search fee paid under Rule 159(1)(e). The reduction applies independently of whether the first invention in the claims was searched by the ISA in the international phase. The reduction does not apply to any further search fee (to be) paid under Rule 164(1).

No reduction of the supplementary search fee applies for PCT applications for which an International Searching Authority other than the ones mentioned above was selected. For the latest overview of the amounts payable, see the Notice from the EPO dated 20 March 2020, OJ EPO 2020, A30.

9.3.2 Reduction of the examination fee where the international preliminary examination report is being drawn up by the EPO

Art. 14(2) RFees

Where the EPO has drawn up the international preliminary examination report in respect of an international application, the examination fee is reduced by 75% in proceedings before the EPO as elected Office. Accordingly, the reduction applies to the Euro-PCT application entering the European phase. The reduction of the examination fee does not apply to divisional applications for whose parent application the EPO has drawn up the international preliminary examination report.

If the conditions for a reduction under the language arrangements (see A-X, 9.2.3) are also fulfilled, the examination fee is first reduced by 75%, then by a further 30%, i.e. the total reduction is 82.5%, or the amount payable is 17.5% of the full fee.

10. Refund of fees

10.1 General remarks

A fee that has been validly paid (see A-X, 7.1.1) is not refunded. For instance, a validly paid further processing fee is not refunded if the request for further processing is rejected due to non-completion of the omitted act, which is another requirement of Rule 135(1) (see E-VIII, 2). As an exception to this general principle, a validly paid fee is refunded if there are special provisions for the refund in either the EPC or the Rules relating to Fees (see A-X, 2).

By contrast, any fee which has not been validly paid is to be refunded. See subsections A-X, 10.1.1 to A-X, 10.1.3 below.

10.1.1 Fee payments lacking a legal basis

If a payment does not relate to a pending European patent application (e.g. it relates to a patent application already deemed to be withdrawn) or to

pending proceedings, there is no legal basis for the payment. In these cases, the amount paid must be refunded.

If the payment is made before or on the due date and if, no later than that date, the legal basis ceases to exist (e.g. because the patent application is deemed to be withdrawn or is withdrawn), the amount paid is to be refunded. For the designation fee and renewal fees see A-X, 5.2.2 and 5.2.4 respectively. Fees paid after the due date and before expiry of the time limit for payment are refunded only if there is a particular reason for a refund (see A-X, 10.2).

10.1.2 Late payments

The payment of a fee after expiry of the applicable time limit is not valid and must be refunded, unless a valid request for further processing has been filed. Examples: filing fee, search fee, designation fee or examination fee paid as laid down under the provisions relating to further processing (Art. 121 and Rule 135), without the further processing fee required by Rule 135(1) and Art. 2(1), item 12, RFees (see E-VIII, 2).

10.1.3 Insignificant amounts

Art. 12 RFees

Where the sum paid is larger than the fee, the excess will not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. It has been decided that any amount up to EUR 16 constitutes an insignificant amount (see the Decision of the President of the EPO dated 14 February 2020, OJ EPO 2020, A17).

10.2 Special refunds

10.2.1 Refund of the search fee

Art. 9 RFees
Rule 10

The search fee for a European or supplementary European search is refunded in cases provided for in Art. 9 RFees and in the Decision of the President of the EPO dated 21 December 2018, OJ EPO 2019, A4, which applies to European patent applications in respect of which the European or supplementary European search is completed on or after 1 April 2019. Details on criteria for refund of search fees are given in the Notice from the EPO dated 9 January 2009, OJ EPO 2009, 99, according to which the search division will determine the level of refund to be applied. In the event of disagreement, the applicant may request an appealable decision (Art. 106(2)), the issuing of which falls within the competence of the Receiving Section where the examining division has not yet assumed responsibility for the application (Rule 10) (see B-XI, 2).

For the purposes of Art. 9(1) RFees, the date of the start of the search is indicated by means of EPO Form 1704 in the public part of the dossier and is thus open to file inspection in the European Patent Register after publication of the patent application (see also B-IV, 1). Before publication, the EPO will provide the applicant with the relevant information upon request, or this information can be accessed electronically via the My Files service.

10.2.2 Refund of the further search fee

Rule 64(2), 164(5)

If an applicant, following a communication from the search division, has paid a further search fee but the examining division, at the applicant's request, has found that there was no justification for charging the further search fee, the latter will be repaid. The same principle applies if the applicant has paid a search fee on the basis of an invitation by the examining division in accordance with Rule 164(2) (see C-III, 2.3). In such case the examining division will, on request, review the justification for charging the search fee in its invitation under Rule 164(2) (see C-III, 3.3).

10.2.3 Refund of the examination fee

Art. 11 RFees

The examination fee will be refunded in the situations described in Art. 11 RFees (see A-VI, 2.2, third paragraph, and A-VI, 2.5).

10.2.4 Refund pursuant to Rule 37(2)

Rule 37(2)

If a European patent application filed with a competent national authority is deemed to be withdrawn pursuant to Art. 77(3), all fees, in particular the filing, search and designation fees and any claims fees paid, will be refunded.

10.2.5 Refund of the fee for grant and publishing

Rule 71a(6)

If the application is refused, withdrawn prior to notification of the decision on the grant of a European patent or, at that time, deemed to be withdrawn, the fee for grant and publishing shall be refunded. The date of notification of the decision is determined as indicated in E-II, 2. Note that this date is later than the date on which the decision is handed over to the EPO internal postal service (i.e. decision G 12/91 does not apply in this case).

This may happen, for example, where the applicant pays the fee for grant and publishing within the Rule 71(3) period but does not pay the claims fees which are due and/or neglects to file the translations of the claims, leading to deemed withdrawal of the application under Rule 71(7) (see C-V, 3).

Where the application is refused, the refund will be effected only after the period for filing of an appeal has expired without an appeal having been filed (see E-XII, 6). Where the application is deemed to be withdrawn, the refund will be effected only after the period for requesting further processing has expired and this has not been requested by the applicant (see E-VIII, 2).

10.3 Method of refund

Refunds are made either to a deposit account held with the EPO or by transfer to a bank account (see the Notice from the EPO dated 27 February 2019, OJ EPO 2019, A26). Refunds are not made to a credit card account (see the Notice from the EPO dated 23 September 2021, OJ EPO 2021, A73).

10.3.1 Refunds to a deposit account

Point 8 ADA

Fees are refunded to any deposit account that the party to the proceedings before the EPO (e.g. the applicant, the opponent, the appointed

representative, the appellant) has indicated in its refund instructions. In most cases this will be the deposit account of the party to the proceedings itself, but it may also be the deposit account of a third party. The EPO notifies the party to the proceedings about the intended refund and the deposit account to which the amount will be credited in a separate communication.

Refund instructions, i.e. to which deposit account refunds are to be made, are to be filed in an electronically processable format (XML), namely via OLF or Online Filing 2.0, using EPO Form 1001E, 1200E or 1038E, preferably as early as possible in the proceedings before the EPO. Refund instructions can be updated at any time, using EPO Form 1038E.

For international applications filed with the EPO as receiving Office or for which the EPO acted as an International Authority under the PCT, new refund instructions are to be filed when entering into the European phase, using EPO Form 1200E.

New refund instructions filed together with a request for a change of representative or a transfer of rights will apply only once the EPO has confirmed the recording of the change. If no new refund instructions are present, a deposit account recorded for an applicant or representative who has withdrawn from the proceedings will be deleted *ex officio*. The same applies to the deposit account held by a third party indicated in the refund instructions of the former applicant or representative.

If no refund instructions are on file when a refund becomes due or if they are ambiguous, the EPO will establish *ex officio* whether it can make a refund to a deposit account held by the appointed professional representative or by the applicant (opponent/appellant). Otherwise it will invite the person who made the payment to claim the refund online.

10.3.2 Refunds to a bank account

If a refund cannot be made to a deposit account, the party to the proceedings is invited to claim the refund online via the EPO website (*fee-payment.epo.org/refund*) using a refund code communicated to it in a non-public communication. Upon successful registration and login, the refund can be claimed by entering the details of the application, the refund code and a bank account.

10.4 Re-allocation instead of refund

If a party files a written request, the payment may be re-allocated instead of being refunded. The date of receipt of the re-allocation instructions is then considered to be the date of payment for the new purpose of payment.

11. Crediting of fees under Rule 71a(5)

Rule 71a(5)

If, in response to an invitation under Rule 71(3), the applicant has already paid the fee for grant and publishing or the claims fees, the amount paid shall be credited if a further such invitation is issued. This may happen where:

(i) the applicant requests amendments or corrections in response to the first Rule 71(3) communication or requests the reversal of amendments proposed by the examining division in that communication (see C-V, 4.1) and also voluntarily pays the fee for grant and publishing and claims fees (even though this is not required, C-V, 4.2); and the examining division then issues a subsequent Rule 71(3) communication (see C-V, 4.6 and 4.7.2), or

(ii) after the applicant has approved the text for grant in response to the first Rule 71(3) communication (which requires payment of the fee for grant and publishing and any claims fees due - see C-V, 1.1), examination is resumed (see C-V, 6.1) leading to the issuance of a subsequent Rule 71(3) communication (see C-V, 6.2).

11.1 Crediting of the fee for grant and publishing

The amount of the fee for grant and publishing paid in response to the first Rule 71(3) communication is credited towards the amount of this same fee due in response to the second Rule 71(3) communication. If there is an increase in this fee between the first and second Rule 71(3) communications, the difference must be paid within the period for reply to the second Rule 71(3) communication.

Art. 2(2), item 7, RFees

For European applications filed before 1 April 2009 or international applications entering the European phase before that date, the fee for grant and publishing incorporates a fixed component and a component in respect of each page of the application over and above 35 (see C-V, 1.2 and A-III, 13.2). If the overall fee changes between the first and the second Rule 71(3) communication, any shortfall must be paid within the second Rule 71(3) period (e.g. resulting from a fee increase or an increase in the number of pages). Any excess will be refunded (for example where the version of the application on which the second Rule 71(3) communication is based has fewer pages than the earlier version on which the first Rule 71(3) communication was based).

11.2 Crediting of claims fees

The amount of the claims fees paid in response to the first Rule 71(3) communication is credited towards the amount of the claims fees due in response to the second Rule 71(3) communication. In this regard it is important to note that, unlike claims fees paid on filing under Rule 45 or on entry into the European phase under Rule 162, it is not the number of claims paid for which is used in the calculation, but rather the amount paid.

If the amount of the claims fees due increases between the first and second Rule 71(3) communications (e.g. because there is an increase in the fee per claim or an increase in the number of claims or both), the difference

must be paid within the period for reply to the second Rule 71(3) communication.

In order to calculate the amount of the claims fees due in response to the second Rule 71(3) communication, the number of fee-free claims (15) and also the number of claims fees paid on filing or on entry into the European phase are deducted from the number of claims on which both the first and second Rule 71(3) communications are based. Thereafter, the amount of the claims fees paid in response to the first Rule 71(3) communication is then credited towards (and so deducted from) the amount of the claims fees due in response to the second Rule 71(3) communication (if the amount of fees due after the second Rule 71(3) communication is smaller than that voluntarily paid after the first Rule 71(3) communication, see C-V, 4.2).

11.3 Separate crediting of the fee for grant and publishing and claims fees

The crediting of claims fees and the fee for grant and publishing is dealt with separately. Claims fees are not credited towards any increase in the fee for grant and publishing.

11.4 Further processing fee and crediting of fees

Where the applicant has requested further processing in respect of the first Rule 71(3) communication (see E-VIII, 2), the fee for further processing is not credited towards any increase in the amount of the fees due in response to the second Rule 71(3) communication.

Furthermore, the fee for further processing paid in respect of the first Rule 71(3) communication is also not credited to any subsequent request for further processing in respect of the second Rule 71(3) communication.

Chapter XI – Inspection of files; communication of information contained in files; consultation of the European Patent Register; issuance of certified copies

1. General

After a European patent application has been published, any person may inspect and obtain information from the files relating to the application and the resultant European patent. Similarly, anybody may request the issuance of a sample of biological material in accordance with Rule 33 (see A-IV, 4.4).

Art. 128
Rule 143, Rule 144
Rule 145, Rule 146
Art. 3(1) RFees

The provisions governing inspection of files are contained in Art. 128 and Rules 144 and 145 (see A-XI, 2); those governing communication of information are contained in Rule 146 (see A-XI, 3). For international (PCT) applications, see E-IX, 2.10.

The European Patent Register, containing the particulars specified in Rule 143 and accessible free of charge, can be consulted in order to ascertain the state of the proceedings and the legal status of patent rights. It also provides access to the files of published European patent applications and patents for inspection (see A-XI, 4). The inspection of paper files on the premises of the European Patent Office was discontinued in 2007.

On request, the EPO issues certified copies of documents contained in the files or of other documents (see A-XI, 5).

Any fees payable for any of the above services are laid down by the President pursuant to Art. 3(1) RFees and are regularly published in the Official Journal. See also the schedule of fees and expenses on the EPO website (epo.org).

An administrative fee, if any, falls due when the request is received. The methods of payment and the date on which payment is deemed to have been made are dealt with in the Rules relating to Fees (see A-X, 2 and 4). Where the administrative fee has been duly paid, it will not be refunded (see A-X, 10.1).

2. Inspection of files

2.1 Documents open to file inspection

All parts of the file compiled when conducting the examination, opposition and appeal procedure with the parties are open for inspection, subject to the restrictions mentioned below (see A-XI, 2.3). It also includes information on the dates of the start of search and examination, any invitations under Rule 63(1) or Rule 62a(1) and the search opinion if applicable.

Art. 128
Rule 145(2)
Rule 147(2)

Observations by third parties (Art. 115) are an integral part of the files and as such are open to inspection in accordance with Art. 128. If a third party

asks that their observations or a part thereof be treated confidentially, that request cannot be granted and the third party will be notified accordingly (see E-VI, 3).

The parts of the file excluded from inspection (see A-XI, 2.3) are kept separate from those open to inspection.

2.2 Conducting file inspections

Rule 145(2)
Art. 3(1) RFees

The President of the EPO determines all file inspection arrangements, including the circumstances in which an administrative fee is payable (see the Decision of the President of the EPO 20 February 2019, OJ EPO 2019, A16).

As a rule, published patent applications and granted patents can be inspected free of charge online on the EPO website via the European Patent Register. In exceptional cases, and only if accompanied by a substantiated request, uncertified paper copies of files or uncertified extracts from the European Patent Register are still issued. The corresponding administrative fees have been abolished (see the Notice from the EPO dated 20 February 2019, OJ EPO 2019, A15, and the Decision of the President of the EPO dated 20 February 2019, OJ EPO 2019, A16)

Regarding requests to furnish certified copies of documents from the file or a certified extract from the European Patent Register, see A-XI, 5.

With regard to the inspection of files containing high-volume sequence listings, see A-IV, 5.

2.3 Restrictions to file inspection

Art. 128(4)
Rule 146
Rule 145
Rule 144

Inspection of files is subject to the restrictions laid down in Rule 144.

The parts of the file excluded from inspection are:

Rule 144(a)

(i) the documents relating to the exclusion of or objections to members of the boards of appeal or of the Enlarged Board of Appeal;

Rule 144(b)

(ii) draft decisions and opinions, and all other documents used for the preparation of decisions and opinions, which are not communicated to the parties;

Rule 144(c)

(iii) the designation of the inventor if that party has waived the right to be mentioned as inventor under Rule 20(1);

Rule 144(d)

(iv) any other document excluded from inspection by the President of the EPO on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent. These include documents relating to file inspection and requests for accelerated search and accelerated examination under the "PACE" programme (see the Decision of the President of

the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.3);

(v) subject to Rule 94.2 and 94.3 PCT, the files relating to international preliminary examination for a Euro-PCT application in respect of which the EPO is the International Preliminary Examining Authority and for which an international preliminary examination report has not yet been established (see OJ EPO 2003, 382; see also E-IX, 2.10). *Art. 38(1) PCT* *Rule 94 PCT*

Apart from listing the documents excluded from file inspection by the EPO of its own motion, the decision of the President referred to under point (iv) above stipulates that (parts of) other documents the inspection of which is claimed to be prejudicial to the legitimate personal or economic interests of a natural or legal person may be excluded from file inspection on request. Any such request needs to be duly substantiated and point out in which specific way the legitimate personal or economic interests of the party are affected and what are the consequences thereof rather than merely making a statement concerning a party's interests in general. Also, it is recommended to clearly mark any requests for exclusion from file inspection, allowing them to be immediately identified as such and to be provisionally excluded from inspection, pending a final decision on the request.

When a submission is to be excluded from file inspection only partially, only the parts or passages in question are excluded, while the rest of the submission remains public.

If it is decided that certain papers, either marked "confidential" or in view of the nature of their content, are not to be excluded from file inspection under Rule 144, they are returned to the sender (see T 516/89).

2.4 Confidentiality of the request

Correspondence from the proceedings relating to the inspection of files conducted between the EPO and the person requesting the inspection is included in the non-public part of the file. The EPO does not provide the applicant with any information about the proceedings relating to the inspection of files (see A-XI, 2.3(iv) but also A-XI, 2.5, third paragraph).

2.5 File inspection before publication of the application

Until the European patent application is published, the files may be inspected only by applicants or with their consent. The online service My Files allows applicants to inspect online the public part of the files relating to their still unpublished applications (see Notice from the EPO dated 13 December 2011, OJ EPO 2012, 22). If a third party requests file inspection without at the same time submitting the applicant's consent, the EPO will not release the files until the applicant's approval has been presented. *Art. 128(1)*

However, prior to publication of the European patent application, any person who can prove that applicants have invoked their rights under the application against them may also inspect the files. The rights under a European patent application are also deemed to have been invoked where *Art. 128(2)*

rights under a first filing in a contracting state have been invoked and the subsequent European application is mentioned at the same time (see J 14/91). If such proof is not furnished together with the request, the EPO will invite the requester within a specified period to supply proof. If that is not done in due time, the request will be refused.

In case of a request for inspection of the files under Art. 128(2), the applicant is entitled to notification of the identity of the person making the request. Professional representatives requesting inspection of the files on behalf of a third party pursuant to Art. 128(2) must accordingly give the third party's name and address and file an authorisation.

A decision on a request for inspection of the files pursuant to Art. 128(2) is only taken once the applicant has been heard. If the applicant objects and provides grounds for the belief that the requirements under Art. 128(2) are not met within the period set by the EPO, a decision will be delivered. This decision is subject to appeal.

Art. 128(3)

Prior to publication of a European divisional application the file of this divisional application may only be inspected in the cases described in Art. 128(1) and (2). This also applies where the parent application has already been published. However, where a European divisional application or a new European patent application filed under Art. 61(1)(b) is published, the files of the earlier application may be inspected prior to the publication of that earlier application and without the consent of the relevant applicant.

2.6 Publication of bibliographic data before publication of the application

Art. 128(5)

In accordance with Art. 128(5), the EPO publishes in the European Patent Bulletin the bibliographic data relating to European patent applications which had been announced for publication but for which the application documents were not published, either because the application was withdrawn or because the announcement was erroneous. The lists of these publication numbers can be found on the European publication server, which is accessible via the EPO website (epo.org).

3. Communication of information contained in the files

Rule 146

Subject to the restrictions provided for in Art. 128(1) to (4) and Rule 144 (see A-XI, 2.3), the EPO may, upon request, communicate information concerning any file of a published European patent application or a European patent. This is subject to the payment of an administrative fee (see A-XI, 1 and OJ EPO 2019, A14 and A15).

However, the EPO may refer to the option to obtain inspection of the file itself, should it deem this to be appropriate in view of the quantity of information to be supplied.

Correspondence from the proceedings relating to the communication of information conducted between the EPO and the person requesting the information is filed in the part of the file which is not accessible to the public. The EPO does not provide the applicant with any information about the proceedings relating to the communication of information.

4. Consultation of the European Patent Register

The European Patent Register can be accessed free of charge via the EPO website (epo.org) (see A-XI, 2.2). Entries in the European Patent Register are made starting from the publication of the European patent application up to expiry of the period of opposition or the termination of opposition proceedings. Where applicable, the date and purport of any decision taken in revocation or limitation proceedings (Art. 105b(2)) and/or on a petition for review (Art. 112a) are also included (Rule 143(1)(x) and (y)). Since the correction of the designation of the inventor may be made at any time (see A-III, 5.5), there is no time restriction for related entries in the European Patent Register.

Art. 127
Rule 143
Rule 21(2)

Apart from the data to be entered in the European Patent Register under Rule 143(1), the Register includes, under Rule 143(2), additional application and procedural data not published in the European Patent Bulletin (see the Decision of the President of the EPO dated 15 July 2014, OJ EPO 2014, A86). Register data may also be obtained by telephone from Customer Services: *epo.org/service-support/contact-us.html*. In exceptional cases, an extract from the Register will be provided on receipt of a substantiated request (see OJ EPO 2019, A15).

5. Issuance of certified copies

5.1 Certified copies of documents from the files or of other documents

The EPO will issue on request a certified copy of the European patent application or European patent specification, or of other documents from the files of European applications and patents (e.g. an extract from the European Patent Register), provided that the conditions for file inspection (Art. 128(1) to (4)) are fulfilled and an administrative fee has been paid (see A-XI, 1 and OJ EPO 2019, A14).

A certified copy of the European patent certificate with specification attached is supplied to the patent proprietor on request (see C-V, 12).

Rule 74

5.2 Priority documents issued by the EPO

Any priority document (i.e. the certified copy of the European patent application together with the certificate stating the date of filing thereof) will only be issued to the (original) applicant or that party's successor in title on written request. If such request is missing, the EPO will invite the requester to file it and will supply the certified copy only once this requirement has been fulfilled. In the case of applications filed in a language other than an official language of the EPO (Art. 14(2)), the priority document relates to the application as originally filed, not to the translation in one of the official languages of the EPO.

Rule 54

The President of the EPO determines all necessary arrangements, including the form of the priority document and the circumstances in which an administrative fee is payable (see A-XI, 1). The content of priority documents corresponds to the application documents as available on the date of filing and as contained in the electronic file, reproduced in black and white (see A-IX 1.2 and 7.1).

Where a European patent application claims the priority of a previous European patent application or an international application filed with the EPO as receiving Office under the PCT, a certified copy of the previous application will be included in the file free of charge (see also A-III, 6.7).

Part B

Guidelines for Search

Contents

Chapter VII – Unity of invention VII-1

Chapter VIII – Subject-matter to be excluded from the search VIII-1

Chapter I – Introduction

1. Purpose of Part B

Part B was drafted for, and applies to, European searches, i.e. searches performed by the EPO for European applications. In addition to these searches the search divisions of the EPO are called upon to carry out other types of searches (see B-II, 4.4 to B-II, 4.6). Searches in the context of the Patent Cooperation Treaty (PCT) are dealt with in the PCT Search and Examination Guidelines and in the Guidelines for Search and Examination at the EPO as PCT Authority, Part B.

2. Search division

Art. 17
Art. 18

The search division is responsible for drafting extended European search reports under Art. 92, including a search opinion pursuant to Rule 62(1), as well as for drafting all of the different types of search report referred to in B-I, 1 and B-II, 4. The search division is also responsible for issuing a pre-search invitation under Rule 62a(1) (see also B-VIII, 4) to clarify or where necessary limit the subject-matter to be searched. The issuing of an invitation under Rule 63(1) is also within the responsibility of the search division (see B-VIII, 3.1). Furthermore, in the case of lack of unity, it draws up a partial search report, a provisional opinion on the patentability of the invention or unitary group of inventions first mentioned in the claims (see F-V, 3.4) and the reasons for non-unity findings, together with an invitation to pay additional search fees under Rule 64(1) or Rule 164(1) (see B-VII, 1.2 and B-XI, 5). The member of the search division responsible for the search on a European application is also normally the first member of the examining division for that application.

2.1 Consultation with other examiners

The search division entrusted with the search may consult other examiners for advice on any number of issues, for example:

(i) online searches in databases with which the search division is not familiar;

(ii) understanding aspects of the claimed invention which may lie outside the area of technical expertise of the search division;

(iii) constructing a search strategy (see also B-I, 2.2);

(iv) interpreting the relevance of a prior-art document for determining the patentability of claimed subject-matter (see B-X, 9.2).

2.2 Search division consisting of more than one member

Where the invention is of a nature requiring searching in widely dispersed specialised fields, a special search division consisting of two, or possibly three, members may be formed, for example, where the "person skilled in the art" in the technical field of the application consists of more than one person (see G-VII, 3).

Another case is where there is found to be a lack of unity in subject-matter between different technical fields.

In such cases, the documents found in the different technical fields by the first and by the other member(s) are included in the same search report. The search opinion however is prepared by one member only, if necessary in consultation with the member expert(s) in the other technical field(s).

2.2.1 Where claimed unitary subject-matter covers more than one technical field

Exceptionally, where the application covers two or more technical fields which are so diverse that a member trained to carry out searches in one of those fields cannot reasonably be expected to carry out a search in all of them, the responsibility for preparing the search report may be shared between a number of members.

The skills required to carry out a search in a particular technical field consist of two aspects, viz.:

(a) the technical knowledge and training required to properly understand the claimed subject-matter

(b) expertise in search tools required for performing a satisfactory search in that field.

If the subject-matter of the application extends over different technical fields it might be appropriate to expand the search division to include a second and possibly further member(s) specialised in those fields.

In all the above cases, the search report and search opinion (if applicable, see B-XI, 7) are usually issued by one member only.

2.2.2 Further searches on a non-unitary application in a different technical field

Another case where the search division consists of more than one member is where a lack of unity is found to exist between subject-matter in different technical fields. Such cases are handled as follows:

(a) The search on the invention first mentioned in the claims (see F-V, 3.4) is carried out in one technical field by a first member. A search opinion (if applicable – see B-XI, 7) is prepared giving the reasons for the lack of unity and an opinion on this first invention. The applicant is sent a partial search report, along with an invitation to pay additional search fees (see B-VII, 1.1).

(b) The applicant pays additional search fees for inventions falling into another technical field (see B-VII, 1.2.1).

(c) Those inventions falling into the other different technical field are then searched by a second member competent for that field.

(d) The second member then adds an opinion on the additional inventions which have been searched to the opinion already drafted by the first member relating to unity and the first invention.

In very exceptional cases, the search on other inventions will need to be carried out by more than one further member (second, third and possibly further members). Here the procedure is analogous to that explained above.

Chapter II – General

1. Search and substantive examination

The procedure through which a European patent application proceeds from the filing of the application to the grant of a patent (or the refusal of the application) comprises two separated basic stages, i.e. the search and substantive examination.

Art. 17
Art. 18

1.1 Contact between the applicant and the search division

Consultations with the search division can only take place after the application has entered the examination stage, with the exception of cases indicated in B-VIII, 3.2.2 and 4.2.2, and regarding issues related to the timing of the drawing up of the search report. The search division must not consent to these earlier (see also B-XI, 8). Applicants must be told that any issues they refer to will be dealt with in examination. For the procedure at the examination stage see C-VII, 2.5.

2. Objective of the search

The objective of the search is to discover the state of the art which is relevant for the purpose of determining whether, and if so to what extent, the claimed invention for which protection is sought is new and involves an inventive step.

Rule 61(1)

The search is thus not usually directed to discovering disclosures which may be of interest to the applicant. However, under certain circumstances documents not directly relevant for assessing the patentability of the claimed invention may be cited in the search report (see B-X, 9.2.2 and 9.2.5).

The examination procedure and the preparation of the search opinion depend on the search for the knowledge of the state of the art on which assessment of the patentability of the invention is based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by issues such as unity of invention and other considerations (see B-III, 2, B-VII and B-VIII).

3. Search documentation

The search is carried out in in-house or external collections of documents or databases, the contents of which are systematically accessible, e.g. by means of words, classification symbols or indexing codes. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature (see B-IX).

4. Search report

A search report is prepared containing the results of the search, in particular by identifying the documents constituting the relevant state of the art (see B-X, 9).

Art. 92
Rule 61(1)

Art. 92
Art. 93(1)

The search report serves to provide information on the relevant state of the art to the applicant, to the examining divisions of the EPO and, by means of its publication, to the public.

The search report is accompanied by the search opinion (see B-XI, subject to the exceptions mentioned in B-XI, 7), which together with the European search report constitutes the extended European search report (EESR).

4.1 European searches

Art. 17

The task of the search division is primarily to carry out searches and draw up search reports in relation to European patent applications. In addition to these usual searches, the search divisions of the EPO may be called upon to perform various other types of search, which are listed in the following paragraphs.

4.2 Additional European searches

At the examination stage of a European patent application an additional search may be necessary. The reasons for such an additional search may be, for example:

(i) amendment of claims so that they embrace matter not covered by the original search (see, however, C-III, 3.1.1 and H-II, 7.1 for claims not searched because of lack of unity and H-II, 6.2 for amendments introducing subject-matter from the description resulting in claims defining subject-matter which is not linked by a single general inventive concept to the subject-matter originally searched);

Rule 63
Art. 17(2) PCT

(ii) removal by amendment or rebuttal, during substantive examination, of the deficiencies which resulted in the issuance of an incomplete search or a declaration taking the place of a search report under Rule 63, or a declaration under Art. 17(2)(a) or (b) PCT (see B-VIII and C-IV, 7.2);

Rule 64
Rule 62a

(iii) reversal, by the examining division, of an opinion of the search division with respect to novelty or lack of inventive step (see B-III, 1.1) or on other issues (see B-III, 1.2), in particular lack of unity of invention (see B-VII), exclusions from the search (see B-III, 3.11 and B-VIII) or Rule 62a; and

(iv) limitations or imperfections in the initial search.

The examining division makes use of documents found in such an additional search, where they are considered relevant to the examination of the application. Where a new document is used in the examination procedure, a copy must be communicated to the applicant (Art. 113(1)).

In a similar way, an additional search may become necessary during examination of oppositions against a European patent (see D-VI, 5).

4.3 Supplementary European searches

Art. 153(2), (6) and (7)

An international (PCT) application for which the EPO acts as designated Office or elected Office and which has been accorded an international date

of filing is deemed to be a European patent application. Where an international (PCT) search report is already available, this will take the place of the European search report. The search division will draw up a supplementary European search report or a declaration replacing it according to Rule 63 unless provided otherwise in decisions of the Administrative Council.

However, the Administrative Council decides under what conditions and to what extent the supplementary European search report is to be dispensed with (see B-II, 4.3.1). *Art. 153(7)*

The (S)ISA/IPEA (other than the EPO) will have given opinions on the novelty, inventive step and industrial applicability of the claimed invention according to Art. 33(1) PCT and possibly also on unity of invention according to Art. 34(3) PCT and exclusions from international search/preliminary examination according to Art. 17(2)/Art. 34(4) PCT. The search division for the supplementary European search report will consider these opinions but is free to digress from any or all of them when performing a supplementary European search and when preparing the search opinion (if applicable – see B-XI, 7).

The search division can use the documents cited in the international search report in support of its findings (e.g. lack of novelty) in the search opinion (if applicable – see B-XI, 7).

4.3.1 Dispensing with the supplementary European search report

According to decisions taken by the Administrative Council, no supplementary European search report is drawn up in respect of an international application for which:

(i) the EPO was the International Searching Authority or the Supplementary International Searching Authority (OJ EPO 2009, 594; OJ EPO 2010, 316);

(ii) the Swedish Intellectual Property Office, the Austrian Patent Office or the Spanish Patent and Trademark Office was the International Searching Authority and where the international application was filed before 1 July 2005 (OJ EPO 1979, 248; OJ EPO 1995, 511; OJ EPO 2012, 212 and 219).

A fee reduction may apply (see A-X, 9.3.1).

4.3.2 A supplementary European search report is required

If a supplementary European search report is not to be dispensed with (see B-II, 4.3.1), the supplementary European search is carried out in all of the EPO's search documentation. It is left to the search division's judgement whether a limitation as to the search documents is chosen. No precise limits can at present be set to other supplementary European searches since the documentation and search practices of other International Searching Authorities have not been fully harmonised in respect of the EPO.

As a general rule, the EPO tries to avoid any superfluous work and duplication of work and relies on the efficiency and quality of the international searches to the largest extent possible. If the international search report has not been drawn up upon entry into the European phase, the EPO will wait until it has been drawn up and is available to it before processing the application further. The EPO as designated Office requests the International Searching Authority or the Supplementary International Searching Authority to supply, together with the international search report, copies of the documents cited therein (Art. 20(3) PCT, see also Rule 44.3(a) PCT or Rule 45*bis*.7(c) PCT). When documents are cited that are not in one of the official languages of the EPO and the search division needs a translation into one of these languages, it provides this itself (e.g. a patent family member in an official language of the EPO or, alternatively, an abstract of the document in an official language of the EPO, see B-VI, 6.2), unless it is able to obtain it from any other source, e.g. the applicant or the International Searching Authority.

4.3.3 Application documents for the supplementary European search report

Rule 159(1)(b)
Rule 161

The European grant procedure, including the supplementary European search, is to be based on the application documents as specified by the applicant when the application enters the European phase (Rule 159(1)(b)). Alternatively, if, within a non-extendable period of six months as from notification of a communication pursuant to Rule 161(2) (see E-IX, 3), the applicant has amended the application, the application as amended serves as the basis for the supplementary European search (see also B-XI, 2). For procedures relating to Euro-PCT applications where no supplementary European search report is prepared by the EPO, see E-IX, 3.2, 3.3 and 3.4.

4.4 International (PCT) searches

For the search practice as regards international (PCT) searches, reference is made to the PCT International Search and Preliminary Examination Guidelines, as well as to the latest version of the Euro-PCT Guide ("PCT procedure at the EPO, Guide for applicants").

4.5 International-type searches

Under the PCT, the EPO, as an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (Art. 15(5) PCT). These searches are by definition similar to international searches, and the same considerations apply, except where unity of invention is lacking; in the case of a lack of unity in a national application subject to an international-type search, no reasoned statement on the lack of unity is included in the search report. Furthermore, no invitation to pay additional fees is issued, but applicants may have the possibility to pay these fees directly to the national offices. In cases where a written opinion is established, it is drafted in accordance with EPO practice under PCT Chapter I, including a reasoned statement in respect of any potential lack-of-unity objection.

4.6 Searches on national applications

Prot. Centr. I(1)(b)

The search divisions of the EPO also carry out searches on national applications of certain of its contracting states. These guidelines are not

necessarily fully applicable to these national searches, nor are the ways in which these searches differ from European searches specifically pointed out. However, these national searches are to a large extent identical to, or compatible with, European searches.

Chapter III – Characteristics of the search

1. Opinions of the search division

1.1 Opinions in relation to the search report

As stated in B-II, 2, the objective of the search is to discover the relevant state of the art for the purpose of assessing novelty and inventive step. Decisions on novelty and inventive step are the province of the examining divisions. However, in the search opinion (if applicable, see B-XI, 7), the search division gives the applicant a reasoned opinion on whether the application and the invention to which it relates meet the requirements of the EPC, to which the applicant can reply in the examination procedure (Art. 113(1) and B-XI, 8). Opinions on patentability are also implicitly expressed in the search report by the assignment of document categories as defined in B-X, 9.2 and are subject to review by the examining division at the examination stage (see B-II, 4.2(iii) and B-XI, 1.2), in particular in the light of the applicant's reply thereto (see B-XI, 8).

Rule 61(1)

The assessment of patentability at the search stage can have a direct bearing on the execution of the search itself, see: B-III, 3.8 (search for subject-matter of dependent claims), B-III, 2.3 (search in analogous technical fields) and B-IV, 2.6 (stopping the search when only trivial matter remains).

1.2 Opinions on matters relating to limitation of the search

Occasionally matters of substantive examination other than novelty or inventive step have a direct bearing on the execution of the search and may result in a limitation thereof; here again these opinions are subject to review by the examining division (see T 178/84 and T 631/97, and B-II, 4.2(iii) and B-XI, 1.2), in particular in the light of the applicant's reply to the search opinion (see B-XI, 8).

Examples are to be found in B-VII (Unity of invention) and B-VIII (Subject-matter to be excluded from the search).

2. Scope of the search

2.1 Completeness of the search

The European search is essentially a thorough, high-quality, all-embracing search. Nevertheless, it must be realised that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any information retrieval system and its implementation. The search is carried out in such a manner as to reduce to a minimum the possibility of failing to discover complete anticipations for any claims, or other highly relevant prior art. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower recall ratio can be accepted (see in this context, however, B-III, 2.3). For limitations of the subject-matter searched by the EPO, see B-VIII.

The scope of the international search is defined in Art. 15(4) PCT stipulating that the International Searching Authority must endeavour to discover as much of the relevant prior art as its facilities permit and must, in any case, consult the documentation specified in the PCT Regulations (Rule 34 PCT). It follows from this definition ("as its facilities permit") that the scope of an international search must be equivalent to a European search. International and European searches must thus be fully compatible. In accordance therewith, if the EPO carried out the international search or the supplementary international search, no supplementary European search report need be drawn up and the international search report made by the EPO takes the place of the European search report unconditionally (Art. 153(6) EPC, see OJ EPO 2010, 316, and OJ EPO 2011, 616; see also B-II, 4.3).

2.2 Effectiveness and efficiency of the search

The effectiveness and efficiency of any search for relevant documents (Rule 61(1)) depend on the degree of order which is available in, or which can be applied to, the collection of documents to be searched, the order allowing the search division to determine sections of the documentation to be consulted. The basic components for creating order in a collection of documents are words, classification units, indexing codes or bibliographical links between documents by commonly cited documents. The order may have a permanent character, as with indexing words, classification symbols or indexing codes, or it may be created on demand by a search strategy judiciously using the above-mentioned basic components, the outcome of which is a section of the documentation which is likely to contain material pertinent to the invention. The search division for reasons of economy exercises its judgement, based on its knowledge of the technology in question and of the available information retrieval systems, to omit sections of the documentation in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time when the area of technology in question began to develop. Similarly, the search division needs only to consult one member of a patent family unless it has good reason to suppose that, in a particular case, there are relevant substantial differences in the content of different members of the same family (see B-IX, 2.4).

2.3 Search in analogous fields

The search is carried out in collections of documents or databases which may contain material in all those technical fields pertinent to the invention. The search strategy determines the sections of the documentation to be consulted covering all directly relevant technical fields, and may then have to be extended to sections of the documentation covering analogous fields, but the need for this must be judged by the search division in each individual case, taking into account the outcome of the search in the sections of the documentation initially consulted (see B-III, 3.2).

The question of which technical fields are, in any given case, to be regarded as analogous has to be considered in the light of what appears to be the essential technical contribution of the invention and not only the specific functions expressly indicated in the application.

The decision to extend the search to fields not mentioned in the application must be left to the judgement of the search division, which does not put itself in the place of the inventor and does not try to imagine all the kinds of applications of the invention possible. The overriding principle in determining the extension of the search in analogous fields is whether it is probable that a reasonable objection of lack of inventive step could be established on the basis of what is likely to be found by the search in these fields (see T 176/84, T 195/84 and G-VII, 3).

2.4 Search on the internet

The European search can also cover internet sources, including online technical journals, online databases or other websites (see OJ EPO 2009, 456). The extent of such internet searches depends on the individual case, but in some technical fields a systematic internet search will regularly be necessary. Especially in fields related to information or software technology, searches bypassing the internet will often not yield the most relevant prior art. The search division may therefore use the internet as necessary also when searching unpublished applications but must take great care not to disclose confidential information through the inadvertent use of search terms. It is left to the search division to select keywords that enable such a search to be performed while respecting the duty of confidentiality regarding unpublished applications. This would entail, for example, choosing only a few keywords which do not disclose the invention, rather than entering long portions of the text of a claim as a search term.

Concerning the dating of internet citations, see G-IV, 7.5.

3. The subject of the search

3.1 Basis for the search

The search is made on the basis of the claims, with due regard to the description and drawings (if any) (Art. 92). The claims determine the extent of the protection which will be conferred by the European patent if granted (Art. 69(1)).

Art. 92
Art. 69(1)
Rule 43(6)

3.2 Interpretation of claims

The search is on the one hand not restricted to the literal wording of the claims, but on the other hand is not broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings. The search division may need to consider the contents of the description and/or drawings when performing the search in order to:

Prot. Art. 69
Art. 92

(i) identify the technical problem and its solution;

(ii) establish definitions of unclear terms not defined in the claims;

(iii) establish definitions of clear terms given a definition different from their usual meaning;

(iv) ascertain the existence of a fallback position.

The objective of the search is to identify prior art which is relevant to novelty and/or inventive step (see B-II, 2). The search is directed to what appear to be the essential features of the invention and take into account any changes in the (objective) technical problem underlying the invention which may occur during the search as a result of the retrieved prior art (see B-IV, 2.3 and 2.4 and G-VII, 5.2).

When interpreting claims for the purpose of the search, the search will also take into consideration prior art incorporating technical features which are well-known equivalents to the technical features of the claimed invention, which may undermine inventive step (see G-VII, Annex, 1.1(ii)).

3.2.1 Claims with explicit references to the description or drawings

Although explicit references in the claims to features elucidated in the description or in the drawings are only permissible where "absolutely necessary" (Rule 43(6) – see also B-III, 3.5 and F-IV, 4.17), claims containing such references are still searched if these technical features are unambiguously defined by specific parts of the description.

However, where the reference does not clearly identify which subject-matter of the description and/or drawings is to be considered as included in the claim, an invitation under Rule 63(1) is issued. In the special case of "omnibus claims" (e.g. a claim reading "The invention substantially as herein described"), no invitation under Rule 63(1) is issued, and subsequently the search report will be designated as complete. This means that subject-matter of the above kind will be dealt with only during examination.

The procedure above is followed regardless of whether or not the reference to the drawings and/or the description is allowable according to Rule 43(6). In either case, the claim will have the same scope: if the reference is not allowable under Rule 43(6), the applicant will be requested to copy the definition of the technical feature from the description and/or drawings into the claim; if the reference is allowable, the claim will stay as it is.

However, where the reference does not appear to be justified, the search division then raises an objection according to Rule 43(6) in the search opinion (if applicable – see B-XI, 7).

3.2.2 Use of the description and/or drawings to identify the technical problem

According to Rule 42(1)(c) the description must (at least implicitly) mention the technical problem the application intends to solve (see also F-II, 4.5). This allows the technical problem underlying the invention to be recognised despite the fact that it might not be immediately apparent from the claims.

However, if the objective technical problem addressed by the claimed invention changes in view of the retrieved prior art (see G-VII, 5.3, H-V, 2.4 and T 39/93, OJ EPO 1997, 134), it has to be redefined such that it remains related to the problem initially (explicitly or implicitly) mentioned in the application (see G-VII, 5.2; see also T 184/82, OJ EPO 1984, 261 and T 732/89).

3.2.3 Use of the description and/or drawings to establish definitions of unclear terms not defined in the claims

Some technical features of the claims may be defined by unclear terms so that the scope of the claims cannot be determined unambiguously. In such cases, the description and/or drawings is/are used to interpret the meaning of the terms in question (see F-IV, 4.2).

For example:

Claim 1: Pneumatic tyre comprising a wide groove disposed in a tread portion, characterised in that the wide groove is provided on the groove bottom with at least one longitudinal rib extending in the longitudinal direction of the wide groove.

Description: The term "wide", as used in the context of the present invention, means not less than 20mm wide.

The term "wide" in claim 1 is unclear, since it is a relative term with no well-defined meaning in this technical field. Consequently the scope of the claim is unclear (F-IV, 4.6, Art. 84). However, the description gives an unambiguous definition of this term. The definition of "wide" as being "not less than 20mm wide" is taken into account when the search is carried out (subsequently, an objection to the clarity of the term "wide" is raised in the search opinion according to Art. 84, second sentence). The definition of "wide" in the description is also a fallback position (see B-III, 3.2.5).

3.2.4 Use of the description and/or drawings to establish definitions of clear terms given a definition different from their usual meaning

In some applications the meaning given to a technical term by the description and/or the drawings differs from the commonly recognised meaning of that term in the technical field of the application. This may lead to the meaning of the term (and so the scope of the claim) becoming broader (see Example 1) or narrower (see Example 2).

Example 1

Claim 1: Halide salt of compound A

Normally the term "halide salt" means fluoride, chloride, bromide or iodide salt.

Description: In the context of the present invention the term halide salt means fluoride, chloride, bromide, iodide or tosylate salt.

In this example, the claim at first sight appears to be clear, since it makes use of a technical term ("halide salt") with a clear and well-established meaning in the technical field of the application. However, the description defines this term in such a way that it has a meaning broader than its well-established one (here the meaning of this term is extended to include tosylate salt).

Example 2

As Example 1, but the description defines "halide salt" as meaning fluoride, chloride or bromide salt.

In this example, the meaning of "halide salt" is narrower (it does not cover iodide salt) than in its established definition.

In both cases the search takes into account the definition of the terms as generally recognised in the technical field of the application as well as their definition as laid down in the application itself.

3.2.5 Ascertaining the existence of a fallback position

A claim may contain undefined, unclear terms for which no clear preferred embodiments are given in the claims but where clear preferred embodiments (i.e. a "fallback position", as referred to in B-III, 3.2(iv)) of that unclear term are expressed in the description and/or drawings (see B-III, 3.2.3). In such a case, the search will be based on the broadest technically sensible interpretation of the term. If, however, the meaning of the term in question is so unclear that no meaningful search can be carried out, it is justified to limit the scope of the search according to Rule 63.

3.3 Amended claims or missing parts (Rule 56)

3.3.1 General considerations

Rule 56
Rule 137(1)

Where a European application does not derive from an earlier international application, the applicant may not amend the claims before receiving the European search report (Rule 137(1)). Consequently, in these cases, the search is directed to the claims as originally filed, in the European application, or to the set of claims filed according to Rule 57(c) or 58.

If the application documents used for the search contain missing parts of description and/or missing drawings filed under Rule 56(3) (see H-IV, 2.3.2) and the search division expects the application to be re-dated by the examining division at a later stage of the procedure (see C-III, 1), it extends the scope of the search, such as also to cover prior art which will be relevant for assessing the novelty and inventive step of the subject-matter claimed on the basis of a possible new date of filing of the application (see also B-XI, 2.1). The same applies to Euro-PCT applications when the application contains missing parts of the description, drawings or claims and/or missing elements filed under Rule 20.6 PCT.

3.3.2 Specific rules applicable to Euro-PCT applications

Rule 159(1)(b)
Rule 161

Where a European application derives from an earlier international application, applicants may have amended the international application in the international phase, either after receipt of the international search report (Art. 19(1) PCT) or during international preliminary examination (Art. 34(2)(b) PCT). Applicants may then specify that they wish to enter the European phase with these or otherwise amended application documents (including claims) according to Rule 159(1)(b). Furthermore, applicants are given the opportunity by the EPO to amend the application documents (including the claims) within a set time limit (Rule 161(2), see E-IX, 3). The

application as amended serves as the basis for any supplementary European search which has to be performed pursuant to Art. 153(7) (see B-II, 4.3 and B-XI, 2).

Where the claims of an international application on entry into the European (regional) phase are amended in such a way as to contravene Art. 123(2), the procedure explained in B-VIII, 6 applies.

3.4 Abandonment of claims

Rule 45(3)
Rule 162(4)

For European applications, claims that are deemed to have been abandoned for non-payment of fees must be excluded from the search. The claims which have actually been taken into account for the purposes of the search are identified in the search report. This applies both to searches to be carried out in respect of directly-filed European applications and to supplementary European searches to be carried out in respect of Euro-PCT applications entering the European phase (see B-II, 4.3).

3.5 Anticipation of amendments to claims

In principle, and in so far as possible and reasonable, the search covers the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (see, however, B-VII, 1.3 in the case of lack of unity and H-II, 6 for the ambit of Rule 137(5)).

Example

Where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search includes this circuit.

However, it is not sufficient for the application as filed to contain one broad claim, with no dependent claims, in order to be entitled to a search to all the features of a large number of embodiments covered by the wording of that claim (see T 1679/10).

3.6 Broad claims

Art. 83
Art. 84

No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they relate to matter which is sufficiently disclosed in the application (Art. 83), and are supported by the description (Art. 84).

Example 1

If the claims in an application relating to and describing in detail an automatic telephone exchange are directed to an automatic communication switching centre, the search is not extended to automatic telegraph exchanges, data switching centres etc. merely because of the broad wording of the claim, but only if it is probable that such an extended search could produce a document on the basis of which a reasonable objection as regards lack of novelty or inventive step could be established.

Example 2

If a claim is directed to a process for manufacturing an "impedance element" but the description and drawings relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance element could be manufactured by the process of the invention, extension of the search to embrace, say, manufacture of capacitors would not normally be justified.

Example 3

If the main claim relates to the chemical treatment of a substrate, whereas it appears from the description or all the examples that the problem to be solved is solely dependent on the nature of natural leather, the search is not extended to the fields of plastics, fabrics or glass.

Example 4

If the description and drawings are directed to a lock with a safety cylinder whereas the claims refer to a device allowing the indexation of the angular position of a first element with respect to two other rotating elements, then the search is limited to locks.

In exceptional cases where the lack of disclosure or support is such as to render a meaningful search over the whole of the scope of the claim(s) impossible, application of the procedure for an incomplete search or a declaration taking the place of a search report under Rule 63 may be appropriate (see B-VIII, 3).

3.7 Independent and dependent claims

Rule 43(4)

The search carried out in sections of the documentation to be consulted for the independent claim(s) must include all dependent claims (for cases not complying with Rule 43(2), see B-VIII, 4). Dependent claims are interpreted as being restricted by all features of the claim(s) upon which they depend. Therefore, where the subject-matter of an independent claim is novel, that of its dependent claims will also be novel (see, however, F-VI, 2.4.3). When the patentability of the subject-matter of the independent claim is not questioned as a result of the search, there is no need to make a further search or cite documents in respect of the subject-matter of the dependent claims as such (see, however, B-II, 4.2(iii) and B-XI, 1.2).

Example 1

In an application relating to cathode ray oscilloscope tubes, in which the independent claim is directed to specific means along the edge of the front of the tube for illuminating the screen and a dependent claim is directed to a specific connection between the front and the main part of the tube, the search division searches, in the sections of the documentation it consults for searching the illumination means, also for the connecting means whether in combination with the illumination means or not. If, after this search, the patentability of the illuminating means is not questioned, the search division does not extend its search for the connecting means to

further sections of the documentation which are likely to contain material pertinent to or specifically provided for these connections.

Example 2

If in an application dealing with a pharmaceutical composition for treating nail infections the patentability of the subject-matter of the independent claim relating to specific combinations of the active ingredients is not questioned as a result of the search, there is no need to continue the search for dependent claims dealing with the use of a specific volatile organic solvent as a carrier in the composition.

3.8 Search on dependent claims

However, where the patentability of the subject-matter of the independent claim is questioned, it may be necessary for assessing whether the subject-matter of the dependent claim as such is novel and involves an inventive step to continue the search in other sections of the documentation, e.g. in one or more additional classification units. No such special search is made for features that seem *prima facie* trivial or are generally known in the art. However, if a handbook or other document showing that a feature is generally known can be found rapidly, it may be cited (see G-VII, 6(iii)). When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the independent claim), the dependent claim is to be considered in combination with the features in the independent claim and is dealt with accordingly (see F-IV, 3.4).

3.9 Combination of elements in a claim

For claims characterised by a combination of elements (e.g. A, B and C) the search is directed towards the combination. However, when searching sections of the documentation for this purpose, sub-combinations, including the elements individually (e.g. A and B, A and C, B and C, and also A, B and C separately) are searched in those sections at the same time. A search in additional sections of the documentation either for sub-combinations or for individual elements of the combination is only performed if this is still necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

3.10 Different categories

When the application contains claims of different categories, all these must be included in the search (for cases not complying with Rule 43(2), see B-VIII, 4). However, if a product claim clearly seems to be both new and non-obvious, the search division makes no special effort to search claims for a process which inevitably results in the manufacture of that product or for use of the product (see F-IV, 3.8 and G-VII, 13). When the application contains only claims of one category, it may be desirable to include other categories in the search. For example, generally, i.e. except when the application contains indications to the contrary, one may assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products are only searched when they form the subject of one or more

claims; but the final products will always have to be searched, except when they are evidently known.

3.11 Subject-matter excluded from search

Rule 63
Rule 62a

The search division may exclude certain subject-matter from its search. These exclusions may result from certain subject-matter not complying with the provisions of the EPC relating to exclusions from patentability or to susceptibility to industrial application (see B-VIII, 1 and 2). They may also arise where the application does not comply with the provisions of the EPC to such an extent that a meaningful search is impossible for some or all of the claims, or for a part of a claim, for other reasons (see B-VIII, 3) or where the application does not comply with Rule 43(2) (see B-VIII, 4).

3.12 Lack of unity

Rule 64

Also, when the claims of the application do not relate to one invention only, nor to a group of inventions linked so as to form a single general inventive concept, the search will normally be restricted to the invention or the linked group of inventions first mentioned in the claims (see B-VII and F-V, 3.4). Restriction of the search for the above reasons will be notified to the applicant in a communication accompanying the partial search report (see B-VII, 1.2).

3.13 Technological background

In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention. This would include:

– the preamble to the first claim, i.e. the part preceding the expression "characterised by" or "characterised in that";

– the state of the art which in the introduction of the description of the application is said to be known, but not identified by specific citations;

– the general technological background of the invention (often called "general state of the art").

Chapter IV – Search procedure and strategy

1. Procedure prior to searching

Upon creation of a European search report, a European search opinion or a clarification request under Rule 62a and/or 63(1), a pre-search algorithm generating a list of documents to be inspected by the search division is triggered. This creates a marker which serves as evidence in the file that the search division has started the search. The date of the start of the search is relevant for a possible refund of the search fee in case the application is withdrawn, refused or deemed to be withdrawn (see A-X, 10.2.1).

1.1 Analysis of the application

When taking up an application to be searched, the search division first considers the application in order to determine the subject of the claimed invention taking account of the guidance given in B-III, 3. For this purpose it makes a critical analysis of the claims in the light of the description and drawings. The search division in particular considers the content of the claims, description and drawings sufficiently to identify the problem underlying the invention, the inventive concept leading to its solution, the features essential to the solution as found in the claims and the results and effects obtained (see, however, B-III, 3.5). Furthermore, where technical features which are not present in the claims are indicated in the description as essential for the solution of the stated problem, these features are included in the search (see F-IV, 4.3(ii) and T 32/82).

1.2 Formal deficiencies

If the search division notices any formal shortcomings which have been overlooked by the Receiving Section, it calls these, by means of an internal communication, to the attention of the Receiving Section (or of the examining division in the case of an additional search requested by that division) which takes appropriate action. However, the search division does not repeat the tasks of the Receiving Section and does not undertake any time-consuming enquiries into these matters. Such deficiencies which the search division might notice include:

Art. 90(1)
Art. 92
Art. 78
Art. 53(a)
Rules 30 to 34, 40 to 50 and 55 to 58

(i) physical deficiencies of the application (see A-III, 3.2), including:

Art. 90(3)
Rule 57

(a) no electronic sequence listing (Rule 30(1), OJ EPO 2011, 372, OJ EPO 2013, 542);

(b) incorrect sequence and/or positioning of page numbering and/or failure to use Arabic numerals in page numbering (Rule 49(6));

(c) presence of drawings in the description and/or claims (Rule 49(9));

(d) presence of erasures and/or alterations in the application documents, such that the authenticity of the content and/or the

requirements for good reproduction are jeopardised (Rule 49(12));

Art. 53(a) Rule 48(1)(a) and (b)

(ii) presence of prohibited matter in the application:

(a) which is contrary to "*ordre public*" (see A-III, 8.1, F-II, 7.2 and G-II, 4.1, 4.1.1 and 4.1.2); or

(b) constituting disparaging statements (see A-III, 8.2). Note, however, that fair comment as referred to in F-II, 7.3 is permitted;

Rules 31 to 33

(iii) failure to comply with the provisions relating to the deposition of biological material (see A-IV, 4), in particular with regard to the correct identification in the application of the depositary institution and accession number of the biological material assigned to the deposited material by the depositary institution (Rule 31(1)(c), see G 2/93 and A-IV, 4.2).

(iv) failure to correctly identify the application as a divisional application within the meaning of Art. 76(1) (see A-IV, 1.3.2, Rule 41(2)(e)).

(v) presence of text in two different EPO official languages (Art. 14).

1.3 Documents cited or supplied by the applicant

Rule 66 Rule 141

Under the utilisation scheme (see Rule 141(1) and B-XI, 9, as well as OJ EPO 2010, 410), for applications where a priority is claimed the applicant is expected to file a copy of the results of any search carried out by the office of first filing (for more details see A-III, 6.12)

If the prior-art information of the office of first filing is made available before the search is completed, the search division checks these citations and evaluates their relevance to examination and in the definition of the search strategy.

Documents cited in the application under consideration are examined if they are cited as the starting point of the invention, as showing the state of the art, or as giving alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the content of the application. However, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded.

In the exceptional case that the application cites a document that is not published or otherwise not accessible to the search division, and the document appears essential to a correct understanding of the claimed invention to the extent that a meaningful search of at least part of it would not be possible without knowledge of the content of that document, the search division despatches an invitation under Rule 63 (see B-VIII, 3) containing the following information:

(i) which cited document is needed;

(ii) why the document is needed;

(iii) the consequences of not supplying the document in time (see below).

In reply to this communication, the applicant can:

(a) either submit a copy of the document in question;

(b) or argue why the document in question is not essential for carrying out a meaningful search of the claimed invention, and/or indicate a part of the application whose subject-matter can be searched without knowing the content of the document in question.

If no copy of the document is received within the time limit according to Rule 63(1) and the applicant is unable to convince the search division in a timely response to the Rule 63(1) invitation that the document is not essential to facilitate a meaningful search, an incomplete search report or, where applicable, a declaration replacing the search report under Rule 63 is prepared (see B-VIII, 3.2.1). This incomplete search report or declaration will be issued giving the following grounds:

(1) the non-availability of the document rendered the claimed invention insufficiently disclosed within the meaning of Art. 83; and

(2) the insufficient disclosure mentioned in (1) existed to such a degree that a meaningful search was not possible on at least part of the claimed invention (see B-VIII, 3).

Where the applicant furnishes the document after the search report and the search opinion (if applicable, see B-XI, 7) have been prepared, an additional search on that subject-matter originally excluded from the search may be carried out due to the correction of the deficiency which led to the incomplete search (see C-IV, 7.2).

However, applicants must be aware that information contained in documents referred to in the application can only be taken into account for sufficiency of disclosure pursuant to Art. 83 under the circumstances indicated in F-III, 8.

2. Search strategy

2.1 Subject of the search; restrictions

Rule 63
Rule 62a

Having determined the subject of the invention as outlined in B-IV, 1.1, it may be desirable for the search division to prepare first a search statement, defining the subject of its search as precisely as possible. In many instances one or more of the claims may themselves serve this purpose, but they may have to be generalised in order to cover all aspects and embodiments of the invention. At this time, the considerations relating to subjects excluded from patentability (see B-VIII, 1 and 2) and to lack of unity of invention (see B-VII, 1.1) is to be borne in mind. The search division may also have to restrict the search because claims are deemed abandoned (see B-III, 3.4), because the requirements of the EPC are not

met to such an extent that a meaningful search is impossible (see B-VIII, 3) or because the application does not comply with Rule 43(2) (see the procedure defined in B-VIII, 4). Any such restrictions to the search must be indicated in the search report or declaration taking the place of the search report under Rule 63. The declaration must indicate the reasons for any restrictions under Rule 63 (see B-X, 8(iii)). The declaration or the incomplete search report is considered, for the purposes of subsequent proceedings, as the search report.

2.2 Formulating a search strategy

Next the search division starts the search process by formulating a search strategy, i.e. a plan consisting of a series of search statements expressing the subject of the search, resulting in sections of the documentation to be consulted for the search. In its initial phase, a search strategy will contain one or more combinations of the basic components mentioned in B-III, 2.2. The search process is interactive and iterative in the sense that the search division reformulates its initial search statement(s) according to the usefulness of the information retrieved (see B-III, 1.1 and B-IV, 2.4 and 2.6). When using classification groups, the search division selects the classification groups to be consulted for the search, both in all directly relevant fields and in analogous fields.

The search division will, when appropriate, also consult other classification (e.g. FI) or indexing (e.g. F-terms) schemes. Consultation of colleagues in a similar technical field or in fields possibly related to the content of the application is also a possibility (see B-I, 2.1).

When in doubt about the appropriate fields in which to conduct the search, the search division may request advice from the appropriate classification expert.

Usually various search strategies are possible, and the search division exercises its judgement, based on its experience and knowledge of the available search tools, to select the search strategy most appropriate to the case in hand. The search division gives precedence to search strategies yielding sections of the documentation in which the probability of finding relevant documents is highest. Usually the main technical field of the application will be given precedence, starting with the basic components (see B-III, 2.2) most relevant to the specific example(s) and preferred embodiments of the claimed invention. In considering whether to extend the search to other less relevant sections of the documentation, the search division always takes account of the search results already obtained.

2.3 Carrying out the search; types of documents

The search division then carries out the search, directing its attention to documents relevant for novelty and inventive step.

It also notes any documents that may be of importance for other reasons, such as:

(i) conflicting documents (see B-VI, 4) which are:

(a) published European applications under Art. 54(3) (see G-IV, 5.1 and 5.1.1);

(b) published international applications under Art. 54(3) and Art. 153(3) and (5) (see G-IV, 5.2);

(c) published national applications of EPC contracting states under Art. 139(2) (see G-IV, 6 and H-III, 4.4);

(d) any document published during the priority interval of the application which may be relevant under Art. 54(2) in the case of a non-valid priority date.

When published within the priority interval of the application under search, these applications are cited in the search report as "P" documents (see B-X, 9.2.4); when published on or after the European or international filing date, they are cited in the search report as "E" documents (see B-X, 9.2.6);

(ii) documents putting doubt upon the validity of any priority claimed (see B-VI, 3 and F-VI, 1.4.1), which are cited in the search report as "L" documents (see B-X, 9.2.8(a));

(iii) documents contributing to a better or more correct understanding of the claimed invention, which are cited in the search report as "T" documents (see B-X, 9.2.5);

(iv) documents illustrating the technological background, which are cited in the search report as "A" documents (see B-X, 9.2.2);

(v) European patent applications having the same filing or priority date as the application in respect of which the search is carried out, from the same applicant and relating to the same invention and therefore relevant to the issue of double patenting (see G-IV, 5.4), which are cited in the search report as "L" documents (see B-X, 9.2.8 (c));

(vi) documents indicating or establishing the publication date of a document drawn from the internet (see G-IV, 7.5), which are cited in the search report as "L" documents (see B-X, 9.2.8 (b)); and

(vii) documents retrieved from the internet which do not have any publication date but which the search division nonetheless wants to cite to inform the applicant or third parties (see G-IV, 7.5.4), which are also cited as "L" documents (see B-X, 9.2.8).

However, the search division does not spend a significant amount of time in searching for these documents, nor in the consideration of such matters

unless there is a special reason for doing so in a particular case (see B-VI, 5.3 and B-XI, 4).

2.4 Reformulation of the subject of the search

The search division does continuously evaluate the results of its search, and if necessary reformulates the subject of the search accordingly. For example, the selection of the classification units to be searched or the order of searching them may also require alteration during the search as a consequence of intermediate results obtained. The search division also uses its judgement, taking into account results obtained, in deciding at any time during the systematic search whether it needs to approach the search documentation in some different manner, e.g. by consulting:

(i) documents cited in relevant documents produced by the search, for example cited in the description or search report of a patent document; or

(ii) documents citing a relevant document produced by the search,

or whether it needs to turn to documentation outside that which is available to the search divisions in-house (see B-IX). When searching external document collections for material in relation to unpublished subject-matter using other than secure connections, like the internet, the search division must be extremely careful when formulating search strategies so as not to unwittingly reveal confidential material – i.e. any part of the unpublished patent application (see B-III, 2.4).

2.5 Closest prior art and its effects on the search

It may happen that the search division does not find any documents published before the earliest priority date which prejudice the novelty or the inventive step of the claimed invention. In such cases, the search division cites, whenever possible, in the search report at least that prior art found in the course of search which discloses a solution to the same problem as that underlying the claimed invention (wherein this problem may change depending on the prior art retrieved (G-VII, 5.2) and wherein the known solution is technically the closest to the claimed solution ("closest prior art"). Such prior art is to be cited as an "A" document in the search report (see B-X, 9.2.2).

If such a document cannot be found, the search division cites as the closest prior art a document which solves a problem closely related to the problem underlying the claimed invention and wherein the solution is technically most similar to that of the application under search.

Where the search division retrieves documents which are incidentally prejudicial to the novelty of the claimed invention (to be cited as "X") but which do not affect the inventive step thereof after appropriate amendment of the application, and does not retrieve any other documents prejudicing inventive step, it also proceeds as above.

In the case of a European application derived from an international application and being subjected to a supplementary European search after

entering the European phase (Art. 153(7) – see B-II, 4.3), it is possible that the search division does not uncover any further relevant prior-art documents in the search over and above the documents already cited in the international search report by the International Searching Authority. In such cases, it is permissible to have no further relevant documents in the supplementary European search report (see B-X, 9.1.4).

2.6 End of search

Reasons of efficiency dictate that the search division uses its judgement to end its search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when documents have been found clearly demonstrating lack of novelty in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination, application of which features would not involve inventive step. The search for conflicting applications (see B-VI, 4) is, however, always completed to the extent that these are present in the available documentation.

3. Procedure after searching

3.1 Preparation of the search report

After completion of the search, the search division selects from the documents retrieved the ones to be cited in the report. These always include the most relevant documents (which will be specially characterised in the report, see B-X, 9.2.1). Less relevant documents are only cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. In cases of doubt or borderline cases in relation to novelty or inventive step, the search division will cite rather more readily in order to give the examining division the opportunity to consider the matter more fully (see B-III, 1.1).

The search division does not cite more documents than is necessary and therefore, when there are several documents of equal relevance, the search report does not normally cite more than one of them. In any case, the search report is accompanied by an annex drawn up by computer and listing the patent documents which are available and belong to the same patent family. In selecting from these documents for citation, the search division pays regard to language convenience, and preferably cite (or at least note) documents in the language of the application (see B-X, 9.1.2).

3.2 Documents discovered after completion of the search

It may happen occasionally that, after completion of a search report, the search division discovers further relevant documents (e.g. in a later search for a related application). Such documents may be used in examination (see C-IV, 7.4).

3.3 Errors in the search report

When a material error is found to be present in a search report prior to publication thereof, a new search report will be drawn up which supersedes the preceding one. Where the search report has already been sent to the applicant according to Rule 65, but has not yet been published, the error is

immediately notified to the applicant. When a serious error is noted following publication of the search report, a corrigendum is published in the European Patent Bulletin, and the applicant and the examining division is informed accordingly. If the error comprises the transmission of an incorrect document as a citation, the correct document is sent.

Chapter V – Preclassification, IPC and CPC classification of European patent applications

1. Definitions

By "preclassification" is meant a first stage of classification, for purposes of internal application (file) routing and distribution, whereby the subject of the claimed invention (or the invention first claimed, if there is more than one) is broadly identified by means of the appropriate classification symbols.

By "IPC classification" is meant the assigning of the appropriate classification symbols according to the International Patent Classification (IPC), published by WIPO. See the WIPO website for the IPC edition in force, and the "Guide to the IPC", which sets forth principles and rules of classification.

By "CPC classification" is meant the assigning of the appropriate classification symbols according to the Cooperative Patent Classification (CPC), published by the EPO and the USPTO. See the CPC website for the CPC edition in force, and the "Guide to the CPC", which complements the "Guide to the IPC" in that it covers the distinguishing features of the CPC compared to the IPC.

2. Preclassification (for file routing and distribution)

In order for an application to be allocated correctly, a preclassification must be made. The level of classification at this stage is as general as practicable on the basis of a quick and cursory scrutiny of the document (e.g. the abstract and independent claim or claims). On the other hand, the level is specific enough to avoid the need for any intermediate stage of preclassification before the final allocation.

Classification at this stage is performed using IPC and/or CPC symbols and is indicated on the dossier and in the EPO's in-house electronic tool.

In most cases no further classification is required to enable applications to be distributed to the relevant search divisions. However, where necessary, it falls within the authority of the examiner in charge of the field to arrange for such redistribution in an expedient manner.

2.1 Incorrect preclassification

If, on reaching the search division, an application has been found to be incorrectly preclassified and thus inappropriately distributed, it is redistributed by the search division receiving it, indicating the appropriate amendments on the dossier and in the EPO's in-house electronic tool. Normally this is done by mutual agreement with the search division to which it is proposed to redistribute it. However, cases arise over which there is disagreement or uncertainty regarding classification boundaries, or where the search division dealing with the case is uncertain as to its correct preclassification. In such instances the search division having the case does not spend time in trying to resolve the matter, but forwards the file to one of a team of appointed specialists in classification matters.

3. IPC classification of the application

The IPC classification of the patent application is performed by the search division.

The IPC classification identifies all features relevant to the technical subject of the claimed invention (or of the subjects of each of the claimed inventions if there is more than one) as precisely and comprehensively as the IPC scheme permits.

The IPC classification consists of "invention information" symbols and "additional information" symbols (the latter encompassing the usage of IPC indexing codes) according to the IPC rules defined in the "Guide to the IPC". In addition, where it is necessary to assign more than one symbol for the invention itself, the symbol which in the search division's opinion most adequately identifies it, or, when this presents difficulties, the symbol which identifies the invention for which most information is given, is indicated first. Preferably, this classification is done when the search division has studied the content of the application in order to carry out the search. However, if publication of the application is due before the search report is drawn up, it is necessary for the search division to study the application sufficiently to determine the IPC classification at this earlier stage (see B-X, 5).

The IPC classification is determined without taking into consideration the probable content of the application after any amendment, since this classification relates to the disclosure in the published application, i.e. the application as filed. If, however, the search division's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search (e.g. as a result of prior art found or because of clarification of apparent obscurities), the search division will amend the classification accordingly, if the preparations for publication have not at that stage been completed.

3.1 IPC classification of late-published search reports

Where the search report is not available in time for publication of the application, and is therefore published separately, and the search division finds it necessary to amend the assigned IPC classification for the reasons given in B-V, 3, last paragraph, it states the amended classification on the search report, indicating that it constitutes the IPC classification in place of that published on the application (which thus becomes merely the "classification for publication"). Such amendment of the classification is not made unless the search division is quite certain that it is necessary.

Where a European patent application is classified and published without the European search report (A2 publication), the European search report is prepared and published separately after publication of the application (A3 publication). It may happen that a new edition of the IPC is published in the period between publication of the European application (A2 publication) and the separate publication of the search report (A3 publication). In this case, the search division uses for the search report that version of the IPC which was in force when the application was published.

3.2 IPC classification when the scope of the invention is not clear (e.g. a partial search)

When the scope of the invention is not clear, the classification has to be based on what appears to be the invention in so far as this can be understood. It is then necessary to amend it if obscurities are removed by the search, as discussed in B-V, 3, last paragraph.

3.3 IPC classification in cases of a lack of unity of invention

Where objection of lack of unity of invention arises, all inventions must be classified, since all will be disclosed in the published application. Each invention claimed is to be classified as set out in paragraphs B-V, 3 to 3.2.

3.4 Verification of the IPC classification

As a general rule, applications will not be systematically scrutinised after leaving the search division in order to verify the correctness of the IPC classification assigned by the search division. The Office may, however, institute such sampling check procedures as are deemed necessary to ensure correctness and uniformity in the application of the IPC. It is, of course, for the line managers to arrange for such checks as they consider necessary, having regard to the experience of their members, before the applications leave their units.

4. CPC classification of the application

The search division classifies a patent application under the provisions of the CPC as well as the IPC. In practice, classification is first performed in the CPC, and the relevant IPC symbols are then generated from the CPC allocations by one-to-one concordance (see the CPC to IPC Concordance List (CICL), published on the CPC website).

The CPC classification allocated is as precise and comprehensive as the classification system permits. The CPC comprises "invention information" symbols and "additional information" symbols. Additional information symbols encompass the use of CPC indexing codes. Where it is necessary to assign more than one CPC classification symbol for the invention itself, the symbol which, in the search division's opinion, most adequately identifies the invention, or, when this presents difficulties, the symbol which identifies the invention for which most information is given, is indicated first.

As with the IPC, CPC classification preferably takes place when the search division has studied the content of the application in order to carry out the search.

As for the IPC classification, the CPC classification is determined without taking into consideration the possible future content of the application after any amendment, since the classification relates to the disclosure of the published application, i.e. the application as filed.

However, if the search division's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search, the search division amends the CPC classification accordingly, making use of the appropriate classification tools. Unlike changes to the

IPC classification (see B-V, 3 above), this amendment can be made even after the preparations for publication have been completed.

When the scope of the invention is not clear (e.g. a partial search is necessary) or in the case of lack of unity of invention, the principles described in B-V, 3.2 and 3.3 for the IPC classification apply equally to the CPC classification.

Chapter VI – The state of the art at the search stage

1. General

The general considerations relating to the state of the art and patentability, especially with regard to the determination of novelty and inventive step, are set out in G-IV.

2. Oral disclosure, use, exhibition, etc. as state of the art

According to Art. 54 EPC, a public oral description, use, exhibition, etc. is considered as prior art if the facts of the disclosure can be proved. In particular, a written document confirming the oral disclosure can even be published after the filing date of the application being searched as it is the date of the oral disclosure which is decisive under Art. 54(2).

However, the search division, in carrying out a European search, cites an oral description, etc. as prior art only if it has available a written confirmation or is otherwise convinced that the facts can be proved: the date of the non-written disclosure is given as the relevant date (see G-VI, 3); the date of the eventual written disclosure must also be indicated. *Rule 61(4)*

Such references to oral disclosure, prior public use, disclosure by sale, etc. are more usually brought up by opponents in opposition proceedings (see G-IV, 7.1 to 7.4).

3. Priority

If the claimed priority dates cannot be verified at this stage, uncertainty will exist as regards their validity and the search for conflicting applications is extended so as to cover all published applications with an earliest claimed priority date up to the filing date (not the claimed priority date(s)) of the application under consideration (see B-IV, 2.3 and B-XI, 4).

4. Conflicting applications

4.1 Potentially conflicting European and international applications

Generally, where the search is concluded less than eighteen months after the European or international filing date of the application (the filing date according to Art. 80 and not its claimed priority date(s)), it will not be possible at the time of the search to make a complete search for potentially conflicting European and international applications. This search therefore has to be completed at the examination stage by the examining division (see C-IV, 7.1). If the search division becomes aware of potentially conflicting published documents, these documents are cited in the search report. *Art. 54(3)*

Patent documents, regardless of their state or region of origin, which have a filing or valid priority date prior to the filing date of the application being searched (not the priority date), but which are published on or after the filing date of the application being searched and contain novelty-destroying

subject-matter for at least one independent claim of the application, are referred to as "E" documents, see B-X, 9.2.6.

"E" documents cited in an EP search report can be other EP or WO applications with an earlier priority date (Art. 54(3)) which are relevant because they anticipate the novelty of the subject-matter claimed in the application being searched.

In this regard it must be stressed that the "E" document is novelty-destroying prior art under Art. 54(3) if it discloses the subject-matter in question in any of its parts (i.e. claims, description or drawings).

4.1.1 Published European applications as "E" documents

(a) For European applications filed between 1 July 1997 and 12 December 2007, since the designation fees for European applications are paid after publication of the application (Art. 79(2) EPC 1973), the application is published with all EPC contracting states automatically designated (OJ EPO 1997, 160). However, the automatic designations made on publication of a European application are retroactively invalidated according to Rule 23a EPC 1973 for the purposes of Art. 54(3) and (4) EPC 1973 if the relevant designation fees are not paid on time.

This means that when a European application is retrieved which is potentially relevant as an "E" document by virtue of its novelty-destroying subject-matter and earlier priority rights, and this document is filed after the change in the rule on the designation of states (which happened on 1 July 1997) and before the entry into force of EPC 2000, it is not immediately recognisable from the published document which contracting states have been validly designated. Consequently, this document is always cited as an "E" document (i.e. assuming that it shares validly designated states in common with the application being searched).

(b) For European patent applications filed on or after 13 December 2007, any European patent application having an earlier filing date and published on or after the date of filing of the application under examination is considered to be state of the art for the purposes of Art. 54(3), regardless of the commonly designated states.

4.1.2 Published international applications (WO) as "E" documents

(a) According to Art. 158(1) EPC 1973, a conflicting PCT application that validly entered the European phase before 13 December 2007 and was retrieved as an "E" document in the search for a European application will constitute prior art within the meaning of Art. 54(3) and (4) EPC 1973 only if:

– the EPO has been designated in the international application,

– where necessary, the applicant has supplied to the EPO a translation of the international application into an official EPO language, and

– the applicant has paid the EPO's national basic fee (the same as the filing fee) according to Rule 107(1)(c) EPC 1973 and the EPO's designation fees according to Rule 107(1)(d) EPC 1973.

(b) A conflicting PCT application that entered the European phase on or after 13 December 2007 and was retrieved as an "E" document in the search for a European application will constitute prior art within the meaning of Art. 54(3) only if according to Rule 165:

– the EPO has been designated in the international application,

– where necessary, the applicant has supplied to the EPO a translation of the international application into an official EPO language according to Art. 153(4) and Rule 159(1)(a), and

– the applicant has paid the filing fee according to Rule 159(1)(c).

If it is not possible to verify any of the above based on the published international (WO) application (in particular because the 31-month time limit for performing the above acts under Art. 22 PCT and Art. 39 PCT has not yet expired for the international application at the time of the search), the document may become relevant under Art. 54(3) and consequently is cited as an "E" document in the search report (see also B-X, 9.2.6).

4.2 National earlier rights

There may also be national applications of one or more states designated in the European application of which the dates of filing are prior to the filing or priority date of the European application, and which were published as national applications or patents on or after that date. Although such applications are not a bar to the grant of a European patent, but only a ground for revocation in the Contracting State(s) concerned, they may be of importance to the applicant (see H-III, 4.4). Therefore, any of these which are present in the documentation are noted and mentioned in the search report for information (see B-X, 9.2.6).

Art. 139(2)

5. Date of reference for documents cited in the search report; filing and priority date

5.1 Verification of claimed priority date(s)

Where the validity of the priority claim cannot be verified at the search stage (see B-XI, 4), the basic reference date for the search must be taken as the date of filing of the European application as accorded by the Receiving Section. (For the reference date for the search with respect to conflicting applications, see, however, B-VI, 3).

Art. 80
Rule 40
Art. 90(3)
Art. 54(2)

5.2 Intermediate documents

The search division takes into account documents published between the earliest priority date and the filing date of the application under consideration, and these documents are identified as such in the search report (see B-X, 9.2.4). For identifying these documents when an application has more than one priority date, the oldest date is to be applied. When deciding which documents to select for citing in the search report, the search division refers to these dates and chooses preferably any document published before the date of priority. Thus, for example, where there are two equally relevant documents, one published before the date of priority and the other after that date but before the date of filing, the search division will choose the former (see B-IV, 3.1, second paragraph).

5.3 Doubts as to the validity of the priority claim; extension of the search

It is the responsibility of the examining division to check whether and to what extent the priority claim is justified. However, where intervening state of the art (see B-VI, 5.2) or potential state of the art according to Art. 54(3) is revealed in the search, the search division checks, if possible, the validity of the priority claim (see B-XI, 4, F-VI, 1.2 to F-VI, 1.5 and F-VI, 2). Furthermore, if a document showing that a priority claim might not be justified (e.g. an earlier application or patent from the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned) is found during the search, it will be cited in the search report (see B-X, 9.2.8). However, no special search effort is normally made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation-in-part" of an earlier application from which no priority is claimed (see B-IV, 2.3 and F-VI, 2.4.4). Sometimes the fact that the country of residence of the applicant is different from the country of the priority application may also be an indication that it is not a first filing, justifying a certain extension of the search.

When the search is extended for this purpose, it is directed to:

(i) published patent documents filed earlier than the claimed priority date.

Example 1 (assuming that the applicant is the same for all applications):

date:	application:	subject-matter:
01.03.98	GB1 filed	A
30.05.98	GB2 filed	A
30.05.99	EP1 filed (claiming priority of GB2)	A
10.09.99	GB1 published	A

During the search for EP1, the search division retrieved published application GB1. GB1 may prejudice the priority claim of EP1, since it

was filed earlier than GB2. Published GB1 is, therefore, cited in the search report as an "L" document according to B-X, 9.2.8(a); or

(ii) published patent documents which claim priority from an application filed earlier than the priority date of the application being searched.

Example 2 (assuming that the applicant is the same for all applications):

date:	application:	subject-matter:
01.03.98	GB1 filed	A
30.05.98	GB2 filed	A
01.03.99	US1 filed (claiming priority of GB1)	A
30.05.99	EP1 filed (claiming priority of GB2)	A
15.04.00	US1 published	A

The publication US1 was found during the search for EP1. GB1 may prejudice the priority of EP1, since it was filed earlier than GB2. US1, which claims GB1 as priority, is, therefore, cited in the search report as an "L" document according to B-X, 9.2.8(a).

5.4 Documents published after the filing date

The search does not normally take into consideration documents published after the date of filing of the application as accorded by the Receiving Section.

However, certain situations may occur in which a document published after the filing date is relevant; examples are the written confirmation of an oral disclosures (see B-VI, 2), or a later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or a later document showing that the reasoning or the facts underlying the invention are incorrect (see B-X, 9.2.5). The search is not extended for this purpose, but documents of this nature known to the search division could be selected for citation in the report.

If priority is validly claimed (see B-VI, 5.1), the search also does not normally take into consideration documents published after the earliest validly claimed priority date as the latter counts under Art. 89 as the date of filing of the application. However, some extension is necessary for specific purposes, as is apparent from B-VI, 3, B-VI, 4 and B-VI, 5.3.

5.5 Non-prejudicial disclosures

Art. 55(1)(a) and (b)
Rule 25

Disclosures of the invention are not taken into consideration if they occurred no earlier than six months preceding the filing of the European patent application (see G 3/98 and G 2/99) and if they were due to an evident abuse in relation to the applicant or the legal predecessor, or due to display at an official, or officially recognised, international exhibition. The search division does, nevertheless, cite in the search report any documents

it has reason to believe come within one of the categories mentioned in B-X, 9.2.8. In this case, too, the reference date for the search will be the filing date of the application (see B-VI, 5.1 and B-XI, 4). Since the matter of abuse will generally only be raised after transmission of the search report and search opinion (if applicable, see B-XI, 7), and disclosure at an exhibition involves the question of identity between the displayed and claimed invention, both matters are investigated by the examining division.

5.6 Matters of doubt in the state of the art

Since decisions with respect to novelty are not the responsibility of the search divisions but of the examining divisions (see B-III, 1.1), the search divisions does not discard highly relevant documents because of doubt as regards for example the exact date of publication or public availability (e.g. standards or standard preparatory documents, see G-IV, 7.6), or the exact contents of an oral disclosure, exhibition, etc. to which such documents may refer. The search division tries to remove any doubt that may exist but does nevertheless always cite the documents concerned in the search report and also continues the search as though that document had not been found. Additional documents providing evidence in the matters in doubt may be cited (see B-X, 9.2.8). The search opinion contains details explaining the issue.

Any indication in a document of the date of its publication is accepted as correct unless sound reasons for contesting this are given, e.g. by the search division, showing earlier publication, or in examination proceedings by the applicant, showing later publication. If the indicated date of publication is insufficiently precise (e.g. because only a month or year is given) to establish whether publication was before the reference date for the search, the search division endeavours to establish the exact date with sufficient precision for the purpose. A date of receipt at the EPO stamped on the document, or a reference in another document, which must then be cited (see B-X, 9.2.8), may be of assistance in this respect. In the preparation of the search opinion and during substantive examination, the public availability of a document may be investigated (see C-IV, 1). Where, despite the endeavours of the search division, the date is not sufficiently precise to know whether or not the document was published before or after the priority or filing date, the search division cites the document as though it had been published on the earliest possible date. For instance, if only the month and year of publication are known, the search division cites it as being published on the first day of that month.

6. Contents of prior-art disclosures

6.1 General remark

As a general rule, the search division selects for citation only documents which are present in the search documentation or which it has access to in some other manner. In that way, no doubt exists about the contents of the documents cited, since the search division generally has physically inspected each document cited.

6.2 Citation of documents corresponding to documents not available or not published in one of the official EPO languages

Under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of content with another document which the search division has inspected; both documents are then mentioned in the search report in the manner indicated at the end of B-X, 9.1.2. For example, instead of the document published before the filing date in a non-EPO language and selected for citation, the search division may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in an official EPO language and possibly published after the filing date. Also, it may be assumed that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Further, it is normally assumed that the contents of a report of an oral presentation are in agreement with that presentation.

Before citing documents in a language with which it is not familiar, the search division must make sure that the document is relevant (e.g. through a machine translation, through translation by a colleague, through a corresponding document or abstract in a familiar language, or through a drawing or chemical formula in the document or by consulting database indexes relating to the technical content of that document (see B-X, 9.1.3)).

6.3 Conflict between abstract and source document

Where there is a problem with an abstract, either because it appears to conflict with the source document to which it relates or because it conflicts with other abstracts of the same source document, the search division will proceed as follows:

(i) where the source document is in an accessible language (in particular a language of an EPC contracting state) and either is directly available to the search division or may be ordered, the search division cites the source document;

(ii) where the document is in an inaccessible language (for example Russian, Japanese or Chinese) and/or is difficult to obtain, the search division cites the abstract. Where more than one abstract is available, the search division will cite the abstract most relevant to the claimed invention, regardless of any conflicts between that abstract and other abstracts or the source document.

The source document will be present in the search report as the "&" document of the cited abstract. Where it is available but is in an inaccessible language such as Japanese, both the source document and the abstract will be printed and sent to the applicant and included in the file (see B-X, 9.1.2). The search division must explain in the search opinion why it considers that there is a conflict.

Where an abstract conflicts with the source document to which it relates, to the extent that the abstract is incorrect it does not form part of the state of the art: the source document on which the abstract is based then forms the

state of the art (T 77/87). However, for the purpose of the search report and opinion, an abstract is considered a true representation of the content of the original document, unless the disparity between the two is evident. Being provided with both the abstract and the source document, the applicant will be able to compare both disclosures and reach conclusions about the technical validity of the abstract. The opportunity to refute the above assumption remains available in examination (for example, by providing a translation of the original document).

6.4 Insufficient prior-art disclosures

In general, the search division assumes that any technical subject-matter present in a prior-art document is sufficiently disclosed and consequently is part of the state of the art. Even in cases of doubt the document is cited in the search report in the normal way and relied upon for an appropriate objection in the search opinion. Only in clear cases of insufficient disclosure (see G-IV, 2) will such a document be discarded.

6.5 Incorrect compound records in online databases

If the search division retrieves a compound when interrogating a database created by abstracting source documents (e.g. patents, journal articles or books) and deriving the chemical compounds disclosed in those documents and, on reading the source document, is unable to locate the compound, this does not automatically mean that an error has been made and that the compound is not disclosed in the document. For example, disclosed compounds which are named but whose structures are not drawn are still part of the disclosure and will be abstracted. In addition, database providers use standard nomenclature in their database records, whereas authors of technical literature frequently do not. Consequently, the nomenclature used for the compound in the database record may not be the same as that used in the source document.

However, in certain cases the search division is really unable to locate the compound in the source document, and this compound is relevant to the assessment of patentability. In such cases, the search division may write to the database provider asking why the compound in question was abstracted from that document and where it is disclosed in it. If the reply from the database provider is not available when the search report is drafted, the document is cited in the search report and used in the search opinion on the assumption that the compound is disclosed in the document. However, the search division does also continue the search as though the compound did not exist.

7. Internet disclosures - technical journals

For some technical journals, the publisher's website displays the date(s) when publications occur electronically, in particular if these differ from the publication dates of paper publications (OJ EPO 2009, 456). A number of different situations may occur in the case of electronic publication, as described in G-IV, 7.5.3.1. In all these instances, the search division prints out the journal web page where the (electronic and paper) publication and pre-publication date(s) of the article or issue are mentioned, which is then cited in the search report as an "L" document. It is best to do so as soon as the evidence is found and not leave it until later, since the information may

be moved or removed from the website in the time which elapses between search and substantive examination.

Chapter VII – Unity of invention

1. General remarks

The requirement of unity of invention serves a regulatory function in the interest of an efficient procedure up to grant (T 110/82 and F-V, 6). It would be unfair to regard as having unity of invention those applications which, because of their heterogeneous content, entail a far greater than average expense to process, especially in respect of search, since this expense must partly be borne by the fees levied for other applications. A further aspect is the requirement for ready comprehensibility of the application's subject-matter, which may be impaired by heterogeneous subject-matter.

On the other hand, the general purpose of dealing with interconnected substantive issues within a single procedure would not be achieved if provisions relating to unity of invention were applied too strictly. For this reason, interconnected matter must not be split up needlessly (see F-V).

1.1 Partial European search report

Rule 64

If the search division considers that the European application does not comply with the requirement of unity of invention (see F-V, 1), it must search it, and draw up the partial European search report under Rule 64(1), for those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims (see F-V, 3.4). The partial European search report is supplemented with a specification of the separate inventions.

With regard to the search opinion in cases of a lack of unity of invention, see B-XI, 5.

1.2 Invitation to pay further search fees

Rule 64(1)
Point 6.1 AAD

The search division will inform the applicant of the lack of unity of invention in a communication accompanying the partial search report and will indicate that a further search fee must be paid for each invention other than the one first mentioned in the claims, if the search is to cover these inventions as well. A provisional opinion on the patentability of the invention or unitary group of inventions first mentioned in the claims (see F-V, 3.4) and the reasons for non-unity findings will be provided to the applicant. The provisional opinion will be sent together with the invitation to pay further search fees. The provisional opinion will be for information only. A reply addressing the points raised in the provisional opinion is not required and will not be taken into account when the extended European search report is issued (see the Notice from the EPO dated 3 March 2017, OJ EPO 2017, A20).

1.2.1 General

The payment of these fees must take place within a period of two months (Rule 64(1)). If the automatic debiting procedure is being used for the application, applicants must inform the EPO within this period if they do not want all or any of the further inventions to be searched. Otherwise all the further search fees due will be debited automatically on the last day of the period.

(a) If the applicant does not pay any further search fees within the time limit fixed, no further search is effected and the partial search report becomes the final search report which is accompanied by the search opinion. Nevertheless, the final decision on the question of unity of invention is taken by the examining division or, ultimately, the competent board of appeal (B-VII, 1.4 and C-III, 3.1.1).

(b) If the applicant pays further search fees within the time limit fixed, the search is completed for all inventions or groups of inventions in respect of which the further search fees have been paid. The final search report is then drawn up for all inventions for which (additional) search fees have been paid. The search opinion addresses any issue where the application in respect of the inventions for which additional search fees have been paid does not meet the provisions of the EPC (for example: Invention 1 was searched and the applicant paid an additional search fee for invention 3. The subject-matter of invention 3 lacks novelty. Thus, the search opinion covers invention 1 and raises objections as to lack of novelty for the subject-matter of invention 3.).

1.2.2 Cascading non-unity

If a lack of unity is raised at the search stage for an EP application, a search is conducted for the invention first mentioned in the claims (see F-V, 3.4) and the applicant is invited to pay additional search fees. Furthermore, the applicant is warned that, even if a further lack of unity "*a posteriori*" arises in the procedure, no further invitation to pay additional fees will be issued.

If the applicant pays any additional search fee, a search is carried out for the inventions for which those search fees have been paid.

If the search reveals that one or more of these inventions also lack unity "*a posteriori*", only the first invention of each of the groups of inventions is searched. No further invitation to pay further additional search fees is issued.

The search opinion is prepared, setting out the reasons for non-unity and giving an opinion on the patentability of the inventions paid for (see B-XI, 5).

Inventions that have not been searched can be filed as divisional applications in accordance with C-IX, 1.2.

Example

A lack of unity objection is raised identifying four different inventions A, B, C, D. The first invention A is searched and the applicant is invited to pay further search fees for inventions B, C and D. The warning clause mentioned above is used.

The applicant pays two further search fees for inventions B and C. During the additional search, B is found to lack unity "*a posteriori*" and is divided into groups of inventions B1, B2 and B3.

In this case only B1 and C are searched. In the ESOP, full reasoning must be given as to why the claims of the application were divided into A, B, C and D and why B was further subdivided into B1, B2 and B3. In the ESOP an opinion on patentability must be given for A, B1 and C.

Examination of the application in the European phase will be based on either A, B1 or C (see C-III, 3.1.2). The claims relating to inventions B2, B3 and D can be filed as divisional applications in accordance with C-IX, 1.2.

1.2.3 The applicant has not paid all additional search fees

The applicant needs always to make clear for which inventions the additional search fees have been paid. Hence, in cases where the applicant pays some, but not all, of the additional requested search fees and fails to indicate for which inventions payments have been made, the search division will make efforts to find out which inventions are to be covered by (an) additional search/searches.

1.3 Documents relevant only to other inventions

Whilst documents relevant only to other inventions may be retrieved during the search on the invention first mentioned in the claims, these are not necessarily included in the partial European search report. Such documents must, however, be cited in the partial search report if they form the basis for a lack of unity *a posteriori* (see F-V, 5 and 7).

1.4 Assessment and possible review of the unity requirement

At the search stage, the search division dealing with the question of unity applies the same criteria as in substantive examination (see F-V). In particular, it will not raise an objection of lack of unity merely because the inventions claimed are classified in separate classification groups, or merely for the purpose of restricting the search to certain sections of the documentation, for example certain classification groups (but see B-V, 3.3).

The assessment of unity cannot be made once and for all. Normally, the search division will develop a first view even before it carries out the search. This first assessment is necessarily made in a *prima facie* manner, on the basis of general knowledge and the statements of prior art contained in the application. During and after the search the assessment is reconsidered in the light of the documents found. The beginning of substantive examination is a further procedural step where the previous findings on unity are reconsidered. Even later in the proceedings the position adopted previously may be superseded in view of new facts and evidence.

As a general rule, a previous position on unity of invention is maintained unless strong reasons exist which lead to a situation where the position must be changed. The final decision on the question of unity of invention is taken by the examining division or, ultimately, the competent board of

appeal. Therefore, as a matter of principle, any previous finding on unity is open to review.

2. Procedures in cases of lack of unity

2.1 Request for refund of further search fee(s)

Rule 64(2)
Rule 164(5)

At the examination stage the applicant may contest the allegation of non-unity and request a refund of one or more of the further fee(s) paid. If the examining division finds this to be justified, the fee(s) in question will be refunded (see, however, B-XI, 1.2).

2.2 Complete search despite of lack of unity

Exceptionally, in cases of lack of unity, especially "*a posteriori*", the search division is able to make a complete search and prepare a search opinion (where applicable - see B-XI, 7) for all inventions with negligible additional work and cost, in particular when the inventions are conceptually very close. In those cases, the search for the further invention(s) is completed together with that for the invention first mentioned in the claims. All results are then included in a single search report, which raises the objection of lack of unity and identifies the different inventions. It further indicates that the search division did not invite the applicant to pay further search fee(s) because all claims could be searched without effort justifying such a fee. However, the search opinion (if applicable, see B-XI, 7) still raises the issue of unity of invention (see B-XI, 5).

2.3 Supplementary European search

Art. 153(7)
Rule 164(1)

When in a supplementary European search following an international (PCT) search a problem of unity of invention arises, a partial supplementary European search report is drawn up on the invention or group of inventions first mentioned in the claims (see F-V, 3.4) serving as basis for the supplementary European search (Rule 164(1)(a)), independently of the findings of the International Searching Authority as regards unity of invention. Together with this partial search report, the applicant receives an invitation to pay further search fees for each invention other than the one first mentioned in the claims (Rule 164(1)(b)), i.e. the same procedure is followed as for the non-unity invitation for EP direct applications under Rule 64(1) (see B-VII, 1.2). A provisional opinion on the patentability of the invention or unitary group of inventions first mentioned in the claims and the reasons for non-unity findings will also be provided.

3. Lack of unity and Rule 62a or Rule 63

The procedures for dealing with cases which lack unity and where Rule 63 or Rule 62a applies are dealt with in B-VIII, 3.4 and 4.5 respectively.

Chapter VIII – Subject-matter to be excluded from the search

1. General remarks

In relation to searches carried out for European patent applications, the subject-matter listed in Rule 39.1 PCT may be considered under the EPC either not to be susceptible of industrial application (Art. 57) or, to the extent to which the European patent application relates to that subject-matter as such, to be excluded from patentability under Art. 52(2) and (3), or to constitute an exception to patentability under Art. 53(b) and (c). The claims are not searched in as far as they relate to such subject-matter (for the procedure for limiting the search according to Rule 63 see B-VIII, 3.1 to 3.4). For the specific case of compositions for use in methods of treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body, see B-VIII, 2.1 below.

Art. 52(2) and (3)
Art. 53
Art. 57
Rule 63

While a decision on these matters rests with the examining division, opinions on these matters are formed by the search division for the purpose of drafting the search opinion (if applicable, see B-XI, 7) and also in considering possible limitations of the search and therefore whether or not to apply the procedure provided for under Rule 63(1) (see B-VIII, 3.1 to 3.4). The search division has thus to consider the requirements for patentability other than novelty and inventive step, as set out in G-II and G-III.

Art. 52

The above-mentioned situations may also occur for only some of the claims or for part of a claim. In these cases, this will be indicated in the invitation according to Rule 63(1) and in any subsequent incomplete search report or the declaration taking the place of the search report under Rule 63(2).

Rule 63

2. Considerations relating to specific exclusions from and exceptions to patentability

2.1 Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body

Even if a claim is drafted as a method of medical treatment (see G-II, 4.2) and is for this reason not directed to patentable subject-matter, a meaningful search may be possible if the determining technical feature is the effect of the substance, which can be searched, and as such the procedure under Rule 63 (see B-VIII, 3.1 to 3.4) would not be necessary. For example, such claims may be worded as follows:

"A method of treating dementia by administering a compound of formula X to a patient", or

"A method of diagnosis of disease Y practised on the human/animal body, comprising steps A, B and C"

These method claims are excluded from patentability under Art. 53(c). However, in most cases it is possible for the applicant to reformulate them into an allowable form during the examination procedure (see G-II, 4.2). Consequently, such claims are searched since they are usually characterised by the effect of substance X or by one or more of steps A, B and C which are not directly practised on the human or animal body or are characterised by the use of reagents rather than the act of therapy or diagnosis on the human/animal body.

If, however, specific method features are present (e.g. a combination of pharmaceutical with physical treatment), a meaningful search may not be possible. In cases of doubt the search division issues an invitation under Rule 63(1) (see B-VIII, 3.1). However, regardless of whether such claims are searched or not, the applicant's attention will be drawn in the search opinion (if applicable, see B-XI, 7) to the fact that such subject-matter is excluded from patentability (see B-XI, 3).

2.2 Subject-matter excluded from patentability under Art. 52(2) and (3)

Subject-matter or activities listed in Art. 52(2), when taken as such (Art. 52(3)), are considered non-technical (G-II, 1 and 2). In the case of a claim containing a mix of technical and non-technical features, the search division identifies which features contribute to the technical character of the claimed subject-matter (see G-VII, 5.4). The search covers all features that are found to contribute to the technical character.

Features that appear to be non-technical when taken in isolation may nonetheless contribute to the technical character of a claimed invention if, in the context of that invention, they contribute to produce a technical effect serving a technical purpose. The mere implementation of effects that are inherent in the excluded matter (T 1543/06) or result from circumvention of the technical problem rather than contributing to a technical solution would not qualify as technical effects (T 258/03). Examples of how to evaluate contribution to technical character for each of the items listed in Art. 52(2) are provided in G-II, 3.1-3.7.

Claimed features are analysed in the light of the description and drawings to determine if they produce a technical effect and form part of a technical solution to a technical problem (in accordance with B-III, 3.2 and B-IV, 1.1). In particular, specific embodiments of the application disclosed in its description and drawings, to which the claims might reasonably be expected to be limited, are taken into account since they could confer technical character on the claimed features (B-III, 3.5).

If the search division considers that some claim features do not contribute to the technical character of the claimed invention, this is indicated in the search opinion. If a lack of inventive step objection is raised and at least some of the distinguishing features are found not to have a technical effect contributing to the solution of a technical problem as set out in G-VII, 5.4, this finding is substantiated.

2.2.1 Computer-implemented business methods

For claims directed to computer-implemented business methods, if the features contributing to the technical character of the claimed subject-matter are so well-known that their existence at the relevant date cannot reasonably be disputed (T 1411/08, Reasons 4.1 and 4.2, and T 690/06, Reasons 13), no documentary evidence as to the relevant state of the art is required in the search report. Such "notorious" knowledge, for which no documentary evidence needs to be cited, is not to be confused with the skilled person's common general knowledge, which is something that generally can be reasonably questioned (G-VII, 2 and 3.1). In such exceptional cases, a search report with no documents cited may be issued under Rule 61 (OJ EPO 2007, 592). This search report under Rule 61 is to be distinguished from a declaration of no search or a partial search report under Rule 63(2).

3. No meaningful search possible

Rule 63

In addition to the reasons discussed in B-VIII, 1, an invitation under Rule 63(1) and subsequent limitation of the search under Rule 63(2) may also result from the application not meeting the relevant requirements of the EPC to such an extent that a meaningful search of the claims, or of some of the claims, or of part of a claim, is impossible. In such cases, the search division applies the procedure under Rule 63 (see B-VIII, 3.1 to 3.4 and OJ EPO 2009, 533).

Rule 63 relates only to the practicability of the search and not to the potential relevance of its results in subsequent examination. Even if a search were not to produce any result that could be used in examination proceedings, a search cannot be refused by reference to Rule 63 (see T 1242/04).

What is or is not "*meaningful*" is a question of fact for the search division to determine. Its finding may change in the light of any reply from the applicant to the invitation under Rule 63(1) (see B-VIII, 3.2). The exercise of the search division's discretion will depend upon the facts of the case. A restriction of the search must be carefully considered. There are cases where a search is rendered de facto impossible by the failure to meet the prescribed requirements of the EPC, for example a fundamental lack of clarity or the absence of any technical character whatsoever. The word "*meaningful*" must be construed reasonably. It is not to be construed in such a way that Rule 63 is invoked simply because a search is difficult or does not provide results that are significant for subsequent examination proceedings.

As there is no legal provision providing that an applicant must formulate the application in such a way as to make an economical search possible, "reasons of economy" cannot be used as a reason, or part of a reason, for issuing an incomplete search report (see also T 1020/98).

A number of non-limiting examples will illustrate where Rule 63 may find application:

(i) claims lacking support; insufficient disclosure

One example would be a claim so broadly formulated that its scope is at least to a certain extent speculative, i.e. not supported by the disclosure of the application. In this case, the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, and a meaningful search can only be performed on the basis of the narrower, disclosed invention: in extreme cases this may mean a search directed only to (one or more of) the specific examples disclosed in the description. Accordingly, the procedure under Rule 63(1) may be applied (see B-VIII, 3.1 to B-VIII, 3.4). Here, the requirements underlying the application of Rule 63 would be those of sufficiency of disclosure and support set out in Art. 83 and 84 (see F-III, 1 and 2, and F-IV, 6). The search division needs however to bear in mind that the requirements under Art. 83 and Art. 84 concerning sufficiency of disclosure and support are to be seen in relation to the person skilled in the art.

(ii) claims lacking conciseness

An example would be where there are so many claims, or so many possibilities within a claim, that it becomes unduly burdensome to determine the matter for which protection is sought (however, for the case of multiple independent claims in the same category see B-VIII, 4). A complete search (or any search at all) may de facto be impossible. Again, the application of Rule 63 and the issuing of a subsequent incomplete search report (according to the procedures defined in B-VIII, 3.1 to 3.3) or a declaration of no search may be appropriate, on the grounds that the lack of conciseness of the claim(s) is such as to render a meaningful search impossible (see Art. 84; F-IV, 5).

(iii) claims lacking clarity

An example would be where the applicant's choice of parameter to define the invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not employed the same parameter, or has employed no parameter at all. In such a case, the parameter chosen by the applicant may lack clarity (see Art. 84; F-IV, 4.11). It may be that the lack of clarity of the parameter is such as to render a meaningful search of the claims or of a claim or of a part of a claim impossible, because the choice of parameter renders a sensible comparison of the claimed invention with the prior art impossible. If so, the application of Rule 63 and the issuing of a subsequent incomplete search report (or, in exceptional cases, no search at all) under Rule 63(2) (according to the procedures defined in B-VIII, 3.1 to 3.3) may be appropriate, the search possibly being restricted to the worked examples, as far as they can be understood, or to the way in which the desired parameter

is obtained (any response from the applicant to the invitation under Rule 63(1) being taken into account in determining the subject-matter to be searched to the extent indicated in B-VIII, 3.2).

(iv) claims contravening Art. 76 or Art. 123(2)

Rule 63 may also find application with regard to claims containing added subject-matter in the following cases (see B-VIII, 6):

– claims in divisional applications contravening Art. 76;

– applications for which the claims were filed after the filing date and which contravene Art. 123(2); or

– Euro-PCT applications for which amended claims were filed as a basis for the supplementary European search and which contravene Art. 123(2).

These examples are not exhaustive (see also B-VIII, 6). The basic principle is that there needs to be clarity and openness both for the applicant and for third parties as to what has and what has not been searched.

The treatment of these Rule 63 cases in subsequent examination proceedings is dealt with in H-II, 5 and 6.1.

3.1 Invitation to indicate subject-matter for search

If the EPO considers that the application does not comply with the EPC to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed (see B-VIII, 1, 2 and 3), it will invite the applicant to file, within a period of two months, a statement indicating the subject-matter to be searched. The invitation will also give the reasons behind this finding and may additionally indicate the claimed subject-matter on which the search division considers it feasible to base a meaningful search. *Rule 63(1), (2)*

In the particular case of medical method claims, a complete search report is issued only when the claims can easily be reformulated to patentable subject-matter (see B-VIII, 2.1). Conversely, if an incomplete search report (or a declaration of no search) is envisaged, an invitation must be sent (e.g. in respect of the claims that cannot easily be reformulated).

3.2 Reply to the invitation under Rule 63(1)

3.2.1 Failure to reply in time or no reply

If the applicant does not reply in time to the invitation under Rule 63(1), the search division will determine what to search. In this case a partial search report will be drawn up accordingly, or in exceptional cases a declaration replacing the search report. This limitation of the search has consequences in examination (see H-II, 5 and 6.1). A late-filed reply is included in the file for consideration in the examination phase because it may be useful for reviewing the arguments given by the search division for carrying out an incomplete search.

Given that the search report should be published together with the application, the two-month period prescribed under Rule 63 is not open to further processing, but it is possible to request re-establishment of rights (see OJ EPO 2009, 533).

3.2.2 Reply in time

Rule 63(2)

If applicants reply in time to the invitation under Rule 63(1), indicating the subject-matter to be searched, and if a meaningful search based on the subject-matter that they have indicated is deemed possible by the search division, a search will be conducted on that subject-matter.

If applicants reply to the invitation under Rule 63(1) but in their reply indicate subject-matter which it is still not possible to search in full, the search division will determine the subject-matter to search, but will do so in a way which is consistent with the applicant's response, to the extent that this is possible, or in exceptional cases may determine that no meaningful search is possible at all.

Statements consisting of reworded claims filed in reply to a communication pursuant to Rule 63 are not considered as amended claims in view of Rule 137(1) but merely as explanations in respect of the set of originally filed claims. These claims will then be formally introduced in the proceedings upon receipt by the EPO of a statement to that effect filed by the applicant within the time limits under Rule 70(1) and (2). This confirmatory statement can be filed either together with the reply to the extended European search report (Rules 70a(1) and (2)), or, where applicable, when complying with the requirements under Rule 70(1) and (2). As far as possible the search division will draw up the search report in the light of these clarifications. Both the search report and the search opinion must clearly indicate what has been searched.

If applicants reply in time to the invitation under Rule 63(1), they may, instead of indicating the subject-matter to be searched, simply argue why they believe that it is possible to carry out a meaningful search on all of the subject-matter claimed. If the search division is convinced by the applicant's argumentation, a full search report will be issued and the consequences of a limitation of the search which apply in examination will not ensue. If the search division is not convinced, or is only partially convinced, it will issue a partial search report and will determine which subject-matter to search or, in exceptional cases, will issue a declaration replacing the search report. The final responsibility as to whether an invitation under Rule 63 was appropriate lies with the examining division. An additional search may be necessary in examination after a declaration or a partial search report has been issued at the search stage following an invitation under Rule 63(1) (see C-IV, 7.2).

Furthermore, the applicant may, in reply to an invitation under Rule 63, file arguments against the findings in the invitation requesting as a main request that the claims as filed be completely searched and as an auxiliary request, in the case that the search division is not convinced, indicate specific subject-matter to be searched (see also H-III, 3.2).

A consultation may take place if the applicant phones the search division to enquire about the course of action after an invitation under Rule 63 has been sent. The consultation is limited to formal issues concerning the content of the invitation and the options available to the applicant. The search division writes minutes of the consultation, which are sent to the applicant (without time limit) for information only. The time limit set with the invitation is still applicable for the applicant to file a written reply; the consultation *per se* does not constitute a valid reply.

3.3 The content of the extended European search report (EESR)

The two components of the EESR, the search report (or the declaration replacing it) and the search opinion, will indicate the reasons why it was not considered possible to conduct a meaningful search in respect of some or all of the claimed subject-matter according to Rule 63 and will indicate the subject-matter which was searched, if any, as determined according to the procedures given in B-VIII, 3.2. Furthermore, the search opinion will also invite the applicant to limit the claims to subject-matter which has been searched (in order to comply with Rule 63(3)). The documents cited in the search report and referred to in the search opinion will relate only to this subject-matter. In the event that the subject-matter subject to the search complies with the requirements of the EPC (in particular in that it is novel, inventive and industrially applicable, but also satisfies the other requirements of the EPC such as clarity under Art. 84), the search opinion will still be negative, because the claims do not comply with the requirements of the EPC in respect of their full scope.

Furthermore, if in response to the invitation under Rule 63(1) the applicant disputes the finding that a meaningful search is not possible (see B-VIII, 3.2), but the search division is not convinced by the applicant's argumentation, it will indicate why this is the case in the search opinion, as appropriate. If necessary, it can refer directly in the search opinion to the applicant's reply.

3.4 Applications to which Rule 63 applies which also lack unity

Cases will arise where the application does not comply with the EPC to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of some of the subject-matter claimed (B-VIII, 1, 2 and 3) and where the application also lacks unity of invention according to Art. 82 and Rule 44. It may be appropriate to raise only the issue of unity of invention and send an invitation under Rule 64(1) (see B-VII, 1.1 and 1.2), for example where a large number of claims which results in a severe lack of conciseness is resolved by splitting up the claims into the different inventions.

It may, however, be necessary to apply the procedures under both Rule 64(1) (invitation to pay additional search fees for inventions other than that first mentioned in the claims) and Rule 63(1). In this case, the EPO will first send the applicant an invitation according to Rule 63(1), requesting the applicant to indicate the subject-matter to be searched. In cases where the lack of unity is already apparent before any clarification is received from the applicant, this invitation would also identify the first invention mentioned in the claims (see F-V, 3.4) and the claims which relate to this invention,

either in full or in part, and would invite the applicant to clarify what to search in respect of this invention first mentioned in the claims.

After expiry of the time limit according to Rule 63(1), the subject-matter, if any, to be searched in respect of the first invention will be determined according to the procedures specified in B-VIII, 3.2. A partial search report (or exceptionally a declaration replacing it) will then be prepared on the invention first mentioned in the claims. This will be sent to the applicant along with an invitation to pay additional search fees under Rule 64(1) in respect of the other inventions. A provisional opinion on the patentability of the invention or unitary group of inventions first mentioned in the claims and the reasons for non-unity findings will also be provided. Where appropriate, the invitation under Rule 64(1) may also include an invitation according to Rule 63(1), inviting the applicant to clarify the subject-matter to be searched in respect of any additional inventions for which the applicant subsequently pays additional search fees.

Rule 164 For Euro-PCT supplementary European search reports, where these exceptional conditions apply, the procedure will be as above, with the exception that a Rule 164(1) invitation is sent instead of a Rule 64 invitation.

Rule 164 Rule 63 also applies to searches performed under Rule 164(2) (see C-III, 2.3). As for EP direct cases, any Rule 63 objection relating to an invention for which a search fee is to be paid must be included in the invitation itself.

4. More than one independent claim per category (Rule 62a)

4.1 Invitation to indicate which independent claim to search

Rule 62a(1) If the European Patent Office considers that the claims as filed do not comply with Rule 43(2) (see F-IV, 3.2), it may invite the applicant to indicate, within a period of two months, claims complying with Rule 43(2) on the basis of which the search is to be carried out. Along the lines of Rule 64, the search division has the discretion either to send this invitation or to make a complete search for all claims, raising the objection under Rule 43(2) only in the written opinion.

4.2 Reply to the invitation under Rule 62a(1)

4.2.1 Failure to reply in time

If the applicant fails to provide the above indication in due time, the search will be carried out on the basis of the first claim in each category. In either case a search report will be drawn up accordingly. This limitation of the search has consequences in examination (see H-II, 5 and 6.1). As for the invitation under Rule 63 above, a late-filed reply is included in the file for consideration at the examination stage.

Since the search report should be available on publication of the application, Rule 62a prescribes a response period of two months and rules out further processing. However, a request for re-establishment of rights may be granted, provided the relevant conditions are met.

4.2.2 Reply filed in time

If applicants reply to the invitation under Rule 62a(1), indicating an independent claim in a particular category which they wish the EPO to search, the EPO will conduct the search based on this claim.

In reply to this invitation, the applicant may also indicate more than one independent claim in the same category for search, where these fall within the exceptions provided for in Rule 43(2) (see F-IV, 3.2). However, if the applicant does so, but the EPO finds that the claims indicated do not fall within the exceptions provided for in Rule 43(2), only the independent claim with the lowest number indicated by the applicant will be searched.

Example

If an application contains independent product claims 1, 10 and 15, an invitation under Rule 62a(1) is sent and the applicant contends in the reply that independent product claims 10 and 15 fall within the exceptions provided for in Rule 43(2) and indicates that these two claims are to be searched, but the search division does not agree, then only claim 10 will be searched.

Where the applicant attempts to file amendments, the procedure indicated in B-VIII, 3.2.2 is followed.

In any timely response to the invitation under Rule 62a(1), applicants may, instead of indicating the independent claim or claims to be searched, simply argue why they believe that the claims comply with Rule 43(2) (i.e. why the plurality of independent claims in the same category fall within one or more of the exceptions provided for in Rule 43(2)). If the search division is convinced by the applicant's argumentation, a search report will be issued on the basis of all the claims, and the consequences of a limitation of the search which apply in examination will not ensue. If the search division is not convinced, it will issue a search report for which the search will be conducted based on the first independent claim in that category. The final responsibility as to whether an invitation under Rule 62a was appropriate lies with the examining division.

Furthermore, the applicant may, in reply to an invitation under Rule 62a, file arguments against the findings in the invitation requesting as a main request that the claims as filed be completely searched and as an auxiliary request, in case the search division is not convinced, indicate the independent claims to be searched (see also H-III, 3.2).

The applicant may phone the search division in order to enquire about the course of action after an invitation under Rule 62a has been sent, as explained above for the invitation under Rule 63 (see B-VIII, 3.2.2).

4.3 The content of the extended European search report (EESR)

The search opinion will invite the applicant to limit the application to claims which have been searched (Rule 62a(2)). Furthermore, if in response to the invitation under Rule 62a(1) the applicant disputes the finding under Rule 43(2) (see B-VIII, 4.2), but the search division is not convinced by the

applicant's argumentation, it will indicate why this is the case in the search opinion, as appropriate.

4.4 Cases under Rule 62a where claims fees are not paid

If an independent claim has been deemed to be abandoned under Rule 45(3) or Rule 162(4) as a result of the non-payment of claims fees (see A-III, 9), the applicant cannot indicate this claim for search in response to the invitation under Rule 62a(1), because no search is conducted on such a claim (see B-III, 3.4). The indication of such a claim by the applicant in response to the invitation under Rule 62a(1) will be ignored by the EPO, which will then apply Rule 62a(1), last sentence, and will search the first independent claim in the category in question for which claims fees **have** been paid.

If all independent claims in the category in question have been deemed to be abandoned for failure to pay claims fees, no invitation under Rule 62a(1) will be sent in respect of these claims and none of them will be subject to a search.

4.5 Applications to which Rule 62a applies which also lack unity

Cases will arise where the application does not comply with Rule 43(2) (see B-VIII, 4.1 and F-IV, 3.2) and the application also lacks unity of invention according to Art. 82 and Rule 44. It may be appropriate to raise only the issue of unity of invention and send an invitation under Rule 64(1) (see B-VII, 1.1 and 1.2).

It may, however, be necessary to apply the procedures under both Rule 64(1) (invitation to pay additional search fees for inventions other that the first mentioned in the claims) and Rule 62a(1). In this case, the EPO will first send the applicant an invitation according to Rule 62a(1), requesting to indicate the independent claims to be searched.

In cases where the lack of unity is already apparent when the invitation under Rule 62a(1) is sent, it will also identify the first invention mentioned in the claims (see F-V, 3.4) and the claims which relate to this invention, either in full or in part, and will invite the applicant to indicate which claims to search in respect of this invention first mentioned in the claims. After expiry of the time limit according to Rule 62a(1), the claims to be searched in respect of the first invention will be determined according to the procedures specified in B-VIII, 4.2. A partial search report will then be prepared on the invention first mentioned in the claims. This will be sent to the applicant along with a provisional opinion on the patentability of the invention or unitary group of inventions first mentioned in the claims, the reasons for the non-unity findings and an invitation to pay additional search fees under Rule 64(1) in respect of the other inventions. Where appropriate, this invitation under Rule 64(1) may also include an invitation according to Rule 62a(1), requesting the applicant to clarify the claims to be searched in respect of any additional inventions for which additional search fees are subsequently paid.

Conversely, it may also happen that after an invitation is sent according to Rule 62a(1) in respect of all claims, the claims which satisfy Rule 43(2) and

which are subject to a search (as determined according to the procedures given in B-VIII, 4.2) are subject to an objection of lack of unity *a posteriori*. In such cases, an invitation to pay additional fees under Rule 64(1) will then be sent, the invitation being based only on the subject-matter of the claims determined by the applicant's response (or failure to respond) to the invitation under Rule 62a(1).

For Euro-PCT supplementary European search reports, where these exceptional conditions apply, the procedure will be as above, with the exception that a Rule 164(1) invitation is sent instead of a Rule 64 invitation. *Rule 164*

Rule 62a also applies to searches performed under Rule 164(2) (see C-III, 2.3). As for EP direct cases, any Rule 62a objection relating to an invention for which a search fee is to be paid must be included in the invitation itself. *Rule 164*

4.6 Treatment of dependent claims under Rule 62a

Claims depending either directly or indirectly via other dependent claims on an independent claim excluded from the search in accordance with Rule 62a(1) (see B-VIII, 4.2) are likewise excluded from the search. Conversely, if a dependent claim depends on more than one previous claim, not all of which were searched, that dependent claim will be searched only in as far as it depends on a claim or claims which *were* searched in accordance with Rule 62a(1).

5. Invitation under both Rule 62a(1) and Rule 63(1)

In certain cases it may be appropriate to send an invitation according to both Rule 63 (see B-VIII, 3.1) and Rule 62a(1) (see B-VIII, 4.1). This may be necessary, for example, in cases where clarifying which claim or claims to search under Rule 62a will not necessarily help to clarify what subject-matter to search because the application contains several independent claims in the same category, none or only some of which can be subject to a meaningful search in respect of their entire scope. In such cases invitations under both Rule 62a(1) and Rule 63(1) will be sent in a single communication. This single communication gives rise to the same two-month time limit for reply under both rules. In such cases, applicants wishing to respond to both invitations should do so simultaneously.

In response to this invitation under Rule 62a(1) and Rule 63(1), the applicant must not indicate independent claims (in response to the invitation under Rule 62a(1)) and subject-matter (in response to the invitation under Rule 63(1)) which are inconsistent with each other. If the applicant provides inconsistent indications, the search division may, depending on the circumstances, either (i) elect to search the claims indicated by the applicant according to Rule 62a(1), where necessary limiting the subject-matter searched in respect of those claims according to Rule 63(2) *mutatis mutandis* or (ii) elect to search the subject-matter indicated by the applicant according to Rule 63(1) and as defined in the first independent claim of a particular category which is consistent with that subject-matter according to Rule 62a(1), last sentence, *mutatis mutandis*.

Although sent in the same communication, the invitations under Rule 62a(1) and Rule 63(1) are still legally separate. Consequently, applicants may also reply to only one of the invitations and not to the other. If they reply only to the Rule 62a(1) invitation, option (i) of the previous paragraph applies. If they reply only to the Rule 63(1) invitation, option (ii) of the previous paragraph applies.

6. Claims contravening Art. 123(2) or Art. 76(1)

Art. 123(2)
Rule 58

If the claims on which the search is to be based were filed after the date of filing or under Rule 58, they do not form part of the application documents "as originally filed". Also, for Euro-PCT applications (see B-III, 3.3.1), it may happen that amended claims form the basis for the supplementary European search. In either case, before starting the search, the search division checks whether or not these claims introduce subject-matter that extends beyond the content of the application "as originally filed" (see also A-III, 15). For Euro-PCT applications, this is the PCT application as originally filed.

If the claims contravene the requirements of Art. 123(2), the search division will face one of the following situations:

(a) if there are doubts about the objection (e.g. the amendment relies on common general knowledge and the search division is unsure if the introduced term can be based on this) and/or the amendment does not significantly change the scope and subject of the search: the search division searches the claims as they are.

(b) if there are certain individual features in the claims that clearly violate Art. 123(2): the search division performs the search ignoring these features.

(c) if there are substantial non-allowable amendments in the claims: the search division may need to issue an invitation under Rule 63(1) prior to starting the search (see B-VIII, 3(iv)). Depending on the reply to the invitation, an incomplete search report or even a declaration replacing the search report according to Rule 63 may be issued. In deciding what to include in the search and what to exclude from it, the search division refers to how the invention is defined in the description.

A similar problem may also occur when a divisional application is filed and the amended claims do not satisfy the requirements of Art. 76(1): the same criteria as described in steps (a) to (c) above is then to be applied.

In any case, the search opinion will include an objection under Art. 123(2) or Art. 76(1) indicating the reasons for limiting the scope of the search.

Chapter IX – Search documentation

1. General

1.1 Organisation and composition of the documentation available to the search divisions

The basic part of the search documentation consists of a collection of patent documents systematically accessible in a manner suitable for searching. Additionally, periodicals and other publications of technical literature are put at the disposal of the search division. This non-patent literature is accessible through in-house or external databases, some of which are arranged in the library in a manner suitable for consultation; parts thereof, such as particularly relevant articles, are selected and made available for direct access by incorporating these, or copies thereof, into the systematic documentation. The systematically accessible part of the search documentation includes the minimum documentation required for an International Searching Authority under Rules 34 and 36.1(ii) PCT and extends somewhat beyond these minimum requirements.

1.2 Systematic access systems

All members of the search division have at their disposal computer facilities for searching the search documentation. These allow, amongst other things, the use of the Cooperative Patent Classification (CPC), which is based on the International Patent Classification (IPC) but comprises finer internal subdivisions. Searches can also be performed using other classification systems and/or words.

2. Patent documents arranged for systematic access

2.1 PCT minimum documentation

The systematically accessible search documentation includes the national patent documents belonging to the PCT minimum documentation as specified in Rule 34.1(b)(i) and (c) PCT.

Also included are published international (PCT) and regional (e.g. European) patent applications, patents, and inventors' certificates (Rule 34.1(b)(ii) PCT).

A complete list of the contents of the PCT minimum documentation is available on the WIPO website.

2.2 Unpublished patent applications

Since the completion of the search for conflicting applications that are not published at the time of the initial search is entrusted to the examining divisions, the documents which can be cited in the search report do not include unpublished patent applications (see B-VI, 4.1).

2.3 Search reports

The official European and international (PCT) search reports are normally published together with the European and international applications and are included in the search files together with these applications. The official

search reports relating to national applications, as well as unofficial search reports, are also included in these files to the extent that they are available to the public. Search reports that are not normally or not yet accessible to the public in the form of a published document are nevertheless available to the search division separately from the state-of-the-art documents, and searching thereof is not compulsory for all applications.

2.4 Patent family system

The EPO keeps a patent family system based on application data and priority data of the patent documents stored in databases of the EPO. When viewing patent documents on screen, normally only one representative document of a patent family is displayed, but links to the other members of its patent family are provided.

3. Non-patent literature arranged for systematic access

3.1 Periodicals, records, reports, books, etc.

The systematically accessible search documentation includes the relevant articles from the list of periodicals belonging to the minimum documentation under the PCT as established by the competent WIPO body and from other periodicals where deemed useful by the search division. In principle, copies of the articles selected as relevant for search purposes are added to the EPO search databases with a fictitious country code "XP", scanned for inclusion in the electronic "BNS" collection and included in the manual search files, where appropriate.

The EPO also subscribes to many further periodicals including abstract journals. Furthermore, records of conference proceedings, reports, books, standards, etc. covering the three official languages of the EPO and the various technically important geographical areas are obtained. Individual items are selected for inclusion in the online documentation in so far as they constitute useful additions to the state of the art.

4. Non-patent literature arranged for library-type access

4.1 Composition

In addition to the non-patent literature mainly serving search purposes (see B-IX, 3), the non-patent literature arranged for library type access also comprises such literature serving primarily as sources of information and education of the search division both as regards general and background technical information and as regards new technical developments. Furthermore, the collection includes many reports, pamphlets, etc. internet-based document delivery services of publishing companies are made available to the members of the search division in the form of an Electronic Virtual Library (EVL), which can be used from the member's desktop computer.

5. Access to EPO documentation for the national patent offices

The EPO provides the national offices of its member states with access to its electronic search documentation as described in B-IX, 2.1 to 2.3.

For other documentation of the EPO, if delivered by commercial database providers, access can be limited, depending on the conditions of data delivery agreed between the EPO and the data provider. However, separate agreements may exist between national offices and data providers.

Chapter X – Search report

1. General

The results of the search will be recorded in a search report. A number of different possible limitations of the scope of the search report exist. These are:

(i) where claims are deemed abandoned for non-payment of claims fees (Rule 45(3), see B-III, 3.4);

(ii) a declaration replacing the search report according to Rule 63 (see B-VIII);

(iii) an incomplete search report according to Rule 63 and/or Rule 62a (see B-VIII);

(iv) a partial European search report due to a finding of a lack of unity according to Rule 64(1); and

(v) a supplementary European search report according to Art. 153(7) may be incomplete for the reasons given in (i) or (iii) or may be replaced by a declaration according to (ii) (in the case of unpaid claims fees for a supplementary European search, Rule 162(4) applies).

The search reports of types (i) - iii), (and (v) in so far as only (i) - iii) apply) are transmitted to the applicant, published and serve as a basis for the examination by the examining division. A partial search report according to Rule 64(1) (case (iv) above) is transmitted to the applicant, but not published; it can however be inspected by the public as it is part of the electronic file accessible via the European Patent Register (see A-XI, 2).

Rule 62(1)

Subject to the exceptions mentioned in B-XI, 7, European search reports and supplementary European search reports are accompanied by a search opinion, where the search division gives an opinion on whether the application and the invention to which it relates seem to satisfy the requirements of the EPC (see B-XI, 1.1). Together, the European search report or supplementary European search report and the search opinion constitute the extended European search report (EESR).

The search division is responsible for drawing up the European search report. It is also responsible for drafting international search reports and search reports on behalf of the industrial property offices of certain contracting states (see B-X, 2 and B-II, 4.4 to 4.6).

This chapter contains the information which is necessary to enable the search division to correctly prepare the search report.

A search report must contain no matter, in particular no expressions of opinion, reasoning, arguments or explanations, other than that required by

the form or referred to in B-III, 1.1 and 1.2 or B-X, 9.2.8. However, this does not apply to the search opinion (see B-XI, 3).

2. Different types of search reports drawn up by the EPO

The EPO will draw up the following types of search reports:

(i) European search reports (see B-II, 4.1);

(ii) supplementary European search reports concerning PCT applications (see B-II, 4.3);

(iii) "search results under Rule 164(2)" (see C-III, 2.3);

(iv) international search reports under the PCT (see B-II, 4.4);

(v) international-type search reports (see B-II, 4.5);

(vi) search reports drawn up on behalf of national offices (see B-II, 4.6); and

(vii) search reports further to special work.

Further, in the examination procedure, accounts containing the results of additional searches are drawn up when necessary and are not published (see B-II, 4.2). However, the documents cited therein may be used in the examination procedure (see C-IV, 7.2).

This chapter sets out the requirements for search reports of types (i) to (v) only, although it is the intention that all search reports drawn up by the EPO are as similar as possible.

3. Form and language of the search report

3.1 Form

The standard search report is prepared by the search division and contains a main page to be used for all searches for recording the important features of the search, such as:

(i) the application number;

(ii) the classification of the application;

(iii) the fields searched;

(iv) the relevant documents revealed by the search; and

(v) the name of the member of the search division who executed the search,

as well as supplemental sheet A and, in certain cases, also supplemental sheet B.

Supplemental sheet A is to be used for indicating approval or modifications of the title, the abstract as submitted by the applicant, and the figure to be published with the abstract and for giving the translation of the title into the two other official languages (see B-X, 7).

Supplemental sheet B is to be completed where there are restrictions on the search, i.e. when claims incurring fees are not searched due to non-payment of claims fees (see B-III, 3.4), when unity of invention is lacking (see B-VII), when a meaningful search is not possible such that the search report is an incomplete one or is completely replaced by a declaration according to Rule 63 (see B-VIII, 3) or when the search is limited according to Rule 62a (see B-VIII, 4).

Dates appearing in the report are expressed according to the WIPO standard ST.2.

3.2 Language

The search report or the declaration accompanying or replacing it according to Rule 63 are drawn up in the language of the proceedings. *Art. 14(3)* *Rule 61(5)*

3.3 Account of the search

For internal quality purposes, at the end of the search the search division completes an account summarising all the information necessary for auditors to understand what has been searched (see B-III, 3), as well as where (see B-III, 2) and how (see B-IV, 2) the search was carried out. The account of the search is not public.

3.4 Record of search strategy

All search reports established at the EPO will be automatically supplemented with an information sheet entitled "Information on Search Strategy" that lists the databases searched, classification symbols used and the keywords reflecting the subject of the search.

4. Identification of the patent application and type of search report

On the main page and supplemental sheets, the European patent application is identified by its application number.

The type of the search report is indicated in the report.

In the case of a joint publication of the application and the search report, the main page of the report is marked A1 (WIPO Standard ST.16). If publication of the application is due before the search, the main page is marked A2 (WIPO Standard ST.16). The subsequent search report is established on a new main page which is marked A3 (WIPO Standard ST.16). Where the search report is a supplementary European search report in respect of an international application, this search report is established on a new main page marked A4 (WIPO Standard ST.16). *Art. 153(7)*

5. Classification of the patent application

The main page of the report gives the IPC classification symbol(s) for the European patent application in accordance with B-V, 3.

If the application is to be published before the search report is prepared (A2 publication, see B-X, 4), the search division prepares supplemental sheet A before the publication of the application. In such cases, supplemental sheet A will contain all of the requisite information indicated in B-X, 7 and also the IPC classification of the application (in cases where the application lacks unity, see B-V, 3.3).

When subsequently the search report is established (A3 publication, see B-X, 4), the IPC classification of the application is repeated on the separately published search report. Where the search division has modified the IPC classification (i.e. the IPC classification as given in the A2 published application differs from that given on the later published A3 search report – see B-V, 3), it is this amended classification which will appear on the later published A3 search report (see B-V, 3.1).

6. Areas of technology searched

Although the EPC does not require the European search report to identify the areas of technology searched, this information is included in the report in the form of a list of IPC symbols up to the sub-class level.

Where the search report is entirely or partly based on a previous search made for an application relating to a cognate subject, the sections of the documentation consulted for this previous search are also identified in the report as having been consulted for the application in question. This is done by indicating the appropriate IPC symbols.

7. Title, abstract and figure(s) to be published with the abstract (as indicated on supplemental sheet A)

Supplemental sheet A is prepared by the search division before publication of the application, regardless of whether this is with the search report (A1 publication) or without it (A2 publication). The information contained in supplemental sheet A is needed for the publication of the application.

On supplemental sheet A, the search division indicates:

Rule 47(1)
Rule 66

(i) approval or amendment of the text of the abstract, the content of which is communicated to the applicant according to Rule 66 (see A-III, 10). Examination of the abstract does not go beyond ensuring that it relates to the application concerned and that there is no conflict with the title of the invention or with the classification of the application. Since the abstract needs to relate to the application as filed, the search division will consider it and determine its definitive content before carrying out the search, in order to avoid being inadvertently influenced by the results of the search.

If the search report is published separately (A3 publication), information about the abstract is not given in the communication. The information sent to the applicant includes the title of the invention and the figure, if any, of the drawings to be published with the abstract.

In exceptional cases, the search division may change the abstract after the search has been carried out. However, if this is done after

the application has been published A2, supplemental sheet A is not reissued;

(ii) approval or amendment of the title of the invention (see A-III, 7); *Rule 41(2)(b)*

(iii) approval, modification or abolition of the selection of the figure which is to accompany the abstract (see F-II, 2.3(vi) and 2.4); and *Rule 47(4)*

(iv) the translation of the title of the European application into the two other official languages. *Art. 14(7)(a)*

The European Patent Bulletin is published in all three official languages of the EPO according to Art. 14(7)(a) and contains the entries made in the Register of European Patents, which, according to Rule 143(1)(c), must contain the title of the invention. Consequently, the title is required in all three official languages of the EPC.

The above applies equally to applications published with the search report (A1 publication) and those published without it (A2 publication). In the case of an A2 publication, supplemental sheet A further contains the IPC classification of the application (see B-X, 5). In the case of an A1 publication, the IPC classification appears only on the search report (Rule 61(6)).

Supplemental sheet A also indicates the nature of the publication to which it relates (A1 or A2).

In the case of a supplementary European search report in respect of an international application, supplemental sheet A is marked A4. The search division does not determine the title, abstract or figure to be published with the abstract, since these have already been determined by the International Searching Authority according to Rules 37.2, 38.2(a) and 8.2 PCT, respectively.

8. Restriction of the subject of the search

In the following cases, the search report, the declaration replacing it, or the incomplete or partial search report will indicate whether the subject of the search was restricted and which claims have or have not been searched:

(i) claims above the number of fifteen for which no additional fee has been paid (see B-III, 3.4). The claims not searched are identified. This only applies to European and supplementary European search reports; *Rule 45(1) and (3)* *Rule 162(1) and (4)*

(ii) lack of unity of invention (see B-VII). The different inventions must be mentioned by indicating their subject-matter and the claims relating thereto (in part or in full; see Rule 44(2). For the partial search report (see B-VII, 1.1), an indication is made that it has been established for the invention first mentioned in the claims. This applies to *a priori* lack of unity and to *a posteriori* lack of unity. For the search report which will be drawn up for all those inventions in respect of which search fees have been paid, the different inventions (and *Rule 64(1)*

corresponding claims in full or in part) which have been searched are indicated in the search report;

Rule 63
Art. 52(2)
Art. 53

(iii) claims in respect of which a meaningful search cannot or only an incomplete search can be carried out (see B-VIII). A declaration is made either:

(a) that a meaningful search has not been possible on the basis of all claims (this declaration replaces the search report); or

(b) that a meaningful search has not been possible for one or more of the claims in part or in full. In this case, the claims concerned are mentioned in the declaration accompanying the incomplete search report.

In both cases (a) and (b), the reasons for not carrying out or restricting the search must be indicated (for example: subject-matter not patentable; insufficiently clear claims). If necessary, full reasoning is provided in the search opinion; see B-VIII, 3.3 for the content of the EESR in these cases.

Rule 62a

(iv) claims in respect of which a search was not carried out due to non-compliance with Rule 43(2) (see B-VIII, 4.2).

9. Documents noted in the search

9.1 Identification of documents in the search report

9.1.1 Bibliographic elements

All documents cited in the search report must be identified unambiguously by indicating the necessary bibliographic elements. All citations in the search report normally comply with WIPO Standard ST.14 (Recommendation for the inclusion of references cited in patent documents), WIPO Standard ST.3 (Two-letter codes) and ST.16 (Standard code for identification of different kinds of patent documents). This does not exclude deviations in those special cases where strict adherence, whilst not necessary for the clear and easy identification of a document, would require considerable extra cost and effort.

9.1.2 "Corresponding documents"

The search division will often be confronted by the existence of "corresponding" documents (see B-VI, 6.2), that is to say documents which have the same or substantially the same technical content. These usually fall into one of two groups, namely patent documents from a patent family and abstracts:

(i) Patent documents in the same patent family

These are patent documents from the same country or from different countries, and which share at least one claimed priority.

If a cited patent document belongs to a patent family, the search division needs not cite all the members of the family which are known or accessible to it, since these are already mentioned in the annex to the search report. However, it may mention one or more members in addition to the one cited (see B-IV, 3.1). Such documents are identified by the Office of origin, type and number of document, and preceded by the sign ampersand (&). There are a number of possible reasons why the search division may wish to draw attention in the search report to more than one document in the same patent family, including the following:

(a) One document of the patent family is published before the earliest priority date of the application, but is published in a non-EPO language, whereas a different member of the same patent family is published in an EPO language (see Art. 14(1)), but after the earliest priority date of the application.

Example

A European application claims a priority of 3 September 1999. In the search on this application, a relevant document – WO 99 12395 A – is found. This document is published in Japanese on 11 March 1999 – in time to constitute prior art according to Art. 54(2). There also exists the European family member published in an English translation according to Art. 153(4) on 1 March 2000 – too late to constitute prior art according to Art. 54(2), but cited in the search report as an "&" document of the Japanese-language WO publication and sent to the applicant (see B-X, 11.3). It will be used in examination of the application to interpret the content of the Japanese language WO publication (see G-IV, 4). In the search report, these documents would be cited as follows (for the mentioning of the claims to which the cited documents relate, here claims 1-10, see B-X, 9.3):

X	WO 99 12395 A (SEKI SHUNICHI; KIGUCHI HIROSHI (JP); SEIKO EPOSON CORP (JP)) 11 March 1999 (1999-03-11) * figure 1 * & EP 0 982 974 (SEIKO EPSON CORP) 1 March 2000 (2000-03-01) * figure 1 * * claim 1 *	1-10

(b) Different documents in the same patent family each containing relevant technical subject-matter not present in the other family members;

(c) Where a family member is cited in the application in a non-EPO language and there exists another family member in an EPO language, where these are both published before the earliest priority date.

Example

Y	WO9001867 A (WIDEGREN LARS (SE)) 8 March 1990 (1990-03-08) * claim 1 *	1-10
D,Y	& SE461824 B (WIDEGREN LARS (SE)) 2 April 1990 (1990-04-02)	1-10

The fact that the applicant has already cited the relevant SE document in the application, which is a family member of the relevant WO document, means that the applicant has already satisfied the requirement that the state of the art be mentioned in the description (Rule 42(1)(b)). It is of value to the examining division that this be made known in the search report (see F-II, 4.3).

(ii) Abstracts of documents (see B-VI, 6.2)

These are provided by one of a number of database providers (for example Chemical Abstracts or Derwent) and may relate to many different types of disclosure such as patent documents, journal articles, PhD theses, books etc. The abstract provides a summary of the most important aspects of the technical content of the original document. Most abstracts cited are in the English language. In all cases where an abstract is cited in the search report, the search division must input the original document to which the abstract relates after the "&" sign.

Example

X	DATABASE WPI Week 200961 Thomson Scientific, London, GB; AN 2009-N01904 & WO 2009/104990 A1 (VALEXPHARM CO LTD) 27 August 2009 (2009-08-27) * abstract *	1-5

The search division may choose to cite the abstract (in which case the original document must be cited as an "&" document) rather than cite the original document for one of a number of reasons. These reasons include: the original document is not easily available to the search division (for example, retrieval of PhD theses); or the original document is in a non-EPO language and no other corresponding document exists (for example, a journal article in Russian). The original document is sent to the applicant only if it is so designated by the search division (see B-X, 12).

If the search division wishes to refer to a Japanese or Korean published patent application (with kind code A), it cites the Japanese or Korean publication in the search report. If there is an English

abstract available in the EPO databases (Patent Abstracts of Japan or Patent Abstracts of Korea), both the Japanese or Korean publication and the English abstract are sent to the applicant.

9.1.3 Languages of the documents cited

Frequently, members of the same patent family are published in a number of different languages. Consequently, the search division has a choice regarding the language of the document which is cited in the search report. If the relevant technical content does not differ between the various family members and they are all published before the earliest priority date of the application, then all of the members of the family are of equal relevance to the application. In such cases, the search division chooses the document to be cited by virtue of its language of publication and according to the following list, the most preferred language being given first:

(1) an official language of the EPO (i.e. English, French or German (Art. 14(1));

(2) an official language of a Contracting State of the EPC according to Art. 14(4) (see A-VII, 1.1). Such documents can usually be read by a colleague if the member of the search division in question is not familiar with this language (see B-VI, 6.2);

(3) a language other than any of those of the contracting states of the EPC.

In cases (2) and (3), the search division might consider citing an abstract in an official language of the EPO, instead of the original document.

If the original document is in a less "accessible" language (e.g. Chinese or Russian), it is best to cite the abstract. In some cases it is possible to obtain an automated translation of certain patent documents into an official language of the EPO. If the search division relies on this translation in the search opinion, the translation will be sent to the applicant by annexing a copy of the automated translation to the search opinion (see B-X, 12 and G-IV, 4).

Alternatively, if only a specific paragraph of the translation is needed, the search division may copy the translation of that paragraph into the search opinion instead of annexing the entire translation. Note, however, that where a full translation was available during search, this full translation will normally be sent to the applicant.

Non-official translations (i.e. translations having no legal value) of publications in "less accessible" languages will not be cited in the search report.

9.1.4 Supplementary European search report

In the case of a supplementary European search report according to Art. 153(7), it is also permissible under certain circumstances to have no documents at all cited on the supplementary European search report (see B-IV, 2.5). In such cases, the expression "No further relevant

documents disclosed" will appear in the search report. However, in such cases, the search opinion (if applicable, see B-XI, 7) will give an opinion on the patentability of the claimed invention over the state of the art cited in the International Search Report (B-XI, 1.1).

If the search division disagrees with the ISA opinion on the relevance of a document cited in the international search report to the novelty and/or inventive step of the claimed invention, the document in question is normally not re-cited in the supplementary European search report with a new, corrected document category. The exception to this is where the search division wishes to combine a first document found only in the supplementary European search as a "Y" category with a second document already cited in the international search report: in this case the search division may re-cite the second document from the international search report in the supplementary European search report as a "Y" document in combination with the first document. Where not all claims are affected by such re-qualification of the document category, this is clarified in the supplementary European search report in order to ensure consistency with the ESOP.

9.2 Categories of documents (X, Y, P, A, D, etc.)

All documents cited in the search report are identified by placing a particular letter in the first column of the citation sheets. Where needed, combinations of different categories are possible. The following letters are used.

9.2.1 Particularly relevant documents

Art. 52(1)
Art. 54
Art. 56

Where a document cited in the European search report is particularly relevant, it is indicated by the letter "X" or "Y". Category "X" is applicable where a document is such that **when taken alone**, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step.

Art. 52(1)
Art. 56

Category "Y" is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents of the same category, such combination being obvious to a person skilled in the art. However, if a document (a so-called "primary document") explicitly refers to another document as providing more detailed information on certain features (see G-IV, 8) and the combination of these documents is considered particularly relevant, the primary document is indicated by the letter "X", i.e. not "Y", and the document referred to (the "secondary" document) is indicated as "X" or "L" as appropriate.

9.2.2 Documents defining the state of the art and not prejudicing novelty or inventive step

Where a document cited in the European search report represents state of the art not prejudicial to the novelty or inventive step of the claimed invention, it is indicated by the letter "A" (see, however, B-III, 1.1).

9.2.3 Documents which refer to a non-written disclosure

Where a document cited in the search report refers to a non-written disclosure, the letter "O" is entered (see B-VI, 2). Examples of such disclosures include conference proceedings. In cases where the oral disclosure took place at an officially recognised exhibition (Art. 55(1)(b)), see B-VI, 5.5. The document category "O" is always accompanied by a symbol indicating the relevance of the document according to B-X, 9.2.1 or 9.2.2, for example: "O, X"; "O, Y"; or "O, A". *Rule 61(4)*

9.2.4 Intermediate documents

Documents published on dates falling between the date of filing of the application being examined and the date of priority claimed, or the earliest priority if there is more than one (see B-VI, 5.2 and B-XI, 4), are denoted by the letter "P". The letter "P" is also given to a document published on the very day of the earliest date of priority of the patent application under consideration. The document category "P" is always accompanied by a symbol indicating the relevance of the document according to B-X, 9.2.1 or 9.2.2, for example: "P, X"; "P, Y"; or "P, A". *Rule 61(3)*

9.2.5 Documents relating to the theory or principle underlying the invention

Where a document cited in the search report may be useful for a better understanding of the principle or theory underlying the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it is indicated by the letter "T".

In the latter case, the "T" document constitutes evidence within the meaning of Art. 117(1)(c), rather than prior art within the meaning of Art. 54(2). Consequently, it is of no relevance whether a "T" document is published before or after the priority or filing date of the application being searched.

For example, the applicant claims a group of chemical compounds and the description gives a generically defined process for their production. The search division finds a document published after the priority date which clearly shows that the generically defined process is not able to produce all of the compounds covered by the claims. The search division may use this document to raise the objection that the claims are not supported by the description according to Art. 84 (see F-IV, 6.3), and therefore it may cite this document as a "T" document.

9.2.6 Potentially conflicting patent documents

Any patent document bearing a filing or priority date earlier than the filing date of the application searched (not the priority date – see B-VI, 3 and B-XI, 4) but published on or after that date and the content of which would constitute prior art relevant to novelty (Art. 54(1)) is indicated by the letter "E". Where the patent document and the application searched have the same date (see G-IV, 5.4), the patent document is also identified by the letter "E". An exception is made for patent documents based on the claimed priority under consideration; these documents are not cited. *Art. 54(3)* *Art. 139(2)*

9.2.7 Documents cited in the application

Rule 42(1)(b) When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, these are denoted by the letter "D" (see B-IV, 1.3).

9.2.8 Documents cited for other reasons

Art. 117(1)(c) Where in the search report any document is cited for reasons (in particular as evidence – see B-VI, 5.6) other than those referred to in the foregoing paragraphs, for example:

(a) a document which may throw doubt on a priority claim (see B-VI, 5.3);

(b) a document which establishes the publication date of another citation (see B-VI, 5.6);

(c) a document relevant to the issue of double patenting (see B-IV, 2.3(v) and G-IV, 5.4),

such document is indicated by the letter "L". Brief reasons for citing the document are given. In the specific case where the search division considers no documentary evidence to be necessary for the claimed subject-matter, as it is deemed to be notorious (see B-VIII, 2.2), the reasoning behind not citing any prior-art documents is given in the search opinion.

The citation of "L" documents need not be linked to any of the claims. However, where the evidence which they provide relates only to certain claims (for example the "L" document cited in the search report may invalidate the priority claim in respect of certain claims only), then the citation of the document is linked to those claims, in the manner indicated in B-X, 9.3.

9.3 Relationship between documents and claims

Rule 61(2) Each document cited in the search report is accompanied by an indication of the claims to which it relates, unless the document is indicated by category letter "L" (see B-X, 9.2.8). One and the same document may be indicated by different categories with respect to different claims, wherein each category is associated with particular claims.

Example

X	WO9001867 A (WIDEGREN LARS (SE)) 8 March 1990 (1990-03-08)	1
Y	* column 3, line 27 - line 43; figure 1 *	2-5
A	* figure 2 *	6-10

The above example means that the cited document discloses subject-matter which prejudices the novelty or inventive step of the subject-matter of claim 1 and the inventive step of the subject-matter of claims 2 to 5, when combined with another document cited in the search report, and that it represents non-prejudicial state of the art for the subject-matter of claims 6 to 10. The passages or figures are not necessarily relevant to the claims and the category indicated on the same line.

Furthermore, in general, all claims are mentioned in the search report at least once in relation to at least one document published before the earliest priority date (unless the claim in question is excluded from the search by virtue of a restriction of the subject of the search mentioned in B-X, 8) (see B-IV, 2.5).

9.4 Identification of relevant passages in prior-art documents

Rule 61(2)

In the case of long documents, the search division indicates those parts (such as a claim, example, figure, table or text passage on a particular page) of a cited document which contain the technical subject-matter closest to (or coinciding with) the searched invention. This is of particular importance where the document is relied upon for objections of novelty or inventive step.

Where it relies on a translation of a prior-art document, the search division indicates the relevant passages in the original document, whenever possible.

Furthermore, it makes sense to cite not only those parts of the document describing the same or similar technical subject-matter, but also those parts or passages relating to the problem solved by that subject-matter. This approach facilitates the assessment of inventive step in examination and also gives the applicant a greater indication of how the document may be used during prosecution.

10. Authentication and dates

The date on which the search report was drawn up is indicated in the report. This date is that of the drafting of the report by the member of the search division who carried out the search.

The name of the member must appear on the search report.

11. Copies to be attached to the search report

11.1 General remarks

Rule 65

The search report is sent to the applicant and transmitted to the examining division. In both cases, the report must be accompanied by copies of all documents cited (see also B-IV, 3.3), except those documents appearing in the search report after the "&" symbol, which are not designated for copying and communication to the applicant (see B-X, 11.3).

These cited documents are used to assess the patentability of the claimed invention (see B-XI, 3) both in the search opinion (if applicable, see B-XI, 7) and in the examination procedure.

11.2 Electronic version of document cited

In the case of a patent document, a complete copy is supplied even if the patent is bulky.

In cases where part or all of the document is published only by electronic means (see Rule 68(2) and OJ EPO 2000, 367), an electronic version of at least those parts of the document not available in paper form will be made available to the applicant. This must be done in such a way that the applicant is provided with the whole document either in a combination of paper and electronic forms or in electronic form only.

11.3 Patent family members; the "&" sign

In the case of patent families, only a copy of the member of the family actually cited is normally supplied. The other members are mentioned in an annex systematically produced by the computer for information only (see B-X, 9.1.2). However, in certain circumstances one or more further patent documents in the same patent family may be mentioned on the search report after the "&" sign (see B-X, 9.1.2(i)). In these cases, the search division may designate that a patent document appearing after the "&" sign is also copied and forwarded to the applicant (this document will then also be included in the examination file and may be referred to in the search opinion, if applicable).

11.4 Reviews or books

In the case of a review or a book, copies are made of the relevant pages of the publication concerned. The relevant bibliographic information has to be clear from the copy of the document.

11.5 Summaries, extracts or abstracts

Where a document cited is a summary, extract or abstract of another document, published separately, a copy of the summary, extract or abstract is forwarded to the applicant along with the report.

If, however, the search division considers that the entire document is required, that document must be cited and a copy must be attached to the report (see B-X, 9.1.2(ii)). In the case of a reference obtained by an online search for which neither the printed version from the database (e.g. COMPDX, PAPERCHEM2 and NTIS) nor the original article is available at the EPO at the time of drafting the search report, the print-out is added to the file in lieu of the original. This may also be done where the printed form of the abstract is available, but where there is no difference in the relevant technical content between the abstract derived from the database print-out and the printed version thereof.

11.6 Citation of video and/or audio media fragments available on the internet

Video and/or audio media fragments available on the internet are converted into a non-patent literature citation. The bibliographic data contain the URL of the original location on the internet.

12. Transmittal of the search report and search opinion

Rule 65
Rule 61(1)

The EPO forwards the search report, the search opinion (if applicable, see B-XI, 7) and copies of all cited documents to the applicant, see B-X, 11.1), including automated translations annexed to the ESOP (when appropriate, see B-X, 9.1.3) and those documents appearing after the "&" sign and designated to be copied and sent to the applicant (see B-X, 11.3).

Chapter XI – The search opinion

1. Search opinion is part of the EESR

The extended European search report (EESR) is made up of two components: *Rule 62(1)*

(i) the European search report or the supplementary European search report (see B-X)

(ii) the search opinion

1.1 The search opinion

For European applications filed as of 1 July 2005 and international applications filed as of that date entering the European phase, European search reports and supplementary European search reports will be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of the EPC.

The above applies except in the cases referred to in B-XI, 7.

The findings of the search opinion must be consistent with the document categories assigned in the search report and must also be consistent with any other issues raised in the search report, such as lack of unity of invention or limitation of the search.

1.2 Position of the examining division

The examining division will consider both the objections raised in the search opinion and the applicant's response thereto (see B-XI, 8) when examining the application further. It may change the position adopted in the search opinion after receiving arguments, amendments and other submissions from the applicant in response to the search opinion or subsequently in examination proceedings. The position may also alter, irrespective of the applicant's submissions, where the top-up search could not be completed when the search was performed and Art. 54(3) state of the art is found in a top-up search by the examining division or further state of the art is brought to the attention of the examining division by the applicant or by means of observations according to Art. 115 (see also B-IV, 3.2, C-IV, 7.2 and 7.3).

The examining division may also reverse the findings of the search opinion for reasons other than those above (see B-III, 1.1), however, such cases are exceptional.

2. Basis of the search opinion

Where the application is a European application not derived from an international application, applicants cannot amend their application before the search report has been communicated to them. Consequently, in these cases, the search opinion will always relate to the application documents as originally filed. Furthermore, any reply filed by the applicant in response to an invitation according to Rule 63(1) (see B-VIII, 3.4) will also be taken into consideration when drawing up the search opinion. *Art. 123(1)* *Rule 137(1)*

Rule 161(2)
Rule 159(1)(b)
Art. 19 PCT
Art. 34(2)(b) PCT

However, where the application under consideration derives from an international application and is subject to a supplementary European search according to Art. 153(7) (see B-II, 4.3), applicants will have had the opportunity to amend their application both in the international phase and also upon entry into the European phase. The search opinion will then be based on the application documents constituting the latest filed request from the applicant (this may involve the cancellation of amendments previously filed and consequent reversion in part or in full to an earlier set of application documents). The supplementary European search report is also based on these application documents (see B-II, 4.3 and B-III, 3.3.2).

Where the search opinion and supplementary European search report are based on such amendments but Rule 137(4) has not been satisfied (see H-III, 2.1), a communication according to Rule 137(4) (see B-VIII, 6 and H-III, 2.1.1) cannot be sent at this stage (before preparation of the search opinion) because the application is not yet under the responsibility of the examining division (see C-II, 1). However, once the examining division has assumed responsibility for the application, it may send such a communication, provided that the amendments in question have not been withdrawn or superseded (see H-III, 2.1.1) and only where the application is of one of the types mentioned in H-III, 2.1.4.

2.1 Applications containing missing parts of description and/or drawings filed under Rule 56 EPC or Rule 20 PCT

If the Receiving Section decided not to re-date the application under Rule 56(2) or (5), but the search division is of the opinion that the subsequently filed missing parts are not "completely contained" in the priority document and/or the requirements of Rule 56(3) are not fulfilled, it carries out the search also taking into account prior art which might become relevant for assessing novelty and inventive step of the subject-matter claimed if the application were re-dated pursuant to Rule 56(2) or (5). The search opinion must include a warning that the application seems not to fulfil the requirements laid down in Rule 56 for maintaining the accorded date of filing, a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the examining division. If appropriate, the search opinion may also include comments about the effect of re-dating on the priority claim and/or the status of the prior-art documents cited in the search report.

The procedure for a Euro-PCT application is similar to that set out above. If when carrying out a supplementary European search the search division finds that the subsequently filed missing parts are not "completely contained" in the priority document, despite the fact that the receiving Office did not re-date the application under Rule 20.5(d) PCT, the search opinion must include a warning that the application seems not to comply with the requirements of Rule 20.6 PCT (Rule 82*ter*.1(c) PCT), a statement of reasons as to why this is the case and an indication that a formal decision as to whether to re-date the application will be taken at a later stage by the examining division.

However, if the application has been re-dated by the Receiving Section or receiving Office, but the search division has reasons to believe that the application meets the requirements of Rule 56(3) (or Rule 20.6 PCT), it must indicate in the search opinion that decisions given by the Receiving Section (or the receiving Office) may be reconsidered at a later stage by the examining division, except where the latter is bound by a decision of the board of appeal.

2.2 Applications containing claims filed after the accorded date of filing

Where the application documents contain one or more claims filed after the accorded date of filing (Rules 40(1), 57(c) and 58), the search division is required to examine whether or not the one or more claims fulfil the requirements of Art. 123(2) in the light of the technical content of the application documents filed at the accorded date of filing. If the claims do not meet the requirements of Art. 123(2), the search is carried out in accordance with B-VIII, 6.

Where the search opinion and search report are based on late-filed claims but Rule 137(4) has not been satisfied (see H-III, 2.1), a communication according to Rule 137(4) (see H-III, 2.1.1) cannot be sent at this stage (before preparation of the search opinion) because the application is not yet under the responsibility of the examining division (see C-II, 1). However, once the examining division has assumed responsibility for the application, it may send such a communication, provided that the late-filed claims have not been superseded (see H-III, 2.1.1) and only where the application is of one of the types mentioned in H-III, 2.1.4.

3. Analysis of the application and content of the search opinion

Where it is held that the application and/or the invention to which it relates does not satisfy the requirements of the EPC, then corresponding objections are raised in the search opinion.

The search opinion covers, as a general rule, all objections to the application (but see B-XI, 3.4). These objections may relate to substantive matters (e.g. the subject-matter of the application is not patentable) or to formal matters (e.g. failure to comply with one or more of the requirements specified in Rules 41 to 43, 46 and 48 to 50) or to both.

Where claims relating to a method of treatment of the human or animal body or methods of diagnosis practiced on the human or animal body have been searched because their reformulation into an allowable format can be envisaged at the time of the search (see B-VIII, 2), the search opinion will, nonetheless, object to these claims as relating to subject-matter which is excluded from patentability. *Art. 53(c)*

3.1 The search division's dossier

The search division's first step is to study the description, drawings (if any) and the claims of the application. In carrying out its task, the search division will have access to the documents making up the European application and a complete history of the proceedings up to the start of search. However, *Rule 62*

the priority documents together with any translations may not yet be available at this stage (see B-XI, 4).

3.2 Reasoning

3.2.1 Reasoned objections

For each objection the search opinion indicates the part of the application which is deficient and the requirement of the EPC which is not met, either by referring to specific articles or rules, or by other clear indication; it also gives the reason for any objection where this is not immediately apparent. For example, where prior art is cited and only part of a cited document is relevant, the particular passage relied upon is identified. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the independent claim or claims, and if, consequently, there is lack of unity between dependent claims (see F-V, 7), the applicant is informed of this situation (see H-IV, 4.2(i)). Substantive matters are normally set out first. The search opinion is drafted in such a manner as to facilitate later examination of the amended application and, in particular, to avoid the need for extensive rereading (see C-IV, 2).

In general, all claims are referred to, and all documents cited as "X" or "Y" against certain claims are referred to in the search opinion with a corresponding objection. In the case of dependent claims, while detailed reasoning may not always be necessary in the search opinion, it needs at least to be apparent what the reason for the objection is.

3.2.2 Positive statements

The search division also makes positive statements on patentability in the search opinion, where applicable. The level of detail is such as to assist applicants in their decision-making. Therefore, it is not necessary to provide such detailed reasoning as for a negative objection, but a mere statement without any explanation is sufficient only if the reason is immediately apparent.

3.3 Comments and amendments in response to the search opinion

Subject to certain exceptions, the applicant is required to respond to the search opinion (see B-XI, 8).

3.4 Extent of first analysis for generally deficient applications

Where the application is found to be generally deficient, the search division does not carry out a detailed analysis, but sends a search opinion to the applicants informing them of its opinion, mentioning the major deficiencies and saying that when the application enters the examination stage, further examination will be deferred until these have been removed by amendment. There may be other cases in which, although a meaningful analysis is possible, a fundamental objection arises, e.g. it is clear that certain claims lack novelty and that the statement of claim will have to be drastically recast, or there are substantial amendments (international applications entering the European phase - see B-XI, 2) which are not allowable either because they introduce new matter not present in the application as filed (Art. 123(2)), or they introduce other deficiencies (e.g. the amendment makes the claims unclear - Art. 84). In such cases, it

may be more appropriate to deal with this objection before making a detailed analysis; if, e.g. the claims need recasting, it may be pointless to raise objections to the clarity of some dependent claims or to a passage in the description which may have to be amended or even deleted in examination proceedings as a consequence. However, if there are other major objections these are to be dealt with. Generally, the search division seeks to make the maximum impact in the search opinion with the broad aim of facilitating as efficient a decision making process as possible in later examination proceedings. Concerning positive statements on patentability in the search opinion, see B-XI, 3.2.2.

3.5 Contribution to the known art

Rule 42(1)(c)

When analysing the application, the search division concentrates on trying to understand what technical contribution the invention as defined in the claims adds to the known art. This should normally be sufficiently clear from the application as filed. If it is not, an objection is raised in the search opinion (see F-II, 4.5); but the search division does not raise an objection of this kind unless it is convinced it is necessary, since to do so might result in the applicant introducing additional subject-matter and thus offending against Art. 123(2) (see H-IV, 2 and H-V).

3.6 EPC requirements

Although the search division must bear in mind all the requirements of the EPC, the requirements which are most likely to require attention in the majority of cases are, in particular: sufficiency of disclosure (see F-III); clarity and support in the description, especially of the independent claims (see F-IV, 4 and 6); novelty (see G-VI); and inventive step (see G-VII).

3.7 Search division's approach

The search division does not require or suggest amendments merely because it thinks they will improve the wording of the description or claims. A pedantic approach is undesirable; what is important is that the meaning of the description and claims is clear. However, any serious inconsistencies between the claims and the description as filed are objected to (see F-IV, 4.3).

3.8 Making suggestions

It must be emphasised that it is not part of the duty of the search division to require the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicants' responsibility and they are free to amend in any way they choose provided that the amendment removes the deficiency and otherwise satisfies the requirements of the EPC. However, it may sometimes be useful if the search division suggests at least in general terms an acceptable form of amendment, but if it does so it has to make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered in examination proceedings. Although the search division is not obliged to do so, it does indicate to the applicant those amendments which would overcome the objections raised, if there is a clear way out.

When suggesting an acceptable form of amendment to the claims, the search division will also invite the applicant to adapt the description to bring it into line with the amended claims (see F-IV, 4.3).

Responsibility for determining the text of the application and in particular for defining the subject-matter for which protection is sought remains with the applicant (Art. 113(2) EPC).

3.9 Positive opinion

After the analysis referred to in B-XI, 3.1 to 3.8 has been made, the search division may come to the conclusion that the application and the invention to which it relates both satisfy the requirements of the EPC. In this case the search opinion contains a statement giving a general positive opinion on the application documents. However, where it is not possible to conclude the search for all potentially conflicting applications according to Art. 54(3) at the time of the search (see B-VI, 4.1), a top-up search will have to be carried out in the examination procedure (see C-IV, 7.1) and subsequently objections according to Art. 54(3) will be raised if appropriate.

Where minor amendments of the application documents would be necessary for the application to proceed to grant, a positive search opinion can still be issued. Thereafter, subject to no prior art according to Art. 54(3) being found in any subsequent top-up search, the Rule 71(3) communication can then be issued in examination proceedings, with those minor amendments being proposed by the examining division according to C-V, 1.1.

In the above cases, the applicant is not required to respond to the search opinion (see B-XI, 8).

At the search stage, it is not possible to officially designate an examining division, since responsibility for the application lies with the Receiving Section (Art. 16). However, the prospective members of the examining division are already indicated. Thereafter, the search division will consult the prospective members of the examining division to ensure that they agree to the issuing of a positive search opinion.

4. Priority claim and the search opinion

When it is not possible to check the validity of the priority claim at the search stage, because:

(i) the search is carried out before the date on which the priority document must be supplied (up to 16 months from the earliest claimed priority – Rule 53(1))

(ii) a translation of the priority document is required but not available to the search division at the time of drafting the search opinion (Rule 53(3), A-III, 6.8 and subsections and F-VI, 3.4)

then, for the purposes of drafting the search opinion, the priority claim will usually be assumed to be valid. Where at this stage the only objections which can be raised against the application depend on the priority being

invalid, and the priority document (or its translation) is not available, the search division issues an entirely positive search opinion without objections. In case (ii) above, a communication according to Rule 53(3) may be issued as specified in A-III, 6.8.1 and the validity of the priority subsequently reviewed in examination proceedings.

However, if an assessment of the validity of the priority claim is necessary as a result of intermediate prior art or potential state of the art according to Art. 54(3), and evidence is already available undermining the validity of the priority claim, then this needs to be brought up in the search opinion. For example, where the priority document is available at the time of drafting the search opinion and technical features of the claims are not present in the priority document, this may even be possible where a translation is required, but the search division is familiar with the language of the priority document (see also B-VI, 5.3).

4.1 Use of "P" and "E" documents in the search opinion

Where a document relating to potential prior art according to Art. 54(3) is referred to in the search opinion, two situations may arise, depending on whether or not the search division can conclusively establish that said prior-art document has an earlier relevant date than that of the application. If so, the search division raises an objection under Art. 54(3). If not, it assumes that any priority which cannot be checked is valid. This leads to two different scenarios:

(i) The prior-art document is comprised in the state of the art under Art. 54(3). The search division consequently raises an objection under Art. 54(3) in the search opinion and indicates which priorities have been assumed to be valid;

(ii) The prior-art document does not belong to the state of the art under Art. 54(3). Where the search opinion raises other objections, it will refer to the document potentially falling under Art. 54(3) (and its relevant passages) and will explain which priorities have been assumed valid.

Where there are also "P" documents cited in the search report and these are not potential Art. 54(3) documents (because they are not international or European patent applications), these documents may constitute prior art under Art. 54(2) and thus be relevant for the assessment of novelty and inventive step in so far as the priority of the application is not valid. Where the priority of the application can be checked, the search division checks the priority and makes objections in the search opinion based on the "P" documents if the priority is not valid. If the priority of the application cannot be checked, it is assumed to be valid and no objection is raised in the search opinion.

The issue of the validity of the priority claim(s) then needs to be reviewed in examination (see F-VI, 2).

5. Unity in relation to the search opinion

Where the search division finds that the claimed invention does not meet the requirement of unity of invention (Art. 82 and Rule 44(1) and (2)), the search division sends the applicant an invitation to pay additional search fees and the partial search report relating to the invention or unitary group of inventions first mentioned in the claims (see B-VII, 1.1, 1.2 and 1.3 and Rule 64(1)). A provisional opinion on the patentability of the invention or unitary group of inventions first mentioned in the claims and the reasons for non-unity findings is also sent to the applicant (see B-VII, 1.2).

After the time limit for payment of the additional search fees has expired, (Rule 64(1)) the applicant is sent a search report relating to the invention or unitary group of inventions first mentioned in the claims and all other claimed inventions or unitary groups of inventions in respect of which additional search fees have been paid. This is accompanied by a search opinion containing:

(i) the reasoning behind the lack of unity

(ii) an opinion on the first invention or unitary group of inventions mentioned in the claims

(iii) an opinion on all inventions or unitary groups of inventions in respect of which additional search fees have been paid

For supplementary European search reports on Euro-PCT applications lacking unity of invention, the same procedure is followed (Rule 164(1) - see B-VII, 2.3).

6. The search opinion in cases of a limitation of the search

Any argumentation and objections presented in the search opinion must be consistent with limitations of the search and the reasons therefor. This applies to limitations for reasons of non-patentability (e.g. business methods – Art. 52(2)(c), see B-VIII, 1), for reasons of severe deficiencies prejudicing a meaningful search (Rule 63, see B-VIII, 3) or due to a contravention of Rule 43(2) (Rule 62a, see B-VIII, 4). In these cases, the search opinion will also contain the information indicated in B-VIII, 3.3 and 4.3.

Where claims are deemed abandoned by reason of non-payment of a claims fee (Rule 45 or Rule 162) and are consequently not searched, the search opinion will draw the applicant's attention to this fact.

7. No search opinion is issued

Where applicants have filed the request for examination according to Rule 70(1) before the search report has been communicated to them and they have waived the right to receive the communication under Rule 70(2) (see C-II, 1(ii)), the despatch of the search report to the applicant causes the application to enter the competence of the examining division (Art. 18(1) and Rule 10(2)).

In this case, where the application contains deficiencies, the examining division will issue a communication according to Art. 94(3) in place of the search opinion. Failure to respond to this communication results in deemed withdrawal of the application according to Art. 94(4) (see C-III, 4.2).

If the application is ready for grant, the procedure is as follows:

(i) Where the search for conflicting applications according to Art. 54(3) was complete:

The examining division will issue a communication according to Rule 71(3).

(ii) Where the search for conflicting applications according to Art. 54(3) was not complete:

The applicant is informed that the application is in order for grant, on condition that no state of the art according to Art. 54(3) is found to exist when the top-up search is completed (see B-XI, 3.9). This is purely for information and no response from the applicant is required.

8. Reaction to the extended European search report (EESR)

The applicant is required to respond to the search opinion within the time limit for filing the request for examination provided for under Rule 70(1) (see C-II, 1 and A-VI, 2.1). *Rule 70a(1)*

If, however, applicants filed the request for examination before the search report and the search opinion were transmitted to them (according to Art. 94(1) this also requires payment of the examination fee), a communication according to Rule 70(2) is sent requesting to indicate whether they wish to proceed further with the application within a period to be specified (see C-II, 1(i)). In these cases, the applicant must respond to the search opinion within the time period set under Rule 70(2). This generally applies to Euro-PCT applications subject to preparation of the supplementary European search report and search opinion (see B-II, 4.3 and E-IX, 2.5.3), except where the applicant has waived the communication according to Rule 70(2) (see C-II, 1(ii)), in which case the procedure under B-XI, 7, applies. *Rule 70a(2)*

Failure to respond to the search opinion within the applicable period results in the application being deemed to be withdrawn, and the applicant is notified accordingly. In response to this communication of a loss of rights, the applicant can request further processing in accordance with Art. 121 and Rule 135. *Rule 70a(3)* *Rule 112(1)*

There is, however, no requirement for the applicant to respond to the European or supplementary European search report where this was drawn up before 1 April 2010, where it is not accompanied by a search opinion (see B-XI, 1.1 for applications for which a search opinion is prepared) or where the search opinion was positive (see B-XI, 3.9). However, in these cases, the applicant *may* still respond to the search report according to Rule 137(2) if so wished. In such cases, the applicant is encouraged to

respond to the search report before the application enters the examination stage (see C-II, 1).

The applicant responds to the search opinion by filing amended application documents according to Rule 137(2) (see C-II, 3.1) (where amended claims are filed before publication, see A-VI, 1.3, paragraph 3) and/or by filing observations on the objections raised in the search opinion, either in addition to, or in place of, such amendments. Such amendments and/or observations will only be examined by the examining division if the application enters the examination stage.

Procedural requests, such as a request for a consultation or for oral proceedings, or a mere disapproval do not constitute a valid reply where these are made without comment on any of the objections raised in the search opinion. In cases where such a request or disapproval is the only response to the search opinion on expiry of the applicable time limit, the application is deemed to be withdrawn according to Rule 70a(3). The same applies for a request which, at this stage, cannot be considered (e.g. request according to the state of the file).

For applications for which a search opinion was prepared but where the search report was drawn up before 1 April 2010, if the applicant does not reply to the search opinion and the application enters the examination stage (see C-II, 1 and 1.1), a communication referring to the search opinion and setting a time limit for reply will be issued by the examining division as the first communication under Art. 94(3) (see C-III, 4). Failure to respond to this communication in due time will result in the application being deemed withdrawn according to Art. 94(4).

Where the applicant files amendments in response to the search opinion, if Rule 137(4) is not complied with (see H-III, 2.1), a communication according to Rule 137(4) (see H-III, 2.1.1) may be sent in respect of these amendments only after the application has passed to the responsibility of the examining division (see C-II, 1) and only where the application is of one of the types mentioned in H-III, 2.1.4.

9. Art. 124 and the utilisation scheme

Art. 124
Rule 141

When drafting the search opinion, the search division takes into consideration any prior art document provided by the applicant under Rule 141(1) or by the office of first filing under Rule 141(2) (see OJ EPO 2011, 62, OJ EPO 2012, 540, OJ EPO 2013, 216, OJ EPO 2015, A2, OJ EPO 2016, A18, OJ EPO 2019, A55, OJ EPO 2019, A38, and OJ EPO 2019, A39), if available at the time of preparing the opinion (see A-III, 6.12 and B-IV, 1.3). Requests for information on prior art under Rule 141(3) may be made only when the application has entered the examination phase (see C-III, 5).

Part C

Guidelines for Procedural Aspects of Substantive Examination

Contents

Chapter I – Introduction

1. General remark

In this Part C of the Guidelines the term "examiner" is used to mean the examiner entrusted with substantive examination forming part of the examining division, which is responsible for the final decision. *Art. 18*

Chapters C-II to IX set out the general procedure for examination, together with guidance on particular matters where necessary. They do not provide detailed instructions on matters of internal administration.

2. The work of examiners

Under the "Early Certainty from Search" (ECfS) scheme, completing examination files already started is prioritised over beginning work on new files, and grants are expedited once a positive search opinion has been issued.

The attitude of examiners is very important. They should always try to be constructive and helpful. While it would of course be quite wrong for examiners to overlook any major deficiency in an application, they should have a sense of proportion and not pursue unimportant objections. They should bear in mind that, subject to the requirements of the EPC, the drafting of the description and claims of a European application is the responsibility of applicants or their authorised representatives.

The attention of examiners is particularly directed to the instruction in paragraph 4 of the General Part of the Guidelines. This applies not only in relation to other departments of the EPO. It also means, for example, that the other members of an examining division should not attempt to repeat the work of the primary examiner (see C-VIII, 4).

3. Overview

Part C of the Guidelines deals with matters of examination procedure (see Chapters C-II to IX).

Matters of substantive law, i.e. the requirements which a European application must fulfil, are dealt with in Parts F, G and H.

4. Purpose of examination

The purpose of preparing the search opinion (see B-XI) and of the subsequent examination proceedings is to ensure that the application and the invention to which it relates meet the requirements set out in the relevant articles of the EPC and the rules of its Implementing Regulations. The prime task of the examining division is to deal with the substantive requirements; the criteria by which an examiner judges whether they have been met are dealt with in detail, in so far as appears necessary, in Parts F, G and H. As for the formal requirements (see Part A), these are initially the responsibility of the Receiving Section. *Art. 94(1)* *Art. 164(1)* *Rule 62(1)*

The examination is to be carried out in accordance with Art. 94(3) and (4), Art. 97, Rule 71(1) to 71(7), Rule 71a(1) to 71a(6) and Rule 72. The *Rule 70(2)*

examiner's first step is to study the description, drawings (if any) and the claims of the application. However, as examiners will normally already have done this when they carried out the search (see B-XI, 3), they should concentrate on any amendments and/or comments filed by the applicant in response to the search opinion (see B-XI, 8). If amendments were made and these have not been identified and/or their basis in the application as filed not indicated by the applicant (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the examining division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see H-III, 2.1.1).

Chapter II – Formal requirements to be met before the division starts substantive examination

1. Request for examination

In order that examination of a European application can begin, applicants are required to file a request for examination, which, however, is not deemed to be filed until after the examination fee has been paid. The request for examination may be filed from the date on which the application is filed up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report (see A-VI, 2.1). If the request for examination is not filed within this period, the application is deemed to be withdrawn. However, in such a case, applicants have the possibility of filing a request for further processing pursuant to Art. 121. The amount of the further processing fee to be paid depends on how many and which of the actions required for a valid request for examination have been omitted (see E-VIII, 2). According to Rule 70(1), the request for examination may not be withdrawn.

Art. 94
Art. 121
Rule 70
Art. 122(4)
Rule 136(3)

Subject to certain exceptions, applicants must also respond to the search opinion within the above-mentioned period for filing the request for examination (see B-XI, 9 and C-II, 3.1), unless the EPO invites them to confirm an early request for examination according to Rule 70(2), in which case they must respond to the search opinion within the period provided for under Rule 70(2) (see C-II, 1.1).

Rule 70a(1) and (3)

Responsibility for examining the application passes from the Receiving Section to the examining division at the time when a request for examination is filed. This is subject to two exceptions:

Rule 10
Rule 70(2)

(i) if applicants have filed a request for examination before the European search report has been sent to them, then the examining division is responsible only from the time when the confirmation of the request is received by the EPO following an invitation under Rule 70(2);

(ii) if applicants have filed a request for examination before the European search report has been sent to them and have also waived the right to receive an invitation to confirm under Rule 70(2) (see C-VI, 3), then the examining division is responsible only from the time when the search report is sent to the applicants.

1.1 Confirmation of the intention to proceed further with the application

If applicants have filed a request for examination before the search report has been transmitted to them, the EPO will invite them to confirm, within a six-month period, that they desire to proceed further with their application. This six-month period is calculated from the mention of the publication of the European search report in the European Patent Bulletin. Where applicants also have to respond to the search opinion, their response is required within this same period (see B-XI, 8 and C-II, 3.1). In these cases,

Rule 70(2) and (3)
Art. 121
Art. 11 RFees
Rule 70a(2) and (3)

the applicant's response to the search opinion is interpreted as the confirmation required by Rule 70(2), even where not explicitly expressed as such. If applicants fail to confirm their desire to proceed further with the application in due time in reply to this invitation, the application will be deemed to be withdrawn. In this case, however, the means of redress provided for in Art. 121 (further processing of the application) will apply (see A-VI, 2.3 and E-VIII, 2). For the conditions applicable to a refund of the examination fee if the application is withdrawn, refused or deemed to be withdrawn, see A-VI, 2.5.

1.2 Euro-PCT applications

Art. 153(4), (6) and (7)
Art. 150(2)
Rule 159(1)(f)

If the application has proceeded via the PCT (Euro-PCT application), the six-month period under Rule 70(1) begins with the publication of the PCT search report or the declaration under Art. 17(2)(a) PCT. However, as is laid down in Art. 150(2), the time limit for requesting examination in a Euro-PCT case does not expire before the time prescribed in Art. 22 PCT and Art. 39 PCT (i.e. not before the time limit of Rule 159(1)(f)). The time limit will not be affected by whether a supplementary European search pursuant to Art. 153(7) needs to be made or whether the international application is again published by the EPO pursuant to Art. 153(4).

Art. 121
Rule 136(3)
Rule 160(1)

If the request for examination of a Euro-PCT application has not been filed within the time limit, the application is deemed withdrawn under Rule 160(1). In such a case, however, applicants have the possibility of filing a request for further processing pursuant to Art. 121 (see E-VIII, 2).

Where the Euro-PCT application is subject to the preparation of a supplementary European search report (see B-II, 4.3), once this search report has been despatched to the applicants, a communication according to Rule 70(2) is sent to them, inviting them to confirm the request for examination within six months of the notification of that communication (see E-IX, 2.5.3).

1.3 Invention to be examined

Rule 36

It is to be noted that where the search report and the search opinion have been drawn up to cover several inventions lacking unity, the applicant is free to select the invention to be examined in the application under consideration (see also C-III, 3.1).

The others will be subject to objections of lack of unity and may be divided out according to Rule 36 (see C-III, 3.2 and C-IX, 1.3).

2. Allocation of the application

The dossier will normally be allocated to an examining division responsible for the examination of applications in the technical field in which the particular application has been classified by the search division or ISA which carried out the search. It is usual for the primary examiner entrusted with the examination of the application in accordance with Art. 18(2) to be the same person who prepared the (supplementary) European search report and search opinion or, where the EPO was the ISA or the authority specified for the supplementary international search, the international

search report and WO-ISA or the supplementary international search report.

There may, however, be instances where it is appropriate to allocate the application to an examining division comprising examiners who are not normally responsible for the indicated part of the IPC and who might not have been involved at the search stage. There are a number of possible reasons for this: e.g. to make it possible, where appropriate, that an original and a divisional application are dealt with by the same examining division (this could sometimes be more efficient even when the two applications are classified in different technical fields); or if the classification of the published application does not correspond to the subject-matter of the application in the form in which it reaches the substantive examiner (e.g. because the application has been amended after receipt of the search report and search opinion).

3. Response filed before first communication in examination

3.1 Response to the search opinion

Rule 137(2)
Rule 70(2)
Rule 70a

Following receipt of the search report and search opinion, and prior to the first communication from the examining division, the applicant must (subject to certain exceptions) respond to the search opinion, by filing amendments to the description, claims or drawings and/or filing observations on the objections raised in the search opinion (see B-XI, 8 for details, in particular as to the exceptions where no reply is required). In order to avoid delays, care should be taken to comply with the requirements of Rule 137(4) when filing such amendments (see OJ EPO 2009, 533, point 7). Any amendments filed at this stage are made by applicants of their own volition in accordance with Rule 137(2) (for more details, see C-III, 2.1).

Art. 94(3) and (4)
Rule 62(1)

The applicant's response to the search opinion required by Rule 70a (or filed voluntarily in response to search opinions not requiring a response) will be taken into account by the examining division when drafting the first communication. Failure to respond to this communication in due time will result in the application being deemed withdrawn according to Art. 94(4), although this loss of rights is subject to further processing (see E-VIII, 2). With regard to what constitutes a valid response, see B-XI, 8.

If applicants accept a search division's suggestion regarding an acceptable form of amendment of the claims to overcome the objections raised (see B-XI, 3.8), applicants are requested to adapt the description to the claims on file and delete or amend any statements or expressions which throw doubt on the scope of protection (see F-IV, 4.3).

In exceptional cases the examining division may decide to issue summons to oral proceedings as the first action in examination proceedings (see C-III, 5). In such a case, the applicant's response to the search opinion will be taken into account when drafting the annex to the summons.

If the European search report or supplementary European search report was accompanied by a search opinion but was drawn up before 1 April 2010 (such that a reply to the search opinion was not mandatory –

see B-XI, 8) and the applicant did not reply to it, a communication referring to the search opinion and setting a time limit for reply would have been issued as the first communication under Art. 94(3). Failure to respond to this communication in due time would have resulted in the application being deemed withdrawn according to Art. 94(4).

The procedure explained in the above paragraphs also applies to Euro-PCT applications for which the EPO prepares a supplementary European search report and a search opinion (see B-II, 4.3 and B-XI, 1.1).

3.2 Response to PCT actions prepared by the EPO

Rule 161(1)

For Euro-PCT applications where the EPO acted as the International Searching Authority (ISA) and, where a demand under Art. 31 PCT was filed, also as the International Preliminary Examining Authority, or as the authority specified for supplementary international search, the applicant will already have responded to a negative WO-ISA, IPER or supplementary international search report prepared by the EPO (unless the communication under Rule 161 was issued before 1 April 2010 – see E-IX, 3.3.3).

This response may comprise amendments and/or observations filed in response to the communication under Rule 161(1) (or possibly filed earlier – see E-IX, 3.3.1).

If applicants accept the search division's suggestion regarding an acceptable form of amendment of the claims to overcome the objections raised (see PCT-EPO Guidelines, B-XI, 3.3), applicants are requested to adapt the description to the claims on file and delete or amend any statements or expressions which throw doubt on the scope of protection (see F-IV, 4.3).

Any amendments filed at this stage are made by applicants of their own volition in accordance with Rule 137(2) (for more details see C-III, 2.2). This response will be taken into account by the examining division when drafting the first communication according to Art. 94(3) or, in exceptional cases, the annex to the summons to oral proceedings (C-III, 5). For more details, see E-IX, 4.1, E-IX, 4.2 and E-IX, 4.3.

3.3 The invitation under Rule 70a(1)

Under Rule 70a(1) the applicant is invited to respond to the ESOP within the period referred to in Rule 70(1) or, where applicable, within the period referred to in Rule 70(2) (see B-XI, 8) unless the applicant has waived the communication under Rule 70(2) (see C-VI, 3).

Where the request for examination (including payment of the examination fee) is filed after the search report has been transmitted to the applicant, the applicant must respond to the ESOP within the period referred to in Rule 70(1). In such cases the invitation under Rule 70a(1) is sent in a combined communication with the communication according to Rule 69(1) (see A-VI, 2.1). This communication under Rule 70a(1) and Rule 69(1) is issued shortly after the mention of the publication of the European search report in the European Patent Bulletin (in general, this is approximately one week later).

Where the request for examination (including payment of the examination fee) is filed before the search report has been transmitted to the applicant, the applicant must respond to the ESOP within the period referred to in Rule 70(2). In such cases the invitation under Rule 70a(1) is sent in a combined communication with the communication according to Rule 70(2). With regard to how the period referred to in Rule 70(2) is calculated for these cases, see C-II, 1.1 for Euro-direct applications and C-II, 1.2 for Euro-PCT applications for which a supplementary European search report is prepared.

4. Designation fee(s), extension and validation fees

Under Rule 39(1), the designation fee(s) can be validly paid up to the same time limit as the examination fee and therefore will be generally paid at the same time as the examination fee. The examination whether and to what extent a designation fee has been validly paid has been entrusted to the formalities officer by virtue of Rule 11(3); see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6; OJ EPO 2015, A104. The same applies to the examination as to whether extension or validation fees have been paid; see A-III, 12.2.

Rule 39(1)
Art. 90(3)

5. Copy of the search results on the priority or priorities

Where the EPO notes, at the time the examining division assumes responsibility, that a copy of the results of a search on the claimed priority or priorities as referred to in Rule 141(1) has not been filed by the applicant and is not deemed to be duly filed under Rule 141(2) (see A-III, 6.12), it invites applicants to file, within a period of two months, the copy or a statement that the results of the search referred to in Rule 141(1) are not available to them. This requirement applies to European or Euro-PCT applications filed on or after 1 January 2011 (see OJ EPO 2009, 585). This communication is also sent in cases where the priority in question has since been withdrawn or has lapsed.

Rule 70b(1)

Failure to reply to this invitation in due time results in the application being deemed to be withdrawn. Further processing is available for this loss of rights (see E-VIII, 2).

Rule 70b(2)

The search results provided by the applicant will be included in the file and will be open to file inspection (see A-XI).

Chapter III – The first stage of examination

1. Missing parts or elements

1.1 European applications

1.1.1 Missing drawings or parts of the description filed under Rule 56

Rule 56

Where the applicant has supplied missing drawings or parts of the description after accordance of a filing date (see A-II, 5) under Rule 56, and the Receiving Section has determined that the missing drawings or parts of the description are "completely contained" in the claimed priority application, the application is not re-dated to the date on which the missing drawings or parts of the description were supplied.

The examining division may review the findings of the Receiving Section on the applicability of Rule 56(3) unless there has been a decision of the board of appeal.

Normally the review of the findings will have been initiated at the search stage (see B-III, 3.3.1 and B-XI, 2.1). However, it can still be done for the first time during substantive examination.

For the criteria for determining whether the "completely contained" requirement of Rule 56(3) is satisfied, see A-II, 5.4.2.

Should the examining division come to the conclusion that the missing elements are not "completely contained" in the priority document, contrary to the original finding of the Receiving Section, it will raise an objection under Rule 56 in the first communication under Art. 94(3), presenting detailed arguments as to why the "completely contained" requirement is not satisfied. The communication will contain a warning of the possible consequence of re-dating because of non-compliance with the requirements of Rule 56(3) and, if re-dating would result in the filing date being more than 12 months after the claimed priority date, also a warning of the resultant loss of priority right.

Note that if the review was initiated at the search stage and an objection under Rule 56 was raised in the EESR, the applicant may already have submitted a response to the search opinion (required by Rule 70a or filed voluntarily in response to a search opinion not requiring a response). The examining division will treat this response in the same manner as the reply to the first communication.

If the applicant replies by withdrawing the missing parts, the examination will be continued as normal with the original filing date, but without the missing parts (see also F-III, 10).

If the applicant replies by arguing convincingly that the "completely contained" requirement is satisfied, the examination will be continued as normal with the missing parts and with the original filing date.

If applicants maintain the missing parts and their arguments are not convincing, the examining division will issue a further communication under Art. 94(3) informing them of the impending re-dating of the application to the date on which the missing parts were received at the EPO. This communication gives the applicant a further opportunity to withdraw the subsequently filed missing parts within a time limit of two months (Rule 132(2)) so as to restore the original filing date or to request an appealable decision on the re-dating. It indicates the reasons why the "completely contained" requirement is not met, and also deals with any counter-arguments presented by the applicant.

If applicants do not reply in due time to the communication informing them of the impending re-dating of the application, the application is deemed to be withdrawn (Art. 94(4)).

If the applicant opts to withdraw the subsequently filed missing parts, the re-dating of the application will be deemed not to have been made (see also B-XI, 2.1). The examiner will continue the examination procedure as normal with the original filing date, but without the missing parts (see also F-III, 10).

Rule 111

If applicants do not agree with the finding, they may (within two months (Rule 132(2)) request an appealable decision on the matter. In this case, the examining division will issue a reasoned decision, informing the applicants of the new date of filing, of the reasons for the re-dating and (where appropriate) of the detrimental effect of the re-dating on the claimed priority right. This decision will allow a separate appeal according to Art. 106(2).

Once the period for filing an appeal has expired without an appeal being filed, the examiner will resume examination on the basis of the new date of filing. Note that the EESR may contain documents which could become relevant as a result of the re-dating.

If applicants file an appeal in due time, competence for the file passes to the board of appeal for reviewing the decision on the accordance of a filing date. While the case is pending before the board of appeal, the examining division will not continue substantive examination. Once the board of appeal has issued a decision, the file will be returned to the examining division, which will be bound on this point by the decision of the board (Art. 111(2)). It will then resume examination on the basis of the filing date fixed by the board.

1.1.2 Claims filed after accordance of a date of filing

Art. 123(2)

If the claims were not present at the date of filing the application, the examining division must check whether the subsequently filed claims satisfy the requirements of Art. 123(2). If the basis for these subsequently filed claims in the application as filed has not been indicated by the applicant (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the examining division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see H-III, 2.1.1).

1.2 Euro-PCT applications – Missing elements and parts filed under Rule 20.5 and 20.6 PCT

In the case of PCT applications, missing drawings and parts of the description, but also missing claims, may have been filed at the receiving Office for international applications under Rule 20.5 and 20.6 PCT, and its finding can be reviewed in accordance with Rule 82*ter*.1 PCT. The examining division will review this finding in all cases in which the filing date was retained on the basis of the "completely contained" requirement using the same criteria as applied when assessing compliance with Rule 56(3) EPC (see A-II, 5.4.2).

If either the EPO acted as the ISA or a supplementary EESR has been issued, this review will normally have been initiated at the search stage (see B-III, 3.3.1 and B-XI, 2.1). However, it can still be done for the first time during substantive examination. The procedure is the same as for European applications (see C-III, 1.1.1).

1.3 Euro-PCT applications – Erroneous elements filed under Rule 20.5*bis* PCT

Rule 20.5*bis* PCT allows applicants to correct an erroneously filed element (description or claims) or part of the description, claims or drawings (including all drawings) contained in an international application. The EPO has notified WIPO that this provision is partially incompatible with the current legal framework under the EPC and will therefore not be fully applicable in proceedings before the EPO as receiving and designated/elected Office (Rule 20.8(a-*bis*) and (b-*bis*) PCT; see the Official Notice published by the International Bureau in the PCT Gazette of 30 January 2020).

Corrections accepted by the receiving Office during the international phase under either Rule 20.5*bis*(b) PCT or Rule 20.5*bis*(c) PCT – i.e. where it accorded the date of receipt of the correct application documents or a later date as the filing date of the application or shifted the initial filing date of the application to the date of receipt of the correct application documents – will be effective in proceedings before the EPO as designated/elected Office (see OJ EPO 2020, A81).

However, if the receiving Office considered the correct application documents to be incorporated by reference under Rule 20.5*bis*(d) PCT, i.e. without changing the filing date, this incorporation will not be effective in proceedings before the EPO as designated/elected Office. In such cases, the EPO will, on entry into the European phase, consider the filing date of the application to be the date on which the correct application documents were received (Rule 20.8(c) PCT and Rule 20.5*bis*(b) or (c) PCT). Furthermore, it will consider the application as filed to include the correct application documents but not the erroneously filed ones. The EPO will inform the applicant about this in a communication under Rules 20.8(c) PCT and 82*ter*.1(c) and (d) PCT, setting a time limit of two months for reply.

(i) If, within the time limit, the applicant requests that the correct application documents be disregarded under Rule 82*ter*.1(d) PCT, the EPO will issue an interlocutory decision changing the filing date

to the date initially accorded by the receiving Office and confirming that the procedure before the EPO as designated/elected Office will be based on the application documents as filed on that date.

(ii) If the applicant files observations with regard to the communication under Rule 20.8(c) PCT and Rule 82*ter*.1(c) and (d) PCT within the time limit set, the EPO will also issue an interlocutory decision taking into account the observations made.

(iii) If the applicant does not file observations and does not request that the correct application documents be disregarded, an interlocutory decision will not be issued. In this case, the EPO will stick to its findings.

Applicants interested in avoiding this procedure, namely the issuance of the communication under Rules 20.8(c) PCT and 82*ter*.1(c) and (d) PCT and the setting of a time limit of two months for reply, may make use of the abridged procedure. According to it, they may, within the 31-month time limit under Rule 159(1) EPC, at the time of validly requesting early processing or, at the latest, before the communication under Rules 20.8(c) and 82*ter*.1(c) and (d) PCT is issued:

(a) request that the EPO disregard the correct application documents. In that case, no such communication but an interlocutory decision will be issued. This decision will confirm that the application maintains the initial filing date and that the correct application documents will be disregarded in the procedure before the EPO as designated/elected Office.

(b) confirm that they wish to pursue the application with the filing date corresponding to the date of receipt of the correct application documents and with those correct application documents. In that case, no invitation and no interlocutory decision will be issued. The EPO will correct the filing date and consider the erroneously filed application documents not to have been filed. The applicant will be informed accordingly.

Once the procedure described above has been finalised, a communication under Rules 161 and 162 EPC will be issued, and the applicant may amend the application within the scope of the disclosure on the filing date as determined in this procedure.

As a consequence of the procedure described above, it may happen that the application documents as originally filed differ from those that formed the basis for the search in the international phase. If the EPO acted as International Searching Authority, the examiner has to check carefully whether the invention forming the basis for the European phase was covered by a search in the international phase. If this is not the case, an invitation under Rule 164(2) EPC will be issued (see C-III, 2.3).

If the subject-matter forming the basis for European phase processing is covered by the international search report, then examination continues as

usual but taking into account that the potential change of the filing date might have an impact on intermediary documents cited in the international search report and that the priority might not be valid anymore.

For more details and examples, see OJ EPO 2020, A81.

2. Amendments made by applicants of their own volition

Any amendment, including any made by applicants of their own volition, must satisfy the following conditions:

(i) it must not add subject-matter to the content of the application as filed (see H-IV, 2.3 and H-V, 1 to 7); *Art. 123(2)*

(ii) it must not itself cause the application as amended to be objectionable under the EPC, e.g. the amendment must not introduce a lack of clarity into the claims (Art. 84); and

(iii) it must comply with Rule 137(5) (see H-II, 6).

If the amendments do not meet these conditions, the applicants should be told that the amended application cannot be allowed. Apart from the amendments referred to in C-III, 2.1 and 2.2, which are admissible under Rule 137(2), the applicants may correct obvious errors at any time (see H-VI, 2.2.1).

If amendments are made and these are not identified and/or their basis in the application as filed not indicated by the applicants (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the examining division may send a communication according to Rule 137(4) requesting the applicants to provide this information (see H-III, 2.1.1).

If applicants accept a search division's suggestion regarding an acceptable form of amendment of the claims to overcome the objections raised (see B-XI, 3.8), applicants are requested to adapt the description to the claims on file and delete or amend any statements or expressions which throw doubt on the scope of protection (see F-IV, 4.3).

2.1 Amendments made in response to the search opinion

The amendments referred to in C-II, 3.1 are made by the applicant "of his own volition" (applicants are required to respond to the search opinion in the EESR, but do not necessarily have to respond by filing amendments; they can also respond by filing observations on the search opinion – see B-XI, 8). This means that the applicant is not restricted to amendment(s) necessary to remedy a defect in the application. Further amendments may be made only with the consent of the examining division (see H-II, 2.3). *Rule 137(2) and (3)*

2.2 Amendments made in response to the WO-ISA, IPER or supplementary international search report

For Euro-PCT applications where the EPO acted as International Searching Authority (ISA) or as the authority specified for supplementary international search (SISA), any amendments which applicants file in response to the *Rule 137(2)*

communication under Rule 161(1) (see E-IX, 3.3.4) are made by applicants of their own volition. This means that they may be submitted to overcome objections raised in the WO-ISA, IPER or supplementary international search report or they may be suggested for some other reason, e.g. to remedy some lack of clarity which the applicants themselves have noted in the original documents. In order to avoid delays, care should be taken to comply with the requirements of Rule 137(4) when filing such amendments. Furthermore, the applicant may also file observations in place of or in addition to amendments.

2.3 Searches under Rule 164(2)

Rule 164(2)

For Euro-PCT applications where the EPO acted as ISA or as SISA, the examining division under Rule 164(2) assesses the application documents upon expiry of the six-month time limit set in the communication under Rule 161 and Rule 162. For any claimed invention or group of inventions within the meaning of Art. 82 which was not searched by the EPO in its capacity as ISA or SISA, the examining division issues an invitation to pay search fees.

The application documents as amended may contain claims directed to a non-searched invention in situations other than where the application documents which are to serve as the basis for examination do not meet the requirement of unity of invention.

For instance, the amended application may contain just one invention, but it may be an invention that was claimed but not searched by the EPO as (S)ISA in the international phase. In this case, there is no non-unity objection for this set of claims and the reasoning in the invitation needs only to refer to the non-unity objection in the WO-ISA and to the fact that no additional fee was paid for this invention during the international phase.

It may well be that an invention in the application documents was not even claimed in the application documents that served as the basis for the procedure in the international phase and has been imported from the description (see F-V, 7.1(iv)). In such cases an invitation to pay search fees under Rule 164(2) for any non-searched invention is to be issued by the examining division, irrespective of whether lack of unity persists in the claims. The invitation under Rule 164(2) must state that this is a new invention not searched in the international phase, and the reasons therefor. If other inventions are also present in the claims of such a case, which were also not searched (but were claimed in the PCT phase), in the same invitation the applicant must also be invited to pay further search fees in respect of those inventions. In assessing whether or not subject-matter present in amended claims constitutes a previously unclaimed invention imported from the description (for which an invitation under Rule 164(2) is to be sent), the principles laid down for assessing compliance with Rule 137(5) (see in H-II, 6.2) are to be taken into account.

The application documents forming the basis for the European phase may also cover inventions or groups of inventions which were not searched in the (supplementary) international search report as a result of the procedure for erroneously filed elements under Rule 20.5*bis* PCT (see C-III, 1.3). In

this case too, an invitation to pay search fees under Rule 164(2) EPC is to be issued by the examining division.

The invitation under Rule 164(2) must be sent before any communication according to Art. 94(3). It is to be noted that for Rule 164(2) to apply, the claims must be sufficiently clear to allow the identification of a non-searched invention by which the procedure under Rule 164(2) is triggered. If the claims are so unclear that a non-searched invention cannot be identified, the first action must be issuance of a communication under Art. 94(3) setting out the objections under Art. 84. Should it turn out later in the procedure that amended claims are indeed directed to a non-searched invention, the applicant must file a divisional application for any such subject-matter. Recourse to Rule 164(2) is not provided for if, as a result of further amendments or clarification, (further) non-searched inventions are identified, since the procedure under Rule 164(2) applies to the application documents as submitted by the applicant as the basis for examination.

If auxiliary requests are submitted before a search under Rule 164(2) is performed, only the main request is taken into account for the purpose of the search (notwithstanding the exceptions relating to Rule 62a or 63 cases where main and auxiliary requests are both considered at the search stage, see B-VIII, 3.2.2 and 4.2.2).

If any search fee(s) is/are paid in time, the results of the search(es) are communicated to the applicant as an annex to a communication under Art. 94(3) and Rule 71(1) and (2) or under Rule 71(3), as set out in Rule 164(2)(b). This annex is entitled "Search result according to Rule 164(2)".

If the applicant pays the search fees in due time under Rule 164(2) and at the same time files a new set of claims, the search will be carried out and the written opinion issued for the claims on file upon expiry of the period under Rule 161 for which the invitation to pay has been sent and the requested fees have been paid. The amended documents may, however, informally be taken into account by the examiner carrying out the search, where this appears appropriate. Applicants will have the opportunity to file amendments of their own volition after having received the results of the search under Rule 164(2) annexed to the communication according to Art. 94(3) (see H-II, 2.3).

If search fees are not paid in due time under Rule 164(2), a communication under Art. 94(3) and Rule 71(1) and (2) or under Rule 71(3) will be issued and the examining division will require deletion from the claims of any non-searched subject-matter that was not searched either because a search fee under Rule 164(2) was not paid (see H-II, 7) or for a different reason (see H-II, 6). Before the patent is granted, this subject-matter should be either deleted from the description and drawings or indicated as not forming part of the claimed invention (see F-IV, 4.3(iii)).

A communication under Rule 164(2)(b) deals with all objections for each of the inventions searched in accordance with Rule 164(2). For claims relating to inventions already searched by the EPO in the international phase which

have been amended but still lack unity, it is sufficient to argue in detail why lack of unity is still present. The communication, where appropriate, further requests the applicant to limit the application to a single searched invention (see Rule 164(2)(c)).

It follows from Rule 164(2)(b) and (c) that the special procedure under Rule 164(2) as set out in H-II, 2.3 ends upon expiry of the time limit set in the communication issued under paragraph (b). This means that the applicants' right to make amendments of their own volition ends upon expiry of the time limit set in that communication.

Furthermore, the special procedure as set out in F-V, 7.1(iv), which exempts amendments from the requirements of Rule 137(5), first sentence, ends upon expiry of the time limit under Rule 161(1). Such amendments will result in an invitation under Rule 164(2)(a) and allow the applicant to obtain a search of unsearched subject matter referred to in Rule 137(5). However, any amendments submitted after expiry of the time limit under Rule 161(1) are subject to the requirements of Rule 137(5), first sentence (see H-II, 6.2).

The EPO's obligations under Rule 164(2) are fulfilled and the applicant's rights under this rule are exhausted once a single communication under Rule 164(2) has been sent. It follows that in cases of cascading non-unity no (further) invitation under Rule 164(2) is sent. The same applies if claims are added or existing claims amended so that they relate to non-searched inventions in the course of the examination procedure.

Exceptional cases may arise where the following sequence of events has occurred in the international phase:

(i) The EPO acted as ISA in the international phase.

(ii) The EPO acting as ISA invited the applicant to pay one or more additional international search fees in accordance with Art. 17(3)(a) PCT and Rule 40 PCT (due to a lack of unity according to Rule 13 PCT).

(iii) The applicant paid at least one such additional search fee.

(iv) The additional search(es) led to a further objection as to a lack of unity a posteriori (a cascading lack of unity), resulting in one of the inventions identified in the invitation under Art. 17(3)(a) PCT and Rule 40 PCT being further sub-divided and resulting in sub-inventions not originally identified in that invitation.

(v) The EPO did not search all such sub-inventions.

In the above case, the EPO will invite the applicant to pay search fees for any such unsearched sub-inventions in the claims which are to form the basis for examination on expiry of the six-month period under Rule 161(1), in accordance with Rule 164(2).

Where the EPO was the SISA in accordance with Rule 45*bis*.9 PCT, it may make a finding of a lack of unity of the international application according to Rule 45*bis*.6(a) PCT. However, in the procedure before the SISA, the applicant cannot pay additional supplementary international search fees, and the supplementary international search report will be directed only to the invention or unitary group of inventions first mentioned in the claims (Rule 45*bis*.6(a) PCT). Where such an application contains unsearched inventions in the claims which are to form the basis for examination on expiry of the six-month period under Rule 161(1), a communication according to Rule 164(2) is issued, allowing the applicant to have these inventions searched upon payment of search fees and to pursue one of them in the examination proceedings.

Rule 164(2)(b) provides for a right to amend the application in response to the results of any search under Rule 164(2). This means that applicants may make amendments of their own volition once in response to the communication under Art. 94(3) to which the search results under Rule 164(2) are annexed (H-II, 2.3).

3. Unity of invention

3.1 Relation to unity in search; limitation to searched invention

Art. 82

An objection of lack of unity of invention, if applicable, should already have been raised at the search stage. If such an objection was not raised, but the examining division nevertheless considers that the requirements of Art. 82 are clearly not met, the question of lack of unity will be addressed as early as possible during examination (see F-V, 7.1 and H-II, 7.3).

When raising a finding of lack of unity or upholding an earlier one objected to by the applicant on the basis of unconvincing reasons, the examining division will invite the applicant to limit the application to one invention or group of inventions. In response to such an invitation, applicants must clearly indicate which searched invention they wishes to prosecute further. If the response is unclear, the examining division must seek clarification before continuing with the examination (see T 736/14).

3.1.1 No additional search fees paid

Rule 64
Rule 164(1) and (2)

If applicants have not availed themselves of the opportunity to have the search results on the other inventions included in the search report because they have paid no additional search fees in response to the invitation under Rule 64(1) (see B-VII, 1.2) or Rule 164(1) (see B-VII, 2.3), they will be taken to have elected that the application should proceed on the basis of the invention which has been searched (see G 2/92). In cases where a communication according to Rule 164(2) has been sent, Rule 164(2)(c) requires the applicant to delete all unsearched inventions from the claims.

It must be taken into account that the final responsibility for establishing whether the application meets the requirement of unity of invention ultimately rests with the examining division (see T 631/97). When considering the issue of unity, the examining division will consider both the reasons given in the search opinion and the applicant's response thereto

(see B-XI, 8, for details of when a response to the search opinion is required); for Euro-PCT cases where no supplementary European search report is prepared, the examining division will consider the reasons given in the WO-ISA, IPER or supplementary international search report prepared by the EPO and the applicant's response thereto as required by Rule 161(1) (see E-IX, 3.2). In the absence of any convincing response from the applicant to the issue of unity as raised earlier, the examining division will normally initially uphold the position taken earlier (see B-XI, 1.2) and will then require deletion of all the inventions other than that which has been searched. If the examining division is convinced, e.g. by arguments from the applicant, that the opinion on unity at the search stage was incorrect, then an additional search is performed for that part of the subject-matter which is judged to be unitary with an invention which was searched (see B-II, 4.2(iii), and C-IV, 7.2) and the examination is carried out on those claims which comply with the requirement of unity of invention. The applicant may file a divisional application for any excised subject-matter (see C-III, 3.2).

3.1.2 Additional search fees paid

If applicants have taken the opportunity to have other inventions searched, then they may determine that the application is to proceed on the basis of any of these, the other(s) being deleted. If the applicant has not yet done so, the examining division should at the beginning of substantive examination, if it maintains the objection of lack of unity (see C-III, 3.1.1), invite the applicant to state on which invention the prosecution of the application should be based and to limit the application accordingly by excising those parts belonging to the other inventions. For the latter inventions, the applicant may file divisional applications (see C-III, 3.2).

3.1.3 Invitation to pay additional search fees combined with invitation to restrict the scope of the search

In exceptional cases an invitation to pay additional search fees under Rule 64(1), Rule 164(1) or Rule 164(2) may be combined with an invitation to restrict the scope of the search under Rule 62a(1) and/or Rule 63(1).

When the application enters the examination phase or, in the case of Rule 164(2), after the reply to the first communication, the examiner will check whether the claims on which substantive examination is based meet the requirement of unity of invention (Art. 82) and cover only subject-matter which has been searched. If the claims lack unity of invention, the applicant will be invited to limit the claims to one searched invention and to exclude all unsearched subject-matter from the scope of the claims. If in reply to the objection raised by the examiner the applicant fails to respond adequately (either by amending the claims or by submitting convincing arguments) and the non-unity objection can be maintained, the application may be refused under Art. 97(2) in conjunction with Art. 82 (see H-II, 7.3 and 7.4), provided that the right to be heard – which includes the right to oral proceedings if so requested (Art. 116(1)) – has been respected.

If the original set of claims has been amended before entering the examination phase or, in the case of Rule 164(2), in reply to the first communication such as to meet the requirements of Art. 82, but includes

subject-matter that was excluded from the search following an invitation under Rule 62a(1) and/or Rule 63(1), the examiner will either (i) invite the applicant to limit the set of claims to the searched subject-matter under Rule 62a(2) and/or Rule 63(3), or (ii) raise an objection under Rule 137(5) against the claim(s) concerned (see H-II, 6.2). In Rule 164(2) cases, if the first communication already included the relevant objections/invitations and the right to be heard has been respected, the application may be refused.

If in reply to the invitation under Rule 62a(2) or Rule 63(3) the applicant fails to respond adequately (either by amending the claims or by submitting convincing arguments), the application may be refused under Art. 97(2), provided that the right to be heard has been respected (see F-IV, 3.3).

3.2 Excision of other inventions; filing divisional applications

Rule 36

For inventions which the applicant has deleted in accordance with C-III, 3.1.1 or 3.1.2, the applicant may file divisional applications.

The filing of a divisional application is only possible if the application being divided is still pending (see A-IV, 1.1.1).

3.3 Refund of additional search fees

Rule 64(2)
Rule 164(5)

If the applicant has paid further search fees in response to an invitation under Rule 64(1), 164(1) or (2) and has requested a refund of these, the examining division is required to review the validity of the finding of lack of unity (see also F-V, 4 to F-V, 7).

Requests for refunds should be handled promptly. If the examiner concludes that a request for refund should not be granted, an interlocutory decision to that effect should be issued at the earliest opportunity, subject to the requirements of Art. 113(1), and the issuing of the decision should not normally be left until the final decision on the application. Of course, if the stage in the procedure at which the examiner is in a position to issue the decision on the refund coincides with the issuing of either a Rule 71(3) communication or a decision refusing the application, then in the former case the interlocutory decision can be issued with the Rule 71(3) communication, and in the latter case the decision on the refund can be included in the decision refusing the application. An interlocutory decision issued on this matter will allow separate appeal under Art. 106(2).

Before an interlocutory decision is issued which refuses the request to refund additional search fees under Rule 64(2), applicants should be informed of the examining division's preliminary opinion in a communication under Art. 94(3). The arguments presented by the applicants in their reply to the search opinion should be taken into account in this preliminary opinion. Furthermore, a time limit should be set in order to give the applicants the possibility to comment on the examining division's preliminary opinion. At the same time, the applicants can be informed that they may request an interlocutory decision on the refund which will allow separate appeal under Art. 106(2). If these requirements are fulfilled, the applicant's right to be heard under Art. 113(1) is respected. The same procedure applies to the refund of search fees paid under Rule 164(1) and (2).

Rule 164(5) provides for a refund of any search fee paid under Rule 164(1) or (2) in line with Rule 64(2) (see A-X, 10.2.2). Where the applicant pays a search fee in response to the Rule 164(2) invitation and at the same contests the basis for requiring payment of a search fee and requests its refund under Rule 164(5), the examining division may deal directly with this issue in the communication according to Art. 94(3) and Rule 71(1) or (2) which accompanies the search results under Rule 164(2). Such an immediate review of the applicant's request is not possible in Rule 64(1) and 164(1) cases until such time as the examining division assumes responsibility for the application.

Moreover, it is essential to bear in mind that the review under Rule 64(2) or 164(5) is restricted to a reconsideration of the validity of that original finding under the circumstances existing at the time the Rule 64(1), 164(1) or (2) invitation was sent, taking into account only the prior art which was available at that time. For more details on the assessment of unity of invention, see F-V.

The issue of refunds of additional **international** search fees paid to the EPO acting as ISA in response to an invitation under Art. 17(3)(a) PCT, however, does not arise in the European phase, because these fees were paid in the international phase, which is closed by this stage of the procedure. The applicant may contest the payment of additional international search fees to the EPO acting as ISA by paying these under protest according to Rule 40.2(c) PCT. However, this must be done in the **international** phase (see also the Decision of the President of the EPO dated 9 June 2015, OJ EPO 2015, A59, and the Notice from the EPO dated 24 March 2010, OJ EPO 2010, 322).

3.4 Changing from one searched invention to another

Once the applicant has limited the claims to one searched invention, the examining division will refuse to admit amendments which involve switching to a different searched invention (for further information, see H-II, 7.1).

4. First communication

Rule 71(1) and (2)
Rule 132
Art. 94(3)

If deficiencies persist in the application even after the applicants have filed their response to the search opinion, the examining division will issue a communication according to Art. 94(3) and Rule 71(1), (2) in subsequent examination proceedings and will consider the applicant's reply thereto before issuing a negative decision or a summons to oral proceedings. For the exceptional case where summons to oral proceedings are issued as the first action in examination proceedings, see C-III, 5.

When drawing up such a communication (or exceptionally the summons to oral proceedings), the examining division will take into account the documents (if any) cited in the search report and any further documents found as the result of the search referred to in C-IV, 7.1, as well as any amendments proposed, or comments made, by the applicant in reply to the search opinion (see B-XI, 8) or in reply to the communication under Rule 161(1) (see E-IX, 3). The examiner should identify in this communication any requirements of the EPC which, in his or her opinion, the application does not satisfy. The communication will give reasons for

any objections raised and will invite the applicants within a specified period to file their observations or submit amendments. The filed application documents are not sent back to the applicant although a copy of the description and claims may be sent in appropriate cases (see H-III, 2). When the applicant has replied, the examiner will then re-examine the application.

If no search opinion has been issued (see C-VI, 3, F-V, 7.1(ii) and B-XI, 1.1), the examiner's first communication under Art. 94(3) will, as a general rule (see B-XI, 3) and by analogy with the search opinion, cover all objections to the application (see B-XI, 3.4 for exceptional cases where not all objections are raised). Summons will not be issued as the first office action in examination proceedings in such cases.

4.1 Reasoning

4.1.1 Reasoned objections

As with the search opinion, for each objection the communication should indicate the part of the application which is deficient and the requirement of the EPC which is not met, either by referring to specific articles or rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent (for more details see B-XI, 3.2). *Rule 71(2)*

The burden of proof and the onus of presentation of the relevant facts about patentability requirements lie initially with the examining division, which must provide evidence and facts to support its objection (see decision T 655/13). Accordingly, prior art documents forming the basis for novelty or inventive step objections must be cited in such a way that these conclusions can be checked without difficulty (see E-X, 2.6).

4.1.2 Positive statements/suggestions

Where appropriate, the communication should also contain positive statements on patentability where some of the claims meet the patentability requirements (see B-XI, 3.2.2). In this phase of the proceedings, the examiner should make such statements in particular where the claims for which a positive conclusion is reached have not yet been commented on.

Concerning making suggestions on how to overcome objections, see B-XI, 3.8. When suggesting an acceptable form of amendment to the claims, the examining division will also invite the applicant to adapt the description to bring it into line with the amended claims (see F-IV, 4.3).

4.2 Invitation to file comments and amendments

The communication should include an invitation to the applicant to file observations, to correct any deficiencies and, if necessary, to submit amendments to the description, claims and drawings. It must also state the period within which the applicant must reply. Failure to reply in due time will cause the application to be deemed withdrawn (see C-VI, 1 and E-VIII, 1). Further processing applies to this loss of rights (E-VIII, 2). *Rule 71(1) and (2)* *Art. 94(3) and (4)*

5. Summons to oral proceedings as the first action in examination

In exceptional cases, the examining division may issue a summons to oral proceedings as the first action in examination. The division may decide to do so only if

– in its opinion, there is no prospect of a grant, even taking into account the applicant's reply to the search opinion;

– the content of the claims on file is not different in substance from that of the claims which served as a basis for the search, and

– one or more of the objections raised in the search opinion which are crucial to the outcome of the examination procedure still apply.

The annex to the summons issued as the first action in examination must deal with the applicant's requests in their entirety and be as detailed as a communication under Art. 94(3) EPC (see, in particular, C-III, 4.1). It must not include any new objections or cite new documents. All objections to the application must be covered and substantiated by giving the essential legal and factual reasons. In addition, it must include the reasons why the division decided to directly summon to oral proceedings as the first action in examination. The division may inform the applicant in a telephone call if it is considering issuing a summons to oral proceedings as the first action in examination (C-VII, 2.5).

In order to allow the applicant sufficient time to prepare any submissions ahead of the oral proceedings, the summons should be issued with at least six months' notice.

In accordance with the principles applicable to the summons to oral proceedings, applicants may avail themselves of the possibility to submit any arguments and amendments by expiry of the deadline set under Rule 116(1) EPC. Requests filed after the date set under Rule 116(1) are not to be treated as late-filed (H-II, 2.7) in the case of a summons to oral proceedings issued as first action in examination.

Should the applicant's submissions contain a genuine effort to overcome the examining division's objections, oral proceedings may be cancelled or postponed. Otherwise, a decision on the substance of the application will in principle be taken during the oral proceedings, even if the applicant does not attend them (see E-III, 6 and E-III, 8.3.3.3).

6. Requesting information on prior art (not confined to priority)

Art. 124
Rule 141(3)

The EPO may invite the applicant to submit, within a period of two months, information on prior art which has been taken into consideration in national or regional patent proceedings concerning an invention to which the European patent application relates. This in particular encompasses search results with respect to applications for patents or utility models whose priority is not being claimed. It also enables the EPO to request, *inter alia*, the copy of the results of the search on the priority or priorities referred to in Rule 141(1), where the search results were not available to the applicant when requested under Rule 70b(1) (see the Notice from the EPO dated

28 July 2010, OJ EPO 2010, 410). Failure on the part of the applicant to comply with this invitation results in the application being deemed to be withdrawn under Art. 124(2). Further processing is available for this loss of rights (see E-VIII, 2).

In view of the considerable work such invitations may imply for applicants, further requests under Rule 141(3) will be issued only in individual cases, where there are cogent reasons to suspect the existence of additional, relevant prior art.

This invitation is an independent communication, and the above-mentioned time limit is non-extendable. The invitation can be sent by itself or at the same time as a communication according to Art. 94(3). If sent at the same time, the time limits set in both communications are independent of one another. Any information on prior art provided by the applicant will be included in the file and will be open to file inspection (see A-XI).

7. Evaluation of prior art documents cited in search report and late priority claim

As explained in A-III, 6.5.1 and 6.5.2, the applicant has the right to correct or to introduce a priority claim within 16 months of the earliest priority (with a minimum of four months from the European filing date in the case of corrections). When this happens before finalisation of the search report, the examiner may review the draft search report to take into account the change in the effective date of the application. In cases where the search report was issued on the basis of the original priority status (i.e. addition or correction of a priority claim is effected after the search report is drawn up), the primary examiner at the substantive examination stage should re-evaluate the relevance of the documents cited in the search report. Where it appears that the prior art available to the examiner is unlikely to reflect the state of the art in a sufficiently complete way for the purpose of a patentability assessment, the examiner should then conduct an additional search (see C-IV, 7.2). No further search report will be issued in these cases: the applicant will be informed of any newly-found documents in a communication pursuant to Art. 94(3) (with copies of such documents annexed to that communication).

Chapter IV – Examination of replies and further stages of examination

1. General procedure

Following the applicant's reply to the search opinion (see B-XI, 8), WO-ISA, IPER or supplementary international search report prepared by the EPO (see E-IX, 3) or to the first communication, the examiner must examine the application, taking into account observations or amendments made by the applicant.

Where the application is one of those mentioned in H-III, 2.1.4, Rule 137(4) requires that any amendments made by the applicant in reply to the search opinion, WO-ISA, IPER or supplementary international search report be identified and their basis in the application as filed indicated. Failure to comply with this requirement may result in the examining division sending a communication according to Rule 137(4). For more details of the procedure, see H-III, 2.1.1 and 2.1.2.

In the case of one or more auxiliary request(s) directed to alternative texts for grant of a patent, every such request qualifies as a text submitted or agreed by the applicant within the meaning of Art. 113(2) and therefore must be dealt with in the order indicated or agreed to by the applicant, up to and including the highest-ranking allowable request, if any (see also H-III, 3 and C-V, 1.1). It is also to be noted that, for the types of application mentioned in H-III, 2.1.4, Rule 137(4) must also be complied with in respect of auxiliary requests, which may also be subject to a communication according to Rule 137(4).

2. Extent of examination of replies

After the first examination stage, provided that the:

– search opinion,

– WO-ISA (when prepared by the EPO),

– explanation accompanying the supplementary international search report under Rule 45*bis*.7(e) PCT (when prepared by the EPO, see the Notice from the EPO dated 24 March 2010, OJ EPO 2010, 316, point 6),

– IPER (when prepared by the EPO), or

– first communication (see B-XI, 1.1 and 8)

was comprehensive and clear (see B-XI, 3 and C-III, 4 and 4.1), the examiner will not normally need to completely reread the application but rather should concentrate on the amendments themselves, the related passages, and the deficiencies previously noted.

3. Further action upon examination of replies

Art. 94(3)

Examiners should be guided at this stage by the overriding principle that a final position (grant or refusal) should be reached in as few actions as possible, and they should control the procedure with this always in mind. The EPC provides that the process of communicating with the applicant described in C-III, 4 is repeated "as often as necessary".

In most cases, the applicant will have tried to deal with all the examiner's objections. A letter of reply from the applicant does not have to be substantively complete or cogent in order to qualify as a reply within the meaning of Art. 94(4). For the application not to be deemed withdrawn, it is enough for the applicant to comment on, even incompletely, or to file amendments in reply to at least one of the objections raised in the communication under Art. 94(3). In contrast, purely formal requests, such as the extension of the time limit under Art. 94(3) or the request for a consultation, do not qualify as replies under Art. 94(4) (see also B-XI, 8 and E-VIII, 2). A request for a decision according to the state of the file (see C-V, 15), however, qualifies as a reply within the meaning of Art. 94(4).

If the only outstanding objection is the need to amend the description, see C-VI, 1.1.

Art. 113(1)

If examination of the applicants' reply shows that despite their submissions objections persist, and provided that at least one communication has been sent in examination proceedings (see C-III, 4 and E-IX, 4.1) and the applicants have been given the right to be heard (Art. 113(1)), i.e. the decision is based solely on grounds on which they have had an opportunity to comment, the examiner will consider recommending to the other members of the examining division that the application be refused (see T 201/98). However, where there is a reasonable prospect that an additional invitation to overcome the objection(s) could lead to a grant, the examiner will send a further written communication or contact the applicants by telephone. The examiner may also make suggestions on how to overcome the raised objections (see B-XI, 3.8 and C-III, 4.1.2).

If examination of the applicants' reply shows that they have not dealt with all the main objections in their reply, it may be appropriate to draw the deficiencies to their attention, e.g. by telephone. But if no positive reaction is to be expected, the examiner should consider recommending to the other members of the examining division that the application be refused immediately (again provided that at least one communication has been sent in examination proceedings).

If substantial differences of opinion exist, the issues are generally best dealt with in writing. If, however, there seems to be confusion about points in dispute, e.g. the applicant seems to have misunderstood the examiner's arguments or the applicant's own arguments are unclear, then a consultation may be useful. A consultation may also expedite the procedure, if the matters to be resolved are minor. Consultations do not constitute oral proceedings (see E-III). They are more fully considered in C-VII, 2.

3.1 Further action where a request for a translation of the priority application was sent earlier in examination proceedings

In cases where an invitation under Rule 53(3) to file a translation of one or more priority applications was sent earlier in examination proceedings (either separately or at the same time as a communication under Art. 94(3) – see A-III, 6.8.2), a subsequent communication (under Art. 94(3) or Rule 71(3), or a summons to oral proceedings) cannot be sent until the translation is filed or the period for further processing has expired (see also E-III, 5.1). This also applies in cases where the Rule 53(3) invitation was sent at the same time as a previous communication under Art. 94(3) and the applicant has already replied to that communication (e.g. by filing amendments), but has not yet provided the translation and the original time limit or the period for further processing is still running.

Rule 53(3)

4. Later stages of examination

Similar considerations apply to later stages of examination on the understanding that, having regard to the principle stated in C-IV, 3, the greater the number of actions which have already taken place, the greater is the likelihood that the most appropriate action is to refer the application to the other members of the examining division for a decision. Where this decision is to refuse the application, particular care should be taken to ensure that the decision does not offend against Art. 113(1).

5. Examination of amendments

Any amendment must satisfy the conditions listed in C-III, 2. When it was effected must also be established.

6. Admissibility of amendments made by the applicant

For matters relating to the admissibility of amendments made in examination proceedings, see H-II, 2.

Rule 137(2) and (3)

7. Search-related issues in examination

7.1 Search for conflicting European applications

The examiner should make a search for any additional conflicting European applications falling within the area defined by Art. 54(3) unless this was already covered by the search report.

This is because as a general rule the search files will not be complete in respect of such material at the time the main search is made. Since priority dates claimed (if any) may not be accorded to all or part of the application but may be accorded to the appropriate part of a conflicting application (see F-VI, 2.1), this search should be extended so as to cover all European applications published up to eighteen months after the filing of the application under consideration. On condition that the priority claim is valid for the whole content of the patent application under examination, the top-up search may exceptionally be performed at the earliest 18 months from the priority date. If examiners are unable to complete this "topping-up" search at the time the search opinion or the first communication under Art. 94(3) is prepared, they should ensure that such search is completed before the application is reported to be in order for the grant of a patent. In the rare case in which the application is found to be in order before this

search can be completed (e.g. due to a request for accelerated prosecution of an application not claiming priority, "PACE", see the Notice from the EPO dated 4 May 2010, OJ EPO 2010, 352), the grant of a patent should be postponed until the topping-up search can be completed (T 1849/12).

In addition to retrieving Art. 54(3) documents which were not available at the time of the original search, the top-up search takes into consideration, *inter alia*, potentially relevant prior art cited by other patent offices on applications belonging to the same patent family as the application under examination at the EPO, and therefore needs to be performed for any file at the start and end of examination.

In the framework of the refund of examination fees (see A-VI, 2.5), the launch of a top-up search is triggered at the start of examination. This creates a marker which serves as evidence in the file that the examining division has started its substantive work.

7.2 Additional searches during examination

An additional search will sometimes be required either at the first stage of amendment or subsequently. This may arise for a number of reasons.

An additional search may be necessary:

(i) where a partial search taking the place of the search report under Rule 63 has been issued at the search stage after an invitation under Rule 63(1) (see B-VIII, 3, 3.1 and 3.2), and subsequently the deficiencies which rendered a meaningful search impossible under Rule 63 have been corrected by amendment complying with Rule 137(5) (see H-II, 6.1) or successfully refuted by the applicant;

(ii) where a declaration that a meaningful search was not possible took the place of the search report under Rule 63, and the applicant successfully refuted the objections;

(iii) where the applicant successfully argues that a plurality of independent claims in the same category, which led to a limitation of the search report in accordance with Rule 62a (see B-VIII, 4.1 and 4.2), is in fact allowable according to the exceptions provided for in Rule 43(2) (see F-IV, 3.2);

(iv) where a particular part of the application has not been searched because of an objection of lack of unity of invention, and the arguments put forward by the applicant have convinced the examining division that unity is given;

(v) where the claims have been so amended that their scope is no longer covered by the original search;

(vi) where a search report under Rule 61 was issued containing no prior art documents because the technical features were found to be notorious (see B-VIII, 2.2.1) and the examining division does not share this opinion;

(vii) where no prior art document was cited for features which were considered to be part of the common general knowledge and the examining division does not share this opinion or the common general knowledge is challenged by the applicant (see G-VII, 2 and 3.1);

(viii) exceptionally, where the applicant states that a mistake was made in the acknowledgement of prior art (see G-VII, 5.1) or the examiner believes that material relevant to obviousness might be found in technical fields not taken into account during the search;

(ix) where the applicant has introduced a new priority claim after the date of filing (see C-III, 6).

Art. 153(6) and (7)

If the application has been filed under the PCT, the search report will be the international search report made under the PCT, which will be accompanied by a supplementary European search report, unless the Administrative Council has decided that a supplementary report is to be dispensed with (see E-IX, 3.2). Both of these reports will have to be considered by the examiner when deciding whether any additional search is required.

For searches under Rule 164(2) see C-III, 2.3.

7.3 Search at the examination stage

Although in principle all search work (other than for Art. 54(3) material) should be done at the search stage, in exceptional circumstances examiners are not barred from looking for a relevant document whose existence they know of or have reason to suspect, if they can retrieve that document in a short time.

7.4 Citing documents not mentioned in the search report

A copy of any document cited by the examiner but not mentioned in the search report, for example one found in a search under C-IV, 7.1 or 7.2, should be sent to the applicant and identified in the electronic dossier (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.2).

8. New submissions in reply to summons

New requests filed in reply to a summons to oral proceedings will normally be discussed at the oral proceedings. As a rule there is no provision for detailed discussion before the oral proceedings.

However, informal consultation to discuss the new request(s) may be allowed by the first examiner (see C-VII, 2), in particular if there is a reasonable prospect that the consultation could lead to an agreed allowable claim set.

The examining division strives to review newly-filed requests in good time before oral proceedings so that the proceedings can be cancelled if necessary, in particular where a newly-filed main request is considered patentable.

For cases where the newly-filed main request is not considered patentable but one of the auxiliary requests is, see E-X, 2.9.

Chapter V – The final stage of examination

1. Communication under Rule 71(3)

1.1 Text for approval

Rule 71(3)

Once the examining division has decided that a patent can be granted it must inform the applicant of the text on the basis of which it intends to do so. This text may include amendments and corrections made by the examining division on its own initiative which it can reasonably expect the applicant to accept. In case of doubt as to whether the applicant would agree to the amendments proposed by the examining division, the applicant should be contacted by telephone or an official communication has to be written. The applicant's agreement to such amendments will usually be recorded in the communication according to Rule 71(3) (see C-VII, 2.4).

Examples of amendments where no such consultation with the applicant is required are the following:

(a) bringing a statement of invention in the description into conformity with the claims

(b) deletion of vague general statements in the description (see F-IV, 4.4) or of obviously irrelevant matter (see F-II, 7.4)

(c) insertion of values in SI units (see F-II, 4.13)

(d) insertion of reference numerals in claims unless the applicant is known to object to this or has previously objected to this

(e) introduction of a summary of background art which clearly represents the prior art closest to the invention (see F-II, 4.3)

(f) amendments which, in spite of the fact that they change the meaning or scope of an independent claim, would very clearly have to be made, so that it can be assumed that the applicant would not object to them (see for example G-VI, 7.1.2, G-VI, 7.1.3 and G-VI, 7.1.4)

(g) correction of linguistic and other minor errors

(h) reformulation of method-of-treatment claims into an allowable format (see G-II, 4.2).

(i) deletion of redundant claims (e.g. omnibus claims and claims which the applicant has not deleted despite having incorporated their features into other claims).

Examples of amendments which may not be proposed without consulting the applicant are:

(i) amendments which significantly change the meaning or scope of the claims, if there are different ways of amending the claim, so that the examiner cannot assume to which possibility the applicant will agree.

(ii) deletion of entire claims, with the exception of so-called "omnibus claims" (i.e. claims reading "An apparatus substantially as described herein", or the like)

(iii) combining claims so as to overcome a novelty or inventive step objection.

With regard to such amendments and corrections made by the division, it is important to bear in mind that the above list is designed to avoid changes which the applicant is more likely to reject, thus helping to avoid delays in the conclusion of examination proceedings. The standard marks used by the division for indicating amendments and corrections using the electronic tool are listed in C-V, Annex.

The text is communicated to the applicant by despatching a communication under Rule 71(3), in which the applicant is furthermore invited to pay the fee for grant and publishing (see C-V, 1.2) and to file a translation of the claims in the two official languages of the EPO other than the language of the proceedings (see C-V, 1.3) within a period of four months, which is non-extendable. If the applicants pay the fees and file the translations within this period (and file or request no corrections or amendments to the text proposed for grant in the Rule 71(3) communication, see C-V, 4.1), they will be deemed to have approved the text intended for grant (Rule 71(5)).

If during examination proceedings a main request and auxiliary requests have been filed (see C-IV, 1 and E-X, 2.9) and one of the requests is allowable, the communication pursuant to Rule 71(3) is to be issued on the basis of the (first) allowable request and must be accompanied by a short indication of the essential reasons for the non-allowability of the subject-matter of the higher-ranking requests or the non-admissibility of these requests (see also H-III, 3). This short indication should provide sufficient information about the objections raised by the examining division to enable the applicant to comment on them.

Handwritten amendments by the applicant to the description, claims and abstract, unless they involve graphic symbols and characters and chemical or mathematical formulae, are no longer accepted in strict compliance with Rule 50(1) in conjunction with Rule 49(8) (see OJ EPO 2013, 603, and A-III, 3.2). For the procedure to follow in oral proceedings, see E-III, 8.7.

1.2 Grant and publishing fee

The communication under Rule 71(3) also invites the applicant to pay the fee for grant and publishing within the same non-extendable four-month period. Note that for European patent applications filed before 1 April 2009

and international applications entering the regional phase before that date the fee for grant and printing may include an element depending on the number of pages, but for applications filed or entering the regional phase on or after that date this additional element is payable as part of the filing fee (see A-III, 13.2).

1.3 Translations of the claims

The communication under Rule 71(3) also invites the applicant to file a translation of the claims in the two official languages of the EPO other than the language of the proceedings within the same non-extendable four-month period.

If the application contains different sets of claims for particular contracting states (see H-III, 4), a translation of all the sets of claims must be filed.

Only one copy of the translation needs to be filed.

Examiners should not concern themselves with the quality of the translation filed.

The translation should meet the requirements pursuant to Rule 50(1). *Rule 50(1)*

1.4 Claims fees due in response to Rule 71(3) communication

If the text of the European patent application serving as the basis for grant contains more than fifteen claims, the examining division requests the applicants to pay, within the period under Rule 71(3), claims fees in respect of each claim over and above that number unless they have already done so under Rule 45(1) or Rule 162(1) and (2) (see A-III, 9). Where there is more than one set of claims, fees are incurred under Rule 45(1), Rule 162(1) and Rule 162(2), or Rule 71(4) only for the set with the highest number of claims. *Rule 71(4)* *Rule 45(1)* *Rule 162(1) and (2)*

If the text on which the Rule 71(3) communication is based contains fewer claims than the set of claims in respect of which claims fees were paid on filing under Rule 45 or on entry into the European phase under Rule 162, no refund of claims fees will be made.

Where the communication under Rule 71(3) is based on an auxiliary request, it is the number of claims in that auxiliary request which determines the claims fees which are due in response to this communication. However, if the applicant then replies by requesting a grant based on a higher-ranking request, no claims fees need to be paid in response to that Rule 71(3) communication (see C-V, 4.1).

1.5 Other information in the communication under Rule 71(3)

An annex to the communication under Rule 71(3) states the contracting states which have been validly designated as well as the extension and validation states for which the corresponding fees have been paid, the title of the invention in the three EPO official languages, the international patent classification, the date of filing of the application, any priorities claimed, the designated inventors and the registered name of the applicant.

The communication under Rule 71(3) also states that, where a renewal fee falls due between the notification of this communication and the proposed date of publication of the mention of the grant, publication will be effected only after the renewal fee and any additional fee have been paid (see C-V, 2).

Where the examining division changes its opinion after an earlier negative communication, it will communicate the reasons for this change unless they are clear from the applicant's reply, from a communication or from the minutes of a consultation.

During the grant procedure an applicant may submit further technical information, for example:

– comparative tests

– further examples

– statements concerning the effects and/or advantages of the invention.

Technical information which extends beyond the content of the application as filed, however, cannot be included in the application by way of amendment (Art. 123(2), H-IV and H-V). Such information is added to the file, which is open to inspection (Art. 128(4)). The existence of such information is indicated on the cover page of the patent specification.

All further documents which were neither cited in the application as filed nor mentioned in the search report but have been cited during the examination procedure are to be indicated, even if they have not been used in an objection concerning novelty or inventive step. This also applies to documents which are cited to show, for instance, a technical prejudice.

2. Approval of the proposed text – grant of a patent

Rule 71(5)
Art. 97(1)

If applicants pay the fee for grant and publishing and any claims fees due under Rule 71(4) and file the translation of the claims within the specified period (and file or request no corrections or amendments to the text proposed for grant in the Rule 71(3) communication, see C-V, 4.1), they are deemed to have approved the text intended for grant.

The above also applies where the Rule 71(3) communication was based on an auxiliary request, provided that the applicant does not reply to the Rule 71(3) communication by requesting that a grant be based on a higher-ranking request. This means that, in the absence of any indication to the contrary, the above acts imply approval of the text of the auxiliary request upon which the Rule 71(3) communication was based as well as the abandonment of all higher-ranking requests.

The above also applies where the Rule 71(3) communication included proposals by the examining division for amendments or corrections of the text intended for grant (see C-V, 1.1). Consequently, provided the applicants do not reject these proposed amendments or corrections in their

reply, the completion of the above acts constitutes approval of the text containing the amendments or corrections as proposed by the examining division.

Once all the requirements set out in C-V, 1.1 to 1.4, are met, the decision to grant the European patent is issued, provided that renewal fees and any additional fees already due have been paid. *Rule 71a(1)*

If a renewal fee becomes due after notification of the Rule 71(3) communication but before the next possible date for publication of the mention of the grant of the European patent, the decision to grant is not issued and the mention of the grant is not published until the renewal fee has been paid. The applicant is informed accordingly. If the renewal fee or any additional fee is not paid in time, the application is deemed to be withdrawn (see A-X, 5.2.4). *Rule 71a(4)* *Art. 86(1)*

In the rare case that examination was accelerated to such an extent that the communication under Rule 71(3) is issued before the designation fee becomes due, the decision to grant will not be issued and the mention of the grant of the patent will not be published until the designation fee has been paid. The applicant is informed accordingly. For European patent applications filed before 1 April 2009 or international applications entering the regional phase before that date this publication will not take place until the designation fees have been paid and the designation of states for which no designation fees have been paid has been withdrawn (see also A-III, 11.1 and 11.3). *Rule 71a(3)*

The decision to grant does not take effect until the date on which the grant is mentioned in the European Patent Bulletin. *Art. 97(3)*

3. No reply in time – application deemed withdrawn

If the applicant fails to pay the fee for grant and publishing or the claims fees or to file the translation within the period under Rule 71(3), the application is deemed to be withdrawn unless, within the same period, the applicant files or requests corrections or amendments to the text proposed for grant in the Rule 71(3) communication (see C-V, 4.1). *Rule 71(7)*

If the applicant overruns the time limit set under Rule 71(3), further processing may be requested under Art. 121 (see E-VIII, 2). In such a case, the omitted act to be completed would be either: *Art. 121*

(i) all of the following acts referred to in Rule 71(3) and Rule 71(4):

(a) payment of the fee for grant and publishing,

(b) payment of any claims fees due, and

(c) filing of the translations of the claims; or

(ii) one or more of the following acts:

(a) filing amendments and/or corrections to the application documents,

(b) rejecting amendments proposed by the examining division in the communication under Rule 71(3), or

(c) requesting the grant to be based on a higher-ranking request than the auxiliary request on which the Rule 71(3) communication was based.

4. Request for amendments or corrections in reply to the Rule 71(3) communication

Rule 71(6)

If the applicant, within the period under Rule 71(3), requests amendments or corrections to the communicated text which are reasoned (with regard to the reasoning required, see C-V, 4.3), the examining division will issue a new communication under Rule 71(3) if it gives its consent (i.e. if it finds the amendments admissible and allowable; see C-V, 4.6); otherwise it will resume the examination proceedings (see C-V, 4.7). This also applies in the following cases:

– if the applicant requests the reversal of amendments proposed by the examining division in the Rule 71(3) communication (see C-V, 4.6.1);

– if the Rule 71(3) communication was based on an auxiliary request and the applicant replies by requesting that a grant be based on a higher-ranking request (see C-V, 4.6.2 and 4.7.1.1).

In this and sections C-V, 4.1 to 4.10, unless otherwise stated, the terms "amendment(s)" and "correction(s)" refer only to amendments or corrections of the application documents and not of other documents (e.g. bibliographic data, the designation of the inventor, etc.).

4.1 No payment of fees or filing of translations necessary

In the case referred to in C-V, 4, applicants will not be required to pay the fee for grant and publishing or any claims fees in reply to the first communication under Rule 71(3), nor will they be required to file any translations of the claims within this period. This applies irrespective of whether the examining division subsequently finds these amendments or corrections to be admissible and allowable and irrespective of whether the amendments or corrections are reasoned (see C-V, 4.3).

This also applies if the applicant requests the reversal of amendments proposed by the examining division in the Rule 71(3) communication (see C-V, 1.1). Furthermore, it also applies if the Rule 71(3) communication was based on an auxiliary request and the applicant replies by requesting that a grant be based on a higher-ranking request.

4.2 Crediting of fees paid voluntarily

Although the payment of fees in response to the Rule 71(3) communication is not required where applicants file amendments or corrections in their

response thereto (see C-V, 4.1), they can still pay these fees voluntarily. If they do so, the amount of the fees paid will be credited to the payment of the same fees in response to a subsequent Rule 71(3) communication (issued either directly or after resumption of examination – see C-V, 4.6 and 4.7.2 respectively).

This crediting will be dealt with according to the procedures explained in A-X, 11. This is subject to the following: if the amount of the claims fees due in response to the second Rule 71(3) communication is less than the amount voluntarily paid in response to the first Rule 71(3) communication, a refund will be made of the excess paid, since the higher claims fees were not due when paid in response to the first Rule 71(3) communication.

If, after such voluntary payment, the application is withdrawn, deemed to be withdrawn or refused, a refund of the voluntarily paid fee for grant and publishing will be possible under the conditions explained in A-X, 10.2.5. Furthermore, since the claims fees were paid when they were not due, these will also be refunded under the same conditions.

4.3 Amendments or corrections should be reasoned

The reasoning accompanying amendments or corrections filed in response to the Rule 71(3) communication should indicate respectively:

– why the applicant considers that the amended application documents comply with the EPC, in particular the requirements of patentability, Art. 123(2) and Art. 84;

– why the applicant considers that the errors and their proposed corrections are evident according to Rule 139.

If, within the period under Rule 71(3), the applicant files amendments or corrections which are **not** reasoned, no payment of the fee for grant and publishing or claims fees is necessary nor is the filing of translations (see C-V, 4.1). However, the lack of any reasoning means that such amendments or corrections are more likely to lead to a resumption of the examination procedure (see C-V, 4.7).

4.4 Admissibility of amendments

The criteria for assessing the admissibility of such amendments are dealt with in detail in H-II, 2.5 and subsections. *Rule 137(3)*

By way of exception, in cases where the Rule 71(3) communication was also the first communication in examination proceedings, amendments filed in response thereto **must** be admitted into the proceedings under Rule 137 in cases (i) to (iii) mentioned in H-II, 2.2. However, where a **further** Rule 71(3) communication is sent in respect of such cases (see C-V, 4.6 and 4.7.2), any amendments filed in response thereto must be consented to by the examining division according to Rule 137(3) (see H-II, 2.5).

4.5 Adaptation of the description

If the amendments or corrections filed by the applicant in the Rule 71(3) period concern the claims, the applicant should consider whether this

necessitates any adaptation of the description. In order to avoid potential delays in cases where adaptation is necessary, it is preferable for the applicant to provide an adapted description when filing amended claims in the Rule 71(3) period.

If no such adapted description is filed, the examining division may carry out the adaptation itself and propose these amendments to the description in the second Rule 71(3) communication (see C-V, 4.6.3). Alternatively, it may resume examination (see C-V, 4.7) and send a communication according to Art. 94(3) requesting the applicant to provide the adapted description before issuing a second Rule 71(3) communication (see C-V, 4.7.2).

4.6 Amendments/corrections admitted and allowable – second Rule 71(3) communication sent

Rule 71(6)

If the amendments and/or corrections filed within the period under Rule 71(3) are admitted under Rule 137(3) and also comply with the EPC, the examining division will send a second communication under Rule 71(3) based thereon.

4.6.1 Second Rule 71(3) communication reversing the amendments proposed by the examining division in first Rule 71(3) communication

A second communication under Rule 71(3) is also sent if the applicant requests reversal of amendments proposed by the examining division in the first communication under Rule 71(3) and the examining division overturns its previous opinion, finding that the amendments that it had proposed were not necessary, possibly as a consequence of argumentation or evidence provided by the applicant in the reply to the first Rule 71(3) communication (in the absence of such convincing argumentation or evidence, examination will normally be resumed; see C-V, 4.7).

4.6.2 Second Rule 71(3) communication based on higher-ranking request initially rejected in first Rule 71(3) communication

In cases where the first Rule 71(3) communication was based on an auxiliary request (see H-III, 3, in particular H-III, 3.1 and 3.3 and subsections), the first communication under Rule 71(3) would have been accompanied by an indication of why the higher-ranking requests were not considered to be admissible or allowable (see C-V, 1.1). If applicants reply to this first Rule 71(3) communication indicating that they wish a grant to be based on one of these higher-ranking requests which the examining division had previously held not to be allowable (see C-V, 1.1), such a request will normally lead to examination being resumed (see C-V, 4.7 and 4.7.1.1). The examining division may reverse its opinion, for example due to convincing argumentation or evidence filed by the applicants with their reply to the first Rule 71(3) communication. If the applicant is successful in this regard, the examining division will send a second communication under Rule 71(3) based on this higher-ranking request.

4.6.3 Examining division proposes amendments in second Rule 71(3) communication

As with the first communication under Rule 71(3), the examining division may propose amendments to the applicant's latest request on which the second Rule 71(3) communication is based (this request includes

amendments or corrections filed in response to the first Rule 71(3) communication). The types of amendment which may or may not be proposed by the examining division in the second Rule 71(3) communication are the same as those mentioned in C-V, 1.1. However, in the second communication under Rule 71(3), the examining division cannot re-propose amendments which were previously proposed and then rejected by the applicant. Where the examining division considers that such an amendment is necessary to overcome an objection, it should consider resuming examination (see C-V, 4.7).

4.7 Amendments not admitted and/or not allowable, examination resumed

Until the decision to grant the European patent, the examining division may resume the examination proceedings at any time. This applies *inter alia* when the applicant files non-allowable or inadmissible amendments in response to the Rule 71(3) communication.

Rule 71a(2)

4.7.1 Communications/oral proceedings after resumption

Where the grounds or evidence behind the finding of non-allowability or inadmissibility of the amendments have not yet been dealt with in examination proceedings, before issuing a summons to oral proceedings or a decision to refuse (see C-V, 4.7.3) the examining division will send a communication according to Art. 94(3) and Rule 71(1) and (2) explaining this finding.

Art. 94(3)
Rule 71(1) and (2)

If one of the following situations applies, the examining division will have to appoint oral proceedings before issuing a decision to refuse (see C-V, 4.7.3):

Art. 116(1)

(i) oral proceedings have been requested, but have not yet been held, or

(ii) oral proceedings have been held, but:

- the subject of the proceedings has changed such that a right to subsequent oral proceedings arises under Art. 116(1) (e.g. as a result of the amendments filed in response to the Rule 71(3) communication), and
- the applicant has requested subsequent oral proceedings.

If the grounds and evidence behind the finding of non-allowability or inadmissibility of the amendments have been dealt with in examination proceedings, but not yet in oral proceedings, a summons to oral proceedings can be issued directly, provided at least one communication under Art. 94(3) and Rule 71(1) and (2) has been issued.

Requests for oral proceedings must be allowed as long as proceedings before the EPO are still pending, i.e. until the decision to grant has been handed over to the internal post (see G 12/91 and T 556/95, especially reasons for the decision 4.4).

Art. 97(2)

If the following criteria are satisfied, the application may be refused directly:

(a) the grounds and evidence behind the non-allowance or non-admittance of the request filed in response to the Rule 71(3) communication have already been dealt with in examination proceedings (Art. 113(1));

(b) the applicant has received at least one communication according to Art. 94(3) and Rule 71(1) and (2) (see C-III, 4); and

(c) the applicant's right to oral proceedings on request has been respected (Art. 116(1)).

4.7.1.1 Higher-ranking request not admissible and/or not allowable

If applicants reply to the Rule 71(3) communication by requesting that a grant be based on a higher-ranking request and the examining division is not convinced by the arguments and evidence filed by the applicants with their reply, the examining division resumes examination following the procedure in C-V, 4.7.1. The examining division may also directly refuse the application providing a full reasoning under the proviso that:

– the short indication of the essential reasons given in the communication under Rule 71(3) for the non-allowability of the subject-matter of the higher-ranking requests or the non-admissibility of these requests (see C-V, 1.1 and C-V, 4.6.2) provides sufficient information about the objections raised by the examining division to enable the applicant to comment on them (such that the applicant is not taken by surprise, in particular where amendments or corrections have been filed together with the disapproval; see C-V, 4.7.1) and

– the applicant's right to oral proceedings on request has been respected (Art. 116(1)) (see also H-III, 3.3.2).

For the purposes of determining whether the reasons not to grant the higher-ranking requests given in the communication under Rule 71(3) allow the division to issue a refusal, a general indication such as "Auxiliary request 3 is not clear because an essential feature is missing" is not sufficient. Rather, a more detailed statement is needed to ensure that the applicant's right to be heard is properly respected. For example, the division may provide the applicant with an explanation such as: "Auxiliary request 3 is not inventive in view of D1 (see col. 5, lines 25-46; fig. 4) because the skilled person, wishing to avoid friction between the cable and the carpet, would make the clip recess deeper than the cable diameter".

4.7.2 Agreement reached on a text - second Rule 71(3) communication

Rule 71(6)

If the resumption of examination described in C-V, 4.7.1 results in an allowable and admissible text being filed or results in the applicant convincing the examining division that the text already filed in response to the Rule 71(3) communication is in fact admissible and allowable, a second Rule 71(3) communication is sent based on this agreed text. Such cases are dealt with in the same way as described in C-V, 4.6.

4.7.3 No agreement reached on a text - refusal

If, after resumption of examination, no agreement can be reached on a text, the application is refused (see C-V, 14). For details on conducting the resumed examination proceedings before issuing this decision, see C-V, 4.7.1.

Art. 97(2)

4.8 Fees to be paid within the second Rule 71(3) period

Where the applicants file amendments or corrections in response to the first communication under Rule 71(3), they do not have to pay either the fee for grant and publishing or the claims fees (see C-V, 4.1). A second Rule 71(3) communication may then be issued either immediately (where the amended/corrected text is allowable – see C-V, 4.6) or after examination is resumed and an allowable text is agreed on (see C-V, 4.7.2).

4.8.1 Claims fees

In order for the text on which the second Rule 71(3) communication is based to be deemed approved according to Rule 71(5), it is necessary for the applicant to pay any claims fees which are due in response to the communication, thus also avoiding deemed withdrawal of the application under Rule 71(7) (for the calculation of claims fees due at this stage, see C-V, 1.4).

Since no claims fees would normally have been paid in response to the first Rule 71(3) communication, the number of claims in the text on which this first communication was based plays no role in calculating the amount of the claims fees due in response to the second Rule 71(3) communication. However, in cases where the applicant paid the claims fees voluntarily in response to the first Rule 71(3) communication, the amount paid is credited according to Rule 71a(5) (see C-V, 4.2 and A-X, 11.2).

4.8.2 Fee for grant and publishing

In order for the text on which the second Rule 71(3) communication is based to be deemed approved according to Rule 71(5), it is necessary for the applicant to pay the fee for grant and publishing in response to the communication, thus also avoiding deemed withdrawal of the application under Rule 71(7).

For European applications filed before 1 April 2009 or international applications entering the European phase before that date, the fee for grant and publishing incorporates a fee for each page of the application over and above 35 (see C-V, 1.2 and A-III, 13.2). If the number of pages of such an application changes between the first and the second Rule 71(3) communication, it is the number of pages on which the second Rule 71(3) communication is based which is used to calculate the amount of this fee. Where the applicant paid the fee voluntarily in response to the first Rule 71(3) communication, the amount paid will be credited according to Rule 71a(5) (see C-V, 4.2 and A-X, 11.1).

Art. 2(2), No 7.2 RFees

4.9 Reply explicitly disapproving the proposed text without indicating an alternative text

If the applicant replies to the communication under Rule 71(3) by simply disapproving of the text proposed for grant, not indicating an alternative text

and not paying any fees or filing the translations of the claims, the following will apply:

(1) If the text proposed for grant was based on the main request submitted by the applicant (without any amendments or corrections proposed by the examining division), the application will be refused, provided that at least one communication in examination proceedings has been sent (see C-III, 4 and E-IX, 4.1), and the applicant's right to oral proceedings is respected (Art. 116(1)). The basis for the refusal in this case is the lack of an application text agreed to by the applicant (Art. 113(2)).

(2) If amendments or corrections were proposed by the division in the Rule 71(3) communication, the applicant's disapproval is interpreted as a rejection of the proposal and the procedure continues as described in C-V, 4.6.1.

(3) If the communication under Rule 71(3) was based on an auxiliary request, the applicant's disapproval is interpreted as a request to base the grant on a higher-ranking request. The procedure continues as described in C-V, 4.6.2 and 4.7.1.1. If it is not clear which higher-ranking request the applicant wishes to pursue, the examining division must request that the applicant clarify this in resumed examination proceedings.

If the applicant first files only the disapproval of the text and then (still within the Rule 71(3) period) files a request for amendment or correction, this is interpreted as a desire to proceed with the application as amended or corrected. The procedure in C-V, 4 applies.

4.10 Amendments/corrections filed in second Rule 71(3) period

In cases where a second Rule 71(3) communication is sent (see C-V, 4.6 and 4.7.2) and the applicant replies within this second Rule 71(3) period by doing one or more of the following, the procedures explained in C-V, 4.1 to 4.9 apply *mutatis mutandis*:

(i) filing further amendments or corrections,

(ii) rejecting amendments proposed by the examining division in the second Rule 71(3) communication, or

(iii) reverting to a higher-ranking request (where the second Rule 71(3) communication is based on an auxiliary request).

In particular, in such cases the applicant will be required neither to pay the fee for grant and publishing or any claims fees, nor to file translations of the claims within this second period under Rule 71(3). If the examining division agrees to a text (either with or without resumption of examination), a third communication under Rule 71(3) is then sent.

Furthermore, if the applicant replies to the second Rule 71(3) communication by rejecting amendments proposed by the examining

division in the first Rule 71(3) communication (where these have not been superseded), the procedures described in C-V, 4.1 to 4.9 likewise apply *mutatis mutandis* (no need to pay fees or file translations, etc.).

In respect of repeated requests for amendments in response to the second or subsequent Rule 71(3) communication, the division may exercise its discretion under Rule 137(3) not to admit such amendments (H-II, 2.5.1). If the division intends not to admit the amendments, it will resume the examination proceedings, e.g. by summoning the applicant to oral proceedings.

5. Further requests for amendment after approval

The criteria for assessing the admissibility of such amendments are dealt with in detail in H-II, 2.6. The procedure for dealing with such late-filed amendments is explained in C-V, 6. *Rule 137(3)*

6. The examining division resumes examination after approval of the text

6.1 When does the examining division resume examination after approval?

Subsequent to the applicant's approval in response to the Rule 71(3) communication (see C-V, 2), the examining division may resume the examination procedure at any time up to the moment the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant (see G 12/91). This will seldom occur, but may be necessary if e.g. the applicant files further prior art which necessitates further substantive examination, if the examining division becomes aware of very relevant prior art following observations by third parties under Art. 115, if the applicant files amendments or corrections (having already approved the text), or if the examining division becomes aware in some other way of circumstances which are such as to cause the subject-matter claimed to fail to comply with the EPC. *Rule 71a(2)*

The resumption of examination after approval is subject to the same considerations as where examination is resumed due to amendments filed in the Rule 71(3) period (see C-V, 4.7.1). The next action issued after resumption of the examination procedure must however indicate the fact that the proceedings have been resumed as well as the substantive reasons that led to the resumption of examination. In particular, the applicant's right to comment (Art. 113(1)), the right to at least one communication under Art. 94(3) and Rule 71(1) and (2) in examination proceedings (see C-III, 4) and the right to oral proceedings on request (Art. 116(1)) must be respected.

The criteria applied in assessing the admissibility of amendments or corrections filed by the applicant after approval are dealt with in H-II, 2.6. *Rule 137(3)*

6.2 A further communication under Rule 71(3)

A second Rule 71(3) communication is sent out if the resumed examination results in a text on the basis of which a patent can be granted (substantive *Rule 71(6)*

amendments directed to resolving the issues which gave rise to the resumption of examination are possible).

If the translations of the claims have already been filed (see C-V, 1.3) and the fees have already been paid (see C-V, 1.2 and 1.4) in reply to a previous communication under Rule 71(3), e.g. in the case of resumption of examination after approval (see C-V, 6 and Rule 71(6)), the applicant must express agreement as to the text to be granted (Rule 71a(1)) within the non-extendable four-month period mentioned in the further Rule 71(3) communication (e.g. by approving the text and verifying the bibliographic data, by confirming that grant proceedings can continue based on the documents on file and/or by stating which translations of the claims already on file are to be used). This also applies if a further Rule 71(3) communication was sent.

6.3 Crediting of fees under Rule 71a(5)

Rule 71a(5)

If, in response to an invitation under Rule 71(3), the applicant has already paid the fee for grant and publishing or the claims fees, the amount paid shall be credited if a further such invitation is issued. For more details on this procedure, see A-X, 11.

7. Correction of errors in the decision to grant

Under certain circumstances, a decision to grant a European patent may be corrected. For more details see H-VI, 3.

8. Further processing

If the applicant overruns the time limit set under Rule 71(3), further processing may be requested under Art. 121 (see E-VIII, 2). The procedure to follow is explained in C-V, 3.

9. Refund of the fee for grant and publishing

Rule 71a(6)

If the application is refused, withdrawn prior to notification of the decision on the grant of a European patent or, at that time, deemed to be withdrawn, the fee for grant and publishing will be refunded (for more details see A-X, 10.2.5).

10. Publication of the patent specification

The decision to grant contains the date of the mention of the grant of the European patent and is sent to the applicant when the technical preparations for printing the patent specification have been completed.

Art. 98
Rule 73
Art. 14(6)

As soon as possible after the mention of the grant is published in the Bulletin, the EPO publishes the patent specification containing the description, claims (in the three official languages) and any drawings. The front page of the published specification shows *inter alia* the contracting states which are still designated at the time of grant (or the designation of which has been withdrawn after completion of the technical preparations for printing). With regard to the form in which the publication takes place, see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.3.

Mistakes in the specification of a European patent arising in the course of its production have no effect on the content of the patent granted. For this, only the text on which the decision to grant the patent is based is decisive (see H-VI, 4). If necessary, the Office may arrange for correction to be made public as soon as any mistake in a specification is discovered. This is done by means of a note in the European Patent Bulletin and publication of a corrigendum, the sole purpose being to bring the specification into line with the content of the decision to grant (see Rule 143(2) and the Decision of the President of the EPO dated 14 October 2009, OJ EPO 2009, 598, Art. 1, point 2).

11. Withdrawal before publication of the patent specification

Rule 73

The specification of the European patent is not published if the application is withdrawn before termination of the technical preparations for publication. If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed. The EPO will, however, try (in accordance with the principles of J 5/81) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily. The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80). The applicant is bound by an effective declaration of withdrawal (see J 25/03, J 4/97 and J 10/87) (see also E-VIII, 8).

12. Certificate

Rule 74

As soon as the European patent specification has been published, the EPO issues the proprietor with a certificate attesting that the European patent has been granted to the person named in the certificate. Where there is more than one proprietor, each of them is issued with a certificate. Proprietors may request that a certified copy of the certificate with the specification attached be supplied to them upon payment of an administrative fee. For further details see the Decision of the President of the EPO dated 16 July 2013, OJ EPO 2013, 416.

13. European Patent Bulletin

Art. 129(a)

If no notice of opposition is recorded in the dossier of the European patent within nine months of publication of the mention of grant, the patent proprietor is informed and an appropriate entry is published in the European Patent Bulletin (point 1, Art. 1, Decision of the President of the EPO dated 14 October 2009, OJ EPO 2009, 598). If, subsequently, it emerges that an opposition was filed in time, the proprietor is again informed and a correction is published in the Bulletin.

14. Refusal

A decision to refuse the application cannot be issued without a first communication in examination having been sent (see C-III, 4 and E-IX, 4.1) or oral proceedings having been held (see C-III, 5). Therefore the examining division may not refuse the application directly after the reply to the search opinion under Rule 70a(1) or directly after the reply to the WO-ISA under Rule 161(1), even if the objections raised in the search opinion or WO-ISA remain the same and there is no pending request for oral proceedings.

Art. 97(2)
Art. 113(1)
Rule 111
Art. 109
Art. 111(1) and
Art. 111(2)

If, despite the applicant's submissions, i.e. amendments or counter-arguments, objections persist after the applicant's reply to the first communication under Art. 94(3) in examination, then a refusal can be issued. If there is a pending request for oral proceedings, oral proceedings must be held and the decision to refuse will, where appropriate, be announced at the end of the oral proceedings. Similarly, if summons were issued as the first action in examination, the decision to refuse will, where appropriate, be announced at the end of the oral proceedings.

In the event that refusal is contemplated, the examiner should bring the application before the other members of the examining division, which may then decide to refuse the application. In any event, at some stage, the primary examiner will consult the other members of the examining division with a view to establishing whether the application should be refused or a patent should be granted. If the division intends to refuse the application, a written reasoned decision is necessary and this will normally be prepared by the primary examiner (see E-X, 2.3 and E-X, 2.6). In preparing the decision, the examiner must take care to abide by the general principles set out in Art. 113(1), i.e. the decision must be based on grounds or evidence on which the applicant has had the opportunity to comment (see E-X, 1.1 and E-X, 1.2).

In addition, the applicant's attention must be directed to the provisions for appeal laid down in Art. 106 to Art. 108. If oral proceedings take place (see E-III), the decision may be given orally but must subsequently be notified in writing, the time limit for appeal then running from the date of such notification.

Art. 109

If the applicant appeals against the decision and the examining division considers, in the light of the applicant's statement, that the appeal is admissible and well-founded, it should rectify its decision accordingly within three months after receipt of the statement of grounds. Otherwise, the appeal will be considered by a board of appeal. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the examining division for further examination. In such a case, the further examination will normally be entrusted to the examiner who performed the original examination. The examining division is bound by the *ratio decidendi* of the board of appeal, in so far as the facts are the same.

15. Decision according to the state of the file

A special case is where the applicant does not file comments or amendments in reply to the examiner's communication but requests a decision "according to the state of the file" or "on the file as it stands", meaning that the applicant wishes to close the debate and a decision is taken on the basis of the current status of the application and any supporting arguments. The decision, which may be appealed, may only be based on grounds and evidence on which the applicant has had an opportunity to present comments (Art. 113(1)).

15.1 The request for a decision according to the state of the file

An applicant may file a request for a decision according to the state of the file at any stage during examination proceedings, provided that at least one

communication in examination has been sent (see also C-V, 15.4). The request should be explicit and unambiguous, preferably using the wording "according to the state of the file" or "on the file as it stands".

If the request is not clear in this respect, the examiner should solve the ambiguity with an enquiry to the applicant.

If, at the time the applicant files a request for a decision according to the state of the file, a request for oral proceedings is pending, the examining division will interpret the request for a decision according to the state of the file as equivalent to an implicit withdrawal of the pending request for oral proceedings by the applicant.

15.2 Decision by means of a standard form

In such cases, the examiner may be in a position to refuse the application using a standard form referring to the previous communication. In order to comply with the requirement that such a decision be reasoned (Rule 111(2)), this is only possible where the previous communication properly identifies the application documents on file, is well-reasoned and complete with respect to the grounds and the reasons for the refusal of the current request and addresses all the arguments raised by the applicant. A further condition is that no new arguments or amendments have been submitted by the applicant since the previous communication. If, in its reply to the last communication from the examining division, the applicant has submitted new arguments which are at least potentially refutative, these arguments cannot be ignored even if, in the same reply, the applicant has explicitly requested a decision according to the state of the file. In this case, the division must consider these freshly presented arguments either by issuing a regular reasoned decision (see C-V, 15.3) or by issuing a further communication (see C-V, 15.4).

Minutes of a consultation do not meet the standards of an Art. 94(3) communication. A decision according to the state of the file by means of a standard form cannot therefore be based on such minutes unless they contain a full exposition of all the legal and factual reasons for refusing the application and set a time limit for reply, as in the case of minutes of a consultation as the first communication in examination (see C-VII, 2.5).

Examining divisions are not to refer either to the minutes of oral proceedings in decisions by means of a standard form.

Although it is possible by way of exception to refer to more than one communication in the standard form, the examiner should carefully consider the requirements of Rule 111(2). In particular, if the different communications deal with different sets of claims, such that it is not clear which of the reasons given by the examining division in its communications might be essential to the decision to refuse, a fully reasoned decision should be issued instead (see C-V, 15.3).

15.3 Issuing a self-contained decision

If the conditions set out in C-V, 15.2 are not met, it is necessary to issue a self-contained decision to refuse in order to comply with Rule 111(2). This

is necessary, for example, where the numerous objections raised in the previous communications with respect to different sets of claims render unclear the grounds and the reasons for the refusal. This also applies if the applicant has made further submissions (including amendments) since the previous communication, where these do not cause the subsequent decision to be based on grounds or evidence on which the applicant has not had the opportunity to present comments. In all cases, the requirements of Art. 113(1) should be carefully considered (see also E-X, 1).

15.4 Issuing a further communication (no refusal)

If it appears that the previous communications were insufficiently reasoned or incomplete, or if the applicant has filed amendments and/or arguments since the previous communication, the examiner should carefully consider Art. 113(1) and Rule 111(2) before issuing a refusal (see E-X, 1). A further communication may have to be issued with sufficient reasoning, unless oral proceedings are to be held (see E-III, 2), in which case the reasoning would be given in the summons (Rule 116(1)). In the communication or summons the applicant should be informed that the request for a decision according to the state of the file could not be followed.

Annex
Standard marks for indicating amendments or corrections by the divisions

1. Insertion of letters and words

Any insertion to the text made using the electronic tool is made in-line. No marks need to be put separately in the margins, top or bottom of the page.

In the produced PDF of the "working copy" of the "Druckexemplar", the tool will insert amendment bars to the right of amendments and indicate amended pages as such. The tool also adds a pair of insertion signs that mark the beginning and end of each in-line insertion:

Mark	Explanation
	Denotes the beginning of text inserted
	Denotes the end of text inserted

"No break", "line break" or "paragraph break" signs precede and succeed the signs above to indicate whether the inserted text should be kept in the same line or a new line or a paragraph should start before or after the inserted text:

Mark	Explanation
	No breaks: inserted text is kept on the same line (this is the default)
	Line break: starts a new line (must be set if needed)
¶	Paragraph break: starts a new paragraph (must be set if needed)

In case of inserting an entire newly-filed page, e.g. a page numbered "1a", the construct [insert page 1a] is used.

Chapter VI – Time limits and acceleration of examination

1. Time limits for response to communications from the examiner

1.1 General considerations

The general considerations relating to time limits are set out in E-VIII. The time limit for response to a communication from the examiner should in general be between two and four months in accordance with Rule 132. The period to be allowed will be determined by the examiner taking all the factors relevant to the particular application into account. These include the language normally used by the applicants or their representative; the number and nature of the objections raised; the length and technical complexity of the application; the proximity of the EPO to the applicants or, if they have one, their representative; and the distance separating applicants and representatives.

If the only outstanding objection is the need to amend the description, the examiner may invite the applicant to amend the description by issuing a communication under Art. 94(3) with a two-month time limit to reply. Alternatively, the examiner may consult the applicant informally, e.g. by telephone, explain the objection and set a one-month time limit documented in the minutes of the consultation referring to this objection (unless a shorter limit is agreed during the consultation).

Art. 94(1) and (4)
Rule 132

This time limit can be extended if the applicant so requests before it expires (see E-VIII, 1.6). Failure to respond to a communication according to Art. 94(3) and Rule 71(1) and (2) in time results in the application being deemed to be withdrawn. This loss of rights is subject to further processing (see E-VIII, 2).

1.2 Special circumstances

In certain special circumstances the examiner may allow up to six months for the time limit. The six-month period may be appropriate, for instance, if the applicant resides a long way from the representative and the language of the proceedings is not one to which the applicant is accustomed; or if the subject-matter of the application or the objections raised are exceptionally complicated (for more information see E-VIII, 1.2).

The search opinion is not a communication under Art. 94(3).

2. Influencing the speed of examination proceedings – PACE

With a request for accelerated examination under the programme for accelerated prosecution of European patent applications (PACE), the applicant can speed up the proceedings at the examination stage (see Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93). For further information, see E-VIII, 4.2.

3. Further ways to accelerate examination

Rule 70(2)
Art. 11(b) RFees
Rule 62(1)

Where applicants file a request for examination before the search report is transmitted to them, they may also dispense with the need to comply with the invitation pursuant to Rule 70(2), and file a categorical request for examination whatever the result of the search may be, by which the procedure can also be accelerated (see the Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93). In this case, confirmation that they desire to proceed further with their application is deemed to be given when the search report is transmitted to them, so that in accordance with Rule 62(1) the search report is not accompanied by a search opinion. Under these circumstances, if the application is not in order for grant, a communication under Art. 94(3), and Rule 71(1) and Rule 71(2) is transmitted to the applicant. Own-volition amendments under Rule 137(2) may in that case be submitted by the applicant in reply to this communication (see C-III, 2).

If the application is in order for grant, the subsequent procedure will depend on whether or not it is possible at that time to carry out the search for conflicting European applications according to Art. 54(3) (see C-IV, 7.1 and B-XI, 7). If that search can be carried out and assuming that it does not identify any conflicting applications, then the communication under Rule 71(3) is transmitted to the applicant. If it cannot yet be carried out, then the communication from the examining division will be postponed until the said search is completed. If the European patent application is subsequently withdrawn before the substantive examination has begun, the examination fee will be refunded in full. If substantive examination has already begun, withdrawal of the application may still result in a refund of 50% of the examination fee in the cases laid down in Art. 11(b) RFees (for more details see A-VI, 2.5 and OJ EPO 2016, A49).

The applicant can also accelerate the processing of Euro-PCT applications by waiving the right to the communication under Rule 161 and Rule 162 (see E-IX, 3.1) or by filing an explicit request for early processing of an international application by the EPO as designated/elected Office (see E-IX, 2.8).

Chapter VII – Other procedures in examination

1. General remark

In this Chapter the term "applicant" is intended to mean "representative" where the applicant has appointed one. In this case, the procedures described in this Chapter should be conducted with that representative.

2. Consultations

2.1 General

There are instances where personal consultation with the applicant can be helpful in advancing the procedure. Such consultation will preferably be held by videoconference, thereby allowing, where necessary, the presentation of documents, the participation of other persons and the verification of the identity of the person(s) attending (see C-VII, 2.2). However, consultations can also be held by telephone at the request of the applicant, if the situation so requires.

The consultation may take place at the initiative of either the applicant or the examiner or formalities officer. However, the decision on whether it is to be held is at the discretion of the formalities officer or examiner. A consultation request from the applicant should usually be granted unless the nature of the issue to be discussed requires formal proceedings or the examiner believes that no useful purpose would be served by such a discussion. For example, where substantial differences of opinion exist in examination, written procedure or oral proceedings are normally more appropriate.

Typical situations in which applicants may want a consultation are:

(i) to enquire about a procedural issue such as how to proceed in particular circumstances (note however that the examiner is not normally in charge of formal issues such as extensions of time limits and payment of fees); for enquiries as to the processing of files, see E-VIII, 7;

(ii) where there appears to be an error in the communication or in the applicant's reply which makes it difficult for the applicant or the examiner to prepare the next reply/communication (e.g. wrong document cited, communication based on wrong set of claims, new submissions referred to but not included).

Typical situations in which examiners may consider it appropriate to consult the applicant are:

(iii) where it appears that there is confusion about certain points in dispute, e.g. the applicant seems to have misunderstood the arguments of the examiner or vice versa, so that the written procedure does not lead anywhere;

(iv) where the application seems to be ready for grant except that the examiner needs to clarify some minor issues with the applicant or would like to discuss a proposal for amendments to overcome the objections raised;

(v) where amendments or corrections requested by the applicant after the Rule 71(3) communication have been submitted but the examiner cannot agree to the request.

With regard to consultations in response to the EESR before the application has entered the examination phase, see B-XI, 8.

Telephone conversations held for the sole purpose of arranging a date for a consultation or oral proceedings do not in and of themselves constitute a consultation within the meaning of this section. Therefore, no minutes need to be prepared (C-VII, 2.4) unless so required where the applicant agrees to a notice period of less than two months before oral proceedings (E-III, 6).

2.2 Persons participating in the consultation

The consulted person must be a person entitled to act for the applicant before the EPO. If the applicant is a natural or legal person having either residence or place of business in a contracting state, consultations may only be conducted with:

(a) the applicant (see A-VIII, 1.1),

(b) a professional representative (see A-VIII, 1.1) or

(c) a duly authorised employee of the applicant (see A-VIII, 1.2) or, to the extent defined in Art. 134(8), a legal practitioner (see A-VIII, 1.4).

Regarding (c), see also A-VIII, 1.5.

If the applicant is a natural or legal person having neither residence nor place of business in a contracting state, consultations may only be conducted with:

– a professional representative (see A-VIII, 1.1) or

– a legal practitioner (see A-VIII, 1.4 and A-VIII, 1.5).

The person entitled to act before the EPO, i.e. one of the persons listed above, may be accompanied by other persons, such as the inventor, a non-European representative or an employee of the applicant. On request of the person entitled to act, such other persons may be allowed to take part in the consultation if their participation is relevant to the proceedings. Where the consultation is held as a videoconference, these persons may connect from a different location than the person entitled to act before the EPO.

If there is any doubt as to the identity of any of the persons participating in the consultation or if the consulted person so requests, the examiner or

formalities officer will check the identity of the person or persons concerned. This can be done by inviting them to show an official identity document to the camera in the case of a videoconference or to send a copy of the document by email. For data protection reasons, the copy of the identity document sent by email will not be included in the file (see also E-III, 8.3.1).

From the examining division, only the examiner dealing with the case will normally be present. However, there is no objection to one or even both of the other members of the examining division participating in the consultation.

When the inventor or an expert is attending the consultation, it is recommended that at least the chair of the examining division should also attend. However, the applicant or representative does not have the right to demand that additional members of the examining division be present. If a request is made for a consultation with all three members, it will usually be advisable to appoint oral proceedings instead.

2.3 Informal nature of consultations

A consultation is not a formal procedure (for formal oral proceedings before the examining division, see E-III), and the character of the minutes of the consultation depends upon the nature of the matters under discussion. It should always be made clear to the applicant that any agreement reached must ultimately be subject to the views of the other members of the examining division. A decision cannot be taken during a consultation.

Oral statements made during a consultation must be confirmed in writing in order to be procedurally effective. Indeed, such statements are not normally legally binding. Such a statement cannot, for instance, be effective to meet a time limit (see, however, C-VII, 2.4). For the purpose of the European grant procedure, except in oral proceedings, only written statements are effective and only from the date on which they are received by the Office. Oral statements substantively addressing the objections raised in an earlier communication may however lead the examiner to cancel any running time limit (see C-VII, 2.4 (iv)). Furthermore, documents, validly submitted by email during the consultation (see C-VII, 3) may indeed be effective to meet a running time limit (see C-IV, 3).

If a fresh objection of substance is raised during a consultation and no amendment to meet it is agreed at the time, the objection must be confirmed by a communication of the minutes thereof, giving the applicant a fresh period within which to reply (see C-VII, 2.4(iii)).

2.4 Minutes of a consultation

The minutes of a consultation should list the participants, summarise the main results and state any oral requests. They must be signed by the examiner. Documents filed by email during a consultation (see C-VII, 3), such as new claims or an amended description, must be attached to the minutes.

The minutes should always indicate whether the next action is due to come from the applicant or the examiner. In this regard, the minutes when despatched to the applicant may:

(i) be issued for information only, in which case if a time limit is still pending, it should be observed; if no time limit is pending, no action is required from the applicant;

(ii) be issued such as to extend a pending time limit, in which case the applicant must reply within that extended time limit, or

(iii) be issued such as to set a new time limit for response, in which case the applicant must reply within this new time limit;

(iv) be issued such as to cancel a pending time limit;

(v) be issued such as to reflect the decision to cancel scheduled oral proceedings. This may be the case, for instance, when an agreement on an allowable set of claims can be reached during the consultation. Cancellation of the oral proceedings is communicated to the applicant orally during the consultation and noted in the minutes. No separate communication regarding the cancellation of the oral proceedings is issued.

Where the consultation is concerned with the clarification of obscurities, the resolution of uncertainties, or putting the application in order by clearing up a number of minor points, it will usually be sufficient if the examiner makes a note in the minutes of the matters discussed and the conclusions reached or amendments agreed unless a time limit is set for reply (see below).

With regard to the discussion of weightier matters, such as questions of novelty, inventive step, unity or whether the amendment introduces added subject-matter, a fuller note of the matters discussed is made in the minutes. In particular, the minutes will specify in concrete terms the topics discussed, together with any amendments agreed, any opposing views, the reasons for any change of opinion and any conclusions drawn unless these are clear from other documents in the dossier. In particular, the reasons for any amendments required by the examiner should be clearly indicated.

The use of indefinite, ambiguous or universally applicable statements in minutes should be avoided. For example, statements such as "Amendments to the claims were proposed to take account of the prior art cited in the search report" are of no assistance to members of the public, other members of the division, or indeed the primary examiner at later stages of the procedure. The same applies to conclusions worded in a generalised manner.

If the minutes are sent as a first communication in examination, see C-VII, 2.5.

The minutes are placed in the dossier, made available for file inspection (including all documents filed by an applicant or representative during the

consultation) and sent to the applicants or their representative, even where the consultation merely changes/confirms/cancels the time/date of a proposed consultation.

However, by way of exception, consultations relating to amendments agreed immediately preceding completion of the communication according to Rule 71(3) may be reflected in that communication, provided that there is no uncertainty for the public as to what was agreed. The amendments must be identified as exactly as possible.

2.5 Minutes as the first communication in examination

A consultation may be used as the first action in examination provided that:

– minutes are issued;

– the minutes present the matters discussed with the same level of information and structure as an Art. 94(3) communication;

– the minutes are issued with a time limit for reply not shorter than four months unless agreed otherwise with the applicant.

Matters (e.g. objections or reasoning) not discussed during the conversation itself may be included in such minutes. However, it must be clear in the minutes that they were not discussed during the consultation.

If the above criteria are met, minutes issued as the first action in examination replace the first communication under Art. 94(3) and Rule 71(1), (2) (see C-III, 4).

Furthermore, examiners may inform the representative in a call if the examining division is considering issuing summons to oral proceedings as the first action in examination (see C-III, 5). Instead of issuing separate minutes, a remark regarding the call may be included in the summons. If, however, the examining division decides not to issue summons at that stage, minutes must be issued.

3. Use of email

At present, email is an admissible filing means only for the submission of subsequently filed documents as referred to in Rule 50 EPC during consultations and during oral proceedings held by videoconference (for details, in particular on signature and format of attachments, see the Decision of the President of the EPO dated 13 May 2020, OJ EPO 2020, A71 and E-III, 8.5.2).

Other than in the above-mentioned cases, email has no legal effect in proceedings under the EPC and thus cannot be used to validly perform any procedural act and, in particular, cannot be used to comply with time limits (see OJ EPO 2000, 458 and A-VIII, 2.5). If, for instance, shortly before oral proceedings, the applicant would like to submit new requests and/or amended documents, this should be done by electronic filing or fax. Experience shows that documents submitted via electronic filing are normally visible in the electronic file on the same day.

Examples of cases where exchanges by email may be useful are:

(i) arranging a date for a consultation

(ii) if during a consultation possible amendments to claims are being discussed the applicant might want to communicate these immediately without submitting them formally

(iii) shortly before oral proceedings: sending an electronic copy of amended claims in addition to the official submission made e.g. by fax; this would ensure that the examining division gets the documents well in time for preparation of the oral proceedings.

Emails cannot replace an official communication under Art. 94(3).

3.1 Initiation of exchanges by email

Except in cases where it is a valid filing means (see C-VII, 3 and E-III, 8.5.2), neither the examiner nor the applicant should use email without having previously agreed to this, e.g. during a consultation. There must be mutual agreement between the examiner and the applicant to such use if the content of the email goes beyond the mere arranging of a date for a consultation or oral proceedings. Furthermore, the mere fact that an email address is indicated on a letter head does not mean that the examiner can simply use such an email address for file-related topics.

If, on the other hand, an examiner receives an email from an applicant concerning procedural requests or addressing any substantive issues without previous agreement, such an email cannot simply be ignored but must be dealt with, ensuring that the content is put in the official file (see also T 599/06); it is recommended that such an email be replied to with the clear message that email is not an official means of communication and that any requests should be filed by permitted means (see A-II, 1.1, A-II, 1.2 and A-II, 1.3).

3.2 Confidentiality

For non-published applications, confidentiality issues should be carefully considered and substantive matters should not form part of any email correspondence concerning such applications.

3.3 Inclusion in the file of any email exchange

If email is used, it is essential to ensure that the exchange of emails is properly documented in the file. This should be done by sending the result of the consultation to the applicant for information with no time limit. This ensures that the exchange is included in the public part of the file and that the applicant is aware of this.

Submissions filed by email during a consultation or during oral proceedings held as a videoconference, including all attachments, should be annexed to the minutes (see E-III, 8.5.2 for details).

4. Taking of evidence

4.1 General remark

The general considerations relating to the taking of evidence are set out in E-IV. This section deals only with the kind of evidence most likely to arise in pre-grant proceedings, viz. written evidence.

4.2 Producing evidence

An examining division would not, as a general rule, require evidence to be produced. The primary function of the examiner in proceedings before grant is to point out to the applicant any ways in which the application does not meet the requirements of the EPC. If the applicant does not accept the view of the examiner, then it is for the applicants to decide whether they wish wishes to produce evidence in support of their case and, if so, what form that evidence should take. The examining division should afford the applicant a reasonable opportunity of producing any evidence which is likely to be relevant.

However, this opportunity should not be given where the examining division is convinced that no useful purpose would be served by it, or that undue delay would result.

4.3 Written evidence

Written evidence could include the supply of information, or the production of a document or of a sworn statement. To take some examples:

To rebut an allegation by the examiner of lack of inventive step, applicants might supply information as to the technical advantages of the invention. Again, they might produce a sworn statement, either from themselves or from an independent witness, purporting to show that workers in the art have been trying for a long time unsuccessfully to solve the problem with which the invention is concerned, or that the invention is a completely new departure in the relevant art.

5. Oral proceedings

If a request for oral proceedings, even conditional, was filed before the examining division became responsible for the application (see C-II, 1), the division must honour the request, even if it was not repeated in examination.

On dealing with new requests filed in reply to a summons to oral proceedings, see C-IV, 8.

As a rule, oral proceedings in examination proceedings are held by videoconference unless the direct taking of evidence is required or if there are other serious reasons for not doing so, e.g. where an impediment prevents an applicant or representative from participating in oral proceedings held by videoconference. Sweeping objections against the reliability of videoconferencing technology or the non-availability of videoconferencing equipment will, as a rule, not qualify as serious reasons in this regard. Equally, the need to consider written evidence will not qualify as a serious reason (see E-III, 2.2, OJ EPO 2020, A134 and A40).

The general considerations relating to oral proceedings are set out in E-III.

6. Examination of observations by third parties

The general considerations relating to observations from third parties are set out in E-VI, 3.

Chapter VIII – Work within the examining division

1. General remarks

An examining division will normally consist of three technical examiners. However, within the examining division made responsible for the application, one member (the primary examiner) will, as a general rule, be entrusted to carry out all the work up to the point of a decision to grant a patent or refuse the application. This means that this examiner is entrusted to act on behalf of the examining division in all communications with the applicant up to that point, but the primary examiner may confer informally with the other members of the division at any time if a special point of doubt or difficulty arises. Where reference is made in this Part C of the Guidelines to the "examiner", this normally means the primary examiner, and it should be understood that this primary examiner is always acting in the name of the examining division. This examiner is normally the examiner who drafted the search report.

Art. 18(2)

As stated above, the examiner may seek the advice of other members of the examining division, if necessary, at any stage in the examination. However, a point will be reached when it becomes appropriate for the examiner to refer the case formally to the other members of the examining division. This will arise if the examiner considers the case is in order to proceed to grant or, alternatively, where there seems no possibility of amendment which would overcome his or her objections or where the applicant has not overcome these objections, and the examiner considers the case is in order to proceed to refusal. There are also other circumstances in which reference to the examining division is appropriate, e.g. oral proceedings may be suggested by the examiner or requested by the applicant because an impasse has been reached. In considering whether to refer the application to the division, the examiner should be guided by the principle stated in C-IV, 3.

Primary examiners should also bear in mind that when they issue a communication they do so in the name of the division, and applicants are entitled to assume that if the examiner had doubts as to the views of the rest of the division he or she would have discussed the matter with them beforehand.

As soon as the application has passed to the examining division under Rule 10, that division will have ultimate responsibility, but formal matters will normally be dealt with by a formalities officer (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6; OJ EPO 2015, A104). Examiners should not spend time checking the work done by the Receiving Section or the formalities officer, but if they believe a formalities report is incorrect or incomplete they should refer the application to the formalities officer for further consideration.

If the specific circumstances (e.g. sickness) so require, an application may be reallocated to another examiner/examining division. The director is responsible for deciding whether the dossier is to be fully reallocated to a

new examining division or whether a single member of the division is to be replaced.

2. Recommendation to grant

If examiners considers that the application satisfies the requirements of the EPC and is thus in order to proceed to grant, they should make a brief written report (the "votum"). As a general rule, it will be appropriate in this report for the examiner to give the reasons why, in their opinion, the subject-matter as claimed in the application is not obvious having regard to the state of the art. They should normally comment on the document reflecting the nearest prior art and the features of the claimed invention which make it patentable, although there may be exceptional circumstances where this is not necessary, e.g. where patentability is based on a surprising effect. They should also indicate how any apparently obscure but important points have ultimately been clarified, and if there are any borderline questions which the examiner has resolved in favour of the applicant, they should draw attention specifically to these.

3. Recommendation to refuse

When referring to the examining division an application which is not in order for grant of a patent, the examiner should confer with the other members of the division, bringing to their attention the points at issue, summarising the case history to the extent necessary to enable the other members to obtain a quick grasp of the essential facts, and recommending the action to be taken, e.g. refusal, or grant conditional upon certain further amendments. As the other members will need to study the case themselves, there is no need for a detailed exposition. It will be useful, however, to draw attention to any unusual features or to points not readily apparent from the documents themselves. If the examiner recommends refusal and the issue seems clear-cut, he or she may already provide a draft reasoned decision for issue by the examining division (see C-V, 14); if the issue is not clear-cut, the drafting of the reasoned decision should be deferred until the division has discussed the case.

4. Tasks of the other members of the examining division

Art. 18(2)

When an application is referred to the other members of the division, they will first consider the case individually and each will indicate his or her opinion on the course of action to be taken. If there is complete agreement with the recommendation of the primary examiner, no further consultation of the division will be necessary. When further action is needed, the primary examiner will be entrusted with the work. If, however, there is not complete agreement immediately with the primary examiner, or at least one member of the division wishes to discuss the case further, further consultation of the division will be arranged. In such discussions, the division should try to reach a unanimous opinion, but where this seems unlikely, the difference of opinion must be resolved by voting. When the division is enlarged to four members (see C-VIII, 7), the chair has a casting vote should this be necessary.

The other members of the examining division should bear in mind that their function generally is not to perform a complete re-examination of the application. If, following a discussion, the conclusions of the examiner

entrusted with the examination are generally considered to be reasonable, the other members should accept them.

5. Further communication with the applicant

If, in the opinion of the examining division, the possibility exists of amending the application to bring it into a form which meets the requirements of the EPC, then the primary examiner should be entrusted with the task of informing the applicant that the examining division is of the opinion that the application should be refused on certain grounds unless satisfactory amendments are submitted within a stated period (see C-VI, 1). If, within the time limit, satisfactory amendments are made, the examiner will then report back to the examining division recommending that the application should proceed to grant. If not, he or she should report back recommending refusal.

6. Decision

Any decision is issued by the examining division as a whole and not by an individual examiner. All members, therefore, sign the written decision irrespective of whether or not it was a unanimous one. If, exceptionally, one or more division members cannot sign the decision, one of the other members, normally the chair, may sign it on their behalf, subject to the conditions defined in E-X, 2.3. A seal may replace the signature. *Rule 113*

7. Enlargement of the examining division; consultation of a legally qualified examiner

If the examining division considers that the nature of the decision so requires, it is enlarged by the addition of a legally qualified examiner. The decision to enlarge or to set aside an enlargement lies within the discretion of the examining division. *Art. 18(2)*

The participation of a legally qualified examiner or at least internal consultation of Directorate Patent Law, the department responsible for providing legally qualified members for examining and opposition divisions, will be required if a difficult legal question arises which has not yet been solved by the Guidelines or by jurisprudence.

The applicant is informed of the enlargement in the communication, the annex to the summons or the decision following enlargement, as appropriate. Once the examining division has been enlarged, communications or decisions must be signed by all four members of the examining division.

If the examining division has been enlarged by the addition of a legally qualified examiner, it consists of four members. In this case, in the event of parity of votes, the vote of the chair will be decisive. As a rule, this enlargement of the examining division will be required in cases where evidence has to be taken according to Rule 117 (including the giving of evidence by witnesses – see E-IV). The addition of a legally qualified examiner is to be considered also in the case of oral proceedings. Such enlargement will also be necessary in cases involving technical opinions (Art. 25 – see E-XIII, 3.1).

Where an examining division has been enlarged pursuant to Art. 18(2) but the case is nevertheless decided in a three-member composition, there should be clear evidence on the public file that a decision to set aside enlargement was taken by the examining division in its four-member composition prior to the final decision.

Therefore, if the examining division considers that the enlargement is no longer necessary, it will set aside the enlargement. This decision is not separately appealable. The applicant is informed about the setting aside of the enlargement in the communication, the annex to the summons or the decision following the setting aside of the enlargement.

Depending on the nature of the problem, as an alternative to the enlargement of the examining division, internal consultation of a legally qualified examiner in Directorate Patent Law may take place. For instance, doubts may arise whether an application concerns an invention within the meaning of Art. 52(2) or whether the claimed invention is excluded from patentability by virtue of Art. 53. Consultation of a legally qualified examiner may also be appropriate in cases where legal considerations are predominant in respect to a decision, as in proceedings following a request for re-establishment of rights according to Art. 122. Formalities officers may also consult Directorate Patent Law in cases within the scope of the duties transferred to them according to Rule 11(3) (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6).

Chapter IX – Special applications

1. Divisional applications (see also A-IV, 1)

1.1 General remarks

Subsequent to the filing of a European application or upon entry into the European phase of a Euro-PCT application, a divisional application may be filed. The divisional application is accorded the same date of filing as the parent application and has the benefit of any right of priority of the parent application in respect of the subject-matter contained in the divisional application. However, the parent application must be pending when a divisional application is filed (A-IV, 1.1.1). A European application may give rise to more than one divisional application. A divisional application may itself give rise to one or more divisional applications. *Art. 76(1)*

Divisional applications are to be treated in the same manner as ordinary applications and subject to the same requirements as these unless specific provisions of the EPC, in particular Art. 76 or Rule 36, require something different (G 1/05, G 1/06).

Furthermore, as soon as the requirements set forth in Rule 36 and Art. 76(1) are fulfilled, the proceedings for grant of a divisional application become separate and independent from the proceedings concerning the parent application (G 4/98). Pending opposition or appeal proceedings concerning the parent application (or any other member of that family of applications) are not a reason to adjourn the examination of a divisional application, neither by the EPO of its own motion nor upon request. Reasons for a stay or interruption of proceedings are set out in E-VII, 1 to E-VII, 3.

1.2 Voluntary and mandatory division

Applicants may file a divisional application of their own volition (voluntary division). The most common reason, however, for filing a divisional application is to meet an objection under Art. 82 due to lack of unity of invention (mandatory division). If the examiner raises an objection due to lack of unity, applicants are allowed a period (see C-VI, 1) in which to limit their application to a single invention. The limitation of the parent application has to be clear and unconditional. The communication inviting the applicant to limit the application due to lack of unity should therefore include a reference to the fact that if the application is not limited within the set time limit the application may be refused. *Art. 82*

1.3 Abandonment of subject-matter

The mere deletion of subject-matter in the parent application is not prejudicial to the later filing of a divisional application. When deleting subject-matter, the applicant should, however, avoid any statements which could be interpreted as abandonment with substantive effect, thereby impeding the valid filing of a divisional application for that subject-matter (see also H-III, 2.5, last paragraph).

1.4 Examination of a divisional application

Art. 76(1)

The substantive examination of a divisional application should in principle be carried out as for any other application but the following special points need to be considered. The claims of a divisional application need not be limited to subject-matter already claimed in claims of the parent application. Furthermore, no abuse of the system of divisional applications can be identified in the mere fact that the claims of the application on which the examining division had then to decide had a broader scope than the claims granted in relation with the parent application (see T 422/07).

However, under Art. 76(1), the subject-matter may not extend beyond the content of the parent application as filed. If a divisional application as filed contains subject-matter additional to that contained in the parent application as filed, it can be amended later in order that its subject-matter no longer extends beyond the earlier content, even at a time when the earlier application is no longer pending (see G 1/05). If the applicant is unwilling to remedy the defect by removal of that additional subject-matter, the divisional application must be refused under Art. 97(2) due to non-compliance with Art. 76(1).

It cannot be converted into an independent application taking its own filing date. Moreover, a further divisional application for this additional subject-matter should also be refused under Art. 97(2) due to non-compliance with Art. 76(1).

Art. 123(2)

Amendments made to a divisional application subsequent to its filing must comply with the requirements of Art. 123(2), i.e. they may not extend the subject-matter beyond the content of the divisional application as filed (see G 1/05 and T 873/94). If those amendments have not been identified and/or their basis in the application as filed not indicated by the applicant (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the examining division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see H-III, 2.1.1).

If the subject-matter of a divisional application is restricted to only a part of the subject-matter claimed in the parent application, this part of the subject-matter must be directly and unambiguously derivable from the parent application as being a separate part or entity, i.e. one which can even be used outside the context of the invention of the parent application (see T 545/92).

In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor (see A-IV, 1.1.2), it is a necessary and sufficient condition for a divisional application of that sequence to comply with Art. 76(1), second sentence, that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed (see G 1/06).

1.5 Description and drawings

The description and drawings of the parent application and the or each divisional application should in principle be confined to matter which is relevant to the invention claimed in that application. However, amendment of the description should be required only where it is absolutely necessary. Thus, the repetition in a divisional application of matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application. As for the matter of cross-references, there is no need for the examiner to check in the description since, under present practice, cross-references are always made between the parent and divisional applications. These appear on the front page of the respective application and patent published after receipt of the divisional application unless the technical preparations for publication have already been completed.

1.6 Claims

The parent and divisional applications may not claim the same subject-matter, even in different words (for further information, see G-IV, 5.4). The difference between the claimed subject-matter of the two applications must be clearly distinguishable. As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B.

2. Applications resulting from a decision under Art. 61

2.1 General remarks

In certain circumstances, before a patent has been granted on a particular application, it may be adjudged as a result of a final decision of a national court that a person other than the applicant is entitled to the grant of a patent thereon. In this event this third party may either:

(i) prosecute the application as their own application in place of the applicant; *Art. 61(1)(a)*

(ii) file a new European patent application in respect of the same invention; or *Art. 61(1)(b)*

(iii) request that the application be refused. *Art. 61(1)(c)*

If the first of these options is adopted, the third party becomes the applicant in place of the former applicant and the prosecution of the application is continued from the position at which it was interrupted (see also A-IV, 2).

If, however, the third party files a new application under Art. 61(1)(b), the provisions of Art. 76(1) apply to this new application *mutatis mutandis*. This means that the new application is treated as though it were a divisional application i.e. it takes the date of filing and the benefit of any priority right of the original application (see also A-IV, 1.2). The examiner must therefore ensure that the subject-matter content of the new application does not *Art. 61(1) and (2)* *Rule 17(1)*

extend beyond the content of the original application as filed. The original application is deemed to be withdrawn on the date of filing of the new application for the designated states concerned.

2.2 Original application no longer pending

In cases where the original application has been withdrawn, refused or deemed to be withdrawn and is thus no longer pending, Art. 61(1)(b) is applicable, thus allowing the third party to still file a new European patent application in respect of the same invention (see G 3/92).

2.3 Partial entitlement

Rule 18(1)

If, by a final decision, it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, then the foregoing considerations apply only to that part. In such a case, option (i) mentioned in C-IX, 2.1 is not open to the third party and, regarding option C-IX, 2.1(ii), the new application must be confined to that part of the original subject-matter to which the third party has become entitled. Similarly, the original application must, for the designated states concerned, be confined to the subject-matter to which the original applicant remains entitled. The new application and the amended original application will stand in a relationship to each other similar to that pertaining between two divisional applications, and they will each stand in a relationship to the original application similar to that in which divisional applications stand in relation to the application from which they are divided. The guidance set out in C-IX, 1.4, 1.5 and 1.6 is therefore applicable to this situation.

2.4 Entitlement for certain designated states only

Rule 18(2)

Where the final decision on entitlement applies only to some of the designated States, the original application may contain different claims, description and drawings for those states compared with the others (see H-III, 4.1, last paragraph, and 4.3).

If the sole result of the application of Art. 61(1) is to divide the right to the grant between the original applicant and the third party so that each may apply for the entire subject-matter for different designated states, each application should be examined in the normal way without regard to the other, with the proviso that the subject-matter of each application must not extend beyond that of the original application.

3. Applications where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973

See H-III, 4.4.

4. International applications (Euro-PCT applications)

For more details on this topic, see E-IX.

Part D

Guidelines for Opposition and Limitation/Revocation Procedures

Contents

Chapter I – General remarks

1. The meaning of opposition

The public may oppose a granted European patent on the basis of one or more of the grounds mentioned in Art. 100. The grounds on which the opposition is based may arise for example from circumstances of which the EPO was not aware when the patent was granted (e.g. prior use or a publication which was not contained or not found among the material available to the EPO). Opposition is therefore a means by which any person (but see D-I, 4) may obtain the limitation or revocation of a wrongly granted patent.

2. Opposition after surrender or lapse

An opposition may be filed even if the European patent has been surrendered or has lapsed for all designated states. This is relevant in that in such cases the rights acquired with the patent remain in existence during the period up to surrender or lapse and claims arising from such rights may subsist after that date.

Rule 75

3. Territorial effect of the opposition

The opposition applies to the European patent in all the contracting states in which that patent has effect. Thus, the opposition has, in principle, to be in respect of all the designated states. If an opposition is filed in respect of only some of the designated states it will be treated as if it were in respect of all the designated states.

Art. 99(2)

Nevertheless, the effect of an opposition may differ as between contracting states. This may arise where the patent contains different claims for different contracting states in accordance with Rule 18(2) (see C-IX, 2.4), or where the claims must take account of different art under the provisions of Art. 54(3) and of Art. 54(4) EPC 1973 (see D-VII, 8). Amendments may also be occasioned by national rights of earlier date within the meaning of Art. 139(2) and Art. 140 (see H-II, 3.3 and H-III, 4.4). Thus, the patent may be differently amended in respect of different contracting states and may be revoked in respect of one or more contracting states and not in respect of others.

Art. 61
Art. 139(2), Art. 140

4. Entitlement to oppose

"Any person" may give notice of opposition without specifying any particular interest. "Any person" is to be construed in line with Art. 58 as meaning any natural person (private individual, self-employed persons, etc.), any legal person or any body assimilated to a legal person under the law governing it. "Any person" does not include the patent proprietor (see G 9/93, reversing G 1/84).

Art. 99(1)

Notice of opposition may also be filed jointly by more than one of the persons mentioned above. In order to safeguard the rights of the patent proprietor and in the interests of procedural efficiency, it has to be clear throughout the procedure who belongs to the group of common opponents. If a common opponent (including the common representative) intends to withdraw from the proceedings, the EPO must be notified accordingly by

the common representative or by a new common representative determined under Rule 151(1) in order for the withdrawal to take effect (see also G 3/99).

Oppositions are not assignable but may be inherited or succeeded to as part of an overall succession in law, e.g. in the event of the merger of legal persons (see G 4/88). Acquiring companies may also take over oppositions filed by acquired companies. However, a legal person who was a subsidiary of the opponent when the opposition was filed and who carries on the business to which the opposed patent relates cannot acquire the status of opponent if all its shares are assigned to another company (see G 2/04).

The European Patent Office has to examine, *ex officio*, the validity of any purported transfer of opponent status to a new party at all stages of the proceedings (see T 1178/04).

5. Intervention of the assumed infringer

Art. 105(1) and (2)
Rule 89

Under certain conditions (see D-VII, 6) third parties who prove that proceedings for infringement of the opposed patent have been instituted against them or that the patent proprietor has requested them to cease alleged infringement of the patent and that they have instituted proceedings for a court ruling that they are not infringing the patent may, after the opposition period has expired, intervene in the opposition proceedings. If the notice of intervention is filed in good time and in due form, the intervention is to be treated as an opposition (see D-IV, 5.6). For accelerated processing of oppositions on request, see E-VIII, 5.

6. Parties to opposition proceedings

Art. 99(3)
Art. 105(2)
Art. 115

The patent proprietor, the opponent(s) and, where applicable, the intervener(s) will be parties to the opposition proceedings. However, an opponent who has withdrawn their opposition or whose opposition has been rejected as inadmissible will remain a party to the proceedings only until the date of such withdrawal or the date on which the decision on rejection has become final. The same will apply in the case of interveners. Third parties who have presented observations concerning the patentability of the invention in respect of which an application has been filed are not parties to opposition proceedings (see E-VI, 3).

Art. 118

Where the patent proprietors are not the same in respect of different designated contracting states, they are to be regarded as joint patent proprietors for the purposes of opposition proceedings (see D-VII, 3.1 concerning the unity of the European patent).

Art. 99(4)
Art. 61(1)(a)

Where evidence has been provided that in a contracting state, following a final decision, a person has been entered in the patent register of that state instead of the previous patent proprietor, this person is entitled on request to replace the previous patent proprietor in respect of that state. In this event, by derogation from Art. 118, the previous patent proprietor and the person making the request are not deemed to be joint patent proprietors unless both so request. The aim of this provision is to afford new patent proprietors the opportunity of defending themselves against the opposition

as they see fit (see D-VII, 3.2 as regards the conduct of the opposition proceedings in such cases).

The Legal Division is responsible for decisions in respect of entries in the Register of European Patents (see the Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). *Art. 20(1)*

It is to be noted that a person who files two different notices of opposition to the same granted patent acquires party status as opponent only once (T 9/00). Two filings by the same opponent within the opposition period that individually are not admissible but taken together comply with Art. 99(1) and Rule 76 are considered as one admissible opposition (T 774/05; for a joint opposition, see D-I, 4).

Multiple oppositions are dealt with in a single set of proceedings (see E-III, 6). When there are multiple opponents and/or proprietors as parties to a single opposition proceedings, it is normally appropriate to deal with all relevant issues (including e.g. admissibility of one of the oppositions, see D-IV, 5.5) when taking the final decision, e.g. during one oral proceedings (also see E-III, 6). The legal framework is defined by the sum of the statements of the extent to which the patent is opposed and by the grounds for opposition submitted and substantiated in the notices of opposition provided by each opponent. If one of the oppositions is admissible, but is later withdrawn, prejudicial grounds put forward in said opposition are generally examined by the opposition division of its own motion. If one of the oppositions is inadmissible, and provided at least one admissible opposition has been filed, the opposition division will consider of its own motion any *prima facie* relevant art cited in the inadmissible opposition (see D-V, 2.2).

7. Representation

As regards the requirements relating to representation of opponents and patent proprietors, reference is made to A-VIII, 1. Deficiencies in the representation of an opponent when filing the opposition and their remedy are dealt with in D-IV, 1.2.1(ii) and 1.2.2.2(iv).

8. Information to the public

As soon as an opposition has been received, the date of filing of the opposition is entered in the Register of European Patents and published in the European Patent Bulletin. The same applies to the date on which opposition proceedings are concluded and to the outcome of the proceedings (see also A-XI, 4).

Chapter II – The opposition division

1. Administrative structure

Each opposition division is assigned to an EPO directorate dedicated to conducting opposition proceedings. *Rule 11(1)*

2. Composition

2.1 Technically qualified examiners

An opposition division consists of three technically qualified examiners, at least two of whom must not have taken part in the proceedings for grant of the patent to which the opposition relates. *Art. 19(2)*

2.2 Legally qualified examiners

If the opposition division considers that the nature of the decision so requires, it is enlarged by the addition of a legally qualified examiner who has not taken part in the proceedings for grant. *Art. 19(2)*

The principles established for inclusion of a legally qualified member and for consultation of the Directorate Patent Law, the department responsible for providing legally qualified members for examining and opposition divisions, by the examining division apply *mutatis mutandis* to the opposition division (see C-VIII, 7). Difficult legal questions may also arise during the examination as to whether an opposition is to be rejected as inadmissible. In addition, consultation of a legally qualified member is to be envisaged in cases where it is questionable whether or not a disclosure by means other than a document was made available to the public.

2.3 Chair

The chair must be a technically qualified examiner who has not taken part in the grant proceedings.

3. Allocation of duties and appointment of members of the opposition division

C-II, 2 applies *mutatis mutandis*. *Rule 11(1)*

4. Tasks of the opposition divisions

4.1 Examination of oppositions

The opposition divisions are responsible for the examination of oppositions against European patents. *Art. 19(1)*

The examination of newly submitted documents for compliance with physical requirements will essentially be the task of the competent formalities officers (see D-II, 7, A-I, 2, A-III, 3.2 and C-VIII, 1).

4.2 Decision concerning the awarding of costs by the opposition division

The opposition division will decide on requests to have the costs fixed by the formalities officer reviewed (see D-II, 7 and D-IX, 2.1). *Art. 104(2)* *Rule 88(3) and (4)*

4.3 Ancillary proceedings

Art. 122(2)
Rule 136(4)
Rule 112(2)

It will be incumbent upon the opposition division to conduct ancillary proceedings arising in the course of opposition proceedings. Such ancillary proceedings may for example concern a request for re-establishment of rights in respect of a time limit which was not observed vis-à-vis the EPO during the opposition proceedings, a request for a decision concerning a finding arrived at by the formalities officer that a right has been lost or a request for exclusion from file inspection. Additional tasks may be entrusted to the opposition divisions by the President of the EPO in accordance with Rule 11(2).

Rule 144

As regards exclusion from file inspection pursuant to Rule 144 in conjunction with the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.3, reference is made to A-XI, 2.1. Documents having a substantive and/or procedural bearing on opposition proceedings can only exceptionally be excluded from file inspection (T 1691/15). Communications dealing with a request for exclusion from file inspection are excluded from file inspection and are issued separately from communications dealing with other issues. Depending on its content, a document (provisionally) excluded from file inspection and any communication concerning a request for its exclusion from file inspection may be forwarded to the other party or parties (Rule 81(2)). As the public must be informed of the grounds prejudicing or supporting the maintenance of an opposed patent, only documents, or parts thereof, not (provisionally) excluded from file inspection can be used as evidence to prove or to refute a ground for opposition.

If a party requests that the EPO excludes an otherwise public nonpatent literature document from file inspection for reasons of copyright, the opposition division will interpret this as a request not to make the document available to third parties in the public part of the file. This request, in the above interpretation, is normally granted if the copyright of the document in question is not owned by a party to the proceedings and the document in question is relatively easily retrievable including against payment. For example, a scientific article is usually easily retrievable, and its copyright is assigned to the editor. In contrast, a third-party company brochure is not easily retrievable. If the copyright of such company brochure is owned by a party to the proceedings, the request is refused by the opposition division and the document is made available via file inspection.

Where the request not to make a document available via file inspection for reasons of copyright is acceded to by the opposition division, the page(s) carrying the bibliographic details of the non-patent literature document (normally the cover page) will nonetheless be made available via file inspection in order to ensure that members of the public are in a position to retrieve the entire document. The nonpatent literature document is not considered as being excluded from file inspection within the meaning of Rule 144 and can be used as evidence in the opposition proceedings.

5. Allocation of tasks to members

Art. 19(2)
Rule 119(1)

An opposition division will normally entrust one of its members with the examination of the opposition, but not with the conduct of oral proceedings,

up to the time of the final decision on the opposition (see also D-IV, 2). If need be, the same member may also be entrusted with the examination of the evidence adduced (see E-IV, 1.3). This member will be referred to as the primary examiner.

6. Duties and powers of members

The primary examiner will conduct the examination of the opposition. If oral proceedings have been requested, they are normally arranged as first action, possibly in conjunction with the taking of evidence (see E-III, 1 to E-III, 4 and E-IV, 1.6.1). The primary examiner will prepare the communication accompanying the summons to oral proceedings and submit it to the other members. If the primary examiner considers that communications to the parties preceding the summons for oral proceedings are necessary, these communications will be submitted to the opposition division before despatch.

If there are differences of opinion within the opposition division, the primary examiner will confer with the other members to discuss the points at issue. The chair will preside at the meeting and, following a discussion, will take a vote on the decision or the further course of the procedure.

Voting will be on the basis of a simple majority. In the event of parity of votes, the vote of the chair of the division is decisive. *Art. 19(2)*

Any further measures necessary will as a rule be entrusted to the primary examiner. If no further measures are necessary, the primary examiner will draft a decision on the opposition and will distribute the draft to the other members of the opposition division for examination and signature. If any changes are proposed by a member and there are differences of opinion on such changes, the chair must arrange a meeting.

Where reference is made hereinafter to the opposition division, this is to be taken to mean the primary examiner where such a member has been appointed and in so far as the EPC entitles an opposition division member to act alone.

7. Allocation of individual duties

The President of the EPO may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the examining divisions or to the opposition divisions and involving no technical or legal difficulties. In so far as such duties affect the public, their allocation will be notified in the Official Journal of the EPO (see Decisions of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6, and 23 November 2015, OJ EPO 2015, A104). *Rule 11(3)*

The formalities officers entrusted with these duties are also in charge of fixing the amount of the costs (see D-IX, 2.1).

Chapter III – Opposition

1. Time allowed for filing notice of opposition

Within nine months from the publication of the mention of the grant of the European patent, notice of opposition has to be given to the EPO in Munich, The Hague or Berlin. *Art. 99(1)*

For expiry of the time limit see E-VIII, 1.4. Re-establishment of rights in respect of unobserved time limits for opposition is not possible in the case of an opponent (see, however, E-VIII, 3.1.2).

2. Opposition fee

The amount of the opposition fee specified in the Rules relating to Fees under the EPC must be paid before expiry of the time limit for opposition. *Art. 99(1)*

An opposition filed in common by two or more persons, which otherwise meets the requirements of Art. 99 and Rules 3 and 76, is admissible on payment of only one opposition fee (see G 3/99).

As regards the legal consequences and the procedure where the fee is not paid in good time, see D-IV, 1.2.1(i) and 1.4.1.

3. Submission in writing

3.1 Form of the opposition

The notice of opposition must be filed in writing and must be typewritten or printed, with a margin of about 2.5 cm on the left-hand side of each page. It would be appropriate if the notice of opposition also satisfied the requirements laid down in Rule 49(3). *Rule 86* *Rule 50(2)* *Rule 49(3)* *Rule 76(1)*

3.2 Notices of opposition filed electronically

Notice of opposition may, without prejudice to other means of filing, be filed in electronic form using EPO Online Filing (OLF) or Online Filing 2.0 . However, it may not be filed using the EPO webform filing service (OJ EPO 2021, A42).

3.3 Notices of opposition filed by fax

Notice of opposition may also be filed by fax (see the Decision of the President of the EPO dated 20 February 2019, OJ EPO 2019, A18). At the invitation of the EPO, written confirmation reproducing the contents of the fax and complying with the requirements of the Implementing Regulations – in particular properly signed – must be supplied. If the opponent fails to comply with this invitation in due time, the fax is deemed not to have been received (see A-VIII, 2.5). The opposition fee must in any case be paid within the opposition period. *Rule 2*

3.4 Signature of the notice of opposition

The notice of opposition must be signed by the person responsible, i.e. by the opponent or, where appropriate, by the representative (see also D-IV, 1.2.1(ii), and A-VIII, 1). *Rule 50(3)* *Rule 2*

Initials or other abbreviated forms will not be accepted as a signature.

Where the notice of opposition is filed in electronic form, the signature may take the form of a facsimile signature or a text string signature. Where EPO Online Filing is used, the signature may also take the form of an enhanced electronic signature (see OJ EPO 2021, A42).

Where the notice of opposition is filed by fax, the reproduction on the facsimile of the signature of the person filing the notice of opposition will be considered sufficient.

If the signature is omitted, the formalities officer must request the party, or where appropriate the representative, to affix their signature within a time limit to be laid down by the formalities officer. If signed in due time, the document retains its original date of receipt; otherwise, it is deemed not to have been received (see D-IV, 1.2.1(ii) and 1.4.1).

4. Derogations from language requirements

Derogations from language requirements for written opposition proceedings are dealt with in A-VII, 3 (for documents filed as evidence, see A-VII, 3.4) and for oral opposition proceedings in E-V.

5. Grounds for opposition

Art. 99(1)
Rule 76(1)

A written reasoned statement of the grounds for opposition must be filed within the opposition period.

Art. 100

Opposition may only be filed on the grounds that:

Art. 100(a)

(i) the subject-matter of the European patent is not patentable under Art. 52 to 57, because it

- is not new (Art. 52(1), 54, 55),
- does not involve an inventive step (Art. 52(1), 56),
- is not susceptible of industrial application (Art. 52(1), 57),
- is not regarded as an invention under Art. 52(1) to (3), or
- is not patentable under Art. 53;

Art. 100(b)

(ii) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (see Art. 83);

Art. 100(c)

(iii) the subject-matter of the European patent extends beyond the content of the application as filed (see Art. 123(2)) or, if the patent was granted on a divisional application or on a new application filed under Art. 61 (new application in respect of the invention by the person adjudged in a final decision to be entitled to the grant of a European patent), beyond the content of the earlier application as filed (see Art. 76(1)).

(See also D-V, 3, 4 and 6 and C-IV).

Note that each single condition mentioned above forms an individual legal basis for objection to the maintenance of the patent. Consequently, each such condition is to be regarded as a separate ground for opposition (see G 1/95 and G 7/95).

The following allegations, for example, do not constitute grounds for opposition: that national rights of earlier date exist which put the patentability of the invention in question (see, however, H-III, 4.4), that the patent proprietor is not entitled to the European patent, that the subject-matter of the patent lacks unity, that the claims are not supported by the description (unless it is also argued that the claims are so broadly worded that the description in the specification does not sufficiently disclose the subject-matter within the meaning of Art. 100(b)), that the form and content of the description or drawings of the patent do not comply with the provisions as to formal requirements as set forth in Rules 42 and 46, or that the designation of the inventor is incorrect. Nor does the simple allegation that priority has been wrongly claimed constitute a ground for opposition. However, the matter of priority must be subjected to a substantial examination in the course of opposition proceedings if prior art is invoked in connection with a ground for opposition under Art. 100(a) in relation to which the priority date is of decisive importance (see G-IV, 3 and F-VI, 2).

6. Content of the notice of opposition

The notice of opposition, filed in a written reasoned statement, must contain:

(i) the name, address and nationality of the opponent and the state in which the opponent's residence or principal place of business is located. Names of natural persons must be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, must be indicated by their official designations. Addresses must be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They must comprise all the relevant administrative units, including the house number, if any. Opponents (whether natural or legal persons) whose residence or principal place of business is in an EPC contracting state and who act without a professional representative can use an address for correspondence other than their residence. The address for correspondence must be the opponent's own address. Post cannot be sent to a different (natural or legal) person, since that requires a valid form of representation under Art. 133 and 134. It is recommended that the telephone and fax numbers be indicated (see D-IV, 1.2.2.2(i) and 1.4.2); *Rule 76(2)(a)* *Rule 41(2)(c)*

(ii) the number of the European patent against which opposition is filed, the name of the patent proprietor and the title of the invention (see D-IV, 1.2.2.2(ii) and 1.4.2); *Rule 76(2)(b)*

Rule 76(1)
Rule 76(2)(c)

(iii) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts and evidence presented in support of these grounds (see D-IV, 1.2.2.1(iii) to 1.2.2.1(v) and 1.4.2). The requirement under Rule 76(1) that notice of opposition must be filed in a written reasoned statement also implies presenting arguments. However, in order to streamline opposition procedure, it is recommended that a single copy of any written evidence be submitted as soon as possible and ideally with the notice of opposition (see D-IV, 1.2.2.1(v), last two paragraphs);

Rule 76(2)(d)

(iv) if the opponent has appointed a representative, the representative's name and address of place of business in accordance with the provisions of subparagraph (i) as set out above (see D-IV, 1.2.2.2(iii) and 1.4.2).

D-IV, 1 sets out further details and explains how to deal with the opposition if one of these requirements is not fulfilled.

Chapter IV – Procedure up to substantive examination

1. Examination for deficiencies in the notice of opposition and communications from the formalities officer arising from this examination

1.1 Forwarding of the notice of opposition to the formalities officer

The notice of opposition must be forwarded directly to the formalities officer, who then places it in the electronic file of the European patent concerned in accordance with the relevant administrative instructions and communicates it without delay to the patent proprietor for information. If a notice of opposition is received prior to the publication of the mention of the grant of the European patent, the formalities officer informs the senders that their document cannot be treated as an opposition. This document becomes part of the file and, as such, is also available for inspection under Art. 128(4), and is brought to the attention of the applicant or the patent proprietor as an observation by a third party in accordance with Art. 115 (for details, see E-VI, 3). If an opposition fee has been paid, it will in this case be refunded.

Examinations, observations, communications and, where appropriate, invitations to the parties will be the responsibility of the formalities officer who has been entrusted with this task of the opposition division (see D-II, 7).

1.2 Examination for deficiencies in the notice of opposition

After notice of opposition has been given, the formalities officer examines whether any deficiencies exist.

1.2.1 Deficiencies which, if not remedied, lead to the opposition being deemed not to have been filed

The following deficiencies fall into this category:

(i) the opposition fee or a sufficient amount of the fee has not been paid within the opposition period (Art. 99(1); see also G 1/18). However, if the opposition fee, apart from a small amount (e.g. deducted as bank charges), has been paid within the opposition period, the formalities officer examines whether the amount lacking can be overlooked where this is justified. If the formalities officer concludes that the amount lacking can be overlooked, the opposition fee is deemed to have been paid and there is no deficiency in the present sense;

Art. 7 RFees
Art. 8 RFees

(ii) the document giving notice of opposition is not signed and this is not rectified within the period set by the formalities officer, which is fixed at two months as a rule (see E-VIII, 1.2) (Rule 50(3)).

It is noted that for cases covered by Art. 133(2) (see also D-IV, 1.2.2.2(iv)) a professional representative first has to be appointed within the prescribed time limit. The above applies if the

appointed representative then fails to remedy such deficiency either by signing the notice or by approving it in writing;

(iii) where a notice of opposition is filed by fax and written confirmation reproducing the contents of the fax, if requested by the formalities officer, is not supplied in due time (Rule 2(1) and Decision of the President of the EPO dated 20 February 2019, OJ EPO 2019, A18)

(iv) where a notice of opposition is filed by the representative or employee of an opponent, and the authorisation, if any is required (see A-VIII, 1.5 and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1), is not supplied in due time (Rule 152(1) to (3) and (6)); and

(v) the opposition is submitted within the opposition period but not in an official language of the EPO, as specified in Rule 3(1), or if Art. 14(4) applies to the opponent, the translation of the elements referred to in Rule 76(2)(c) is not submitted within the opposition period (see also A-VII, 2, G 6/91 and T 193/87). This period is extended where the one-month period as required under Rule 6(2) expires later. This deficiency is present if the opposition is not filed in English, French or German or if, for example, an opponent from Belgium files an opposition in time in Dutch but fails to file the translation of the essential elements into English, French or German within the abovementioned time limits.

For oppositions which, upon submission, are deemed not to have been filed because of deficiencies as described above, see the further procedure as described in D-IV, 1.3.1, 1.3.3 and 1.4.1.

1.2.2 Deficiencies which, if not remedied, lead to the opposition being rejected as inadmissible

Only such oppositions as are deemed to have been filed will be examined for deficiencies under Rule 77(1) and (2).

If the formalities officers are not sure whether the opposition in question contains a deficiency under Rule 76(2)(c), they will submit the file to the opposition division for checking. They will do this in particular if the opposition alleges non-patentability under Art. 52, 54 or 56 and the relevant prior art has been made available to the public by means other than by written description, or if taking of evidence has been requested in accordance with Rule 117.

In this connection the opposition division will also examine the extent to which it is necessary for the formalities officer to request the opponent to submit evidence (see D-IV, 1.2.2.1(v)).

1.2.2.1 Deficiencies under Rule 77(1)

The following deficiencies fall into this category:

(i) the notice of opposition is not filed in writing with the EPO in Munich or its branch at The Hague or its suboffice in Berlin within the nine-

month opposition period, calculated from the date of publication of the mention of the grant of the European patent in the European Patent Bulletin (Art. 99(1));

Accordingly, the opposition is deficient if, for example, notice of opposition is submitted to the EPO belatedly, i.e. after expiry of the nine-month period, or where the opposition is notified within the opposition period but only verbally in a telephone call officially noted in the files. This category of deficiency also includes oppositions which, notwithstanding Art. 99(1), are filed with the central industrial property office of a contracting state or an authority thereunder and not forwarded by these offices either at all or in time for them to be received by the EPO before the expiry of the opposition period. There is no legal obligation upon these offices or authorities to forward oppositions to the EPO.

(ii) the notice of opposition does not provide sufficient identification of the European patent against which opposition is filed;

Such a deficiency exists if the EPO is unable to identify the relevant patent on the basis of the particulars in the notice of opposition; for example, if only the proprietor of the contested patent and perhaps the title of the invention for which the patent was granted are mentioned in the notice of opposition. Such particulars alone are not an adequate description of the contested European patent, unless the patent proprietor who alone is named possesses only one patent or possesses several patents, the subject-matter of only one of which fits the title of the invention given in the notice of opposition, being clearly distinct from the subject-matter of the other patents which this proprietor holds. A mere indication of the number of the contested European patent in the notice of opposition constitutes sufficient identification of the patent concerned, provided that no conflicting information is given, e.g. an inconsistent name for the patent proprietor, and the conflict cannot be resolved from the information given.

(iii) the notice of opposition contains no statement of the extent to which the European patent is opposed; *Rule 76(2)(c)*

Such a deficiency is present if it is not clear from the requisite statement whether the opposition is directed against the entire subject-matter of the patent or only a part of it, i.e. whether it is directed against all the claims or only against one or a part of one claim, such as an alternative or embodiment;

(iv) the notice of opposition contains no statement of the grounds on which the opposition is based; *Rule 76(2)(c)*

A notice of opposition contains such a deficiency if it does not mention at least one of the grounds for opposition referred to in Art. 100 (see D-III, 5). If non-patentability is given as a ground for opposition, the statement of grounds must at least implicitly indicate

which conditions for patentability (Art. 52 to 57) are considered not to have been fulfilled.

Art. 99(1)
Rule 76(2)(c)

(v) the notice of opposition is not adequately substantiated;

According to Rule 76(2)(c), a notice of opposition has to contain a statement of the extent to which the European patent is opposed, the grounds on which the opposition is based, as well as an indication of the facts and evidence presented in support of these grounds for opposition.

The wording of Rule 76(2)(c) clearly indicates that there is a difference between the grounds for opposition, i.e. the legal basis for revocation of the patent (e.g. Art. 100(a)), and the facts and evidence presented in support of these grounds. Where the facts and evidence are entirely absent or so vague as not to allow a proper understanding of the case, the opposition is considered to contain only a mere allegation, which is not sufficient to render the opposition admissible.

Therefore, the opponent has to substantiate the grounds for opposition by adducing facts, evidence and arguments for at least one of those grounds. The opponent has to establish the legal and factual framework on which the opposition rests to pave the way for a substantive assessment. As a consequence, the division and the patent proprietor need to be able to understand, without further investigation of their own, the issues that need to be decided. It is not necessary for the admissibility of the opposition that a final decision can be taken without further investigation. In other words, it is not a question of admissibility but of substantive examination whether the facts on which the opponent relies in comprehensibly explaining a ground for opposition are or can be proven. Where the grounds comprise an allegation of a prior use or an oral disclosure prior to the date of filing or the priority date, the opposition division must be supplied with an indication of the facts, evidence and arguments necessary to determine

(a) the date on which the alleged use occurred ("when"),

(b) what was used ("what"),

(c) and the circumstances relating to the use ("where, how, by whom") (G-IV, 7.2 and 7.3).

Where there are multiple grounds for opposition, if the facts, evidence and arguments for one ground are sufficiently indicated, the opposition is admissible even if the facts, evidence and arguments in support of the other grounds are submitted belatedly. Such belated facts, evidence and arguments are in that event dealt with in accordance with E-VI, 2. Owing to the length of the opposition period (nine months), however, in order to expedite the opposition proceedings, it is recommended that a single copy of any written

evidence indicated in the notice of opposition be submitted as soon as possible and ideally with the notice of opposition.

Otherwise, if the opposition is admissible, the opponent will be invited to supply such evidence as soon as possible and as a rule within two months. If the documents thus requested are neither enclosed nor filed within the time limit set, the opposition division may decide not to take into account any arguments based on them. (As regards facts or evidence not submitted in due time and arguments presented at a late stage see E-VI, 2) *Rule 76(2)(c)* *Rule 83*

As far as the admissibility of an opposition is concerned, it is immaterial whether and to what extent the facts, evidence and arguments submitted in due time actually warrant revocation of the contested European patent or its maintenance in amended form. On the one hand, an unconvincing ground for opposition may have been substantiated (making the opposition admissible), whereas on the other hand a deficient submission may have been rejected as inadmissible even though, if properly drafted, it could have succeeded (see also T 222/85).

The substantiation of the grounds for opposition thus has to be clearly distinguished from the actual assessment of the evidence, which is part of the process of ascertaining whether the opposition is well-founded in substance, i.e. proven. Subject to the admissibility of the opposition, this has to be established by the opposition division in the light of the applicable standard of proof (G-IV, 7.5.2).

(vi) the opposition does not indicate beyond any doubt the identity of the person filing the opposition (Art. 99(1) and Rule 76(2)(a)). *Art. 99(1)* *Rule 76(2)(a)*

1.2.2.2 Deficiencies under Rule 77(2)

The following deficiencies fall within this category:

(i) the notice of opposition does not specify the name, address and nationality of the opponent and the state in which the opponent's residence or principal place of business is located in the prescribed manner (see D-III, 6(i)); *Rule 76(2)(a)*

(ii) the number of the European patent against which the opposition is filed or the name of the patent proprietor or the title of the invention is not indicated; *Rule 76(2)(b)*

Each of the particulars listed in (ii) above must be supplied within the time limit set by the formalities officer (see D-IV, 1.3.2), even if the contested European patent may be identified by means of one of these or other particulars within the opposition period (see D-IV, 1.2.2.1(ii)). If the name of the patent proprietor as indicated by the opponent is not the same as that recorded in the Register, the formalities officer will inform the opponent of the patent proprietor's correct name.

Rule 76(2)(d)

(iii) where the opponent has appointed a representative, the name or the address of the place of business of such representative is not indicated in the notice of opposition in the prescribed manner (see D-III, 6(iv));

(iv) the opponent has neither residence nor principal place of business in one of the contracting states (Art. 133(2)) and has not communicated the appointment of a professional representative (Art. 134). In the communication requesting remedy of such deficiency the opponent must also be asked to arrange for the signature or approval of the notice of opposition by the representative to be appointed; and

Rule 86

(v) the notice of opposition fails to satisfy further formal requirements other than those mentioned in Rule 77(1). For instance, it may fail to comply with the provisions of Rule 50(2) without due justification.

1.3 Issue of communications by the formalities officer as a result of examination for deficiencies

Art. 14(4)
Rule 2(1)
Rule 3(1)
Rule 6(2)
Rule 50(3)
Rule 77(1) and (2)
Rule 152(1) to (3)

If, in the course of the examination as described in D-IV, 1.2, formalities officers note deficiencies which may still be remedied, and if there are no deficiencies which may no longer be remedied (in the case of deficiencies which may no longer be remedied see D-IV, 1.4), they will issue the communications described in D-IV, 1.3.1 and/or 1.3.2 to the opponent, if possible in a single communication.

1.3.1 Communication in the event of deficiencies as described in D-IV, 1.2.1 which, if not remedied, will lead to the opposition being deemed not to have been filed

The communication will indicate the deficiencies noted in accordance with D-IV, 1.2.1 and will state that the opposition will be deemed not to have been filed unless the deficiency or deficiencies are remedied within the time limits indicated in D-IV, 1.2.1.

1.3.2 Communication in the event of deficiencies as described in D-IV, 1.2.2 which, if not remedied, will lead to rejection of the opposition as inadmissible

The communication will indicate the deficiencies noted in accordance with D-IV, 1.2.2.1 or 1.2.2.2 and will state that the opposition will be rejected as inadmissible unless the deficiencies as described in D-IV, 1.2.2.1 are remedied within the opposition period and unless the deficiencies as described in D-IV, 1.2.2.2 are remedied within the period stipulated by the formalities officer.

1.3.3 Extent of the formalities officer's obligation to issue the above communications

Although formalities officers are not obliged to do so, they may notify the opponent of deficiencies as described in D-IV, 1.2.1(i) and D-IV, 1.2.2.1 in good time before the expiry of the time limits within which it is still possible to remedy the deficiencies. However, the opponent can seek no legal remedy against failure to issue these communications, which is to be

regarded merely as a service afforded the opponent by the EPO so as largely to obviate any adverse legal consequences. Deficiencies as described in D-IV, 1.2.1(ii) and 1.2.2.2 must in any event be officially notified to the opponent, since this is a statutory requirement. Should this communication inadvertently be omitted notwithstanding deficiencies of this type in the notice of opposition, opponents may submit the missing particulars on their own initiative at any time, even after the expiry of the opposition period without suffering adverse legal consequences.

1.4 Subsequent procedure in the event of deficiencies which may no longer be remedied

1.4.1 Deficiencies which may no longer be remedied, as a result of which the opposition is deemed not to have been filed

If formalities officers establish that the deficiencies referred to in D-IV, 1.2.1 have not been remedied within the time limits laid down in the EPC or by the EPO, they will inform the opponent in accordance with Art. 119 that the notice of opposition is deemed not to have been filed and that a decision may be applied for under Rule 112(2) (see E-VIII, 1.9.3). If no such application is made within the prescribed period of two months after notification of this communication, and if there is no other valid opposition pending, the proceedings are closed and the parties informed accordingly. Any opposition fees which have been paid are refunded. *Rule 112(1)*

Documents submitted with a notice of opposition which is deemed not to have been filed will form part of the file and will thus be available for inspection in accordance with Art. 128(4). They will be regarded as observations by third parties under Art. 115 (see in this connection D-V, 2.2 and E-VI, 3). If a further admissible opposition is pending, the proceedings are continued in respect of it.

1.4.2 Deficiencies which may no longer be remedied in accordance with Rule 77(1) and (2), resulting in the opposition being rejected as inadmissible

If there are no deficiencies of the type referred to in D-IV, 1.4.1 but a notice of opposition which is deemed to have been filed reveals deficiencies under Rule 77(1) (see D-IV, 1.2.2.1) which may no longer be remedied and which have not been communicated to the opponent(s) in accordance with D-IV, 1.3.2 (because the opposition period has already expired), the formalities officer must, by virtue of Art. 113(1), notify the opponent(s) of these deficiencies, allowing them time in which to submit comments (normally two months), and point out to them that the notice of opposition is likely to be rejected as inadmissible.

If the opponent does not refute the opinion expressed by the formalities officer on the existence of deficiencies which may no longer be corrected or have failed to remedy in good time deficiencies which may be corrected (Rule 77(2)) and which were communicated to them pursuant to D-IV, 1.3.2, the formalities officer will reject the notice of opposition as inadmissible, except in the case mentioned in D-IV, 1.2.2.1(v) (for which the opposition division is competent to decide, see the Decisions of the President of the EPO dated 12 December 2013 and 23 November 2015

concerning the entrustment to non-examining staff of certain duties incumbent on the examining or opposition divisions, OJ EPO 2014, A6, and OJ EPO 2015, A104). As regards the form of the decision, see E-X, 2.3 and E-X, 2.6.

In all other cases the formalities officer will submit the opposition documents to the directorate responsible for the European patent in suit (for designation of an opposition division, see D-IV, 2).

The decision declaring the opposition inadmissible under Rule 77(1) or (2) can be taken without the participation of the patent proprietor in accordance with Rule 77(3). However, for reasons of procedural economy, the substantive examination is in fact initiated if at least one further admissible opposition is pending. The patent proprietor may also comment on the admissibility of the former opposition in the course of that examination.

When the decision declaring the opposition inadmissible has become final the opponent concerned is no longer a party to the proceedings.

1.5 Notifications to and observations by the patent proprietor

Communications and decisions in the course of the examination as to whether the opposition is deemed to have been filed and is admissible are also notified to the patent proprietors. If they file observations on their own initiative concerning such a communication, these observations may be taken into account in the decision.

1.6 Subsequent procedure

For the subsequent procedure in the event of one or more oppositions with no deficiencies see D-IV, 5.2.

2. Activity of the opposition division

Art. 19(2)

Formalities officers submit the file to the opposition division in question on despatch of the invitation to the proprietor to submit comments in the cases referred to in D-IV, 5.2; in all other cases (see D-IV, 1.4.2) they submit it immediately.

The director responsible will then designate the three technical members of the competent opposition division. The opposition division will decide whether one of its members – and if so, which – is to be entrusted with the examination of the opposition up to the taking of a decision (see D-II, 5). The technical members of the division will not be designated if the opposition is rejected as inadmissible by the formalities officer and no further admissible opposition has been filed (see D-IV, 1.4.2).

3. Rejection of the opposition as inadmissible by the opposition division, the patent proprietor not being a party

(For rejection of the opposition as inadmissible at a later stage, the patent proprietor being a party, see D-IV, 5.1 and 5.5)

In cases of insufficient substantiation, where the formalities officer is not competent to decide on the inadmissibility (see D-IV, 1.2.2.1(v)), the opposition division will either:

(i) issue the decision rejecting the opposition as inadmissible (when the formalities officer has already informed the opponent of this deficiency pursuant to D-IV, 1.3.2); or

(ii) consider the opposition admissible and continue with examination of the opposition (see D-V); or

(iii) communicate its findings to the opponent(s) in question and at the same time request them to submit observations.

If the opponent does not refute the opinion expressed by the opposition division on the existence of these deficiencies which may no longer be corrected, the opposition division will reject the notice of opposition as inadmissible, possibly after having held oral proceedings. As regards the form of the decision, see E-X, 2.3 and E-X, 2.6.

The decision will be communicated to the other parties. An inadmissible opposition or documents produced in support of an inadmissible opposition will be placed in the file and will therefore be available for inspection in accordance with Art. 128(4). As regards the possibility of taking them into consideration as observations by third parties, see D-V, 2.2 and E-VI, 3. If there are further admissible oppositions, for reasons of procedural economy this decision to reject the opposition as inadmissible will normally be taken at the end of the procedure together with the decision on the admissible oppositions.

For the possibility of appeal by the opponent and other possible means of redress, see E-XII, 1 and E-XII, 7.

4. Termination of opposition proceedings in the event of inadmissible opposition

Under Art. 101(1) and Rule 79(1), the examination as to whether the European patent can be maintained can only be performed if at least one admissible opposition has been filed. This means that the opposition division has to refrain from commenting on the substantive merits of the opposition when expressing an opinion on its inadmissibility if there is no further admissible opposition (see T 925/91). Opposition proceedings are terminated if all notices of opposition filed against a European patent have been rejected as inadmissible and the last decision in this respect has become final. This will be communicated to the parties.

5. Preparation of substantive examination

5.1 Inadmissibility at a later stage

Since the admissibility of an opposition is always open to question by the patent proprietor, no separate communication that the opposition is admissible will be sent to the opponent or the patent proprietor. Where deficiencies on the basis of which the notice of opposition is likely to be

regarded as inadmissible, but of which the opponent has not been informed by the formalities officer, come to the attention of the opposition division in the opposition documents submitted to it or because the patent proprietor has raised the issue during the proceedings, it will inform the parties about its reservations in a communication and at the same time request the opponent in question to submit observations. If deficiencies within the meaning of Rule 77(2) are involved, it is sufficient to specify a period for the opponent to remedy such deficiencies.

If the opponent does not refute the opinion expressed by the opposition division on the existence of these deficiencies which may no longer be corrected or fails to remedy in good time deficiencies which may be corrected, the opposition division will reject the notice of opposition as inadmissible, possibly after having held oral proceedings. As regards the form of the decision, see E-X, 2.3 and E-X, 2.6. For subsequent procedure, see the last two paragraphs of D-IV, 3.

5.2 Invitation to the patent proprietor to submit comments and communication of opposition to the other parties concerned by the formalities officer

Rule 79(1) and (2)

If formalities officers consider that no further ex-officio objection to the admissibility of each or the only opposition remains, they will invite the patent proprietor, immediately after expiry of the opposition period or the period laid down by the formalities officer for the remedying of the deficiencies in accordance with Rule 77(2) (see D-IV, 1.2.2.2), or for the presentation of evidence (see D-IV, 1.2.2.1(v)), to file observations concerning the oppositions communicated earlier and to file amendments, where appropriate, to the description, claims and drawings within a four-month period. Extension of the time limit will only be granted in exceptional cases on the basis of a duly substantiated request (see E-VIII, 1.6, and the Notice from the EPO dated 31 May 2016, OJ EPO 2016, A42). The above procedure also applies to oppositions where a decision to the effect that they are deemed not to have been filed or are inadmissible has not yet been taken or has not yet become final.

If several notices of opposition have been filed, the formalities officer will communicate them to the other opponent(s) at the same time as the communication provided for in the previous paragraph. This will not be combined with an invitation to file observations or the setting of a time limit.

However, copies of documents supporting the parties' submissions which are available for inspection in the Register will no longer be transmitted (see A-XI, 2 and the Notice from the EPO dated 28 August 2020, OJ EPO 2020, A106).

5.3 Filing of amended documents in reply to the notice of opposition

Amended documents must, provided that it is not irrelevant at the stage reached in the procedure, be as complete as possible and drawn up in such a way as to allow the European patent, where appropriate, to be maintained without further delay in the amended version.

These considerations apply also to auxiliary requests in which the patent proprietor proposes amendments for consideration by the opposition division only if the division is unable to grant the main request, for example that the opposition is to be rejected. In both cases, however, it will be more convenient in certain circumstances to determine first the form of the claims, leaving purely consequential amendments in the description to be dealt with later.

Care must be taken to ensure that any amendments do not offend against Art. 123(2) and (3) (see D-V, 6, H-IV, 4.3 and H-V, 2 and 3). It must also be checked that the patent, by the amendments **themselves**, does not contravene the requirements of the EPC (with the exception of Art. 82, see D-V, 2.2). For the form of amended documents, see H-III, 2.2 to 2.4.

Proprietors' observations, and any amendments they make, are communicated to the opponent(s) by the formalities officer without delay for information. No time limit for reply is set.

5.4 Communication of observations from one of the parties to the other parties

The formalities officer will, at any stage in the procedure, immediately communicate the observations of any of the parties to the other parties for information.

Rule 79(3)
Rule 81(2)

If the opposition division considers that observations are called for in the course of the further procedure, a separate invitation is issued and a period is fixed (normally four months), with or without a communication stating the grounds.

5.5 Decision concerning the admissibility of an opposition, the patent proprietor being a party

If the patent proprietor, when replying to the notice of opposition, contends that the opposition is inadmissible pursuant to Rule 77(1) and (2) because of deficiencies specified by the patent proprietor himself, the opponent concerned must be given the opportunity to submit comments within a period fixed by the formalities officer (normally two months).

If the opposition division concludes that the opposition is inadmissible, it must as a rule first take a reasoned decision, possibly after having held oral proceedings. This decision is appealable. If, on the other hand, on the basis of another – admissible – opposition, an immediate decision can be taken on the rejection of the opposition or oppositions or on the revocation of the patent, the decision on admissibility is to be taken together with this final decision.

If, despite the observations of the patent proprietor, the opposition division concludes that the opposition is admissible, the decision on admissibility is normally to be taken together with the final decision, especially where at least one other admissible opposition exists (see D-I, 6). If the opposition division is of the opinion that all oppositions are inadmissible, a reasoned decision is to be taken, which is appealable.

An opponent whose opposition has been finally rejected as inadmissible is no longer a party to the subsequent proceedings once this decision becomes final.

5.6 Examination of the admissibility of an intervention and preparations in the event of an intervention

Rule 79(4)

When examining whether an intervention is admissible, the formalities officer and the opposition division will proceed as for the examination as to admissibility of an opposition (see D-IV, 1, 3 and 5.5) but on the basis of the requirements for intervention under Art. 105 and Rule 89.

Rule 86

Paragraphs D-IV, 5.2 and 5.4, may, however, be disregarded in the case of an intervention in opposition proceedings.

Accordingly, particularly in the case of proceedings which are at an advanced stage, the formalities officer will inform third parties who have intervened of the progress of the proceedings and request them to indicate within one month whether they will also require the documents received from the parties in accordance with Rule 79(1) to (3), together with the communications from the opposition division and the observations of the parties under Rule 81(2), for the preceding period. If this is the case, the formalities officer will send them with the relevant communications from the opposition division or the formalities officer to the intervening third party.

Chapter V – Substantive examination of opposition

1. Beginning of the examination of the opposition

Once the preparations for the examination of the opposition have been completed pursuant to Rule 79, the opposition division examines whether the grounds for opposition (see D-III, 5) laid down in Art. 100 prejudice the maintenance of the European patent. The examination may also begin if a single admissible opposition has been withdrawn in the interim (see D-VII, 5.3). If the opponent has died or is legally incapacitated, the examination may begin even without the participation of the heirs or legal representatives (see D-VII, 5.2).

Art. 101(1)

2. Extent of the examination

2.1 Extent to which the patent is opposed

In the unusual case where an opposition is limited to only a certain part of the patent, the opposition division has to limit its examination to the part opposed. However, if the opposition is directed only to an independent claim, the dependent claims are considered to be implicitly covered by the extent of the opposition and may be examined by the opposition division, provided their validity is *prima facie* in doubt on the basis of the information already available (see G 9/91). Similarly, if only a process claim is opposed, a product-by-process claim making reference to the same process is considered to be implicitly covered by the extent of opposition and may be examined under the same conditions as above (see T 525/96).

2.2 Examination of the grounds for opposition

Opposition proceedings are not a continuation of examination proceedings. Hence as a general rule the opposition division will confine its examination to those grounds for opposition brought forward by the opponent. If, for example, the opposition is filed only on the grounds that the subject-matter of the European patent is not sufficiently disclosed or that it extends beyond the content of the patent application as filed, the opposition division will examine the patentability of the subject-matter of the European patent pursuant to Art. 52 to 57 only if facts have come to its notice which, ***prima facie***, wholly or partially prejudice the maintenance of the patent (see G 10/91).

A document indicated in the patent specification as the closest or important prior art for the purposes of elucidating the technical problem set out in the description forms part of the opposition proceedings even if not expressly cited within the opposition period. The same applies to any relevant documents cited in the patent specification which do not constitute the closest prior art but whose contents are nevertheless important for understanding the problem underlying the invention within the meaning of Rule 42(1)(c) EPC (T 536/88, in particular point 2.1).

Once proceedings for examining the opposition(s) have been initiated because an admissible opposition has been filed (although it may have been withdrawn in the interim), there may be reason to believe that other

Rule 81(1)
Art. 114

grounds exist which, *prima facie*, in whole or in part prejudice the maintenance of the European patent. If that is the case, these grounds will generally be examined by the opposition division of its own motion pursuant to Rule 81(1). Such other grounds may result from facts emerging from the search report or the examination procedure, the examiner's personal knowledge or observations presented by third parties pursuant to Art. 115 (see also E-VI, 3). Such grounds may also have been put forward in another opposition which has been rejected as inadmissible, or in another opposition deemed not to have been filed. They may also be any grounds submitted belatedly (see E-VI, 1.1 and E-VI, 2). Under Art. 114(1), such prejudicial grounds put forward in an opposition which has been withdrawn will also generally be examined by the opposition division of its own motion. In carrying out such examination the opposition division will, however, take the interests of procedural expediency into account (see E-VI, 1.2). If the decision is to be based on grounds to be taken into account pursuant to Art. 114(1) or Rule 81(1), the parties must be given the opportunity to comment (see E-X, 1).

If during examination of the opposition an allegation about a relevant fact seems plausible, it may be taken into account without further evidence if it is not challenged by the other party.

If a fact is contested or not plausible, the party making the allegation must prove it. If the parties to opposition proceedings make contrary assertions which they cannot substantiate and the opposition division is unable to establish the facts of its own motion, the patent proprietor is given the benefit of the doubt (see T 219/83, Headnote I).

For example, if the opponent raises an objection under Art. 100(b) and provides experimental evidence that e.g. the claimed process cannot be realised, and the patent proprietor replies that the process can be carried out without undue burden by the skilled person taking common general knowledge also into consideration (T 281/86, OJ EPO 1989, 202; reasons 6), the patent proprietor has to provide proof of what was common general knowledge at the filing date (or the date of the earliest priority if priority has been claimed).

Pursuant to Art. 100, the absence of unity of invention is not a ground for opposition (see D-III, 5).

Art. 82

Since unity of invention under Art. 82 is only required for the European patent application, the unity of the subject-matter of the European patent may not be examined by the opposition division, even of its own motion. In particular, where the facts, evidence and arguments which come to light in the opposition proceedings lead to the maintenance of the European patent in amended form, there will be no further examination as to whether the remaining subject-matter of the patent contains a single invention or more than one. Any lack of unity must be accepted (see G 1/91).

The grounds for opposition laid down in Art. 100 are examined in greater detail below.

3. Non-patentability pursuant to Art. 52 to 57

Art. 100(a)

The same substantive requirements apply in the opposition procedure regarding patentability pursuant to Art. 52 to 57 as in the examination procedure. G-I to VII will therefore also be applied in opposition proceedings. However, it will be more common in opposition proceedings than in examination procedure for the examination as to patentability to be based on the state of the art as made available to the public not by written description but "by means of an oral description, by use, or in any other way" (see Art. 54(2) and G-IV, 7).

4. Insufficient disclosure of the invention

Determination of whether the disclosure of an invention in a European patent application is sufficient is dealt with in F-III, 1 to 3.

Art. 100(b)

The principles set out there will also apply *mutatis mutandis* to the opposition procedure. The overriding consideration in this context is the disclosed content of the European patent specification, that is to say what a person skilled in the art is able to derive directly and unambiguously from the explicit and implicit disclosure in the patent claims, description and drawings, if any, without using inventiveness. Pursuant to Art. 100(b), the patent has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by persons skilled in the art. If the patent specification does not disclose the invention sufficiently clearly to enable it to be carried out over the full scope of the claim in accordance with Art. 100(b), this may be remedied, provided the original documents contained a sufficient disclosure, but subject to the condition that, as required under Art. 123(2), the subject-matter of the European patent does not extend beyond the content of the application as filed and, as required under Art. 123(3), the protection conferred is not extended.

The skilled person wishing to implement the claimed invention reads the claims in a technically sensible manner. An objection of insufficient disclosure of the invention is therefore not to be based on embodiments that are meaningless and not consistent with the teaching of the application as a whole (see T 521/12).

There is normally no deficiency under Art. 100(b) if a feature which is essential for performance of the invention is missing from the claim but is disclosed in the description and/or drawings. However, unduly broad claims may be objected to under Art. 56 (see T 939/92).

5. Clarity of claims

Art. 100

Clarity is not a ground for opposition. Opposition proceedings are not designed as a procedure for generally amending (or revoking) patents that contain any kind of defect, and therefore opposition proceedings are not to be regarded as a continuation of examination proceedings. As a general rule this means that a granted claim has to be lived with even if new facts (e.g. new prior art) demonstrate that the claim is unclear (G 3/14).

Art. 101(3)

In considering whether, for the purpose of Art. 101(3), a patent as amended meets the requirements of the EPC, the claims of the patent may be examined for compliance with the requirements of Art. 84 only when, and

then only to the extent that, an amendment introduces non-compliance with Art. 84 (G 3/14, confirming the jurisprudence as exemplified by T 301/87). A lack of compliance with Art. 84 cannot be seen as having been introduced by an amendment if a clarity problem already present in the claims as granted is only brought into notice, highlighted or made visible by the amendment.

According to G 3/14, the amendment of one claim or part of a patent cannot lead to a re-examination of other parts of the patent which have not been amended. Thus, the deletion of an independent claim with its dependent claims or the deletion of a dependent claim leaving the independent claims and other dependent claims intact does not permit examination of the remaining claims for compliance with Art. 84.

A claim amended during opposition proceedings is not subject to examination for compliance with Art. 84 if it results from

(i) inserting a complete dependent claim as granted into an independent claim;

(ii) combining one of several alternative embodiments of the dependent claim as granted with the independent claim as granted;

(iii) deleting wording from a granted claim (whether independent or dependent), whereby its scope is narrowed but a pre-existing lack of compliance with Art. 84 is left intact (as exemplified by T 301/87); or

(iv) deleting optional features from a granted claim (whether independent or dependent).

However, an amended claim is to be examined for compliance with Art. 84:

(v) if features are taken from the description and inserted into a granted claim by way of amendment; or

(vi) if a feature from a dependent claim as granted is introduced into an independent claim as granted and this feature was previously connected with other features of that dependent claim and an alleged lack of compliance with Art. 84 is introduced by the amendment.

6. Subject-matter of the European patent extending beyond the original disclosure

6.1 Basis of this ground for opposition

Art. 100(c)

This ground for opposition under Art. 100(c) refers back to Art. 123(2) and stipulates that the subject-matter of a European patent may not extend beyond the content of the application as filed. In the case of a patent granted on the basis of a European divisional application (Art. 76(1)), two criteria apply: the subject-matter must not extend beyond the content of the earlier application as filed (Art. 76(1)), and it must not extend beyond the content of the divisional application as filed (Art. 123(2)) (see T 873/94). Similar considerations apply to applications filed under Art. 61. In the case

of a patent granted on an application filed in a language other than an official language of the EPO either in accordance with Art. 14(2) or in accordance with Rule 40 (see Rule 40(3)), the original text will, as provided for in Art. 70(2), constitute the basis for determining whether the subject-matter of the European patent extends beyond the content of the application as filed. However, unless, for example, the opponent adduces proof to the contrary the opposition division may, under Rule 7, assume that the translation referred to in Art. 14(2) or Rule 40(3) is in conformity with the original text of the application.

6.2 Distinction between allowable and unallowable amendments

The distinction between allowable amendments to the content of a European patent application and amendments which are at variance with Art. 123(2) or Art. 76(1) is set forth in H-IV, 2, and C-IX, 1.4. These guidelines will be applied *mutatis mutandis* in the course of opposition proceedings to determine whether the subject-matter of the European patent as granted or as amended during the opposition proceedings extends beyond the content of the application as filed.

Chapter VI – Procedure for the examination of the opposition

(Oral proceedings: see E-III; taking and conservation of evidence: see E-IV)

1. General remarks

The opposition division will first of all endeavour to reach a decision in written proceedings. Taking account of the investigations usually conducted beforehand by the primary examiner (see D-II, 5 and 6), the opposition division will base its decision on the written submissions of the parties and, where appropriate, on other written evidence obtained, in particular, through the production of documents, requests for information and sworn statements in writing.

Art. 114(2)
Rule 76(2)(c)
Rule 80

The parties in *inter partes* cases are subject to a particular duty to facilitate due and swift conduct of the proceedings, in particular by submitting all relevant facts, evidence, arguments and requests as early and completely as possible (see D-IV, 1.2.2.1 and E-IV, 1.2). Furthermore, any ground, fact and evidence filed by the opponent(s) after the expiry of the opposition period are considered as late-filed unless they are due to a change in the subject of the proceedings; see E-VI, 2 and subsections for more details. Admissibility of amendments by the proprietor is treated in detail in H-II, 3 to H-II, 3.5, E-VI, 2.2.2 and E-VI, 2.2.3.

Art. 116

If the opposition division considers it expedient, or if any party requests oral proceedings, oral proceedings in accordance with Art. 116(1) will be held before the opposition division after suitable preparation (see D-VI, 3.2). In the oral proceedings, the parties may state their cases and make submissions in order to clarify outstanding questions. Members of the opposition division may put questions to the parties.

Rules 117 to 120

In special, less common cases it will occasionally prove necessary in opposition proceedings for oral evidence to be taken by the opposition division as part of oral proceedings or for the conservation of evidence, or by the primary examiner outside the oral proceedings. The opposition division is not obliged to take oral evidence if it does not consider it necessary, even if a party has so requested. Oral evidence may be taken, where appropriate under oath, before the competent court in the country of residence of the person to be heard. A member of the opposition division may, at the request of the opposition division, attend such court hearings (see E-IV, 1.3).

The principal means of taking oral evidence will be the hearing of witnesses and parties (see E-IV, 1.6).

Only in exceptional cases will evidence be obtained at the initiative of the opposition division by means of oral and/or written reports by experts (see E-IV, 1.8.1) or by carrying out an inspection (see E-IV, 1.2, last paragraph). In view of the specialised knowledge of the members of the opposition division – and of the costs involved – such means will be used only as a last resort.

2. Adherence to the text of the European patent submitted or approved by the patent proprietor

2.1 Basis for the examination

Art. 113(2)

If the patent proprietors submit amendments to the description, claims or drawings after the notice of opposition has been communicated to them (see H-II, 3), the opposition division must take as a basis for its examination the text of the European patent submitted by the patent proprietors. This principle, that the opposition division must concern itself solely with the text most recently "submitted or agreed by the patent proprietor", also applies to the rest of the opposition procedure. (As regards the possibility of amending texts, see H-IV, 3.1, second paragraph.)

2.2 Revocation of the patent

Where it is stated that the patent proprietor no longer approves the text in which the patent was granted and no amended text is submitted, the patent must be revoked. This also applies when the patent proprietor requests that the patent be revoked.

3. Invitation to file observations

3.1 Opposition division's communications

Art. 101(1)
Rule 81(2)

In examining the opposition, the opposition division will invite the parties, as often as is necessary, to clarify the substance of the case, to file observations on communications from another party or issued by itself (see E-II, 1) and, where appropriate, to adduce evidence in respect of matters under dispute. Rule 81(2) does not require the opposition division to set a period for replying to this invitation. Such a period will, however, be set whenever the opposition division considers this expedient. As regards the length of the period see E-VIII, 1.2, as regards the extension of a period see E-VIII, 1.6, and as regards late submission of observations see E-VIII, 1.7 and E-VIII, 1.8, as well as Art. 114(2).

Rule 81(2)

Communications from the opposition division and all replies thereto must be communicated to all parties.

3.2 Summons to oral proceedings

Art. 116(1)
Rule 115(1)

If oral proceedings have to be arranged, the parties must be summoned to them as quickly as possible at reasonable notice (see E-III, 6). If the first action of the opposition division is to summon the parties, the first substantive communication of the opposition division under Art. 101(1) is annexed to the summons to oral proceedings. For the form of oral proceedings, see E-III, 5 and E-III, 11.

Rule 116(1)

Together with the summons, the opposition division will draw attention to and in the annexed communication explain the points which in its opinion need to be discussed for the purposes of the decision to be taken; where this has already been done sufficiently in a prior communication, it is appropriate to refer to that communication. Normally, the annexed communication will also contain the provisional and nonbinding opinion of the opposition division on the positions adopted by the parties and in particular on amendments filed by the patent proprietor. At the same time, a

date will be fixed up to which written submissions may be made or amendments may be filed. Normally this date will be two months before the date of the oral proceedings. As this date is not a time limit, Rule 132 does not apply and the parties cannot request to postpone it.

The summons to oral proceedings and the annexed communication do not constitute decisions within the meaning of Art. 106(1) and can thus only be appealed together with the final decision (see T 1954/14) unless either of them allows a separate appeal to be filed (see E-X, 3).

4. Communications from the opposition division to the patent proprietor

4.1 Communications from the opposition division; reasoned statement

Rule 81(3)

Where necessary, any communication to the patent proprietor must contain a reasoned statement. This also applies to any communication to other parties which is communicated to the proprietor of the patent for information only. A reasoned statement will usually not be required if the communication concerns only matters relating to form or if it contains no more than self-explanatory proposals. Where appropriate, all the grounds against the maintenance of the European patent are to be given in the communication.

4.2 Invitation to file amended documents

Rule 81(2) and (3)

If the opposition division considers that the European patent cannot be maintained in an unamended form, it must inform the patent proprietors accordingly, stating the grounds, and give them the opportunity to amend, in appropriate cases, the description, claims and drawings. As regards the time limit here, see E-VIII, 1.2. Where necessary, the description adjusted in line with the new claims will also deal with the state of the art as set out in the opposition proceedings, the technical purpose and the advantages of the invention as it will then stand. However, if the patent proprietor has neither requested oral proceedings nor filed amendments (including any auxiliary requests), the patent can be revoked directly on the basis of the grounds, evidence and arguments on file (see also E-X, 1.1).

Proposals for amendment filed at a late stage in the proceedings may be disregarded (see T 406/86).

For amended documents, see H-III, 2.

5. Additional search

In exceptional cases, the opposition division, like the examining division, may on its own initiative cite new material relating to the state of the art and take it into account in its subsequent decision (see C-IV, 7.3). In the normal course of events, however, since the grant of the patent will have been preceded by a search into the subject-matter of the application by the search division, by the examining division and generally by the opponent(s), no additional search will be made. Only in exceptional cases will an additional search by the opposition division be set in train. Such a case might arise, for example, if in the opposition the main subject covered

by the patent shifts to elements of a dependent claim which were originally of subsidiary importance, to elements which were previously not set out in the claims, but only in the description, to individual features of a combination, or to sub-combinations, and there are grounds for believing that the original search did not extend to such elements or features and if no relevant document can be found quickly in the circumstances set out in C-IV, 7.3.

6. Examination of the opposition during oral proceedings

For details regarding the examination shortly before and during oral proceedings and the conduct thereof, see E-III, 8.

7. Preparation of the decision

7.1 General remarks

Art. 116(1)
Rule 117

If the opposition division does not consider it expedient to arrange for oral proceedings of its own motion (see E-III, 4 and below) or for the taking of evidence even where the latter is requested (see E-IV), and if no admissible request for oral proceedings has been received from a party (see E-III, 2), the decision must be reached on the basis of written proceedings. In this case there is no obligation to arrange for oral proceedings before a decision is reached.

If the case is decided on the basis of written proceedings, submissions filed after the decision has been handed over to the EPO internal postal service for remittal to the parties can no longer be considered, as from that moment the division cannot amend the decision (see G 12/91), except to the limited extent provided for in Rule 140 (see H-VI, 3.1).

The decision, whether or not preceded by oral proceedings or the taking of evidence, may be to revoke the patent (see D-VIII, 1.2), to reject the opposition (see D-VIII, 1.3) or to maintain the patent as amended (see D-VIII, 1.4).

7.2 Preparation of a decision to maintain a European patent in amended form

7.2.1 Procedural requirements

Art. 113

A decision to maintain the patent in amended form may be delivered only when the patent proprietor has approved the new text on the basis of which the opposition division intends to maintain the patent and the opponent has had sufficient opportunity to comment on the proposed new text.

Both prerequisites can be fulfilled during oral proceedings at which the opposition division establishes the text including the amended description and, if necessary, the amended figures. In written proceedings, the necessary opportunity to comment on the new text on the basis of which the opposition division intends to maintain the patent is given to the opponent when a communication is issued to the parties. Once these requirements have been met, a separate communication under Rule 82(1) is neither necessary nor appropriate (see G 1/88).

If the patent can be maintained in the amended form, the opposition division tries to obtain the patent proprietor's approval of the text in which the patent can be maintained and gives the opponent an opportunity to comment on it. An interlocutory decision can then be delivered.

If these requirements have still not been met and no oral proceedings are being held, a communication under Art. 101(1) must be issued. This also applies when it has been established in principle that the patent can be maintained in a particular form but a complete text expressly approved by the patent proprietor is not yet available.

The patent proprietor's approval of an amended version of the patent need not be given in a separate, express declaration; it may also be apparent from the circumstances, in particular from the fact that an amended version was filed or requested. This applies equally to versions which have been filed as an auxiliary request. (For the wording of documents in oral proceedings, see E-III, 8.11 and E-III, 8.11.1.)

Rule 82(1)

The patent proprietor's approval can also be obtained through a communication under Rule 82(1) in which the opposition division informs the parties that it "intends to maintain the patent as amended" and invites them to "state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent". If no objections are filed to the text thus notified, the patent proprietor is considered to approve of it.

A communication under Rule 82(1) can also be sent if the opposition division considers that the complete document expressly approved by the patent proprietor, on which the opponent has been able to comment, still requires amendments. However, these must not go beyond such editorial changes to the wording as appear absolutely necessary by comparison with the text most recently submitted or approved by the patent proprietor. The opposition division will draw attention to such amendments and state why they are required if they are not self-explanatory.

If within the period specified in the communication, or in a communication under Rule 82(1), the patent proprietor objects to the text in which the patent is to be maintained, the proceedings are continued. The European patent can be revoked in the subsequent proceedings if the patent proprietor objects to the text and fails to submit new, properly amended documents despite having been requested to do so.

If any opponent objects to the text communicated to them in which it is intended to maintain the patent, the opposition division will continue examining the opposition if it considers that the EPC prejudices the maintenance of the patent in the text initially envisaged.

7.2.2 Decision on the documents on the basis of which the patent is to be maintained

If the opposition division considers that the patent can be maintained on the basis of the text submitted or approved by the patent proprietor, and the opponent has had sufficient opportunity to comment on this text – either in

writing or during oral proceedings – as well as on the reasons decisive to the patent's maintenance, the opposition division will issue an interlocutory decision to the effect that the patent and the invention to which it relates meet the requirements of the EPC following the amendments made by the patent proprietor during the opposition proceedings.

If the patent can only be maintained on the basis of an auxiliary request, the decision has to contain a reasoned statement why the version of the main request (and any higher-ranking auxiliary request) does not meet the requirements of the EPC (see T 234/86).

A separate appeal under Art. 106(2) is allowed against this decision, which must be reasoned having regard to the grounds for opposition maintained by the opponent or taken up by the opposition division. The decision is delivered in all cases where a European patent is maintained in amended form, even if the opponent has approved of the text communicated by the opposition division or has not commented on it. In the former case, the decision is fairly brief, merely noting that in the light of the amended text the opponent no longer maintains the original grounds for opposition. If this decision is not contested, the ruling enshrined in it becomes final and as a result the documents can no longer be amended.

This interlocutory decision is intended to save the patent proprietor unnecessary translation costs arising from an amendment to the text in appeal proceedings. It nevertheless qualifies as a grant decision in the sense of G 1/10 and corrections can only be requested in the narrow ambit provided for in Rule 140 (see H-VI, 3.1).

7.2.3 Request for publishing fee, translations and a formally compliant version of amended text passages

Rule 82(2)

Once the interlocutory decision becomes final or the amended text in which the patent is to be maintained has been drawn up in opposition appeal proceedings, the formalities officer requests the patent proprietor

– to pay, within three months, the fee for publishing a new specification of the European patent;

– to file translations of any amended claims in the two official languages of the EPO other than the language of the proceedings; and

– to file a formally compliant verbatim version of amended text passages if in oral opposition proceedings the interlocutory decision of the opposition division under Art. 101(3)(a) and 106(2) or the board of appeal decision under Art. 111(2) has been based on documents not complying with Rule 49(8) (see E-III, 8.7).

If the European patent in the amended form contains different claims for different contracting states, a translation of all sets of claims – in the text communicated to the patent proprietor – into all official languages other than the language of the proceedings must be filed.

If the request under the first paragraph above is not complied with "in due time", the acts may still be validly performed within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this two-month period the prescribed surcharge is paid. If any of the acts is not performed within the period of grace, the formalities officer will issue a decision for revocation of the patent in accordance with Rule 82(3).

Rule 82(2) and (3)
Art. 2(1), item 9, RFees

8. Request to adjourn opposition proceedings

If a party requests adjournment of opposition proceedings for the sole reason of pending appeal or opposition proceedings of a patent family member (e.g. a parent application), the request will not be granted. The party will receive a communication from the opposition division indicating the reasons for its intention not to grant the request. This communication does not constitute an appealable decision under Art. 106(1) or Art. 106(2).

If oral proceedings take place and the request is maintained, the opposition division will address it at oral proceedings, giving the parties an opportunity to comment. After the oral discussion on adjournment, the opposition division will take a decision on the request.

Chapter VII – Details and special features of the proceedings

1. Sequence of proceedings

1.1 Basic principle

Examination of the admissibility of the opposition and preparation of the examination of the opposition will be commenced immediately after the notice of opposition has been received by the formalities officer or the opposition division (see D-IV, 1 and 3 and D-V, 1 and 2).

If during the rest of the proceedings the opposition division, on account of the amount of work in hand, is unable to process immediately all the oppositions submitted, the reference date for the sequence of tasks will, in principle, be the date on which the last observations in respect of which a time limit had been laid down were submitted by any of the parties, but may not be later than the date on which the time limit expired. Documents received unsolicited or not subject to a previously stipulated official time limit, in connection with official communications setting a time limit, will not affect the sequence of tasks unless they require a further early notification setting a time limit.

1.2 Exceptions

Notwithstanding D-VII, 1.1 above, oppositions are to be given priority:

(i) if the earlier examination proceedings were of considerably longer duration than usual;

(ii) if the opposition proceedings have already extended over a considerably longer period than usual;

(iii) if a party to the proceedings has submitted a reasoned request for accelerated processing in a case where an infringement action in respect of the European patent is pending before a national court of a contracting state, or if the EPO is informed by a national court or competent authority of a contracting state that infringement actions are pending (see the Notice from the EPO dated 17 March 2008, OJ EPO 2008, 221);

(iv) if other matters to be dealt with, e.g. divisional applications, hinge upon the final decision concerning the opposition; or

(v) if the next procedural step can be dealt with relatively quickly.

2. Request for documents

Documents referred to by a party to opposition proceedings must be filed together with the notice of opposition or the written submissions. A single copy of these documents is sufficient. If such documents are neither enclosed nor filed in due time upon invitation by the formalities officer, the opposition division may decide not to take any arguments based on them into account. *Rule 83*

In implementing this provision, the desired aim of speeding up the procedure will be borne in mind as much as the common interest in taking obviously relevant submissions into account.

Rule 53(3)

If during the opposition proceedings it becomes apparent that the previous application from which the opposed patent claims priority is not in an official language of the European Patent Office and the validity of the priority claim is relevant to the determination of the patentability of the subject-matter of the patent concerned, the opposition division will invite the patent proprietor to file a translation of that application into one of the official languages within a period to be specified. Alternatively, a declaration may be submitted that the European patent application on the basis of which the opposed patent was granted is a complete translation of the previous application. For the procedure for inviting the patent proprietor to file such a translation or declaration see A-III, 6.8, and F-VI, 3.4. Such an invitation is not to be issued if the translation of the previous application or the declaration was available to the European Patent Office and is to be included in the file of the European patent application under Rule 53(2).

Failure by the patent proprietor to supply a required translation or declaration in due time will lead to the priority right being lost. This will have the effect that the intermediate document(s) will become prior art under Art. 54(2) or Art. 54(3), as applicable, and therefore relevant for the assessment of patentability (see A-III, 6.8.3). The patent proprietor will be notified of this loss of rights (see A-III, 6.11). As a means of redress, the patent proprietor may request either re-establishment of rights under Art. 122 and Rule 136 (see E-VIII, 3) or a decision under Rule 112(2) (see E-VIII, 1.9.3).

3. Unity of the European patent

3.1 Basic principle

Art. 118

If the patent proprietors are not the same for different designated contracting states, the unity of the European patent in opposition proceedings will not be affected, since such persons are to be regarded as joint proprietors (see D-I, 6, second and third paragraphs).

In particular, the text of the European patent will be uniform for all designated contracting states unless otherwise provided for in the EPC (see D-VII, 3.2 and H-III, 4).

3.2 Factors affecting the unity of the European patent

The unity of the European patent in opposition proceedings will be affected if the previous patent proprietor and the person replacing them pursuant to Art. 99(4) in respect of a particular contracting state are not deemed to be joint patent proprietors (see D-I, 6). In this event, the opposition proceedings involving the different patent proprietors must be conducted separately. Since different requests may be submitted by the two patent proprietors (e.g. as regards amendments to the claims), the two sets of opposition proceedings may lead to different conclusions, e.g. as regards the text of the European patent or the scope of protection.

4. Procedure where the patent proprietor is not entitled

4.1 Stay of proceedings

Rule 78(1)

If third parties provide proof, e.g. a certificate from the court concerned, to the EPO during opposition proceedings or during the opposition period that they have opened proceedings against the patent proprietor for the purpose of obtaining a decision within the meaning of Art. 61(1), opposition proceedings are stayed by the Legal Division in accordance with Rule 14(1) EPC unless the third parties consent to their continuation. Such consent must be communicated in writing to the EPO and is irrevocable. However, the proceedings will be stayed only if the opposition division has deemed the opposition admissible.

If proceedings within the meaning of Art. 61(1) are instituted during the opposition period, a stay of proceedings will be possible only if a notice of opposition has been filed. Accordingly, the third party might have to file an opposition itself in order to benefit from a stay of proceedings under Rule 78.

The dates of stay and resumption of proceedings will be entered in the European Patent Register. The parties to the opposition proceedings are to be informed of the order staying the proceedings.

4.1.1 Date of the stay of proceedings

The proceedings are stayed on the date on which the EPO receives evidence that proceedings against the patent proprietor have been instituted. The requirements for valid institution of relevant proceedings are determined by national law (J 7/00).

4.1.2 Legal character and effect of the stay of proceedings

Stay of proceedings is a preliminary procedural measure *sui generis* which takes immediate effect as a preventive measure to preserve the third party's possible rights (J 28/94; J 15/06).

The patent proprietor will not be heard but may file a request for an appealable decision on the stay of proceedings.

Stay of proceedings means that the legal status quo existing at the time of ordering is maintained, i.e. neither the EPO nor the parties may validly perform any legal acts (J 38/92).

An automatic debit order ceases to be effective on the day on which a stay of the proceedings takes effect (see Point 11.1(c) AAD, Annex A.1 to the ADA, Supplementary publication 4, OJ EPO 2019, page 30). If the automatic debiting procedure is to be used again after resumption of the proceedings, a new automatic debit order is to be filed.

4.2 Continuation of proceedings

The date of the continuation of the proceedings and the legal basis for their continuation are to be communicated to the parties to the opposition proceedings.

4.2.1 Continuation after a final decision

Rule 14(2)
Rule 78(1)

Proceedings are resumed when evidence is provided that a final decision within the meaning of Art. 61(1) has been taken. If the decision is in favour of the third party, the proceedings may not be resumed earlier than three months after the decision has become final, unless the third-party requests resumption.

4.2.2 Continuation regardless of the stage reached in national proceedings

Rule 14(3)
Rule 78(1)

When giving a decision on the stay of proceedings or thereafter, the Legal Division may set a date on which it intends to continue the proceedings, regardless of the stage reached in the national proceedings.

Unlike the decision on staying the proceedings, it is at the discretion of the Legal Division to decide whether proceedings are to be resumed. In exercising this discretion, the Legal Division has to take into account the impact of a further suspension or the continuation of the proceedings on each of the parties (J 33/03). Some aspects to be taken into account when exercising this discretion are the duration of the stay and the outcome of first instance proceedings before national courts. Likewise, it will be considered whether delaying tactics are being employed by the third party.

4.3 Interruption of time limits

Rule 14(4)
Rule 78(1)

The time limits in force at the date of stay are interrupted by the stay of proceedings. The time which has not yet elapsed begins to run as from the date on which proceedings are resumed; however, the time still to run after the resumption of the proceedings must not be less than two months.

Example:

A communication under Rule 82(2) maintaining the patent in amended form is despatched by the EPO on 24.01.2018. Under Rule 126(2) and Rule 131(2), this communication is deemed delivered on 03.02.2018. The three-month period to pay the publication fee and file the translation of any amended claim starts on the day following delivery of the communication, i.e. on 04.02.2018, and it ends on 03.05.2018.

If proceedings are stayed under Rule 14(1) by the Legal Division on 23.02.2018, the three-month period has elapsed from 04.02.2018 to 22.02.2018 before the event of the staying of the proceedings, i.e. 19 days have already passed and the period remaining is 9 days and 2 months. Since the remaining period is longer than two months, under Rule 14(4) it will run after the resumption of the proceedings.

Hence, if the proceedings are resumed by the Legal Division on 07.06.2018, the period for paying the publication fee and filing the translation of the claims runs until 16.08.2018 for the following reasons:

(i) the day of resumption of the proceedings by the Legal Division (07.06.2018) is the first day on which the remaining period starts running again (Rule 131(2) does not apply).

(ii) The remaining days are added first and then the remaining months: in the example, 9 days from and including 07.06.2018 results in 15.06.2018, and the addition of another 2 months results in the remaining period expiring on 15.08.2018.

(iii) Since Rule 134(1) applies also to the remaining period and since on the 15.08.2018 no mail is delivered in Munich (public holiday), the time limit is extended until 16.08.2018.

4.4 Department responsible

The Legal Division is responsible for the procedure where the patent proprietor is not entitled (see the Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). *Art. 20*

5. Continuation of the opposition proceedings in the cases covered by Rule 84

5.1 Continuation in the case of surrender or lapse of the patent

If the European patent has been surrendered or has lapsed for all the designated states, the opposition proceedings must be continued at the request of the opponent filed within two months after the date on which the opposition division informed the opponent of the surrender or lapse. Evidence of the lapse must generally be provided by submitting extracts from the Patent Registers of the designated contracting states. *Rule 84(1)*

Surrender or lapse has immediate nonretroactive effect (i.e. patent protection ceases on the date of surrender or lapse), whereas a revoked patent is deemed to have had no effect from the outset (Art. 68). So the opponent may still have an interest in the revocation of a lapsed or surrendered patent.

If, in the case of a request for continuation of the proceedings, the patent proprietor has renounced before the competent authorities in the designated states all rights conferred by the patent with *ab initio* and universal effect, or if no request for continuation has been received within the time limit, the opposition proceedings will be closed. The decision to close the proceedings will be communicated to the parties.

A statement by the patent proprietors making it unambiguously clear that they no longer wish their patent to be maintained is considered to be a request for its revocation, irrespective of the wording used (T 237/86). For details of the procedure to be followed, see D-VIII, 1.2.5.

5.2 Continuation on the death or legal incapacity of the opponent

In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the opposition division of its own motion, even without the participation of the heirs or legal representatives, for example if the legal proceedings in connection with the will or the appointment of a new legal representative would inordinately prolong the opposition proceedings. This provision will apply not only where only one opposition has been filed: it will also apply in cases where not all those who have filed opposition are deceased or legally incapacitated. *Rule 84(2)*

The opposition division will continue the proceedings if, for instance, the patent proprietor has submitted amendments to the patent in response to the notice of opposition (see T 560/90). The opposition division will also continue the proceedings if it considers that the stage reached in the opposition proceedings is such that they are likely to result in a limitation or revocation of the European patent without further assistance from the opponent(s) concerned and without the opposition division itself having to undertake extensive investigations (see T 197/88).

The patent proprietor and any other parties are to be informed that the proceedings will be continued. Otherwise the proceedings are closed and the decision to close the proceedings is communicated to the parties.

5.3 Continuation after the opposition has been withdrawn

Rule 84(2)

The opposition proceedings can be continued even if every opposition has been withdrawn. The principles set forth in D-VII, 5.2 apply *mutatis mutandis* in deciding whether the proceedings are to be continued or closed.

6. Intervention of the assumed infringer

Art. 105
Rule 89

Assumed infringers of a patent (see D-I, 5) may file notice of intervention in the opposition proceedings within three months of the date on which infringement proceedings were instituted against them or on which they instituted proceedings for a court ruling that they are not infringing the patent. Notice of intervention must be filed in a written reasoned statement. It is not deemed to have been filed until the opposition fee has been paid in the amount prescribed in the Rules relating to Fees under the EPC.

Intervention is permissible as long as opposition or appeal proceedings are pending. A third party can become a party to the proceedings during the period for filing an appeal only if a party to the proceedings in which the decision was given files an appeal pursuant to Art. 107; otherwise the decision of the opposition division will become final on expiry of the appeal period (see G 4/91 and G 1/94).

A properly filed and admissible intervention is treated as an opposition, which may be based on any ground for opposition under Art. 100 (see G 1/94). This means that, when intervening at any stage of first-instance proceedings, the intervener enjoys essentially the same rights as any other party to the proceedings. If the intervener introduces new facts and evidence which appear to be crucial, the proceedings may need to be prolonged to enable them to be adequately considered. In all other cases the opposition division must ensure that the intervention does not delay the proceedings.

Rule 79(4)

If the notice of intervention is filed at a late stage of the proceedings, for example when oral proceedings have already been scheduled, the opposition division may dispense with issuing communications under Rule 79(1) to Rule 79(3). The introduction of a new ground for opposition at such a late stage may lead to a postponement of the date set for oral proceedings.

For accelerated processing of oppositions and accelerated processing before the boards of appeal on request, see E-VIII, 5 and E-VIII, 6.

The notice of intervention, filed in a written reasoned statement, must contain: *Rule 89(2)*

(i) a statement of the grounds for intervention and corresponding evidence. The proceedings providing the grounds for intervention must be directed towards establishing an infringement (or its absence) as a final legal result. Proceedings directed at the preservation of evidence to enable a party to initiate separate infringement proceedings are not sufficient in this regard (see T 439/17). *Art. 105(1)*

(ii) the name, address and nationality of the assumed infringer and the state in which the assumed infringer's residence or principal place of business is located. Names of natural persons must be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, must be indicated by their official designations. Addresses must be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They must comprise all the relevant administrative units, including the house number, if any. Assumed infringers (whether natural or legal persons) whose residence or principal place of business is in an EPC contracting state and who act without a professional representative can use an address for correspondence other than their residence. The address for correspondence must be the assumed infringer's own address. Post cannot be sent to a different (natural or legal) person, since that requires a valid form of representation under Art. 133 and 134. It is recommended that the telephone and fax number be indicated (see D-IV, 1.2.2.2(i) and 1.4.2); *Rule 76(2)(a)* *Rule 41(2)(c)*

(iii) the number of the European patent at issue in the opposition proceedings in which intervention is made, the name of the patent proprietor and the title of the invention (see D-IV, 1.2.2.2(ii) and 1.4.2); *Rule 76(2)(b)*

(iv) a statement of the extent to which the European patent at issue is opposed by way of intervention and of the grounds on which the opposition by way of intervention is based, as well as an indication of the facts and evidence presented in support of these grounds, together with a statement of reasons, i.e. arguments (see D-IV, 1.2.2.1(iii) to 1.2.2.1(v) and 1.4.2); *Rule 76(1)* *Rule 76(2)(c)*

(v) if the assumed infringer has appointed a representative, the representative's name and address of place of business in accordance with subparagraph (ii) as set out above (see D-IV, 1.2.2.2(iii) and 1.4.2). *Rule 76(2)(d)*

Rule 77(1)

D-IV, 1 sets out further details and explains how to deal with the intervention if one of these requirements is not fulfilled.

7. Publication of a new specification of the patent

Art. 103

If a European patent is maintained in an amended form, the EPO must, as soon as possible after it publishes the mention of the opposition decision, publish a new specification of the European patent containing the description, the claims and any drawings, in the amended form.

Rule 87

Rule 74 applies *mutatis mutandis* to the new specification of the European patent.

8. Transitional provisions for Art. 54(4) EPC 1973 and Art. 54(5)

Art. 54(4) EPC 1973 and Rule 23a EPC 1973 continue to apply to patents granted in respect of patent applications filed before 13 December 2007. Consequently, in such cases, the designated countries need to be taken into consideration when assessing the novelty of documents according to Art. 54(3) (see H-III, 4.2).

Art. 54(5) applies only to patents for which the date of the decision to grant the patent under consideration was taken on or after 13 December 2007 (Special edition No. 1, OJ EPO 2007, 197). If the decision to grant was taken before that date (the date of entry into force of EPC 2000), only "Swiss type" claims are allowed for any second or further medical use (provided these claims meet with all the other requirements of the Convention).

Where the subject-matter of a claim is rendered novel only by a new therapeutic use of a medicament, that claim may no longer take the form of Swiss-type claim for European or international patent applications having a filing date or earliest priority date of 29 January 2011 or later (see G 2/08, OJ EPO 2010, 514 and G-VI, 7.1).

Examples:

Date of entry into force of EPC 2000: 13.12.2007.

The decision to grant for patent EP1 mentions the date of 13.12.2007 in the top box and the date of 07.12.2007 in the bottom line.

EP1 has three claims.

Claim 1: Product X.

Claim 2: Product X for use in medicine.

Claim 3: Product X for use in the treatment of asthma.

Notice of opposition is duly filed in 2008 citing prior-art document D1 under Art. 54(2) EPC which reveals product X and its therapeutic use in the treatment of pain and more specifically headache.

The situation is as follows:

According to G 12/91 and J 7/96, published in OJ EPO 1999, 443, the date when the decision to grant the patent was taken is the date the decision to grant was handed over to the EPO postal service, that is 07.12.2007.

This means that, as regards medical use-related claims, EP1 is treated under the system applicable before EPC 2000's entry into force on 13.12.2007. Thus, Art. 54(5) EPC does not apply to EP1.

Therefore, in the opposition proceedings for EP1, claims 1-3 are no longer acceptable. Claims 1 and 2 are not novel and claim 3 is not in the required "Swiss-type" format for a second medical use (G 5/83). The proprietor of patent EP1 would then need to abandon claims 1 and 2 and reformulate claim 3 as: "Use of product X for the manufacture of a medicament for the treatment of asthma".

It is to be noted that if the date of handing the decision to grant over to the EPO postal service had been 13.12.2007 or later, then Art. 54(5) EPC would have been applicable and in the current example claim 3 of EP1 could have been maintained as granted.

Example of conflicting prior art:

The mention of grant for a patent EP1 filed on 10.12.2007, designating FR, DE, GB, IT and ES and claiming no priority, is published in the Bulletin in May 2012 and nine months later notice of opposition is filed. One of the novelty objections is raised under Art. 54(3) EPC with regard to a European patent application EP2 published on 18.12.2007, having a valid priority date of 16.06.2006 and validly designating FR, DE and GB. Oral proceedings in this case are held during 2013.

The situation is as follows:

EP1 was granted in respect of a patent application filed before the date of EPC 2000's entry into force (i.e. 10.12.2007). Consequently, as regards Art. 54(3) EPC, the provisions in force before that date apply. So in this case, Art. 54(4) and Rule 23a EPC 1973 still apply (in 2013). Therefore, EP2 is relevant for novelty only for the designations FR, DE and GB but not for the designations IT and ES.

Note that if EP1 had in this case been filed on 13.12.2007, Art. 54(4) and Rule 23a EPC 1973 would no longer be applicable when assessing novelty under Art. 54(3) EPC. Consequently, EP2 would be prior art against the novelty of EP1 as a whole, regardless of any common designations.

Chapter VIII – Decisions of the opposition division

General remarks on decisions appear in E-X.

1. Final decisions on an admissible opposition

1.1 General remarks

The opposition division has to take a final decision on the opposition, by revoking the European patent or rejecting the opposition or ruling that the European patent is to be maintained as amended. If the only admissible opposition or all the admissible oppositions are withdrawn and the opposition division takes the view that as the case stands there is no reason for the Office to continue the proceedings of its own motion, the proceedings are closed by means of a formal decision (Rule 84(2), second sentence).

1.2 Revocation of the European patent

1.2.1 Revocation on substantive grounds

If the opposition division is of the opinion that at least one ground for opposition as set out in Art. 100 prejudices the maintenance of the European patent, it will revoke the patent under Art. 101(2), first sentence. Analogously, if the opposition division is of the opinion that the patent as amended during the course of the opposition proceedings does not meet the requirements of the Convention, it will revoke the patent under Art. 101(3)(b).

Art. 101(2)
Art. 101(3)(b)

For revocation because the patent proprietor has not agreed to the text, see D-VI, 2.2 and D-VIII, 1.2.5.

1.2.2 Revocation for failure to pay the prescribed fee for publishing, to file a translation or to file a formally compliant version of amended text passages

Under Rule 82(2) in conjunction with (3), if the patent proprietor fails in due time to:

Rule 82(3)

(i) pay the prescribed fee for the printing of a new specification of the European patent,

(ii) file a translation of the amended claims in the two official languages of the EPO other than the language of the proceedings (see D-VI, 7.2.3), or

(iii) file a formally compliant verbatim version of the amended text passages (see E-III, 8.7.3),

the European patent will be revoked.

1.2.3 Revocation for failure to notify the appointment of a new representative

Rule 142(3)(a)

If opposition proceedings are interrupted according to Rule 142(1)(c) and the patent proprietor, who is not resident in one of the contracting states, does not forward a notification of the appointment of a new representative within the two-month period laid down in Rule 142(3)(a) (see E-VII, 1.4(i)), the European patent will be revoked.

1.2.4 Revocation in the event of requirements not being met until after expiry of time limits

In the cases referred to in D-VIII, 1.2.2 and 1.2.3, the European patent will be revoked even if the omitted acts have been completed during the period between expiry of the time limit and the taking of a final decision, unless a request for re-establishment of rights has been filed, in which case a decision must first be given on the request.

1.2.5 Revocation of the patent in the event that the patent proprietor no longer wishes the patent to be maintained as granted

If patent proprietors state that they no longer approve the text in which the patent was granted and do not submit an amended text, the patent must be revoked pursuant to Art. 101 (see T 203/14 and T 2405/12). This also applies when the patent proprietor requests the patent to be revoked.

If patent proprietors unambiguously declare to the EPO the surrender (or abandonment or renunciation) of the patent, this is interpreted as equivalent to a request that the patent be revoked (see T 237/86). If the request of the patent proprietors is not unambiguous, they are given the opportunity to request that the patent be revoked or to declare that they no longer approve of the patent being maintained as granted. This results in the patent being revoked.

1.3 Rejection of the opposition

Art. 101(2)

If the opposition division is of the opinion that the grounds for opposition mentioned in Art. 100 do not prejudice the maintenance of the European patent unamended, it will reject the opposition.

1.4 Maintenance of the European patent as amended

1.4.1 Taking of a final decision

Art. 101(3)(a)
Rule 82(1) and (2)

If the opposition division is of the opinion that, taking into consideration the amendments made by the patent proprietor during the opposition proceedings, the patent and the invention to which it relates meet the requirements of the EPC, it will issue an interlocutory decision to maintain the European patent as amended.

The procedure specified in D-VI, 7.2.1 to 7.2.3 will precede the final decision.

1.4.2 Statement in the decision of the amended form of the European patent

The decision must state which text of the European patent forms the basis for maintaining it. *Rule 82(4)*

2. Other decisions

2.1 Decision on the inadmissibility of an opposition or intervention

See D-IV, 3 and 5.5 with reference to the notice of opposition and D-IV, 5.6 and D-VII, 6 for the intervention of an assumed infringer.

2.2 Decisions which do not terminate proceedings

Such decisions are dealt with in E-X, 3.

See D-VI, 7.2.2 with reference to the maintenance of a patent with amended documents.

2.3 Decision on a notified loss of rights at the request of the person concerned

This decision is dealt with in E-VIII, 1.9.3. *Rule 112(2)*

2.4 Decision on re-establishment of rights

This decision is dealt with in E-VIII, 3.3.

2.5 Decision on closure of the opposition proceedings

This decision is dealt with in D-VII, 5 and D-VIII, 1.1.

Chapter IX – Costs

1. Charging of costs

1.1 General principle

Each party to the proceedings must bear the costs it has incurred. However, an opposition division may, for reasons of equity, order a different apportionment of such costs, which may have been incurred during the taking of evidence, in oral proceedings or under other circumstances.

Art. 104(1)
Rule 88

The phrase "taking of evidence" refers generally to the receiving of evidence by an opposition division, whatever the form of such evidence. It includes among other things the production of documents and sworn statements in writing as well as hearing witnesses (see T 117/86).

1.2 Decisions on the apportionment of costs

Apportionment of costs must be dealt with in the decision on the opposition. This apportionment will form part of the main decision and will be incorporated in the operative part of the decision.

Rule 88(1)

The decision will deal only with the obligation on the party or parties concerned to bear costs. The actual amounts to be paid by one party to another must be dealt with in the decision on the fixing of costs (see D-IX, 2).

A statement that the parties will bear their own costs may be incorporated in the grounds for the decision on the opposition and must be included in cases where one of the parties to the proceedings has submitted a request for a decision on the apportionment of costs which the opposition division does not consider justified.

A decision to apportion costs may be made by the opposition division of its own motion, even if no application for the apportionment of costs has been made.

In the absence of an express decision on the apportionment of costs, each of the parties concerned must bear its own costs.

1.3 Costs to be taken into consideration

Apportionment of costs may relate only to those expenses necessary to assure proper protection of the rights involved.

Rule 88(1)

Examples of such expenses are:

Art. 104(1)

(i) expenditure incurred in respect of witnesses and experts, together with other costs arising in connection with the taking of evidence;

(ii) remuneration of the representatives of the parties in respect of oral proceedings or the taking of evidence;

(iii) remuneration of the representatives of the parties in respect of undue delaying of the procedure by one of the parties or in respect of the late filing of documents; and

(iv) expenditure incurred directly by the parties, i.e. their travel expenses in coming to oral proceedings or the taking of evidence.

Costs incurred in respect of superfluous or irrelevant evidence, etc., cannot be apportioned.

In the order of apportionment as part of its decision, the opposition division will state the kind of costs to be differently apportioned and reimbursed to the receiving party as clearly and precisely as possible.

1.4 Principle of equity

Reasons of equity will require an opposition division to decide on issuing an order to apportion costs when the costs arise in whole or in part as a result of conduct of one party which is not in keeping with the care required to assure proper protection of the rights involved, in other words when the costs are culpably incurred as a result of irresponsible or even malicious actions. Parties may of course defend their rights or interests (e.g. the proprietors defend their patent) by any legally admissible means within the framework of the opposition proceedings; they may, for example, request oral proceedings or the taking of evidence.

Accordingly, costs incurred as a result of default or of inappropriate legal means used by either party may be charged to the party responsible, even if that party has been successful in the opposition proceedings. Situations resulting from "*force majeure*" (such as absence at oral proceedings due to a sudden serious illness) do in general not lead to the apportionment of costs.

The following are examples where the principle of equity may be applied:

The costs incurred by the opponent in preparing oral proceedings which have been appointed may be charged to patent proprietors if the latter surrender the patent just before the date appointed for the oral proceedings, although it was clear when the proceedings were being arranged, from a document put forward by the opponent, that the patent proprietors had no case and that they alone were therefore liable for their irresponsible conduct.

If an aspect of the state of the art is adduced as an argument at a late stage and it can be shown, or it is evident, that the party concerned knew of it earlier, e.g. in that the party in question had made prior use of it, the additional costs of further oral proceedings unnecessarily incurred by the other parties may be charged to the party which caused them by submitting this argument at such a late stage.

If relevant facts or evidence are submitted by a party only at a late stage of the proceedings without any good reason and if, as a consequence,

unnecessary costs are incurred by another party, the opposition division may decide on the apportionment of costs.

2. Procedure for the fixing of costs

2.1 Fixing of costs by the opposition division

The formalities officer is entrusted with fixing the amount of the costs to be paid to the beneficiary at the request of at least one party. The request from a party to the proceedings to fix the costs is admissible only if the decision in which the apportionment of costs was ordered has become final. *Art. 104(2)* *Rule 88(2)*

A list of costs, with supporting evidence in respect of each amount involved, must be attached to the request. Costs may be fixed once their credibility is established. *Rule 88(2)*

The parties will be notified of the costs as fixed by the formalities officer acting for the opposition division. *Art. 119*

For an explanation of the duties entrusted to the formalities officers, see D-II, 7.

2.2 Appeal against the fixing of costs by the opposition division

The communication in which the formalities officer has fixed the costs may be reviewed if requested by one of the parties to the proceedings. The opposition division will then issue an appealable decision.

The request for such a decision, stating the reasons on which it is based, must be filed with the EPO in writing within one month after the date of notification of the communication in which the costs have been fixed. This request is not deemed to be filed until the fee for the request of a decision to be issued by the opposition division on the costs as fixed has been paid at the rate prescribed in the Rules relating to Fees under the EPC. *Rule 88(3)*

The opposition division will take a decision on the request without oral proceedings. *Rule 88(4)*

This final decision by the opposition division can be appealed by each party adversely affected. The appeal will only be admissible if the amount fixed exceeds the appeal fee. *Rule 97(2)*

3. Enforcement of the fixing of costs

Any final decision of the EPO fixing the amount of costs must be dealt with, for the purpose of enforcement in the contracting states, in the same way as a final decision given by a civil court of the state in the territory of which enforcement is to be carried out. Verification of any such decision must be limited to its authenticity. *Art. 104(3)*

"Decision" as referred to above also covers the final fixing of costs by the opposition division.

Chapter X – Limitation and revocation procedure

1. Introduction

The limitation and revocation procedures are centralised *ex parte* procedures at the level of the EPO which allow the patent proprietor either to have the claims of the granted patent limited or to have the whole patent revoked for all the designated states. More particularly, the limitation procedure offers an opportunity to obtain a limitation of a European patent in a short and straightforward procedure.

Unlike in the opposition procedure, there is no restriction on the period between the grant of the patent and the filing of the request. Accordingly, the request can be filed at any time after grant, after opposition proceedings, or even after expiry of the patent.

The examining division is competent to decide on requests for limitation and revocation. However, certain aspects of this procedure are entrusted to formalities officers (see Decisions of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6, and 23 November 2015, OJ EPO 2015, A104). *Rule 91*

2. Examination for deficiencies in the request

2.1 Deficiencies which lead to the request being deemed not to have been filed

On receipt of a request for revocation or limitation of a patent, the formalities examiner will examine whether: *Art. 105a*

(i) the request is filed with the EPO (Art. 105a(1))

(ii) opposition proceedings in respect of the patent are not pending at the time of filing the request (Art. 105a(2) and Rule 93(1))

(iii) the relevant fee is paid (Art. 105a(1) and Art. 2(1), item 10a, RFees)

(iv) where the request is filed in a language according to Art. 14(4), the translation has been filed in due time (Rule 6(2))

(v) where the requester is required by Art. 133(2) to appoint a representative, this was done in due time (Rule 152 (3) and (6)).

If any of these requirements are not met, the request is deemed not to have been filed. This finding is notified to the requester (Art. 119), and the fee is refunded.

Otherwise, the request is considered to have been filed, and the limitation/revocation procedure commences.

2.2 Deficiencies which, if not remedied, lead to the request being rejected as inadmissible

Rule 92

The formalities officer will furthermore examine whether:

(i) the request is filed in writing (Rule 92(1))

(ii) the request includes the particulars of the requester required by Rule 92(2)(a), referring to Rule 41(2)(c)

(iii) the request indicates in which contracting states the requester is the patent proprietor (Rule 92(2)(a))

(iv) the request indicates the number of the patent to be limited or revoked (Rule 92(2)(b))

(v) the request indicates in which contracting states the patent has taken effect, even if in the meantime it has lapsed in one or more of those contracting states (Rule 92(2)(b))

(vi) in cases (iii) and (v), and if the requester is not the patent proprietor for all these contracting states, the requester provides the names and addresses of the other patent proprietors, and evidence of entitlement to act on their behalf (Rule 92(2)(c)); due to the retroactive effect of a limitation/revocation (Art. 68), such evidence is required also in the case where the patent has lapsed in one or more of the contracting states referred to under (v) in the meantime. Note that in the case of joint patent proprietors, whether for the same or different contracting states, the requirements of Rule 151 for appointment of a common representative also apply in the limitation or revocation procedure (see A-VIII, 1.3).

(vii) where limitation is sought, the request includes the complete version of the amended claims (and of the description and drawings where applicable) (Rule 92(2)(d))

(viii) if the requester has appointed a representative, the particulars according to Rule 41(2)(d) (Rule 92(2)(e)) have been filed.

Rule 94

If any of the above requirements are not met, the requester is invited to correct the deficiencies within a period to be specified.

If the deficiencies are not corrected within this period, the request is to be rejected as inadmissible. This decision is notified to the requester (Art. 119). Re-establishment of rights under Art. 122 is, however, available. The decision rejecting the request is open to appeal (Art. 106(1)).

Otherwise, the request is deemed admissible.

3. Decision on request for revocation

Art. 105b(2)
Rule 95

If the request is for revocation, and is admissible, the examining division will revoke the patent and communicate this to the requester (Art. 105b(2) and Rule 95(1)). The decision takes effect on the date on which it is published

in the Bulletin (Art. 105b(3)). In accordance with Art. 68, the effect of the decision is that the patent is revoked *ab initio*, conferring no rights under Art. 64 or 67. As stated in Art. 105b(3), the decision applies to all contracting states in respect of which the patent was granted. It is not possible for the patent to be revoked only for some contracting states, and not for others.

4. Substantive examination (limitation)

4.1 Department responsible

If a request for limitation is deemed to be admissible, then the file will be forwarded to the examining division, as the department responsible for the examination of the request. *Rule 91*

4.2 Basis for the examination

The basis for the examination is the patent as granted or amended in opposition or limitation proceedings (Rule 90). In cases in which there have already been both opposition and limitation procedures, or more than one limitation procedure, the basis for the examination is the patent as amended in the most recent of those procedures. *Rule 90*

The requester has the option of providing information (with the request, or later in the procedure) as to why the request is allowable, and/or as to the purpose behind the request, but there is no obligation to do so. The purpose underlying the request is, however, of no relevance to the question whether it is allowable.

4.3 Scope of the examination

The scope of the examination is limited by Rule 95(2). The examining division is required to decide only whether the amended claims of the request constitute a limitation with respect to the claims as granted or amended (i.e. those referred to in D-X, 4.2), and whether the amended claims comply with the requirements of Art. 84 and Art. 123(2) and (3). *Rule 95(2)*

The term "limitation" is to be interpreted as meaning a reduction in the extent of protection conferred by the claims. Mere clarifications or changes made to protect a different subject ("*aliud*") are not to be considered as limitations.

More particularly, the limitation of a dependent claim only, without any independent claim being limited, is acceptable. However, it is not permissible to introduce non-limiting amendments in the description or in the claims that are not a consequence of the limitation of the claims (for example tidying up unclear claims, making amendments to improve the patent or cosmetic changes). Likewise, adding dependent claims in limitation is not permissible if not directly caused by the limitation introduced in the claims.

Amendments in a claim leading to a scope of protection which is smaller but falls partly outside the extent of protection conferred by the claim previously on file must be dealt with cautiously. Even if the amendment constitutes a limitation, such a claim would generally contravene Art. 123(3)

(see also H-V, 7, for Art. 123(3) in the case of a change of category of a claim).

Art. 69(1)

For interpretation of Art. 84 and Art. 123(2), see F-IV, 4 and H-IV, 4.4. The description and drawings are used to interpret the claims in accordance with Art. 69(1) and its Protocol on Interpretation. Amendments made to these parts might therefore introduce matter contrary to Art. 123(3) (see H-IV, 3.1 and 3.3).

Rule 139

For the admissibility of a request for correction under Rule 139 of the documents making up the patent, see H-VI, 2.1.1.

The filing of auxiliary requests together with a main request is possible (see H-III, 3).

4.4 Further stages of the examination

If the examination under D-X, 4.3 above leads to the conclusion that the request is allowable, then the next stage of the procedure – the establishment of the formal requirements for limitation as described under D-X, 5 can begin. Otherwise, in accordance with Rule 95(2), a communication must be sent to the requester identifying the deficiencies and giving the opportunity to correct them within a period to be specified. The normal period is two months (Rule 132(2)). It is, in principle, extendable, but only under exceptional circumstances.

The division may not adapt the description of its own motion (see D-X, 5). In the case of discrepancy between the claims and the description, an objection will always be raised.

If the requester responds in due time in a manner such that no objections remain, then the procedure continues as in D-X, 5.

Rule 95(2) provides for only one opportunity to make amendments during limitation. However, if the response to the communication under Rule 95(2) overcomes the objections raised in that communication, but gives rise to new objections, the fundamental principle of the right to be heard under Art. 113(1) will normally make a further communication necessary in order to communicate the new objections to the requester before the decision to reject the request for limitation is issued (see D-X, 6). Normally, no further amendments may be made in reply to that communication.

Rule 95(2) specifies that the examining division must give the requester one opportunity to correct the deficiencies. However, any request for oral proceedings according to Art. 116 will be granted if the division does not consider the request for limitation to be allowable. No further amendments may be submitted during oral proceedings if the opportunity to make amendments has already been taken.

4.5 Third-party observations during the examination

Art. 115
Rule 114

Art. 115 explicitly covers all proceedings before the EPO, not just pre-grant proceedings. Accordingly, its provisions also apply in principle to revocation and limitation proceedings. Patentability under Art. 115 is to be interpreted

in a broader sense, so that issues relating to Art. 84 and Art. 123(2) may also be taken into consideration. Requesters could, when responding to an invitation under Rule 95(2), introduce further restrictions intended to address such observations. If they wish to do this, and no invitation under Rule 95(2) is issued, their only option is to file a further request for limitation.

5. Formal procedure for limitation when the request is allowable

If the request for limitation is allowable, then according to Rule 95(3) the examining division must communicate this to the requesters and invite them to pay the prescribed fee and file translations of the amended claims into the other two official languages within a period of three months.

Rule 95(3)
Art. 2(1), item 8 and item 9, RFees

The nature of the communication under Rule 95(3) inviting the requester to pay the prescribed fee and file translations of the claims is different from the communication of the intention to grant during examination proceedings under Rule 71(3). During limitation, the text filed by the requester is deemed to be approved, whereas at this stage in examination the text is a version proposed to the applicants and subject to their approval.

Once the communication under Rule 95(3) is received, the requester can only pay the fee and file the translations or have the request rejected for failure to do so. Therefore, the examining division may not, with the communication under Rule 95(3), make amendments of its own motion to the claims of a request for limitation in order to render them allowable or adapt the description of its own motion to the limited claim(s). The provisions of Art. 113 would not be met, since the requester does not have an opportunity to contest or comment on the amendments made.

As in opposition proceedings, the requester benefits from a two-month period of grace for reply with payment of a surcharge (Art. 2(1), item 9, RFees). Reestablishment of rights is available.

If the requester pays the fee and files the required translations in due time, the examining division will decide to limit the patent (Art. 105b(2) and Rule 95(3), last sentence). This takes effect on the date on which the mention of the decision is published in the Bulletin.

Art. 105b(2) and (3)

As soon as possible after this, the amended specification will be published by the EPO. The form of publication of the amended patent specification is defined in Rule 96, Rule 73(2) and (3) and Rule 74. The procedure for this is the same as in opposition proceedings.

Art. 105c

As for revocation (see D-X, 3), the effect of the decision to limit the patent is that the patent is limited *ab initio*.

Art. 68

6. Rejection of the request

If:

(i) the requester does not respond in due time to the invitation under Rule 95(2) (see D-X, 4.4 above); or

(ii) the requester responds in due time, but the request is still not allowable; or

(iii) the requester fails to pay the fee(s) and file the translation according to Rule 95(3) (see D-X, 5 above),

then the examining division will reject the request (Art. 105b(2), last sentence and Rule 95(4)), provided the requirements of Art. 113(1) are met (see D-X, 4.4).

The decision to reject the request will be notified in accordance with Art. 119 to the requester.

Rule 111(2)
Art. 106(1)

In case (ii), the decision is a reasoned decision taken by the examining division and is subject to appeal.

7. Relation to opposition proceedings

7.1 Precedence of opposition proceedings

Rule 93(1)

The case in which opposition proceedings are already pending when the request for revocation or limitation is filed has been mentioned in D-X, 2.1. In the opposite case, i.e. where an opposition is filed while revocation or limitation proceedings are pending, the procedure depends on whether the pending proceedings relate to a request for revocation or for limitation.

Rule 93(2)

According to Rule 93(2), if the pending proceedings relate to a request for limitation, the examining division will terminate those proceedings and order the reimbursement of the limitation fee. The limitation procedure is terminated on the day the decision on the limitation procedure is handed over to the internal EPO postal service. If the requester has already paid the fee referred to in Rule 95(3) (see D-X, 5), this fee will also be refunded. The opposition procedure will then continue in the normal manner.

The decision to terminate the limitation proceedings is notified to the requester (Art. 119).

Rule 93(2) is restricted to limitation proceedings. Therefore, in the case of revocation proceedings, there is no precedence of opposition. Revocation proceedings continue after an opposition is filed, and the case proceeds to opposition only if the request for revocation is deemed not to have been filed, is rejected as inadmissible or is withdrawn. Otherwise, if the patent is revoked, the opponent(s) will be informed of this situation and the opposition proceedings will be terminated.

7.2 Filing of opposition after decision on limitation

On rare occasions it may happen that the limitation procedure is finished before an opposition is filed within the nine-month period and the decision to limit has already been published in the European Patent Bulletin. In such cases the opponent does not benefit from a new nine-month period, since the opposition period runs only once from publication of the mention of the grant of the patent. Accordingly, the opponent will not have a full nine-month period to formulate the opposition for the patent as limited.

8. Legal status of decisions

The decisions rejecting the request for limitation or revocation as either inadmissible or not allowable (see D-X, 2 and 6) are open to appeal, as they are decisions of the examining division terminating a procedure. Accordingly, they are decisions listed as such in Art. 21(3)(a). *Art. 106(1)*

9. Withdrawal of the request

In the absence of any provision to the contrary and in accordance with normal legal principles, the requester may withdraw the request for limitation or revocation at any time, provided that the request is still pending. In this case, however, the limitation or revocation fee will not be refunded.

10. Different sets of claims

Art. 105b(3) specifies that the decision to limit or revoke will apply to the patent in all contracting states for which it has been granted. There is thus a single decision, covering all contracting states, but this decision may include different sets of claims for different contracting states, or determine that the limitation is in other ways different for different contracting states. Such situations could arise in two different sets of circumstances. *Art. 105b(3)*

10.1 Limitation results in the claims becoming different in different contracting states

The limitation could result in the claims becoming different in different contracting states if the requester wishes to restrict the claims with respect to one or more, but not all, contracting states in order to avoid conflict with national prior rights. Such different sets of claims can be allowed, provided that the substantive requirements are met for all sets for which the requester is seeking an amendment.

It follows from Rule 138 that a prerequisite for the introduction of different claims for different contracting states during the limitation procedure is that requesters inform the EPO of the existence of the national prior rights when filing the different sets of claims. If they file different sets of claims without informing the EPO of the national prior rights, then the request is to be refused under Art. 105b(3) and Rule 138. *Rule 138*

For applications filed on or after 13.12.2007, different sets of claims can no longer be justified on the basis of prior art under Art. 54(3) (for transitional provisions, however, see D-VII, 8). *Art. 54(3)*

10.2 Limitation is different for different contracting states because the claims as granted were different for different contracting states

The limitation is different in different contracting states because the claims forming the basis of the limitation procedure were different in different contracting states. This situation would occur where the patent has different claims for different contracting states, e.g. because of national prior rights or prior art under Art. 54(3) (for patents granted before 13.12.2007 or for patents granted in respect of European patent applications pending at that time), or where under Art. 61 a partial transfer of rights has taken place (Rule 18(2)).

The requester might wish to apply a limitation already introduced for one or more contracting states to the other contracting states, or to bring the claims into line with each other for a different reason. If this results in a single set of claims for all contracting states, and the substantive requirements are met separately for each different set of original claims, then the request would be allowable.

Note that it would also be possible that the circumstances of this paragraph and paragraph D-X, 10.1 coexist in a single request.

11. Multiple requests

Rule 90

Rule 90 defines that the basis for the request can be the claims as amended in limitation proceedings, thus providing for multiple subsequent requests, i.e. a request for limitation or revocation following one or more earlier requests for limitation.

Part E

Guidelines on General Procedural Matters

Contents

Chapter I – Introduction

Part E contains guidelines for those procedural steps in respect of the examination of European patent applications and patents which without major variations may, in so far as the EPC permits, occur at a number of stages in the procedure. Attention is also drawn to Art. 125, which states: "In the absence of procedural provisions in this Convention, the EPO shall take into account the principles of procedural law generally recognised in the Contracting States".

Chapter II – Communications and notifications

1. Communications

1.1 General remarks

Communications are sent, *inter alia*:

(i) if a party has to be informed of deficiencies, together, where appropriate, with a request to remedy those deficiencies, e.g. in accordance with Rule 55, 58, 59, 62a, 63, 64(1), 71(1), 77(2), 95(2) or 108(2);

(ii) if a party is to be invited to file observations on particular questions or to submit documents, evidence, etc., to clarify the issues involved;

(iii) if, in the opinion of the examining or opposition division, the patent cannot be granted or maintained in the text requested by the applicant or proprietor of the patent, but could possibly be granted or maintained in an amended text of more limited scope;

(iv) if information necessary to the conduct of the proceedings has to be communicated to the parties, e.g. in accordance with Rule 14(2) and (3), 35(4) or 142(2) and (3);

(v) for preparing oral proceedings, (see E-III, 5); or

(vi) if a decision is to be based on grounds on which the parties have not yet had an opportunity to comment (see E-X, 1).

1.2 Number of communications

Since each communication issued may entail prolonging the proceedings, the proceedings are conducted in such a way as to manage with as few communications as possible. If a communication has to be issued, it will cover all the points which are necessary, or likely to be of importance, for the particular stage of the proceedings, e.g. the preparation of oral proceedings or of a decision.

1.3 Form of decisions, communications and notices

Rule 113(1) and (2)

Any decision, communication or notice from the EPO is to be signed by and to state the name of the employee responsible. Where these documents are produced by the employee responsible using a computer, a seal may replace the signature. Where the documents are produced automatically by a computer the employee's name may also be dispensed with. The same applies to pre-printed notices and communications.

2. Notification

2.1 General remarks

Art. 119
Rule 125
Rule 126
Rule 127

The EPO as a matter of course notifies those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of the EPC, or of which notification has been ordered by the President of the EPO; other communications are not subject to formal notification.

Notifications may, where exceptional circumstances so require, be given through the intermediary of the central industrial property offices of the contracting states.

In proceedings before the EPO, any notification to be made must take the form of the original document, or a copy thereof certified by or bearing the seal of the EPO, or a computer print-out bearing such seal, or an electronic document containing such seal or otherwise certified. Copies of documents emanating from the parties themselves do not require such certification.

2.2 Method of notification

Rule 125(2) and (3)

Notification is to be made by postal services, by delivery on the premises of the EPO, by public notice or, if so agreed by the addressee, by means of electronic communication as determined by the President of the EPO and under the conditions laid down by him governing their use. Further details concerning notifications are given in Rules 126 to 129. Notification through the central industrial property office of a contracting state competent to deal with the addressee must be made in accordance with the provisions applicable to that office in national proceedings.

2.3 Notification by postal services

Rule 126

All notifications by postal services must be by registered letter (see also OJ EPO 2019, A57). The President of the EPO has, so far, not named any other documents to be notified by registered letter with advice of delivery or equivalent.

The letter is deemed to be delivered to the addressee on the tenth day following its handover to the postal service provider, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it is incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

Notification is deemed to have been effected even if acceptance of the letter has been refused.

The law of the state on the territory of which the notification is made applies to other matters concerning notification, e.g. the question whether delivery to a person other than the addressee constitutes an effective notification to the latter.

2.4 Electronic notification

Where a user has agreed to receive communications electronically, the electronic document is deemed to be delivered to the addressee on the tenth day after its transmission unless it has failed to reach its destination or has reached it at a later date. *Rule 127*

Currently, notification may occur in electronic form to an activated Mailbox. Electronic notification comprises the decisions, summonses, notices and communications contained in a list published on the EPO website. For the Mailbox service, the date of transmission is the date indicated on the document, provided that the addressee has access to it in the Mailbox by that date. For further details, see the Decision of the President of the EPO dated 11 March 2015 concerning the pilot project to introduce new means of electronic communication in EPO proceedings (OJ EPO 2015, A28) and the Notice from the EPO dated 30 March 2015 (OJ EPO 2015, A36).

In the event that further means are introduced for electronic notification, the conditions and details will follow from the decisions governing the use of such means.

2.5 Notification to representatives

If a representative has been appointed, notifications must be addressed to him. If several such representatives have been appointed for a single interested party, notification to any one of them is sufficient. If several persons are joint applicants for or proprietors of a patent or have acted in common in filing notice of opposition or intervention and have not appointed a common representative, notification of one person, viz. the person referred to in Rule 151, will again be sufficient. If several interested parties have a common representative, notification of a single document to the common representative is sufficient. *Rule 130*

2.6 Irregularities in the notification

Where a document has reached the addressee, if the EPO is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document is deemed to have been notified on the date established by the EPO as the date of receipt. In cases where the EPO is not able to prove the actual date of notification, a letter, for instance, sent by the addressees themselves and indicating the date of receipt, is accepted as proof. If it is evident from a reply from the addressees that they have received the document, although they do not mention the date of its notification, the date on which that reply was written is to be regarded as the date of notification. *Rule 125(4)*

Chapter III – Oral proceedings

1. General

By "oral proceedings" is meant formal proceedings within the meaning of Art. 116. The term does not include consultations such as occur in examination proceedings and limitation/revocation proceedings (see C-VII, 2). In view of Rule 81(2), such consultations are not allowed in opposition proceedings in which more than one party is involved unless the consultations concern matters which do not affect the interests of other parties. An example is proceedings for examining the admissibility of opposition, provided this involves only the EPO and the opponent concerned.

Oral proceedings will take place before the competent body, e.g. within the Receiving Section before the appointed officer and during the examination and opposition procedure before the whole division. In matters lying within its competence, oral proceedings can be held before the Legal Division. The right to oral proceedings forms a substantial part of the right to be heard under Art. 113.

Art. 18(2)
Art. 19(2)
Art. 113

Oral proceedings can be held on the premises of the EPO or by videoconference, where so permitted. Oral proceedings by videoconference are equivalent to oral proceedings held on the premises of the European Patent Office (OJ EPO 2020, A134, Article 1(3); OJ EPO 2020, A121, Article 2(3)).

Oral proceedings before examining divisions, the Receiving Section and the Legal Division are generally held by videoconference, either at the request of the applicant or at the instigation of the competent department unless there are serious reasons against holding the oral proceedings by videoconference (OJ EPO 2020, A134, Article 1(2); OJ EPO 2021, A49, Article 1(2); OJ EPO 2021, A50, Article 1(2)). Examples of serious reasons are, in particular, reasons relating to a participant to the oral proceedings as an individual (e.g. a proven visual impairment that prevents a representative from following oral proceedings on screen) and reasons related to the nature and subject-matter of the proceedings (e.g. where they involve the demonstration or inspection of an object where the haptic features are essential, to the extent that this is possible in accordance with the applicable provisions). Sweeping objections against the reliability of videoconferencing technology or the non-availability of videoconferencing equipment will, as a rule, not qualify as serious reasons in this regard.

2. Oral proceedings at the request of a party

If, in the course of proceedings, a party requests oral proceedings, the competent department must grant this request as further explained in this section. The EPO will not inform any party concerned of this right but will expect them – if they do not obtain satisfaction from the competent department – to request oral proceedings (if they so wish) before a decision is reached.

Art. 116(1)

Under Art. 116(1), parties can request oral proceedings at any time, provided a decision has not yet been issued. In particular, a request for oral proceedings made before the decision to grant or to limit has been handed over to the internal post has to be allowed (see T 556/95 and G 12/91).

Art. 116(2)

Oral proceedings will take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application. Where the Receiving Section does not consider it necessary to hold oral proceedings, it must inform the applicant accordingly (see J 16/02).

The competent department will decide on the most appropriate date for the oral proceedings, which will only be held after the issues to be determined are sufficiently clear (see E-III, 5).

With a conditional request for oral proceedings, i.e. if any party concerned has indicated that the request for oral proceedings has been made solely as a precaution to cover the eventuality that the case they have put forward is not accepted, oral proceedings will be held only if a negative decision against the party concerned is envisaged.

With an unconditional request for oral proceedings, if the competent department considers that a decision on the matter may be reached on the basis of the written evidence on file and intends to take a decision (e.g. in accordance with Art. 97, 101 or 105b) which fully concurs with the case put forward by the party or parties having unconditionally requested the oral proceedings, and providing there is no valid request for oral proceedings from a party adversely affected by the decision envisaged, the decision may be issued in writing without oral proceedings being held (T 1050/09).

A request to hold oral proceedings at a particular EPO site is not admissible; a refusal by the competent department to accept such a request is not subject to appeal (see T 1142/12).

2.1 Request for oral proceedings by an opponent whose opposition is to be rejected as inadmissible or is deemed not to have been filed

Under Art. 116(1), oral proceedings may be requested only by a party to pending proceedings. If the opposition division notes deficiencies in the notice of opposition under Rule 77(1), any opponent still remains a party to the proceedings until such time as their opposition is rejected as inadmissible. This also applies when deficiencies lead to the opposition being deemed not to have been filed (see D-IV, 1.4.1).

2.2 Request for oral proceedings in examination to be held on EPO premises

A request that oral proceedings before the examining division be held by way of exception on the premises of the EPO (see E-III, 1) needs to be filed as early as possible, preferably together with the request for oral proceedings. The granting of a request for oral proceedings to be held on the premises of the EPO will be at the discretion of the competent division.

If the request for oral proceedings on the premises of the EPO cannot be allowed and is received after the summons to oral proceedings, the division will inform the parties that the oral proceedings will take place by videoconference as set out in the summons and include a brief reasoning as to why the request cannot be granted. If the request is received before the summons has been issued, the reasons for the refusal will be given in the annex to the summons. In either case, a refusal of this type is not separately appealable (OJ EPO 2020, A134, Article 1(2)).

If a request for oral proceedings on the premises of the EPO is allowable and is received after the summons to oral proceedings by videoconference has been issued, the parties will be informed that oral proceedings will be held on the premises of the EPO as requested; where possible, the date of the oral proceedings will remain unchanged.

3. Request for further oral proceedings

The EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same, irrespective of the form in which the oral proceedings were held. *Art. 116(1)*

Oral proceedings, particularly in opposition proceedings, are held to give the opportunity to finally discuss all matters raised and are normally terminated with a decision announced orally. The division is bound by that decision, once announced, and it cannot reopen the proceedings to allow further submissions to be filed or to take into account new facts (see the last two paragraphs of E-VI, 2). Only if the division, in the oral proceedings, has not announced a decision, but has decided to continue the proceedings in writing, can further submissions be examined. Such may be the case e.g. when the examining division indicates that it intends to grant a patent (or to limit a granted patent in limitation proceedings) on the basis of the documents filed during the oral proceedings.

Thus, as a rule, in examination, limitation or opposition proceedings there will be no justification for further oral proceedings, for example where one of the parties wishes to re-examine from a different viewpoint a subject already discussed in the course of the proceedings, either before or during the original oral proceedings. However, if the oral proceedings are not terminated with a decision and after the oral proceedings the subject of the proceedings changes, for example where fresh evidence is admitted into the proceedings after the original oral proceedings, then further oral proceedings will generally have to be held if requested (see T 194/96).

4. Oral proceedings at the instance of the EPO

The competent department of the EPO may arrange for oral proceedings to take place without a request from a party if it considers this to be expedient. *Art. 116(1)*

Oral proceedings will normally only be expedient if after an attempt at written clarification there are still questions or doubts which have a crucial bearing on the decision to be reached and which may be more efficiently or surely settled by oral discussion with the party or parties, or if it is necessary to take evidence as part of oral proceedings (see E-IV, 1.3 and 1.6.1). The competent department will also bear in mind

the need for economy in such procedures, since oral proceedings give rise to costs for both the EPO and the party or parties.

5. Preparation of oral proceedings

The purpose of oral proceedings is to settle as far as possible all outstanding questions relevant to the decision. To this end proceedings will be carefully prepared after examination of all the written matter submitted and with this in mind the most appropriate date for conducting oral proceedings is chosen.

When preparing oral proceedings, particularly in opposition, the division considers carefully whether complex legal issues are likely to arise, and it may therefore decide to enlarge the division by adding a legally qualified member (Art. 18(2) and 19(2)).

In so far as certain questions relevant to the decision are considered by the EPO to require discussion, it will in many cases be expedient to inform the party or parties in a notice and possibly also to invite one or more of the parties to submit written observations or to produce evidence, where appropriate. Parties may produce evidence in support of their arguments on their own initiative. Where, however, the evidence is such that it should have been put forward at an earlier stage, e.g. in opposition proceedings pursuant to D-IV, 1.2.2.1(v) and 5.4, it is for the competent body to consider whether the evidence not filed in due time is to be admitted (see E-VI, 2). Any observations should be received in time for them to be communicated to the other parties at the latest one month before the oral proceedings. The time limit for submission of observations is fixed accordingly, particularly where the invitation to file observations is issued at the same time as the summons to oral proceedings.

5.1 When can summons to oral proceedings be issued in substantive examination?

At the beginning of substantive examination, if the examining division is of the opinion that the application cannot be granted directly, at least one substantive communication within the meaning of Art. 94(3) will generally be sent before the division issues a summons to oral proceedings (see C-III, 4).

In particular, neither the search opinion of an EESR or a supplementary search (ESOP) nor an opinion or report from the PCT procedure (WO-ISA, SISR, IPRP or IPER) is a communication under Art. 94(3), so that even if the applicant has replied thereto, it is in general not appropriate to send a summons as a first communication in European substantive examination.

Nor are the following communications/requests considered as substantive communications from the examining division for this purpose: invitation under Rule 62a or Rule 63, communication under Rule 137(4), request under Rule 53(3), request under Art. 124 and Rule 141, invitation under Rule 164(2)(a).

Exceptionally, summons to oral proceedings may be issued as the first action in examination proceedings, provided that the criteria set out in C-III, 5 are met.

In examination proceedings, where the applicant has been invited to provide a translation of the priority according to Rule 53(3) (see A-III, 6.8.2 and F-VI, 3.4), no summons to oral proceedings will be issued until either the translation is provided or the period for further processing in respect of the time limit according to Rule 53(3) has expired.

6. Summons to oral proceedings

All parties must be duly summoned to oral proceedings by notification. The summons must state the subject, the date and time and the form of the oral proceedings. *Rule 115(1)* *Art. 119*

The division sets a single date for the oral proceedings, i.e. one day or, in particular cases, more than one consecutive day. No pre-announcement of the date will be made. Oral proceedings may be set for any working day on which the EPO is open at the relevant site.

The summons will be accompanied by a note drawing attention to the points which need to be discussed, normally containing the provisional and non-binding opinion of the division. New documents may be cited in the annex to the summons (T 120/12), together with an explanation of their significance. However, examiners must carefully consider on a case-by-case basis whether citing a new document would introduce a new line of argument. At an early stage in the procedure, they must consider sending a further communication before issuing any summons if a new document needs to be cited. For the additional requirements of the accompanying note if the summons is issued as the first action in examination, see C-III, 5. The summons as well as the annexed communication can only be appealed together with the final decision unless a separate appeal is allowed (see E-X, 3). *Rule 116(1)*

The summons will also fix a date up to which written submissions may be filed or amendments which meet the requirements of the EPC may be submitted (see also D-VI, 3.2).

Rule 115(1) stipulates that at least two months' notice of the summons must be given unless the parties agree to a shorter period. Such agreement must be present in the public part of the file. *Rule 115(1)*

Harmonised with the standards applied in the written procedure (E-VIII, 1.2), the practice outlined below is followed in setting the date of the oral proceedings to allow the parties sufficient time for preparing and filing submissions:

(i) Any time limit (even shorter than two months) may be set provided that prior agreement has been reached with the parties.

(ii) Normally, the summons is issued at least four months ahead of the day of the oral proceedings in examination and at least six months ahead of the day of the oral proceedings in opposition.

(iii) Between two and four months' notice can be given without preliminary agreement only in specific circumstances, since the parties would have very limited time for filing submissions before the date fixed in the summons. Examples are where, in examination, the summons follows an extensive exchange between the first examiner and the applicant, or where the date of the oral proceedings is changed to a later date (see also E-III, 7.2).

(iv) Where the summons is issued as the first action in examination, six months are foreseen between the despatch of the summons and the date of the oral proceedings (see C-III, 5).

The summons must state that if parties duly summoned do not appear as summoned or fail to connect to the oral proceeding by videoconference, as the case may be, the proceedings may continue without them.

In opposition proceedings, where multiple oppositions have been filed, as a rule, a single hearing in oral proceedings is scheduled, even if the oppositions are based on different grounds (see D-I, 6). This means that all the parties must be summoned to attend them and may present comments on all grounds raised.

7. Change of date, cancellation or maintenance of oral proceedings

7.1 Changing the date of oral proceedings

7.1.1 Requests to change the date of oral proceedings

A request to change the date of oral proceedings is allowable only if the party concerned can advance serious reasons which justify the fixing of a new date (see T 1080/99, T 300/04, J 4/03 and T 178/03). The request to fix another date must be filed as soon as possible after the grounds preventing the party concerned from attending the oral proceedings have arisen. It must be accompanied by a sufficiently substantiated written statement indicating these reasons (see OJ EPO 2009, 68; see also T 178/03).

Serious reasons to request a change of the date for oral proceedings may be, for instance:

– a previously notified summons to oral proceedings of the same party in other proceedings before the EPO or a national court

  – for the same date or

  – for the preceding or following day or

– for the two preceding or two following days where the other oral proceedings are to take place on the premises of the EPO at a geographically distant location,

– serious illness,

– a death within the family,

– the marriage of a person whose attendance in oral proceedings is relevant,

– military service or other obligatory performance of civic duties,

– business trips which have been firmly booked before notification of the summons to oral proceedings,

– holidays which have already been firmly booked before notification of the summons to oral proceedings. In the case of holidays scheduled but not yet booked, the representative must indicate the circumstances (e.g. school holidays) which prevent the holidays from being rescheduled.

If the grounds for changing the date of the oral proceedings submitted by a party do not meet the above criteria, the division will inform the parties that the oral proceedings will take place as set out in the summons and annex a brief reasoning as to why in its view the criteria are not met.

The reasons that can be invoked to change the date only apply to those participants whose presence is essential to the oral proceedings, e.g. the representative or a witness.

If during the procedure substantive submissions were made by several representatives of a firm, an indication must be given why none of those who previously made such submissions can present the case at the oral proceedings, i.e. why the representative who cannot attend is essential or why the others are also unable to attend.

In opposition proceedings, in particular if more than one opponent is involved, a more strict approach may be applied to prevent a series of changes of date (see T 1102/03).

Grounds which, as a rule, are not acceptable are, for instance:

– a summons to oral proceedings before the EPO or a national court notified after the summons in the relevant proceedings,

– excessive work pressure.

As Mondays and Fridays are normal working days, oral proceedings will be scheduled for these days, too. The fact that this may necessitate travel at weekends is not a sufficient reason to change the date of the oral proceedings. The departments of first instance will however, circumstances

permitting, try to be flexible where there is a request to change the starting time in order to enable the party to travel on the same day.

7.1.2 Change of date of oral proceedings at the instigation of the division

In exceptional cases the division might have to instigate the change of date of oral proceedings for reasons similar to those mentioned above. The date of the oral proceedings will, however, be changed only if a suitable replacement cannot be found.

7.1.3 Change of date of oral proceedings – defined notice period

The notice period defined in Rule 115(1), i.e. at least two months, is valid also in the case of a change of date unless the parties have agreed on a shorter period (see also E-III, 6(iii) and E-III, 8.11.1).

7.2 Cancellation or maintenance of oral proceedings

7.2.1 General

In response to submissions made by a party in reply to the summons to oral proceedings, the division may also decide to cancel the oral proceedings and continue the procedure in writing. If it takes such a decision, it notifies the parties accordingly. In the absence of such notification, the parties must be aware that oral proceedings will be held. However, as an additional service in examination proceedings, if oral proceedings are not cancelled following such submissions, the division informs the applicant that the date and time set for the oral proceedings are maintained.

7.2.2 Withdrawal of the request for oral proceedings

If the request for oral proceedings is explicitly withdrawn, or if a written statement is to be interpreted as equivalent to a withdrawal of the request for oral proceedings (because the party has indicated that it will not attend – see T 3/90, T 696/02 and T 1027/03 – or has requested a decision according to the state of the file – see OJ EPO 2020, A124), it is within the discretion of the division to decide whether the scheduled oral proceedings are to be maintained or to be cancelled.

If the division decides that oral proceedings are nevertheless to be conducted, this means that there are objections still outstanding that need to be discussed at the oral proceedings. Consequently the applicant and/or patentee can expect that problems relating to the requests filed in reply to the summons to oral proceedings will be dealt with at the oral proceedings.

If any applicant or patentee decides not to attend the oral proceedings, they are thereby choosing not to make use of the opportunity to comment at the oral proceedings on any of the objections, but to rely on the arguments as set out in the written submissions. The decision may be given orally in their absence. The procedural principles require that the party to the proceedings is not taken by surprise by the decision (see also E-III, 8.3.3).

8. Conduct of oral proceedings

8.1 Admission of the public to proceedings

Oral proceedings before the Receiving Section, the examining divisions and the Legal Division are not public. *Art. 116(3)*

Oral proceedings, including delivery of the decision (see E-III, 9), are public before the opposition divisions in so far as the opposition division does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings. This could, for example, be the case if any of the parties wishes to give information about sales figures or other commercial secrets in support of their case. Generally, the public will only be excluded whilst such information is being given. The public is also excluded during discussions about a request for exclusion of a document from file inspection (see D-II, 4.3) and when a decision on the matter is pronounced. The parties other than the requester(s), as well as their representatives, may also be excluded as being part of the public (e.g. in the case of a request for exclusion of a medical certificate from file inspection). *Art. 116(4)*

8.2 Conduct of oral proceedings

Before the Receiving Section oral proceedings will be conducted by the appointed officer and before the examining or opposition divisions by the chair of the division concerned. Before the Legal Division, oral proceedings will be conducted by one legally qualified member of the Legal Division.

The responsibilities of the person conducting the proceedings will include keeping order and conducting the proceedings as regards their formal and substantive aspects.

The person conducting the proceedings must in particular ensure that, where necessary, a list is prepared of all disputed or unclear points relevant to the decision to be reached, that these are discussed and that the party or parties have the opportunity of commenting on them. In the case of oral proceedings by videoconference, the person conducting them must ascertain that no technical problems have prevented the oral proceedings from being conducted in accordance with the right to be heard and the right to oral proceedings.

On the other hand, the oral proceedings are to be conducted strictly and efficiently, so that the submissions of the party or parties and the discussions are not unnecessarily digressive and do not deal with points which are of no relevance to the decision to be reached. Repetition is to be avoided as far as possible. In particular, written material submitted at the appropriate time to the competent department and to the party or parties which has already been the subject of proceedings need not be read out *in extenso*. A simple reference to such written material may suffice.

8.2.1 Oral proceedings on the EPO premises – use of laptops or other electronic devices during either *ex parte* or *inter partes* oral proceedings

As a general rule, the use of laptops or other electronic devices during oral proceedings on the EPO premises is allowed provided they do not cause disturbance to the participants and are not used for sound recording (see the Notice of the Vice-Presidents Directorates-General 2 and 3 dated 25 February 1986, OJ EPO 1986, 63).

Only in exceptional circumstances, where oral proceedings are held on the premises of the EPO and where, for example, the use of an electronic device disturbs the oral proceedings and despite warning of the division the disturbance is not remedied, can the division decide not to admit the use of the incriminated device. It will be taken into consideration that it is normal for representatives to rely on electronically stored documents to present their case and they may be put in a difficult position if the division denies them the right to use their laptop.

8.2.2 Oral proceedings by videoconference before examining divisions

Oral proceedings before examining divisions are to be held by videoconference unless there are serious reasons against it.

8.2.2.1 Remote connection of applicants and their representatives

Upon request, applicants and their representatives may connect to the oral proceedings by videoconference from different locations.

8.2.2.2 Remote connection of members of the examining division

The members of the examining division may equally connect to the oral proceedings by videoconference from different locations. In such cases, the members of the division will deliberate and vote among themselves via a separate communication channel. The venue of oral proceedings will be deemed to be the location where the examining division is set up.

The applicant or representative will be informed of the remote participation of the members of the examining division at the beginning of the oral proceedings, after the connection has been established and before they are formally opened.

8.3 Opening of oral proceedings: non-appearance of a party

8.3.1 Checking the identity and authorisations of participants at oral proceedings

If the parties or their representatives are not personally known to at least one member of the division, it is necessary to check their identity before the start of the oral proceedings. During a videoconference, this can be done by requesting the representative to show their EPO badge or ID card to the camera. An ID card may be shown solely in a private session unless there is only one representative or party connected to the videoconference; where necessary, a separate session is established for that purpose.

In the case of oral proceedings held by videoconference, copies of identity documents can also be filed via the EPO online filing options no later than two days prior to the oral proceedings or via email to the address provided to the parties at the beginning of the oral proceedings. For data protection reasons, copies of identity documents sent via email are deleted and are not included in the file. Copies submitted via EPO online filing options are put in the non-public part of the file.

In order for the division to be able to confirm the identity of the person concerned, the full name (first name and surname) and the picture of the ID should be visible. All the other information on the identity document can be kept hidden if so wished, as long as it is possible to recognise that it is an official identity document.

For accompanying persons, including those who will be making oral submissions (see E-III, 8.5), it is sufficient that their identity is confirmed by the relevant representative.

Professional representatives need to file authorisations only in exceptional cases (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1).

Authorisations need be checked only if a party is represented by a person whose authorisation is not apparent from the file. If it is established that the person is either

(i) a professional representative acting under a sub-authorisation

(ii) a professional representative from the same agency as the representative acting in the case, or

(iii) a natural person (e.g. executive director) authorised by law in the party's country of business to act on behalf of that party

then no further check is required.

If however the person is:

(a) a professional representative who is neither from the same agency nor acting under a sub-authorisation, and his/her attendance at the oral proceedings is his/her first appearance in the procedure, or

(b) a legal practitioner or a party's employee who is not an authorised professional representative

then the procedure is as follows:

In case (a), the division will check the file to see whether the previous representative's authorisation has lapsed. A change in representative or the termination of the authorisation of a previous representative may have been effected via an electronic notification through the My Files service

(see OJ EPO 2012, 352). If the previous representative's authorisation has lapsed, no further action is required. If not, the representative concerned will be requested to provide a reference to a registered general authorisation or to file an individual authorisation.

In case (b), the division will request the person concerned to provide a reference to a registered general authorisation or to file – by email in the case of oral proceedings by videoconference (OJ EPO 2020, A71) – an individual authorisation.

Any person without an authorisation will be requested to submit one without delay. If they are unable to do so straight away, a time limit of two months will be set for its submission. The fact that the authorisation was missing, and the time limit set for submitting it, must be recorded in the minutes. The proceedings then continue in the normal way, except that no decision can be pronounced at the end. Instead, the decision is issued in writing once the missing authorisation has been filed. At the end of the proceedings, the party concerned must be reminded to file the authorisation.

8.3.2 Opening the oral proceedings

After opening the oral proceedings any person conducting them will introduce the parties present. They will have the particulars of the persons taking part in the proceedings recorded and will establish in what capacity they are present. Details of these steps and any consequences thereof will be recorded in the minutes (see E-III, 10).

8.3.3 Late arrival, non-appearance and failure to connect

8.3.3.1 General

If an absent party was not duly summoned, this is noted in the minutes and the oral proceedings are closed. A new date must be fixed for further oral proceedings.

Rule 115(2)

If any party who has been duly summoned to oral proceedings does not appear as summoned or fails to connect to the oral proceedings by videoconference, as the case may be, the oral proceedings may be conducted without them, since a party should not be able to delay issuance of a decision by failing to appear or connect.

It is to be noted that if any party appears or connects **before the end** of the oral proceedings, they have the right to be heard.

If the party appears or connects only **after the proceedings** have been closed, the division may reopen them at its discretion, subject to two conditions:

(a) the division has not pronounced a decision under Art. 97(1) or (2) or Art. 101(2) or an interlocutory decision under Art. 106(2) maintaining the patent in amended form according to Art. 101(3) (see also D-VI, 7.2.2) or a decision to reject the request for limitation under Rule 95(4).

(b) all parties to the proceedings agree to the reopening.

If, however, an allowable request for a change of date of oral proceedings has been filed (see E-III, 7), the proceedings are postponed and a new date fixed. If the filing of the request was delayed due to the carelessness of the party concerned, the proceedings may, depending on the circumstances, still be postponed; if this happens in opposition proceedings, a decision on the apportionment of costs may have to be taken (see D-IX, 1.4). *Art. 104(1)*

8.3.3.2 Procedure in opposition proceedings

If new facts or evidence are submitted during *inter partes* oral proceedings which a party, although duly summoned, fails to attend, it must first be examined whether these submissions may be disregarded (Art. 114(2); see also E-VI, 2).

Following G 4/92, if new facts are taken into consideration, then at the end of the oral proceedings a decision based on these facts cannot be taken against the absent party. Further, new evidence can only be used against the absent party if it has been previously notified and merely supports the previous assertions of the party who submits it. However, new arguments may be used at any time, in so far as they do not change the grounds on which the decision is based.

In other words, what the Enlarged Board of Appeal ruled out in G 4/92 was the possibility of taking decisions against the absent party on the basis of a surprising course of events at the oral proceedings, which changes the legal and factual framework of the case in an unforeseeable way (see T 414/94).

An absent party cannot be considered taken by surprise if during oral proceedings the other side attempts to overcome objections raised before the oral proceedings. In particular, a submission during oral proceedings of a more restricted and/or formally amended set of claims with a view to overcoming the objections of the opponent is not considered a "new fact" (see T 133/92 and T 202/92). Nor is it unexpected that amended claims are examined for formal admissibility and for compliance with Art. 123(2) and (3) (see T 341/92).

In the particular case of an absent opponent, if new prior art is submitted for the first time during oral proceedings which may be an obstacle to the maintenance of the opposed patent, this new prior art can be taken into consideration despite the opponent's absence because it is in the opponent's favour (see T 1049/93).

8.3.3.3 Procedure in examination proceedings

Oral proceedings give applicants an opportunity to exercise their rights under Art. 113(1). In examination proceedings, when applicants file amended claims before oral proceedings which they subsequently do not attend, they may expect a decision based on objections which might arise against such claims in their absence. A decision can be taken based on facts and arguments presented earlier in the proceedings and/or based on

new arguments which may be expected to be raised (see OJ EPO 2008, 471).

In examination proceedings, the annex to the summons to oral proceedings must include all the objections that are likely to be discussed during oral proceedings and indicate that amended claims in response to the communication will have to be examined at the oral proceedings for compliance with the EPC. This ensures that the applicant's right to be heard (Art. 113(1)) is respected and that the proceedings are not delayed unnecessarily if an applicant does not attend oral proceedings.

Where auxiliary requests are filed before the summons to oral proceedings is issued, these requests must be commented on in terms of both admissibility and allowability. However, the reasoning given in the preliminary opinion is to focus on the main request; only a brief indication of the essential reasons for the non-allowability of the subject-matter or the non-admissibility of the auxiliary requests is to be provided. It is to be noted that this brief indication of the essential reasons for not allowing or not admitting the auxiliary requests has to be thorough enough to ensure that the applicant has been informed of the objections raised by the examining division and has thus been given the opportunity to comment on them (see C-V, 1.1 and C-V, 4.9).

8.4 Opening of the substantive part of the proceedings

In so far as necessary, the person conducting the proceedings will outline the stage reached in the proceedings and will indicate the most important matters in dispute according to the file. In examination or opposition proceedings this may also be done by the primary examiner.

8.5 Submissions by the parties

After the introduction referred to above, the party or parties will be allowed the floor in order to put their cases and to make applications on procedural matters and state the grounds thereof. In the normal course of events each party will have only one opportunity of making a comprehensive statement.

In opposition proceedings the opponents will generally speak first and the patent proprietor afterwards. Where there are a number of opponents, it may be expedient to grant the patent proprietor an opportunity of replying directly after the statement of each individual opponent. The opponents and the patent proprietor will be given the opportunity of making a final reply.

The submissions of the party or parties may be prepared in writing, although they are expected to be made extemporaneously as far as possible. Passages from documents already introduced into the proceedings which are referred to again may only be read out where their precise wording is relevant.

Submissions by a person who is not qualified under Art. 133 and 134 to represent parties to proceedings before the EPO may be admitted at oral proceedings when this person accompanies a professional representative representing that party. Such submissions, however, cannot be made as a matter of right, but only with the permission and at the discretion of the

examining or opposition division or the Legal Division. In opposition proceedings the division will consider in exercising its discretion whether (see G 4/95):

(i) the party on behalf of which the person is to speak has filed a request to this effect;

(ii) the party making the request has indicated the name of the person, the subject-matter of the submission and the person's qualification to speak on this matter;

(iii) the request has been filed sufficiently in advance of the oral proceedings;

(iv) in the case of a late-filed request, either there are exceptional circumstances justifying the admission of the submission or all the other parties agree to the making of the submission; and

(v) the submissions are made under the continuing responsibility and control of the professional representative.

If neither of the alternative conditions mentioned under (iv) are met, a late-filed request will be refused. The time limit to be applied when deciding whether a request was late-filed is that fixed in the summons under Rule 116.

If a party is represented by an authorised employee rather than a professional representative, the same considerations apply in respect of a person accompanying the authorised employee. As no other party is affected, examining divisions can adopt a more liberal approach than opposition divisions.

Parties are not to be considered as accompanying persons in the sense of G 4/95 (see T 621/98). They have the right to make submissions in oral proceedings by virtue of their status as party to the proceedings.

If written submissions are made during oral proceedings, the division will make sure that requirements such as typed-form, signature and dating of the submissions are met (T 733/99). See also E-III, 8.7 and OJ EPO 2020, A71.

8.5.1 Use of computer-generated slideshows in oral proceedings

In oral proceedings a computer-generated slideshow cannot be used as a matter of right, but only with the permission of and at the discretion of the examining or opposition division or the Legal Division (T 1556/06), and provided that – in the case of oral proceedings on the EPO premises – the necessary equipment is available in the room in which the oral proceedings are held. Generally, screens are available in most meeting rooms; however, requests to provide further equipment such as projectors will be refused.

Care must be taken that presentations of computer-generated slideshows do not negatively impact the efficient conduct of oral proceedings

(e.g. interruptions for the technical preparations for the presentation). Similar considerations apply to the use of other visual aids (e.g. flipcharts, pictures, screensharing).

8.5.1.1 Opposition proceedings (*inter partes*)

As a prerequisite, copies of the material to be presented must be provided in good time before the oral proceedings, i.e. Rule 116 applies. These copies are treated like any other submission made in writing.

The opposition division will decide whether the presentation of a computer-generated slideshow would facilitate the proceedings, after having heard the parties and taking into account whether allowing or refusing the use of the presentation would be detrimental to any participant.

A balance must be found between the presenter's interest in defending the case in the most appropriate manner and the other party's need to fully understand the submissions made and to have a true opportunity to respond.

The presentation of computer-generated slideshows in oral proceedings will be allowed if in the absence of this visual aid it would be much more difficult to follow the party's submissions. For example, slides showing:

(a) the structure or functioning of a product which is complex, or

(b) complicated reaction schemes,

(c) complex formulae, or

(d) the operation of a complex apparatus

might be considered by the opposition division to facilitate the discussion.

If copies of the material to be presented have not been filed in good time, or if the slides contain new matter, the presentation may be disregarded under Art. 114(2) and Rule 116. In this case the opposition division will apply the same criteria for admissibility as are used for other late-filed facts or evidence (see E-VI, 2).

The same considerations apply to oral proceedings before the Legal Division where they constitute *inter partes* proceedings.

8.5.1.2 Examination proceedings (*ex parte*)

As no other party is affected, examining divisions may adopt a more liberal approach than opposition divisions. Therefore, examining divisions will consider allowing the presentation of a computer-generated slideshow even if the slides are not communicated in advance of the oral proceedings, provided that:

(a) the examining division feels able to deal with this late-filed material without unduly lengthening the proceedings. The same

considerations as for other late-filed facts and evidence apply (see E-VI, 2);

(b) the submissions contribute to the resolution of the questions at issue.

The same considerations apply to oral proceedings before the Legal Division where they constitute *ex parte* proceedings.

8.5.2 Written submissions during oral proceedings by videoconference

Where oral proceedings are held as a videoconference, documents filed subsequently as referred to in Rule 50 must be filed by email (OJ EPO 2020, A71, Art. 1(1)). This also applies to authorisations.

Where filed documents require signature, this signature may be applied to the attached document or to the text of the accompanying email. The signature must take the form of a string of characters (such as an email signature with the sender's name and position) or a facsimile signature. *OJ 2020, A71, Art. 2*

The documents are to be sent to the email address indicated during the videoconference by the competent department. *OJ 2020, A71, Art. 3*

Amended application documents are to be filed as attachments. Attachments containing these amended application documents must be in PDF format and must comply with the WIPO Standard for Filing and Processing in Electronic Form (Annex F). Where an attachment containing these amended application documents is not in PDF format or does not comply with the WIPO Standard or is illegible or incomplete, the party must be promptly informed during the videoconference. Where the deficiencies cannot be remedied during the videoconference or within the time limit set, that document (or that part of the document which is illegible or incomplete) is deemed not to have been received. *OJ 2020, A71, Art. 4*

Other attachments may be sent in any format which can be opened by the division or (in the case of consultations) the examiner and which can be reproduced in a legible form. Otherwise they are deemed not to have been filed.

If an attachment is infected with a computer virus or contains other malicious software, it will be deemed to be illegible. The EPO is not obliged to receive, open or process any such attachment.

No paper documents need be filed to confirm documents filed by email. *OJ 2020, A71, Art. 5*

All submissions made by email during a videoconference must be annexed to the minutes unless the exceptions under Rule 144 and the decision of the President of the EPO dated 12 July 2007 concerning documents excluded from file inspection apply (see A-XI, 2.3 and Special edition No. 3, OJ EPO 2007, J.3). A confidentiality note which is routinely included in emails is not to be regarded as a request to exclude these submissions from the public file. *OJ 2020, A71, Art. 6*

8.6 Facts, evidence or amendments introduced at a late stage

With respect to facts, evidence or amendments not submitted in due time or arguments presented at a late stage in the proceedings, including during oral proceedings, see E-VI, 2.

8.7 Handwritten amendments in oral proceedings

8.7.1 General principles

Rules 50(1) and 86

The requirement of Rule 49(8) that the description, claims and abstract, as well as the request for grant, must be typed or printed in principle extends to documents replacing application documents and to amended patent specification documents (see also A-III, 3.2).

Responsibility for formally correct submissions and, in particular, for compliance with Rule 49(8) lies with the applicant/proprietor.

It is to be noted that deletions, correction of the numbering of the figures and insertion of reference numbers and associated arrows in drawings are considered as typewritten amendments.

If the document to be amended contains numbered paragraphs, amended replacement paragraphs may be submitted. In such cases it is not necessary to supply entire amended pages.

In order to assist the parties, including parties using their own laptops or other electronic devices during oral proceedings on the premises of the EPO, the EPO provides technical facilities that allow for compliance with the formal requirements, in particular computers equipped with a word processor and a printer, network printers and copiers enabling documents to be printed from a USB stick, and internet access in public areas via a public wireless network (see OJ EPO 2013, 603).

Parties are recommended to prepare electronic copies of documents likely to be amended. Published patent applications and specifications are available via the European publication server.

In examination proceedings, the formal requirement of Rule 49(8) applies to documents submitted during oral proceedings as well. Documents containing handwritten amendments will normally be accepted by the division as a basis for discussion during oral proceedings until agreement is reached on the final text of the patent. However, a final decision granting a patent may be taken only on the basis of documents which are formally compliant. See E-III, 8.7.2 for the procedure to be followed.

For opposition oral proceedings, Rule 82(2), third sentence, provides for one exception to the principle that a decision determining the final text of the patent may be based only on formally compliant documents. Pursuant to this provision, in oral opposition proceedings, the patent proprietor is by way of exception not required to file documents compliant with Rule 49(8) prior to the interlocutory decision on the documents on the basis of which the patent is to be maintained. The proprietor may choose to submit a formally compliant version of the amended text only within the time limit

under Rule 82(2) (OJ EPO 2016, A22). The parties will nevertheless be encouraged to file documents compliant with Rule 49(8) during oral opposition proceedings. See E-III, 8.7.3 for the procedure to be followed.

In contrast, in written opposition proceedings, an interlocutory decision to maintain the patent as amended may be issued only on the basis of formally compliant documents since the invitation in Rule 82(2) applies only to documents filed during oral proceedings (see H-IV, 4.3).

8.7.2 Procedure in examination proceedings

In examination proceedings, the formal requirements of Rules 46 and 49(2)-(9) and (12) apply equally to application documents submitted during oral proceedings by hand or by email (OJ EPO 2020, A71).

If the applicant is unable to provide formally correct amended application documents during oral proceedings, the following applies:

(a) If a decision to refuse a patent application is imminent and formally non-compliant documents making up the application are on file, to avoid prolonging the proceedings the examining division will go ahead and issue the decision, based on substantive arguments. It may however mention this formal deficiency in the decision.

(b) If there is agreed patentable subject-matter, the examining division announces the following:

– the amended application fulfils the requirements of the EPC except for certain formal requirements, e.g. the ones under Rule 49(8) regarding handwritten amendments; and

– the procedure will be continued in writing.

After the closure of the oral proceedings, the formalities officer on behalf of the examining division (see A-III, 3.2) will invite the applicant to file formally correct documents within two months. Where the amendments submitted in reply to this invitation differ from the patentable subject-matter established at the oral proceedings, the procedure described in C-V, 4.7 is to be applied.

8.7.3 Procedure in opposition proceedings

If, in oral proceedings, the interlocutory decision of the opposition division was based on documents which do not comply with Rule 49(8), i.e. which contain handwritten amendments, the opposition division will invite the proprietor in the communication under Rule 82(2) to file a formally compliant version of the amended text. The invitation will specify the formally deficient amended paragraphs and/or claims for which replacement paragraphs and/or claims need to be filed. The same applies where a decision of the boards of appeal remits the case to the department of first instance with the order to maintain the patent on the basis of amended documents with handwritten amendments.

In reply to the invitation of the opposition division under Rule 82(2) the proprietor will have to submit replacement paragraphs and/or claims which contain a formally compliant verbatim reproduction of the text as determined by the interlocutory decision (or the decision of the board of appeal). Any divergence between the text matter of the formally deficient paragraphs (and/or claims) specified in the invitation under Rule 82(2) and the text of the replacement paragraphs (and/or claims) will trigger a communication under Rule 82(3). A communication under Rule 82(3) will also be sent, if the proprietor does not reply at all or not in time, if the replacement paragraphs and/or claims are incomplete or if the replacement paragraphs and/or claims are again formally deficient.

If a formally compliant version of the verbatim text of the specified amended paragraphs (and/or claims) is not submitted within two months from the notification of the communication under Rule 82(3), the patent will be revoked.

8.8 Use of Rule 137(4) for amendments filed during oral proceedings in examination

A communication under Rule 137(4) will not be sent in respect of amendments filed during oral proceedings (see H-III, 2.1.3), since this would unduly delay the procedure. Making a request under Rule 137(4) during oral proceedings would have the consequence of staying the proceedings for one month, while waiting for the applicant's answer.

The examining division therefore requests the applicants to provide a basis for any amendments submitted during oral proceedings before any new amendments can be admitted into the proceedings.

In special cases, e.g. where there are many auxiliary requests which are difficult to check for compliance with the requirements of Art. 123(2) and the requests do not comply with Rule 137(4), the examining division may exercise its discretion by not admitting these requests under Rule 137(3) rather than raising an objection under Rule 137(4) (see H-II, 2.3 and H-III, 3.3.2.1).

8.9 Discussion of the facts and of the legal position

A discussion will be conducted with the party or parties concerning those technical or legal questions which are relevant to the decision and which, after the parties have made their submissions, do not appear to have been sufficiently clarified or discussed or are seemingly contradictory. Where necessary, it must be ensured that the party or parties file requests which are to the point and that the applicant or proprietor formulates the claims appropriately.

If the examining division finds that some patentable subject-matter results from an amendment of the claims, it informs the applicant of the fact and allows him an opportunity to submit amended claims based thereon.

If the competent department intends to depart from a previous legal assessment of the situation with which the parties are acquainted or from a prevailing legal opinion, or if facts or evidence already introduced into the

proceedings are seen in a different light – e.g. during the deliberations of the examining or opposition division (see E-III, 8.11) – so that the case takes a significant turn, the parties must be informed thereof.

8.10 Right of the other members of the division to put questions

The chair must allow any member of the examining or opposition division who so requests to put questions. They may determine at which point in the proceedings such questions may be put.

In oral proceedings, questions may be put to the parties in connection with their statements or the discussion of the facts or of the legal position. When evidence is taken as part of oral proceedings questions may also be put to the witnesses, parties and experts called. As regards the right of the parties to put questions, see E-IV, 1.6.7.

8.11 Closure of oral proceedings

If the competent department considers that the matter has been sufficiently thoroughly discussed, it must decide on the subsequent procedure to be followed. Where the department consists of a number of members – as in the case of the examining or opposition divisions – they must, if necessary, deliberate on the matter in the absence of the parties. Where oral proceedings are held by videoconferences and the members connect to the oral proceedings from different locations (see E-III, 8.2.2.2), the members will deliberate and vote among themselves via a separate communication channel. If new aspects emerge during the discussion and require further questions to be put to the parties, the proceedings may be restarted. Any person conducting the proceedings may thereafter give the decision of the department. Otherwise they inform the party or parties of the subsequent procedure and then close the oral proceedings.

While the department is bound by the decision it issues on substantive matters (see E-III, 9), it is free, as a result of further reflection, to inform the parties that it intends to depart from the procedure which it has announced.

The subsequent procedure may, for example, consist in the department issuing a further communication, imposing certain requirements on one of the parties, or informing the parties that it intends to grant or maintain the patent in an amended form. As regards the delivery of a decision in the last case, see E-III, 9.

If the patent is to be granted or maintained in an amended form, it is the aim to reach an agreement upon the final text in the oral proceedings. If, however, by way of exception the examining or opposition division indicates during the oral proceedings that it would be willing to grant or maintain a European patent provided that certain amendments are made which could not reasonably have been foreseen from the earlier procedure, the applicant or patent proprietor will be given a time limit of normally two to four months in which to submit such amendments. If the applicant or patent proprietor fails to do so, the application will be refused or the patent will be revoked.

8.11.1 Requesting postponement during oral proceedings

Oral proceedings in examination, limitation or opposition are intended to bring the proceedings to a close, and parties are expected to prepare themselves fully.

The division will therefore normally refuse any request from a party that the proceedings be postponed or continued in writing.

Even if the description needs to be revised to bring it into conformity with amended claims, the applicant or proprietor is expected to make the necessary changes either in the oral proceedings or during a break.

Continuing oral proceedings on a day other than the one set out in the summons requires a new summons according to Rule 115(1) to be issued unless all parties can agree to a shorter period of notice.

9. Delivery of the decision

Rule 111(1) and (2)

The delivery of the decision will follow a statement by the person conducting the proceedings announcing the operative part of the decision (see also E-III, 8.11 and E-X, 2.3).

The operative part may, for example, read as follows:

"The patent application ... is refused." or

"The opposition to the patent ... is rejected." or

"The patent ... is revoked." or

"Taking account of the amendments made by the proprietor in the opposition proceedings, the patent and the invention to which it relates satisfy the requirements of the Convention." or

"The request for limitation of the patent .... is allowable." or

"The request for limitation of the patent .... is rejected." or

"Patent grant proceedings relating to European patent application No. ... are interrupted/resumed as from ..."

Once a decision has been pronounced, submissions of the party or parties cannot be considered any longer and the decision stands, subject to the correction of errors in accordance with Rule 140. It may only be amended by appeal (see E-XII, 1, E-XII, 7 and E-XII, 8).

No pronouncement need be made at this point as to the reasons for the decision or the possibility of appeal. However, the examining or opposition division may give a short explanation of the reasons for the decision.

Subsequently the decision in writing (see E-X) containing the reasoning and information as to right of appeal must be notified to the parties without

undue delay. The period for appeal will only begin to run from the date of notification of the written decision.

Generally speaking it will not be possible to give a decision granting a European patent or maintaining it in amended or limited form in oral proceedings since, in the case of the grant of a patent, the requirements laid down in Rule 71(3) to (7), and in the case of a patent being maintained in amended or limited form, the requirements of Rule 82(1) and (2) or Rule 95(3) must be fulfilled.

The division further ensures that the result of oral proceedings in opposition is made available to the public online immediately after the hearing. If the patent is maintained on the basis of amendments filed during oral proceedings, these amendments are made public as well.

10. Minutes of oral proceedings

As regards the minutes of taking of evidence, see E-IV, 1.7.

10.1 Formal requirements

Minutes of oral proceedings must be drawn up. *Rule 124(1)*

The person conducting the proceedings must ensure that during the whole proceedings an employee is available to keep minutes. If necessary, during oral proceedings different employees may carry out the task of minute-writing in sequence. In this case it must be made clear in the minutes which section was drawn up by which employee. The employees are normally members of the competent department, e.g. the examining or opposition division. Following the proceedings, the minutes are formatted.

The minutes must be authenticated by the employee responsible for drawing them up and by the employee who conducted the oral proceedings, either by signature or by other appropriate means. If exceptionally the employee responsible cannot sign the minutes, one of the other members of the division may sign them on the employee's behalf subject to the conditions defined in E-X, 2.3. They are not signed by the parties. The parties must be provided with a copy of the minutes. Copies must be notified to them as soon as possible after the oral proceedings. *Rule 124(3) and (4)*

Provided the parties have been informed, the EPO may make sound recordings of the oral proceedings. However, no person other than an EPO employee is allowed to make any recording or retransmit any part of the oral proceedings, whether image or sound or both (see OJ EPO 1986, 63, OJ EPO 2020, A122).

Sound recordings are made only in specific exceptional circumstances, for example if the division expects

(a) witness testimony

(b) complex proceedings (e.g. because of the subject-matter or number of parties)

(c) requests for amendments to the minutes because of the importance of the case.

The recording is kept until the end of any possible proceedings. Copies of the recording will not be provided to the parties.

The minutes must first include the date of the proceedings, the names of the members of the department, e.g. the opposition division, present and the name or names of the minute-writer or writers. Minutes must also include the details referred to in E-III, 10.3.

10.2 Language

The minutes are normally written in the language of the proceedings under Art. 14(3), i.e. the EPO official language in which the application was filed or into which it was translated. The exceptions are set out in Rule 4(6).

Amendments to the text of the description or claims of the application or patent must be recorded in the minutes in the language of the proceedings under Art. 14(3).

Where the exact wording is important, or if the parties so insist, the minutes must record the following, word for word, in the EPO official language actually used or into which the statements were translated, as provided for in Rule 4(6):

(a) requests of the parties

(b) legally relevant statements by parties, witnesses, experts and division members, and

(c) order of the decision.

For derogations from the language of proceedings see E-V, 6.

10.3 Subject-matter of minutes

Art. 113(1)
Rule 124(1)

Minutes have an important function as evidence of respect for the right to be heard (Art. 113(1)). They must contain the essentials of the oral proceedings and the relevant statements made by the parties, together with arguments relevant to the decision and not contained in the parties' written submissions. Details of the arguments raised by the parties, however, are developed in the decision, and therefore are only briefly reported in the minutes.

Relevant statements are, for example, new or amended procedural submissions or the withdrawal thereof, the fresh submission or amendment or withdrawal of application documents, such as claims, description and drawings, and statements of surrender.

The essentials of the oral proceedings include new statements by the party or parties and by the member or members of the department concerning the subject-matter of the proceedings. In examination and opposition proceedings, the essentials are principally new statements arguing the

presence or lack of novelty, inventive step and other patentability criteria. The minutes are not, however, expected to be an exhaustive recollection of everything that was said during the oral proceedings. Rather, they are limited to the essentials and are as brief and concise as possible.

Vague or general statements are to be avoided. Also, care must be taken to ensure that statements crucial to the decision are correctly recorded. Although this is normally not necessary, in case of doubt the record of such statements is read out to the parties concerned before the decision is taken and announced. If new facts or evidence are submitted during the oral proceedings, the minutes must make clear that the division has examined them under Art. 114(1). They must also indicate whether or not the division, after having heard the parties, subsequently disregarded them under Art. 114(2).

The minutes briefly summarise the following elements, where present:

(a) arguments relevant for the decision as submitted by the parties, which, if they are already known from the written procedure, can be referred to as such,

(b) the substance of any new requests by the parties, preferably in the form of a brief statement referring to documents containing these requests, which must be attached to the minutes, and

(c) objections, arguments and/or requests to the parties voiced by a member of the division, focusing on the points relevant for the decision which are developed in the grounds for the decision.

The minutes conclude by indicating the decision taken by the division or, if no final decision is taken, the outcome of the proceedings. This part is preceded by a record of the parties' final requests as indicated in point (b) above.

The minutes must also contain procedural information, such as how the proceedings are to be continued after closure of the oral proceedings or whether the public was excluded for the whole or part of the oral proceedings.

The structure of the minutes mirrors the course of oral proceedings (see E-III, 8 and sub-points).

If a decision is given (see E-III, 9), it must be reproduced in the minutes.

The minutes with the result reached during the proceedings are communicated to the parties as soon as possible.

10.4 Request for correction of minutes

If a party to oral proceedings considers the minutes thereof not to fulfil the requirements of Rule 124, it may file a request to that effect, with a proposed correction, as soon as possible after receipt of the minutes in question.

The examining/opposition division is competent to decide upon the request (T 1198/97, T 68/02 and T 231/99). In response to a request for correction the division will either issue corrected minutes of the oral proceedings or despatch a communication stating that the minutes already contain the essentials of the oral proceedings and the relevant statements of the parties and give reasoning thereto (see T 819/96). The communication from the division cannot on its own be subject to an appeal.

It is at the discretion of the writer of the minutes (and of the chair who authenticates them) to decide what is considered essential and relevant in the meaning of Rule 124(1) (T 212/97). The minutes are corrected when they show deficiencies with regard to the aspects mentioned, for example if essential submissions or similarly important procedural statements are missing, or if they are incorrectly reflected in the minutes (T 231/99, T 642/97 and T 819/96).

11. Oral proceedings held by videoconference –technical aspects

11.1 Equipment and technology

Videoconferences will be conducted using IP technology: detailed information on the technology and tools used by the EPO and on the minimum technical requirements is available on the EPO website and will be communicated to the parties; such information may be updated from time to time.

11.1.1 Videoconference rooms at the EPO

Rooms equipped for videoconferences are available at all locations. Where necessary, the formalities officer will take care of the room reservation.

The EPO videoconference studios are for internal use only and therefore not available for applicants' or representatives' own use. In particular, any requests from parties wishing to use the EPO videoconference facilities to attend proceedings at other EPO premises (e.g. when the applicant is in Munich and the proceedings are to be held in The Hague) are refused with reference to OJ EPO 2020, A122, point 23.

For oral proceedings, the videoconference rooms will be reserved for at least half a day.

11.1.2 Document camera

A document camera can be made available in each videoconference room. With this device a live image of a paper document can be transmitted to the parties. It is, however, preferable to share documents via email.

11.2 Preparations for the videoconference

In addition to the summons, participants will receive an email confirming the date, time and the videoconference contact details to be used to establish the connection (in the form of a link or by other suitable means) and containing any further appropriate information, including on the organisation of the videoconference.

Participants are responsible and bear the costs for their own connection to the internet and any technical facilities at their end. They must ensure that their videoconferencing equipment meets the technical requirements specified in the communication containing the technical instructions. Participants are encouraged to perform a test call well before the oral proceedings take place.

Further information on the technology, procedure and etiquette for conducting oral proceedings by videoconference is available on the EPO website.

11.3 Technical problems

OJ 2020, A134, Art. 4

Where technical problems occur such that the oral proceedings held by videoconference cannot be conducted openly and fairly, for example due to a total or partial breakdown in communication, the right to be heard might possibly be violated (Art. 113(1)). The parties, due to the technical problems, might be taken by surprise by the grounds mentioned in an adverse decision on which they have not had an opportunity to comment. In such cases, the videoconference is terminated and new summons to oral proceedings are issued. The EPO will not attempt to re-establish the line in case of technical problems, but the applicant may be contacted by phone and asked to do so.

As a rule, new oral proceedings will be held by videoconference unless there are serious reasons for not doing so (OJ 2020, A122, point 22).

11.4 Recording

The recording of oral proceedings by the parties is not permitted (see E-III, 10.1). At the beginning of the videoconference the chair therefore reminds all participants that recording of the videoconference is prohibited.

Chapter IV – Taking and conservation of evidence

1. Taking of evidence by the departments of the EPO

1.1 General remarks

Formal taking of evidence in accordance with Rule 117 will occur mainly in opposition proceedings and hardly ever before the examining division. The following sections of this chapter are therefore based primarily on opposition proceedings. However, they also apply *mutatis mutandis* to other proceedings and particularly to substantive examination.

Art. 117
Rule 117

1.2 Means of evidence

The party or parties may at any time during proceedings submit evidence in support of alleged facts (see E-III, 5, E-X, 1.2, D-IV, 5.3, D-IV, 5.4 and D-VI, 3). This must be done at the earliest opportunity. When such evidence is such as could have been put forward at an earlier stage it is for the competent department to consider whether it is expedient (see E-VI, 2) to allow the new evidence to be introduced.

Art. 117(1)

It is generally desirable for parties to produce evidence in respect of all the facts alleged in support of their case, in order, for example, to show whether a particular technique was generally known to industry or whether there was any prejudice against a particular technique.

Facts adduced by a party will, however, normally be deemed true, even without supporting evidence, if it is clear that no doubts exist concerning them, if they do not contradict one another or if no objection is raised. In such cases the facts need not be supported by evidence.

There will however be occasions, particularly in opposition proceedings, in which the arguments of the party or parties must be supported by evidence. This will for example be the case where reference is made to prior art, for instance in the form of an oral description, a use or perhaps a company publication and there is some doubt as to whether, and if so when, such prior art was made available to the public.

The means of evidence which are admissible in proceedings before the EPO are (non-exhaustively) listed in Art. 117(1):

– production of documents;

– hearing the parties;

– hearing witnesses;

– sworn statements in writing;

– requests for information, for instance from a publisher concerning the date of publication of a book

– opinions by experts (see E-IV, 1.8.1); and

– inspection.

The most appropriate way of obtaining evidence in the individual case depends on the facts which have to be proven and on the availability of the evidence. To prove prior use in an opposition, the opponents usually offer as evidence the production of documents, the hearing of witnesses or parties, or they present sworn statements in writing. It is at the opposition division's discretion to evaluate this evidence, there being no fixed rules as to how any category of evidence is to be judged (for the evaluation of evidence, see E-IV, 4).

If the documents produced (e.g. patent documents) leave no doubt as to their contents and date of availability to the public and are more relevant for the patent in suit than other evidence offered, reasons of procedural efficiency may lead the opposition division to not pursue the other evidence at first.

If the testimony of a witness is offered, the opposition division may decide to hear this person in order to verify the facts for which this witness is brought forward, e.g. the prior use of the claimed product in an undertaking or the existence of an obligation to secrecy. For adequate substantiation the notice of opposition must make clear these facts, as witnesses are meant to serve for corroboration of facts brought forward, not for supplying these facts in place of the opponent. The above applies likewise to hearing the parties (see also E-IV, 1.6).

The "sworn statements in writing" referred to in Art. 117(1)(g) are unknown in some national legal systems, which instead have their own instruments (see T 558/95).

Whether a written statement ("affidavit") is made under oath or not is only one of the criteria applied by the opposition division in its evaluation of the evidence adduced. Apart from its relevance for the case, other criteria are the relationship between the person making the statement and the parties to the proceedings, the personal interest of that person, the context in which the statement was made, etc. Such a statement does not go beyond its literal content and does not allow the opposition division to assess the associated or background factors. If the alleged facts are contested by the other party, the opposition division does not generally base its decision on such a statement, but summons the person making the statement as a witness, if so offered by the party. The ensuing hearing of the witness allows the opposition division and the parties to put questions to the witness and thus enables the opposition division to establish the facts on the basis of that person's testimony. If that person is not offered as a witness, the opposition division will not pursue this evidence further.

Inspection will enable direct observations to be made and direct impressions to be formed of the object or process concerned. It may, for example, involve the demonstration of a product or process requested by the applicant or proprietor of the patent to substantiate the method of

operation of the subject-matter of the patent where this is disputed by the examining or opposition division.

Evidence in the form of documents normally stays on the file. Only exceptionally and on reasoned request can documents filed as evidence be returned unconsidered, e.g. if they were third-party statements filed in breach of a confidentiality agreement and the other parties agree to the request (see T 760/89).

1.3 Taking of evidence

Art. 117(2)
Rules 118 to 120

The department responsible for the taking of evidence in the form of a hearing of witnesses, parties and experts will, in substantive examination and opposition proceedings, be the division before which the taking of evidence as part of oral proceedings would normally take place. If evidence is to be taken, the examining or opposition division will normally have been enlarged to include a legally qualified member. The division may commission one of its members to examine the evidence adduced. Generally, this will be the primary examiner under Art. 18(2) or 19(2). A member may, for example, be commissioned pursuant to Rule 119(1), for the purposes of an inspection, such as in the form of a demonstration of a process or the investigation of an object, particularly in undertakings located far away.

A member may also be commissioned to attend a court hearing pursuant to Rule 120(3), and put questions to the witnesses, parties and experts.

The language for taking evidence and writing the minutes is governed by Art. 14(3) (language of the proceedings) and Rule 4 (derogations from the provisions concerning the language of the proceedings in oral proceedings); see also E-III, 10.2 and E-V.

Evidence can be taken on the premises of the EPO or by videoconference. For details regarding the taking of evidence by videoconference see OJ EPO 2020, A135.

1.4 Order to take evidence

Rule 117

Where the competent department of the EPO considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it must make a decision to this end (order to take evidence), setting out the investigation which it intends to carry out, relevant facts to be proved, the date, time and place of the investigation and whether it will be conducted by videoconference. If oral evidence of witnesses and experts is requested by a party but the witnesses and experts are not simultaneously named, the party is requested, either prior to the issue of the order to take evidence or in the order itself, to make known within a specified time limit the names and addresses of the witnesses and experts whom it wishes to be heard. The time limit to be computed in accordance with Rule 132(2) will be not less than two months and not more than four months, since any party concerned will normally know beforehand whom they wish to be heard as a witness or expert.

Art. 119

The order to take evidence must be notified to the parties. It may be appealed only together with the final decision, unless it allows separate appeal (see E-X, 3).

1.5 Summoning of parties, witnesses and experts

Art. 119
Rule 118(1) and (2)

The parties, witnesses and experts to be heard must be invited to appear to give evidence on the date fixed. The summons must be notified. At least two months' notice of a summons issued to a party, witness or expert to give evidence must be given, unless they agree to a shorter period. The summons must contain:

Rule 118(2)(a)

(i) an extract from the order to take evidence, indicating in particular the date, time and place of the investigation ordered, whether it will be conducted by videoconference and stating the facts regarding which parties, witnesses and experts are to be heard;

Rule 118(2)(b)

(ii) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke (see E-IV, 1.10);

Rule 118(2)(c)

(iii) an indication that a party, witness or expert who has been summoned to appear before the European Patent Office on its premises may, at their request, be heard by videoconference; and

Rule 118(2)(d)

(iv) an indication that any party, witness or expert may request to be heard by the competent court of their country of residence and a requirement that they inform the EPO within a time limit to be fixed by the EPO whether they are prepared to appear before it (see E-IV, 3.2.2 (iii) and (iv)).

Rule 119(3)

Even if evidence is not taken in oral proceedings, all parties to the proceedings may attend an investigation. Parties not summoned are informed thereof within the period laid down in Rule 118(2), together with a statement that they may attend.

1.6 Hearing of parties, witnesses and experts

1.6.1 General remarks

Where the examining or opposition division holds hearings for the purpose of taking evidence (see E-IV, 1.3) or if the case in question is expected to give rise to particular legal issues, it is advisable that the division be enlarged by the addition of a legally qualified examiner, if this is not already the case (see D-II, 2.2).

The evidence of witnesses is normally taken at oral proceedings either on the premises of the EPO or by videoconference. A party, witness or expert can even be heard by videoconference if the oral proceedings are otherwise conducted on the premises of the EPO. For details see OJ EPO 2020, A135.

The hearing will be either public or non-public, depending on the oral proceedings themselves (Art. 116(3) and (4)).

Where a hearing is held in connection with oral proceedings, the considerations set out in E-III, 8.2, E-III, 8.3, E-III, 8.9 and E-III, 8.10 are directly applicable, and where this is not the case they apply *mutatis mutandis*.

The hearing of an "expert" in the sense of Rule 117 requires as a precondition a decision to take evidence (see E-IV, 1.4). This is different from hearing oral submissions by a person accompanying the representative during oral proceedings, which can be allowed at the discretion of the division (see G 4/95 and E-III, 8.5).

1.6.2 Witnesses and experts not summoned

After opening the proceedings for the taking of evidence, the official in charge of the taking of evidence, i.e. in substantive examination and opposition proceedings the chair of the division concerned or the member commissioned for the taking of evidence, will determine whether any party requests that any other person present but not summoned is heard. If any party makes such a request they must briefly state why and to what purpose the person concerned should give testimony. The department in question will then decide on whether or not to grant the request (for the admission of facts or evidence not filed in due time see E-VI, 2).

1.6.3 Guidance to persons heard

Before any party, witness or expert may be heard, they must be informed that the EPO may request the competent court in the country of residence of the person concerned to re-examine their evidence on oath or in an equally binding form. *Rule 119(2)*

1.6.4 Separate hearings

Normally each witness must be heard separately, i.e. any other witnesses to be heard subsequently must not be present. This Rule does not apply to experts and to the parties. Witnesses whose statements conflict may be confronted with one another, i.e. each heard in turn in the presence of the other. The same applies to experts.

1.6.5 Examination as to personal particulars

The hearing will begin by the persons giving evidence being asked their given names, family name, age, occupation and address. Witnesses and experts must also be asked whether they are related by blood or marriage with any of the parties and whether they have a material interest in a particular party being successful in the proceedings.

1.6.6 Examination as to *res gestae*

The examination as to personal particulars will be followed by the examination as to *res gestae*. Any person testifying is to be instructed to give a full and logical account of what they know concerning the subject-matter of the hearing. Further questions may have to be put to clarify and supplement statements and to establish on what the knowledge of the person testifying is based. Such questions may be put by the member commissioned for the taking of evidence, where applicable, the chair or any other member of the department concerned. As regards the entitlement of other members of the division to put questions,

see E-III, 8.10. When formulating questions the same considerations apply as for the parties (see E-IV, 1.6.7).

1.6.7 Entitlement of parties to put questions at hearings

Rule 119(3) The parties may put relevant questions to the testifying parties, witnesses and experts including, e.g. in opposition proceedings, witnesses and experts testifying on behalf of other parties. The official in charge of the taking of evidence will determine at what point in the proceedings such questions may be put.

Any doubts on the part of the competent department, e.g. the opposition division, or a party as to the admissibility of a question must be settled by the competent department. "Leading questions", i.e. questions which already contain the statement which one would like to hear from the witness, practically only requiring him to answer by "yes" or "no", must be avoided, because they do not allow to properly establish the witness' own recollection of the facts. Questions may further not be directed to facts which require no further discussion, which are in no way relevant to the subject-matter for which the taking of evidence has been ordered, or if they aim at establishing facts in respect of which no evidence has been offered. A decision to reject a question cannot be challenged. As regards the entitlement of other members of the division to put questions, see E-III, 8.10.

1.6.8 Hearing of a witness no longer necessary

The testimony of a witness summoned to oral proceedings is heard if the facts which the testimony is supposed to corroborate are relevant to the decision (see E-IV, 1.2). Therefore, the witness is not heard if the facts to be proved are no longer relevant due to developments before or during oral proceedings before the witness is heard. This may be the case for example if the public availability of the relevant prior art has been proven by another means of evidence or if the patent is to be revoked on another ground for opposition and the patent proprietor submits no admissible auxiliary requests for the assessment of which the testimony would be relevant.

1.7 Minutes of taking of evidence

Rule 124(1) Minutes of the taking of evidence must be drawn up as described in E-III, 10, subject to the following qualifications:

The minutes of the taking of evidence must, in addition to the essentials of the taking of evidence, also record as comprehensively as possible (almost verbatim as far as the essential points are concerned) the testimony of the parties, witnesses or experts.

Rule 124(2) The minutes will normally be taken down by a member of the competent department carrying out the taking of evidence. The most efficient way of noting testimony is by way of dictation on to a dictating machine, in the process of which the person hearing the evidence will summarise the testimony in small sections, taking into account any objections raised by the persons being heard, and dictate it in this form on to a dictating machine. If the dictated passage does not correspond in full to their testimony, the persons being heard must raise any objections immediately. This is pointed

out to them at the beginning of their testimony. At the end of their testimony, they will be asked to approve the dictated minutes, which they will have listened to as they were dictated. Their approval or any objections are to be included in the dictated text. The dictated minutes are typed out and the parties are provided with a copy as soon as possible. It is not necessary to play back the minutes or to obtain approval of them if the testimony has been recorded verbatim and directly, using technical means.

Where the taking of evidence includes an inspection, the minutes must record, in addition to the essentials of the proceedings, the results of the inspection.

In addition, the taking of evidence as well as oral proceedings (see E-III, 10.1) may be recorded on sound recording apparatus.

1.8 Commissioning of experts

1.8.1 Decision on the form of the opinion

If the competent department decides of its own motion to obtain an expert opinion (D-VI, 1, sixth paragraph), it will have to decide in what form it is submitted by the expert whom it appoints. The opinion is drawn up in written form only in cases where the competent department considers that this form is adequate in view of the content of the opinion and provided that the parties agree to this arrangement. As a rule, in addition to submitting a written opinion and introducing it orally, the expert will also be heard (see E-IV, 1.6). *Rule 121(1)*

A copy of the opinion must be submitted to the parties. The copy will be produced by the EPO. *Rule 121(3)*

1.8.2 Objection to an expert

The parties may object to an expert. Therefore, before commissioning an expert to make an opinion, the competent department informs the parties of the expert whom it intends to ask to draw up an opinion and of the subject-matter of the opinion. The communication to the parties states a time limit within which objections to the expert may be made. If the parties do object to an expert, the competent department will decide on the objection. *Rule 121(4)*

1.8.3 Terms of reference of the expert

The terms of reference of any expert must include: a precise description of their task, the period laid down for the submission of their opinion, the names of the parties to the proceedings and particulars of the rights which they may invoke under the provisions of Rule 122(2) to (4) (regarding travel and subsistence expenses and fees, see E-IV, 1.10). *Rule 121(2)(a)-(d)*

1.9 Costs arising from oral proceedings or taking of evidence

As a rule, the parties to proceedings before the EPO meet the costs they have incurred. This principle notwithstanding, the competent body in the opposition proceedings may for reasons of equity (see D-IX, 1.4) decide to apportion in some other way the costs arising for the parties in respect of oral proceedings or taking of evidence (see D-IX, 1) and the costs arising *Art. 104(1) and (2)* *Rule 122(1) and (2)*

for the EPO in respect of witnesses and experts (see E-IV, 1.10). The competent body may make the taking of evidence conditional upon deposit with the EPO by the party who requested the evidence to be taken of a sum the amount of which is to be fixed by reference to an estimate of the costs. This procedure is applied where at the request of a party to grant or opposition proceedings evidence is to be taken by hearing witnesses or seeking an expert opinion unless no costs will arise because the witnesses or experts have waived their right to indemnification. If the party requesting evidence to be taken does not comply with the requirement of making such a deposit, the evidence need not be taken. In opposition proceedings the party requesting the evidence bears the costs of indemnifying witnesses or experts, unless for reasons of equity in individual cases other arrangements are made for the apportionment of costs under Art. 104(1) in conjunction with Rule 88. Any shortfall between the deposit lodged and the amounts payable by the EPO under Rule 122(4), second sentence, is fixed by the EPO of its own motion. Any unused amount of the deposit lodged is refunded. The EPO's internal costs arising through oral proceedings or taking of evidence, e.g. any associated staff travel and subsistence costs, are to be met by the EPO itself.

1.10 Entitlements of witnesses and experts

1.10.1 Expenses for travel and subsistence

Rule 122(2)

Witnesses and experts who are summoned by and appear before the EPO are entitled to appropriate reimbursement, by the EPO, of expenses for travel and subsistence (see E-IV, 1.10.3). This applies equally to witnesses and experts who are summoned by and appear before the EPO in the course of oral proceedings held by videoconference for travel to the place where they make themselves available to appear before the EPO by videoconference (e.g. a videoconference facility provided by one of the parties or a venue with a sufficiently stable internet connection).

This applies even if the witnesses or experts are not heard, e.g. where evidence is to be produced concerning an alleged prior use and shortly before the taking of evidence such prior use is substantiated by a document already published. Witnesses and experts may be granted an advance on their expenses for travel and subsistence. Witnesses and experts who appear before the EPO without being summoned by it but are heard as witnesses or experts will also be entitled to appropriate reimbursement of expenses for travel and subsistence.

1.10.2 Loss of earnings, fees

Rule 122(3)

Witnesses entitled to reimbursement of travel and subsistence expenses are also entitled to appropriate compensation, by the EPO, for loss of earnings, and experts to fees from the EPO for their work (see E-IV, 1.10.3). These payments must be made to the witnesses and experts after they have fulfilled their duties or tasks.

1.10.3 Details of the entitlements of witnesses and experts

Rule 122(4)

For the details governing the entitlements of witnesses and experts set out under E-IV, 1.10.1 and E-IV, 1.10.2, see OJ EPO 1983, 100. Payment of amounts due must be made by the EPO.

1.11 Models

1.11.1 When may models be submitted?

The EPC makes no express provision for the submission of models, but there is nothing to stop a party from submitting one himself. Models are not part of the application or patent, and therefore cannot be used to disclose the invention (Art. 83).

Models may be useful in EPO proceedings if they serve to substantiate the patentability of an invention, e.g. by showing that a given device actually works or does so particularly advantageously. Models may also be filed, e.g. in opposition proceedings, to illustrate the state of the art, especially prior use under Art. 54(2). Models as items for inspection therefore constitute evidence under Art. 117(1)(f).

1.11.2 Procedure

It is for the competent division to decide whether to take evidence by way of inspection of a model. If it considers this to be necessary, it must take a decision in the form of an order to take evidence (see E-IV, 1.4), setting out the relevant facts to be proved as well as the date, time and place of the inspection.

Where possible, the inspection is to be carried out on the premises of the EPO. However, if in view of the characteristics of the model (e.g. form, size, material) or due to security constraints an inspection cannot be carried out on EPO premises (see also the Notice from the EPO dated 20 December 2016, OJ EPO 2017, A6), the model may be inspected at a different location. In particular if such undertakings are located far away, the division may commission one of its members to carry out the inspection on its behalf (see E-IV, 1.3).

In general, any object which can be made available for inspection on the premises of the EPO can also be inspected during oral proceedings by videoconference unless such inspection would result in a disadvantage for a party where, e.g. the haptic feel, texture or handling experience of the object is of relevance.

In accordance with Rule 124(1), minutes must be taken, including the essential aspects and the result of the inspection.

1.11.3 Keeping the model

Even if the division does inspect the model, the EPO is not obliged to keep it. It is for the division to decide whether a model is to be kept by the EPO. However, as a general rule, models which would require special precautions or security measures if kept in the EPO are returned to the party.

The formalities officer is responsible for implementing the decision to keep or return the model. If the model is to be kept, the formalities officer notes this on a label on the file. If it is to be returned, the formalities officer informs the submitter that the model should be preserved in view of

possible opposition or appeal proceedings and notes the date of return on the label.

1.12 Video recordings

A party to the proceedings may request that a video recording be shown at the oral proceedings. Such a request must include the recording as such as well as specifying the type of equipment needed.

If video recordings are submitted, the division decides whether showing them will assist the proceedings. Video data carriers are always kept if the division has looked at them.

2. Conservation of evidence

2.1 Requirements

Rule 123(1) On request, the EPO may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. This could for example be the case where an important witness is about to emigrate to a distant country or where perishable matter, e.g. a food-stuff, is adduced as involving a use made accessible to the public.

2.2 Request for the conservation of evidence

Rule 123(2) The request for the conservation of evidence must contain:

Rule 123(2)(a) (i) the name, address and nationality of the persons filing the request and the state in which their residence or principal place of business is located, in accordance with the provisions of Rule 41(2)(c);

Rule 123(2)(b) (ii) sufficient identification of the European patent application or European patent in question;

Rule 123(2)(c) (iii) the designation of the facts in respect of which evidence is to be taken;

Rule 123(2)(d) (iv) particulars of the way in which evidence is to be taken; and

Rule 123(2)(e) (v) a statement establishing a *prima facie* case for fearing that it might subsequently become more difficult or impossible to take evidence.

Rule 123(3) The request is not deemed to have been filed until the fee for conservation of evidence has been paid.

2.3 Competence

Rule 123(4) The decision on the request and any resulting taking of evidence are incumbent upon the department of the EPO required to take the decision liable to be affected by the facts to be established.

Responsibility for the decision and the taking of evidence will therefore normally rest with:

(i) the examining division, from the date of filing until the date of the decision on the granting of the patent;

(ii) the opposition division, from the latter date until expiry of the time allowed for filing notice of opposition and during opposition proceedings; and

(iii) the board of appeal, from the date of a final decision by the opposition division until it becomes legally binding or while appeal proceedings are pending.

2.4 Decision on the request and the taking of evidence

The competent department must decide upon the request without delay. If it grants the request, it must also immediately make a decision on the taking of evidence. *Rule 123(1)* *Rule 117*

The provisions with regard to the taking of evidence in proceedings before the EPO are applicable. *Rule 123(4)*

The date on which the measures are to be taken must therefore be communicated to the applicant for or proprietor of the patent and the other parties in sufficient time to allow them to attend. They may ask relevant questions. *Rule 123(1)* *Rule 118(2)* *Rule 119(3)*

3. Taking of evidence by courts or authorities of the contracting states

3.1 Legal co-operation

Upon receipt of letters rogatory from the EPO, the courts or other competent authorities of contracting states will undertake, on behalf of the EPO and within the limits of their jurisdiction, any necessary enquiries. *Art. 131(2)*

3.2 Means of giving or taking evidence

3.2.1 Taking of evidence on oath

The principal case where evidence is taken by a competent court will be the hearing of parties, witnesses or experts. In such instances the competent department may request the competent court to take the evidence on oath or in an equally binding form. *Rule 120(3)*

3.2.2 Evidence taken by a competent court

The competent department will, if necessary, request a competent court to take evidence, where appropriate under oath, where: *Rule 120(3)*

(i) the taking of evidence by that department would entail disproportionately high travelling costs or the taking of evidence by the competent court appears to be appropriate on other grounds;

Rule 120(2)

(ii) the competent department considers it advisable for the evidence of a party, witness or expert it has heard to be re-examined under oath or in an equally binding form (see E-IV, 3.2.1);

Rule 120(1)

(iii) there has been no reply to the summons by the expiry of a period fixed by the competent department in the summons (see E-IV, 1.5(iii)); or

Rule 120(1)
Rule 150(3)

(iv) any party, witness or expert who has been summoned before that department requests the latter in accordance with E-IV, 1.5(iii) to allow their evidence to be heard by a competent court in their country of residence. If the party, witness or expert simply refuses to be heard by the responsible division, they are notified that the competent national court will have the relevant national legal possibilities to oblige them to appear and to testify.

3.3 Letters rogatory

Rule 150(2)

The EPO must draw up letters rogatory in the language of the competent authority or must attach to such letters rogatory a translation into the language of that authority.

Rule 150(1)

Letters rogatory must be addressed to the central authority designated by the contracting state.

3.4 Procedures before the competent authority

Rule 150(5)

The EPO must be informed of the time when, and the place where, the enquiry is to take place and must inform the parties, witnesses and experts concerned.

Rule 120(3)
Rule 150(6)

If so requested by the EPO, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority. Whether the parties may put questions or not will depend on the laws of the contracting states concerned.

3.5 Costs of taking evidence

Rule 150(7)

The execution of letters rogatory does not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the state in which letters rogatory are executed has the right to require the European Patent Organisation to reimburse any fees paid to experts and interpreters and the costs incurred as a result of the attendance of members of the competent department when evidence is taken.

3.6 Taking of evidence by an appointed person

Rule 150(8)

If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the competent department, appoint a suitable person to do so. When seeking the consent of the department concerned, the competent authority must indicate the approximate costs which would result from this procedure. If the competent department gives its consent, the European Patent Organisation must reimburse any costs incurred; without such consent, the Organisation is not liable for such costs.

4. Evaluation of evidence

4.1 General remarks

The competent department must examine whether the conclusions drawn by the parties from the evidence and facts are correct and give grounds for the conclusions it itself freely arrives at on the basis of the situation as a whole.

The state of the art to be taken into consideration in individual cases for the purposes of Art. 54 is that laid down in G-IV, 1 to 5 and 7 and G-V.

The competent department is not obliged to take into consideration any facts or evidence not presented by the parties in due time, except within the limits specified in E-VI, 2.

4.2 Types of evidence

When evaluating submissions made, the difference between facts, evidence and arguments must be observed.

Example:

The opponent asserts that the preamble to claim 1 is described in document A, the characterising portion in document B (facts). To prove this, documents are submitted (evidence). The opponent then contends that the method claimed does not involve an inventive step, because the skilled person, on the basis of common general knowledge, would have combined the submitted documents in such a way as to arrive at the subject-matter of claim 1 (argument).

Evidence admissible in EPO proceedings is not confined to that listed in Art. 117(1). "Taking of evidence" within the meaning of Art. 117 comprises the submission or gathering of evidence of any kind, particularly the filing of documents.

Pure arguments are not evidence (see T 642/92).

4.3 Examination of evidence

When evidence is submitted, the first thing to establish is what fact is being asserted, and then whether that fact is relevant to the decision. If not, the assertion is no longer considered and the evidence is not examined further. If the alleged fact is relevant, the next point is whether it is proven by the evidence submitted.

When evidence is examined, since the EPC says nothing about how the outcome of taking of evidence must be assessed, the principle of unfettered consideration applies. This means that its content and its significance for the proceedings are assessed in the light of the particular circumstances of each individual case (e.g. time, place, type of evidence, position of witness in firm, etc.). The principle of unfettered consideration also means that EPO departments are empowered to evaluate evidence submitted by the parties in any appropriate manner, or indeed to disregard it as unimportant or

irrelevant. In particular it has to be decided on a case-by-case basis when a particular piece of evidence is sufficient.

When deciding whether an alleged fact is accepted, the division may use the criterion of the "balance of probabilities", which means that it is satisfied that one set of facts is more likely to be true than the other. Furthermore, the more serious the issue, the more convincing must be the evidence to support it (see T 750/94). For example, if a decision might result in revocation of the patent in a case concerning alleged prior use, the available evidence has to be very critically and strictly examined. In particular, in the case of alleged prior use for which little if any evidence would be available to the patentee to establish that no prior use had taken place, the division has to cede to the stricter criterion close to absolute conviction, i.e. beyond any reasonable doubt (see T 97/94).

When parties make conflicting assertions, the division must decide which evidence is the most convincing. If it cannot establish which allegation is right on the basis of the evidence put forward, it must decide on the basis of the burden of proof, i.e. against the party bearing that burden but unable to prove its point convincingly.

4.4 Asking for evidence

When pointing out that it cannot accept a line of argument because certain facts have not been proven, the division must do so as neutrally and objectively as possible. In particular, it may neither

(a) require a specific kind of evidence (see T 474/04), nor

(b) prescribe the content of the evidence (e.g. the wording of a sworn statement in writing (see T 804/92).

The taking of evidence in each of the forms listed in Art. 117 is done at the discretion of the EPO department in question, i.e. only if that department considers it necessary. This will be the case, for example, if a fact relevant to the decision needs to be proven.

4.5 Evaluation of the testimony of a witness

After the witnesses have been heard, the party or parties must be given an opportunity of making observations. The observations may be made either in oral proceedings following the taking of evidence or exceptionally in writing after transmission of the minutes of the taking of evidence. The decision on this matter will rest with the competent department. The parties may file requests accordingly.

Only when this has been done may the competent department proceed to evaluate the evidence. Where a witness's testimony which is crucial to the decision has been challenged by a party but the department regards it as credible, or where a witness's oral or written testimony is disregarded in its decision as being not credible, the department concerned must state the grounds for its view in its decision.

In evaluating a witness's oral or written testimony, special attention is to be paid to the following:

(i) what is important is what witnesses can relate concerning the points at issue on the basis of their own knowledge or views, and whether they have practical experience in the field in question. Second-hand assertions based on something heard from third parties are for the most part worthless on their own. It is also important from the point of view of the evaluation whether the witness was involved in the event himself or only knows of it as an observer or listener;

(ii) in the event of long intervals of time (several years) between the event in question and the testimony, it is to be borne in mind that most people's power of recall is limited without the support of documentary evidence;

(iii) where testimony appears to conflict, the texts of the statements concerned are closely compared with one another.

Apparent contradiction in the testimony of witnesses may sometimes be resolved in this way. For example, a close examination of apparently contradictory statements by witnesses as to whether a substance X was commonly used for a particular purpose may show that there is in fact no contradiction at all, in that while one witness was saying specifically that substance X was not used for that particular purpose, the other witness was saying no more than that substances like X, or a certain class of substances to which X belonged, were commonly used for this particular purpose without intending to make any statement regarding substance X itself;

(iv) an employee of a party to the proceedings can be heard as a witness (see T 482/89). The possible partiality of a witness determines how the evidence is assessed, not whether it is admissible (see T 443/93).

4.6 Evaluation of the testimony of parties

Oral or written evidence given by parties or their refusal to give evidence are evaluated in the light of their special interest in the matter. Because of their special interest, the testimony of parties possibly should not be evaluated on the same level as that of neutral witnesses. This applies above all where parties have been present when witnesses have been heard and have ascertained the attitude of the competent department. The considerations set out in E-IV, 4.5 (Evaluation of the testimony of a witness) apply *mutatis mutandis*.

4.7 Evaluation of an expert opinion

The competent department must examine whether the grounds on which an expert opinion is based are convincing. Notwithstanding its discretion in the evaluation of evidence, it may not disregard an expert opinion in the absence of grounds based on adequate specialist knowledge of its own or of another expert, irrespective of whether the latter expert is an

independent expert commissioned under Rule 121 or an expert who testifies at the request of one of the parties.

4.8 Evaluation of an inspection

In the case of a demonstration, a specific test programme under specific conditions is agreed in advance. During the demonstration itself care must be taken to ensure that the characteristics or conditions of operation claimed for the invention are complied with. Where an invention is compared under test with an item forming part of the state of the art, as far as possible the same or comparable test conditions must be applied to both.

Chapter V – Derogations from the language of the proceedings in oral proceedings

1. Use of an official language

Rule 4(1) and (5)

Any party to oral proceedings before the EPO may, in lieu of the language of the proceedings, use one of the other official languages of the EPO, on condition that such party either gives notice to the EPO at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings. In the former case, it is the responsibility of the EPO to provide for interpretation at its own expense.

A party must be clear as to which official language it wishes to use. It then has a right to both speak and hear that language, as long as the conditions of Rule 4 have been fulfilled. The party does not, however, have a right to have one language in which it will speak and a different language in which it will hear (see T 774/05).

The language of the proceedings as defined in Art. 14(3) cannot be changed. This means that any amendments to the application or patent have to be filed in the language of the proceedings (Rule 3(2)).

If all parties have indicated that they will use another official language, the division may depart from the language of the proceedings so as to manage without or with fewer interpreters (this question normally arises only in opposition proceedings). The parties' summonses are therefore accompanied by information which encourages them to agree how this can be achieved.

It may be possible to agree to limit the interpreting to "one-way", i.e. from one language into another but not the other way round. If a comment made in one language has clearly been misunderstood, the division may clarify it in another. Under no circumstances however can its members officially act as interpreters.

2. Language of a contracting state or other language

Rule 4(1) and (4)

Any party may likewise use one of the official languages of the contracting states, other than English, French or German, on condition that they make provision for interpreting into the language of the proceedings. However, if the parties and the EPO agree, any language may be used in oral proceedings without interpreting or prior notice.

3. Exceptions from sections 1 and 2

Rule 4(1)

Derogations from the provisions of Rule 4(1) are permitted, and these are at the discretion of the EPO. Clearly such permission must depend on the circumstances of the individual case. It may, for example, be envisaged that parties are unable to give one month's notice through no fault of their own, and, although they have made arrangements for an interpreter, the latter is unable (e.g. through illness) to attend. If, in such circumstances, the EPO is unable to provide for interpreting, it postpones the oral proceedings if they occur at the examination stage. However, in opposition proceedings,

the oral proceedings continue if the parties agree and the employees of the EPO involved in the proceedings can cope with the language. In other cases, the EPO postpones the oral proceedings and any costs incurred by the innocent party as a result of the postponement are a matter for apportionment under Art. 104.

4. Language used in the taking of evidence

Rule 4(3)

When the evidence is being taken, a party, witness or expert who is unable to express himself adequately in English, French or German or in any other official language of the contracting states is permitted to use another language. The EPO is responsible for interpreting into the language of the proceedings, assuming that this is necessary, if the evidence is taken at the request of the EPO itself. However, if the taking of evidence follows a request by a party to the proceedings, the use of a language other than English, French or German is allowed only if that party provides for interpreting into the language of the proceedings or, at the discretion of the EPO, into any one of English, French or German. This discretion is exercised in opposition proceedings only if the other parties agree.

5. Language used by employees of the EPO

Rule 4(2)

Employees of the EPO may use in oral proceedings an official language of the EPO other than the language of proceedings. The parties must be informed accordingly prior to the oral proceedings, unless it can be reasonably assumed that they would not object to this, e.g. because they have equally requested to use that different official language.

However, employees may not depart from the language of the proceedings without good reason. Unless the parties are competent in the language used, the EPO provides for interpreting into the language of the proceedings at its own expense.

6. Language used in the minutes

Where the official language actually employed in oral proceedings is not the language of the proceedings as defined in Art. 14(3), if the examining or opposition division or the Legal Division considers it appropriate and subject to explicit agreement of all parties concerned, the minutes may be recorded in the language actually employed in the oral proceedings.

Prior to the agreement of the parties, their attention is drawn to the fact that the EPO will not provide translations of the minutes into the language of the proceedings as defined in Art. 14(3). This condition, as well as the declaration of agreement of the party or parties, is recorded in the minutes.

Statements made in English, French or German are entered in the minutes of the proceedings in the language employed.

Statements made in any other language must be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent made during oral proceedings must be entered in the minutes in the language of the proceedings. If the proceedings are conducted in a language other than English, French or German and no interpretation is

effected, statements are entered in the minutes in the language employed and the EPO subsequently provides in the minutes a translation into the language of the proceedings.

Chapter VI – Examination by the EPO of its own motion; facts, evidence or grounds not submitted in due time; observations by third parties

1. Examination by the EPO of its own motion

1.1 General remarks

In proceedings before it, the EPO examines the facts of its own motion; it is not restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought. This principle of examination by the EPO of its own motion must be complied with by the competent department during all proceedings pending before it. Thus, once proceedings have been initiated, e.g. once a valid request for examination has been filed or an admissible notice of opposition has been filed (although it may subsequently be withdrawn), if there is reason to believe, e.g. from personal knowledge or from observations presented by third parties, that there are facts and evidence not yet considered in the proceedings which in whole or in part prejudice the granting or maintenance of the European patent, such facts and evidence must be included in those examined by the EPO of its own motion pursuant to Art. 114(1). See D-V, 2 for the extent of substantive examination of the facts and evidence in opposition proceedings.

Art. 114(1)

1.2 Limits on the obligation to undertake examination

However, the obligation to undertake such examination must be kept within limits in the interests of procedural expediency. For example, in opposition proceedings, an offer to prove that an alleged public prior use took place will not be taken up if the opponent making such an allegation has ceased to participate in the proceedings and the necessary evidence cannot be easily obtained at a reasonable cost.

The unity of the subject-matter of the European patent is not to be examined in opposition proceedings (G 1/91, see D-V, 2.2).

2. Late-filed submissions

The EPO may disregard facts or evidence (e.g. publications) which are not submitted in due time by the parties concerned.

Art. 114(2)

This also applies to grounds for opposition not submitted in due time, together with supporting facts and evidence in opposition proceedings (see D-V, 2.2). Note in this respect that according to G 1/95 and G 7/95, Art. 100(a) does not constitute one single ground for opposition, but has to be considered a collection of individual grounds for opposition, i.e. individual legal bases for objection to the maintenance of a patent. This applies not only to distinctly different objections, such as subject-matter which is not patentable (Art. 52(2)) as compared to subject-matter which is not capable of industrial application (Art. 57), but also to an objection for lack of novelty as opposed to an objection for lack of inventive step.

New arguments based on facts, evidence and grounds constituting the legal and factual framework of the opposition cannot be disregarded.

In deciding whether to admit facts, evidence or grounds for opposition not filed in due time, their relevance to the decision, the state of the procedure and the reasons for belated submission are to be considered. If examination of late-filed grounds for opposition, late-filed facts or late-filed evidence reveals without any further investigation (i.e. ***prima facie***) that they are relevant, i.e. that the basis of the envisaged decision would be changed, then the competent department has to take such grounds, facts or evidence into consideration no matter what stage the procedure has reached and whatever the reasons for belated submission. In that case, the principle of examination by the EPO of its own motion under Art. 114(1) takes precedence over the possibility of disregarding facts or evidence under Art. 114(2) (see T 156/84). Note, however, the limits on the obligation to undertake further examinations as set out in E-VI, 1.2. Otherwise, the department informs the party concerned in the decision, with due regard to Art. 113(1) (see T 281/00), that the facts, evidence and/or grounds for opposition were not submitted in due time and, since they are not relevant to the decision, will be disregarded pursuant to Art. 114(2). On the apportionment of any costs arising from the late filing of facts and evidence, see D-IX, 1.4.

The latest date up to which submissions can be considered at all is the date on which the decision is handed over to the EPO's internal postal service for transmittal to the parties (see G 12/91).

The above applies in written proceedings; in oral proceedings submissions can only be considered up to the pronouncement of the decision (see E-III, 9).

2.1 General principles in opposition proceedings

As far as the assessment of late filing in opposition proceedings is concerned, the rulings of the Enlarged Board of Appeal in G 9/91 and G 10/91 apply. According to these decisions, in principle, the opposition is to be examined to the extent and on the grounds submitted during the period for opposition. Under Art. 114(1) the opposition division may go beyond this framework if *prima facie* maintenance of the patent is prejudiced. The principles developed by the Enlarged Board with respect to new grounds also apply to late-filed facts and evidence (see T 1002/92). Therefore late-filed facts and evidence are to be admitted into the proceedings only if they are *prima facie* relevant, i.e. if they would change the envisaged decision, see E-VI, 2.

If a patent proprietor replies to a notice of opposition by amending the patent, such a request for amendment cannot be considered as late-filed and has to be admitted into the proceedings (Rule 79(1)).

Thus, if the proprietor limits the patent to the subject-matter of a dependent claim as granted, new facts and evidence submitted by the opponent in reply to this amendment are as a general rule to be treated as late-filed and only to be admitted under Art. 114(1) if they are *prima facie* relevant

because the opponent must be prepared for this type of amendment and must have provided material during the nine-month opposition period.

If the new facts and submissions are not *prima facie* relevant, they are to be disregarded under Art. 114(2). An exception to this rule is where the patent specification as granted contained a large number of dependent claims and the opponent could not reasonably have been expected to deal with all of them in the notice of opposition.

If, however, the proprietor amends the patent at an early stage of the proceedings in a manner not foreseeable by the opponent, e.g. by taking up features disclosed in the description, the opponent will have the opportunity to provide new facts and evidence, i.e. possibly even to submit a new ground for opposition and new documents. Such a submission has to be admitted into the proceedings because the subject of the proceedings has changed. At a late stage in the proceedings such unforeseeable amendments are subject to the criterion of "clear allowability" (see H-II, 2.7.1).

2.2 Submissions filed in preparation for or during oral proceedings

If oral proceedings are arranged, the division issues a summons together with an annex drawing attention to the points to be discussed (Rule 116(1)) and normally containing the division's provisional and non-binding opinion (see E-III, 6 and D-VI, 3.2).

2.2.1 New facts and evidence

Rule 116(1), being an implementation of Art. 114(2) as a further development on the existing jurisprudence regarding facts or evidence not filed in due time, makes it clear that the examining or opposition division has a discretion to disregard new facts or evidence for the reason that they have been filed after the date indicated in the summons under Rule 116 unless they have to be admitted because the subject of the proceedings has changed. *Rule 116(1)*

For instance, if the opposition division states in the annex to the summons that the patent is likely to be revoked, and a timely filed request for amendment is admitted but relates to subject-matter not covered by the claims as granted, the subject of the proceedings has changed. Consequently, new facts and evidence submitted by the opponent in response to these requests will be admitted into the proceedings, even if they arrive after the final date set under Rule 116.

However, if the proprietor's requests relate to amendments based only on claims as granted, new facts and evidence submitted by the opponent will be treated as late-filed even if submitted before the final date, i.e. they will be admitted only if they are *prima facie* relevant unless there are other aspects militating in favour of admitting them, such as a large number of dependent claims in the patent as granted (E-VI, 2.1).

Similarly, if in the provisional and non-binding opinion the opposition division reaches the conclusion that maintenance of the patent is not prejudiced by the facts and evidence submitted so far by the opponent, this

fact *per se* does not give the opponent the right to have new facts and evidence admitted into the proceedings, even if submitted before the final date fixed under Rule 116(1).

2.2.2 Amendments filed in preparation for or during oral proceedings

Rule 116(2)

Rule 116(2) imposes the same obligations on the applicant or patent proprietor when submitting new documents which meet the requirements of the EPC (i.e. new amendments to the description, claims and drawings) as Rule 116(1) imposes on the parties in submitting new facts and evidence. Here the division also has the discretion to disregard amendments because they are filed too late before the oral proceedings unless they have to be admitted because the subject of the proceedings has changed.

For example, if new facts and evidence or a new ground of opposition are admitted under Art. 114(1) because they are *prima facie* relevant, a request of the proprietor for corresponding amendment would have to be admitted even if submitted after the above final date because the subject of the proceedings has changed. The same applies if the examining division cites a further relevant document for the first time (H-II, 2.7).

Equally, amendments that are submitted by the applicant or proprietor in due course in response to objections raised by the division which depart from a previously notified opinion may not be rejected as late-filed.

For instance, if the opposition division departs from its provisional opinion set out in the annex to the summons and – contrary to that opinion – concludes during oral proceedings that an objection prejudices the maintenance of the patent, a request of the proprietor for (further) amendment will normally be admitted into the proceedings.

2.2.3 Principles relating to the exercise of discretion

Art. 114(2), Rule 116(1) and Rule 116(2)

In exercising its discretion under Art. 114(2) and Rule 116(1) and (2), the division will in the first place have to consider the relevance of the late-filed facts or evidence (see E-VI, 2) or the allowability of the late-filed amendments on a *prima facie* basis. If these facts or evidence are not *prima facie* relevant, i.e. if they do not appear to affect the outcome of the proceedings (T 320/15) or if these amendments are clearly not allowable (see H-II, 2.7.1), they will not be admitted.

For instance, if the opposition division states in the annex to the summons that the patent is likely to be revoked and the proprietor in response submits amendments after the final date set under Rule 116(1), possibly not until the oral proceedings, the division could, in principle, treat such requests as late-filed and apply the criterion of "clear allowability" (see H-II, 2.7.1) in judging whether they can be admitted into the proceedings. However, the division will consider admitting such requests into the proceedings if they relate to the subject-matter of dependent claims as granted.

For the purpose of admissibility, a late-filed document's relevance is normally decided relative to the amended claims against which it is cited. Documents that have limited relevance to an initial set of claims may

acquire new relevance as a result of subsequent amendments to those claims (T 366/11).

Before admitting these submissions, the division will next consider procedural expediency, the possibility of abuse of the procedure (e.g. one of the parties is obviously protracting the proceedings) and the question whether the parties can reasonably be expected to familiarise themselves in the time available with the new facts or evidence or the proposed amendments.

As regards procedural expediency, where the late-filed facts or evidence are relevant but their introduction would cause a prolonged adjournment of the proceedings, the division may decide not to admit these facts or evidence in the proceedings. An example would be where the witness still has to be found or lengthy tests are still necessary. The division may, however, also postpone the proceedings and in doing so may have to consider the apportionment of costs in opposition proceedings (Art. 104). Similarly, if late-filed requests are based on subject-matter not previously covered by the claims, they will normally not be admitted into the proceedings also for reasons of procedural efficiency. Admission of such requests could give rise to a postponement of oral proceedings and to a decision on apportionment of costs.

Examples of possible abuse of the proceedings would be:

– The patent proprietor introduces at short notice a proliferation of auxiliary requests which are not a reaction to the course of the proceedings.

– The opponent knowingly abstains from raising an assertion of public prior use based on its own activities until late in the proceedings, even though the evidence in its support had become fully available earlier (see T 534/89).

– The applicant or patent proprietor presents a large number of requests or incomplete variants of requests and invites the division to choose, shifting the responsibility for determining the content of the application or patent to the division. It is the duty of any party to proceedings to make its own case and to formulate its own requests (see T 446/00).

Concerning the question of whether the parties can reasonably be expected to familiarise themselves in the time available with the new facts or evidence or the proposed amendments:

– It may only become apparent in the oral proceedings that the pending request submitted to overcome grounds for opposition is not allowable under the EPC. The opponent must always expect to have to discuss subject-matter based on dependent claims as granted if they are reasonable in number.

2.2.4 Right to be heard

Art. 113(1)

Generally, the parties must be heard before the division decides on whether or not to admit late-filed submissions.

For instance, if the opponent introduces a new ground for opposition during oral proceedings, they must always be granted the right to be heard, even where the arguments concern a late-filed ground for opposition and new arguments and evidence related to it. Similarly, where the opponent files pertinent new material, the patent proprietor must be given a chance to present comments and submit amendments. If the opposition division approves the introduction of new facts or evidence and if the other parties have not had sufficient time to study them, it grants, where easily comprehensible subject-matter is involved, the parties an opportunity to familiarise themselves with it, possibly by briefly interrupting the oral proceedings. If this is not feasible, the other parties must, upon request, be given the opportunity to comment in the proceedings subsequent to the oral proceedings, where appropriate in a further set of oral proceedings. Where possible, however, oral proceedings will not be adjourned.

Where possible, legal commentaries, decisions (of a board of appeal, for example) and reports on legal decisions which are to be referred to in oral proceedings must be notified to the opposition division and the other parties in good time before the proceedings. They may, however, be quoted or submitted for the first time in the oral proceedings themselves if the opposition division agrees after consulting the parties.

2.2.5 Costs

In opposition, relevant facts and evidence submitted at a late stage of the proceedings, possibly not until the oral proceedings for example, could give rise to a decision on apportionment of costs, see D-IX, 1.2, if so requested. As regards the costs which may be incurred for late submissions, see also D-IX, 1.4.

3. Observations by third parties

Art. 115
Rule 114(1)

Following publication of the European patent application under Art. 93, any person may present observations concerning the patentability of the invention. Although lack of novelty and/or inventive step are the most common observations, third-party observations may also be directed to clarity (Art. 84), sufficiency of disclosure (Art. 83), patentability (Art. 52(2) and (3), 53 or 57) and unallowable amendments (Art. 76(1), 123(2) and 123(3)).

Such observations must be filed in writing in English, French or German and must include a statement of the grounds on which they are based. The person filing them may not be a party to the proceedings before the EPO. The web interface provided by the EPO is the preferred means of filing such observations (see OJ EPO 2017, A86).

Rule 3(3)

Documentary evidence and, in particular, publications submitted in support of the arguments may be filed in any language. However, the EPO may request that a translation into one of its official languages be filed within a period to be specified; otherwise the evidence will be disregarded.

Although third parties are sent acknowledgment of the receipt of their observations (if these were not filed anonymously), the EPO does not specifically inform them of any further action it takes in response to them. However, the outcome of the evaluation by the competent division will briefly be indicated in the respective office action from the EPO (e.g. in a communication or in the intention to grant) and will thus be visible to the public.

The EPO will make every effort to issue the next office action within three months of receipt of third-party observations under Art. 115 by the examining division, provided the observations are substantiated and have not been filed anonymously. Where the observations are received at a time when a reply from the applicant to a communication is outstanding, this period starts from receipt of the reply at the EPO.

Rule 114(2)

The observations are communicated to applicants or proprietors without delay and they may comment on them. If they call into question the patentability of the invention in whole or in part, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated. If the observations relate to alleged prior art available other than from a document, e.g. from use, this is taken into account only if the alleged facts either are not disputed by the applicant or proprietor or are established beyond reasonable doubt. Observations by third parties received after the decision to grant/refuse the application has been pronounced in oral proceedings or issued in written proceedings (see G 12/91) will be included in the file without taking note of their content. Observations by third parties received once proceedings are no longer pending (e.g. after publication of the mention of the grant) will be neither taken into account nor made available for file inspection. They will however be made available for file inspection upon the start of opposition proceedings.

The EPO will generally apply the practice regarding third-party observations filed in the Euro-direct procedure *mutatis mutandis* to third-party observations filed during the international phase upon entry of the Euro-PCT application into the European phase.

Where a third-party observation was filed during the international phase, the EPO as designated/elected Office will consider its content upon entry into the European phase once this becomes available to it. The examining division will make every effort to issue the next office action within three months after expiry of the period under Rule 161 EPC, but only on condition that the third party has clearly expressed its wish to achieve expedited treatment in the European phase, that the observation was filed non-anonymously and that it was substantiated. A third party wishing to achieve such a result in the European phase must, therefore, make this clear in the observation or file the observation with the EPO as designated/elected Office.

4. External complaints

External complaints can concern any service or product delivered by the EPO and can be submitted by any person, including parties to proceedings

before the EPO (for enquiries as to the processing of files, see E-VIII, 7). Complaints can be submitted using the online form available at epo.org/complaint.

Complaints are forwarded to a dedicated EPO department responsible for

(i) ensuring that the complaint is dealt with fairly and efficiently and that suitable measures are taken to address it; and

(ii) providing a comprehensive reply to the complaint.

The complaint handling procedure does not replace the procedures laid down by the EPC; nor does the department responsible for handling complaints take decisions on procedural requests. Hence, the relevant department competent for the respective proceedings decides on:

(a) complaints relating to procedural and/or substantive aspects of specific pending proceedings which are submitted by a party to those proceedings. All parties to the proceedings will be informed accordingly.

(b) complaints relating to substantive issues which are submitted by a third party while proceedings are pending before the EPO. Such a submission will be treated as a third-party observation (see E-VI, 3).

The department responsible for handling complaints promptly forwards any complaint relating to appeal proceedings to the EPO Boards of Appeal Unit.

Art. 128(4)
Rule 144(d)

Complaints having a substantive and/or procedural bearing on proceedings before the EPO, as well as replies thereto by the department responsible for handling complaints, will only exceptionally be excluded from file inspection (see D-II, 4.3; Decision of the President of the EPO concerning documents excluded from file inspection, OJ EPO 2007, Special edition No. 3, J.3).

Chapter VII – Interruption, stay and consolidation of the proceedings

1. Interruption

1.1 Cases in which the proceedings may be interrupted

Pursuant to Rule 142(1), proceedings before the EPO are interrupted in one of the following events: *Rule 142(1)*

(i) in the event of the death or legal incapacity of the applicant for or proprietor of a European patent or of the person authorised by national law to act on their behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Art. 134, proceedings will be interrupted only on application by such representative; *Rule 142(1)(a)*

(ii) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against their property, being prevented by legal reasons from continuing the proceedings before the EPO; or *Rule 142(1)(b)*

(iii) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European patent or of their being prevented for legal reasons resulting from action taken against their property from continuing the proceedings before the EPO. *Rule 142(1)(c)*

In principle, the EPO interrupts proceedings pursuant to Rule 142 *ex officio*. In the case of Rule 142(1)(a) last sentence, however, proceedings are interrupted on request only.

1.2 Responsible department

The Legal Division of the EPO bears sole responsibility for the interruption and resumption of proceedings under Rule 142 (see the Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). *Art. 20*

1.3 Date of interruption

An interruption is registered (in general retroactively) with legal effect from the date of the occurrence of the event. In cases where proceedings are interrupted on request, the interruption is effected as from the date of receipt of the request at the EPO.

The parties are informed of the interruption of proceedings and the reasons for it. The date of interruption as well as the date of resumption of proceedings are recorded in the European Patent Register. *Rule 143(1)(t)*

1.4 Resumption of proceedings

When, in the cases referred to in Rule 142(1)(a) or (b), the EPO has been informed of the identity of the person authorised to continue the proceedings before the EPO, it notifies that person and, where applicable, any third party, that the proceedings will be resumed as from a specified date. The date is set in such a manner as to allow this person to familiarise himself with the matter. *Rule 142(2)*

If, three years after the publication of the date of interruption in the European Patent Bulletin, the EPO has not been informed of the identity of the person authorised to continue the proceedings, it may set a date on which it intends to resume the proceedings of its own motion.

This date may be postponed upon reasoned request and submission of relevant documentary evidence in the case of a claim of succession in title in respect of the European patent application/European patent concerned.

As a consequence of the *ex officio* resumption, the proceedings will continue with the applicant/proprietor registered in the European Patent Register, and procedural actions may become necessary and/or fees due (see also the Notice from the EPO dated 29 May 2020, OJ EPO 2020, A76).

Communications and decisions of the EPO which have been notified during the interruption period are to be regarded as null and void and will be notified anew after resumption of proceedings by the responsible department.

Rule 142(3)

In the case referred to in Rule 142(1)(c), the proceedings will be resumed when the EPO has been informed of the appointment of a new representative of the applicant or when the EPO has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, the EPO has not been informed of the appointment of a new representative within a period of three months after the beginning of the interruption of the proceedings, it communicates to the applicant for or proprietor of the patent:

Rule 142(3)(a)

(i) where Art. 133(2) (mandatory appointment of a representative) is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified; or

Rule 142(3)(b)

(ii) where Art. 133(2) is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

A copy of the communication will be forwarded to the other parties.

1.5 Resumption of time limits

Rule 142(4)

Time limits in force on the date of interruption of the proceedings begin again, in their original length, as from the day on which the proceedings are resumed, with the exception of the time limits for requesting examination and for paying renewal fees.

If the time limit for filing the request for examination is in force on the date of interruption of the proceedings, it is suspended (J 7/83; see also E-VIII, 1.4). Thereafter it resumes for the time it still has to run, or for at least the two months prescribed by Rule 142(4), second sentence.

Concerning renewal fees falling due during the period of interruption, Rule 142(4) has to be interpreted as deferring the due date for their payment until the date the proceedings are resumed (J 902/87). Thus, such renewal fees may be paid without additional fee at the date of resumption and in the amounts applicable on that date. They may also be paid within six months of said date, provided that an additional fee is also paid within said period (Rule 51(2)).

If the time limit for paying renewal fees with the additional fee referred to in Rule 51(2) is in force on the date of interruption of the proceedings, it is suspended and begins to run again for the remaining period on the date of resumption.

2. Stay of proceedings under Rule 14 due to pending national entitlement proceedings

Rule 14(1)

If third parties provide evidence that they have instituted proceedings against the applicant seeking a decision within the meaning of Art. 61(1), the proceedings for grant are stayed unless the third parties communicate to the EPO in writing their consent to the continuation of proceedings. This consent is irrevocable. For further details see A-IV, 2.2 and subsections, and D-VII, 4.1.

3. Stay of proceedings when a referral to the Enlarged Board of Appeal is pending

Where a referral to the Enlarged Board of Appeal is pending and the outcome of examination or opposition proceedings depends entirely on the answer to the questions referred to the Enlarged Board of Appeal, the proceedings may be stayed by the examining or opposition division on its own initiative or on request of a party or the parties.

The party/ies will be informed of the intention to stay the proceedings. If no reply is received from the party/ies with regard to the intention to stay, or if the party/ies explicitly agree(s), the proceedings will be stayed and the party/ies will be informed thereof. If the party/ies do(es) not agree in writing with the intention to stay, and if the examining or opposition division maintains its opinion, a decision to stay will be despatched. A decision to stay the proceedings or refusing a request to stay is not separately appealable; it can only be appealed together with the final decision on the application/patent (see E-X, 3).

During the stay of proceedings, a PACE request will have no effect. After their resumption, proceedings are again accelerated. Where the proceedings are not stayed, they will be decided according to existing practice.

A stay of proceedings due to dependency on a referral to the Enlarged Board of Appeal is to be distinguished from a stay of proceedings pursuant to Rule 14 (see E-VII, 2).

4. Consolidation of proceedings

The examining or opposition division or the Legal Division may consolidate proceedings if this is considered useful in order to expedite proceedings in the specific circumstances of the case (see J 17/92).

Consolidation is considered *inter alia* if the parties and the underlying facts of the proceedings are identical. It is for the responsible division to decide whether proceedings are to be consolidated in the interest of procedural efficiency and with a view to expediting proceedings and, if so, for what purpose. Consolidation may concern the entire procedure or only individual procedural steps such as the taking of evidence or the conduct of oral proceedings.

The parties are to be informed of consolidation. This information includes a statement about the purpose of consolidation. Where proceedings are consolidated for the taking of evidence, this is to be notified in the order to take evidence and in the annex to the summons to oral proceedings. These must be sent to all parties to the consolidated proceedings. Likewise, submissions from the parties filed in respect of only one of the proceedings which are relevant to the consolidated parts of the proceedings must be included in all the files concerned.

Upon fulfilment of its purpose, consolidation is to be set aside and the proceedings are to be continued separately. Again, the parties must be informed accordingly.

A decision to consolidate proceedings is not subject to a separate appeal but may be appealed only together with the final decision, unless the decision allows a separate appeal (see E-X, 3). The same applies *mutatis mutandis* to a decision setting aside consolidation.

Chapter VIII – Time limits, loss of rights, further and accelerated processing and re-establishment of rights

1. Time limits and loss of rights resulting from failure to respond within a time limit

1.1 Determination of time limits

Art. 120
Rule 131

The EPC imposes time limits upon parties to proceedings. In the EPC, a "time limit" is a period of time of defined duration, calculated in full years, months, weeks or days, by reference to a relevant event (J 18/04), within which an act vis-à-vis the EPO has to be completed.

Some of these are fixed by the articles of the EPC, e.g. Art. 87(1) (priority period) and Art. 99(1) (opposition). Others are fixed in the Implementing Regulations, e.g. in Rule 30(3) (payment of late-furnishing fee), Rule 38 (payment of filing and search fee), Rule 39(1) (payment of designation fees), Rule 58 (correction of deficiencies in application documents), Rule 70(1) (request for examination), Rule 71(3) (filing translations of the claims and payment of fees for grant and publishing) and Rule 112(2) (applying for a decision after notification of loss of rights).

Others take the form of a stipulated range, the precise period within this range being at the EPO's discretion.

In other cases, e.g. those dealt with in Rule 3(3) (filing translation of documentary evidence), or Rule 70(2) (invitation to applicants to indicate whether they desire to proceed further with the European patent application), a period, but not its duration, is provided for in the EPC. The duration must be specified by the EPO in accordance with Rule 132 (see E-VIII, 1.2).

1.2 Duration of the periods to be specified by the EPO on the basis of EPC provisions

The length of such periods is based, in principle, on the amount of work which is likely to be required to perform the operation in question (minimum of two months, maximum of four months, exceptionally six months). However, in order to facilitate the work of parties and the EPO it has been decided, as a general rule, to adopt a uniform practice with respect to time limits. This practice is at present as follows:

(i) if deficiencies to be corrected are merely formal or merely of a minor character; if simple acts only are requested, e.g. under Rule 83 the subsequent filing of documents referred to by a party; or if observations are required on amendments which are merely of a minor character – two months;

(ii) communications from an examining or opposition division raising matters of substance – four months;

(iii) communications from the Legal Division – two months.

Where a communication according to Art. 94(3) in examination is accompanied by a request for a translation of a priority document (Rule 53(3)), the period set for reply to that communication and for providing the translation is the same and is at least four months, regardless of the severity of the objections raised in the communication according to Art. 94(3) (see also A-III, 6.8.2).

Rule 70(2)

A longer time limit of up to six months is set only in the exceptional cases where it is clear that in the circumstances a four-month time limit cannot be adhered to. Each case must be judged on its individual merits and it is difficult to give general guidance, but a six-month time limit might be justified if for example the subject-matter of the application or patent or the objections raised are exceptionally complicated. Note that in this case an extension of the time limit (i.e. beyond six months) will be allowed only in exceptional cases (E-VIII, 1.6). Where the applicant is invited to submit the indication provided for in Rule 70(2), a six-month time limit running from the publication of the search report is appropriate.

1.3 Time limits which may be freely determined

Time limits for operations in respect of which the setting of a time limit is not explicitly provided for in the EPC are not subject to the restrictions as to the duration of time limits laid down in Rule 132. They may be fixed by the EPO at its own discretion.

1.4 Calculation of time limits

Rule 131
Rule 134

Although Rule 131 allows other possibilities, any period fixed by the EPO will usually be specified in full months which will be calculated from the date of notification (see E-II, 2). Rule 131 gives precise details for the determination of the day of expiry of the period, whilst Rule 134 contains provisions covering certain contingencies (see E-VIII, 1.6).

Rule 142

When proceedings have been interrupted because of the death of the applicant or proprietor or for any of the other reasons specified in Rule 142 (see E-VII, 1.1), time limits are subject to the provisions of Rule 142(4). The time limits for the payment of the examination fee and the renewal fees are suspended (see E-VII, 1.5). The time limits in force at the date of the stay of proceedings under Rule 14 due to national entitlement proceedings, with the exception of those for payment of the renewal fees, are interrupted. Rule 14(4) applies to the calculation of time limits after the resumption of proceedings (see A-IV, 2.2.4).

1.5 Effect of change in priority date

Art. 88(2)

Certain time limits run from the date of priority, or in the case of multiple priorities, from the earliest date of priority. Where this date no longer applies (e.g. the right of priority is lost in accordance with the provisions of Art. 90(5)), any such time limits become determinable from the amended date of priority. This does not restore any loss of rights resulting from a time limit having already expired before the loss of priority date. Part A of the Guidelines deals with the procedure to be followed (see A-III, 6.9 to 6.11).

1.6 Extension of a time limit

1.6.1 Extension of time limits set by the EPO under Rule 132

Rule 132

Other than in cases in respect of which the EPC specifies a fixed period which may not be extended, the duration of time limits may be extended on request. The request must be submitted in writing before expiry of the period that has been set. The extended period is to be calculated from the start of the original period.

In opposition proceedings, requests to extend time limits over and above the normal period of four months, both for communications from an opposition division raising matters of substance and communications issued by the formalities officer, or two months for communications requesting an act of a merely formal or minor character (E-VIII, 1.2), will only be granted in exceptional, duly substantiated cases. For a communication under Art. 101(1) and Rule 79 or Rule 81(2) and Rule 81(3), all parties to the proceedings can request an extension irrespective of whether they were invited in the communication to reply: if the extension is, exceptionally, granted to one of the parties, it automatically applies to all other parties.

In other proceedings, a request for extension, even if filed without reasons, is normally allowed if it is for not more than two months and the total period set does not thereby exceed six months. A request for a longer extension, especially if the total period set exceeds six months, is allowed only exceptionally, when the reasons given are sufficient to show convincingly that a reply in the period previously set will not be possible. Such exceptional circumstances might be e.g. the fact that representatives or clients are so seriously ill that they cannot deal with the case in time; or the need to perform extensive biological experiments or tests. On the other hand, foreseeable or avoidable circumstances (e.g. leave, pressure of other work) are not accepted as a sufficiently exceptional circumstance (see Notice of the Vice-President of Directorate-General 2 of the EPO, OJ EPO 1989, 180).

If the request for an extension is granted, the parties are informed of the new time limit. Otherwise, they are told that the relevant sanction has taken effect or will take effect.

An application will be removed from the PACE programme (see E-VIII, 4) if the applicant has requested an extension of a time limit (OJ EPO 2015, A93, point A.4).

In examination proceedings, failure to respond to a communication according to Art. 94(3) results in deemed withdrawal of the application (see E-VIII, 1.8 and E-VIII, 1.9.2).

Art. 106(2)

If the request for extension of a time limit filed in good time has been rejected and any applicant considers this unjust, they can only overcome the ensuing loss of rights by requesting a decision under Rule 112(2) and/or further processing under Art. 121(1) and Rule 135(1) (see E-VIII, 2), as applicable. Where the reimbursement of the fee for further processing is

requested and this is rejected, such decision is open to appeal, either together with the final decision or separately, as the case may be (see J 37/89).

The failure of a party to reply to a communication from the opposition division within the period set does not lead directly to any legal consequence. Rather, the opposition proceedings will proceed to the next stage, and this could be a decision under Art. 101(2) or (3).

1.6.2 Extension of periods under Rule 134

1.6.2.1 Extension of periods under Rule 134(1)

Rule 134(1)

Periods that expire on a day on which at least one of the filing offices of the European Patent Office (i.e. Munich, The Hague or Berlin) is not open for receipt of documents (e.g. because a public holiday is observed at the location of the EPO's filing office) or on which mail is not delivered for other reasons (with the exception of a general dislocation in the transmission or delivery of mail, which is subject to the provision of Rule 134(2) – see E-VIII, 1.6.2.3) are extended to the first day thereafter on which all the filing offices are open again for receipt of documents and on which mail is delivered.

An extension pursuant to Rule 134(1) also applies in the event that any one of the means of electronic filing provided by the EPO under Rule 2(1) is not available, regardless of any restrictions on the documents which may be filed by the means of electronic filing that suffered the outage.

– If a means of electronic filing is unavailable for four hours or more because of scheduled maintenance, Rule 134(1), second sentence, applies. If the unavailability of a means of electronic filing lasts less than four hours and is announced at least two working days in advance, Rule 134(1), second sentence, does not apply.

– In the case of unplanned outages, users who are unable to file a document should contact the EPO's Customer Services. If it is confirmed that the unavailability of the service is attributable to the EPO, said users will not suffer any adverse consequences; they may also request that the EPO declare under Rule 134(1), second sentence, that the missed period is extended to the date on which the document was filed.

– If a payment period expires on a day on which one of the accepted means of making payment to the EPO for a Euro-direct or Euro-PCT application is unavailable, the payment period is extended to the first working day thereafter on which all such means of making payment are available unless the outage lasts less than four hours and is announced at least two working days in advance.

For further details see OJ EPO 2020, A120.

1.6.2.2 Extension of periods under Rule 134(2) and Rule 134(5)

Rule 134(2) and (4)

Where there is a general dislocation in the delivery or transmission of mail in a contracting state, any period expiring during such dislocation is extended for parties who are resident in the state concerned or have appointed a representative with a place if business in that state. Where the state concerned is the state in which the EPO is located, the extension applies to all parties and representatives, irrespective of their residence. The beginning and the end of the period of such general dislocation is published in the Official Journal.

Rule 134(5)

Equally, where an individual party can provide evidence of a dislocation of the delivery or transmission of mail due to an exceptional occurrence inside or outside EPC contracting states (such as, in particular, a natural disaster, war, civil disorder or a general breakdown of any of the means of electronic communication accepted by the EPO for the filing of documents), a late submission or payment will be deemed to be received in due time, provided that

– the dislocation affected the locality where that party or their representative resides or has their principal place of business,

– the dislocation existed on any of the last ten days of the period at issue, and

– the transmission or payment is effected within five days from the end of the dislocation, together with

– a formal request of the party concerned under Rule 134(5), accompanied by appropriate evidence.

1.6.2.3 Scope of application of Rule 134

An extension under Rule 134 applies to all periods under the EPC (see E-VIII, 1.1), including, in particular:

– the time limits for the filing of submissions, e.g. replies to EPO communications;

– the time limit under Rule 37(2) for the onward transmission to the EPO of applications filed with the central industrial property office of a contracting state (see A-II, 1.6);

– the priority period under Art. 87(1) (see A-III, 6.6);

– the opposition period under Art. 99(1);

– the period for entry into the European phase under Rule 159(1);

– the periods for the payment of fees (see A-X, 6.1), including, *mutatis mutandis*, the expiry of the period to pay renewal fees with an additional fee in accordance with Rule 51(2) and the expiry of the periods under Rule 51(3) and (4) (see A-X, 5.2.4).

By contrast, an extension under Rule 134 does not affect:

– the pendency of the earlier application when filing a divisional application (see A-IV, 1.1.1);

– the beginning of the six-month period for the payment of a renewal fee with an additional fee under Rule 51(2) unless the due date for the renewal fee is deferred to the expiry of a period, for instance in the case of Rule 159(1)(g) (see A-X, 5.2.4);

– the due date for the renewal fees for a divisional application and the beginning of the four-month period under Rule 51(3) (see A-IV, 1.4.3);

– the date of the start of the search, which is relevant for the entitlement to a refund of the search fee (see A-X, 10.2.1);

– the date of the start of substantive examination, which is relevant for filing a PPH request (see E-VIII, 4.3) or the entitlement to a refund of the examination fee (see A-VI, 2.5);

– the date on which a request under Rule 22 (registration of transfers) or Rule 54 (certified priority document) is deemed to be filed, where the payment date is decisive, because these requests are deemed to have been filed only when the corresponding administrative fee has been paid.

The extension equally does not affect the final date for making written submissions in preparation for oral proceedings under Rule 116, strictly speaking. However, a general dislocation in the delivery of mail or other exceptional occurrence under Rule 134(5) will be taken into account by an examining or opposition division in exercising its discretion whether to admit submissions filed after the date set under Rule 116 (see E-III, 8.5, sub-item (iv)). Given that the date fixed under Rule 116 is meant to ensure adequate preparation of the oral proceedings, a party making submissions after that date must show that it has taken reasonable efforts to do so as early as reasonably possible.

1.7 Late receipt of documents

Rule 133(1)

If a document received late was delivered to a recognised postal service provider at least five days before expiry of the time limit and was received no later than three months after expiry of the time limit, it will be deemed to have been received in due time under Rule 133. The five days are calendar days, not working days. This legal fiction applies to all time limits to be observed vis-à-vis the EPO and/or the national authorities, including the priority period laid down in Art. 87(1). Despite this legal fiction that the time limit has been observed, the filing date of the document remains the day on which it was actually received.

Recognised postal service providers are the designated operators within the meaning of Article 1 of the Universal Postal Convention as well as Chronopost, DHL, Federal Express, flexpress, TNT, SkyNet, UPS and

Transworld (see the Decision of the President of the EPO dated 11 March 2015, OJ EPO 2015, A29). The document must have been sent as a registered letter or equivalent and, if posted outside Europe, by airmail. At the request of the EPO, confirmation of receipt by the postal service provider must be provided as evidence that the document was delivered in due time.

1.8 Failure to respond within a time limit

If a party has not acted within a time limit, various sanctions may be applied depending on the circumstances. For instance, under Art. 90(2) and Rule 55 the application will not be proceeded with; under Art. 90(5) the application will be refused or a right of priority lost; under Rule 5 a document may be deemed not to have been received. If the request for examination has not been filed in time, the application is deemed to be withdrawn (Art. 94(2)), and this sanction may also apply in those cases where the applicant fails to meet a time limit set by the EPO (e.g. the time limit for replying to an invitation to amend under Art. 94(3)).

If a particular time limit is not complied with and, in contrast to cases where mandatory legal sanctions are laid down (e.g. revocation of the European patent if the publishing fee is not paid in due time (Rule 82(3)), no specific legal sanction is laid down in the EPC, submissions and requests from the parties made after expiry of the time limit but before a decision is handed over to the EPO's internal postal service for transmittal to the parties are to be regarded in the rest of the proceedings as if they had been received in time (see G 12/91); any facts or evidence are, however, to be treated as not filed in due time (Art. 114(2), see also E-VI, 1.2).

1.9 Loss of rights

1.9.1 Cases of loss of rights

If a party to the proceedings or a third party fails to comply with a time limit laid down in the EPC or fixed by the EPO, this will result in a loss of rights in certain cases specified in the EPC, without any decision concerning the refusal of the European patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence.

Rule 112

1.9.2 Noting and communication of loss of rights

If there has been a loss of any right as described in E-VIII, 1.9.1, a formalities officer will note such loss of rights and communicate this to the person concerned. The communication will be notified to the person concerned as a matter of course (see also D-IV, 1.4.1).

Art. 119
Rule 112(1)

1.9.3 Decision on loss of rights

If the party concerned considers that the finding of the EPO is inaccurate, they may, within two months after notification of the communication, apply for a decision on the matter by the EPO.

Rule 112(2)

The competent department of the EPO will give such a decision only if it does not share the opinion of the person requesting it; otherwise it will inform the person requesting the decision and then continue with the proceedings. Since such decisions are subject to appeal, the reasons on

which they are based must be stated. Only the person affected by the loss of rights noted will be party to the proceedings.

The request under Rule 112(2) for a review of the accuracy of the communication under Rule 112(1) exists in parallel to the legal remedies against the loss of rights. It is advisable to apply for the appropriate legal remedy as an auxiliary request to that under Rule 112(2) in order to observe the relevant time limit for that request (see E-VIII, 2 and E-VIII, 3.1.3). The competent department will deal with the request under Rule 112(2) first. If it is allowable, all other requests are redundant and any related fees paid will be refunded. If it is not allowable, one decision will deal with the various requests in the order in which they were filed. If applicants fail to observe the time limit for requesting a decision under Rule 112(2), they may still apply for re-establishment of rights under Art. 122(1) and Rule 136(1) in respect of that time limit.

2. Further processing

Art. 121(1) and (2)
Rule 135(1) and (3)
Art. 2(1), item 12, RFees

If the European patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit vis-à-vis the EPO, the application is allowed to proceed if the applicant makes a request for further processing of the application within two months of the communication concerning either the failure to observe a time limit or a loss of rights. Further processing must be requested by payment of the prescribed fee. The omitted act must be completed within the period for making the request. The request is not deemed to have been filed until the respective fee for further processing has been paid. If the fee for further processing has been paid in due time but the omitted act has not been completed within the period for making the request, the request is inadmissible.

If several acts have the same legal basis, they form a unitary procedural act and are subject to a unitary time limit (see J 26/95). Further processing in respect of such a time limit is subject to the payment of a single fee for further processing. The amount of the single fee depends on the number and character of the omitted acts forming the unitary procedural act.

The following examples serve to illustrate this:

– Requesting examination under Art. 94(1) in conjunction with Rule 70(1) requires filing a written request for examination and paying the examination fee. As both actions have the same legal basis, they form a unitary procedural act subject to a unitary time limit. If both actions were omitted, the single fee for further processing amounts to the sum of the flat fee and 50% of the examination fee (Art. 2(1), item 12, first and third indents, RFees). If only the examination fee was not paid in due time, the fee for further processing amounts to 50% of the examination fee (Art. 2(1), item 12, first indent, RFees). If only the written request for examination was omitted, the fee for further processing amounts to the flat fee (Art. 2(1), item 12, third indent, RFees).

– The filing fee and the additional fee due if the application comprises more than 35 pages must be paid within the time limit set by Rule 38(1) and (2). As the additional fee is part of the filing fee, the payment of these two fees forms a unitary procedural act subject to a unitary time limit. Hence, one fee for further processing is due. If both fees were not paid in due time, the single fee for further processing comprises 50% of the filing fee and 50% of the additional fee (see Art. 2(1), item 12, first indent, RFees). If only one fee was not paid in due time, the single fee for further processing amounts to 50% of that omitted fee (see Art. 2(1), item 12, first indent, RFees).

An exception to the above principle concerns Rule 71(3):

– Approval of the text communicated under Rule 71(3) requires paying the fee for grant and publishing and, where applicable, claims fees (Rule 71(4)) and filing the translations of the claims within a four-month period (Rule 71(5)). As these actions have the same legal basis, they form a unitary procedural act subject to a unitary time limit. By way of exception to the principle that the single fee for further processing is computed on the basis of the number of omitted acts, Art. 2(1), item 12, second indent, RFees stipulates that only one flat fee for further processing is due in the event of late performance of any or all of the acts required under Rule 71(3), i.e. paying the fee for grant and publishing and filing the translations of the claims. If in addition claims fees were not paid in due time, the single fee for further processing amounts to the sum of the flat fee **and** 50% of the claims fees (see Art. 2(1), item 12, second and first indent, RFees). If only the claims fees were not paid in due time, the single fee for further processing amounts to 50% of the claims fees (Art. 2(1), item 12, first indent, RFees). For European patent applications filed before 1 April 2009 and international applications entering the European phase before that date, any page fees under Art. 2(2), item 7.2, RFees are part of the fee for grant and printing. Therefore, if only page fees were not paid in due time, the fee for further processing amounts to the flat fee (Art. 2(1), item 12, second indent, RFees).

Actions not forming a unitary procedural act are subject to time limits expiring independently of one another, each resulting in the application being deemed withdrawn. If such time limits expire on the same date, the missing of each independent time limit results in the application being deemed withdrawn (see J 26/95). This applies regardless of whether the applicant is informed of the non-performance of procedural acts in one communication or in several communications. In such cases, a fee for further processing is due in respect of each unobserved time limit. For an example, see E-VIII, 3.1.3.

A request for further processing may also be filed between expiry of the unobserved time limit and notification of the communication concerning either the failure to observe a time limit or a loss of rights.

The department competent to decide on the omitted act also decides on the request for further processing.

Where the omitted act is a substantive response (e.g. to the extended European search report or to a communication under Art. 94(3)), a mere procedural request (e.g. a request for oral proceedings) does not qualify as completion of the omitted act and therefore cannot lead to further processing being granted (see B-XI, 8 and C-IV, 3).

Rule 135(2)

As a general rule, further processing is the legal remedy for failure to observe a time limit during proceedings before grant, even where the consequence is a partial loss of rights (e.g. loss of priority right). However, the possibility of requesting further processing is ruled out for the periods referred to in Art. 121(4) and Rules 6(1), 16(1)(a), 31(2), 36(2), 40(3), 51(2) to (5), 52(2) and (3), 55, 56, 58, 59, 62a, 63, 64, 112(2) and 164(1) and (2).

3. Re-establishment of rights

Art. 122(1)

An applicant for or proprietor of a European patent who, despite taking all due care required by the circumstances, was unable to observe a time limit vis-à-vis the EPO may apply to have their rights re-established.

3.1 Admissibility of the request

3.1.1 Time limits covered

Art. 122(1)

Failure to observe the time limit must have the direct consequence of causing the refusal of the European patent application or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress. This means, for example, that in opposition proceedings there can be no re-establishment of rights in respect of the time limits for the patent proprietor's submission of observations on the written statements of the other parties to the proceedings or on communications from the opposition division. Likewise, there can be no re-establishment of rights in case of failure to observe the time limit for the payment of the renewal fees under Rule 51(1) as valid payment is still possible under Rule 51(2).

Art. 122(4)
Rule 136(3)

Re-establishment of rights is ruled out in respect of all periods for which further processing is available and in respect of the period for requesting re-establishment of rights. This means that re-establishment of rights comes into play where further processing is excluded in respect of a specific period or where the time limit for requesting further processing has expired. In the latter case, re-establishment of rights in respect of the time limit for requesting further processing is to be requested (see E-VIII, 2), and not in respect of the originally missed time limit.

Rule 131(1)

A "time limit" is taken to mean a specific period of time within which an act vis-à-vis the EPO must be completed (see E-VIII, 1.1). Re-establishment of rights is therefore not admissible e.g. in respect of failure to be present on the date of appointed oral proceedings.

The following are examples of cases where re-establishment of rights may be requested. They concern the time limits for:

– payment of a renewal fee plus additional fee; *Rule 51(2)*

– requesting further processing in respect of the time limit for replying to a communication from the examining division under Art. 94(3); *Rule 135(1)*

– filing the translation of any amended claims in opposition proceedings; *Rule 82(2)*

– filing the request for a decision by the opposition division on the awarding of costs; *Rule 88(3)*

– filing notice of appeal; and *Art. 108*

– filing a petition for review by the Enlarged Board of Appeal. *Art. 112a(4)*

3.1.2 Entitlement to file the request

The wording of Art. 122(1) implies that re-establishment of rights is available only to applicants and proprietors. Therefore, opponents are in principle not entitled to request re-establishment of rights, e.g. in respect of the time limit for filing an appeal (see T 210/89). However, an opponent who has filed an appeal can request re-establishment of rights in respect of the time limit for submitting the grounds for appeal (see G 1/86).

Where re-establishment of rights is requested by the patent proprietor in respect of a time limit connected with the opposition procedure, the opponents are party to the re-establishment proceedings (see T 552/02 and T 1561/05).

In the case of transfer of an application or patent, the request for re-establishment of rights may only be filed by the registered applicant (E-XIV, 3). *Rule 22(3)*

3.1.3 Form of the request and applicable time limit

As a rule, the request for re-establishment of rights must be filed in writing within two months from the removal of the cause of non-compliance with the time limit, but at the latest within one year of expiry of the unobserved time limit. The omitted act must be completed within this period. *Rule 136(1), (2)*

Where the "cause of non-compliance with the time limit" involved some error in the carrying out of the party's intention to comply with the time limit, the removal of the cause of non-compliance occurs on the date on which the person responsible for the application is made aware of the fact that a time limit has not been observed or ought to have noticed the error if all due care had been taken. The removal of the cause of non-compliance is a matter of fact which has to be determined in the circumstances of each individual case. In the absence of circumstances to the contrary, where a communication under Rule 112(1) has been duly sent, it may be assumed that the removal was effected by receipt of this communication (see J 27/90).

Unlike the time limit for other cases as described above, a request for re-establishment in respect of the priority period (Art. 87(1)) or the period for filing a petition for review by the Enlarged Board of Appeal (Art. 112a(4)) must be filed within two months of expiry of the relevant period.

A request for re-establishment is not deemed to be filed until after the fee for the re-establishment of rights has been paid.

The principles regarding unitary and independent procedural acts described in E-VIII, 2 apply *mutatis mutandis* to establishing the number of requests for re-establishment of rights, in particular for establishing the relevant fees to be paid. Where one unitary procedural act is omitted by not performing one or more actions forming that act, only one fee for re-establishment is due. Where several independent procedural acts are omitted, each resulting in the application being deemed withdrawn, a fee for re-establishment is due for each omitted act.

These principles also apply to cases where re-establishment of rights must be requested in respect of the time limit(s) for requesting further processing (see Rule 136(3)). In such cases, the number of unobserved time limits, each resulting in the application being deemed withdrawn and requiring a request for further processing, determines the number of requests for re-establishment and the corresponding number of fees for re-establishment.

Example:

An international application comprises more than 35 pages and was published in a language other than an official language of the EPO. The acts required for entry into the European phase upon expiry of the 31-month period under Rule 159(1) were omitted. Due to their different legal nature, the individual acts required under Rule 159(1) do not form a unitary procedural step but are legally independent and subject to independent time limits. The table below provides a schematic illustration regarding further processing and re-establishment of rights (for information on the remedies available for non-observance of the time limits under Rule 159(1), see the individual sections under E-IX, 2).

Box I of the table lists the number of independent unobserved time limits. Box II indicates the fee for further processing corresponding to each unobserved time limit. Box III provides the fee for re-establishment corresponding to each unobserved time limit.

In the example, for a request for further processing to be allowed, completion of the omitted acts (i.e. all acts that were to be performed within the 31-month period) and payment of five fees for further processing (two of which comprise two fees) are required within the two-month period under Rule 135(1). If that period is missed, the applicant may request re-establishment of rights in respect of the period. The request requires completion of the omitted acts and payment of the corresponding number of fees for re-establishment of rights within the period under Rule 136(1). The omitted acts are those that were to be performed within the

31-month period and payment of the corresponding five fees for further processing. Payment of five fees for re-establishment of rights corresponds to the number of five independent fees for further processing.

Omitted acts	Time limits missed (box I)	Number of fees for further processing (box II)	Number of fees for re-establishment (box III)
Filing of the translation	1	1	1
Payment of the filing fee	1 (unitary)	1 (comprising 50% of the filing fee and 50% of the additional fee)	1
Payment of the additional fee for an application comprising more than 35 pages			
Payment of the designation fee	1	1	1
Payment of the search fee	1	1	1
Filing of the request for examination	1 (unitary)	1 (comprising a flat fee and 50% of the examination fee)	1
Payment of the examination fee			
Resulting number of fees to be paid	5 non-observed time limits	5 fees for further processing, 2 of them comprising 2 fees	5 fees for re-establishment

3.1.4 Substantiation of the request

The request must state the grounds on which it is based, and must set out the facts on which it relies. Thus, it must set forth the precise cause of non-compliance with the time limit concerned (i.e. the fact or obstacle preventing the required action within the time limit), specify at what time and under which circumstances the cause occurred and was removed, and present the core facts making it possible to consider whether all due care required by the circumstances had been taken in order to comply with the time limit concerned (see J 15/10). General statements with no indication of the concrete facts or events that caused the time limit to be missed do not satisfy the requirement for a duly substantiated request under Rule 136(2).

Once the time limit for filing the request for re-establishment has expired, the requester may clarify or supplement the alleged facts and, where appropriate, submit further evidence. However, the requester cannot alter the factual basis on which the original request for re-establishment had been based (see J 5/94). Any new facts introduced at this stage are not admissible and are, therefore, not taken into consideration by the deciding instance.

3.2 Merit of the request

Art. 122(1)

Applicants can have their rights re-established only if they show that they were unable to observe a time limit vis-à-vis the EPO in spite of all due care required by the circumstances having been taken. The obligation to exercise due care must be considered in the light of the situation as it stood before the missed time limit expired. "All due care" means all reasonable care, i.e. the standard of care that the notional reasonably competent patentee, applicant or representative would employ in all the relevant circumstances (see T 30/90).

For cases where the cause of non-compliance with a time limit involves some error in the carrying out of the party's intention to comply with the time limit, all due care is considered to have been taken if non-compliance with the time limit results either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system.

A finding of exceptional circumstances justifying the re-establishment of rights is dependent on the individual facts of the case. Examples include *inter alia* organisational upheavals and sudden serious illnesses. In such cases, the requesters must show not only the existence of those circumstances, but also that they took all due care, e.g. by carefully preparing the reorganisation or by having an effective staff substitution system.

Where an isolated mistake within a normally satisfactory monitoring system is alleged, the relevant party must show that the monitoring system normally works well. Such a system must include an independent, effective cross-check mechanism. However, this requirement does not apply to relatively small entities/patent departments (see T 166/87 and J 11/03).

The duty to exercise all due care applies first and foremost to the applicants and then, by virtue of delegation, to the representative duly entrusted by the applicant to act on their behalf in prosecuting the application (see J 3/93). The obligations of the applicant and those of their representative are clearly distinct and depend on the relationship between them (see T 112/89 and J 19/04). In this regard, the scope of the mandate and any express instructions given to the representative are taken into account.

Applicants are entitled to rely on their representative. To the extent that applicants are on notice that instructions are required in order to meet a time limit, they have however a duty to take all due care in the circumstances to meet the time limit (see T 381/93). The fact that the professional representative has acted correctly does not exempt applicants from suffering the consequences of their own mistakes or negligence.

European representatives are responsible in the procedure before the EPO and must be presumed to be supervising their own work continuously (see T 1095/06). When professional representatives have been instructed by their client to perform a particular procedural action and do not receive in due time the necessary additional instructions or required means, they must in principle take all necessary measures to try to obtain these instructions from their client and ascertain their true wishes (see T 112/89 and J 19/04).

Professional representatives can delegate routine tasks, such as typing, posting letters, noting time limits or checking due dates, to assistants. In those cases, the same strict standard of care is not expected of the assistant as is demanded of the representative himself. The representative must however show that the assistants have been carefully selected, duly instructed and periodically supervised (see J 5/80 and T 439/06).

If the applicants entrust a further party with taking care of their application matters, e.g. a non-European representative or a fee payment agency, it has to be established that such a party has taken the due care required of an applicant for or proprietor of a European patent (see J 3/88). In particular, a non-European representative must also show that a reliable system for the monitoring of time limits was in place when the time limit was missed (see J 4/07).

3.3 Decision on re-establishment of rights

The department competent to decide on the omitted act is also competent to decide on the request for re-establishment of rights. The grounds for the decision need only be stated if the request is not granted, except in opposition proceedings, as opponents are party to the re-establishment proceedings (see E-VIII, 3.1.2). *Rule 136(4)*

The department which took the contested decision will have to consider re-establishment of rights in respect of an unobserved time limit for appeal when the conditions for granting interlocutory revision are fulfilled (see E-XII, 7). It can, however, only decide to allow re-establishment if it can do so within the three-month time limit of Art. 109(2) and the conditions for re-establishment (see E-VIII, 3.1.1 to E-VIII, 3.1.4) are fulfilled. In all other cases, the appeal, together with the application for the re-establishment of rights, must be submitted to the competent board of appeal.

If the request is granted, the legal consequences of the failure to observe the time limit will be deemed not to have ensued. Any renewal fees which may have fallen due between the expiry of the missed time limit and the notification of the decision to grant the request for re-establishment will be due on that latter date. Valid payment will still be possible within four months of that date. If a renewal fee was already due when the loss of rights occurred but could still be paid under Rule 51(2), it may still be paid within six months of the date of notification of the decision re-establishing the rights, provided that the additional fee is also paid within that period. *Art. 122(3)* *Rule 51(4)*

If other time limits the non-observance of which would also lead to a loss of rights were already running when the loss of rights occurred, on granting the request for re-establishment the EPO will send the applicant a communication triggering those time limits anew.

4. Accelerated prosecution of European patent applications

Applicants requiring faster search or examination can ask to have their applications processed under the programme for accelerated prosecution of European patent applications (PACE) (see the Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93; for PACE requests filed before 1 January 2016 see also OJ EPO 2010, 352). For information regarding additional ways to expedite the European grant procedure see OJ EPO 2015, A94).

Requests for participation in the PACE programme (PACE requests) must be filed online using the dedicated request form (EPO Form 1005). The EPO will issue an acknowledgement of receipt promptly. Requests filed informally, i.e. without using the dedicated form, and/or on paper will not be processed by the EPO.

A PACE request may be filed only once during each stage of the procedure, i.e. search and examination, and for one application at a time. A PACE request filed during search will not trigger accelerated examination. If the applicant wishes to have the application examined in an accelerated manner, a PACE request may be filed, once the application has entered the examination phase.

The EPO does not publish requests for accelerated search and/or examination and, by decision of the President dated 12 July 2007 (Special edition No. 3, OJ EPO 2007, J.3), they are excluded from file inspection.

An application will be taken out of the PACE programme if:

– the PACE request has been withdrawn,

– the applicant has requested an extension of time limits,

– the application has been refused,

– the application has been withdrawn,

– the application is deemed to be withdrawn.

This applies regardless of the legal remedies available under the EPC. In such cases it will not be possible to restore the application to the PACE programme, i.e. a second request for that application during the same stage of the procedure will not be processed.

Additionally, accelerated prosecution will be suspended in the event of failure to pay renewal fees by the due date stipulated in Rule 51(1).

Accelerated prosecution under the PACE programme can be provided only where practically feasible and subject to the workload of the search and examining divisions. In certain technical fields there may be constraints due to the numbers of incoming PACE requests. Applicants requesting accelerated prosecution for all or most of their applications will, as a rule, be required by the EPO to limit the number of their PACE requests by making a selection.

4.1 Accelerated search

For European patent applications filed on or after 1 July 2014 (including PCT applications entering the European phase where the EPO did not act as (S)ISA) the EPO strives to issue the extended/partial European search report within six months from the filing date or from expiry of the period under Rule 161(2). Hence, no PACE request is needed.

For European patent applications (including PCT applications entering the European phase where the EPO did not act as (S)ISA) which were filed before 1 July 2014 and which do claim priority (second filings), on receipt of a PACE request the EPO makes every effort to issue the extended/partial European search report within six months from receipt of the request.

Without prejudice to the above an accelerated search can only start:

(i) after receipt of the applicant's response to a communication under Rule 62a or 63, or expiry of the respective time limit;

(ii) in all cases: when the application documents on filing are complete enough for the extended search report to be drawn up. That means, in particular, that the accelerated search can only start once the claims, the description, the translations required and, where applicable, the drawings and a sequence listing conforming to the rules for the standardised representation of nucleotide or amino acid sequences have been filed;

(iii) for PCT applications entering the European phase where the EPO did not act as (S)ISA: after expiry of the six-month period under Rule 161(2), even if acceleration has been requested under the PACE programme. In order for the supplementary European search to start immediately, on entry into the European phase the applicant must explicitly waive the right to communications pursuant to Rules 161(2) and 162(2) and pay any claims fees due (see the Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93).

If the EPO has invited the applicant to pay further search fee(s) under Rule 64(1), second sentence, or 164(1)(b), the final search report under Rule 64(1), last sentence, or 164(1)(c) cannot be drawn up until the applicant's response to the invitation to pay further search fee(s) has been received or until the respective time limit has expired.

4.2 Accelerated examination

Accelerated examination can, in principle, be requested at any time after the examining division has assumed responsibility for the application (Rule 10(2), (3)).

For PCT applications entering the European phase where the EPO also acted as (S)ISA, accelerated examination can, in principle, be requested at any time, for example

– on entry into the European phase before the EPO, or

– together with any response to the WO-ISA, IPER or SISR required under Rule 161(1).

When accelerated examination is requested, the EPO makes every effort to issue the next office action within three months of receipt by the examining division of the application, the applicant's response under Rule 70a or the end of the period under Rule 161(1), or the request for accelerated examination (whichever is later).

In particular for PCT applications entering the European phase where the EPO acted as (S)ISA, accelerated examination can only start after expiry of the six-month period under Rule 161(1), even if acceleration has been requested under the PACE programme. In order for examination to start immediately, on entry into the European phase the applicant must explicitly waive the right to the communication pursuant to Rule 161(1) and Rule 162(2) and fulfil all corresponding requirements (see the Notice from the EPO dated 30 November 2015, OJ EPO 2015, A94).

The EPO strives to produce subsequent examination communications within three months of receipt of the applicant's reply, provided that the application is still being processed under the PACE programme (see E-VIII, 4).

4.3 Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) enables an applicant whose claims have been determined to be allowable to have a corresponding application which has been filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results. A request before the EPO must be filed before substantive examination has begun.

A PPH request can be based on:

(i) the latest PCT work product (WO-ISA or IPRP/IPER) established by one of the PPH partner offices as ISA or IPEA (PPH based on PCT work products); or

(ii) any national work product (office action indicating allowable claims) established during the processing of a national application or of a PCT application that has entered the national phase before one of the PPH partner offices (PPH based on national work products).

Currently, the EPO's PPH partner offices are: JPO (Japan), KIPO (South Korea), CNIPA (China), USPTO (USA), ILPO (Israel), CIPO (Canada), IMPI (Mexico), IPOS (Singapore), IPA (Australia), SIC (Colombia), ROSPATENT (Russian Federation), MyIPO (Malaysia), IPOPHL (Philippines), EAPO (Eurasia), INPI (Brazil) and INDECOPI (Peru).

5. Accelerated processing of oppositions

In cases where an infringement action in respect of a European patent is pending before a national court of a contracting state, a party to the opposition proceedings may request accelerated processing. The request may be filed at any time. It must be filed in written reasoned form. In addition, the EPO will also accelerate the processing of the opposition if it is informed by the national court or competent authority of a contracting state that infringement actions are pending (see the Notice of the EPO dated 17 March 2008, OJ EPO 2008, 221).

6. Accelerated processing before the boards of appeal

Parties with a legitimate interest may ask the boards of appeal to deal with their appeals rapidly. This option is also available to the courts and competent authorities of the contracting states (see Art. 10 Rules of Procedure of the Boards of Appeal, OJ EPO 2019, A63, as amended by OJ EPO 2021, A19).

7. Enquiries

In specific cases, parties to proceedings before the EPO may have an interest in enquiring about the progress of the file and thus obtaining information on when the next Office action is to be expected. A specific procedure for enquiries is available to all parties to proceedings before the EPO's departments of first instance, and applies to enquiries filed on or after 1 November 2016 (see the Notice from the EPO dated 2 August 2016, OJ EPO 2016, A66).

Under this procedure, an enquiry is processed and replied to only if it is filed online using EPO Form 1012. It may be submitted for only one application or patent at a time. The EPO will promptly issue an acknowledgement of receipt. Both the enquiries and the replies from the EPO form integral parts of the file and, as such, are open to file inspection.

Specific parameters may have an impact on the handling time for enquiries. For example, the non-payment of the renewal fee by the due date under Rule 51(1) may delay the EPO's handling of an enquiry.

In general, the EPO will reply to enquiries by indicating the period within which the next Office action may be expected, taking into account the workload in the technical area concerned and the internal deadline for the completion of the pending action.

Nevertheless, in the following cases an enquiry will automatically cause the EPO to issue the next action within one month from receipt of the enquiry:

– where the extended/partial European search report in respect of European patent applications filed on or after 1 June 2014 (including

international applications entering the European phase where the EPO did not act as (S)ISA) has not been issued within six months from the filing date or from expiry of the period under Rule 161(2); or

– where an Office action in respect of an application which is being processed under the PACE programme or for which a previous enquiry has been made has not been performed within the committed period;

and within six months from receipt of the enquiry:

– where the extended/partial European search report in respect of European patent applications (including PCT applications entering the European phase where the EPO did not act as (S)ISA) filed before 1 June 2014 and which do claim priority (second filings) has not been issued.

Unlike the PACE programme, the filing of enquiries does not imply a general acceleration of the prosecution of European patent applications. Prosecution of the application can be accelerated by separately requesting application of the PACE programme (see E-VIII, 4).

8. Renunciation of rights

8.1 Withdrawal of application or designation

Rule 15

Applicants may withdraw their application at any time as long as the application is pending, provided that no third parties have proven to the EPO that they have initiated proceedings concerning entitlement to the application pursuant to Rule 14. With regard to the pendency of an application, see A-IV, 1.1.1.

Art. 79(3)
Rule 39(2) and (3)

The same applies to the withdrawal of a designation (see also A-III, 11.3.8). If all designations are withdrawn, the application is deemed to be withdrawn.

Art. 87(4)

Withdrawal of the application in due time before the eighteen-month publication has the advantage that the contents of the application do not become known to the public (see A-VI, 1.2). If, furthermore, no rights have been left outstanding and the application has not served as a basis for claiming a right of priority, a subsequent application for the same invention can be considered as the first application for the purposes of determining priority (see F-VI, 1.4.1). If the examination fee has been paid, it will be refunded in full or in part (see A-VI, 2.5).

Where a patent application has been refused, proceedings are still pending until expiry of the period for filing an appeal. On the day after, proceedings are no longer pending if no appeal is filed. Therefore, an application which is refused either in written or oral proceedings can still be withdrawn in this period.

8.2 Withdrawal of priority claim

The priority claim may also be withdrawn (see F-VI, 3.5). If this is done before the technical preparations for publication of the application are completed, the publication will be deferred until eighteen months after the date of filing of the European application or, where multiple priorities are claimed, the earliest priority date remaining (see A-VI, 1.1 and A-III, 6.3).

8.3 Statement of withdrawal

Any statement of withdrawal must be unqualified and unambiguous. It may, however, be conditional upon, e.g. avoidance of publication or refund of the examination fee. An unqualified and unambiguous withdrawal becomes effective the day it has been received by the EPO.

If such a statement of withdrawal is made orally during oral proceedings, then either a (handwritten) signed confirmation is to be submitted during the proceedings or the division has to confirm the withdrawal in the minutes and read out the corresponding passage for confirmation in the oral proceedings. The withdrawal has effect from the date of the oral proceedings.

8.4 Surrender of patent

A patent may not be surrendered in opposition proceedings by the proprietor filing a declaration of surrender with the EPO. Such a surrender must be declared before the competent authorities in the designated states in question (see D-VII, 5.1). Nevertheless, if a proprietor unambiguously declares to the EPO the surrender (or abandonment or renunciation) of the patent, this is deemed equivalent to a request that the patent be revoked (see also D-VIII, 1.2.5).

Rule 84(1)

Chapter IX – Applications under the Patent Cooperation Treaty (PCT)

1. General remarks

The EPO may be a "designated Office" or an "elected Office" for an international application filed under the Patent Cooperation Treaty (PCT) designating "EP" (Euro-PCT application). If an applicant enters the European phase without having requested international preliminary examination under PCT Chapter II, the EPO will act as a "designated Office". If before entering the European phase the application was processed under PCT Chapter II, the EPO will act in the European phase as an "elected Office". Pursuant to Art. 153(2), an international application for which the EPO is a designated or elected Office is deemed to be a European patent application.

Art. 153(1)(a) and (b)
Art. 153(2)
Art. 150(2)

In addition to being a designated and, where appropriate, elected Office, the EPO may act as a receiving Office under the PCT within the terms set out in Art. 151. It may also act as an International Searching Authority (ISA), as an International Preliminary Examining Authority (IPEA) under the terms of Art. 152 and/or as an International Searching Authority specified for Supplementary International Search (SISA) under the PCT (see also the EPO-WIPO Agreement, OJ EPO 2017, A115, OJ EPO 2018, A24, and OJ EPO 2018, A35). There are thus the following possibilities for a European application filed under the provisions of the PCT:

Art. 151
Art. 152
Rule 157
Rule 158

(i) the filing of the application and the international search take place at an office or offices other than the EPO (e.g. the Japan Patent Office). The EPO is a designated Office;

(ii) the application is filed at another office (e.g. the United Kingdom Patent Office) but the EPO performs the international search. The EPO acts as International Searching Authority and is a designated Office;

(iii) the application is filed at the EPO, which also performs the international search. The EPO acts as receiving Office, International Searching Authority and designated Office;

(iv) in the cases mentioned under (i) - (iii), the applicant files, in addition, a demand for international preliminary examination with an IPEA other than the EPO. The EPO is an "elected Office";

(v) in the cases mentioned under (i) - (iii), the applicant files, in addition, a demand for international preliminary examination with the EPO as International Preliminary Examining Authority. The EPO may carry out this function irrespective of whether it was the receiving Office. It can, however, only act as an IPEA if the international search was carried out by the EPO, the Austrian, Spanish, Swedish, Finnish or Turkish Patent Office, the Nordic Patent Institute or the Visegrad Patent Institute. The EPO thus acts as IPEA and is also an elected Office;

(vi) if the international search has been carried out by an office other than the EPO, the applicant may still request the EPO to perform a supplementary international search (SIS) in its capacity as SISA.

In case (i), there will be an international search report drawn up by another office. In cases (ii) and (iii), the international search report and the "written opinion of the International Searching Authority" (WO-ISA) (Rule 43*bis* PCT) will have been prepared by the search division of the EPO. For further details on the procedure before the EPO as RO, ISA, IPEA or SISA, see the Guidelines for search and examination at the EPO as PCT authority (GL/PCT-EPO) and the Guide for applicants: "'Euro-PCT Guide': PCT procedure at the EPO".

2. EPO as designated or elected Office

Art. 150(2)
Art. 27(1) PCT

In proceedings before the EPO relating to international applications, the provisions of the PCT apply, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT prevail. The EPO cannot require compliance with requirements relating to form or contents of the international application different from or additional to those which are provided for in the PCT.

As a result of the prevalence of the PCT provisions and the requirements of Art. 150 and Art. 153 relating to international applications under the PCT in the European phase, the instructions in the earlier chapters of these Guidelines do not always apply to the procedure before the EPO as designated or elected Office.

This section deals with the specific aspects of the procedure before the EPO as designated or elected Office. It addresses, in subsections E-IX, 2.2 to 2.5 and 2.10, the formalities examination of international applications upon entry into the European phase **in so far as it differs** from that applicable to European direct applications, by reference to the instructions in the appropriate sections of Part A.

2.1 Entry into the European phase

2.1.1 Requirements for entry into the European phase

Rule 159

"Entry into the European phase" is not an act in itself but a series of acts to be performed. In order to initiate the European phase, the applicant must perform the following acts within 31 months from the filing date or, if priority has been claimed, from the earliest priority date:

– supply the translation if the Euro-PCT application was not published in one of the EPO's official languages (see E-IX, 2.1.3),

– specify the application documents on which the European grant procedure is to be based,

– pay the filing fee provided for in Art. 78(2), including the additional page fee for applications with more than 35 pages (see E-IX, 2.1.4),

– pay the designation fee (and any extension or validation fees) if the period under Rule 39 has expired earlier (see E-IX, 2.3.11),

– pay the search fee if a supplementary European search report is to be drawn up (see E-IX, 2.1.4 and E-IX, 2.5.3),

– file the request for examination and pay the examination fee if the period under Rule 70(1) has expired earlier (see E-IX, 2.1.4),

– pay the renewal fee for the third year if the period under Rule 51(1) has expired earlier (see E-IX, 2.3.12),

– where applicable, file the certificate of exhibition mentioned in Art. 55(2) (see E-IX, 2.4.3).

Depending on the circumstances of the particular application, the applicant may additionally have to complete one or more of the following acts within the 31-month time limit:

– pay any claims fees due (see E-IX, 2.3.8),

– file the designation of the inventor (see E-IX, 2.3.4),

– furnish the file number or the certified copy of the application(s) of which priority is claimed (see E-IX, 2.3.5),

– furnish a sequence listing complying with the standard (see E-IX, 2.4.2),

– furnish the indications on the applicant mentioned in Rule 163(4) in respect of any applicant (see E-IX, 2.3.1),

– appoint a professional representative (see E-IX, 2.3.1),

– furnish a copy of the results of any search carried out by or on behalf of the authority with which the priority application was filed (see A-III, 6.12).

Applicants are strongly recommended to use the most recent edition of Form 1200 available as editable electronic document from the EPO website (epo.org), as part of the Online Filing software or as part of the new online filing (CMS). For further details on the available filing methods see A-VIII, 2.5. The form and any other documents must be filed with the EPO, they may not be sent to the IB or to an authority of an EPC contracting state.

Rule 159(1)(b)

The documents on which the proceedings in the European phase are to be based can best be indicated in section 6 of Form 1200; further details may be provided on an additional sheet. The applicant must make sure that the indications in section 6 and/or on the additional sheet correspond to any indications given in the table for section 6 provided for the calculation of the additional (page) fee to be paid for applications comprising more than

35 pages (see A-III, 13.2). If the applicant has filed test reports (e.g. comparative examples in support of inventive step) with the EPO as IPEA, it is assumed that the EPO may also use them in the European grant proceedings.

If the applicant does not specify the application documents on which the European grant procedure is to be based, the international application as published as well as any amendments made in the international phase are considered to form part of the procedure. The additional fee to be paid for an application comprising more than thirty-five pages will be calculated on the basis of the international application as published; any amendment pages not specified as replacing the corresponding pages of the international publication will be taken as additional pages (see A-III, 13.2).

2.1.2 Initial processing and formal examination; copy of the international application

Art. 23 PCT
Art. 40 PCT
Rule 49.1(a bis) PCT

The initial processing and formal examination of international applications are carried out in the international phase by PCT authorities under the PCT.

Art. 24(1)(iii) PCT
Rule 159(1)
Rule 160
Art. 121
Art. 2(1), item 12, RFees

Unless there is a specific request for early processing (see E-IX, 2.8), the EPO acting as a designated or elected Office may not process or examine an international application prior to the expiry of 31 months from the date of filing of the application or, if priority has been claimed, from the earliest priority date (31-month time limit). The EPO will, however, prior to the expiry of the 31-month time limit, perform any purely administrative tasks such as adding documents relating to the European phase to the file and recording the professional European representative appointed to act on behalf of the applicant in the European phase, to ensure the correct notification of correspondence once the ban on processing has been lifted. Since the EPO has not exercised the waiver referred to in Art. 20(1)(a) PCT, a copy of the international application will be furnished by the International Bureau. The EPO does not require the applicant to furnish a copy of the international application under Art. 22 or 39 PCT, even if the International Bureau has not yet communicated a copy under Art. 20 PCT at the time the application enters the European phase (see PCT Gazette 14/1986, 2367).

2.1.3 Translation of the international application

Art. 14(2) and (3), 153(4)
Rule 159(1)(a)

Where the international application was not published in an official language of the EPO, the applicant is required, in accordance with Art. 22 or 39 PCT and Rule 159(1)(a), to furnish a translation of the published application within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (31-month time limit). The language of the translation determines the language of the proceedings before the EPO.

The translation must include:

Rule 49.5(a) and (k) PCT

(i) the description (as originally filed; the title as established by the ISA under Rule 37.2 PCT, if applicable),

Rule 49.5(a) PCT

(ii) the claims (as originally filed),

(iii) any text matter in the drawings except for the expression "Fig." (as originally filed), — *Rule 49.5(a), (d) and Rule 49.5(f) PCT*

NB: In relation to items (i) to (iii) above, in the case of a correction of erroneously filed elements or parts under Rule 20.5*bis*(d) PCT by the receiving Office (see C-III, 1.3), the translation must include both the erroneously filed application documents and the correct application documents with an indication as to which pages relate to the correct and which to the erroneously filed application documents,

(iv) the abstract (as published), — *Rule 49.5(a) PCT*

(v) any published request for rectification under Rule 91.3(d) PCT;

(vi) any text matter contained in the sequence listing, unless the text in the sequence listing is available to the EPO in English; the translation is to be furnished in the form of a copy of the complete sequence listing complying with the applicable WIPO standard including a translation of the text matter; — *Rules 12.1(d) and 49.5(a-bis) PCT*

(vii) any references to deposited biological material furnished separately, — *Rule 49.3 and 49.5(h) PCT*

(viii) if the EPO acts as **designated Office**, and the applicant wishes the amended claims under Art. 19 PCT to form the basis of further proceedings, — *Art. 19 PCT Rule 49.3, 49.5(a)(ii) and (c-bis) PCT Rules 3 and 137(4)*

- the amendments under Art. 19 PCT in the form of a translation of the complete set of claims furnished under that provision and the statement under Art. 19(1) PCT, if submitted to the IB, and,

- the accompanying letter, indicating the basis for the amendments in the application as filed (Rule 46.5(b) PCT), so as to allow the examiner to understand and take the amendments into account (see also E-IX, 3.4),

(ix) if the EPO acts as **elected Office**, — *Art. 39(1), 36(2)(b) and (3)(b) PCT Rules 70.16 and 74.1(a) PCT*

- all annexes to the international preliminary examination report (IPER), i.e. any replacement sheets and accompanying letters referred to in Rule 70.16 PCT that allow the examiner to understand the amendments, regardless of whether protection is sought for the same version of the application documents as was the subject of the IPER,

- any amendments made to the claims under Art. 19 PCT (cf. item (viii) above) if the applicant wishes these amendments to form the basis of further proceedings and they are not annexed to the IPER (for instance because they were considered reversed by an amendment under Art. 34 PCT). — *Rule 76.5(iv) PCT*

Art. 24(1)(iii) or 39(2) PCT
Rule 160(1)

If the applicant does not furnish the translation of any of the items (i) or (ii) above within the 31-month period, the application is deemed to be withdrawn under Rule 160(1).

Rule 49.5(c-bis), (g), (h) PCT

If the applicant does not furnish the translation of any of the items (iii) to (ix) above within the 31-month period, the EPO will invite him to furnish the translation within a two-month period from notification of the respective communication under Rule 159(1)(a). The same applies if, in the case of a correction of erroneously filed elements or parts under Rule 20.5*bis*(d) PCT by the receiving Office (see C-III, 1.3), translations of the erroneously filed application documents (in relation to items (i) to (iii) above) have not been filed. If the applicant does not comply with this invitation

Art. 24(1)(iii) or 39(2) PCT; Rule 160(1)

– as regards items (iii) to (vii) above, the application is deemed to be withdrawn;

– as regards translations of erroneously filed application documents (in relation to items (i) to (iii) above) in the case of a correction of erroneously filed elements or parts under Rule 20.5*bis*(d) PCT by the receiving Office, the application is deemed to be withdrawn;

Art. 39(2) PCT; Rule 160(1)

– as regards the replacement sheets referred to in item (ix) above, the application is deemed to be withdrawn;

Rule 49.5(c-bis) PCT; Rule 3(2)

– as regards the replacement sheets referred to in item (viii) above, the EPO will disregard the amendments under Art. 19 PCT;

Rule 49.5(c) PCT; Rule 3(1)

– as regards the accompanying letter and the statement referred to in item (viii) above, the EPO will disregard that letter and that statement and may proceed under Rule 137(4) where applicable (see E-IX, 3.4);

Rule 49.5(c) PCT; Rule 3(1)

– as regards the accompanying letters referred to item (ix) above, the EPO will disregard those letters and may proceed under Rule 137(4) where applicable (see E-IX, 3.4).

Where the application is deemed to be withdrawn under Rule 160(1), Rule 112(2) applies *mutatis mutandis*. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation and a valid request for further processing (including the payment of the requisite fee) are filed (Art. 121 and Rule 135(1), see E-VIII, 2).

Where an international application was filed and published in the international phase in an official language of the EPO, it is not possible to change the language of the proceedings on entry into the European phase by filing a translation of that application into either of the other two official languages of the EPO (see G 4/08). In such cases, the language of the proceedings within the meaning of Art. 14(3) remains the language in which the application was published by WIPO's International Bureau.

A translation, whether filed on entry into the European phase under Art. 153(4) or in the international phase under Rule 12.3 or 12.4 PCT, may always be brought into conformity with the application as filed. The conditions set out in A-VII, 7 apply.

Art. 153(4)
Art. 14(2)

2.1.4 Filing fee, designation fee, request for examination and search fee

Under Rule 159(1)(c), applicants must pay the filing fee, including any additional fee for pages in excess of thirty-five (see A-III, 13.2), within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date. Further, under Rule 159(1)(d), they must pay the designation fee within this period, if the time limit specified in Rule 39(1) has expired earlier. Under Rule 159(1)(f), the request for examination must also be filed within this period, if the time limit specified in Rule 70(1) has expired earlier (see also E-IX, 2.5.2). Where a supplementary European search report needs to be drawn up, a search fee must also be paid to the EPO within this period (see also E-IX, 2.5.3). Failure to pay in due time the filing fee, the additional fee, the search fee, the designation fee or the examination fee, or to file the request for examination, means that the application is deemed to be withdrawn.

Rule 159(1)
Rule 160
Art. 2(1), item 12, RFees

If the EPO finds that the application is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 160(2)).

The communication under Rule 160(2) and the communication according to Rule 112(1) are sent together in one and the same communication. In response to this notification of a loss of rights, the applicant can request further processing (see E-VIII, 2).

2.2 Instructions in Chapter A-II ("Filing of applications and examination on filing")

The instructions in A-II, 1 ("Where and how applications may be filed") do not apply to international applications, except where explicit reference is made to international applications, including Euro-PCT applications.

The PCT requirements corresponding to those of A-II, 2 ("Persons entitled to file an application") are more restrictive, as in general the applicant must be a resident or national of a PCT contracting state and therefore no further examination as regards entitlement is necessary.

The instructions in A-II, 3 ("Procedure on filing") do not apply.

The provisions for late filing of missing parts completely contained in the priority document (Rule 56) apply if the EPO is designated/elected Office. A similar option exists under the PCT in relation to the receiving Office (Rule 20.5 to 20.8 PCT). Both sets of provisions apply in parallel. For a request under Rule 56 to be allowed by the EPO as designated/elected Office, it must have been filed, together with the documents required under Rule 56(3), within two months from the date of filing or from a communication of the receiving Office under Rule 20.5(a) PCT (see Rule 56(2)), and the applicant must have effectively requested "early

Rule 56
Rule 20 PCT

processing" under Art. 23(2) PCT (see E-IX, 2.8) before expiry of the two-month period under Rule 56(2).

Art. 24, 25, 26, 27 and 48 PCT
Rule 82bis and 82ter PCT
Rule 139

In addition, Art. 26, 27 and 48 PCT, Rules 82*bis* and 82*ter* PCT and Rule 139 EPC apply.

The date of filing (see A-II, 4 ("Examination on filing")) of a Euro-PCT application is that accorded under the PCT by the PCT authority which acted as the receiving Office, unless correction as a consequence of review by the EPO as designated/elected Office under Art. 24 or 25 PCT or Rule 82*ter* PCT applies (see E-IX, 2.9). In respect of the procedure for establishing the date of filing in the case of elements or parts erroneously filed under Rule 20.5*bis*(d) PCT, see C-III, 1.3. The formalities examination upon entry into the European phase encompasses all checks required to verify that the requirements of Rules 159 and 163 have been met.

If the application is not deemed to be withdrawn, a copy of the application is referred to the search division for drawing up any supplementary European search report, if necessary (see E-IX, 3.1).

2.3 Instructions in Chapter A-III ("Examination of formal requirements")

2.3.1 Representation, address for correspondence

The instructions in A-III, 2 ("Representation") apply to international applications whether furnished in an official language or in translation. An agent having a right to practise before the PCT International Authorities is not necessarily authorised to act before the EPO (see Art. 27(7) PCT).

If the agents acting in the international phase are professional representatives entitled to practise before the EPO, such representatives are not automatically considered appointed for the European phase. If any applicant has mandated them to act on their behalf also in the European phase, the representatives need to identify themselves accordingly to the EPO as designated/elected Office. The only case in which professional representatives acting in the international phase are automatically considered appointed for the European phase is if they were validly appointed in the procedure before the EPO as receiving Office, ISA or IPEA and it is clear from the respective file that the appointment extends to representation in the European phase. The same principles apply where applicants having their residence or principal place of business in an EPC contracting state are represented by an authorised employee (see A-VIII, 1.3).

Applicants, in particular those not resident in an EPC contracting state, are recommended to appoint a professional representative before the EPO in good time, i.e. before initiating proceedings before the EPO as designated/elected Office (see also E-IX, 2.1.2).

However, up to expiry of the 31-month time limit under Rule 159, applicants having neither a residence nor their principal place of business within the territory of one of the contracting states may either comply with any

requirement themselves or act through a professional representative entitled to practise before the EPO. This means that applicants having neither a residence nor the principal place of business within the territory of one of the contracting states may themselves , within the 31-month time limit, for example sign and file EPO Form 1200, submit amendments, file a translation of the application, file a request for early processing, etc.

Applicants having neither a residence nor their principal place of business within the territory of one of the contracting states who do not themselves take the required steps for entry into the European phase within the 31-month time limit may, after expiry of that time limit, perform these and the other procedural steps (e.g. filing a request for re-establishment of rights) only through a professional representative entitled to practise before the EPO.

In case of failure to appoint a professional representative where this is required, the EPO invites the applicant to do so within a time limit of two months. Until the EPO is informed of a (valid) appointment, any procedural step taken by the applicant will be deemed not to have been taken. If the deficiency is not corrected in due time, the application will be refused; the applicant may request further processing (see E-VIII, 2). *Rule 163(5) - (6)*

If there is more than one applicant and the following information was not provided for one or more of those applicants in the international phase and is still missing at the expiry of the 31-month time limit under Rule 159(1): *Rule 163(4) - (6)*

(i) address

(ii) nationality

(iii) state of residence or principal place of business

the EPO will invite the applicant to furnish these indications within two months. Failure to do so will lead to refusal of the application. The same applies if the requirements for representation are not met at the end of the 31-month time limit, with the same consequence for failure to correct the deficiency in time. If the applicants fail to reply in time to the above-mentioned invitation, they may request further processing.

Applicants (whether natural or legal persons) whose residence or principal place of business is in an EPC contracting state and who act without a professional representative may make use of an address for correspondence which is different from their address of residence. See A-III, 4.2.1.

2.3.2 Physical requirements

Although compliance of an international application with the PCT requirements as to form and content is, as a rule, ascertained during the international phase, the EPO may check Euro-PCT applications entering the European phase for compliance with Rule 11 PCT. If the application documents do not comply with this provision, the EPO will issue a

communication indicating any deficiencies and invite the applicant to correct them within a time limit of two months under Rule 58.

Since the translation filed under Rule 159(1)(a) is filed for the procedure before the EPO as designated or elected Office, the translation must comply with the physical requirements as set out in A-III, 3 ("Physical requirements"). The requirements are in general identical with the corresponding requirements of the PCT.

2.3.3 Request for grant

The PCT request corresponds in general to the EPO request for grant form (EPO Form 1001) and provides for the entry of the information listed in Rule 41(2), with the exception of the items referred to in sub-paragraphs (e) and (f) thereof.

2.3.4 Designation of inventor

Rule 163(1)

The requirement, as set out in A-III, 5 ("Designation of inventor"), that the designation of inventor is filed in a separate document where the applicant is not the inventor or the sole inventor has to be complied with irrespective of the language of the international application, unless the inventor has already been named in the PCT request. Where an inventor has been named in the PCT request, the latter cannot waive their right to be mentioned in the published application. If the inventor has not been named in the international application at the expiry of the period of 31 months from the date of filing, or, in the case of priority, from the earliest date of priority claimed (31-month time limit), the EPO invites the applicant to file the designation of inventor within a period of two months. Failure to rectify this deficiency in time, leads to refusal of the application according to Rule 163(6). Applicants will be notified of this decision according to Rule 111. They may request further processing (see E-VIII, 2).

2.3.5 Claim to priority

Rule 17.1 and 17.2 PCT

The claim to priority (see A-III, 6 ("Claim to priority")) for an international application refers to the date, or dates, claimed under the PCT.

2.3.5.1 Priority document

Normally, the copy of the previous application, referred to in A-III, 6.7, i.e. the priority document, is furnished to the EPO as designated Office by the International Bureau and not by the applicant. In accordance with Rule 17.2 PCT, the International Bureau will be requested by the EPO to furnish it with a copy as standard practice promptly, but not earlier than international publication, or, where the applicant has requested early processing (in accordance with Art. 23(2) PCT), not earlier than the date of the request. Where the applicant has complied with Rule 17.1(a), (b) or (b-*bis*) PCT, the EPO may not ask the applicant himself to furnish a copy.

Rule 163(2)

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the 31-month time limit, the EPO invites the applicant to furnish the number or the copy within two months. However, Rule 53(2) and the Decision of the President of the EPO dated 18 October 2018, OJ EPO 2018, A78, providing an exception to the requirement that a copy of the previous application be furnished

(see A-III, 6.7), also apply to international applications entering the European phase. Furthermore, where the applicant has complied with Rule 17.1(a), (b) or (b-*bis*) PCT the EPO as a designated Office may not ask the applicant himself to furnish it with a copy of the priority document (Rule 17.2(a) PCT, second sentence).

If the priority document is not on file, substantive examination may nevertheless be started, provided that neither intermediate documents (published in the priority period) nor Art. 54(3) documents exist which cause the patentability of the subject-matter claimed to depend on the validity of the priority right. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

On the other hand, the application may be refused without the priority document being on file, provided that the relevant prior art is neither an intermediate document nor an Art. 54(3) document, the relevance of which depends on the validity of the priority right. For more details on treatment of such cases in examination see F-VI, 3.4.

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed on request from the EPO in accordance with Rule 53(3) (see A-III, 6.8 and subsections and 6.10).

Art. 88(1)
Rule 53(3)

2.3.5.2 Information on prior art

The applicant must, on entry into the European phase, file the results of any search carried out by or on behalf of the office of first filing for each application whose priority is claimed (see A-III, 6.12).

2.3.5.3 Restoration of priority

The provisions for restoration of priority right (see A-III, 6.6) also exist under the PCT (Rules 26*bis*.3 and 49*ter* PCT). Under the PCT, restoration of the right of priority can be made either in the international phase before the receiving Office (Rule 26*bis*.3 PCT) or upon entry into the European phase before the EPO as designated or elected Office (Rule 49*ter*.2(b)(i) PCT).

The EPO only applies the "due care" criterion in accordance with its practice under Art. 122 (Rules 26*bis*.3(a)(i) and 49*ter*.2(a)(i) PCT; see also E-VIII, 3.2 and the Notice from the EPO dated 7 November 2007, OJ EPO 2007, 692). As a consequence, any request for restoration of priority rights granted by a receiving Office under the "unintentional" criterion does not have any effect before the EPO as designated/elected Office (Rule 49*ter*.1(b) PCT).

As set out hereafter, if the applicant has already filed a request for restoration of priority with the receiving Office, a (new) request need not always be filed upon entry into the European phase.

Rule 49ter PCT
Art. 122
PCT Newsletter 9/2015, 10

If the priority right was restored by the receiving Office under the "due care criterion", no new request need be filed with the EPO as designated/elected Office, since the EPO will, in principle, recognise the decision of the

receiving Office. If, however, the EPO has reasonable doubt that the requirements for grant were met, it will notify the applicant accordingly. In this communication the reasons for such doubt will be indicated and a time limit will be set within which the applicant may submit comments.

Consequently, if the applicant wants the priority claim to be valid in the procedure before the EPO as designated/elected Office, a request for restoration must always be filed if, in the procedure before the receiving Office:

– no request for restoration of priority right was filed;

– a request for restoration of priority right was rejected;

– a request for restoration of priority right was granted under the "unintentional criterion".

The EPO as designated/elected Office will grant a request for restoration of priority right only if the following requirements are met:

(i) the filing date is within two months of the date of expiry of the priority period;

(ii) the failure to claim the right of priority within the priority period occurred in spite of due care required by the circumstances having been taken;

(iii) a request for restoration of priority is filed within one month from the date on which the 31-month time limit for entry into the European phase expired or from the effective date of early entry into the European phase (see E-IX, 2.8); where the application is deemed withdrawn under Rule 160(1) for failure to comply with a requirement under Rule 159(1), the request for restoration of priority may still be filed together with a timely request for further processing in respect of the 31-month time limit under Rule 159(1) or, failing this, with a timely request for re-establishment of rights in respect of the period for requesting further processing;

(iv) the fee for restoration of priority (Art. 2(1), item 13, RFees) is duly paid within the time limit mentioned under point (iii); the further considerations made under point (iii) also apply to this fee;

(v) the request is accompanied by a statement of reasons for the failure to file the international application within the priority period and is preferably accompanied by any declaration or other evidence in support of the statement of reasons.

2.3.6 Title of the invention

In relation to A-III, 7 ("Title of the invention"), the title need only meet the less demanding requirements of Rule 4.3 PCT rather than those set out in A-III, 7.1 and 7.2.

2.3.7 Prohibited matter

As prohibited statements or matter may not necessarily be omitted under Art. 21(6) PCT, the application must be examined to ensure that the instructions in A-III, 8 ("Prohibited matter") are complied with. Where the EPO is informed by the International Bureau that statements or matter were omitted from the published PCT application, the Receiving Section has to ensure that the corresponding material is excluded from the translation as furnished by the applicant (see E-IX, 2.1.3).

2.3.8 Claims fee

The time limit for paying the claims fee referred to in A-III, 9 is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (Rule 162(1)).

Rule 162(2)

If they have not been paid by then, under Rule 162(2), they may still be paid within the six-month period under Rule 161(1) and (2). Rule 162(2) distinguishes between two situations in which the applicant must ensure payment of claims fees before expiry of the six-month period:

Rule 162(2), first sentence, covers the situation in which the applicant does not file amendments after expiry of the 31-month period and before expiry of the six-month period under Rule 161. In this case, the applicant must ensure that any claims fees not yet paid for the set of claims filed within the 31-month period are paid before expiry of the six-month period under Rule 161.

Example:

A Euro-PCT application X contains 27 claims on expiry of the 31-month period. The applicants pay five claims fees within the 31-month period. They must ensure that seven claims fees are paid before expiry of the six-month period under Rule 161.

Rule 162(2), second sentence, covers the situation in which the applicants file an amended set of claims after expiry of the 31-month period and before expiry of the six-month period under Rule 161. In this case, they must compute the number of claims fees due on the basis of the claims on file on expiry of the six-month period under Rule 161. Before expiry of this period, they must ensure that any claims fees are paid for the number of claims on file on expiry of this period which exceeds the number of claims for which claims fees were paid within the 31-month period.

Example:

A Euro-PCT application Y contains 27 claims on expiry of the 31-month period. The applicants pay five claims fees within the 31-month period. After expiry of the 31-month period and before expiry of the six-month period under Rule 161, they file an amended set of 32 claims. The applicants must compute the number of claims fees on the basis of the claims on file on expiry of the six-month period, i.e. 32 - 15 = 17. Since they have already paid five claims fees, they must pay 12 claims fees (17 - 5 = 12) before expiry of the six-month period under Rule 161.

If there are more than 15 claims on file on expiry of the six-month period under Rule 161, any of the sixteenth and each subsequent claim for which no claims fee has been paid is deemed to be abandoned under Rule 162(4) (see also the Notice from the EPO dated 16 December 2016, OJ EPO 2016, A103).

Where a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned. The loss of rights may be remedied by a request for further processing (see E-VIII, 2). Features of a claim deemed to have been abandoned pursuant to Rule 162(4) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims.

2.3.9 Drawings

The provisions of the EPC concerning the filing of drawings (see A-II, 5 and A-III, 3.2) are identical with the corresponding provisions of the PCT and therefore no supplementary examination is necessary, provided that the provisions of Rule 11 PCT have been complied with (see also E-IX, 2.3.2).

2.3.10 Abstract

The abstract (see A-III, 10 ("Abstract")) is included in the copy of the international application supplied to the EPO.

2.3.11 Designation fee

The time limit for paying the designation fee is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (31-month time limit), if the time limit specified in Rule 39(1) has expired earlier (Rule 159(1)(d)) (see A-III, 11.2.5 for further details). If, subsequent to the receipt of the international application by the EPO and prior to the date on which processing or examination may start, the regional designation of all contracting states of the EPC is withdrawn, the Euro-PCT application, in so far as it is deemed to be a European application pursuant to Art. 153(2) and Art. 11(3) PCT, is deemed to be withdrawn.

For information on the requirements for extension or validation of a Euro-PCT application to states for which an Extension Agreement or a Validation Agreement with the EPO has become effective, see A-III, 12.

2.3.12 Renewal fees

Rule 159(1)(g)

The renewal fees for a Euro-PCT application are due in respect of the third and each subsequent year, calculated from the date of filing of the Euro-PCT application as accorded by the receiving Office. If, according to Rule 51(1), the renewal fee for the third year fell due within the 31-month time limit for entry into the European phase, the due date is deferred and the fee may be paid without surcharge up to expiry of the 31-month time limit (see A-X, 5.2.4).

2.4 Instructions in Chapter A-IV ("Special provisions")

2.4.1 Divisional applications

In relation to A-IV, 1 ("European divisional applications") there is no provision in the PCT for filing divisional applications. One or more

European divisional applications may be filed in respect of subject-matter contained in a pending Euro-PCT application, but not before the latter application has entered the European phase (see A-IV, 1.1), i.e. not before the time limit under Rule 159(1) (in conjunction with Art. 22(1) PCT and Art. 22(3) PCT) has expired (see G 1/09, Reasons 3.2.5), and on condition that any requirement of Art. 22(1) PCT which must be fulfilled within that time limit for the application concerned is met (see J 18/09). Furthermore, divisional applications may be filed as from the date the applicant has filed an effective request for early processing (see J 18/09, Reasons 9, and E-IX, 2.8).

The requirements of Rule 36 for filing divisionals must be complied with (see A-IV, 1). The divisional application must be filed in the language specified in Rule 36(2) (see A-IV, 1.3.3). In order to avoid that the Euro-PCT application is deemed withdrawn at the time a divisional application is filed, the respective requirements of Rule 159(1) must be fulfilled within the relevant time limits (see also E-IX, 2.1.2, E-IX, 2.1.3 and E-IX, 2.1.4).

2.4.2 Sequence listings

Rule 163(3)

In relation to A-IV, 5 ("Applications relating to nucleotide and amino acid sequences"), where the Euro-PCT application discloses nucleotide or amino acid sequences, a sequence listing in electronic form (i.e. in TXT format) drawn up in compliance with the applicable WIPO standard must be available to the EPO as designated/elected Office on expiry of the 31-month time limit. As a rule, it will be available to the EPO if it was contained in the international application under Rule 5.2 PCT or filed under Rule 13*ter* PCT with the EPO acting as ISA/SISA or IPEA. It will also be accessible to the EPO if it is made available by WIPO on PATENTSCOPE and can be downloaded in a usable form.

If such a sequence listing is not available to the EPO and has not been filed by the applicant, at the expiry of the 31-month time limit, the applicant will be invited to furnish the sequence listing in electronic form, i.e. in text format (TXT), in accordance with the applicable WIPO standard and pay a late-furnishing fee within a period of two months (see Rule 163(3) and 30(3)). The sequence listing does not need to be filed additionally on paper or in PDF format (see Art. 1 and Art. 5 of the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372, and the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542).

If the required sequence listing is not filed within the time limit set, the application is refused. The refusal may be remedied by a request for further processing (see E-VIII, 2).

2.4.3 Certificate of exhibition

Rule 159(1)(h)

As regards the requirements described in A-IV, 3 ("Display at an exhibition"), for Euro-PCT applications the certificate of exhibition, where relevant, is to be filed within the 31-month time limit for entry into the European phase. If the document is not filed in due time, the applicant is informed of this in a communication under Rule 112(1). The omission may be remedied by a request for further processing, which will be granted if

within two months from notification of the communication the certificate is furnished and the fee for further processing is paid (see E-VIII, 2).

2.4.4 Biological material

Rule 31

With respect to A-IV, 4 ("Applications relating to biological material"), no remedy is available before the EPO as designated/elected Office upon entry into the European phase if the specific requirements for the sufficient disclosure of the invention have not been met in the international phase. If, however, on filing the international application a reference to the deposit of biological material complying with Rule 31 was made but no proof of the deposit in the form of a copy of the deposit receipt issued by the depositary institution was submitted, the applicant is strongly advised to do so upon entry into the European phase. See also F-III, 6.5.

If the Euro-PCT application was not published by the IB in an official language of the EPO, the biological material referred to in the application is available upon request to any person (only) from the date of publication of the translation by the EPO (see E-IX, 2.5.1). In this case, if the applicant files the statement under Rule 32(1) before the technical preparations for publication of the translation by the EPO are completed, the biological material concerned will be made available only by the issue of a sample to an independent expert nominated by the requester (see A-IV, 4.3).

2.5 Instructions in Chapter A-VI ("Publication of application; request for examination and transmission of the dossier to examining division")

2.5.1 Publication of the international application

Art. 153(3) and (4)
Rule 159
Art. 67

The international publication of a Euro-PCT application in an official language of the European Patent Office takes the place of publication of the European patent application and will be mentioned in the European Patent Bulletin. If the international publication of the Euro-PCT application is in another language, a translation into one of the official languages must be filed with the EPO within 31 months of the priority date (Art. 22(1) PCT and Rule 159(1)(a)), see E-IX, 2.1.3. The EPO will publish the translation of the application submitted by the applicant upon entry into the European phase. In that case the provisional protection is, subject to Art. 67(2) and (3), only effective as from the date of publication of the translation by the EPO.

The translation of the international application is published together with the bibliographic data as an A document and includes all documents that were part of the international publication as originally published:

– the description as originally filed;

– the claims as originally filed;

– any claims amended under Art. 19 PCT, including any related statement of which a translation has been filed (see E-IX, 2.1.3, items (viii) and (ix));

– any drawings as originally filed;

– the sequence listing forming part of the description;

– the abstract;

– any appendices to the application;

– any certificate(s) of the deposit of biological material;

– the translation of the international search report (Rule 44*bis*.3 PCT).

The mandatory translation of the annexes to the IPER and any amendments to the application documents filed on or after entry into the European phase are not published.

If Rule 20.5*bis*(d) PCT applies (see C-III, 1.3), the publication will comprise the translation of both the erroneously filed application documents and the correct application documents. The front page of the publication will make reference to the fact that the notification of incompatibility under Rule 20.5*bis*(d) PCT applies to the application.

Pursuant to Art. 153(6), the international search report takes the place of the European search report. Once the supplementary European search report has been drawn up, this will be mentioned in the European Patent Bulletin. The supplementary search report itself is not published but is available via file inspection (see A-XI, 2.2).

If the translation is not supplied, the application is to be deemed withdrawn (see E-IX, 2.1.3). Furthermore, in this case, the application which has been published under the PCT is not considered as comprised in the state of the art in accordance with Art. 54(3) pursuant to Rule 165 (see G-IV, 5.2).

Rule 160(1)
Rule 165

2.5.2 Request for examination

The time limit under Rule 70(1) for filing the request for examination referred to in A-VI, 2 runs from the date of publication under Art. 21 PCT of the international search report. However, this time limit will not expire before the time prescribed by Rule 159(1)(f) (31-month time limit). See also E-IX, 2.1.4.

Art. 153(6)
Art. 150(2)
Rule 159(1)(f)

European substantive examination must normally not begin before expiry of the 31st month from the earliest priority date (Art. 23(1), 40(1) PCT). The only circumstance in which examination may begin earlier is if the applicant has expressly so requested (see E-IX, 2.8) and if any required supplementary European search report is available.

2.5.3 Supplementary European search

If a supplementary European search report has to be drawn up in respect of an international application which is deemed to be a European patent application, the applicant is entitled to receive the invitation provided for in Rule 70(2) (see A-VI, 2.2, third paragraph, and J 8/83). A time limit of six months from the notification of this communication is set for filing the

Rule 70(2)

confirmation required under Rule 70(2) and for response to the search opinion accompanying the supplementary European search report (Rule 70a(2) and the Notice from the EPO dated 15 October 2009, OJ EPO 2009, 533). Applicants making use of Form 1200 for entry into the European phase may waive the right to be asked whether they wish to proceed further by ticking a check box in section 12.2 (see the Notice from the EPO dated 7 July 2017, OJ EPO 2017, A74).

2.6 Reduction and refunds of fees in respect of international (PCT) applications

See A-X, 9.3 and 10.2.

2.7 Communication to the EPO as a designated Office

Art. 20(1)(a) PCT
Rule 44bis.2 PCT

A copy of the application together with the international search report or a declaration in accordance with Art. 17(2)(a) PCT is communicated by the International Bureau to the EPO as a designated Office in accordance with Art. 20(1)(a) PCT; the EPO does not require the applicant to furnish a copy of the international application (Rule 49.1(a-*bis*) PCT). The EPO as a designated Office will then examine the application for compliance with the requirements of the EPC (see in particular E-IX, 2.2 and 2.3).

The International Bureau shall communicate the International Preliminary Report on Patentability (Chapter I of the PCT) and any informal comments received from the applicant to the EPO as designated Office at 30 months from the priority date.

2.8 Early processing

Art. 23 PCT
Rule 44bis.2 PCT

When acting as a designated Office, the EPO must not process or examine an international application before expiry of the period applicable under Art. 22 PCT (Art. 23(1) PCT). However, the EPO may, on the express request of the applicant, process or examine an international application at any time (Art. 23(2) PCT). If the International Bureau (IB) has not yet transmitted to the EPO a copy of the international application, the ISR and the WO-ISA, the applicant may but does not have to file with the IB a request to do so. If necessary, the EPO will take care of this itself.

Art. 23(2) and 40(2) PCT

A request for early processing under Art. 23(2) or 40(2) PCT may be filed with the EPO at any time before expiry of the 31-month time limit (Art. 22(3) PCT and Rule 159(1)). The request does not require a specific wording, but applicants must clearly express that they wish the processing of their application before the EPO as designated/elected Office to commence early. Applicants using EPO Form 1200 may file a request by ticking a check box in section 12.1 (see the Notice from the EPO dated 7 July 2017, OJ EPO 2017, A74).

Rule 159(1)

For the request to be effective, applicants must comply with the requirements stipulated in Rule 159(1) as if the 31-month time limit expired on the date they request early processing, i.e.: payment of the filing fee (including any additional fee under Art. 2(1), item 1a, RFees if the application comprises more than 35 pages), filing of a translation (if a translation is required under Art. 153(4)), specification of the application documents, and payment of the search fee (where a supplementary

European search report has to be drawn up under Art. 153(7)). Which further requirements stipulated in Rule 159(1) must be complied with depends on the date on which early processing is requested, since the (regular) time limits for paying the designation fee (Rule 39(1)) and the renewal fee (Rule 51(1)) and for filing the request for examination and paying the examination fee (Rule 70(1)) may not have expired on the date the request for early processing is filed. Therefore, if any of these time limits is still running on that date (or, in the case of the renewal fee, if the due date according to Rule 51(1) is later than that date), the request for early processing will be effective without the requirement(s) concerned having been complied with (Art. 153(2), Art. 11(3) PCT).

If applicants wish not only the processing of the application before the EPO as designated/elected Office but also the examination of the application to start, they must have filed a valid request for examination (including payment of the examination fee), even if the time limit under Rule 70(1) has not yet expired at the date of effective entry into the European phase, since examination will be taken up only if a request for examination has been validly filed (see E-IX, 2.5.2). Furthermore, if a request for examination is filed before the EPO has, where applicable, sent the supplementary European search report to the applicants, examination will start only upon receipt of an indication from them that they wish to proceed further with the application and, if required, a response to the extended European search report (see E-IX, 2.5.3).

In the case of a correction of erroneously filed elements or parts under Rule 20.5*bis*(d) PCT by the receiving Office, which is not effective in proceedings before the EPO as designated/elected Office in accordance with the EPO's declaration of incompatibility (Rule 20.8 PCT), applicants who want to make use of the abridged procedure (by requesting that the correct application documents be disregarded or by indicating that they wish to pursue the application containing the correct application documents with the date of receipt of those application documents as the filing date – see C-III, 1.3) must inform the EPO accordingly at the time the request for early processing is validly filed or at the latest before the communication under Rules 20.8(c) and 82*ter*.1(c) and (d) PCT is issued.

As from 1 November 2017, the automatic debiting procedure may be used for effecting payment of the fees falling due on filing the request (see Annex A.1 and Annex A.2 to the ADA, Supplementary publication 5, OJ EPO 2017). However, automatic debiting can only be performed if the EPO can establish whether or not a page fee needs to be included as part of the filing fee (see A-III, 13.2). This is only possible if the EPO has access to the documents referred to in Art. 20 PCT, i.e. if:

– the international application has already been published at the time the request for early processing is received,

– the EPO is the receiving Office, or

– the EPO is acting as (S)ISA or IPEA.

If none of the above documents is available to the EPO on the day the request for early processing is filed, applicants are advised to choose another means of payment. Otherwise the fees due will be debited on the date of receipt of the documents referred to in Art. 20 PCT from the International Bureau (Rule 47.4 PCT) and the date on which the request for early processing takes effect will be postponed to that date.

If pursuant to Rule 159(1)(h) a certificate of exhibition must be filed and this requirement is not met, this will not prevent the request for early processing from being effective, but it will affect the prior art that the EPO takes into account in the European phase.

If on the date the request for early processing is filed any necessary requirement is not complied with, the request will be effective only as from the date on which all necessary requirements have been complied with.

If on the date the request for early processing is filed all necessary requirements for entry into the European phase are complied with, the request is effective and the Euro-PCT application will as from that date be processed in the same way as a Euro-PCT application which has entered the European phase by fulfilling the necessary requirements of Rule 159(1) within the 31-month time limit and without a request for early processing having been filed. On that date the international phase is thus terminated in respect of the EPO as designated/elected Office (J 18/09, Reasons 13). Moreover, since by filing an effective request for early processing the processing ban is lifted, as from that date it is no longer possible to claim the 31-month time limit under Rule 159(1). For details see the Notice from the EPO dated 21 February 2013, OJ EPO 2013, 156.

2.9 Review by the EPO as a designated/elected Office and rectification of errors made by the receiving Office or the International Bureau

2.9.1 Review by the EPO under Art. 25 PCT

Art. 25 PCT, Rules 51 and 82ter PCT
Rule 159(2)

The EPO may decide, in accordance with Art. 25 PCT, to allow an international application deemed to be withdrawn, or not accorded a filing date, to proceed as a European application.

To obtain such a review by the EPO as designated Office, applicants must take the following steps within the two-month time limit under Rule 51.1 PCT:

– request the IB to send copies of documents in the files promptly to the EPO as designated Office,

– pay the filing fee under Rule 159(1)(c) and, where required,

– furnish a translation of the Euro-PCT application.

Applicants are recommended to undertake the remaining steps for entry into the European phase under Rule 159(1) at the same time, possibly together with a request for early processing (see E-IX, 2.8).

The formalities officer acting on behalf of the examining division is competent to take decisions in relation to these applications (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6), and the Receiving Section transfers copies of any documents received from the International Bureau under the circumstances of Art. 25(1)(a) PCT to the examining division. Where it is decided that the application can proceed as a European application, the search and examination is carried out as for other applications, taking into account as the date of filing of the application the date it was originally filed with the PCT receiving Office and claiming the priority date of the international application, as applicable.

2.9.2 Review by the EPO under Art. 24 PCT and excuse of delays under Art. 48(2) PCT

Art. 24(2), 48(2), Rule 82bis PCT Art. 122, 121

Pursuant to Art. 24(2) PCT, the EPO as designated/elected Office may maintain the application as a European application even if this is not required by virtue of Art. 25(2) PCT (see also OJ EPO 1984, 565, Reasons 4). The filing of a request under Art. 24(2) PCT is governed by the same requirements as a request for review under Art. 25(2) PCT (see E-IX, 2.9.1), with the exception that the two-month time limit under Rule 51 PCT does not apply (see J 19/16, Reasons 6). Such requests may have to be combined with a request for re-establishment of rights under Art. 122 or further processing under Art. 121 (see E-VIII, 2 and E-VIII, 3) as the appropriate means of remedying the non-observance of a time limit under the EPC.

2.9.3 Rectification of errors made by the receiving Office or the International Bureau

Rule 82ter.1(a) PCT

If the applicant proves to the satisfaction of the EPO that the international filing date is incorrect owing to an error made by the receiving Office or that the priority claim has been erroneously considered not to have been made, and if the error is such that, had it been made by the EPO itself, the EPO would rectify it under the EPC, the EPO must rectify the error on the applicant's request and treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered not to have been made (see also E-IX, 2.9.1).

Art. 11(1)(iii)(d), (e), Rule 4.18, Rule 20.5bis PCT, 20.6, 82ter.1(b) PCT

Further, if a receiving Office accords the international filing date on the basis of incorporation by reference of missing parts under Rule 20.5 PCT, the EPO as designated/elected Office will review of its own motion whether the requirements of Rule 82*ter*.1(b)(i)-(iii) PCT have been complied with. In particular, the EPO will consider whether the element or part incorporated by reference was indeed missing. For instance, where the international application contained a description and a claim or claims on the international filing date, it is not possible to replace these elements with elements from a priority application. It is also not possible to add elements from a priority application if this would result in the international application having, for instance, two (or more) descriptions or two (or more) sets of claims. As of 1 July 2020, such cases may however be handled by the receiving Office under Rule 20.5*bis* PCT (see E-IX, 2.9.4 for the determination of the filing date in such a case).

Rule 82ter.1(c), (d) PCT

If the EPO does not agree with the finding of the receiving Office, it will notify the applicant that it intends to consider the (later) date on which the missing element or part was furnished as the international filing date in the European patent grant procedure, giving the applicant the opportunity to comment in accordance with Art. 113(1). In the case of missing parts, the applicant may also request that the missing part concerned be disregarded in the European patent grant procedure. In that case, the missing part will be considered not to have been furnished and the EPO will not treat the international application as if the international filing date had been corrected.

2.9.4 Determination of filing date in the case of erroneously filed elements or parts of the international application

Rule 20.5bis, 20.8(b-bis) PCT

Rule 20.5*bis* PCT, which entered into force on 1 July 2020, allows applicants to correct an erroneously filed element (description or claims) or part of the description, claims or drawings (including all drawings) contained in an international application. As a result of the EPO's notification of incompatibility under Rule 20.8(b-*bis*) PCT, if the receiving Office considered the correct application documents to be incorporated by reference under Rule 20.5*bis*(d) PCT, i.e. without changing the filing date, this incorporation will not be effective in proceedings before the EPO as designated/elected Office. For the procedure applied for establishing the filing date and the application documents forming the basis of proceedings, see C-III, 1.3.

2.10 Inspection of files

Art. 30(2) PCT
Rule 94.2bis PCT

In its capacity as a designated Office, the EPO also allows access to its files pertaining to the international phase of applications, provided that international publication has taken place. The above applies *mutatis mutandis* to the communication of information from the files.

Rule 94.3 PCT

In its capacity as elected Office the EPO allows access to its files (including the entire PCT Chapter II file) relating to the international phase of applications filed on or after 1 July 1998, provided international publication has taken place and, as far as the PCT Chapter II file is concerned, the IPER has been completed.

The above applies *mutatis mutandis* to the communication of information from the files (see A-XI, 2 and A-XI, 3).

3. The communication according to Rule 161

3.1 Applications for which a supplementary European search report is prepared

Where the EPO has not drawn up an international search report (as ISA) or a supplementary international search report (as the authority charged with the supplementary international search (SISA)), the application is subject to a supplementary European search under Art. 153(7) (see B-II, 4.3.2); a supplementary European search report and search opinion are issued accordingly (see B-XI, 1 and 2). The first communication is then issued as in C-III, 4.

In such cases, promptly after entry into the European phase, the applicant is invited to amend the application within a period of six months (see the Notice from the EPO dated 29 June 2010, OJ EPO 2010, 406, and the Notice from the EPO dated 15 October 2009, OJ EPO 2009, 533). All amendments and comments filed within this period will be taken into account in drawing up the supplementary European search report and the search opinion. The supplementary European search will be based on the last set of claims filed up to expiry of this period for which any claims fee due is paid. *Rule 161(2)*

The applicant may, but is not required to, reply to the WO-ISA, IPER or SISR drawn up by an authority other than the EPO, normally in the form of amendments and/or comments filed with Form 1200 or in response to a communication under Rule 161(2). If the applicant does reply to the WO-ISA, IPER or SISR, the supplementary search report and the search opinion will be drawn up taking this reply into account (see B-II, 4.3 and B-XI, 2).

For proceeding directly to supplementary European search without having to wait until the six-month time limit under Rule 161(2) expires, applicants may explicitly waive their right to a communication pursuant to Rules 161(2) and 162. No communication under Rule 161(2) or 162 is issued if, in addition to the waiver, the applicant has already paid any claims fees due (see the Notice from the EPO dated 5 April 2011, OJ EPO 2011, 354). If not, the communication will be issued and the application will be processed only after expiry of the six-month period, even if a request under the PACE programme has been filed (see E-VIII, 4).

When preparing the first communication in examination for such cases, the examiner may have to consider the international search report (with the corresponding International Preliminary Report on Patentability (IPRP) or the International Preliminary Examination Report (IPER)), any supplementary international search report (SISR), any supplementary European search report (with the corresponding search opinion) prepared by the EPO (see B-II, 4.3) and any reply filed in response thereto (see C-II, 3.1).

3.2 Applications for which no supplementary European search report is prepared

Where the EPO has drawn up an international search report (ISR) or a supplementary international search report (SISR), no supplementary European search report is prepared (see the Decision of the Administrative Council of 28 October 2009, OJ EPO 2009, 594, and B-II, 4.3.1, B-II, 4.3.2). In these cases, a written opinion of the ISA (WO-ISA) or a supplementary international search report (SISR) with explanations under Rule 45*bis*.7(e) PCT and – if the EPO was also IPEA – an international preliminary examination report (IPER) will already have been transmitted to the applicant during the international phase. *Rule 161(1)*

The applicant is required to respond to the WO-ISA or SISR prepared by the EPO or, where applicable, to the IPER prepared by the EPO as IPEA. This does not apply where amendments or observations have already been

filed which can be considered to be a reply (subject to certain requirements, see E-IX, 3.3.1). The time limit for response is six months from the invitation according to Rule 161(1) and is not extendable.

The communication under Rule 161(1) is issued promptly after expiry of the time limit for entry into the European phase and is combined with the communication under Rule 162(2) inviting the applicant to pay any claims fees due (see E-IX, 2.3.8).

Failure to respond to the WO-ISA, SISR or IPER within this period (by filing amendments and/or comments) leads to the application being deemed to be withdrawn according to Rule 161(1), unless one of the exceptions described in E-IX, 3.3 applies. Further processing is available for this loss of rights (see E-VIII, 2). In all cases, the latest filed request on file after expiry of the time limit according to Rule 161(1) will then be taken into account when drafting the first communication (see E-IX, 4.3.2) or when issuing the invitation under Rule 164(2) (see C-III, 2.3), provided that the application is not deemed to be withdrawn.

In order to proceed with the examination of the application without having to wait until the expiry of the six-month time limit for response, applicants may explicitly waive their right to a communication pursuant to Rule 161(1) and Rule 162. Provided that, on entry into the European phase, they have also already responded, where required, to the WO-ISA, the IPER or the SISR and paid the claims fees, no communication under Rules 161 and Rule 162 will be issued (see the Notice from the EPO dated 5 April 2011, OJ EPO 2011, 354). If this is not the case, the communication will be issued and the application will be processed only after expiry of the six-month period, even in the presence of a request under the PACE programme (see E-VIII, 4).

Where the EPO is an elected Office, the international preliminary examination report and the documents attached to it must be considered in accordance with E-IX, 4.3.

Where a translation of the priority document is required (see A-III, 6.8 and F-VI, 3.4), an invitation to file it according to Rule 53(3) may be sent by the examining division only after the period according to Rule 161(1) has expired (see A-III, 6.8.2).

3.3 Exceptions where a reply to the Rule 161(1) invitation is not required

In certain cases, even though the EPO was the ISA or the SISA, the applicant is not required to respond to the communication under Rule 161(1).

3.3.1 Earlier filed amendments or comments

A reply to the communication under Rule 161(1) may not be necessary where amendments or observations have already been filed that can be considered to be a valid reply. This is the case in the following situations:

(i) If the applicant has filed new amendments and/or comments upon entry into the regional phase before the EPO, provided that

- the applicant has indicated on entry into the European phase that such amendments and/or comments are to form the basis for further prosecution of the application (see E-IX, 2.1.1), and

- they constitute a valid response (see B-XI, 8).

(ii) If the applicant filed amendments according to Art. 19 and/or 34 PCT in the international phase, and if the EPO prepared the WO-ISA or SISR but no IPER (either because the applicant did not demand PCT Chapter II or because the IPEA was an office other than the EPO), then these amendments are considered to constitute a response to the WO-ISA or SISR, provided that the applicant

- has indicated on entry into the European phase that these amendments are maintained,

- has provided a copy of the amendments under Art. 34 PCT, filed with the IPEA other than the EPO, as well as any necessary translations in the language of the proceedings.

If amendments have been filed under Art. 19 or 34 PCT and have been taken into consideration in the drawing up of an IPER by the EPO acting as IPEA, these are not considered to constitute a response to the IPER as required by Rule 161(1); in these cases, the applicant is required to respond to the IPER within the six-month period according to Rule 161(1).

If the requirements of Rule 137(4) were not fulfilled for amendments already filed, the required indications are to be made in reply to the Rule 161(1) communication (see E-IX, 3.4).

In cases (i) and (ii) above, no communication under Rule 161(1) and 162 is issued if applicants have explicitly waived their right to these and have already paid any claims fees due (see E-IX, 3.2).

3.3.2 Positive WO-ISA, SISR or IPER

Where the WO-ISA, any supplementary international search report (SISR) or, where applicable, the subsequent IPER prepared by the EPO was positive (according to the same principles explained for European search opinions in B-XI, 3.9), the applicant is still sent a communication according to Rule 161(1), but is not required to respond to it.

No communication under Rule 161(1) and 162 is issued if applicants have explicitly waived their right to these and have already paid any claims fees due (see E-IX, 3.2).

3.3.3 Rule 161 communication issued before 1 April 2010

In cases where the Rule 161 communication was already issued before 1 April 2010, there is no requirement to respond to the WO-ISA prepared by the EPO or to the IPER prepared by the EPO as IPEA; if the applicant has not filed any amendments or comments upon entry into the regional phase before the EPO, the first communication will essentially be based on the content of said WO-ISA or IPER prepared by the EPO.

3.3.4 Voluntary reply to Rule 161(1) communication

In cases (i) and (ii) mentioned in E-IX, 3.3.1 and the case mentioned in E-IX, 3.3.2 where the applicants are not required to respond to the WO-ISA, SISR or IPER prepared by the EPO (in response to the invitation under Rule 161(1)), they **may** still do so by filing further amendments and/or comments if they so wish. Once again it is advisable that the requirements of Rule 137(4) are fulfilled for any such amendments when they are filed, thus avoiding a further communication according to Rule 137(4).

3.4 Rule 137(4) applies

Rule 137(4)

In the case of Euro-PCT applications for which an international search report or supplementary European search report has been drawn up by the EPO since 1 April 2010, if amendments which are to form the basis for further examination were filed either during the Rule 161(1) time limit or earlier, the requirements of Rule 137(4) must be complied with (the amendments must be identified and the basis for them in the application as filed indicated). If the applicant has not yet complied with these requirements on expiry of the time limit according to Rule 161(1), the examining division may request him to provide this information within a period of one month, by issuing a communication according to Rule 137(4). Failure to respond to this communication in time will lead to the application being deemed to be withdrawn (see H-III, 2.1 and H-III, 2.1.1). The examining division may send a Rule 137(4) communication before sending a communication according to Art. 94(3) and Rule 71(1), (2) or (3). Corresponding requirements exist for amendments made in the international phase (Rules 46.5, 66.8 and 70.2 PCT).

4. Examination procedure

4.1 At least one communication in examination

If deficiencies persist in the application even after applicants have filed their response to the WO-ISA, supplementary international search report or IPER (as required by Rule 161(1)), the examining division will in general issue at least one communication according to Art. 94(3) and Rule 71(1) and (2) in subsequent examination proceedings and will consider the applicant's reply thereto before issuing a decision or a summons to oral proceedings. This applies regardless of whether a communication according to Rule 164(2)(a) has been issued. In exceptional cases, summons to oral proceedings may be issued as the first action in examination proceedings (see C-III, 5).

4.2 No examination of multiple inventions in EP phase

Although under PCT Chapter II, where the EPO is the IPEA, the applicant can have multiple inventions examined in one IPER if further examination fees have been paid (or if the examiner has chosen not to invite the applicant to pay further fees), in the European procedure only one invention will be examined.

In cases where protection is sought for an invention not covered by the (supplementary) international search report, by the supplementary European search report or by a search carried out under Rule 164(2) because the search fee due was not paid, the examining division must invite the applicant to limit the application to one invention covered by one of these searches. The procedure under Rule 164(2) is set out in detail in C-III, 2.3. *Rule 164(2)*

If after receipt of the (supplementary) European search report or, where applicable, after a communication under Rule 164(2)(b) the applicant files amended claims relating to an invention which differs from any of the originally claimed inventions and which does not combine with these inventions to form a single inventive concept, an objection under Rule 137(5) is raised (see also F-V, 7 and H-II, 6). *Rule 137(5)*

4.3 Substantive examination of a Euro-PCT application accompanied by an IPER

The substantive examination is conducted in the same way as with any other European applications. Where the EPO was the International Preliminary Examining Authority, the international preliminary examination will normally have been carried out by the examiner responsible for examining the related Euro-PCT application.

The application to be examined will be accompanied by an international preliminary examination report drawn up in one of the official languages of the EPO. New documents in the original language may be attached in annex to the report (Art. 36(3)(a) PCT and Rule 70.16 PCT). The application will also be accompanied by a translation of the annexes, transmitted by the applicant, in the same language into which the international preliminary examination report was translated (Art. 36(3)(b) PCT). *Art. 14(1)*

The examination must be conducted in accordance with Art. 41 and 42 PCT, which stipulate that: *Art. 41 and 42 PCT*

(i) the applicant must be given the opportunity to amend the claims, the description and the drawings within a time limit prescribed pursuant to Rule 78.1(b) or 78.2 PCT (see also Rules 159(1)(b) and 161); and *Rule 159(1)(b)* *Rule 161*

(ii) the EPO cannot require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same application in any other elected Office.

4.3.1 Comparative test results

Where the EPO has established the IPER and refers therein to the submission of test reports, applicants are taken to agree to the use of these reports as the basis for proceedings before the EPO when they use the standard form for entry into the European phase before the EPO as elected Office, i.e. Form 1200. If the latter is not used or the IPER – referring to the test reports – was established by another International Preliminary Examination Authority, the applicant is invited to submit these reports for the European application.

4.3.2 Basis for substantive examination

Normally, the documents which are indicated in the international preliminary examination report as forming the basis for that report will also form the basis for the substantive examination in the EPO as an elected Office in the European phase. New documents (claims, description, drawings) submitted during the international preliminary examination and replacing the earlier filed documents will be attached to the international preliminary examination report. If the documents attached to the international preliminary examination report are in a language other than the language of the proceedings of the European application in the European phase, the applicant must be requested to file the documents in the language of the proceedings within a fixed period.

The applicant may also request that the examination be based on the documents in the international application as published or on amendments made on entry into the European phase. If the declarations of the applicant are unclear in this respect, the examiner will have to clarify the situation.

4.3.3 Consideration of the contents of the IPER

Rule 161(1)
Rule 159

If the international preliminary examination report has been drawn up by the EPO, it is to be regarded as an opinion for purposes of examination, and generally the first communication will be based on the opinion expressed in the IPER and the applicant's response to it filed in accordance with Rule 161(1) (if applicable, see E-IX, 3). Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence (e.g. if further prior-art documents are to be cited or if evidence is produced of unexpected effects), where the substantive patentability requirements under the PCT and the EPC are different, where applicants provide convincing arguments, appropriate amendments or relevant counter-evidence in their response to the IPER according to Rule 161(1), or conversely where the applicant provides amendments in response to the IPER which introduce further deficiencies.

Examination reports drawn up by other International Preliminary Examining Authorities must be examined carefully. If the reasons put forward in the international preliminary examination report are sound, they must not be disregarded.

Chapter X – Decisions

1. Basic principles of decisions

1.1 General remarks

Decisions subject to appeal are taken by the Receiving Section, the examining divisions, the opposition divisions and the Legal Division. Unless otherwise specified, the principles described in this chapter apply to all such decisions. They also apply to decisions taken by formalities officers to whom this work is entrusted (see the Decisions of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6, and 23 November 2015, OJ EPO 2015, A104).

Art. 106(1)
Art. 113(1)

According to Art. 113(1) EPC, decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments.

This provision is intended to ensure that no party can be taken by surprise by grounds for a decision against their application on which they did not have an opportunity to present their comments.

1.2 Consideration of time limits

A decision may not be given until any time limit set has expired, unless all the parties affected by the time limit expressly agree that it need no longer be observed or have submitted their final opinions before it expires. The decision to grant a patent may, however, be given once the applicant is deemed to have approved the text submitted to him under Rule 71(5) and has fulfilled all other formal requirements, even if the time limit set in the Rule 71(3) communication has not yet expired.

Moreover, as a rule, decisions will not be given until an internal EPO time limit (e.g. 20 days) following upon the official time limit (but from which the parties may derive no rights) has expired, so as to ensure that documents received at the end of the period officially allowed have actually been entered in the files when the decision is being taken and can be taken into account in the decision.

With reference to submissions and applications received after expiry of a time limit, see E-VIII, 1.8.

1.3 Form and content

Decisions are to be produced in writing. The same applies to decisions delivered at the end of oral proceedings (see E-III, 9).

No complete rules can be laid down about the form and content of decisions, which will depend on the requirements of each particular case.

The written decision will contain:

– the names of the parties to the proceedings (applicant, proprietor, opponents) and, if applicable, their representatives;

– the order (operative part), and, if necessary;

– the facts and submissions;

– the reasoning;

– the communication of the possibility of appeal (Rule 111(2)); and

Rule 113(1)

– the signature(s) and the name(s) of the employee(s) responsible.

Even in those cases in which the decision contains no communication of the means of redress, an appeal can be filed if the decision is incorrect, e.g. if the grant was not made on the basis of the documents that the applicant had approved.

If the decision is produced by the employee responsible using a computer, the EPO seal may replace the signature. If it is produced automatically by a computer the employee's name may also be dispensed with (Rule 113(2)).

1.3.1 Order

The order (or "operative part") of the decision, must clearly state the request of the parties and the extent to which this request is complied with (T 756/14). It may be, for example, as follows:

"The European patent application ... is hereby refused pursuant to Art. 97(2) EPC.";

"The opposition to the European patent ... is hereby rejected."; or

"The request for re-establishment of rights is hereby rejected".

1.3.2 Facts and submissions

Facts and submissions have to be given in so far as they are significant for the decision.

Under facts, a brief description of the case and a summary of the main reasons on which the decision is based and of the most important replies of the parties is given. These points, however, are to be covered in detail in the subsequent reasoning.

1.3.3 Reasoning

The statement of grounds must first set out and substantiate the reasons for the decision, citing the individual EPC articles and rules involved.

For decisions taken by the examining or opposition division, see E-X, 2.6.

The deciding instance will draft the decision based on one or more grounds forming the basis of the decision, as appropriate. It is essential that the parties have been given an opportunity to comment on all the grounds on which the decision is based.

When several grounds are used in the decision, it is imperative to link them in a logical way, in particular avoiding having a subsequent ground contradict an earlier one. Furthermore, the chain of grounds must be structured so that it starts with the main ground.

All significant arguments advanced by a party to the proceedings are carefully examined and comprehensively discussed in the decision.

In individual cases, consideration may also be given to the reasoning of those decisions which merely meet the requests of the parties. If, for example, a number of reasons are invoked for a request for re-establishment, of which only one justifies re-establishment, a reasoned decision on re-establishment may be appropriate, in order to clarify the official action.

2. Decisions taken by the examining or opposition divisions

In substantive examination, applicants must have an opportunity of presenting their comments on all the grounds invoked against their application.

Before an application is refused by the examining division, the search under Art. 54(3) is completed (see also C-IV, 7.1).

In opposition proceedings, if the patent is to be revoked, it must be ensured that the proprietor of the patent in particular is given sufficient opportunity to defend himself and, similarly, if the oppositions are to be rejected or if, despite the claims of the opponents, the patent is to be maintained in amended form, the opponents in particular must be given the same opportunity. A decision may be based on grounds indicated in a document from one of the parties, provided the document has been sent to the other parties so that they have had an opportunity to comment.

If more than two months have elapsed between despatch of the document "only for information" and the issue of the decision, this generally means that parties have had sufficient opportunity to comment and their right to be heard has therefore not been infringed (T 263/93).

If the patent is to be maintained in amended form, there must be a text of the claims and description which has been approved by the patent proprietor (D-VI, 2), and the opponent(s) must have had an opportunity to comment on it.

2.1 Examples

The right to be heard is a right not just to present comments but also to have those comments duly considered. Amendments and arguments submitted by a party need to be considered, and the party must be given an opportunity to comment on the grounds and evidence brought forward by the examining division (see T 1123/04 and T 852/07). A document may not be cited for the first time in a decision (see T 635/04) unless it has been introduced during oral proceedings. The use of fresh arguments in a decision still based on grounds and evidence communicated beforehand is not precluded (see T 268/00 and T 1557/07).

If a case is remitted from the boards of appeal for further prosecution, the examining division must check whether requests from examination proceedings prior to the appeal are still outstanding and must give the party an opportunity to comment (see T 1494/05). If the facts and grounds essential to a decision have been submitted by one party and if the party whose case is to be rejected has been afforded sufficient time to comment, the principle concerning the right to be heard set out in Art. 113(1) will have been respected. If the decision in opposition proceedings is to be based on grounds which were raised in the examination proceedings but not in the notice of opposition, the observations by the parties or the communications of the opposition division, these must be introduced (i.e. raised for discussion) by the opposition division in the opposition proceedings before the decision is given so as to afford the parties an opportunity to comment. If the opposition is based on lack of inventive step, the proprietor of the patent must expect that the prior art newly designated in the opposition proceedings will be considered in conjunction with the prior art described in the introductory part of an independent claim. However, if new facts and grounds are introduced during the proceedings or if the facts and grounds on which the envisaged decision is to be based were not stated so unambiguously and clearly in the written submissions of the parties as to give a party occasion to comment, the party concerned must be given an opportunity to submit an opinion and to produce evidence before the decision is given.

A patent proprietor's right to be heard has not however been violated if, by making only minor amendments to the claims in response to a communication from the opposition division setting out the material arguments against maintaining the patent as it stands, the result is that the grounds for revoking the patent remain essentially unchanged, provided the proprietor's comments have been duly considered.

In such a case, where the obstacles to maintenance have already been put to the proprietor and continue to apply, the patent may be revoked immediately, without any need to communicate again the full arguments on which the decision would be based.

2.2 Authoritative text of documents

Art. 113(2)

The EPO must decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or proprietor and last used as a basis for the proceedings. Consequently, for example, an amended version proposed by the examining or opposition division (see C-V, 1.1, D-VI, 4.2 and 7.2.1) may only be adopted as a basis for the decision if it has been approved by the applicant or proprietor.

In the case of one or more auxiliary requests directed to alternative texts for grant or maintenance of a patent, every such request qualifies as a text submitted or agreed by the applicant or proprietor within the meaning of Art. 113(2) (see T 234/86), and therefore must be dealt with in the order indicated or agreed to by the applicant or proprietor, up to and including the highest-ranking allowable request, if any.

When considering such requests it is essential that they are treated in the correct order. Thus, for instance, if the only allowable request is an auxiliary request, but is accompanied by a higher auxiliary request for oral proceedings (e.g. a request that oral proceedings be held if the main request cannot be granted) then a communication under Rule 71(3) could not be issued on the basis of the allowable request, but instead oral proceedings in accordance with the higher request would have to be appointed, or a further communication under Rule 71(1) issued (see E-X, 2.9). If the order of the requests is not clear from the applicant's submissions, then it would be necessary to contact the applicant to clarify the situation before proceeding.

2.3 Requirements as to form

Decisions taken by the examining or opposition divisions have to adhere to the principles laid down in E-X, 1. Where a decision is produced by means of a computer, the file copy contains the names and the actual signature(s) of the employee(s) responsible. *Rule 111(1)*

If, exceptionally, one or more division members cannot sign the decision, e.g. owing to extended illness, only a division member who was present at the oral proceedings (preferably the chair) may sign it on their behalf (see T 243/87). However, in such a situation, a brief written explanation as to why one member is signing on behalf of another must be provided (T 2348/19). A written decision signed by someone who did not take part in the oral proceedings at which the decision was pronounced is not legally valid (see T 390/86).

The presentation of the facts and the submissions, the reasoning and the communication of the means of redress are generally omitted when a decision merely meets the requests of all the parties concerned; this applies in particular to the decision to grant, which is based on the documents that the applicant has approved (Rule 71(5)). The same applies when the patent is maintained in an amended form, because this is preceded by a final interlocutory decision pursuant to Art. 106(2) concerning the documents on which the maintenance of the patent is to be based (see D-VI, 7.2.2).

2.4 Facts and submissions

For general aspects relating to facts and submissions, see E-X, 1.3.2. Facts and submissions which are irrelevant to the decision, e.g. requests for amendment which are not maintained, are to be omitted. It must be ensured that the facts and submissions are consistent with the contents of the minutes of oral proceedings (also see E-III, 10.3).

The facts and submissions must clearly indicate what is the subject of the application and show on which documents the decision is based. In examination, this requirement is achieved by including a detailed reference to the application documents which are subject to the decision, including, in particular, any amendments to the claims or to the description as well as maintained auxiliary requests. In addition, the examining division may cite the text of any important claim(s) or passages of the description in the decision. In opposition, the text of the independent claim(s) and other

especially important claims or passages of the description on which the decision is based must be cited verbatim in the language of the proceedings (Rule 3(2)) either by copying the text into the decision or annexing a copy of the claims. As regards the dependent claims, it may be sufficient to refer to the file content.

2.5 Decision on the file as it stands

Applicants may request a decision "on the file as it stands" or "according to the state of the file", e.g. when all arguments have been sufficiently put forward in the proceedings and the applicant is interested in a speedy appealable decision. C-V, 15 and subsections, describes the procedure to be followed in case of such a request.

2.6 Reasoning of decisions

If the division is of the opinion that no patent can be granted, it will substantiate this in a decision citing the individual EPC articles and rules involved. For important general aspects relating to the reasoning of decisions, see the example below and E-X, 1.3.3.

Example:

Often an application lacking an inventive step also lacks clarity. The decision must clearly set whether the application is refused because the subject-matter of the claims is unclear and would also lack inventive step once clarified or whether it is refused because the subject-matter of the claims lacks inventive step and would have to be clarified once the inventive step objection is overcome.

Art. 113(1)
Rule 111(2)

The reasoning for each of the grounds on which the decision is based must contain, in logical sequence, those arguments which justify the order. It must be complete and independently comprehensible, i.e. generally without references. If, however, a question has already been raised in detail in a particular communication contained in the file, the reasoning of the decision may be summarised accordingly and reference may be made to the relevant communication for the details.

The conclusions drawn from the facts and evidence, e.g. publications, must be made clear. In particular, there must be consistency between the reasons and the facts as set out in the decision and in the minutes (also see E-X, 2.4). The parts of a publication which are important for the decision must be cited in such a way that those conclusions can be checked without difficulty. Therefore, reference is made to each particular passage in the publication. It is not sufficient, for example, merely to assert that the cited publications show that the subject of a claim is known or obvious, or, conversely, do not cast doubt on its patentability.

The arguments put forward by the examiner during the proceedings form the "skeleton" for the decision and already define a complete and unbroken chain of reasoning leading to refusal. The decision may be based only on reasons already communicated to the applicant (Art. 113(1)). The applicant's arguments must be dealt with either point by point at the appropriate juncture in the chain of reasoning or *en bloc* at the end. The

latter approach is often preferable as it makes clear that the final result is based solely on reasons already communicated to the applicant in compliance with Art. 113(1). In the part refuting the applicant's arguments, the decision must make clear why none of those arguments persuaded the examining division to depart from the final result.

It is particularly important that special attention be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked. Documents which cover the same facts or arguments may be treated in summary form, in order to avoid unnecessarily long reasoning.

The need for complete and detailed reasoning is especially great when dealing with contentious points which are important for the decision; on the other hand, no unnecessary details or additional reasons need to be given which are intended to provide further proof of what has already been proven.

The decision is a standalone document and must include the statement that the application is refused. This serves to indicate that, in case of several grounds, all of them form the basis for the refusal.

The decisions will not contain any matter on which the parties have not had an opportunity to comment.

2.7 Content

The decision normally deals with all independent claims of the valid request(s) that were discussed during the proceedings. A single ground is enough to refuse an application, so it is not always necessary to deal with all the dependent claims. If however a particular dependent claim has been discussed, the decision includes the relevant arguments.

Any additional requests still outstanding must be dealt with in the refusal decision. If, for example, new oral proceedings were requested in circumstances where Art. 116(1), second sentence, applies, the decision must give the reasons for rejecting that request.

Formulations implying doubt or uncertainty, such as "seems" or "apparently", must be avoided in decisions.

2.8 Analysing the parties' arguments

All significant arguments advanced by a losing party to the proceedings are carefully examined and comprehensively refuted in the decision. The decision must substantiate the division's view that none of the submitted arguments overcome the objections it has raised.

However, facts not in dispute need be mentioned only briefly. Arguments by the parties which are clearly irrelevant to the issues involved do not need to be discussed.

2.9 Main and auxiliary requests

If during **examination proceedings** a main and auxiliary requests have been filed (see E-X, 2.2) and none of these is allowable, the reasons for the decision to refuse the application pursuant to Art. 97(2) must not be limited to the main request, but must also comprise the reasons for the non-allowability of each auxiliary request. If one of the requests is allowable, the communication pursuant to Rule 71(3) is to be issued on the basis of the (first) allowable request and must be accompanied by a brief indication of the essential reasons why the higher-ranking requests are not allowable or not admissible (see C-V, 1.1). If the applicant, in response to the communication pursuant to Rule 71(3), maintains higher-ranking requests which are not allowable or not admissible, a decision to refuse the application pursuant to Art. 97(2) will normally be issued (see C-V, 4.7 and 4.6.2); the reasons must set out the grounds for the non-allowability or non-admissibility of each request which ranks higher than the allowable request. In respect of the allowable request, the decision to refuse must mention that applicants have failed to give their approval to it.

Similarly, if in **opposition proceedings** the proprietor has submitted in addition to the main request one or more auxiliary requests, none of which is allowable, the patent must be revoked and the decision must set out, in respect of each request submitted and maintained by the proprietor, the reasons for not allowing it. Where one of the proprietor's requests directed to the maintenance of the patent in amended form is allowable, an interlocutory decision is to be issued on the basis of the (first) allowable request; it has to set out the reasons why this request meets the requirements of the EPC and, additionally, the reasons why the higher-ranking requests do not.

In so far as a decision includes the rejection of any of the multiple requests, such decision may not be taken until the applicant or proprietor has been informed, with respect to each of these requests, of the reasons for not allowing them, so that the applicant or proprietor is not deprived of the opportunity to present comments (Art. 113(1) – right to be heard). Similarly, an opportunity to comment must be granted to the opponent(s) with respect to an auxiliary request before it is held allowable by an interlocutory decision (see D-VI, 7.2).

Practical considerations will determine at which point in the decision the auxiliary request is dealt with.

2.10 Late-filed submissions

Art. 114(2)
Rule 116

If an examining or opposition division has exercised its discretion under Art. 114(2) or Rule 116 to refuse late-filed facts, evidence or requests, its decision must give the reasons for its refusal. A mere reference to the discretionary power given under Art. 114(2) or Rule 116 is not sufficient (see T 755/96). For details on how to exercise this discretion, see E-VI, 2 and H-II, 2.7.

2.11 Refusal to admit amendments under Rule 137(3)

When, in exercising its discretion under Rule 137(3), the examining division refuses to admit amended claims, it must give reasons for so doing. For details on how to exercise this discretion, see H-II, 2.3 and H-II, 2.7.

Rule 137(3)

3. Decisions which do not terminate proceedings – interlocutory decisions

A decision that does not terminate the proceedings as regards one of the parties is termed an interlocutory decision. An interlocutory decision can only be appealed together with the final decision, unless it allows separate appeal.

Art. 106(2)

The competent department will use its discretion as to the need for an interlocutory decision (see, however, D-VI, 7.2.2 with respect to the interlocutory decision for maintenance of a patent in amended form in opposition proceedings). To avoid fragmentation of the proceedings, such decisions will be the exception rather than the rule and will be given only if the duration or cost of the proceedings as a whole is thereby reduced. The interests of the parties will also be borne in mind as appropriate.

In the normal course, an interlocutory decision will be contemplated only for the purpose of ruling that separate appeal may be made, as only in this way can a decision be obtained on a preliminary point before the final decision terminating the proceedings is reached. (The proceedings must be suspended until the decision has become final.) It is especially important to allow separate appeal where the continuation of the proceedings depends on a preliminary ruling on a fundamental point of law, e.g. where different boards of appeal have given different rulings or conflicting decisions have been given by different examining or opposition divisions and no decision on appeal has been given in the matter.

Interlocutory decisions must state the reasons on which they are taken (see E-X, 1.3.3).

If it is decided not to allow separate appeal, the reasons for this ruling may be given in the final decision instead.

A ruling to allow a separate appeal must be part of the order of the decision (E-X, 1.3.1) (T 756/14).

4. Binding nature of decisions on appeals

If a department has to give a decision in a case which has already been remitted by the board of appeal for further prosecution to that department, it is bound by the *ratio decidendi* of the board of appeal, in so far as the facts, e.g. the subject-matter of the patent and the relevant state of the art, are the same.

Art. 111(2)

An opposition division is not bound by a decision of a board of appeal on appeal against a decision from an examining division (see T 167/93). The exclusive phrasing of the last sentence of Art. 111(2), only mentioning the examining division being bound by the decision on appeal against a decision of the Receiving Section, makes this clear. Opposition

proceedings are entirely separate from the examination proceedings, and the opposition division is entitled to examine the facts, evidence and arguments anew, particularly since another party (the opponent) is now involved. It, however, takes due notice of the assessment of these facts, evidence and arguments as contained in the reasons of the decision of the board of appeal.

5. Information as to means of redress

Rule 111(2) Decisions of the EPO which are open to appeal must be accompanied by a written communication of the possibility of appeal. The communication must also draw the attention of the parties to the provisions laid down in Art. 106 to 108 and Rules 97 and 98, the text of which must be attached. The parties may not invoke the omission of the communication.

6. Notification

Art. 119 Decisions must be notified as a matter of course (see E-II, 2).

Chapter XI – Impartiality of the examining or opposition division

Members of the competent divisions may not take part in the decision on a case:

(i) in which they may have any personal interest (partiality for subjective reasons) or

(ii) in respect of which the party may have good reasons to suspect partiality (partiality for objective reasons).

For the objection to be admissible it must be raised immediately after the party has become aware of the reason for it. The request must also be accompanied by a reasoned statement of grounds setting out the facts and arguments in support of the objection and, where appropriate, any evidence. Unsubstantiated and merely general statements, e.g. based on the nationality of the examiner(s) concerned, are not admissible.

Any challenge to impartiality must be submitted to the competent division, which will forward it to the responsible superior of the members of the division along with the statement of the member(s) concerned on the facts and circumstances put forward by the party. The responsible superior will decide on the challenge. If the challenge to impartiality has been raised in written proceedings and has been considered allowable, the concerned member(s) of the division is/are replaced. If the challenge has been considered either inadmissible or not allowable, the reasons are issued in writing. These reasons are part of the final decision and will be appealable with it.

If the challenge to impartiality is raised in oral proceedings, the proceedings are interrupted in order for the responsible superior to assess the challenge. On the same day, the oral proceedings are resumed and the parties are informed on the outcome of the assessment. If the challenge is found allowable, the oral proceedings are then adjourned. Proceedings will be continued by a division in which the concerned member(s) is/are replaced.

If the challenge to impartiality is considered either inadmissible or not allowable, the oral proceedings will continue. The parties will be informed of the reasons during oral proceedings. These reasons become part of the final decision and are appealable with it.

Chapter XII – Appeals

1. Suspensive effect

This chapter deals in detail only with those questions which are relevant for interlocutory revision. At this stage of the proceedings the department of first instance is still competent.

Art. 23(3)
Art. 109

Appeals shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division.

Art. 106(1)

An appeal has suspensive effect. This means that decisions may not yet become final and their effects are suspended. As the decision may not then be enforced, the following do not take place: entry in the Register of European Patents, mention in the European Patent Bulletin and, where appropriate, publication of a new specification of the European patent.

2. Appeals after surrender or lapse of the patent

An appeal may be filed against the decision of the opposition division even if the European patent has been surrendered or has lapsed for all the designated states.

Rule 98

3. Appeals against the apportionment of costs

The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. Parties to the proceedings who feel that they have been adversely affected by the apportionment of costs may therefore only file an appeal against the decision on costs if they also lodge an appeal against the decision on the opposition on other admissible grounds.

Rule 97(1)

4. Appeals against the decision of the opposition division on the fixing of costs

In accordance with Rule 97(2), the decision of the opposition division fixing the amount of costs of opposition proceedings may be appealed if the amount is in excess of the fee for appeal.

Rule 97(2)
Art. 13 RFees

5. Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings are parties to the appeal proceedings as of right.

Art. 107

6. Time limit and form of appeal

Notice of appeal must be filed with the EPO within two months of the date of notification of the decision appealed from. The notice is not deemed to have been filed until after the fee for appeal has been paid in the amount laid down in the Rules relating to Fees under the EPC. For appeals filed on or after 1 April 2018 by natural persons and entities referred to in Rule 6(4) and (5), i.e. small and medium-sized enterprises, non-profit organisations, universities and public research organisations, a reduced fee for appeal is payable (see the Notice from the EPO dated 18 December 2017, OJ EPO 2018, A5). Within four months after the date of notification of the

Art. 108
Rule 6(4), (5)

decision, a written statement setting out the grounds of appeal must be filed.

7. Interlocutory revision

7.1 General remarks

Art. 109(1) If the department whose decision is contested considers the appeal to be admissible and well founded, it must rectify its decision. This does not apply where the appellant is opposed by another party to the proceedings.

The obligation or possibility of rectification may thus arise in connection with a decision by the Receiving Section, the Legal Division, an examining division or exceptionally an opposition division if all oppositions were withdrawn and the proprietor has filed an appeal.

Art. 109(2) After receipt of the statement of grounds, only three months are available for rectification of the decision by the department of the first instance. That department must therefore consider the appeal with the highest priority and start the examination on admissibility immediately, and if the appeal is considered admissible in the form in which it has been filed, the competent department will start its examination on allowability immediately.

The department concerned will rectify its decision if convinced in the light of the grounds of appeal that the appeal is admissible and well founded. This could arise, for example, because:

(i) the department failed to take due account of some of the material available to it at the time the decision was made;

(ii) the department did not receive material filed at the EPO in due time before the issue of the decision, owing to an office error; or

(iii) the decision of the department concerned does not appear to be incorrect, but the applicant presents new information or evidence or files amendments to the application, which overcome the objections of the decision under appeal (see T 139/87).

For the advantages of a decision covering more than one objection, see E-X, 2.6.

In either case, whether the appealed decision is rectified or the appeal is remitted to the board, a decision issued by the examining or opposition division may be signed only by the examiners belonging to the division at the time of signature. If an examiner is absent for a long period or has left the department, a new member must be appointed to the division.

7.2 Remittal to the board of appeal

Art. 109(2) If the appeal is not allowed within three months after receipt of the statement of grounds, it must be remitted to the competent board of appeal without delay, and without comment as to its merit. This means that the department of first instance does not address any comments of substance to the board. Internal notes made by division members about the merits of

the appeal are kept in the non-public part of the dossier and are not sent to the board of appeal.

The receipt of the statement of grounds of appeal is a prerequisite for the examining division when deciding whether the appeal is well-founded. Such statements can be filed at any time within four months from the notification of the decision (Art. 108). Therefore, the examining division will wait until all the grounds are received before deciding whether to allow interlocutory revision or to remit the appeal to the board to ensure that the full content of the statement of grounds has been received.

7.3 Reimbursement of appeal fees

Rule 103(1)(a)
Art. 109

In the event of interlocutory revision, reimbursement of appeal fees will be ordered by the department whose decision has been impugned if such reimbursement is equitable by reason of a substantial procedural violation. This is particularly the case when essential facts or evidence were not taken into consideration in arriving at a decision, e.g. where a document filed at the EPO in good time by the party concerned is not placed in the file before a decision is reached or where the decision is based on facts or evidence on which the parties concerned had no opportunity of presenting their comments. The appeal fee is to be reimbursed, even if this was not explicitly requested by the appellant (see G 3/03).

If the decision is rectified by an interlocutory revision not because of any substantial procedural violation but e.g. because the party concerned submits amendments at the time of filing the appeal, there will be no reimbursement of appeal fees.

If the department whose decision is contested considers the requirements of Art. 109 for interlocutory revision to be fulfilled, but not the requirements of Rule 103(1)(a) for reimbursement of the appeal fee, it must rectify its decision and remit the request for reimbursement of the appeal fee to the board of appeal for a decision (see J 32/95).

The request for reimbursement of the appeal fee will be remitted to the board of appeal only if it was filed together with the appeal (see G 3/03 and T 21/02).

7.4 Examples

7.4.1 No amended claims filed with the appeal

If the applicant has filed an appeal but no amended claims, the division checks whether the decision was correct in substance. Interlocutory revision is only allowed if the decision was not correct in substance. A refund of the appeal fee is to be ordered if a substantial procedural violation has occurred (see E-XII, 7.3). If interlocutory revision is made and new objections arise, the division communicates these objections to the applicant as often as necessary to reach a final decision on the file; this could include holding oral proceedings (again) and/or a second refusal.

Example:

The applicant points out in the letter of appeal that the examining division has overlooked a request for oral proceedings.

The examining division looks at the file and notes that this was indeed the case: interlocutory revision must be made, even if it results in a further refusal after oral proceedings have been held. The appeal fee must be refunded.

7.4.2 Amended main/single request filed with the appeal

If amendments clearly overcome the grounds for refusal, interlocutory revision is granted even if further new objections arise. This is because the applicant has the right to examination in two instances (see T 219/93).

Important criteria are (see T 47/90):

1. the text is no longer the same

2. substantial amendments have been made.

"Substantial" amendments overcome grounds for refusal vis-à-vis the documents already cited in the decision (e.g. example (d) below).

The examiner has the discretion to decide whether, in each particular case, the amendments to the claims are such that examination has to be continued on a new basis, e.g. where a completely new line of inventive-step argumentation would be necessary.

In arriving at this decision, the examiner takes into account all the grounds mentioned in the original decision, including the main or supporting arguments already raised in previous objections to patentability to which the applicant has had an opportunity to respond and to which reference is made in the grounds of refusal (e.g. objections mentioned in previous communications, during personal consultation or at oral proceedings). This is in the interest of procedural efficiency and to the benefit of the applicant (no second appeal fee necessary, see T 2445/11).

If amendments made to the independent claims clearly do not meet the requirements of Art. 123(2), interlocutory revision is not granted, but the division sends the file to the boards of appeal. If there are doubts as to whether the amendments meet the requirements of Art. 123(2) or the amendments clearly meet the requirements of Art. 123(2), the division checks whether the amended claims overcome the ground(s) for refusal as indicated above.

Examples:

(a) The applicant has included a wording that has already been suggested by the examiner, the new claims are ready for grant but the description needs to be adapted: interlocutory revision must be granted since the grounds for the refusal have been overcome.

(b) **Refusal for lack of novelty only**. New claims are clearly novel but not inventive. The question of inventive step had not been raised in the decision or in the previous procedure: there must be an interlocutory revision.

(c) **Refusal for lack of novelty**. New claim 1 filed which includes a feature from dependent claim 3. This claim had already been discussed in the decision and was considered not to be inventive: no interlocutory revision.

(d) **Refusal for lack of novelty over D1**. New claim 1 filed which includes a feature from the description. This feature had not been previously discussed *per se*; however, it is clearly disclosed in D1: no interlocutory revision since the ground for refusal – lack of novelty over D1 – has not been overcome.

(e) **Refusal for lack of inventive step vis-à-vis D1 and D2**. New claims filed which include a feature from the description. This feature had not been previously discussed, but is clearly disclosed in D1, and therefore there is no change in the argumentation given: no interlocutory revision since the ground for refusal – lack of inventive step vis-à-vis D1 and D2 – has not been overcome.

(f) **Refusal for lack of inventive step vis-à-vis D1 and D2**. New claim filed which includes five new features from the description. These features have not been previously discussed. The examiner notes that although these features are disclosed in D2, the lack-of-inventive-step argumentation would have to be revised: interlocutory revision is allowed, since (i) the applicant has made substantial amendments to overcome the objections raised in the decision and (ii) the line of argumentation has to be revised.

(g) **Refusal for novelty vis-à-vis D1**. New claims filed which clearly relate to unsearched subject-matter and which do not combine with the original searched claims to form a single general inventive concept: no interlocutory revision because said claims cannot be allowed in the proceedings.

7.4.3 Main and auxiliary requests filed with the appeal

Interlocutory revision is never possible on the basis of an auxiliary request, even if an auxiliary request would overcome the grounds for the decision (T 919/95).

Example:

The main request is the same as the one refused (i.e. not amended). However, the auxiliary request corresponds to a suggestion made by the examining division and would thus be allowable. There can be no interlocutory revision since the applicant has the right to have the main request examined by the boards of appeal.

7.4.4 Response to communication pursuant to Rule 58 filed with the appeal

If, in response to the Receiving Section's refusal of the application pursuant to Art. 90(5), the related deficiencies are fully rectified so as to overcome the grounds for refusal, interlocutory revision is granted by the Receiving Section.

Example:

On the date of filing, the application documents did not comply with the requirements of Rule 46. The application was subsequently refused (Art. 90(5)) since the applicant filed the same poor-quality drawings in reply to the communication under Rule 58. When filing an appeal complying with the requirements of Art. 108, the applicant also files drawings of sufficient quality, thereby correcting the deficiency on which the refusal was based. Since the underlying ground for the refusal has been overcome and the reasoning in the decision under appeal no longer applies, the Receiving Section grants interlocutory revision and does not refer the case to the boards of appeal.

8. Rules of Procedure of the Boards of Appeal

Details of the procedure before the boards of appeal, including on the acceleration of appeal proceedings, can be found in the Rules of Procedure of the Boards of Appeal (see OJ EPO 2019, A63, as amended by OJ EPO 2021, A19). The Enlarged Board of Appeal has also adopted Rules of Procedure (see OJ EPO 2015, A35).

9. Remittal to the division after appeal

9.1 Orders on remittal

If a decision by an examining or opposition division is appealed, the board of appeal may remit the case to the division under Art. 111(1). In such cases, the exact wording of the orders must be complied with. Various situations may arise:

(a) The case is remitted for grant or maintenance in amended or limited form on the basis of a complete text which has been finally decided by the board.

(b) The case is remitted for the description to be brought into line with claims whose wording has been finally decided by the board.

(c) The case is remitted for further prosecution.

9.2 Consequences for the division

In situation (a) above, grant or maintenance is handled by the formalities officer, and the dossier goes back to the division merely for checking the classification and title and adding any references to supplementary technical information (STIN) or newly cited documents (CDOC).

Where the case is remitted with the order to grant, or maintain, the patent on the basis of documents with handwritten amendments, the formalities

officer on behalf of the competent division invites the applicant, or proprietor, to file a formally compliant version of the amended text under Art. 94(3) or Rule 82(2), as the case may be (see E-III, 8.7.2 and E-III, 8.7.3, respectively).

In situation (b) above, the board has taken a final decision on the wording of the claims which ends the matter. The division can no longer amend the claims or allow the applicant or proprietor to do so, even if new facts (e.g. new relevant citations) come to light (see T 113/92, Headnote No. 2, and T 1063/92, Headnote, second paragraph). Corrections under Rule 139, however, may still be allowable.

Applicants and proprietors should exercise all possible procedural economy when bringing the description into line with the claims' wording as decided by the board of appeal. Normally, therefore, completely retyped texts will not be accepted (see T 113/92, Headnote No. 1).

In situation (c) above, the division whose decision was appealed is bound by the board's *ratio decidendi*, in so far as the facts are the same (Art. 111(2)). However, new relevant documents or facts which come to light must be taken into account. In particular:

(a) the parties must be given the opportunity to submit further requests, and

(b) the division must check whether requests from examination or opposition proceedings prior to the appeal (e.g. for oral proceedings) are still outstanding – see T 892/92, Headnote.

Chapter XIII – Request from a national court for a technical opinion concerning a European patent

1. General

At the request of the competent national court trying an infringement or revocation action, the EPO is obliged, against payment of an appropriate fee, to give a technical opinion concerning the European patent which is the subject of the action. The examining divisions are responsible for the issue of such opinions. *Art. 25*

Only requests from a national court in a contracting state will be accepted by the EPO. It is not, however, up to the EPO to check whether the requesting court is "competent" to deal with the action or not. The examining division, however, checks whether a European patent is the "subject of the action".

The examining division responsible for the technical opinion gives the parties an opportunity to submit arguments in writing if the court so permits. However, the parties have no right to be heard before the EPO. Nevertheless, where the examining division considers it necessary, it may invite the parties, via the court and provided that the court so permits, either to be heard before the examining division or to submit supplementary observations on specific points identified by the examining division. If the parties are heard, such a hearing is not considered to constitute oral proceedings within the meaning of Art. 116.

The technical opinion is not a decision of the EPO. The parties to the national proceedings therefore have no right of appeal before the EPO against an unfavourable opinion.

2. Scope of the technical opinion

The examining division is obliged to give a "technical opinion" upon request. This means that the division is bound to give an opinion only in so far as the questions put are of a technical character. However, the examining division may not be too restrictive in this regard but will attempt to assist the national court as much as is reasonably possible, while remembering that the actual decision on infringement or revocation is exclusively a matter for the national court.

Generally speaking, the examining division attempts to give a technical opinion on any question which is similar to those normally dealt with in European substantive examination work, even when the question has a legal, as well as a technical, aspect. On the other hand, the examining division will decline to make any specific statement on whether a patent is valid or on whether it is infringed. It also does not give any opinion on the extent of protection (Art. 69 and the accompanying Protocol).

A request from a national court is to be expected to be clearly and precisely formulated, so that the examining division will be in no doubt as to the questions on which the court wishes to have an opinion. Since the court is

responsible for deciding the issues of law involved in the questions and since most questions include a mixture of legal and technical aspects, the court is expected where possible to separate clearly the legal aspects from the technical aspects upon which it seeks the opinion of the EPO.

3. Composition and duties of the examining division

3.1 Composition

The composition of the examining division to which the request is referred must be as defined in Art. 18(2). This means that the division must include three technical examiners; normally a legally qualified examiner will also be included. The main responsibility for dealing with the request up to the time of formulating the opinion is entrusted to one technical examiner, hereinafter referred to as the "primary examiner".

In order to guarantee that the opinion given is not influenced by earlier proceedings within the EPO on the application/patent in question, examiners who have taken part in such earlier proceedings as members of an examining or opposition division will be excluded from the examining division set up under Art. 25. Where this is not practicable, the national court and the parties are informed of the proposed members of the examining division under Art. 25 and of which among these members participated in European examination or opposition proceedings on the case. The court will be asked to state whether, in the circumstances, the request for a technical opinion is maintained.

3.2 Duties

The primary examiner will act on behalf of the examining division and will normally be responsible for issuing communications to the court. The primary examiner also drafts the written opinion and circulates the draft to the other members of the examining division for consideration. If any changes are proposed in the draft and there are differences of view on such changes, the chair arranges a meeting to resolve the matter. The final opinion is signed by all members of the division.

4. Language to be used

In principle the language to be used is the language of the proceedings of the European patent; however, if the court so requests, another official language of the EPO may be used. At least the request itself, any submissions from the parties, and any amendments to the patent must be in that language or translated into that language. The opinion is also produced in that language. However, where appropriate, the examining division will pay regard to the provisions of Art. 70(2) to (4).

Regarding documents to be used as evidence, the provisions of Rule 3(3) apply (see A-VII, 3).

The court or the parties are responsible for providing any translations which may be required to satisfy the above conditions.

5. Procedure

It is envisaged that the procedure will normally involve the following stages.

5.1 Formalities check

The formalities officer will check whether the fee has been paid and whether there are any obvious deficiencies as to the language requirements. If there are any deficiencies in these respects, the formalities officer will write to the national court informing it that no substantive work on the opinion will begin until the deficiencies have been remedied. However, no time limit can be imposed on the court. *Art. 2(1), item 20, RFees*

If the file indicates that the court permits the parties to submit written arguments to the EPO and such arguments are not already on the file, the formalities officer will write via the court to the parties giving them a time limit (say two months) for submitting such arguments.

5.2 Preliminary examination

When the formal requirements have been met, and, where appropriate, the arguments of the parties are on file, the case will be referred to the directorate responsible for the technical field of the patent in order for the examining division to be established. Assuming that an examining division consisting entirely of new members can be formed or, where this is not possible, that the court maintains its request for a technical opinion (see E-XII, 3), the primary examiner will perform a preliminary examination to determine whether:

(i) the questions put by the national court are such as the examining division is competent to answer, at least in part; and

(ii) the papers filed are sufficiently complete and the necessary translations have also been filed.

If there are any deficiencies in these respects, the primary examiner will write to the national court accordingly.

5.3 Withdrawal of the request

If the request for a technical opinion is withdrawn before the examining division starts any substantive work on the opinion, 75% of the fee will be refunded. *Art. 10 RFees*

5.4 Establishment and issue of the technical opinion

After any deficiencies as referred to in E-XIII, 5.1 or E-XIII, 5.2, above have been met, the examining division establishes the technical opinion as soon as possible.

The opinion is sent to the national court. Any papers received from the court which belong to the national proceedings are sent back with the opinion.

5.5 File inspection

The file of a request for a technical opinion is not a file within the meaning of Art. 128 and is not available for file inspection.

5.6 Appearance before the national court

If, after the opinion is issued, the national court asks the examining division to appear before it, the court is informed that the EPO is willing to send one member of the division provided that costs are paid and on the understanding that this member will be required only to answer questions on the technical opinion given and will not be required to give an opinion on additional matters unless notice in writing of these additional matters is given to the examining division at least one month before the appearance before the court.

Chapter XIV – Registration of changes of name, transfers, licences and other rights

1. General

Pursuant to Rules 22 to 24 and 85 in conjunction with Rule 143(1)(w), rights and transfer of such rights relating to an application or a European patent are registered in the European Patent Register.

Transfers and changes of name are recorded as particulars of the applicant in accordance with Rule 143(1)(f).

2. Responsible department

The Legal Division of the EPO bears the sole responsibility for these registrations (see the Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). *Art. 20*

The Legal Division may entrust specific duties which do not require legal expertise to formalities officers (see the Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 601).

3. Transfer of the European patent application

A European patent application may be transferred for one or more of the designated contracting states. *Art. 71*

Art. 72 is an autonomous provision which exclusively governs the formal requirements of such transfers. The EPO registers a transfer of rights in respect of a pending European patent application (see A-IV, 1.1.1 and J 10/93) in the European Patent Register on request, upon fulfilment of the prerequisites of Rule 22. The request is not deemed to have been filed until an administrative fee has been paid. The amount of the fee is determined by the latest schedule of fees and expenses of the EPO (see epo.org). *Art. 72*
Rule 22(1) and (2)

Where the request relates to multiple applications, a separate fee has to be paid for each application.

Rule 22 furthermore requires the production of documents providing evidence of such a transfer. Any kind of written evidence suitable for proving the transfer is admissible. This includes formal documentary proof such as the instrument of transfer itself (the original or a copy thereof) or other official documents or extracts thereof, provided that they immediately verify the transfer (J 12/00). Art. 72 requires that, for an assignment, the signatures of the parties appear on the documents submitted as evidence of the transfer. Assignment documents filed electronically (see A-II, 1.2.2) may, instead of handwritten signatures, bear qualified electronic signatures (see Notice from the EPO dated 22 October 2021; OJ EPO 2021, A86).

Where a document is signed on behalf of a legal person, only such persons as are entitled to sign by law, by the legal person's articles of association or equivalent or by a special mandate may do so. National law applies in that respect. In all cases, an indication of the signatory's entitlement to sign, e.g. his/her position within the legal entity where the entitlement to sign

results directly from such a position, is to be given. The EPO reserves the right to request documentary proof of the signatory's authority to sign if the circumstances of a particular case necessitate this. Where the entitlement results from a special authorisation, this authorisation (a copy thereof, which need not be certified) has to be submitted in every case. The EPO will in particular examine whether the signatory is empowered to enter into a legally binding contract on behalf of the legal entity. As a general rule, the authorisation to represent a party in proceedings before the EPO within the meaning of Rule 152 EPC, be it an individual or a general authorisation, is not as such considered to empower the representative to enter into such a contract.

If the evidence presented is found to be unsatisfactory, the EPO informs the party requesting the transfer accordingly, and invites it to remedy the stated deficiencies within a given time limit.

If the request complies with the requirements of Rule 22(1), the transfer is registered with the date on which the request, the required evidence or the fee has been received by the EPO, whichever is the latest. In case of a minor deficiency, i.e. if all requirements were present but not fulfilled completely (e.g. the request was signed but the name and/or position of the person signing were missing), once rectified the effective date is the date of receipt of the original request for registration.

Rule 22(3)

On the above date, the transfer becomes effective vis-à-vis the EPO, i.e. from that date the newly registered applicant is entitled to exercise the right to the European patent application in proceedings before the EPO (Art. 60(3)). If the transfer was for certain designated states only, Art. 118 applies.

Art. 20

Once a transfer has been duly entered in the European Patent Register, the registration cannot be undone, even if it appears that one or more requirements were actually not fulfilled for reasons not apparent at the time when the transfer was registered by the EPO, e.g. where doubts arise later as to the entitlement of the person signing on behalf of one of the parties to enter such a transfer agreement (see decisions J 16/14 to J 22/14). The original status quo is no longer restored until the valid legal situation has been established. In the meantime, proceedings may have to be stayed under Rule 14 or 78 until it is clear who the legitimate applicant/proprietor is.

4. Transfer of the European patent

Rule 85

Rule 22 applies *mutatis mutandis* to the registration of a transfer of the European patent during the opposition period or during opposition proceedings.

5. Changes of name

Mere changes of name, i.e. changes that do not involve a modification of the legal identity of the applicant, can be entered in the European Patent Register upon request and production of relevant documentary evidence as long as the application (cf. A-IV, 1.1.1) or the proceedings before the EPO are pending. Such registration is free of charge.

6. Licences and other rights

6.1 Registration

A European patent application may give rise to rights *in rem*, may be licensed and may be the subject of legal means of execution. This includes contractual licences only (Art. 73). Licences and other rights may be geographically limited to parts of the territories of the designated contracting states only.

Art. 71
Art. 73
Rule 23(1)
Rule 24(a) and (b)

In the case of co-applicants, the registration of licences requires the consent of each of the co-applicants.

Rule 22(1) and (2) apply *mutatis mutandis* to the registration of the grant, establishment or transfer of such rights (see E-XIV, 3).

A licence will be recorded in the European Patent Register as an exclusive licence if the applicant and the licensee so require. A licence will be recorded as a sub-licence where it is granted by a licensee whose licence is recorded in the European Patent Register.

6.2 Cancellation of the registration

A registration of licences or other rights is cancelled upon request, supported by documents providing evidence that the right has lapsed or by the written consent of the proprietor of the right to the cancellation of that right. Rule 22(2) applies *mutatis mutandis*, i.e. the cancellation is subject to the payment of an administrative fee. Cancellation is only possible until publication of the mention of the grant.

Rule 22(2)
Rule 23(2)

Part F

The European Patent Application

Contents

Chapter I – Introduction

Apart from the requirements of patentability (novelty, inventive step, industrial application and exclusions from patentability), a European patent application must also satisfy a number of other requirements. These include substantive requirements such as sufficiency of disclosure (Art. 83), clarity of the claims (Art. 84) and unity of invention (Art. 82) as well as requirements of a more formal nature such as the numbering of the claims (Rule 43(5)) and the form of the drawings (Rule 46). These requirements are dealt with in the present Part F.

Part F also deals with the requirements relating to the right to priority. This is because, despite the fact that this issue is usually assessed only when it has a potential bearing on a question of patentability (see G-IV, 3), it is nonetheless assessed independently of any issues of patentability.

Chapter II – Content of a European patent application (other than claims)

1. General

The requirements for a European patent application are set out in Art. 78. The application must contain: *Art. 78*

(i) a request for the grant of a European patent; *Art. 78(1)(a)*

(ii) a description of the invention; *Art. 78(1)(b)*

(iii) one or more claims; *Art. 78(1)(c)*

(iv) any drawings referred to in the description or the claims; and *Art. 78(1)(d)*

(v) an abstract. *Art. 78(1)(e)*

This Chapter deals with all these requirements, in so far as they are the concern of the search or examining division, with the exception of item (iii) which is the subject of Chapter F-IV. Item (v) is dealt with first.

2. Abstract

2.1 Purpose of the abstract

The application must contain an abstract. The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and any drawings. The abstract is merely for use as technical information and in particular cannot be used for the purpose of interpreting the scope of the protection sought. The abstract needs to be drafted so that it constitutes an efficient instrument for searching in the particular technical field and for evaluating if it is worth considering the whole content of the application. *Rule 57(d)* *Rule 47(5)*

2.2 Definitive content

The abstract is initially supplied by the applicant. The search division has the task of determining its definitive content, which will normally be published with the application. In doing this, it considers the abstract in relation to the application as filed (see B-X, 7(i)). If the search report is published later than the application, the abstract, published with the application will be the one resulting from the examination referred to in B-X, 7(i), third sentence. *Rule 66* *Rule 68*

In determining the definitive content, the search division takes into consideration the purpose of the abstract (see F-II, 2.1). *Art. 85* *Rule 47(5)*

2.3 Content of the abstract

The abstract must:

(i) indicate the title of the invention *Rule 47(1)*

(ii) indicate the technical field to which the invention pertains; *Rule 47(2)*

Rule 47(2) (iii) contain a concise summary of the disclosure as contained in the description, the claims and any drawings, which must be so drafted as to allow a clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use or uses of the invention and, where applicable, it should contain the chemical formula which, among those contained in the application, best characterises the invention;

Rule 47(2) (iv) **not** contain statements on the alleged merits or value of the invention or its speculative application;

Rule 47(3) (v) preferably not contain more than one hundred and fifty words; and

Rule 47(4) (vi) if the application contains drawings, be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany the abstract. Each main feature mentioned in the abstract and illustrated by a drawing needs to be followed by a reference sign in parenthesis.

2.4 Figure accompanying the abstract

Rule 47(4) The search division considers not only the text of the abstract but also the selection of the figures for publication with it. It alters the text to the extent that this may be necessary in order to meet the requirements set out in F-II, 2.3. The search division will select a different figure, or figures, of the drawings if it considers that they better characterise the invention.

The search division may prevent the publication of any drawing with the abstract, where none of the drawings present in the application is useful for the understanding of the abstract. This can be done even when the applicant has requested that a particular drawing or drawings be published with the abstract according to Rule 47(4).

In determining the content of the abstract, the search division concentrates on conciseness and clarity, and refrains from introducing alterations merely for the purpose of embellishing the language (see B-X, 7).

2.5 Checklist

In considering the abstract, the search division checks it against the General Guidelines for the Preparation of Abstracts of Patent Documents, using the checklist contained in WIPO Standard ST.12, the relevant parts of which are annexed to this Chapter (F-II, Annex 1).

2.6 Transmittal of the abstract to the applicant

Rule 66 The content of the abstract is transmitted to the applicant together with the search report (see B-X, 7(i)).

2.7 Abstract in examination

Art. 98 The general considerations relating to the abstract are set out in F-II, 2.1 to F-II, 2.6. The abstract relates to the application as filed and published and its final form for publication is determined by the search division. It is not necessary to bring it into conformity with the content of the published patent even if this should differ in substance from that of the application, since the

patent specification does not contain an abstract. The examining division therefore does not seek any amendment of the abstract.

The abstract has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter. *Art. 85*

3. Request for grant – the title

The items making up this request are dealt with in A-III, 4. They do not normally concern the search division or the examining division, with the exception of the title.

The title should clearly and concisely state the technical designation of the invention and should exclude all fancy names (see A-III, 7.1). While any obvious failures to meet these requirements are likely to be noted during the formalities examination (and possibly during the search, see B-X, 7(ii)), the search division or the examining division reviews the title in the light of its reading of the description and claims and any amendments thereto, to make sure that the title is concise and gives a clear and adequate indication of the subject of the invention. Thus, if amendments are made which change the categories of claims, the examining division checks whether a corresponding amendment is needed in the title. *Rule 41(2)(b)*

4. Description (formal requirements)

4.1 General remarks

The application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. *Art. 83* *Rule 42*

The "person skilled in the art" for this purpose is considered to be the skilled practitioner in the relevant field aware not only of the teaching of the application itself and the references therein, but also of what was common general knowledge in the art at the date of filing (date of priority) of the application. She is assumed to have at her disposal the means and the capacity for routine work and experimentation, which are normal for the technical field in question. As "common general knowledge" can generally be considered the information contained in basic handbooks, monographs and textbooks on the subject in question (see T 171/84). As an exception, it can also be the information contained in patent specifications or scientific publications, if the invention lies in a field of research which is so new that the relevant technical knowledge is not yet available from textbooks (see T 51/87). Sufficiency of disclosure must be assessed on the basis of the application as a whole, including the description, claims and drawings, if any. The provisions relating to the content of the description are set out in Rule 42. The purpose of the provisions of Art. 83 and Rule 42 is:

(i) to ensure that the application contains sufficient technical information to enable a skilled person to put the invention as claimed into practice; and

(ii) to enable the skilled person to understand the contribution to the art which the invention as claimed has made.

4.2 Technical field

Rule 42(1)(a)

The invention should be placed in its setting by specifying the technical field to which it relates, for example by reproducing the first ("prior art") portion of the independent claims in full or in substance or by simply referring to it.

If claims are amended, the "field of the invention" and "summary of the invention" may also need to be amended to correspond to the claims. If appropriate, it is possible to use statements like "the invention is set out in the appended set of claims" instead of repeating the claims *verbatim*.

4.3 Background art

Rule 42(1)(b)
Art. 123(2)

The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first ("prior art") portion of the independent claim or claims (see F-IV, 2.2).

In principle, when filing an application the applicant should cite in the description the closest prior art known to them. It may happen that the prior art cited by the applicant is not the closest existing for the claimed invention. Therefore, the documents cited in the application as filed do not necessarily describe the known innovations closest to the claimed invention, but may in fact constitute more distantly related prior art.

The insertion into the statement of prior art of references to documents identified during examination may be necessary to put the invention into proper perspective (see T 11/82). For instance, while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examining division requires a reference to these documents and a brief summary of the relevant contents. The subsequent inclusion of such a summary in the description does not contravene Art. 123(2). The latter merely lays down that, if the application is amended, for example by limiting it in the light of additional information on the background art, its subject-matter must not extend beyond the content of the application as filed. But the subject-matter of the European patent application within the meaning of Art. 123(2) is to be understood – starting off from the prior art – as comprising those features which, in the framework of the disclosure required by Art. 83, relate to the invention (see also H-IV, 2.1). In addition, relevant prior-art documents not cited in the original application may be subsequently acknowledged in the description even if these were known to the applicant at the time of filing (T 2321/08 and H-IV, 2.2.6).

References to the prior art introduced after filing must be purely factual. Any alleged advantages of the invention must be adjusted if necessary, in the light of the prior art.

New statements of advantage are permissible provided that they do not introduce into the description matter which extends beyond the content of the application as filed (see H-V, 2.2).

The applicant may cite documents in the application which relate to standard technical knowledge (background art neither addressing the same technical problem nor necessary to complete the disclosure of the claimed invention). Such citations typically relate to well-known tests for measuring certain parameters mentioned in the description or to the definitions of terms of established meaning that are used in the application. Usually they are not relevant for assessing the patentability of the claimed invention, unless for example they contain relevant information which the applicant does not mention in the description.

Acknowledgment of prior art relevant to the dependent claims only is generally not required. If the applicant indicates that subject-matter initially cited as prior art is only "in-house state of the art", such prior art may not be used in the assessment of novelty and inventive step (see T 654/92, Reasons 4, and T 1001/98, Reasons 3). However, it may be allowed to remain in the description, provided the fact that it is only "in-house state of the art" is made clear.

Art. 54(3)

If the relevant prior art consists of another European patent application falling within the terms of Art. 54(3), this relevant prior document belongs to the state of the art for all contracting states. This is the case even if the two applications do not share any commonly designated state, or the designation of commonly designated states has been dropped (see G-IV, 6). The fact that this document falls under Art. 54(3) must be explicitly acknowledged. Thus the public is informed that the document is not relevant to the question of inventive step (see G-VII, 2). According to Rule 165, the above also applies to international applications designating EP, for which the filing fee pursuant to Rule 159(1)(c) has been validly paid and, where applicable, the translation into one of the official languages has been filed (Art. 153(3) and (4)) (see G-IV, 5.2).

Art. 54(4) EPC 1973

For transitional provisions concerning the applicability of Art. 54(4) EPC 1973, see H-III, 4.2.

4.3.1 Format of background art citations

In citing documents or inserting references, applicants and examining divisions alike must use codes that allow the references to be retrieved without difficulty. This can be best achieved through consistent use of the WIPO standards format:

(i) for non-patent literature, WIPO Standard ST.14 (Recommendation for the Inclusion of References Cited in Patent Documents);

(ii) for patent literature (applications, granted patents and utility models): for the two-letter country code, WIPO Standard ST.3 (Recommended Standard on Two-Letter Codes for the Representation of States, Other Entities and Intergovernmental Organizations); for symbols indicating the type of document, WIPO Standard ST.16

(Recommended Standard Code for the Identification of Different Kinds of Patent Documents).

WIPO standards:

ST.14 (http://www.wipo.int/export/sites/www/standards/en/pdf/03-14-01.pdf)
ST.3 (http://www.wipo.int/export/sites/www/standards/en/pdf/03-03-01.pdf)
ST.16 (http://www.wipo.int/export/sites/www/standards/en/pdf/03-16-01.pdf)
These can be found on the WIPO website.

However, in the case of deviation from these standards there is no need to correct the codes used, as long as straightforward retrieval of the citation(s) is possible.

4.3.1.1 Examples of quotation for non-patent literature

(i) For a monograph:

WALTON Herrmann, Microwave Quantum Theory. London: Sweet and Maxwell, 1973, Vol. 2, pages 138 to 192.

(ii) For an article in a periodical:

DROP, J.G. Integrated Circuit Personalization at the Module Level. IBM tech. dis. bull. October 1974, Vol. 17, No. 5, pages 1344 and 1345.

(iii) For a separately published abstract:

Chem. abstr., Vol. 75, No. 20, 15 November 1971 (Columbus, Ohio, USA), page 16, column 1, abstract No. 120718k, SHETULOV, D.I. "Surface Effects During Metal Fatigue," Fiz.-Him. Meh. Mater. 1971, 7(29), 7-11 (Russ.).

Patent Abstracts of Japan, Vol. 15, No. 105 (M-1092), 13 March 1991, JP 30 02404 A (FUDO).

4.3.1.2 Examples of quotation for patent literature

(i) JP 50-14535 B (NCR CORP.) 28 May 1975 (28.05.75), column 4, lines 3 to 27.

(ii) DE 3744403 A1 (A. JOSEK) 29.08.1991, page 1, abstract.

4.4 Irrelevant matter

Rule 48(1)(c)

Since the skilled person is presumed to have the general technical background knowledge appropriate to the art, the examining division does not require the applicant to insert anything in the nature of a treatise or research report or explanatory matter which is obtainable from textbooks or is otherwise well-known. Likewise the examining division does not require a detailed description of the content of cited prior documents. It is sufficient that the reason for the inclusion of the reference is indicated, unless in a particular case a more detailed description is necessary for a full

understanding of the invention of the application (see also F-III, 8 and F-IV, 2.3.1).

A list of several reference documents relating to the same feature or aspect of the prior art is not required; only the most appropriate need be referred to. On the other hand, the examining division does not insist upon the excision of any such unnecessary matter, except when it is very extensive (see F-II, 7.4).

4.5 Technical problem and its solution

Rule 42(1)(c)
Rule 48(1)(b)

The invention as claimed should be disclosed in such a way that the technical problem, or problems, with which it deals can be appreciated and the solution can be understood. To meet this requirement, only such details should be included as are necessary for elucidating the invention.

As an example, to elucidate the nature of the solution according to the independent claims, either the characterising portion of the independent claims could be repeated or referred to, or the substance of the features of the solution according to the relevant claims could be reproduced (see F-II, 4.2).

In cases where the subject-matter of a dependent claim can be understood either by the wording of the claim itself or by the description of a way of performing the invention, no additional explanation of this subject-matter will be necessary. A mention in the description that a particular embodiment of the invention is set out in the dependent claim will then be sufficient.

When there is doubt, however, as to whether certain details are necessary, the examining division does not insist on their excision. It is not necessary, moreover, that the invention be presented explicitly in problem-solution form. Any advantageous effects which the applicant considers the invention to have in relation to the prior art should be stated, but this should not be done in such a way as to disparage any particular prior product or process. Furthermore, neither the prior art nor the applicant's invention should be referred to in a manner likely to mislead. This might be done e.g. by an ambiguous presentation which gives the impression that the prior art had solved less of the problem than was actually the case. Fair comment as referred to in F-II, 7.3 is, however, permitted. Regarding amendment to, or addition of, a statement of problem, see H-V, 2.4.

4.6 Rule 42(1)(c) vs. Art. 52(1)

Rule 42(1)(c)

If it is decided that an independent claim defines a patentable invention within the meaning of Art. 52(1), it must be possible to derive a technical problem from the application. In this case the requirement of Rule 42(1)(c) is fulfilled (see T 26/81).

4.7 Reference in the description to drawings

Rule 42(1)(d)

If drawings are included they should first be briefly described, in a manner such as: "Figure 1 is a plan view of the transformer housing; Figure 2 is a side elevation of the housing; Figure 3 is an end elevation looking in the direction of the arrow X of Figure 2; Figure 4 is a cross-section taken through AA of Figure 1." When it is necessary to refer in the description to

elements of the drawings, the name of the element should be referred to as well as its number, i.e. the reference should not be in the form: "3 is connected to 5 via 4" but, "resistor 3 is connected to capacitor 5 via switch 4".

4.8 Reference signs

Rule 46(2)(i)

The description and drawings need to be consistent with one another, especially in the matter of reference numbers and other signs, and each number or sign must be explained. However, where as a result of amendments to the description whole passages are deleted, it may be tedious to delete all superfluous references from the drawings and in such a case the examining division does not pursue an objection under Rule 46(2)(i), as to consistency, too rigorously. The reverse situation should never occur, i.e. all reference numbers or signs used in the description or claims must also appear on the drawings.

4.9 Industrial application

Rule 42(1)(f)
Art. 52(1)
Art. 57

The description should indicate explicitly the way in which the invention is capable of exploitation in industry, if this is not obvious from the description or from the nature of the invention. The expression "capable of exploitation in industry" means the same as "susceptible of industrial application", and indeed identical expressions are used in the French and German texts of the EPC. In view of the broad meaning given to the latter expression by Art. 57 (see G-III, 1), it is to be expected that, in most cases, the way in which the invention can be exploited in industry will be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must therefore be explicitly indicated.

Rule 29(3)

Also, in relation to certain biotechnological inventions, i.e. sequences and partial sequences of genes, the industrial application is not self-evident. The industrial application of such sequences must be disclosed in the patent application (see G-III, 4).

4.10 Manner and order of presentation

Rule 42(2)

The manner and order of presentation of the description should be that specified in Rule 42(1), i.e. as set out above, unless, because of the nature of the invention, a different manner or a different order would afford a better understanding. Since the responsibility for clearly and completely describing the invention lies with the applicant, the examining division does not object to the presentation unless satisfied that such an objection would be a proper exercise of its discretion.

Some departure from the requirements of Rule 42(1) is acceptable, provided the description is clear and orderly and all the requisite information is present. For example, the requirements of Rule 42(1)(c) may be waived where the invention is based on a fortuitous discovery, the practical application of which is recognised as being useful, or where the invention breaks entirely new ground. Also, certain technically simple inventions may be fully comprehensible with the minimum of description and only slight reference to prior art.

4.11 Terminology

Although the description needs to be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is acceptable, and will often be desirable. Little-known or specially-formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning are not allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs must be consistent throughout the application.

Rule 49(11)

4.12 Computer programs

In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention. The description, as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by a person skilled in the art who is deemed not to be a specialist in any specific programming language, but does have general programming skills. Short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention.

4.13 Physical values, units

When the properties of a material are referred to, the relevant units need to be specified if quantitative considerations are involved. If this is done by reference to a published standard (e.g. a standard of sieve sizes) and such standard is referred to by a set of initials or similar abbreviation, it needs to be adequately identified in the description.

Physical values must be expressed in the units recognised in international practice, which is generally in the metric system, using SI units and the other units referred to in Chapter I of the Annex to EEC Directive 80/181/EEC of 20 December 1979, as amended by EEC Directives 85/1/EEC of 18 December 1984, 89/617/EEC of 27 November 1989, 1999/103/EC of 24 January 2000, 2009/3/EC of 11 March 2009 and Commission Directive (EU) 2019/1258 of 23 July 2019 (see F-II, Annex 2). Any values not meeting this requirement must also be expressed in the units recognised in international practice. Values expressed in the system of imperial units (e.g. inches/pounds) or in units having local character (e.g. pint), in general, do not meet the criterion "recognised in international practice".

Rule 49(10)

As Rule 49(10) indicates, for mathematical formulae the symbols in general use must be employed. For chemical formulae, the symbols, atomic weights and molecular formulae in general use must be employed.

In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

4.14 Registered trade marks

It is the applicant's responsibility to ensure that registered trade marks are acknowledged as such in the description. For the assessment of the clarity of claims referring to a trade mark (Art. 84), see F-IV, 4.8. With regard to the effect of references to trade marks on sufficiency of disclosure (Art. 83), see F-III, 7.

5. Drawings

5.1 Form and content

Rule 46
Rule 46(2)(j)

The requirements relating to the form and content of drawings are set down in Rule 46. Most of these are formal (see A-IX), but the examining division may sometimes need to consider the requirements of Rule 46(2)(f), (h), (i) and (j). Of these, the only question likely to cause difficulty is whether the textual matter included on the drawings is absolutely indispensable. In the case of circuit diagrams, block schematics and flow sheets, identifying catchwords for functional integers of complex systems (e.g. "magnetic core store", "speed integrator") may be regarded as indispensable from a practical point of view if they are necessary to enable a diagram to be interpreted rapidly and clearly.

5.2 Printing quality

The examining division has also to check whether the drawings in the printing copy ("Druckexemplar") are suitable for printing. If necessary, a copy of the original drawings must be prepared as the printing copy. If, however, the quality of the original drawings is also insufficient, then the examining division must request the applicant to present drawings of sufficient quality for printing. It needs to, however, beware of any extension of subject-matter (Art. 123(2)).

5.3 Photographs

For the presentation of photographs, see A-IX, 1.2. In the case of photographs of insufficient original quality for printing, the examining division does not request filing of better photographs, as the risk of infringing Art. 123(2) is obvious. In that case, the insufficient quality is accepted for reproduction.

6. Sequence listings

For the presentation of sequence listings in general, see A-IV, 5.

6.1 Reference to sequences disclosed in a database

The application may refer to a biological sequence belonging to the state of the art by merely providing the sequence's accession number and its version or release number in a publicly available database, without presenting the sequence itself either in a sequence listing complying with the applicable WIPO standard or in any other format.

Since in this case the sequence is already publicly available, the applicant does not need to supply a sequence listing. This applies even if reference is made to these sequences in one or more claims or if the sequences are essential features of the invention or necessary for the prior-art search

(see J 8/11). If the European patent application discloses nucleotide or amino acid sequences that are fragments or variants of a prior-art sequence, a sequence listing complying with the applicable WIPO standard has to be filed for these sequence fragments or variants (see the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542, I.1.5). If the database and/or the sequences in question is/are not completely and unambiguously identified, the sequences are not sufficiently disclosed according to Art. 83 and cannot be added to the application to complete the disclosure without contravening Art. 123(2) (see F-III, 2).

If such insufficiently disclosed sequences are not essential features of the claimed invention, normally no objection is raised. On the other hand, where these sequences are essential features of at least a part of the claimed subject-matter, this results in problems relating to the sufficiency of the original disclosure according to Art. 83, because the nature of the sequences cannot be unambiguously derived from the incomplete or ambiguous reference to the database.

Examples where a biological sequence is considered an essential feature of the invention would be a diagnostic method using a particular nucleic acid sequence or a product made by a biochemical process using an enzyme with a particular amino acid sequence. An example of ambiguous identification would be the citation of an accession number of a certain protein in the database of the European Molecular Biology Laboratory EMBL with no indication of which version number or database release number is meant when there are several such numbers referring to different sequences of the protein.

7. Prohibited matter

7.1 Categories

There are three categories of specifically prohibited matter, these being defined in sub-paragraphs (a) to (c) of Rule 48(1) (see also G-II, 4). *Rule 48*

7.2 Matter contrary to "*ordre public*" or morality

The omission, from the publication of the application, is mandatory for the first category (Rule 48(1)(a)). Examples of the kind of matter coming within this category are: incitement to riot or to acts of disorder; incitement to criminal acts; racial, religious or similar discriminatory propaganda; and grossly obscene matter. *Rule 48(1)(a)*

With regard to patentability issues with such matter, see G-II, 4.1 and subsections.

7.3 Disparaging statements

It is necessary to discriminate in the second category between libellous or similarly disparaging statements, which are not allowed, and fair comment, e.g. in relation to obvious or generally recognised disadvantages, or disadvantages stated to have been found and substantiated by the applicant, which, if relevant, is permitted. *Rule 48(1)(b)*

7.4 Irrelevant or unnecessary matter

Rule 48(1)(c)

The third category is irrelevant or unnecessary matter: such matter is specifically prohibited under Rule 48(1)(c) only if it is "obviously irrelevant or unnecessary", for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art (see also F-II, 4.4). The matter to be removed may already be obviously irrelevant or unnecessary in the original description. It may, however, be matter which has become obviously irrelevant or unnecessary only in the course of the examination proceedings, e.g. owing to a limitation of the claims of the patent to one of originally several alternatives. When matter is removed from the description, it must not be incorporated into the patent specification by reference to the corresponding matter in the published application or in any other document (see also F-III, 8).

7.5 Omission of matter from publication

Rule 48(2) and (3)

Generally, the Receiving Section will deal with matter falling under category 1(a) and may have dealt with matter obviously falling within category 1(b), but if any such matter has not been so recognised and has therefore not been omitted from the publication of the application, it is required to be removed during examination of the application together with any other prohibited matter. The applicant is informed of the category under which matter is required to be removed.

Annex 1
Checklist for considering the abstract (see F-II, 2.5)

In the following checklist, the abstractor should, after having studied the disclosure to be abstracted, place a check in the second column after the applicable terms listed in the first column. The requirements listed in the third column corresponding to the checked items of the first column should be borne in mind by the abstractor when preparing the abstract. Finally, the abstractor may compare the finished abstract with the checked requirements and place a corresponding checkmark in the fourth column if satisfied that the requirements have been met.

If the invention is a(n)	**Check here**	**The abstract should deal with:**	**If so, check here**
Article		its identity, use; construction, organization, method of manufacture	
Chemical compound		its identity (structure if appropriate); method of preparation, properties, uses	
Mixture		its nature, properties, use; essential ingredients (identity, function); proportion of ingredients, if significant; preparation	
Machine, apparatus, system		its nature, use; construction, organization; operation	
Process or operation		its nature and characterizing features; material and conditions employed; product, if significant; nature of and relationship between the steps, if more than one	
If the disclosure involves alternatives		the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative	

Total number of words less than 250: ..... in range 50-150: …….....

Ref: Standards – ST.12/A, April 1994

Original: Handbook on Industrial Property Information and Documentation, Publication N° 208(E), 1998, WIPO, Geneva (CH).

Annex 2
Units recognised in international practice and complying with Rule 49(10) (see F-II, 4.13)*

1. SI units and their decimal multiples and submultiples

1.1 SI base units

Quantity	Unit	
	Name	Symbol
Length	metre	m
Mass	kilogram	kg
Time	second	s
Electric current	ampere	A
Thermodynamic temperature	kelvin	K
Amount of substance	mole	mol
Luminous intensity	candela	cd

Definitions of SI base units:

– Unit of time
The second, symbol s, is the SI unit of time. It is defined by taking the fixed numerical value of the caesium frequency Δv_{Cs}, the unperturbed ground-state hyperfine transition frequency of the caesium 133 atom, to be 9 192 631 770 when expressed in the unit Hz, which is equal to s^{-1}.

– Unit of length
The metre, symbol m, is the SI unit of length. It is defined by taking the fixed numerical value of the speed of light in vacuum c to be 299 792 458 when expressed in the unit m/s, where the second is defined in terms of Δv_{Cs}.

– Unit of mass
The kilogram, symbol kg, is the SI unit of mass. It is defined by taking the fixed numerical value of the Planck constant h to be $6.626\,070\,15 \times 10^{-34}$ when expressed in the unit J s, which is equal to kg m^2 s^{-1}, where the metre and the second are defined in terms of c and Δv_{Cs}.

– Unit of electric current
The ampere, symbol A, is the SI unit of electric current. It is defined by taking the fixed numerical value of the elementary charge e to be $1.602\,176\,634 \times 10^{-19}$ when expressed in the unit C, which is equal to A s, where the second is defined in terms of Δv_{Cs}.

– Unit of thermodynamic temperature
The kelvin, symbol K, is the SI unit of thermodynamic temperature. It is defined by taking the fixed numerical value of the Boltzmann constant k to be $1.380\,649 \times 10^{-23}$ when expressed in the unit J K^{-1}, which is equal to kg

* Mainly based on Chapter I of the Annex to EEC Directive 80/181/EEC of 20.12.1979, as amended by EEC Directives 85/1/EEC of 18.12.1984, 89/617/EEC of 27.11.1989, 1999/103/EC of 24.01.2000, 2009/3/EC of 11.03.2009 and Commission Directive (EU) 2019/1258 of 23.07.2019.

$m^2\ s^{-2}\ K^{-1}$, where the kilogram, metre and second are defined in terms of h, c and Δv_{Cs}.

– Unit of amount of substance
The mole, symbol mol, is the SI unit of amount of substance. One mole contains exactly $6.022\ 140\ 76 \times 10^{23}$ elementary entities. This number is the fixed numerical value of the Avogadro constant, N_A, when expressed in the unit mol^{-1} and is called the Avogadro number.

The amount of substance, symbol n, of a system is a measure of the number of specified elementary entities. An elementary entity may be an atom, a molecule, an ion, an electron, any other particle or specified group of particles.

– Unit of luminous intensity
The candela, symbol cd, is the SI unit of luminous intensity in a given direction. It is defined by taking the fixed numerical value of the luminous efficacy of monochromatic radiation of frequency 540×10^{12} Hz, K_{cd}, to be 683 when expressed in the unit $lm\ W^{-1}$, which is equal to $cd\ sr\ W^{-1}$, or $cd\ sr\ kg^{-1}\ m^{-2}\ s^3$, where the kilogram, metre and second are defined in terms of h, c and Δv_{Cs}.

1.1.1 Special name and symbol of the SI derived unit of temperature for expressing Celsius temperature

Quantity	Unit	
	Name	Symbol
Celsius temperature	degree Celsius	°C

Celsius temperature t is defined as the difference $t = T\text{-}T_0$ between the two thermodynamic temperatures T and T_0 where $T_0 = 273.15$ K. An interval of or difference in temperature may be expressed either in kelvins or in degrees Celsius. The unit of "degree Celsius" is equal to the unit "kelvin".

1.2 SI derived units

1.2.1 General rule for SI derived units
Units derived coherently from SI base units are given as algebraic expressions in the form of products of powers of the SI base units with a numerical factor equal to 1.

1.2.2 SI derived units with special names and symbols

Quantity	Unit		Expression	
	Name	Symbol	In other SI units	In terms of SI base units
Plane angle	radian	rad		$m.m^{-1}$
Solid angle	steradian	sr		$m^2.m^{-2}$
Frequency	hertz	Hz		s^{-1}
Force	newton	N		$m.kg.s^{-2}$
Pressure, stress	pascal	Pa	$N.m^{-2}$	$m^{-1}.kg.s^{-2}$
Energy, work; quantity of heat	joule	J	N.m	$m^2.kg.s^{-2}$

Quantity	Unit		Expression	
	Name	Symbol	In other SI units	In terms of SI base units
Power(1), radiant flux	watt	W	$J.s^{-1}$	$m^2.kg.s^{-3}$
Quantity of electricity, electric charge	coulomb	C		s.A
Electric potential, potential difference, electromotive force	volt	V	$W.A^{-1}$	$m^2.kg.s^{-3}.A^{-1}$
Electric resistance	ohm	Ω	$V.A^{-1}$	$m^2.kg.s^{-3}.A^{-2}$
Conductance	siemens	S	$A.V^{-1}$	$m^{-2}.kg^{-1}.s^3.A^2$
Capacitance	farad	F	$C.V^{-1}$	$m^{-2}.kg^{-1}.s^4.A^2$
Magnetic flux	weber	Wb	V.s	$m^2.kg.s^{-2}.A^{-1}$
Magnetic flux density	tesla	T	$Wb.m^{-2}$	$kg.s^{-2}.A^{-1}$
Inductance	henry	H	$Wb.A^{-1}$	$m^2.kg.s^{-2}.A^{-2}$
Luminous flux	lumen	lm	cd.sr	cd
Illuminance	lux	lx	$lm.m^{-2}$	$m^{-2}.cd$
Activity (of a radionuclide)	becquerel	Bq		s^{-1}
Absorbed dose, specific energy imparted, kerma, absorbed dose index	gray	Gy	$J.kg^{-1}$	$m^2.s^{-2}$
Dose equivalent	sievert	Sv	$J.kg^{-1}$	$m^2.s^{-2}$
Catalytic activity	katal	kat		$mol.s^{-1}$

(1) Special names for the unit of power: the name volt-ampere (symbol "VA") is used to express the apparent power of alternating electric current, and var (symbol "var") is used to express reactive electric power.

Units derived from SI base units may be expressed in terms of the units listed in this annex.

In particular, derived SI units may be expressed by the special names and symbols given in the above table. For example, the SI unit of dynamic viscosity may be expressed as $m^{-1}.kg.s^{-1}$ or $N.s.m^{-2}$ or Pa.s.

1.3 Prefixes and their symbols used to designate certain decimal multiples and submultiples

Factor	Prefix	Symbol	Factor	Prefix	Symbol
10^{24}	yotta	Y	10^{-1}	deci	d
10^{21}	zetta	Z	10^{-2}	centi	c
10^{18}	exa	E	10^{-3}	milli	m
10^{15}	peta	P	10^{-6}	micro	μ
10^{12}	tera	T	10^{-9}	nano	n
10^{9}	giga	G	10^{-12}	pico	p
10^{6}	mega	M	10^{-15}	femto	f
10^{3}	kilo	k	10^{-18}	atto	a
10^{2}	hecto	h	10^{-21}	zepto	z
10^{1}	deca	da	10^{-24}	yocto	y

The names and symbols of the decimal multiples and submultiples of the unit of mass are formed by attaching prefixes to the word "gram" and their symbols to the symbol "g".

Where a derived unit is expressed as a fraction, its decimal multiples and submultiples may be designated by attaching a prefix to units in the numerator or the denominator, or in both these parts.

Compound prefixes, that is to say prefixes formed by the juxtaposition of several of the above prefixes, may not be used.

1.4 Special authorised names and symbols of decimal multiples and submultiples of SI units

Quantity	Unit		
	Name	Symbol	Value
Volume	litre	l or L(1)	1 l = 1 dm^3 = 10^{-3} m^3
Mass	tonne	t	1 t = 1 Mg = 10^3 kg
Pressure, stress	bar	bar	1 bar = 10^5 Pa
Length	Ångström	Å	1 Å = 10^{-10} m

(1) The two symbols "l" and "L" may be used for the litre unit.

The prefixes and their symbols listed in F-II, Annex 2, 1.3 may be used in conjunction with the units and symbols contained in this table.

2. Units which are defined on the basis of SI units but are not decimal multiples or submultiples thereof

Quantity	Unit		
	Name	Symbol	Value
Plane angle	revolution(a)		1 revolution = 2 π rad
	grade or gon	gon	1 gon = π / 200 rad
	degree	°	1° = π / 180 rad
	minute of angle	'	1' = π / 10 800 rad
	second of angle	"	1" = π / 648 000 rad
Time	Minute	min	1 min = 60 s
	Hour	h	1 h = 3 600 s
	Day	d	1 d = 86 400 s

(a) No international symbol exists

The prefixes listed in F-II, Annex 2, 1.3 may only be used in conjunction with the names "grade" or "gon" and the symbols only with the symbol "gon".

3. Units used with the SI, and whose values in SI are obtained experimentally

The unified atomic mass unit is 1/12 of the mass of an atom of the nuclide ^{12}C.

The electronvolt is the kinetic energy acquired by an electron passing through a potential difference of 1 volt in a vacuum.

Quantity	Unit		
	Name	Symbol	Value
Mass	unified atomic mass unit	u	1 u ≈ 1,6605655 x 10^{-27} kg
Energy	Electronvolt	eV	1eV ≈ 1,6021892 x 10^{-19} J

The value of these units, expressed in SI units, is not known exactly.

The prefixes and their symbols listed in F-II, Annex 2, 1.3 may be used in conjunction with these two units and with their symbols.

4. Units and names of units permitted in specialised fields only

Quantity	Unit		
	Name	Symbol	Value
Vergency of optical systems	dioptre		1 dioptre = 1 m^{-1}
Mass of precious stones	metric carat		1 metric carat = 2 x 10^{-4} kg
Area of farmland and building land	are	a	1 a = 10^2 m^2
Mass per unit length of textile yarns and threads	tex	tex	1 tex = 10^{-6} $kg.m^{-1}$
Blood pressure and pressure of other body fluids	millimetre of mercury	mm Hg	1 mm Hg = 133.322 Pa
Pressure in the fields of plasma physics and semiconductors	millimetre of mercury	mm Hg	1 mm Hg = 133.322387 Pa
	Torr	Torr	1 Torr = 133.322368 Pa
Effective cross-sectional area	Barn	b	1b = 10^{-28} m^2

The prefixes and their symbols listed in F-II, Annex 2, 1.3 may be used in conjunction with the above units and symbols, with the exception of the millimetre of mercury and its symbol. The multiple of 10^2 a is, however, called a "hectare".

5. Compound units

Combinations of the units listed in this annex form compound units.

Chapter III – Sufficiency of disclosure

1. Sufficiency of disclosure

A detailed description of at least one way of carrying out the invention must be given. Since the application is addressed to the person skilled in the art, it is neither necessary nor desirable that details of well-known ancillary features are given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it apparent to the skilled person how to put the invention into practice. A single example may suffice, but where the claims cover a broad field, the application is not usually regarded as satisfying the requirements of Art. 83 unless the description gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts and evidence of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example (see also F-IV, 6.3). In these latter cases the application must contain, in addition to the examples, sufficient information to allow the person skilled in the art, using common general knowledge, to perform the invention over the whole area claimed without undue burden and without needing inventive skill (see T 727/95). In this context, the "whole area claimed" is to be understood as substantially any embodiment falling within the ambit of a claim, even though a limited amount of trial and error may be permissible, e.g. in an unexplored field or when there are many technical difficulties (see T 226/85 and T 409/91).

Rule 42(1)(e)
Art. 83

However when assessing sufficiency of disclosure, the intrinsic limitations that a sensible reading imposes on the subject-matter of the independent claims must be taken into consideration; in other words the person skilled in the art wishing to implement the claimed invention will exclude any embodiment that is meaningless and not consistent with the teaching of the application (see T 521/12).

With regard to Art. 83, an objection of lack of sufficient disclosure presupposes that there are serious doubts, substantiated by verifiable facts (see T 409/91 and T 694/92). If the examining division is able, under the particular circumstances, to make out a reasoned case that the application lacks sufficient disclosure, the onus of establishing that the invention may be performed and repeated over substantially the whole of the claimed range lies with the applicant (see F-III, 4).

For the requirements of Art. 83 and of Rule 42(1)(c) and Rule 42(1)(e) to be fully satisfied, it is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed, in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.

Art. 83
Rule 42(1)(c) and (e)

In cases where it is found that an application is sufficiently disclosed according to Art. 83 only in respect of a part of the claimed subject-matter, this may have led to the issuing of a partial European or supplementary

Rule 63

European search report according to Rule 63 (see B-VIII, 3.1 and B-VIII, 3.2). In such cases, in the absence of appropriate amendment, an objection under Rule 63(3) will also arise (see H-II, 5 and H-II, 6.1).

2. Art. 83 vs. Art. 123(2)

Art. 83
Art. 123(2)

It is the responsibility of the applicants to ensure that they supply on filing their application, a sufficient disclosure, i.e. one that meets the requirements of Art. 83 in respect of the invention as claimed in all of the claims. If the claims define the invention, or a feature thereof, in terms of parameters, the application as filed must include a clear description of the methods used to determine the parameter values, unless a person skilled in the art would know what method to use or unless all methods would yield the same result (see F-IV, 4.11). If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against Art. 123(2), which requires that amendments may not result in the introduction of subject-matter which extends beyond the content of the application as filed (see H-IV, 2.1; see also H-V, 2.2). Therefore, in such circumstances, the application must normally be refused. If, however, the deficiency arises only in respect of some embodiments of the invention and not others, it could be remedied by restricting the claims to correspond to the sufficiently described embodiments only, the description of the remaining embodiments being deleted.

3. Insufficient disclosure

Art. 83

Occasionally applications are filed in which there is a fundamental insufficiency in the invention in the sense that it cannot be carried out by a person skilled in the art; there is then a failure to satisfy the requirements of Art. 83 which is essentially irreparable. Two instances deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, the skilled person, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are unrepeatable or that success in obtaining these results is achieved in a totally unreliable way. Sufficiency of disclosure cannot be acknowledged if the skilled person has to carry out a research programme based on trial and error to reproduce the results of the invention, with limited chances of success (T 38/11, Reasons 2.6). An example where this may arise is a microbiological process involving mutations. Such a case is to be distinguished from one where repeated success is assured even though accompanied by a proportion of failures, as can arise e.g. in the manufacture of small magnetic cores or electronic components. In this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection arises under Art. 83. The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws – this applies e.g. to a perpetual motion machine. If the claims for such a machine are directed to its function, and not merely to its structure, an objection arises not only under Art. 83 but also under Art. 52(1) in that the invention is not "susceptible of industrial application" (see G-III, 1).

4. Burden of proof as regards the possibility of performing and repeating the invention

Although the burden of proof in the framework of sufficiency of disclosure as a rule lies with the party raising the objection, this principle does not apply to cases where the application as filed does not provide a single example or other technical information from which it is plausible that the claimed invention can be carried out (see e.g. T 1329/11).

Furthermore, if there are serious doubts as regards the possibility of performing the invention and repeating it as described, the burden of proof as regards this possibility, or at least a demonstration that success is credible, rests with the applicant or the proprietor of the patent. In opposition, this may be the case where, for example, experiments carried out by the opponent suggest that the subject-matter of the patent does not achieve the desired technical result. As regards the possibility of performing and repeating the invention, see also F-III, 3.

5. Cases of partially insufficient disclosure

5.1 Only variants of the invention are incapable of being performed

The fact that only variants of the invention, e.g. one of a number of embodiments of it, are not capable of being performed does not immediately give rise to the conclusion that the subject-matter of the invention as a whole is incapable of being performed, i.e. is incapable of resolving the problem involved and therefore of achieving the desired technical result.

Those parts of the description relating to the variants of the invention which are incapable of being performed and the relevant claims must, however, then be deleted or marked background information that is not part of the invention (see F-IV, 4.3(iii)) at the request of the division if the deficiency is not remedied. The specification must then be so worded that the remaining claims are supported by the description and do not relate to embodiments which have proved to be incapable of being performed.

In some particular cases (for example claims relating to a combination of ranges or Markush claims), the scope of the claim might encompass a large number of alternatives, some of which correspond to non-working embodiments. In such cases, the presence of non-working embodiments in the claim is of no harm, provided that the specification contains sufficient information on the relevant criteria to identify the working embodiments within the claimed alternatives (G 1/03). See also G-VII, 5.2.

5.2 Absence of well-known details

For the purposes of sufficient disclosure the specification does not need to describe all the details of the operations to be carried out by the person skilled in the art on the basis of the instructions given, if these details are well-known and clear from the definition of the class of the claims or on the basis of common general knowledge (see also F-III, 1 and F-IV, 4.5).

5.3 Difficulties in performing the invention

An invention is not immediately regarded as incapable of being performed on account of a reasonable degree of difficulty experienced in its performance ("teething troubles", for example).

1st example: The difficulties which could, for example, arise from the fact that an artificial hip joint could be fitted to the human body only by a surgeon of great experience and above-average ability would not prevent manufacturers of orthopaedic devices from deriving complete information from the description with the result that they could reproduce the invention with a view to making an artificial hip joint.

2nd example: A switchable semiconductor which, according to the invention, is used for switching electrical circuits on and off without using contacts, thereby making for smoother operation, suffers from teething troubles in that a residual current continues to flow in the circuit when switched off. However, this residual current adversely affects the use of the electrical switch in certain fields only, and can otherwise be reduced to negligible proportions by routine further development of the semiconductor.

6. Inventions relating to biological material

6.1 Biological material

Rule 26(3)
Rule 31(1)

Applications relating to biological material are subject to the special provisions set out in Rule 31. In accordance with Rule 26(3), the term "biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system. If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the disclosure is not considered to have satisfied the requirements of Art. 83 unless the requirements of Rule 31(1), (2), first and second sentences, and 33(1), first sentence, have been met.

Rule 26(1)

For inventions based on biological material of plant or animal origin or using such material, it is recommended that the application, where appropriate, includes information on the **geographical origin** of such material, if known. However, this is without prejudice to the examination of European patent applications and European patents (EU Dir 98/44/EC, rec. 27).

6.2 Public availability of biological material

The division must form an opinion as to whether or not the biological material is available to the public. There are several possibilities. The biological material may be known to be readily available to those skilled in the art, e.g. baker's yeast or Bacillus natto, which is commercially available, it may be a standard preserved strain, or other biological material which the division knows to have been preserved in a recognised depositary institution and to be available to the public without restriction (see Notice from the European Patent Office dated 7 July 2010, OJ EPO 2010, 498). Alternatively, the applicant may have given in the description sufficient information as to the identifying characteristics of the biological material

and as to the prior availability to the public without restriction in a depositary institution recognised for the purposes of Rule 33(6) to satisfy the division (see Notice from the European Patent Office dated 7 July 2010, OJ EPO 2010, 498). In any of these cases no further action is called for. If, however, the applicant has given no or insufficient information on public availability and the biological material is a particular strain not falling within the known categories such as those already mentioned, then the division must assume that the biological material is not available to the public. It must also examine whether the biological material could be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art (see, in particular, F-III, 3 and G-II, 5.5).

6.3 Deposit of biological material

If the biological material is not available to the public and if it cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the division must check:

(i) whether the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material. The relevant information under this provision concerns the classification of the biological material and significant differences from known biological material. For this purpose, the applicant must, to the extent available, indicate morphological and biochemical characteristics and the proposed taxonomic description.

Rule 31(1) and (2)

The information on the biological material in question which is generally known to the skilled person on the date of filing is as a rule presumed to be available to the applicant, who must therefore provide it. If necessary, it has to be provided through experiments in accordance with the relevant standard literature.

For characterising bacteria, for example, the relevant standard work would be R.E. Buchanan, N.E. Gibbons: Bergey's Manual of Determinative Bacteriology.

Against this background, information needs to then be given on every further specific morphological or physiological characteristic relevant for recognition and propagation of the biological material, e.g. suitable media (composition of ingredients), in particular where the latter are modified.

Abbreviations for biological material or media are often less well known than the applicant assumes and are therefore to be avoided or written in full at least once.

If biological material is deposited that cannot replicate itself but must be replicated in a biological system (e.g. viruses, bacteriophages, plasmids, vectors or free DNA or RNA), the above-mentioned information is also required for such biological system. If, for example, other biological material is required, such as host cells or helper viruses, that cannot be sufficiently described or is not

available to the public, this material must also be deposited and characterised accordingly. In addition, the process for producing the biological material within this biological system must be indicated.

In many cases the above required information will already have been given to the depositary institution (see Rule 6.1(a)(iii) and 6.1(b) Budapest Treaty) and need only be incorporated into the application;

(ii) whether the name of the depositary institution and the accession number of the deposit were supplied at the date of filing. If the name of the depositary institution and the accession number of the deposit were submitted later, it is checked whether they were filed within the relevant period under Rule 31(2). If that is the case, it is then further checked whether on the filing date any reference was supplied which enables the deposit to be related to the later filed accession number. Normally the identification reference which the depositor gave to the deposit is used in the application documents. The relevant document for later filing the data pursuant to Rule 31(1)(c) could be a letter containing the name of the depositary institution, the accession number and the above-mentioned identification reference or, alternatively, the deposit receipt, which contains all these data (see also G 2/93 and A-IV, 4.2); and

(iii) whether the deposit was made by a person other than the applicant and, if so, whether the name and the address of the depositor are stated in the application or were supplied within the relevant period under Rule 31(2). In such a case, the division must also check whether the document fulfilling the requirements mentioned in Rule 31(1)(d) was submitted to the EPO within the same time limit (see A-IV, 4.1 for details of when this document referred to in Rule 31(1)(d) is required).

The division, in addition to the checks referred to under (i) to (iii) above, asks for the deposit receipt issued by the depositary institution (see Rule 7.1 Budapest Treaty) or for equivalent proof of the deposit of a biological material if such proof has not been filed before (see (ii) above and A-IV, 4.2). This is to provide evidence for the indications made by the applicant pursuant to Rule 31(1)(c).

If this deposit receipt has already been filed within the relevant time period according to Rule 31(2), this document on its own is regarded as submission of the information according to Rule 31(1)(c).

Rule 33(6)

In addition, the depositary institution named must be one of the recognised institutions listed in the Official Journal of the EPO. An up-to-date list is regularly published in the Official Journal.

Where a deposit was originally not made under the Budapest Treaty, it must be converted to a deposit made within the purview of the Budapest Treaty no later than the date of filing of the European patent application in order to fulfil the requirement of Rule 31(1)(a).

If any of these requirements is not satisfied, the biological material in question cannot be considered as having been disclosed pursuant to Art. 83 by way of reference to the deposit.

Rule 31
Rule 40(1)(c)
Rule 56(2) and (3)

Moreover, there are two situations in which the applicant can file information concerning the deposit which is required under Rule 31(1)(c), and where applicable also under Rule 31(1)(d), in a document filed after the accorded filing date and within the relevant time limit for filing that document, but after the expiry of one of the time limits under Rule 31(2)(a) to Rule 31(2)(c). As in the preceding paragraph, the consequence of the information being filed after the relevant time limit under Rule 31(2) is that the biological material is deemed not to have been disclosed pursuant to Art. 83 by way of reference to the deposit. These situations are those in which the information concerning the deposit is contained in either:

(a) a previously filed application to which reference is made under Rule 40(1)(c), the copy of that application being filed within either the two-month period under Rule 40(3) or that under Rule 55; or

(b) missing parts of the description filed later, within the two-month period under Rule 56(2), when the requirements of Rule 56(3) are satisfied, so that the application is not re-dated.

6.4 Priority claim

An application may claim the priority of a previous application with regard to unavailable biological material mentioned in F-III, 6.1. In this case, the invention is considered disclosed in the previous application for the purpose of the priority claim under Art. 87(1) only if the deposit of the biological material was made no later than the date of filing of the previous application and in accordance with the requirements of the country in which it was filed. Also, the reference to the deposit in the previous application must be made in a manner enabling it to be identified. Where the deposit of the biological material referred to in the European patent application is not the same as the deposit referred to in the priority, it is up to the applicant, if the EPO considers it necessary, to provide evidence that the biological material is identical (see also the Notice from the EPO dated 7 July 2010, OJ EPO 2010, 498).

6.5 Euro-PCT cases

International applications relating to the aforementioned unavailable biological material and designating or electing the EPO must comply with Rule 13*bis* PCT in conjunction with Rule 31. That means that for sufficient disclosure of the material the deposit with a recognised depositary institution must be made not later than the international filing date, relevant information must be given in the application and the necessary indications must be furnished as required during the international phase (see also the Notice from the EPO dated 7 July 2010, OJ EPO 2010, 498).

7. Proper names, trade marks and trade names

The use of proper names, trade marks or trade names or similar words to refer to materials or articles is undesirable in so far as such words merely

denote origin or where they may relate to a range of different products. If such a word is used, then, where it is necessary in order to satisfy the requirements of Art. 83, the product must be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by the skilled person at the date of filing. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (e.g. "Bowden" cable, "Belleville" washer, "Panhard" rod, "caterpillar" belt) they may be allowed without further identification of the product to which they relate. For the assessment of the clarity of claims referring to a trade mark (Art. 84), see F-IV, 4.8.

8. Reference documents

References in European patent applications to other documents may relate either to the background art or to part of the disclosure of the invention.

Where the reference document relates to the background art, it may be in the application as originally filed or introduced at a later date (see F-II, 4.3 and 4.4 and H-IV, 2.2.6).

Where the reference document relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus), then the examining division first considers whether knowing what is in the reference document is in fact essential for carrying out the invention as meant by Art. 83.

If not essential, the usual expression "which is hereby incorporated by reference", or any expression of the same kind, needs to be deleted from the description.

Art. 65

If matter in the document referred to is essential to satisfy the requirements of Art. 83, the examining division requires the deletion of the above-mentioned expression and that, instead, the matter is expressly incorporated into the description, because the patent specification must, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document. Furthermore, documents are not part of the text to be translated pursuant to Art. 65 (T 276/99).

Such incorporation of essential matter or essential features is, however, subject to the restrictions set out in H-IV, 2.2.1. It may be that the search division has requested the applicant to furnish the document referred to, in order to be able to carry out a meaningful search (see B-IV, 1.3).

If, for the disclosure of the invention, a document is referred to in an application as originally filed, the relevant content of the reference document is to be considered as forming part of the content of the application for the purpose of citing the application under Art. 54(3) against later applications. For reference documents not available to the public before the filing date of the application this applies only if the conditions set out hereto in H-IV, 2.2.1 are fulfilled.

Because of this effect under Art. 54(3), it is very important that, where a reference is directed only to a particular part of the document referred to, that part needs to be clearly identified in the reference.

9. "Reach-through" claims

In certain technical areas (e.g. biotechnology, pharmacy) cases occur where:

(i) one of the following and its use in a screening method have been defined as the only contribution to the art

- a polypeptide
- a protein
- a receptor
- an enzyme, etc., or

(ii) a new mechanism of action of such molecule has been defined.

It may happen that such applications contain so-called "reach-through" claims, i.e. claims directed to a chemical compound (or the use of that compound) defined only in functional terms with regard to the technical effect it exerts on one of the above molecules.

Typical examples of such claims would be: "An agonist/antagonist to polypeptide X [optionally as identified by the screening method of claim A]."; "An agonist/antagonist to polypeptide X [optionally as identified by the screening method of claim A], for use in therapy."; "An agonist/antagonist to polypeptide X [optionally as identified by the screening method of claim A], for use in the treatment of disease Y.", where the description indicates that polypeptide X is involved in disease Y.

According to Art. 83 and Rule 42(1)(c), the claim must contain sufficient technical disclosure of the solution to the problem. A functional definition of a chemical compound ("reach-through" claim) covers all compounds possessing the activity or effect specified in the claim. It would be an undue burden to isolate and characterise all potential compounds (e.g. agonists/antagonists), without any effective pointer to their identity (see F-III, 1), or to test every known compound and every conceivable future compound for this activity to see if it falls within the scope of the claim. In effect, the applicant is attempting to patent what has not yet been invented, and the fact that the applicant can test for the effect used to define the compounds does not necessarily confer sufficiency on the claim; in fact it constitutes an invitation for the skilled person to perform a research programme (see T 435/91 (Reasons 2.2.1), followed by T 1063/06 (Headnote II)).

In general, claims directed to merely functionally defined chemical compounds that are to be found by means of a new kind of research tool (e.g. using a new screening method based on a newly discovered molecule

or a new mechanism of action) are directed to future inventions, for which patent protection under the EPC is not designed. In the case of such "reach-through" claims, it is both reasonable and imperative to limit the subject-matter of the claims to the actual contribution to the art (see T 1063/06 (Headnote I)).

10. Sufficiency of disclosure and Rule 56

Under Rule 56, missing parts may be withdrawn in order to maintain the original filing date, and these parts are then deemed to be no longer part of the application (see also A-II, 5.4.2 and 5.5, C-III, 1 and H-IV, 2.2.2).

In this case, the division must carefully evaluate whether the invention is still sufficiently disclosed without relying on the technical information contained in the withdrawn missing parts. If the division reaches the conclusion that the requirements of Art. 83 are not satisfied, a corresponding objection is raised. Ultimately, the application may be refused for lack of sufficient disclosure (see F-III, 3 to 5).

11. Sufficiency of disclosure and clarity

An ambiguity in the claims may lead to an insufficiency objection. However, ambiguity also relates to the scope of the claims, i.e. Art. 84 (see F-IV, 4). Normally, therefore, an ambiguity in a claim will lead to an objection under Art. 83 only if the whole scope of the claim is affected, in the sense that it is impossible to carry out at all the invention defined therein. Otherwise an objection under Art. 84 is appropriate (see T 608/07, T 1811/13).

In particular (see T 593/09), where a claim contains an ill-defined ("unclear", "ambiguous") parameter (see also F-IV, 4.11) and where, as a consequence, a person skilled in the art would not know whether they were working within or outside of the scope of the claim, this, by itself, is not a reason to deny sufficiency of disclosure as required by Art. 83. Nor is such a lack of clear definition necessarily a matter for objection under Art. 84 only. What is decisive for establishing insufficiency within the meaning of Art. 83 is whether the parameter, in the specific case, is so ill-defined that a person skilled in the art is not able, on the basis of the disclosure as a whole and using common general knowledge, to identify (without undue burden) the technical measures necessary to solve the problem underlying the application at issue, e.g. see T 61/14.

There is a delicate balance between Art. 83 and Art. 84, which has to be assessed on the merits of each individual case. Care has therefore to be taken in opposition that an insufficiency objection is not merely a hidden objection under Art. 84, especially in the case of ambiguities in the claims (T 608/07). On the other hand, even though lack of support/clarity is not a ground for opposition (see also F-IV, 6.4), a problem related to it may in fact be of concern under Art. 83.

12. Sufficiency of disclosure and inventive step

If the claimed invention lacks reproducibility, this may become relevant under the requirements of sufficiency of disclosure or inventive step. The technical effect achieved by the invention solves the problem which underlies the application. If an invention lacks reproducibility because its

desired technical effect as expressed in the claim is not achieved, this results in a lack of sufficient disclosure, which has to be objected to under Art. 83. Otherwise, i.e. if the effect is not expressed in the claim but is part of the problem to be solved, there is a problem of inventive step (see G 1/03, Reasons 2.5.2, T 1079/08, T 1319/10, T 5/06 and T 380/05).

See F-III, 3 for cases where successful performance of the invention is inherently impossible because it would be contrary to the well-established laws of physics.

Chapter IV – Claims (Art. 84 and formal requirements)

1. General

The application must contain "one or more claims". *Art. 78(1)(c)*

These must: *Art. 84*

(i) "define the matter for which protection is sought";

(ii) "be clear and concise"; and

(iii) "be supported by the description".

Since the extent of the protection conferred by a European patent or application is determined by the claims (interpreted with the help of the description and the drawings), clarity of the claims is of the utmost importance (see also F-IV, 4). *Art. 69(1)*

2. Form and content of claims

2.1 Technical features

The claims must be drafted in terms of the "technical features of the invention". This means that claims must not contain any statements relating, for example, to commercial advantages or other matters not related to "carrying out" the invention, but statements of purpose are allowed if they assist in defining the invention. *Rule 43(1)*

It is not necessary that every feature is expressed in terms of a structural limitation. Functional features may be included provided that a skilled person would have no difficulty in providing some means of performing this function without exercising inventive skill (see F-IV, 6.5). For the specific case of a functional definition of a pathological condition, see F-IV, 4.22.

Claims to the use of the invention, in the sense of the technical application thereof, are allowable.

2.2 Two-part form

Rule 43(1)(a) and (b) define the two-part form which a claim must have "wherever appropriate". *Rule 43(1)*

The first part or "preamble" needs to contain a statement indicating "the designation of the subject-matter of the invention", i.e. the general technical class of apparatus, process, etc. to which the invention relates, followed by a statement of "those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art". This requirement to state prior-art features in the first part of the claim is applicable only to independent claims and not to dependent claims (see F-IV, 3.4). It is clear from the wording of Rule 43 that it is necessary only to refer to those prior-art features which are relevant to the invention. For example, if the invention relates to a photographic camera

but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a camera such as the lens and view-finder.

The second part or "characterising portion" needs to state the features which the invention adds to the prior art, i.e. the technical features for which, in combination with the features stated in the first part, protection is sought.

If a single document in the state of the art according to Art. 54(2), e.g. cited in the search report, reveals that one or more features in the second part of the claim were already known in combination with all the features in the first part of the claim and in that combination have the same effect as they have in the full combination according to the invention, the division will require that such feature or features be transferred to the first part.

Where, however, a claim relates to a novel combination, and where the division of the features of the claim between the preamble and the characterising part could be made in more than one way without inaccuracy, applicants must not be pressed, unless there are very substantial reasons, to adopt a different division of the features from that which they have chosen, if their version is not incorrect. If the applicant insists on including more features in the preamble than can be derived from the closest available prior art, this is accepted.

If no other prior art is available, this first part of the claim could be used to raise an objection on the ground of lack of inventive step (see G-VII, 5.1, last paragraph).

2.3 Two-part form unsuitable

Subject to what is stated in F-IV, 2.3.2, final sentence, applicants are required to follow the above two-part formulation in their independent claim or claims, where, for example, it is clear that their invention resides in a distinct improvement in an old combination of parts or steps. However, as is indicated by Rule 43, this form need be used only in appropriate cases. The nature of the invention may be such that this form of claim is unsuitable, e.g. because it would give a distorted or misleading picture of the invention or the prior art. Examples of the kind of invention which may require a different presentation are:

(i) the combination of known integers of equal status, the inventive step lying solely in the combination;

(ii) the modification of, as distinct from addition to, a known chemical process e.g. by omitting one substance or substituting one substance for another; and

(iii) a complex system of functionally interrelated parts, the inventive step concerning changes in several of these or in their interrelationships.

In examples (i) and (ii), the Rule 43 form of claim may be artificial and inappropriate, whilst in example (iii) it might lead to an inordinately lengthy and involved claim. Another example in which the Rule 43 form of claim may be inappropriate is where the invention is a new chemical compound or group of compounds. It is likely also that other cases will arise in which the applicant is able to adduce convincing reasons for formulating the claim in a different form.

2.3.1 No two-part form

There is a special instance in which the Rule 43 form of claim is avoided. This is when the only relevant prior art is another European patent application falling within the terms of Art. 54(3). Such prior art must however be clearly acknowledged in the description (see F-II, 4.3, penultimate paragraph, and F-II, 4.4). *Art. 54(3)*

2.3.2 Two-part form "wherever appropriate"

When examining whether or not a claim is to be put in the form provided for in Rule 43(1), second sentence, it is important to assess whether this form is "appropriate". In this respect the purpose of the two-part form is to allow the skilled person to see clearly which features necessary for the definition of the claimed subject-matter are, in combination, part of the prior art. If this is sufficiently clear from the indication of prior art made in the description, to meet the requirement of Rule 42(1)(b), the two-part form is not insisted upon.

2.4 Formulae and tables

The claims, as well as the description, may contain chemical or mathematical formulae but not drawings. The claims may contain tables but "only if their subject-matter makes the use of tables desirable". In view of the use of the word "desirable" in this rule, the division does not object to the use of tables in claims where this form is convenient. *Rule 49(9)*

3. Kinds of claim

3.1 Categories

The EPC refers to different "categories" of claim ("products, process, apparatus or use"). For many inventions, claims in more than one category are needed for full protection. In fact, there are only two basic kinds of claim, viz. claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or compositions (e.g. chemical compound or a mixture of compounds) as well as any physical entity (e.g. object, article, apparatus, machine, or system of co-operating apparatus) which is produced by a person's technical skill. Examples are: "a steering mechanism incorporating an automatic feed-back circuit ..."; "a woven garment comprising ..."; "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations". The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things (see, however, G-II, 4.2 and G-II, 5.4). *Rule 43(2)*

Rule 43(2) in combination with Rule 44(1) should be construed as permitting the inclusion of any one of the following combinations of claims of different categories in the same application:

(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of said product and an independent claim for a use of said product; or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out said process; or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of said product and an independent claim for an apparatus or means specifically designed for carrying out said process.

Art. 82 However, while a single set of independent claims according to any one of the combinations (i), (ii) or (iii) above is always permissible, a plurality of such sets of independent claims in one European patent application can only be allowed if the specific circumstances defined in Rule 43(2)(a) to Rule 43(2)(c) apply and the requirements of Art. 82 and Art. 84 are met. The proliferation of independent claims arising out of a combined effect of this kind may therefore be allowed only by way of an exception.

Art. 64(2) If the subject-matter of a European patent is a process, the protection conferred by the patent extends to the products directly obtained by such a process.

3.2 Number of independent claims

Rule 43(2) According to Rule 43(2), as applicable to all European patent applications in respect of which a communication under Rule 51(4) EPC 1973 (corresponding to Rule 71(3) EPC 2000) was not issued by 2 January 2002, the number of independent claims is limited to one independent claim in each category.

Exceptions from this rule can only be admitted in the specific circumstances defined in sub-paragraphs (a), (b) or (c) of this rule, provided the requirement of Art. 82 with regard to unity is met (see F-V).

The following are examples of typical situations falling within the scope of the exceptions from the principle of one independent claim per category:

(i) Examples of a plurality of interrelated products (Rule 43(2)(a))

- plug and socket
- transmitter – receiver
- intermediate(s) and final chemical product

– gene – gene construct – host – protein – medicament

For the purpose of Rule 43(2)(a), the term "interrelated" is interpreted to mean "different objects that complement each other or work together". In addition, Rule 43(2)(a) can be interpreted as covering apparatus claims, since the term "products" is considered to include apparatuses. Likewise, it may include systems, sub-systems and sub-units of such systems, as long as these entities are interrelated. Interrelated methods claims may also fall under the exception of Rule 43(2)(a).

(ii) Examples of a plurality of different inventive uses of a product or apparatus (Rule 43(2)(b))

– claims directed to further medical uses when a first medical use is known (see G-II, 4.2)

– claims directed to the use of compound X for multiple purposes, e.g. for cosmetically fortifying hair and for promoting hair growth

(iii) Examples of alternative solutions to a particular problem (Rule 43(2)(c))

– a group of chemical compounds

– two or more processes for the manufacture of such compounds

(iv) Examples of allowable claim types

– Claims directed to multiple methods involving a novel and inventive polypeptide P, e.g. an enzyme that controls a specific step in the synthesis of a compound:

a method for manufacturing the polypeptide P,

a method for manufacturing the compound by using either the isolated polypeptide or host cells expressing said polypeptide,

a method for selecting a host cell based on whether or not it expresses the polypeptide of the invention.

– A data sending method for sending a data packet between a plurality of devices coupled to a bus;

a data receiving method for receiving a data packet between a plurality of devices coupled to a bus.

– Methods of operating a data-processing system comprising steps A, B, … – a data-processing apparatus/system comprising means for carrying out said method – a computer

program [product] adapted to perform said method – a computer-readable storage medium/data carrier comprising said program;

Note however that when several independent claims are directed to equivalent embodiments that are not sufficiently different (e.g. computer program adapted to perform said method, optionally carried on an electric carrier signal – computer program comprising software code adapted to perform method steps A, B …), the exceptions under Rule 43(2) usually do not apply.

For the purpose of Rule 43(2)(c), the term "alternative solutions" can be interpreted as "different or mutually exclusive possibilities". Moreover, if it is possible to cover alternative solutions by a single claim, the applicant should do so. For example, overlaps and similarities in the features of the independent claims of the same category are an indication that it would be appropriate to replace such claims with a single independent claim, e.g. by selecting a common wording for the essential features (see F-IV, 4.5).

3.3 Objection under Rule 43(2) or Rule 137(5)

Where an unjustified plurality of independent claims in the same category persists after the search (see B-VIII, 4.1 and B-VIII, 4.2) in the application under examination, an objection is raised under Rule 43(2). If no Rule 62a(1) invitation was sent at the search stage, the examining division can still raise an objection under Rule 43(2). If the application is a Euro-PCT application not subject to the preparation of a supplementary European search report (see B-II, 4.3.1), an objection under Rule 43(2) may also arise in examination.

Rule 43(2)

When an objection under Rule 43(2) arises, the applicant is invited to amend the claims appropriately. If the search was restricted in accordance with Rule 62a, and the examining division upholds the objection under Rule 43(2) despite possible counter-arguments provided by the applicant in response to the invitation under Rule 62a(1) (see B-VIII, 4.2.2) or to the search opinion under Rule 70a (see B-X, 8), the claims must be amended in such a way as to result in the removal of all subject-matter excluded from the search (Rule 62a(2)) and the description amended accordingly (see H-II, 5).

If in reply to the reasoned objection (raised or confirmed in a communication from the examining division) the additional independent claims are maintained and no convincing arguments are presented that one of the situations referred to in sub-paragraphs (a) to (c) of Rule 43(2) applies, the application may be refused under Art. 97(2).

If the application is amended to provide a set of claims complying with Rule 43(2), but containing one or more claims directed to subject-matter excluded from the search in accordance with Rule 62a(1), an objection under Rule 137(5) arises and such amendments may not be admitted (see also H-II, 6 and H-II, 6.1). However, before such a decision can be taken, it will be necessary to allow the applicant to comment according to Art. 113(1)

on the underlying issue of whether or not the claims in respect of which the invitation under Rule 62a(1) was sent did in fact comply with Rule 43(2).

The burden of proof concerning an objection under Rule 43(2) is initially shifted onto the applicant, i.e. it is up to the applicant to argue convincingly why additional independent claims can be maintained. For example, the mere statement that the number of claims is the minimum necessary to provide the overall scope of protection which the applicant seeks is not a convincing argument (see T 56/01, Reasons 5).

Where the application also lacks unity of invention, the division may raise an objection under either Rule 43(2) or Art. 82 or under both. The applicant cannot contest which of these objections has priority.

3.4 Independent and dependent claims

Rule 43(3) and (4)

All applications will contain one or more "independent" claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning "particular embodiments" of that invention. It is evident that any claim relating to a particular embodiment must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The term "particular embodiment" is construed broadly as meaning any more specific disclosure of the invention than that set out in the independent claim or claims.

Rule 43(4)

Any claim which includes all the features of any other claim is termed a "dependent claim". Such a claim must contain, if possible at the beginning, a reference to the other claim, all features of which it includes (see, however, F-IV, 3.8 for claims in different categories). Since a dependent claim does not by itself define all the characterising features of the subject-matter which it claims, expressions such as "characterised in that" or "characterised by" are not necessary in such a claim but are nevertheless permissible. A claim defining further particulars of an invention may include all the features of another dependent claim by referring back to that claim. Also, in some cases, a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.

It sometimes occurs that an independent claim refers explicitly to alternative solutions and that these alternatives are also claimed separately in dependent claims. Such claims may seem redundant, but may be important for applicants in some national procedures if they wish to restrict their claims.

Art. 84

The division objects to such claims only if they detract from the clarity of the claims as a whole.

A dependent claim referring explicitly to independent claims in two categories as alternatives cannot be objected to on this ground alone. For

example, if the invention relates to both a composition and a use of that composition, it is possible for a claim specifying further features of the composition to be made dependent on both the independent claim for the composition and the independent claim for its use.

Art. 84 Objections are, however, raised to this type of claim dependency if it leads to a lack of clarity.

3.5 Arrangement of claims

Rule 43(4) All dependent claims referring back to a single previous claim and those referring back to several previous claims must be grouped together to the extent and in the most appropriate way possible. The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The division objects if the arrangement of claims is such as to create obscurity in the definition of the subject-matter to be protected. In general, however, when the corresponding independent claim is allowable, the division does not concern itself unduly with the subject-matter of dependent claims, provided it is satisfied that they are truly dependent and thus in no way extend the scope of protection of the invention defined in the corresponding independent claim (see also F-IV, 3.8).

3.6 Subject-matter of a dependent claim

If the two-part form is used for the independent claim(s), dependent claims may relate to further details of features not only of the characterising portion but also of the preamble.

3.7 Alternatives in a claim

Art. 84 *Art. 82* A claim, whether independent or dependent, may refer to alternatives, provided that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe and provided that the claim meets the requirements of unity (see also F-V, 3.2.1 and 3.2). In the case of a claim defining (chemical or non-chemical) alternatives, i.e. a so-called "Markush grouping", unity of invention is considered to be present if the alternatives are of a similar nature and can fairly be substituted for one another (see F-V, 3.2.5).

3.8 Independent claims containing a reference to another claim or to features from a claim of another category

A claim containing a reference to another claim is not necessarily a dependent claim as defined in Rule 43(4). One example of this is a claim referring to a claim of a different category (e.g. "Apparatus for carrying out the process of claim 1 ...", or "Process for the manufacture of the product of claim 1 ..."). Similarly, in a situation like the plug and socket example of F-IV, 3.2(i), a claim to the one part referring to the other co-operating part (e.g. "plug for co-operation with the socket of claim 1 ...") is not a dependent claim. In all these examples, the division carefully considers the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not. Indeed, objections on the grounds of lack of clarity and failure to state the technical features (Rule 43(1)) apply to a claim which simply says "Apparatus for carrying out the process of claim 1". Since the change of category already

makes the claim independent, the applicant is required to set out clearly in the claim the essential features of the apparatus.

The same is true for a claim which says "Method for using an apparatus according to claim 1". The method claim, formulated as a use claim, lacks the steps that are carried out in order to use the apparatus (see F-IV, 4.16) and is therefore not clear.

For claims directed to computer-implemented inventions, in which independent claims often comprise references to other independent claims, see F-IV, 3.9.

The subject-matter of a claim in one category may also to some extent be defined in terms of features from another category; therefore an apparatus may be defined in terms of functions it is able to perform, provided the structure is made sufficiently clear; or a process may be defined in terms of essential structural features of the apparatus for carrying it out; or an element of an apparatus may be defined in terms of how it is made. However, in the wording of these claims and in the assessment of the claimed subject-matter, a clear distinction must be maintained between product claims (for a device, apparatus or system) and process claims (for a process, activity or use). For example, a claim for an apparatus cannot normally be limited only by the manner in which the apparatus is used; for this reason, a claim which simply reads "Apparatus Z, when used for carrying out process Y" is also objected to on the grounds of lack of clarity and failure to state the technical features (Rule 43(1)).

No separate examination for the novelty and inventive step of a process claim for producing a product is necessary, provided that:

– all features of the product as defined in the product claim inevitably (see also G-VII, 14) result from the claimed process (see F-IV, 4.5 and T 169/88), and

– the product claim is patentable.

This also applies in the case of a claim for the use of a product, when the product is patentable and is used with its features as claimed (see T 642/94). In all other instances, the patentability of the claim referred to does not necessarily imply the patentability of the independent claim containing the reference. If the process, product and/or use claims have different effective dates (see F-VI, 1 and 2), a separate examination may still be necessary in view of intermediate documents (see also G-VII, 14).

3.9 Claims directed to computer-implemented inventions

The expression "computer-implemented inventions" (CII) covers claims which involve computers, computer networks or other programmable apparatus, whereby at least one feature is realised by means of a program.

Claims directed to CII should define all the features which are essential for the technical effect of the process which the computer program is intended to carry out when it is run (see F-IV, 4.5.2, last sentence). An objection

under Art. 84 may arise if the claims contain program listings. Short excerpts from programs may be accepted in the description (see F-II, 4.12).

In the following three sections, a distinction is made between three situations. The practice defined in F-IV, 3.9.1 is confined to inventions in which all the method steps can be carried out by generic data processing means. F-IV, 3.9.2, on the other hand, relates to inventions in which at least one method step defines the use of specific data processing means or other technical devices. Inventions that are realised in a distributed computing environment are discussed in F-IV, 3.9.3.

3.9.1 Cases where all method steps can be fully implemented by generic data processing means

A common type of CII relates to subject-matter where all the method steps can fully be carried out by computer program instructions running on means which, in the context of the invention, provide generic data processing functions. Such means can, for example, be embedded in a personal computer, smartphone, printer etc. In such inventions, although different claim structures are possible, the set of claims usually starts with a method claim. Further claims in other categories with subject-matter corresponding to that of the method may be included to obtain complete protection of the invention. If the invention concerns software which can be loaded into memory, transmitted over a network or distributed on a data carrier, a claim to a computer program [product] may also be present in addition to a computer-implemented method. The category of a computer program [product] claim is distinguished from that of a corresponding computer-implemented method (T 424/03 and G 3/08). The following non-exhaustive list comprises examples of acceptable claim formulations (T 410/96, T 1173/97 and T 2140/08) in such a set of claims:

(i) Method claim (claim 1)

- A computer-implemented method comprising steps A, B, ...
- A method carried out by a computer comprising steps A, B, ...

(ii) Apparatus/device/system claim (claim 2)

- A data processing apparatus/device/system comprising means for carrying out [the steps of] the method of claim 1.
- A data processing apparatus/device/system comprising means for carrying out step A, means for carrying out step B, ...
- A data processing apparatus/device/system comprising a processor adapted to/configured to perform [the steps of] the method of claim 1.

(iii) Computer program [product] claim (claim 3)

– A computer program [product] comprising instructions which, when the program is executed by a computer, cause the computer to carry out [the steps of] the method of claim 1.

– A computer program [product] comprising instructions which, when the program is executed by a computer, cause the computer to carry out steps A, B, ...

(iv) Computer-readable [storage] medium/data carrier claim (claim 4)

– A computer-readable [storage] medium comprising instructions which, when executed by a computer, cause the computer to carry out [the steps of] the method of claim 1.

– A computer-readable [storage] medium comprising instructions which, when executed by a computer, cause the computer to carry out steps A, B, ...

– A computer-readable data carrier having stored thereon the computer program [product] of claim 3.

– A data carrier signal carrying the computer program [product] of claim 3.

In formulation (ii) above, apparatus features of the means-plus-function type ("means for ...") are interpreted as means adapted to carry out the respective steps/functions, rather than merely means suitable for carrying them out (T 410/96). There is no particular preference of wording among "comprising means for", "adapted to", "configured to" or equivalents. In this way, novelty is conferred over an unprogrammed data processing apparatus or a data processing apparatus programmed to perform a different function.

An objection under Rule 43(2) is not raised if the claim set comprises one claim from each of the above formulations (i)-(iv). In these cases, an invitation under Rule 62a(1) is therefore not sent at the search stage since the requirements of Rule 43(2) are fulfilled.

However, an objection under Rule 43(2) may be raised if more than one claim is present from a heading (i)-(iv), for example if there are two or more computer program [product] claims which cannot be considered as falling under one of the exceptions of Rule 43(2) (F-IV, 3.2).

When assessing the novelty and inventive step of a set of claims as defined above (formulations (i)-(iv)), the division usually starts with the method claim. If the subject-matter of the method claim is considered novel and inventive, the subject-matter of the other claims in a set formulated in accordance with the headings above will normally be novel and inventive as well, provided they comprise the features corresponding to all those which assure the patentability of the method.

Claims related to CII which are formulated differently to those in the formulations (i)-(iv) defined above are assessed on a case-by-case basis in view of the requirements of clarity, novelty and inventive step (see also F-IV, 3.9.2).

For example, when the invention is realised in a distributed computing environment or involves interrelated products, it may be necessary to refer to the specific features of the different entities and to define how they interact to ensure the presence of all essential features, rather than making a mere reference to another claim as in the above formulations (ii)-(iv). In such cases, further independent claims to interrelated products and their corresponding methods may also be allowable under Rule 43(2)(a) (F-IV, 3.2 and F-IV, 3.9.3).

Similarly, if user interaction is required, an objection under Art. 84 may arise if it is not possible to determine from the claim which steps are carried out by the user.

Furthermore, a claim to a computer-implemented data structure in addition to formulations (i)-(iv) may be allowable under Rule 43(2) if it is defined by its own technical features, e.g. by a well-defined structure as in T 858/02, possibly with references to the corresponding method or system in which it is used. However, a computer-implemented data structure does not necessarily comprise features of the process by which it is generated. It is not necessarily restricted by a method in which it is used, either. Therefore, a claim to a computer-implemented data structure usually cannot be defined merely by reference to a method or as an outcome of a process. For further information on data structures, see G-II, 3.6.3.

For the assessment of inventive step for claims comprising features related to exclusions under Art. 52(2), as is often the case with CII, see G-VII, 5.4.

3.9.2 Cases where method steps define additional devices and/or specific data processing means

Where a method claim includes steps defined as being carried out by devices other than generic data processing means, a corresponding device and/or computer program claim may need more than a mere reference to the method claim as in formulations (i)-(iv) in F-IV, 3.9.1 to fulfil the requirements of Art. 84 (see also F-IV, 3.8). Furthermore, if not all the features of the method claim are reflected in claims in other categories referring to the method, said claims in other categories have to be construed and examined separately with respect to novelty and inventive step.

In particular in applied fields such as medical devices, measuring, optics, electro-mechanics or industrial production processes, method claims frequently involve steps of manipulating or interacting with technical physical entities by using computer control. These method steps may not always be fully performed by the computer and the method claim may recite specific technical means for carrying out some of the steps. In such a case, defining a computer program claim as in F-IV, 3.9.1(iii) will normally lead to an objection under Art. 84 if the step carried out by the specific

technical means cannot be carried out by a generic data processing means (see Example 1 below). An objection under Art. 84 may also arise if the claims do not define which steps are carried out by the data processor or by the additional devices involved, as well as their interactions. The same applies if specific data processing means (e.g. a particular parallel computer architecture) are required as opposed to the generic data processing means described in F-IV, 3.9.1.

On the other hand, if the method claim defines the further processing, by generic computational means, of data received from specific technical means, such as sensors, it is not necessary that the computer or computer program claims referring to the method comprise those specific technical means. In this case the specific technical means recited in the method are not required for carrying out the method steps and formulations as in F-IV, 3.9.1 may be appropriate (see Example 2 below).

Finally, as is the case for any essential feature, if the specific technical means are essential for defining the invention, they have to be present in all the independent claims. Whether or not a feature is essential is decided according to the principles defined in F-IV, 4.5 and subsections, taking due account of implicit features (F-IV, 4.5.4).

Example 1

1. A method of determining oxygen saturation in blood in a pulse oximeter, comprising:

   – receiving in an electromagnetic detector first and second electromagnetic radiation signals from a blood-perfused tissue portion corresponding to two different wavelengths of light;

   – normalising said electromagnetic signals according to steps A, B and C to provide normalised electromagnetic signals;

   – determining oxygen saturation based on said normalised electromagnetic signals according to steps D and E.

2. A pulse oximeter having an electromagnetic detector and means adapted to execute the steps of the method of claim 1.

3. A computer program [product] comprising instructions to cause the device of claim 2 to execute the steps of the method of claim 1.

4. A computer-readable medium having stored thereon the computer program of claim 3.

Remarks: In this example, the method claim comprises a step which is defined as being executed by specific technical means (the electromagnetic detector in a pulse oximeter). A computer program claim making reference only to the method would lack clarity because such a program could not be executed e.g. on a general-purpose computer which does not have a pulse oximeter with an electromagnetic detector. Therefore, the computer

program claim should be defined as being executed on the pulse oximeter with an electromagnetic detector (by referring to the device of claim 2) rather than only referring to the method claim 1.

Example 2

1. A computer-implemented method of determining oxygen saturation in blood, comprising:

   – receiving data representing first and second electromagnetic radiation signals acquired by an electromagnetic detector from a blood-perfused tissue portion corresponding to two different wavelengths of light;

   – normalising the data representing said electromagnetic signals according to steps A, B and C to provide normalised data;

   – determining oxygen saturation based on said normalised data according to steps D and E.

2. A data processing apparatus comprising means for carrying out the method of claim 1.

3. A computer program [product] comprising instructions which, when the program is executed by a computer, cause the computer to carry out the method of claim 1.

4. A computer-readable medium having stored thereon the computer program [product] of claim 3.

Remarks: In this example the invention lies in the further processing of acquired data for determining the oxygen saturation in blood. The data can be received for example from a data file storing data previously acquired by the electromagnetic detector. Such a method can therefore be carried out by generic data processing means, for example in the form of a desktop computer. It does not specify the electromagnetic detector as a required feature for receiving the input data. Hence, the device claim defined by reference to the method claim does not need to include the pulse oximeter or an electromagnetic detector either. Furthermore, the computer program claim can be executed on a general-purpose computer and not on a specific device in contrast to the case in Example 1. As a result, the formulations as in F-IV, 3.9.1 are appropriate for claims 2-4 of Example 2.

3.9.3 Cases where the invention is realised in a distributed computing environment

Another common type of CII is realised in a distributed computing environment. Examples are a networked client (e.g. a smartphone) and server system, accessing storage or processing resources of a computer cloud, devices in a peer-to-peer network performing file sharing, an augmented reality environment with head mounted displays, autonomous vehicles interacting over an ad hoc network or maintaining a distributed ledger using a blockchain.

For such distributed CIIs, the claim set may comprise claims directed to each entity of the distributed system and/or to the overall system and the corresponding methods. Such a claim set may be allowable under Rule 43(2)(a) (F-IV, 3.2). Each independent claim must nevertheless fulfil the requirements for patentability, in particular the requirements of Art. 54, Art. 56 and Art. 84. For example, if the invention lies in the implementation of a computer cloud using virtual machines enabling adaptation to workload changes by allocating resources in an automatic manner, a client device accessing the resources of the cloud may already be known in the art. The claim set must also fulfil the requirements of unity.

It may be necessary to refer to the specific features of the different entities and to define how they interact to ensure the presence of all essential features. When referring to the interaction between the different entities, particular care must be taken that the claim is clear. In some situations, it may be necessary to limit the claim to the combination of the entities (see F-IV, 4.14). If the distribution of the steps of a method across the involved entities is essential to the invention, it will be necessary to define which method step is carried out by which entity in order to fulfil the requirements of Art. 84. Otherwise, this may be left undefined in generic CII claims (see F-IV, 3.9.1).

Some considerations relating to these requirements are illustrated with the help of the following examples. Other formulations (F-IV, 3.9.1) than the ones given in the examples can also be part of the claim set but have been omitted for reasons of brevity.

Example

1. A transmitter device comprising means for encoding data by performing steps A and B and means to transmit the encoded data to a receiver device.

2. A receiver device comprising means for receiving encoded data from a transmitter device and means for decoding the data by performing steps C and D.

3. A system comprising a transmitter device according to claim 1 and a receiver device according to claim 2.

4. A computer program [product] comprising instructions which, when the program is executed by a first computer, cause the first computer to encode data by performing steps A and B and to transmit the encoded data to a second computer.

5. A computer program [product] comprising instructions which, when the program is executed by a second computer, cause the second computer to receive encoded data from a first computer and decode the received data by performing steps C and D.

Remarks: The problem addressed by the invention is the transmission of data over a network. The transmitter device encodes the data using an

algorithm comprising steps A and B and the receiver device performs the complementary function of decoding the data using an algorithm comprising steps C and D. The requirements of Rule 43(2) are fulfilled since the devices of claims 1 and 2 are interrelated in that they interact to perform the invention and solve the stated problem. Novelty and inventive step have to be assessed for each independent claim individually. For example, if encoding according to steps A and B enables encoding to a known coding format in a more efficient way, and decoding according to steps C and D is conventional, it may be that only claims 1 and 3 are new and inventive.

4. Clarity and interpretation of claims

4.1 Clarity

Art. 84

The requirement that the claims must be clear applies to individual claims, i.e. to independent and dependent claims alike, and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore, the meaning of the terms of a claim must, as far as possible, be clear for the person skilled in the art from the wording of the claim alone (see also F-IV, 4.2). In view of the differences in the scope of protection which may be attached to the various categories of claims, the division must ensure that the wording of a claim leaves no doubt as to its category.

Where it is found that the claims lack clarity under Art. 84, this may have led to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments from the applicant as to why the invitation under Rule 63(1) was not justified, an objection under Rule 63(3) will also arise (see H-II, 5).

4.2 Interpretation

Each claim must be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. Moreover, if such a special meaning applies, the division will, so far as possible, require the claim to be amended whereby the meaning is clear from the wording of the claim alone. This is important because it is only the claims of the European patent, not the description, which will be published in all the official languages of the EPO. The claim must also be read with an attempt to make technical sense out of it. Such a reading may involve a departure from the strict literal meaning of the wording of the claims. Art. 69 and its Protocol do not provide a basis for excluding what is literally covered by the terms of the claims (see T 223/05).

4.3 Inconsistencies

Any inconsistency between the description and the claims must be avoided if it could throw doubt on the subject-matter for which protection is sought and therefore render the claim unclear or unsupported under Art. 84, second sentence, or, alternatively, render the claim objectionable under Art. 84, first sentence. Such inconsistency can be of the following kinds:

(i) Simple verbal inconsistency

For example, there is a statement in the description which suggests that the invention is limited to a particular feature but the claims are not thus limited; also, the description places no particular emphasis on this feature and there is no reason for believing that the feature is essential for the performance of the invention. In such a case, the inconsistency can be removed either by broadening the description or by limiting the claims. Similarly, if the claims are more limited than the description, the claims may be broadened or the description may be limited. See also paragraph (iii) below.

(ii) Inconsistency regarding apparently essential features

For example, it may appear, either from general technical knowledge or from what is stated or implied in the description, that a certain described technical feature not mentioned in an independent claim is essential to the performance of the invention, or, in other words, is necessary for the solution of the problem to which the invention relates. In such a case, the claim does not meet the requirements of Art. 84, because Art. 84, first sentence, when read in conjunction with Rule 43(1) and (3), has to be interpreted as meaning not only that an independent claim must be comprehensible from a technical point of view but also that it must clearly define the subject-matter of the invention, that is to say indicate all the essential features thereof (see T 32/82). If, in response to this objection, the applicants show convincingly, e.g. by means of additional documents or other evidence, that the feature is in fact not essential, they may be allowed to retain the unamended claim and, where necessary, to amend the description instead. The opposite situation in which an independent claim includes features which do not seem essential for the performance of the invention is not objectionable. This is a matter of the applicant's choice. The division therefore does not suggest that a claim be broadened by the omission of apparently inessential features;

(iii) Part of the description and/or drawings is inconsistent with the subject-matter for which protection is sought

According to Art. 84, second sentence, the claims must be supported by the description. This means that there must not be inconsistency between the claims and the description. Parts of the description that give the skilled person the impression that they disclose ways to carry out the invention but are not encompassed by the wording of the claims are inconsistent (or contradictory) with the claims. Such

inconsistencies may be present in the application as originally filed or may result from amending the claims to such an extent that they are no longer consistent with the description or drawings.

For example, an inconsistency may exist due to the presence of an alternative feature which has a broader or different meaning than a feature of the independent claim. Further, an inconsistency arises if the embodiment comprises a feature which is demonstrably incompatible with an independent claim.

However, it is not an inconsistency when an embodiment comprises further features which are not claimed as dependent claims as long as the combination of the features in the embodiment is encompassed by the subject-matter of an independent claim. Similarly, it is not an inconsistency when an embodiment fails to explicitly mention one or more features of an independent claim as long as they are present by reference to another embodiment or implicit.

For borderline cases where there is doubt as to whether an embodiment is consistent with the claims, the benefit of the doubt is given to the applicant.

The applicant must remove any inconsistencies by amending the description either by deleting the inconsistent embodiments or marking them as not falling within the subject-matter for which protection is sought. See paragraph (i) above for the case where an inconsistency can be removed by broadening the claims.

Example: Independent claim defines a vehicle with a broad feature of a "motor", together with other features. The description and the drawings comprise Embodiment 1, in which the vehicle has an electric motor, and Embodiment 2, in which the vehicle has a combustion engine. During the prosecution, in order to fulfil the requirements of inventive step, the independent claim is amended to specify a vehicle employing an electric motor since the combination of claimed features using a combustion engine was anticipated by the prior art. Embodiment 2 is no longer consistent with the independent claim, unless it can be inferred from this embodiment that the combustion engine is used in combination with the electric motor. This inconsistency can be rectified either by removing Embodiment 2 from the description and drawings or by marking Embodiment 2 as not being covered by the claimed subject-matter (e.g. "Embodiment 2 is not covered by the subject-matter of the claims" or similar wording).

An inconsistency between the description and the claims cannot be removed by introducing at the beginning of the description a **generic** statement such as "embodiments not falling under the scope of the appended claims are to be considered merely as examples suitable for understanding the invention" without indicating which parts of the description are no longer covered. To remove the inconsistency,

such a statement has to refer to **specific** embodiments (e.g. "Embodiments X and Y are not encompassed by the wording of the claims but are considered as useful for understanding the invention").

The terms "disclosure", "example", "aspect" or similar do not necessarily imply that what follows is not encompassed by an independent claim. Unambiguous expressions have to be adopted to mark an inconsistent embodiment (e.g. by adding "not encompassed by the wording of the claims", "not according to the claimed invention" or "outside the subject-matter of the claims") instead of replacing the terms "embodiment" or "invention" by one of the aforementioned terms.

Subject-matter in the description regarded as an exception to patentability under Art. 53(c) needs to be excised, reworded such that it does not fall under the exceptions to patentability or prominently marked as not being according to the claimed invention. For the latter case, the description may be amended by adding an indication as follows: "The references to the methods of treatment by therapy or surgery or *in vivo* diagnosis methods in examples X, Y and Z of this description are to be interpreted as references to compounds, pharmaceutical compositions and medicaments of the present invention for use in those methods".

Moreover, features required by the independent claims may not be described in the description as being optional using wording such as "preferably", "may" or "optionally". The description must be amended to remove such terms if they make a mandatory feature of an independent claim appear as being optional.

When inviting the applicant to amend the description, the division provides examples of embodiments inconsistent with the independent claims and brief reasons why. If the inconsistency concerns describing a mandatory feature of an independent claim as optional, the division provides an example passage.

See also H-V, 2 for the allowability of amendments to the description.

An inconsistency between the description/drawings and the claims may frequently occur when, after a limitation of the claims following an invitation under Rule 62a(1) or Rule 63(1), the subject-matter excluded from the search is still present in the description. Unless the initial objection was not justified, such subject-matter is objected to under Art. 84 (inconsistency between the claims and the description).

Furthermore, an inconsistency between the description/drawings and the claims will occur when, after a non-unity objection (Rule 64 or Rule 164), the claims have been limited to only one of the originally claimed inventions: the embodiments and/or examples of the non-claimed inventions must be either deleted or clearly indicated as not being covered by the claims.

4.4 General statements, "spirit of the invention", claim-like clauses

General statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined way are not allowed. In particular, any statement which refers to the extent of protection being expanded to cover the "spirit of the invention" or "all equivalents" of the claims must be deleted.

Statements that refer to the extent of protection covering the "scope of the claims" or the invention being "defined in the claims" are allowed. This does not preclude the removal of inconsistencies (F-IV, 4.3).

Analogously, in the case where the claims are directed to a combination of features, any statement that seems to imply that protection is nevertheless sought not only for the combination as a whole but also for individual features or sub-combinations thereof must be deleted.

Finally, claim-like clauses must also be deleted or amended to avoid claim-like language prior to grant since they otherwise may lead to unclarity on the subject-matter for which protection is sought.

"Claim-like" clauses are clauses present in the description which despite not being identified as a claim, appear as such and usually comprise an independent clause followed by a number of clauses referring to previous clauses. These claim-like clauses are usually found at the end of the description and/or in the form of numbered paragraphs, particularly in divisional or Euro-PCT applications, where the original set of claims from the parent or PCT application is appended to the description.

4.5 Essential features

4.5.1 Objections arising from missing essential features

Art. 84
Rule 43(1) and (3)

The claims, which define the matter for which protection is sought, must be clear, meaning not only that a claim must be comprehensible from a technical point of view, but also that it must define clearly all the essential features of the invention (see T 32/82). Furthermore, the requirement of Art. 84 that the claims be supported by the description applies to features which are explicitly presented in the description as being essential for carrying out the invention (see T 1055/92). A lack of essential features in the independent claim(s) is therefore to be dealt with under the clarity and support requirements.

4.5.2 Definition of essential features

Essential features of a claim are those necessary for achieving a technical effect underlying the solution of the technical problem with which the application is concerned (the problem usually being derived from the description). The independent claim(s) must therefore contain all features explicitly described in the description as being necessary to carry out the invention. Any features which, even if consistently mentioned in the context of the invention throughout the application, do not actually contribute to the solution of the problem are not essential features.

As a general rule, the technical effect or result produced by the feature will provide the key to answering the question of whether or not the feature contributes to solving the problem (see also G-VII, 5.2).

If a claim is to a process for producing the product of the invention, then the process as claimed must be one which, when carried out in a manner which would seem reasonable to a person skilled in the art, necessarily has as its end result that particular product; otherwise there is an internal inconsistency and therefore lack of clarity in the claim.

In particular, where patentability depends on a technical effect, the claims must be so drafted as to include all the technical features of the invention which are essential for the technical effect (see T 32/82).

Claims towards plants or animals which are not exclusively produced by an essentially biological process comprising a functionally defined phenotypic trait and which are worded as product-by-process claims (i.e. obtainable by crossing a plant with a plant grown from deposited seed having accession number XXX and selecting for a progeny plant comprising the phenotypic trait) must fulfil the clarity requirement of Art. 84, as must any other type of claim. In particular, the claimed subject-matter must be defined so that the public is left in no doubt about what the subject-matter for which protection is sought actually is. If the process through which the claimed plant or animal is defined does not impart identifiable and unambiguous technical features to the plant or animal, e.g. the genetic information present in the genome, the claim directed to a plant or animal lacks clarity.

4.5.3 Generalisation of essential features

In deciding how specific the essential features must be, the provisions of Art. 83 must be borne in mind: it is sufficient if the application as a whole describes the necessary characteristics of an invention in a degree of detail such that a person skilled in the art can perform the invention (see F-III, 3). It is not necessary to include all details of the invention in the independent claim. Thus a certain degree of generalisation of the claimed features may be permitted, provided that the claimed generalised features as a whole allow the problem to be solved. In this case a more specific definition of the features is not required. This principle applies equally to structural and functional features.

4.5.4 Implicit features

As detailed above, an independent claim must specify explicitly all of the essential features needed to define the invention. This applies except in so far as such features are implied by the generic terms used, e.g. a claim to a "bicycle" does not need to mention the presence of wheels.

In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in certain respects, it is sufficient that the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for an apparatus.

4.5.5 Examples

Examples illustrating essential features can be found in the Annex to F-IV.

4.6 Relative terms

4.6.1 Clarity objections

Relative or similar terms such as "thin", "wide" or "strong" constitute a potentially unclear element due to the fact that their meaning may change depending on the context. For these terms to be allowed, their meaning must be clear in the context of the whole disclosure of the application or patent.

However, if a relative or similar term is used by the applicant as the only feature to distinguish the subject-matter of a claim from the prior art, the use of this term is objected to under Art. 84 unless the term has a well-recognised meaning in the particular art, e.g. "high-frequency" in relation to an amplifier, and this is the meaning intended.

Where the relative term has no well-recognised meaning the division invites the applicant to replace it, if possible, by a more precise wording found elsewhere in the disclosure as originally filed. Where there is no basis in the disclosure for a clear definition and the term is no longer the only distinguishing feature, it may be retained in the claim, because excising it would generally lead to an extension of the subject-matter beyond the content of the application as filed - in contravention of Art. 123(2).

4.6.2 Interpretation of relative terms

When the use of a relative term is allowed in a claim, this term is interpreted by the division in the least restrictive possible way when determining the extension of the subject-matter of the claim. As a consequence, in many cases, a relative term is not limiting the extension of the subject-matter of a claim.

For example, the expression "a thin metal plate" does not limit the feature "metal plate" against the prior art: a metal plate is "thin" only when compared to another one, but it does not define an objective and measurable thickness. So a metal plate three millimetres thick is thin when compared to a plate five millimetres thick, but thick when compared to a plate one millimetre thick.

As another example, when considering "an element mounted near the end of a truck", is this element mounted 1 mm from the end of the truck, 10 cm or 2 m? The only limitation of such an expression is that the element must be nearer to the end of the truck than to its middle, i.e. the element can be mounted anywhere in the quarter of the truck next to the end.

Also, unless otherwise clear from the context, the term "elastic" does not limit the type of material, because elasticity is an intrinsic property of any solid material measured by Young's modulus. In other words, taken outside any context an elastic material can be anything from rubber to diamond.

4.7 Terms such as "about", "approximately" or "substantially"

4.7.1 Interpretation of terms such as "about", "approximately" or "substantially"

Where terms such as "about" or "approximately" are applied to a particular value (e.g. "about 200°C" or "approximately 200°C") or to a range (e.g. "about x to approximately y"), the value or range is interpreted as being as accurate as the method used to measure it. If no error margins are specified in the application, the same principles described in G-VI, 8.1 apply, i.e. the expression "about 200°C" is interpreted as having the same round-off as "200°C". If error margins are specified in the application, they must be used in the claims in place of the expression containing "about" or similar terms.

When terms such as "substantially" or "approximately" qualify a structural unit of an apparatus (e.g. "a tray plate with a substantially circular circumference" or "a tray plate with an approximately curved base"), the expression containing the term "substantially" or "approximately" will be interpreted as a technical feature being produced within the technical tolerance of the method used to manufacture it (e.g. cutting a metal is much more accurate than cutting a plastic; or cutting with a CNC machine is more accurate than cutting by hand) unless the application suggests otherwise. In other words, in the absence of any indication to the contrary in the application, the expression "a tray plate with a substantially circular circumference" is interpreted as claiming the same technical feature as "a tray plate with a circular circumference"; in turn both expressions are considered as claiming any tray whose base the skilled person in the manufacturing field would consider as being circular.

The same applies when the expression containing "substantially" or "approximately" implies that a certain effect or result can be obtained within a certain tolerance and the skilled person knows how to obtain that tolerance. For example, "a substantially vertical seat back" is interpreted as allowing for a certain +/- variation around 90° where the skilled person can recognise that a functionality for supporting the sitting person's back is present.

4.7.2 Clarity objections

If the application suggests that the use of terms such as "about", "approximately" or "substantially" extends either the interval claimed by a value and/or range outside the error margins of the measurement system or the structural unit beyond the manufacturing tolerances or any other tolerance that the skilled person would take into consideration in the technical field concerned, then the wording of the claims becomes vague and undefined. This leads to an objection under Art. 84 because the presence of this wording prevents the subject-matter of the claims from being unambiguously distinguished from the prior art with respect to novelty and inventive step.

For example, if the application suggests that an icosagon (20-sided polygon) is also a "substantially circular circumference" for a metal tray

realised by a CNC waterjet cutting machine, this renders the scope of the claims unclear because:

(i) the tolerance indicated by the application is outside the tolerance of the manufacturing method (a CNC waterjet cutting machine approximates a circular circumference by using a polygon with hundreds of sides); and

(ii) if an icosagon is also a "substantially circular circumference", what about an enneadecagon (19-sided polygon) or an octadecagon (18-sided polygon)? When does a polygon stop being a "substantially circular circumference"? How can this be assessed objectively by the person skilled in the art?

4.8 Trade marks

The use of trade marks and similar expressions in claims is not allowed as it does not guarantee that the product or feature referred to is not modified while maintaining its name during the term of the patent. They may be allowed exceptionally if their use is unavoidable and they are generally recognised as having a precise meaning.

With regard to the need to acknowledge trade marks as such in the description, see F-II, 4.14. With regard to the effect of references to trade marks on sufficiency of disclosure (Art. 83), see F-III, 7.

4.9 Optional features

Optional features, i.e. features preceded by expressions such as "preferably", "for example", "such as" or "more particularly" are allowed if they do not introduce ambiguity. In such a case, they are to be regarded as entirely optional.

These expressions introduce ambiguity and render the scope of the claim unclear if they do not lead to a restriction of the subject-matter of the claim.

For example, the wording "a method to manufacture an artificial stone, such as a clay brick" does not fulfil the requirements of Art. 84, because a clay brick will never be an artificial stone. Hence it is unclear if either an artificial stone or a clay brick is manufactured by the method of the claim.

Analogously, the wording "the solution is heated up to between 65 and 85°C, particularly to 90°C" does not fulfil the requirements of Art. 84 because the temperature after the term "particularly" contradicts the range before it.

4.10 Result to be achieved

The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention by a result to be achieved are not allowed, in particular if they only amount to claiming the underlying technical problem. However, they may be allowed if the invention either can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims and if the result is one which can be directly and positively verified by tests

or procedures adequately specified in the description or known to the person skilled in the art and which do not require undue experimentation (see T 68/85). For example, the invention may relate to an ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary considerably in a manner difficult to define whilst still providing the desired effect. So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved, provided that the specification includes adequate directions to enable the skilled person to determine the required dimensions by routine test procedures (see F-III, 1 to F-III, 3).

However, these cases have to be distinguished from those in which the product is defined by the result to be achieved and the result amounts in essence to the problem underlying the application. It is established case law that an independent claim must indicate all the essential features of the object of the invention in order to comply with the requirements of Art. 84 (see G 2/88, Reasons 2.5, and G 1/04, Reasons 6.2). Art. 84 also reflects the general legal principle that the extent of monopoly conferred by a patent, as defined in the claims, must correspond to the technical contribution to the art. It must not extend to subject-matter which, after reading the description, would still not be at the disposal of the person skilled in the art (T 409/91, Reasons 3.3). The technical contribution of a patent resides in the combination of features which solve the problem underlying the application. Therefore, if the independent claim defines the product by a result to be achieved and the result amounts in essence to the problem underlying the application, that claim must state the essential features necessary to achieve the result claimed (T 809/12, Reasons 2.6-2.9.2), see also F-IV, 4.5.

The above-mentioned requirements for allowing a definition of subject-matter in terms of a result to be achieved differ from those for allowing a definition of subject-matter in terms of functional features (see F-IV, 4.21 and F-IV, 6.5).

4.11 Parameters

Parameters are characteristic values, which may be values of directly measurable properties (e.g. the melting point of a substance, the flexural strength of a steel, the resistance of an electrical conductor) or may be defined as more or less complicated mathematical combinations of several variables in the form of formulae.

The characteristics of a product may be specified by parameters related to the physical structure of the product, provided that those parameters can be clearly and reliably determined by objective procedures which are usual in the art. Where the characteristics of the product are defined by a mathematical relation between parameters, each parameter needs to be clearly and reliably determined.

The same applies to process-related features defined by parameters.

The requirements of Art. 84 with regard to the characterisation of a product by parameters can be summarised as follows (see T 849/11):

(i) the claims must be clear in themselves when read by the skilled person (not including knowledge derived from the description);

(ii) the method for measuring a parameter (or at least a reference thereto) must appear completely in the claim itself; and

(iii) an applicant who chooses to define the scope of the claim by parameters needs to ensure that the skilled person can easily and unambiguously verify whether they are working inside or outside the scope of the claim.

If the description of the method for measuring a parameter is so long that its inclusion makes the claim unclear through lack of conciseness or difficult to understand, the requirement under point (ii) can be met by including in the claim a reference to the description, in accordance with Rule 43(6).

Furthermore the requirement under point (ii) can still be met if it can be convincingly shown that (see T 849/11):

(a) the measurement method to be employed belongs to the skilled person's common general knowledge, e.g. because there is only one method, or because a particular method is commonly used; or

(b) all the measurement methodologies known in the relevant technical field for determining this parameter yield the same result within the appropriate limit of measurement accuracy.

For further issues relating to lack of support and sufficiency of disclosure regarding parameters, see F-III, 11 and F-IV, 6.4.

4.11.1 Unusual parameters

Unusual parameters are parameters not commonly used in the field of the invention. Two main situations can present themselves:

(i) The unusual parameter measures a property of the product/process for which another generally recognised parameter is used in the field of the invention.

(ii) The unusual parameter measures a property of the product/process that was not measured before in the field of the invention.

In addition to the requirements contained in F-IV, 4.11:

– Cases in which an unusual parameter of type (i) is employed and no straightforward conversion from the unusual parameter to the parameter generally recognised in the art is possible, or a non-accessible apparatus for measuring the unusual parameter is used are *prima facie* objectionable on grounds of lack of clarity, as no

meaningful comparison with the prior art can be made. Such cases might also disguise lack of novelty (see G-VI, 6).

– Use of unusual parameters of type (ii) is allowable if it is evident from the application that the skilled person would face no difficulty in carrying out the presented tests and would thereby be able to establish the exact meaning of the parameter and to make a meaningful comparison with the prior art. In addition, the onus of proof that an unusual parameter is a genuine distinctive feature vis-à-vis the prior art lies with the applicant. No benefit of doubt can be accorded in this respect (see G-VI, 6).

Example of an allowable unusual parameter of type (ii)

The application explains that the abrasive action of sandpaper of very fine grade is improved if strips with abrasive grain are alternated with strips without abrasive grain. Claim 1 contains an unusual parameter of type (ii) that measures the relationship between the widths of the abrasive strips and the non-abrasive strips within a certain length of the sandpaper.

The skilled person has no problem in establishing the exact meaning of the parameter, measuring it and determining its genuine distinctive feature against the prior art.

4.12 Product-by-process claim

Art. 53(b)
Rule 28(2)
Art. 64(2)

A claim defining a product in terms of a process is to be construed as a claim to the product as such. The technical content of the invention lies not in the process *per se*, but rather in the technical properties imparted to the product by the process. Claims defining plants or animals produced by a method including a technical step which imparts a technical feature to a product constitute an exception in so far as the requirements of Article 53(b) as interpreted by Rule 28(2) are concerned. The exclusion under Rule 28(2) regarding plants and animals exclusively obtained by means of an essentially biological process does not apply to patents granted before 1 July 2017 nor to pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, OJ EPO 2020, A119).

If a technical feature of a claimed plant or animal, e.g. a single nucleotide exchange in the genome, can be the result of both a technical intervention (e.g. directed mutagenesis) and an essentially biological process (a natural allele), a disclaimer is necessary to delimit the claimed subject-matter to the technically produced product (see examples in G-II, 5.4.2.1 and G-II, 5.4). If, on the other hand, the feature in question can unambiguously be obtained by technical intervention only, e.g. a transgene, no disclaimer is necessary. For the general principles governing disclaimers see H-V, 4.1 and H-V, 4.2.

If the process through which the claimed plant or animal is defined does not impart identifiable and unambiguous technical features to the plant or animal, e.g. the genetic information present in the genome, the claim directed to a plant or animal lacks clarity.

Claims for products defined in terms of a process of manufacture are allowable only if the products as such fulfil the requirements for patentability, i.e. *inter alia* that they are new and inventive, and it is impossible to define the claimed product other than in terms of a process of manufacture. A product is not rendered novel merely by the fact that it is produced by means of a new process. The claim may for instance take the form "Product X obtainable by process Y". Irrespective of whether the term "obtainable", "obtained", "directly obtained" or an equivalent wording is used in the product-by-process claim, it is still directed to the product *per se* and confers absolute protection upon the product.

As regards novelty, when a product is defined by its method of manufacture, the question to be answered is whether the product under consideration is identical to known products. The burden of proof for an allegedly distinguishing "product-by-process" feature lies with the applicant, who has to provide evidence that the modification of the process parameters results in another product, for example by showing that distinct differences exist in the properties of the products. Nevertheless, the division needs to furnish reasoned argumentation to support the alleged lack of novelty of a product-by-process claim, especially if this objection is contested by the applicant (see G 1/98, T 828/08).

Art. 69

Similarly, examination of product or product-by-process claims in respect of their patentability under the EPC is unaffected by the extent of the protection conferred by the patent or the patent application (see G 2/12 and G 2/13, Reasons VIII(2)(6)(b)).

4.12.1 Product claim with process features

Provided that they are allowable, the process features in a product claim comprising both product features and process features can establish the novelty of the claimed product only if they cause the claimed product to have different properties from the products known from the prior art. As in the case of product-by-process claims (see F-IV, 4.12), the burden of proof for an allegedly distinguishing "product-by-process" feature lies with the applicant.

4.13 Interpretation of expressions stating a purpose

4.13.1 Interpretation of expressions such as "Apparatus for ...", "Product for ... "

If a claim commences with such words as "Apparatus for carrying out the process ...", this must be construed as meaning merely apparatus suitable for carrying out the process. An apparatus which otherwise possesses all of the features specified in the claims but which is unsuitable for the stated purpose or requires modifications to enable it to be so used for said purpose, is normally not considered as anticipating the claim.

Similar considerations apply to a claim for a product for a particular use. For example, if a claim refers to a "mould for molten steel", this implies certain limitations for the mould. Therefore, a plastic ice cube tray with a melting point much lower than that of steel does not come within the claim. Similarly, a claim to a substance or composition for a particular use is

construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which *prima facie* is the same as the substance or composition defined in the claim, but which is in a form which renders it unsuitable for the stated use, does not deprive the claim of novelty. However, if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it deprives the claim of novelty.

An exception to this general principle of interpretation is where the claim is to a known substance or composition for use in a surgical, therapeutic or diagnostic method (see G-II, 4.2 and G-VI, 7.1).

4.13.2 Interpretation of means-plus-function features ("means for ... ")

Means-plus-function features ("means for ...") are a type of functional feature and hence do not contravene the requirements of Art. 84.

Any prior art feature suitable for carrying out the function of a means-plus-function feature will anticipate the latter. For example, the feature "means for opening a door" is anticipated by both the door key and a crowbar.

An exception to this general principle of interpretation is where the function of the means-plus-function feature is carried out by a computer or similar apparatus. In this case the means-plus-function features are interpreted as means adapted to carry out the relevant steps/functions, rather than merely means suitable for carrying them out.

Example:

"1. An eyeglass lens grinding machine for processing a lens such that the lens is fitted in an eyeglass frame, said machine comprising:

at least a grinding wheel for bevelling the lens;

means for receiving frame configurational data on the eyeglass frame and layout data to be used in providing a layout of the lens relative to the eyeglass frame;

means for detecting an edge position of the lens on the basis of the received frame data and layout data;

means for determining a first bevel path by calculation based on the result of detection by said edge position detecting means;

means for determining a second bevel path obtained by tilting said first bevel path such that said second bevel path passes through a desired position on a lens edge; and

means for controlling the grinding wheel during the bevelling of the lens on the basis of said second bevel path."

"1. An eyeglass lens grinding machine for processing a lens such that the lens is fitted in an eyeglass frame, said machine comprising

at least a grinding wheel for bevelling the lens;

a computer adapted to:

– receive frame configurational data on the eyeglass frame and layout data to be used in providing a layout of the lens relative to the eyeglass frame;

– detect an edge position of the lens on the basis of the received frame data and layout data;

– determine a first bevel path by calculation based on the result of detection by said edge position detecting means;

– determine a second bevel path that is obtained by tilting said first bevel path such that said second bevel path passes through a desired position on a lens edge; and

– control the grinding wheel during the bevelling of the lens on the basis of said second bevel path."

Each of these two claims is new over a prior art disclosing an eyeglass lens grinding machine comprising a grinding wheel and a computer for controlling the grinding wheel if the specific processing steps are not disclosed in the prior art. When "means for" refers to computer means, the processing steps being defined as "means for + function" (first claim) and "computer adapted to + function" (second claim) are to be interpreted as limiting. Therefore, a prior-art document disclosing an eyeglass lens grinding machine comprising at least a grinding wheel for bevelling the lens and a computer only anticipates these claims if the prior-art document also discloses that the computer is programmed to carry out the claimed steps.

For further information on claim formulations commonly used in computer-implemented inventions, see F-IV, 3.9.

4.13.3 Interpretation of expressions such as "Method for ..."

In the context of a method, two different types of stated purpose are possible, namely those that define the application or use of a method, and those that define an effect arising from the steps of the method and are implicit therein (see T 1931/14).

Where the stated purpose defines the specific application of the method, this purpose requires additional steps which are not implied by or inherent in the other remaining steps defined in the claim, and without which the claimed process would not achieve the stated purpose. Hence a method claim that defines a working method which, for example, commences with such words as "Method for remelting galvanic layers", the part "for remelting ..." is not to be understood as meaning that the process is merely suitable for remelting galvanic layers, but rather as a functional feature

concerning the remelting of galvanic layers and, hence, defining one of the method steps of the claimed working method (see T 1931/14 and T 848/93).

Analogously, in the case of a "method of manufacture", i.e. a claim directed to a method for manufacturing a product, the fact that the method results in the product is to be treated as an integral method step (see T 268/13).

On the other hand, where the purpose merely states a technical effect which inevitably arises when carrying out the other remaining steps of the claimed method and is thus inherent in those steps, this technical effect has no limiting effect on the subject-matter of the claim. For example, a method claim concerning the application of a particular surface active agent to a specified absorbent product and defining its purpose as "for reducing malodor" in terms of an intended technical effect is anticipated by a prior-art document describing a method having such suitability "for reducing malodor" although not mentioning the specific use (see T 1931/14 and T 304/08).

4.14 Definition by reference to (use with) another entity

A claim in respect of a physical entity (product, apparatus) may seek to define the invention by reference to features relating to another entity that is not part of the claimed first entity but that is related to it through use. An example of such a claim is "a cylinder head for an engine", where the former is defined by features of its location in the latter.

Since the first entity (the cylinder head) can often be produced and marketed independently of the other entity (the engine), the applicant is normally entitled to independent protection of the first entity *per se*. Therefore, in first instance, such a claim is always interpreted as not including the other entity or its features: these limit the subject-matter of the claim only in so far as the first entity's features are suitable to be used with the second entity's features. In the above example, the cylinder head must be suitable to be mounted in the engine described in the claim, but the features of the engine do not limit the subject-matter of the claim *per se*.

Only if the claim is directed without any doubt to a combination of the first and second entities, the features of the other entity are limiting for the subject-matter of the claim. In the above example, the claim should be written as an "engine with a cylinder head" or an "engine comprising a cylinder head" for the features of the engine to be considered as limiting the subject-matter of the claim.

For the assessment of claims directed to computer-implemented inventions, where a claim to a computer program refers to a computer (a separate entity), see F-IV, 3.9.

4.14.1 Clarity objections

Once it has been established if a claim is directed to either one entity or to a combination of entities, the wording of the claim must be adapted appropriately to reflect it; otherwise the claim is objected to under Art. 84.

For example, in the case of a claim directed to a single entity, the first entity is "connectable" to the second entity; in the case of a claim directed to a combination of entities the first entity is "connected" to the second entity.

4.14.2 Dimensions and/or shape defined by reference to another entity

It may be allowable to define the dimensions and/or shape of a first entity in an independent claim by general reference to the dimensions and/or corresponding shape of a second entity which is not part of the claimed first entity but is related to it through use. This particularly applies where the size of the second entity is in some way standardised (for example, in the case of a mounting bracket for a vehicle number-plate, where the bracket frame and fixing elements are defined in relation to the outer shape of the number-plate).

Furthermore, references to second entities which cannot be seen as subject to standardisation may also be sufficiently clear in cases where the skilled person would have little difficulty in inferring the resultant restriction of the scope of protection for the first entity (for example, in the case of a covering sheet for an agricultural round bale, where the length and breadth of the covering sheet and how it is folded are defined by reference to the bale's circumference, width and diameter, see T 455/92). It is neither necessary for such claims to contain the exact dimensions of the second entity, nor do they have to refer to a combination of the first and second entities. Specifying the length, width and/or height of the first entity without reference to the second would lead to an unwarranted restriction of the scope of protection.

4.15 The expression "in"

To avoid ambiguity, particular care is exercised when assessing claims which employ the word "in" to define a relationship between different physical entities (product, apparatus), or between entities and activities (process, use), or between different activities. Examples of claims worded in this way include the following:

(i) Cylinder head in a four-stroke engine;

(ii) In a telephone apparatus with an automatic dialler, dial tone detector and feature controller, the dial tone detector comprising ...;

(iii) In a process using an electrode feeding means of an arc-welding apparatus, a method for controlling the arc welding current and voltage comprising the following steps: ...; and

(iv) In a process/system/apparatus etc. ... the improvement consisting of...

In examples (i) to (iii) the emphasis is on the fully functioning sub-units (cylinder head, dial tone detector, method for controlling the arc welding current and voltage) rather than the complete unit within which the sub-unit is contained (four-stroke engine, telephone, process). This can make it unclear whether the protection sought is limited to the sub-unit *per se*, or

whether the unit as a whole is to be protected. For the sake of clarity, claims of this kind must be directed either to "a unit with (or comprising) a sub-unit" (e.g. "four-stroke engine with a cylinder head"), or to the sub-unit *per se*, specifying its purpose (for example, "cylinder head for a four-stroke engine"). The latter course may be followed only at the applicant's express wish and only if there is a basis for it in the application as filed, in accordance with Art. 123(2).

With claims of the type indicated by example (iv), the use of the word "in" sometimes makes it unclear whether protection is sought for the improvement only or for all the features defined in the claim. Here, too, it is essential to ensure that the wording is clear.

However, claims such as "use of a substance ... as an anticorrosive ingredient in a paint or lacquer composition" are acceptable on the basis of second non-medical use (see G-VI, 7.2, second paragraph).

4.16 Use claims

For the purposes of examination, a "use" claim in a form such as "the use of substance X as an insecticide" is regarded as equivalent to a "process" claim of the form "a process of killing insects using substance X". Thus, a claim in the form indicated is not to be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use as an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" is equivalent to a process claim for the process of amplifying using a circuit containing the transistor and is not to be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit". However, a claim directed to the use of a process for a particular purpose is equivalent to a claim directed to that very same process (see T 684/02).

Care is to be taken when a claim relates to a two-step process which combines a use step with a product production step. This may be the case e.g. when a polypeptide and its use in a screening method have been defined as the only contribution to the art. An example of such a claim would then be:

"A method comprising:

(a) contacting polypeptide X with a compound to be screened and

(b) determining whether the compound affects the activity of said polypeptide, and subsequently transforming any active compound into a pharmaceutical composition."

Many variations of such a claim are conceivable, but in essence they combine (a) a screening step (i.e. using a specified test material to select a compound having a given property) with (b) further production steps (i.e. further transforming the selected compound for instance into the desired composition).

According to decision G 2/88 there are two different types of process claim, (i) the use of an entity to achieve a technical effect and (ii) a process for the production of a product. G 2/88 makes clear that Art. 64(2) applies only to processes of type (ii). The above claim and its analogues thus represent a combination of two different and irreconcilable types of process claim. Step (a) of the claim relates to a process of type (i), step (b) to a process of type (ii). Step (b) builds on the "effect" achieved by step (a), rather than step (a) feeding into step (b) a specific starting material and resulting in a specific product. Thus, the claim is made up partly of a use claim and partly of a process for producing a product. This renders the claim unclear according to Art. 84.

4.17 References to the description or drawings

Rule 43(6)

As indicated in Rule 43(6), the claims must not, in respect of the technical features of the invention, rely on references to the description or drawings "except where absolutely necessary". In particular they must not normally rely on such references as "as described in part ... of the description", or "as illustrated in Figure 2 of the drawings".

The emphatic wording of the excepting clause is to be noted. The onus is upon the applicant to show that it is "absolutely necessary" to rely on reference to the description or drawings in appropriate cases (see T 150/82).

An example of an allowable exception is an invention involving some peculiar shape, illustrated in the drawings, but which cannot be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products some of whose features can be defined only by means of graphs or diagrams.

4.18 Reference signs

Rule 43(7)

If the application contains drawings, and the comprehension of the claims is improved by establishing the connection between the features mentioned in the claims and the corresponding reference signs in the drawings, then appropriate reference signs need to be placed in parentheses after the features mentioned in the claims. If there are a large number of different embodiments, only the reference signs of the most important embodiments need be incorporated in the independent claim(s). Where claims are drafted in the two-part form set out in Rule 43(1), the reference signs need to be inserted not only in the characterising part but also in the preamble of the claims.

Reference signs are not however to be construed as limiting the extent of the matter protected by the claims; their sole function is to make claims easier to understand. A comment to that effect in the description is acceptable (see T 237/84).

If text is added to reference signs in parentheses in the claims, lack of clarity can arise (Art. 84). Expressions such as "securing means (screw 13, nail 14)" or "valve assembly (valve seat 23, valve element 27, valve seat 28)" are not reference signs within the meaning of Rule 43(7) but are

special features, to which the last sentence of Rule 43(7) is not applicable. Consequently, it is unclear whether the features added to the reference signs are limiting or not. Accordingly, such bracketed features are generally not permissible. However, additional references to those figures where particular reference signs are to be found, such as "(13 - Figure 3; 14 - Figure 4)" are unobjectionable.

A lack of clarity can also arise with bracketed expressions that do not include reference signs, e.g. the expression "(concrete) moulded brick" is unclear because it cannot be determined if the feature moulded brick is limited or not by the word concrete. In contrast, bracketed expressions with a generally accepted meaning are allowable, e.g. "(meth)acrylate" which is known as an abbreviation for "acrylate and methacrylate". The use of brackets in chemical or mathematical formulae is also unobjectionable, as is their use when correcting physical values not complying with the requirements of Rule 49(10).

4.19 Negative limitations (e.g. disclaimers)

A claim's subject-matter is normally defined in terms of positive features indicating that certain technical elements are present. Exceptionally, however, the subject-matter may be restricted using a negative limitation expressly stating that particular features are absent. This may be done e.g. if the absence of a feature can be deduced from the application as filed (see T 278/88).

Negative limitations such as disclaimers may be used only if adding positive features to the claim either would not define more clearly and concisely the subject-matter still protectable (see G 1/03 and T 4/80) or would unduly limit the scope of the claim (see T 1050/93). It has to be clear what is excluded by means of the disclaimer (see T 286/06). A claim containing one or more disclaimers must also fully comply with the clarity and conciseness requirements of Art. 84 (see G 1/03, Reasons 3). Moreover, in the interests of the patent's transparency, the excluded prior art needs to be indicated in the description in accordance with Rule 42(1)(b), and the relation between the prior art and the disclaimer needs to be shown.

For the allowability of disclaimers excluding embodiments that were disclosed in the original application as being part of the invention, see H-V, 4.2.2. With respect to the allowability of disclaimers not disclosed in the application as originally filed (so-called undisclosed disclaimers), see H-V, 4.2.1.

4.20 "Comprising" vs. "consisting of"

This section outlines how the terms "comprising" and "consisting of" are to be interpreted when construing a claim.

A claim directed to an apparatus/method/product "comprising" certain features is interpreted as meaning that it includes those features, but that it does not exclude the presence of other features, as long as they do not render the claim unworkable.

On the other hand, if the wording "consist of" is used, then no further features are present in the apparatus/method/product apart from the ones following said wording. In particular, if a claim for a chemical compound refers to it as "consisting of components A, B and C" by their proportions expressed in percentages, the presence of any additional component is excluded and therefore the percentages must add up to 100% (see T 711/90).

In the case of chemical compounds or compositions, the use of "consisting essentially of" or "comprising substantially" means that specific further components can be present, namely those not materially affecting the essential characteristics of the compound or composition. For any other apparatus/method/product these terms have the same meaning as "comprising".

Regarding Art. 123(2), "comprising" does not provide *per se* an implicit basis for either "consisting of" or "consisting essentially of" (T 759/10).

4.21 Functional definition of a pathological condition

When a claim is directed to a further therapeutic application of a medicament and the condition to be treated is defined in functional terms, e.g. "any condition susceptible of being improved or prevented by selective occupation of a specific receptor", the claim can be regarded as clear only if instructions, in the form of experimental tests or testable criteria, are available from the patent documents or from the common general knowledge allowing the skilled person to recognise which conditions fall within the functional definition and accordingly within the scope of the claim (see T 241/95; see also G-II, 4.2).

4.22 Broad claims

The Convention does not explicitly mention overly broad claims. However, objections to such claims may arise for various reasons.

Art. 84 and Art. 83

Where there are discrepancies between the claims and the description, the claims are not sufficiently supported by the description (Art. 84) and also, in most cases, the invention is not sufficiently disclosed (Art. 83) (see T 409/91, F-IV, 6.1 and F-IV, 6.4).

Art. 54 and Art. 56

Sometimes an objection of lack of novelty arises, for example if the claim is formulated in such broad terms that it also covers known subject-matter from other technical fields. Broad claims may also cover embodiments for which a purported effect has not been achieved. On raising an objection of lack of inventive step in such cases, see G-VII, 5.2.

For broad claims in opposition proceedings, see also D-V, 4 and 5.

4.23 Order of claims

There is no legal requirement that the first claim must be the broadest. However, Art. 84 requires that the claims must be clear not only individually but also as a whole. Therefore, where there are a large number of claims, they need to be arranged with the broadest claim first. If the broadest of a large number of claims is a long way down, so that it could easily be

overlooked, the applicant is required either to rearrange the claims in a more logical way or to direct attention to the broadest claim in the introductory part or in the summary of the description.

Furthermore, if the broadest claim is not the first one, the later broader claim must also be an independent claim. Consequently, where these independent claims are of the same category, an objection may also arise under Rule 43(2) (see F-IV, 3.2 and 3.3).

4.24 Interpretation of terms such as identity and similarity in relation to amino or nucleic acid sequences

Amino acid or nucleic acid sequences can be defined by a percentage of identity. The percentage of identity determines the number of identical residues over a defined length in a given alignment. If no algorithm or calculation method for determining the percentage of identity is defined, the broadest interpretation will be applied using any reasonable algorithm or calculation method known at the relevant filing date.

Amino acid sequences can be defined by a degree of similarity (expressed as a percentage of similarity). The term similarity is broader than the term identity because it allows conservative substitutions of amino acid residues having similar physicochemical properties over a defined length of a given alignment. The percentage of similarity is determinable only if a similarity-scoring matrix is defined. If no similarity-scoring matrix is defined, a claim referring to a sequence displaying a percentage of similarity to a recited sequence is considered to cover any sequence fulfilling the similarity requirement as determined with any reasonable similarity-scoring matrix known at the relevant filing date.

For amino acid sequences, if a percentage of homology is used by the applicant as the only feature to distinguish the subject-matter of a claim from the prior art, its use is objected to under Art. 84 (cf. F-IV, 4.6.1) unless the determination or calculation of the percentage of homology is clearly defined in the application as filed. For nucleic acid sequences, homology percentage and identity percentage are usually considered to have the same meaning.

5. Conciseness, number of claims

Art. 84
Rule 43(5)

The requirement that the claims must be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be considered in relation to the nature of the invention the applicant seeks to protect. Undue repetition of wording, e.g. between one claim and another, is to be avoided by the use of the dependent form. Regarding independent claims in the same category, see F-IV, 3.2 and 3.3. The conciseness requirement also applies to dependent claims in respect of both their number and their content. For example, the repetition of subject-matter that has already been claimed is unnecessary and negatively affects the conciseness of the claims. Similarly, the number of dependent claims should be reasonable. What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case. The interests of the relevant public must also be borne in mind. The presentation of the claims must not make it unduly

burdensome to determine the matter for which protection is sought (T 79/91 and T 246/91). Objection may also arise where there is a multiplicity of alternatives within a single claim, if this renders it unduly burdensome to determine the matter for which protection is sought.

Where it is found that the claims lack conciseness under Art. 84, this may lead to the issuing of a partial European or partial supplementary European search report under Rule 63 (see B-VIII, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments from the applicant as to why the invitation under Rule 63(1) was not justified, an objection under Rule 63(3) will also arise (see H-II, 5).

6. Support in description

6.1 General remarks

Art. 84

The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art (see T 409/91). Regarding the support of dependent claims by the description, see F-IV, 6.6.

6.2 Extent of generalisation

Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the division must judge in each particular case in the light of the relevant prior art. Thus an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology. A fair statement of claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicants are allowed to cover all obvious modifications of, equivalents to and uses of that which they have described. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicants ascribe to them in the description, they are allowed to draw the claims accordingly. After the date of filing, however, the applicants are allowed to do so only if this does not contravene Art. 123(2).

6.3 Objection of lack of support

As a general rule, a claim is regarded as supported by the description unless there are well-founded reasons for believing that the skilled person would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must, however, be of a technical character; vague statements or assertions having no technical content provide no basis.

The division raises an objection of lack of support only if it has well-founded reasons. Once the division has set out a reasoned case that, for example, a broad claim is not supported over the whole of its breadth, the onus of demonstrating that the claim is fully supported lies with the applicant

(see F-IV, 4). Where an objection is raised, the reasons are, where possible, to be supported specifically by a published document.

A claim in generic form, i.e. relating to a whole class, e.g. of materials or machines, may be acceptable even if of broad scope, if there is fair support in the description and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where the information given appears insufficient to enable a person skilled in the art to extend the teaching of the description to parts of the field claimed but not explicitly described by using routine methods of experimentation or analysis, the division raises a reasoned objection, and invites the applicant to establish, by suitable response, that the invention can in fact be readily applied on the basis of the information given over the whole field claimed or, failing this, to restrict the claim accordingly.

The question of support is illustrated by the following examples:

(i) a claim relates to a process for treating all kinds of "plant seedlings" by subjecting them to a controlled cold shock so as to produce specified results, whereas the description discloses the process applied to one kind of plant only. Since it is well-known that plants vary widely in their properties, there are well-founded reasons for believing that the process is not applicable to all plant seedlings. Unless the applicants can provide convincing evidence that the process is nevertheless generally applicable, they must restrict their claim to the particular kind of plant referred to in the description. A mere assertion that the process is applicable to all plant seedlings is not sufficient;

(ii) a claim relates to a specified method of treating "synthetic resin mouldings" to obtain certain changes in physical characteristics. All the examples described relate to thermoplastic resins and the method is such as to appear inappropriate to thermosetting resins. Unless the applicants can provide evidence that the method is nevertheless applicable to thermosetting resins, they must restrict their claim to thermoplastic resins;

(iii) a claim relates to improved fuel oil compositions which have a given desired property. The description provides support for one way of obtaining fuel oils having this property, which is by the presence of defined amounts of a certain additive. No other ways of obtaining fuel oils having the desired property are disclosed. The claim makes no mention of the additive. The claim is not supported over the whole of its breadth and objection arises.

Where it is found that the claims lack support in the description under Art. 84, this may lead to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments provided by the applicant in his response to the invitation under Rule 63(1) (see B-VIII, 3.2) or to the search opinion under Rule 70a (see B-XI, 8), an objection under Rule 63(3) will also arise (see H-II, 5).

6.4 Lack of support vs. insufficient disclosure

Art. 83
Art. 84

Although an objection of lack of support is an objection under Art. 84, it can often, as in the above examples, also be considered as an objection of insufficient disclosure of the invention under Art. 83 (see F-III, 1 to 3), the objection being that the disclosure is insufficient to enable the skilled person to carry out the "invention" over the whole of the broad field claimed (although sufficient in respect of a narrow "invention"). Both requirements are designed to reflect the principle that the terms of a claim must be commensurate with, or be justified by, the invention's technical contribution to the art. Therefore, the extent to which an invention is sufficiently disclosed is also highly relevant to the issue of support. The reasons for failure to meet the requirements of Art. 83 may in effect be the same as those that lead to the infringement of Art. 84 as well, namely that the invention, over the whole range claimed, extends to technical subject-matter not made available to the person skilled in the art by the application as filed (see T 409/91, Reasons 2 and 3.3 to 3.5).

For example, where a technical feature is described and highlighted in the description as being an essential feature of the invention, to comply with Art. 84 this feature must also be part of the independent claim(s) defining the invention (see F-IV, 4.5.1). By the same token, if the (essential) technical feature in question is absent from the claims, and no information is given on how to perform the claimed invention successfully without the use of said feature, the description does not disclose the invention defined in the claim(s) in the manner prescribed by Art. 83.

An objection under both Art. 84 and Art. 83 may also be justified. An example would be a claim relating to a known class of chemical compounds defined by measurable parameters, when the description does not disclose a technical teaching allowing the skilled person to manufacture those compounds complying with the parametric definition, and this is not otherwise feasible by the application of common general knowledge or routine experimentation. Such a claim would be both technically not supported and not sufficiently disclosed, regardless of whether the parametric definition meets the clarity requirement of Art. 84.

Whether the objection is raised as lack of support or as insufficiency is not important in examination proceedings; but it is important in opposition proceedings since there only the latter ground is available (see D-III, 5).

6.5 Definition in terms of function

A claim may broadly define a feature in terms of its function, i.e. as a functional feature, even where only one example of the feature has been given in the description, if the skilled person would appreciate that other means could be used for the same function (see also F-IV, 2.1 and 4.10). For example, "terminal position detecting means" in a claim might be supported by a single example comprising a limit switch, it being evident to the skilled person that e.g. a photoelectric cell or a strain gauge could be used instead. In general, however, if the entire contents of the application are such as to convey the impression that a function is to be carried out in a particular way, with no intimation that alternative means are envisaged, and a claim is formulated in such a way as to embrace other means, or all

means, of performing the function, then objection arises. Furthermore, it may not be sufficient if the description merely states in vague terms that other means may be adopted, if it is not reasonably clear what they might be or how they might be used.

6.6 Support for dependent claims

Where certain subject-matter is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention (see F-II, 4.5).

Annex
Examples concerning essential features

Example 1

Claim 1 relates to a method for storing gel-coated seeds having a gel coat comprising an aqueous gel having been made water-insoluble by a metal ion. The method is characterised by storing the gel-coated seeds in an aqueous solution containing said metal ion. In the description the object of the invention is defined as providing a method for storing gel-coated seeds easily without causing reduction in yield and handling properties. It was emphasised in the description that it is necessary to confine the metal ion concentration to a specific range in order to achieve the goals of the invention. A metal ion concentration outside the specific range was presented as negatively influencing yield and handling properties. The subject-matter of claim 1 – which does not indicate the specific range – therefore does not solve the problem stated in the description.

Example 2

The invention relates to an apparatus for concave shaping of a metal strip. In the closest prior art, the metal strip is passed transversely to its length through a shaping set of rollers at which the concave shape is applied to the strip. According to the description, the problem is that the rollers are unable to subject the lateral ends of the strip to a curve-creating force and so the lateral ends normally end up planar. The distinguishing feature of the independent claim specifies that a flexible belt or web-like member is provided to support the strip in its passage through the shaping set of rollers. This feature is sufficient to solve the problem. Further features, e.g. the details of the mechanism for advancing the strip into the shaping set of rollers or the provision of at least three rollers, are not necessary to solve the problem: such additional features would unduly restrict the claim (see T 1069/01).

Example 3

Claim 1 is directed to an apparatus for coding television signals comprising, amongst other features, a parameter generating means which ensures that the error between the pixel data of the predicted and actual current fields is minimised. The description describes only one example for minimising the error, namely a method of least squares. What is important is that the skilled person would be able to realise how the error minimising function can be implemented: it is not relevant in this context whether the method of least squares is the only method applicable. It is therefore not necessary to further restrict the claimed parameter generating means in the sense that it uses a method of least squares (see T 41/91).

Example 4

The description states that a compound C is obtained by reacting a mixture of A and B for at least 10 minutes at 100°C. It is emphasised that A and B must be reacted for this minimum amount of time, as otherwise the reaction will be incomplete and C will not be formed. Claim 1 is directed to a process

for the production of compound C, characterised by reacting a mixture of A and B for 5 to 15 minutes at 100°C. The claim does not contain all the essential features of the invention, as the description clearly states that for the reaction to be complete, it is necessary to react A and B for at least 10 minutes.

Example 5

The description identifies the problem to be solved as providing aerosol compositions wherein the percentage of undesirable volatile organic compounds (VOCs) required as propellant is dramatically decreased, resulting in less VOC release to the atmosphere. Claim 1 specifies the minimum amount of at least 15 weight% of propellant (which is a VOC) in the aerosol, but is completely silent about any maximum amount thereof. The problem underlying the application of releasing less VOCs into the environment is solved only when the propellant does not exceed a particular maximum amount in the aerosol composition: this maximum value is therefore an essential feature of the invention. Claim 1 covers aerosols comprising any amount of propellant greater than or equal to 15 weight%, thereby covering the deficient high percentage of propellant present in conventional aerosols. The percentage of undesirable VOCs in the claimed aerosol compositions is therefore not "dramatically decreased", and so the stated aim of the present invention is not achieved (see T 586/97).

Example 6

As regards diagnostic methods, in G 1/04 it is indicated that if the deductive medical or veterinary decision phase is unambiguously derivable from the application or patent as a whole, it is to be included as an essential feature in the independent claim. In other words, if the inevitable outcome of the first three phases of such a method (see G-II, 4.2.1.3) is a specific diagnosis for curative purposes allowing the deviation to be attributed to a particular clinical picture, the decision phase must be included in the independent claim in order to fulfil the requirements of Art. 84. However, this may cause a claim to be excluded from patentability under Art. 53(c) (see also G-II, 4.2.1.3). The requirement that the final decision phase be included in the independent claim as an essential feature is to be applied only if it is clear from the application/patent as a whole that the inevitable result of the findings leads unambiguously to a particular diagnosis: this will have to be decided by the division on a case-by-case basis.

Chapter V – Unity of invention

1. Introduction

The basic principle behind the requirement of unity is that a patent is granted for each invention separately, i.e. in order to proceed to grant, a European patent application is required to contain claims relating to one invention only (G 2/92, Reasons 2).

This requirement of unity is further justified by the principle of equal treatment of applicants: any applicant is entitled to the same rendered service against the paid fees, i.e. one search/examination against one search/examination fee.

Therefore at the search stage, if an application as filed is considered by the search division to relate to more than one invention, a search fee may be paid for each such invention, and the search report will be drawn up only in respect of inventions for which search fees have been paid. At the examination stage the applicant can select only one searched invention in each application to be examined for conformity with the patentability and other requirements of the EPC (see G 2/92, Reasons 2). *Rule 64*

Art. 82 and Rule 44 govern the application of the requirement of unity to European patent applications. This requirement is not applicable in opposition proceedings (G 1/91).

This chapter deals with the substantive aspects of the assessment of unity of invention (F-V, 2 and F-V, 3), as well as some procedural aspects relating to lack of unity during search (F-V, 4) and lack of unity during substantive examination (F-V, 5). Aspects of unity of invention in the case of amended claims and Euro-PCT applications are dealt with in F-V, 6 and F-V, 7 respectively. Further aspects related to the procedural implementation of unity of invention in search and examination are to be found in chapters B-VII and C-III respectively.

Given the harmonisation of the definitions concerning unity of invention in Rules 13(1) PCT and Rule 13(2) PCT versus Art. 82 and Rule 44(1) respectively, the criteria for unity in both systems are the same. Hence, unity of invention is examined in search and substantive examination in both European and PCT procedures according to the same principles. This does not apply to the respective procedures themselves, where significant differences exist. *Art. 150(2)*

Consequently, decisions of the boards of appeal rendered according to the former PCT protest procedures continue to be of interest for the consideration of unity in European applications.

2. Requirement of unity of invention

A European patent application must relate to one invention only or relate to a group of inventions which must be so linked as to form a single general inventive concept (see also B-VII, 1). *Art. 82*

The requirement of unity of invention needs to be assessed only if a group of inventions is claimed. A group of inventions may be formed, for example, by a plurality of independent claims in the same or in different categories, a plurality of alternative inventions defined within a single independent claim (see also F-IV, 3.7) or a plurality of dependent claims where the independent claim is either not novel or not inventive.

Rule 44(1)

If a group of inventions is claimed, the requirement that the inventions in this group are so linked as to form a single general concept (Art. 82) is fulfilled only if there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The term "special" means that the features in question define the contribution that the invention considered as a whole makes over the "prior art at hand" in terms of novelty and inventive step. The "prior art at hand", i.e. the prior art relied upon in the non-unity assessment, may vary depending on the stage of proceedings (see F-V, 3).

The term "same" means that the special technical features are identical or define an identical chemical structure.

The term "corresponding" means that the special technical features achieve the same technical effect or solve the same technical problem. Correspondence may be found for example in alternative solutions, or interrelated features, e.g. the interaction between a plug and a socket causing a releasable electrical connection, or in a causal relationship such as a step in a manufacturing process that causes a certain structural feature in a product. For example, an application might include two sets of claims, one comprising a metal spring, and another comprising a block of rubber. The metal spring and block of rubber may be considered to be corresponding technical features as they both achieve the same technical effect of resilience.

In contrast, features that are not shared, i.e. features that only appear in some but not in other claims, cannot be part of the single general inventive concept.

2.1 Insufficient grounds for lack of unity

Art. 84

When determining unity of invention, a finding of lack of clarity of the claims is on its own not sufficient grounds for a finding of lack of unity.

Normally, too, the sequence of the claims has no impact on the determination of unity of invention. However, it will have an impact on which invention is to be considered the first invention mentioned in the claims (see F-V, 3.4).

Moreover, the fact that the claimed separate inventions belong to different groups of the classification is not in itself a reason for a finding of lack of unity.

If an application contains claims of different categories or several independent claims of the same category, this is not in itself a reason for an objection of lack of unity of invention (the relationship between Rule 43(2) and Art. 82 is explained in more detail in F-V, 3.2.1). *Rule 43(2)*

Lack of unity does not arise because of one claim containing a number of individual features, where these features do not present a technical interrelationship (i.e. a combination), but merely a juxtaposition (see G-VII, 7).

By definition, no lack of unity can be present between an independent claim and its dependent claims, even if the features of the dependent claims are juxtaposed with the features of the independent claim (see F-V, 3.2.3).

2.2 Division's approach

Lack of unity is not a ground of revocation in later proceedings. Therefore, although the objection is certainly made and amendment insisted upon in clear cases, it is neither raised nor insisted upon on the basis of a narrow, literal or academic approach. This is particularly so during search when the possible lack of unity does not necessitate a further search.

When a lack of unity is established, the claimed subject-matter is divided into separate inventions and/or inventions grouped together in view of their technical relationships (see F-V, 3.2), i.e. according to any common matter comprising same or corresponding potential special technical features. In this context, an invention must have technical character and be concerned with a technical problem within the meaning of Art. 52(1) (see G-I, 1 and 2), but it does not necessarily need to meet other requirements for patentability, such as novelty and inventive step (see G-VI and G-VII).

Lack of unity may be evident *a priori*, i.e. prior to carrying out a prior-art search, or may become apparent *a posteriori*, i.e. after taking into account the prior art revealed by the search in terms of novelty and inventive step.

3. Assessment of unity

The assessment of unity of invention serves to determine if the subject-matter of the claims have anything in common that represents a single general inventive concept (Art. 82). If any of the claims contain one or more alternatives, each of the alternatives is considered as if it were a separate claim for the purpose of assessing lack of unity.

A substantive assessment of unity of invention requires

(i) determining, in the light of the application as a whole, the common matter, if any, between the claims of the different claimed inventions that the examiner provisionally identifies (see F-V, 2.2, 3.2 and 3.4);

(ii) comparing the common matter with the "prior art at hand" to examine whether the common matter makes a contribution over that prior art, namely whether it comprises "special" technical features within the meaning of Rule 44(1);

(iii) if the common matter does not comprise special technical features, analysing any remaining technical features which are not part of the identified common matter to determine if there is a unifying technical relationship among some of the claims.

For example, lack of unity may arise among the dependent claims if the independent claim upon which they depend does not comprise any features making a technical contribution over the prior art at hand. In such a case, the independent claim would not provide a unifying technical relationship among the dependent claims as required by Rule 44(1) as it would not contain any "special technical features".

(i) Determining the common matter

Common matter represents a potential single general inventive concept among the claims. It may be present in features which are the same or corresponding (see F-V, 2), namely in features that are either identical to each other or that provide alone or in combination a common technical effect or a solution to a common technical problem.

The technical problem in the non-unity assessment may be different from that in a patentability assessment since the overall object is to find out what the claims have in common.

When analysing the technical problem in a non-unity assessment, the starting point is usually what is considered by the applicant in the description as having been achieved. In this regard, the applicant must disclose the invention in such terms that the technical problem and its solution can be understood, and state any advantageous effects of the invention with reference to the background art (Rule 42(1)(c)). This technical problem defines in the first instance the common matter of the claims.

However, for the purpose of considering unity of invention, the division is not restricted to the general concept of what the applicant subjectively claims to be his invention (G 1/89 and G 2/89).

The technical problem put forward by the applicant in the description may, on closer examination, reveal itself as unsuitable as a means of linking the subject-matter of the claims in such a way that they form a single general inventive concept. This may happen either where, in view of the information contained in the description and the common general knowledge of the skilled person, it is evident that different claims solve different problems (*a priori* assessment of lack of unity) or where the search reveals prior art which discloses or renders obvious a solution of the unifying technical problem stated by the applicant in the description (*a posteriori* assessment of lack of unity). In the latter case, the technical problem stated by the applicant may no longer constitute the single general inventive concept required by Art. 82 since it cannot be regarded as inventive.

For example, a prior-art document under Art. 54(2) disclosing all the features of an independent claim also discloses, at least implicitly, the

technical problem stated by the applicant since by definition this problem must be solved by the features of said independent claim.

The division will then proceed to analyse if any other common matter is present among the claims, i.e. identify, in the light of the application as a whole, any technical features of the claims that are the same or corresponding. When determining whether technical features are corresponding, it is important that the technical problems solved, which are associated with the technical effects, are not formulated too narrowly or too generally. If the technical problems are too narrow when they could have been more general, they may have nothing in common leading to the possibly wrong conclusion that technical features are not corresponding. If they are too general when they could have been narrower, the common aspects of the problem may be known, also leading to the possibly wrong conclusion that there is a lack of unity.

For example, a membrane and a diaphragm may achieve the technical effect of "providing resilience" and hence may be corresponding features.

Common matter may not only be found in features of claims in the same category but may also be embodied in features of claims of different categories. For example, in the case of a product, a process specially adapted for the manufacture of said product and the use of said product, the product may represent the common matter which is present in the use and in the process as the effect or result of the process.

Common matter may also be embodied in interrelated product features (e.g. a plug and a socket). Although corresponding features in interrelated products may be formulated quite differently, if in their interaction they contribute to the same technical effect or to the solution of the same technical problem, they may be part of the common matter.

There may be cases where no common matter at all can be identified. Then the application lacks unity because neither a technical relationship within the meaning of Rule 44(1) is present between the independent claims, nor does the application entail a single general inventive concept within the meaning of Art. 82.

(ii) Comparison of the common matter with the prior art at hand

If common matter, namely subject-matter involving the same or corresponding technical features, is identified in the claims, it must be compared with the prior art at hand. If the common matter defines a non-obvious contribution over that prior art, it will involve "special technical features", and the inventions concerned will be so linked as to form a single general inventive concept. Otherwise, if the common matter is known or obvious from the prior art at hand, then the application lacks unity. This assessment is to be done on the basis of an assessment of novelty and inventive step vis-à-vis the prior art at hand. The obviousness is to be assessed, whenever appropriate, using the problem-solution approach.

The common matter may involve features defining technical alternatives. If the common technical effect to be achieved by these technical alternatives is already known, or may be recognised as generally desirable (a mere desideratum), or is obvious, these alternative features cannot be considered as defining a technical relationship within the meaning of Rule 44(1) because there is no inventive merit in formulating the problem.

The "prior art at hand", i.e. the prior art relied upon in the non-unity assessment, may vary depending on the stage of proceedings. For example, where the assessment is carried out before the search ("*a priori* assessment"), the only "prior art at hand" may be the background art provided by the applicant in the description and any common general knowledge. During the search, other prior art may be revealed and may form the basis for the "*a posteriori* assessment". Therefore, the "prior art at hand" may change during the course of the proceedings. For this reason the assessment of unity is iterative.

(iii) Analysis of the remaining technical features

If the comparison of the common matter under (ii) leads to the finding of a lack of unity, as a next step, the groups of potential different inventions present in the claims need to be confirmed or refined (see F-V, 3.2).

In order to determine these groups of potential inventions, the remaining technical features not forming part of the identified common matter need to be analysed. In most cases, each group will comprise several claims. This grouping is performed on the basis of the technical problems associated with the remaining technical features of each of the claims. Those claims comprising remaining technical features associated with the same technical problem are combined into a single group. However, if the technical problem has been successfully solved in the prior art, claims associated with the same technical problem may be placed into different groups (see F-V, 3.3.1(iii)(c)).

The technical problems associated with the claims must be formulated with care. It may not be sufficient to analyse the remaining technical features of each claim in isolation, but rather to analyse their effect when read in the context of the individual claim as a whole and in the light of the description. When formulating the technical problems of the various potential inventions in a unity assessment, a very narrow approach should be avoided since the aim of the exercise is to see whether any commonality may be established between the inventions. It is therefore often necessary to redefine the very specific problems associated with each of the claims to arrive at a more general problem, while bearing in mind the context in which the relevant features are disclosed.

For the grouping, it is irrelevant whether or not the subject-matter of the claims or of the remaining technical features of the claims are novel or inventive over the prior art at hand. However, it is relevant for assessing whether or not the applicant is to be invited to pay an additional search fee for a group (see F-V, 4).

If the problem(s) associated with the different groups is (are) either known from the prior art at hand or is (are) different from each other, then the finding of step (ii) that there exists a lack of unity is confirmed.

3.1 Non-unity and prior art under Art. 54(3)

Documents cited under Art. 54(3) should be disregarded in the evaluation of unity of invention since they cannot anticipate the inventive concept of the application under examination.

3.2 Grouping of inventions

As a general rule, after the initial identification of subject-matter lacking unity, the claims and alternatives contained in claims are assigned to the identified groups of inventions. This step comprises the assessment of which of the remaining claims or alternatives in claims could potentially relate to the same technical problem. By doing so, groups of inventions are identified wherein each group of inventions relates to unitary subject-matter in view of the prior art at hand. If, in the course of grouping, the same special technical feature, which provides a contribution over the prior art, is identified in two groups of inventions, both groups of inventions need to be combined into one single group. Conversely, if, within one initial single group of inventions, claims or alternatives in claims are identified that are not linked by a potentially special technical feature, which provides a contribution over the prior art at hand, they will normally be separated into different groups of inventions. See also F-V, 3(iii) for analysing features in their context rather than in isolation. The initial grouping of claims and alternatives in claims into different inventions may require re-evaluation during the course of assessment of unity of invention.

Typically, different groups of inventions are based on different independent claims of the same category, on alternatives defined in one independent claim (see F-V, 3.2.1) or on dependent claims defining alternative embodiments, provided that the independent claim is either not novel or not inventive. However, different groups of inventions may also be based on independent claims in different categories if lack of unity is present between these claims.

3.2.1 Plurality of independent claims in the same category

Rule 43(2)

Rule 43(2) defines in sub-paragraphs (a), (b) and (c) the situations where, without prejudice to the requirements of Art. 82, an application is allowed to comprise a plurality of independent claims in the same category (see F-IV, 3.2 and 3.3). The express reference to Art. 82 in Rule 43(2) makes clear that the requirement for unity of invention must still be met. Where the application both lacks unity of invention and fails to comply with the requirements of Rule 43(2), it is at the discretion of the division to raise an objection under Rule 43(2) or Art. 82, or both.

A plurality of inventions in the same category may constitute a group of inventions so linked as to form a single general inventive concept. Examples of inventions in the same category are alternative forms of an invention or interrelated inventions.

Rule 44(2)

Alternative forms of an invention may be claimed either in a plurality of independent claims or in a single independent claim (see also F-IV, 3.7). In the latter case, the presence of the two alternatives as independent forms may not be immediately apparent. In either case, the same criteria are applied in deciding whether or not there is unity of invention, and lack of unity of invention may therefore also exist within a single claim.

Several independent claims in the same category directed to interrelated subject-matter may meet the requirement of unity even if it appears that the claimed subject-matter is quite different, provided that technical features making a contribution over the prior art at hand are the same or corresponding. Examples of such situations include a transmitter and the corresponding receiver or a plug and the corresponding socket (see also F-IV, 3.2).

Thus, special technical features relating to the single general inventive concept must be either implicitly or explicitly present in each of the independent claims.

3.2.2 Plurality of independent claims in different categories

A plurality of independent claims in different categories (see F-IV, 3.1) may constitute a group of inventions so linked as to form a single general inventive concept as defined in Rule 44(2).

However, it is essential that a single general inventive concept link the claims in the various categories. The presence in each claim of expressions such as "specially adapted" or "specifically designed" does not necessarily imply that a single general inventive concept is present.

3.2.3 Dependent claims

A dependent claim and the higher-ranking claim on which it depends cannot be grouped into two different groups of inventions (see F-V, 2.1).

If, however, the higher-ranking claim appears not to be patentable, then the question of whether there is still an inventive link between all the claims dependent on that higher-ranking claim needs to be carefully considered.

In this context it is important to verify that a claim that is drafted as a dependent claim is in fact a true dependent claim comprising all the features of the corresponding independent claim, see F-IV 3.7. For a definition of a dependent claim, see F-IV, 3.4 and 3.8.

3.2.4 Common dependent claims

While an independent claim is always part of the common matter among its dependent claims, the opposite is not true: a claim dependent on several independent claims is never part of the common matter between these independent claims.

Example 1

An application contains three independent claims, A, B and C, and several claims combining the content of the independent claims, i.e. claims A+B, A+C, B+C and A+B+C.

Independently of the order and the manner in which the claims are presented, the application in question contains three sets of claims:

(1) independent claim A with dependent claims A+B, A+C and A+B+C;

(2) independent claim B with dependent claims A+B, B+C and A+B+C;

(3) independent claim C with dependent claims A+C, B+C and A+B+C.

Unity or lack of unity is assessed firstly between the independent claims A, B and C: if these claims are not linked by a single general inventive concept and they do not contain any same or corresponding special technical features, a lack of unity is present. The content of any of the dependent claims, e.g. of claim A+B+C, has no bearing on this analysis. Dependent claims comprising features of two or more groups of inventions, i.e. dependent claim A+B+C in the above examples, belong to all of the two or more groups of inventions.

Example 2

An application comprises the following claims:

1. A device comprising feature A.

2. A device according to claim 1 comprising feature B.

3. A device according to any of the previous claims comprising feature C.

In this case, claim 3 defines two different embodiments. Firstly, an embodiment in which claim 3 depends only on claim 1 and thus comprises only the features A + C (= claim 3a) and, secondly, an embodiment in which claim 3 depends on claim 2, in which case it comprises the features A + B + C (= claim 3b).

If claim 1 (feature A) is anticipated by prior art and lack of unity exists between the feature combinations A + B (claim 2) and A + C (claim 3a) due to B and C not being same or corresponding special technical features, then claim 1 is shared by and belongs to both groups of inventions.

Claim 3b is similarly shared by both groups of inventions. Consequently, a search (or examination) restricted to the first invention must include claim 3 in as far as it depends on claim 2 (= claim 3b). The unsearched or unexamined second invention thus includes claim 3 only in as far as it depends on claim 1 directly, i.e. claim 3a.

Moreover, as outlined in F-V, 2.1, no lack of unity can be present between an independent claim and its dependent claims. For this reason alone, claim 3 must belong to both groups of inventions. Similar considerations apply to claim 1, which is shared by both groups of inventions but only to the extent that it relates to the subject-matter of the respective groups of inventions.

As a result, Group I comprises claim 1 in as far as it relates to the subject-matter of Group I and claims 2 and 3b completely, and Group II comprises claim 1 in as far as it relates to the subject-matter of Group II and claims 3a and 3b completely.

A search related to Group I will cover claim 2 entirely and claim 3 only when depending on claim 2 (= claim 3b) but will not cover claim 3 when depending directly on claim 1 (= claim 3a). Conversely, a search related to Group II will also cover claim 3 when depending directly on claim 1 (= claim 3a) but will not cover claim 2 alone.

The examiner also assesses if a further search fee should be paid for Group II (see F-V, 2.2, F-V, 3.4, B-VII, B-III, 3.8).

3.2.5 Markush grouping (alternatives in a single claim)

Where a single claim defines several (chemical or non-chemical) alternatives, e.g. it contains a so called "Markush grouping", the requirement of Rule 44(1) for same or corresponding special technical features is considered met if the alternatives are of a similar nature (see F-IV, 3.7).

When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where:

(i) all alternatives have a common property or activity, and

(ii) a common structure is present, i.e. a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognised class of chemical compounds in the art to which the invention pertains.

Thus, common matter is provided for a Markush grouping by the common property or activity of the alternatives (see (i) above) and the common structure defined by (ii) above.

A "significant structural element is shared by all of the alternatives" if the compounds share a common chemical structure that occupies a large portion of their structures, or, if the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion and this structure or portion leads to a technical contribution in view of existing prior art at hand. The structural element may be a single component or a combination of individual components linked together.

There is no need for a significant structural element to be novel in absolute terms (i.e. novel per se). Rather, the term "significant" means that in relation to the common property or activity, there must be a common part of the chemical structure that distinguishes the claimed compounds from any known compounds having the same property or activity.

In other words, the significant structural element defines the technical contribution which the claimed invention, considered as a whole, makes over the prior art at hand.

The alternatives belong to a "recognised class of chemical compounds" if there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. that each member could be substituted one for the other, with the expectation that the same intended result would be achieved.

However, if it can be shown that at least one Markush alternative is not novel, unity of invention must be reconsidered. In particular, if the structure of at least one of the compounds covered by a Markush claim is known, together with the property or technical effect under consideration, this is an indication of lack of unity of the remaining compounds (alternatives).

This is because the Markush alternatives comprise no same (c.f. common structure) or corresponding (c.f. same property or technical effect) technical features that are "special".

Claims covering different alternative nucleic acids or proteins defined by different sequences are equally considered to represent a Markush grouping and are also analysed according to the foregoing principles.

3.2.6 Claims for a known substance for a number of distinct medical uses

For the particular case of claims for a known substance for a number of distinct medical uses, see G-VI, 7.1.

3.2.7 Intermediate and final products

In the present context of intermediate and final products, the term "intermediate" is intended to mean intermediate or starting products. Such products are made available with a view to obtaining end products through a physical or chemical change in which the intermediate product loses its identity.

The requirement for the same or corresponding special technical features (Rule 44(1)) is considered to be met in the context of intermediate and final products where:

(i) the intermediate and final products have the same essential structural element, i.e. their basic chemical structures are the same or their chemical structures are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(ii) the intermediate and final products are technically interrelated, i.e. the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

An essential structural element is a chemical structure that defines the technical contribution that the claimed inventions, considered as a whole, make over the prior art. Typically, the above-mentioned conditions are met in the case of a precursor compound yielding the final product directly upon reaction.

Unity of invention may also be present between intermediate and final products of which the structures are not known – for example, as between an intermediate having a known structure and a final product with unknown structure or as between an intermediate of unknown structure and a final product of unknown structure. In such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

Different intermediate products used in different processes for the preparation of the final product may be claimed provided that they have the same essential structural element. The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new. Where different intermediates for different structural parts of the final product are claimed, unity should not be regarded as being present between the intermediates. If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products, so the two families need not be absolutely congruent.

The mere fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not prejudice unity of invention.

3.3 Reasoning for a lack of unity objection

An objection of lack of unity must consist of logically presented, technical reasoning containing the basic considerations behind the finding of lack of unity. If necessary, it must comprise considerations relating to the number and grouping of the claimed separate inventions.

3.3.1 Minimum requirements for reasoning of lack of unity

When raising a non-unity objection, the division must back it up with a minimum reasoning outlining at least the following elements:

(i) the common matter, if any, between the groups of inventions. The common matter is based on the same or corresponding technical features. It is not confined to individual features but also includes

synergistic effects being the result of a combination of features, see G-VII, 7;

(ii) the reasons why this common matter cannot provide a single general inventive concept based on the same or corresponding special technical features. This includes prior art or general knowledge or the teaching of the application itself which anticipates or renders obvious the common matter (and the general problem if applicable). If prior art is relied upon, it must be identified, indicating any relevant passages and the reasons why they are considered relevant;

(iii) the reasons why there is no technical relationship between the remaining technical features of the different groups of claims, including:

(a) an identification of any remaining technical features of the different groups and the respective claims of each group, with an explicit statement that these technical features are different;

(b) for each group, an identification, in the light of the description, of the objective technical problem(s) solved by these remaining technical features;

(c) why the problem(s) solved are either known from the prior art or are different so that the different technical features cannot be considered to be "corresponding special technical features";

(iv) in all cases, the minimum reasoning comprises a concluding statement that, because neither the same nor corresponding special technical features are present in the claims, there is no single general inventive concept and the requirements for unity of invention are not met;

(v) in special cases, point iii, parts (a) to (c), which prove that there is no technical relationship involving the same or corresponding special technical features, will be automatically covered if it is explained:

(1) why grouped alternatives of chemical compounds are not of a similar nature;

(2) in case of lack of unity between intermediate and final products, why the intermediate and final products do not have the same essential structural elements and are not technically closely interrelated;

(3) why a process is not specially adapted to the production of a product;

(4) why a product itself does not provide a single general inventive concept linking different uses as defined in the claims;

(5) why a use in itself does not provide a single general inventive concept linking the subject-matter of the claims.

3.4 Determination of the invention first mentioned in the claims

Rule 64(1)
Rule 164(1)

When lack of unity is established, the sequence of the claimed (groups of) inventions will normally start with the invention first mentioned in the claims ("first invention"); see also B-VII, 1.1 and 2.3. In other words, as a general rule the division of subject-matter follows the order of appearance of the different inventions in the claims. The content of the dependent claims will be taken into account when determining the first invention. Trivial claims relating exclusively to features that seem unimportant in the light of the invention or that are generally known in the technical field of the invention are disregarded (see B-III, 3.8 for the search phase).

However, if the filed claims do not fulfil the requirements of Rule 43(4), i.e. if the dependency of the claims is not correct, the claims will be re-ordered accordingly before assessing the fulfilment of the requirements of unity.

4. Procedure in the case of lack of unity during search

Rule 64(1)
Rule 64(2)

The search division may neither refuse the application for lack of unity nor require limitation of the claims, but must inform the applicant that, if the search report is to be drawn up to cover those inventions present other than the first mentioned, then further search fees must be paid within two months. This applies even if the search reveals prior art that renders the entire subject-matter of the first invention not novel.

When lack of unity is raised *a posteriori*, the assessment of the search division is provisional (G 2/89) and is based on the prior art at hand when the assessment is done. In view of the fact that such novelty and inventive step considerations are being made without the applicant having had an opportunity to comment, the search division will exercise restraint in this assessment and in borderline cases, will preferably refrain from considering an application as not complying with the requirement of unity of invention.

Before issuing an invitation to pay additional fees based on an *a posteriori* assessment (see B-VII, 1.2), the search division will assess the technical problem underlying a claimed group of inventions in the light of both the disclosure of the application as a whole and the relevant prior art at hand revealed by the search (see W 6/97, W 6/91).

The consideration of the requirement of unity of invention is always made with a view to giving the applicant fair treatment and the invitation to pay additional fees is made only in clear cases.

The applicant is never invited to pay an additional search fee for claimed inventions that are either not novel or do not possess an inventive step over the prior art at hand. Nevertheless, the search division may still raise an objection of lack of unity for such alleged "sub-inventions" in view of potential amendments that could be reasonably expected in the light of the description and any drawings.

However, if the inventions concern non-obvious alternatives to the disclosure of the prior art at hand or technical details of different apparatuses/methods/products that require a complete new search for an enabling disclosure, the search division may invite the applicant to pay additional fees for all the inventions.

Example:

The independent claim is directed to a new method to dope a molecule so as to enhance its ability to bind to a cellular membrane's receptor. A dependent claim claims that the molecule can be doped to bind to several different receptors of the membrane. The search reveals that the method of the independent claim, applied to one receptor listed in the dependent claim, has already been disclosed in the prior art. If the search division is of the opinion that the application of the by now known method to the alternative receptor is an invention in view of the prior art at hand, it invites the applicant to pay additional fees for all the remaining alternatives since a complete search needs to be carried out in order to try to retrieve an enabling disclosure for each of them.

4.1 Provisional opinion accompanying the partial search results

As from 1 April 2017, the EPO provides applicants with a provisional opinion on the patentability of the invention (or unitary group of inventions) first mentioned in the claims (see OJ EPO 2017, A20). This provisional opinion is sent together with the invitation to pay further/additional search fees and the partial search results. It also includes the reasons for the non-unity findings.

The provisional opinion is sent for information only. A reply addressing the points raised in the provisional opinion is not required and will not be taken into account when the extended European search report (EESR) is issued. Only the EESR requires a response under Rule 70a.

The provisional opinion accompanying the partial search results is available to the public via online file inspection.

4.2 Consequences for the applicant

There is no obligation for applicants to pay any additional fee.

However, subject-matter that has not been searched will not be examined by the examining division (G 2/92). Hence, it cannot be prosecuted in an independent claim.

If the lack of unity persists also in examination after the claims have been amended, the excision of the non-searched subject-matter from the application may be necessary (see C-III, 3.2 and F-IV, 4.3).

Non-searched subject-matter can always be prosecuted in a divisional application.

5. Procedure in the case of lack of unity during substantive examination

5.1 General principles

The final responsibility for establishing whether the application meets the requirement of unity of invention ultimately rests with the examining division (see T 631/97; see also C-III, 3.1). For Euro-PCT applications which have entered the European phase, see F-V, 7.

Whether or not the question of unity of invention has been raised by the search division, it must always be considered by the examining division. The conclusion reached may change, e.g. when further prior art becomes available at a later stage of the proceedings. When lack of unity of invention arises only during substantive examination, the examining division should raise an objection only in clear cases, particularly if substantive examination is at an advanced stage (see also H-II, 7.3).

Rule 36(1)

Whenever unity is found to be lacking, the applicants should be required to limit their claims in such a way as to overcome the objection (see C-III, 3.1 and 3.2), which means restricting them to a single searched invention (see H-II, 7.1). Excision or amendment of parts of the description may also be necessary (see C-III, 3.2). One or more divisional applications, covering matter removed to meet this objection, may be filed (see C-IX, 1), provided that the parent application is pending (A-IV, 1.1.1).

5.2 Objections to unsearched inventions

See H-II, 7.2 and 7.3.

5.3 Review of non-unity findings

The reviewing of non-unity findings and the refund of additional search fees are dealt with in C-III, 3.3.

In so far as the examining division finds that unity of invention is given, if the applicant has paid the further search fee(s) and requested a full or partial refund thereof, the examining division will order refund of the relevant further search fee(s).

6. Amended claims

Rule 137(5)

For the situation where the applicant submits new claims directed to subject-matter which has not been searched e.g. because it was only contained in the description and at the search stage it was not found to be appropriate to extend the search to this subject-matter, see H-II, 6.2 and B-III, 3.5.

7. Euro-PCT applications

7.1 International applications without supplementary search

As indicated in B-II, 4.3.1, for certain international applications entering the European phase with an international search report, no supplementary European search is carried out. The following situations may then be distinguished during substantive examination: *Art. 153(7)*

(i) If, during the international search, an objection of lack of unity has been raised and the applicant has not taken the opportunity to have the other invention(s) searched by paying additional search fees for them, but has taken the opportunity to amend the claims after receipt of the international search report (see E-IX, 3.3.1) so that they are limited to the invention searched and has indicated that examination is to be carried out on these amended claims, the examining division proceeds on the basis of these claims.

(ii) If, during the international search, an objection of lack of unity has been raised and the applicant has **neither** taken the opportunity to have the other invention(s) searched by paying additional search fees for them, **nor** amended the claims so that they are limited to the invention searched, **and** the examining division agrees with the objection of the ISA (taking into account any comments on the issue of unity submitted by the applicant in the response to the WO-ISA or IPER, see E-IX, 3.3.1), the examining division will then proceed to issue an invitation under Rule 164(2) to pay search fees for any claimed invention in the application documents for which no additional search fee has been paid to the EPO, where it has acted as the ISA. *Rule 164(2)*

(iii) If additional search fees have been paid during the international phase, the applicant may determine that the application is to proceed on the basis of any of the searched inventions, the other(s) being deleted, if the examining division agrees with the objection of the ISA. Where the applicants have not yet taken that decision, the examining division will, at the beginning of substantive examination, invite them to do so.

(iv) If the claims to be examined relate to an invention which differs from any of the originally claimed inventions, the examining division will proceed to issue an invitation under Rule 164(2) to pay search fees for any claimed invention in the application documents not covered by the international search report or supplementary international search report, if any (see C-III, 2.3).

(v) If the applicant has not paid additional search fees during the international phase and the examining division does not agree with the objection of the ISA (for example, because the applicant has convincingly argued in response to the WO-ISA or IPER, see E-IX, 3.3.1, that the requirement of unity of invention is satisfied), an additional search will be performed (see B-II, 4.2(iii)) and the examination will be carried out on all claims.

Rule 36(1)

In cases (i) to (iv), the applicant may file divisional applications for the inventions deleted to meet the objection of non-unity (see C-IX, 1 and A-IV, 1), provided that, when a divisional application is filed, the application being divided is still pending (see A-IV, 1.1.1).

7.2 International applications with supplementary search

Art. 153(7)
Rule 164(1)

For international applications entering the European phase with an international search report established by an ISA other than the EPO, a supplementary European search is carried out by the search division in the cases listed in B-II, 4.3.2. If the search division, during the supplementary European search, notes a lack of unity, B-VII, 2.3 applies.

The procedure before the examining division in such cases is described in E-IX, 4.2. In brief, the examining division will proceed with the examination of that invention (or group of inventions) covered by the supplementary European search report which has been chosen by the applicant in response to the ESOP.

7.3 International preliminary examination report (IPER)

For international applications entering the European phase with an international preliminary examination report, the examining division should carefully take into account the position taken in that IPER before deviating from it. This may be necessary where the claims have been changed, the applicant successfully refutes the objection (either of which may happen in response to the IPER, see E-IX, 3.3.1) or the interpretation of the rules regarding unity of invention was erroneous; see further F-V, 7.1 and F-V, 7.2 above.

7.4 Restricted IPER

Art. 76
Rule 164(2)

If the EPO has established an IPER on the application and the applicant wishes to obtain protection pertaining to claims which were not the subject of this IPER because they were not searched during the international phase in consequence of an objection of lack of unity, the applicant can decide to have such claims searched in response to the invitation to pay additional search fees under Rule 164(2) and choose them for further prosecution. Alternatively, the applicant can decide to file one or more divisional applications for the inventions not searched, provided that, when a divisional application is filed, the application being divided is still pending (see A-IV, 1.1.1).

Chapter VI – Priority

1. The right to priority

In this respect see also A-III, 6.

1.1 Filing date as effective date

Rule 40

According to Art. 80, a European application is accorded as its date of filing the date on which it satisfies the requirements of Rule 40, or, if filed under the PCT, the date on which it satisfies Art. 11 PCT. This date remains unchanged except in the special circumstances of late-filed drawings or parts of the description provided for in Rule 56 EPC and Art. 14(2) PCT.

The date of filing may be the only effective date of the application. It will be of importance for fixing the expiry of certain time limits (e.g. the date by which the designation of the inventor must be filed under Rule 60), for determining the state of the art relevant to the novelty or obviousness of the subject-matter of the application, and for determining, in accordance with Art. 60(2), which of two or more European applications from separate persons for the same invention is to proceed to grant.

1.2 Priority date as effective date

Art. 89

However, in many cases, a European application will claim the right of priority of the date of filing of a previous application. In such cases, it is the priority date (i.e. the date of filing of the previous application) which becomes the effective date for the purposes mentioned in the preceding paragraph.

1.3 Validly claiming priority

Art. 87(1), (2) and (5)

For a valid claim to priority, the following conditions must be satisfied:

(i) the previous application was filed in or for a state or WTO member recognised as giving rise to a priority right in accordance with the provisions of the EPC (see also A-III, 6.2);

(ii) the applicant for the European patent was the applicant, or is the successor in title to the applicant, who made the previous application (see also A-III, 6.1 and, for transfer of partial priority, F-VI, 1.5);

(iii) the European application is made during a period of twelve months from the date of filing of the previous application (subject to certain exceptions, see A-III, 6.6); and

(iv) the European application is in respect of the same invention as the invention disclosed in the previous application, which must be the "first application" (see F-VI, 1.4 and 1.4.1).

Art. 87(2) and (3)

The words "in or for" any member state of the Paris Convention or member of the WTO, referred to in A-III, 6.2, mean that priority may be claimed in respect of a previous national application, a previous European application, a previous application filed under another regional patent treaty or a previous PCT application. If the previous application was filed in or for an

EPC contracting state, this state may also be designated in the European application. The previous application may be for a patent or for the registration of a utility model or for a utility certificate. However, a priority right based on the deposit of an industrial design is not recognised (see J 15/80). So long as the contents of the application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the outcome of the application may be; for example, it may subsequently be abandoned or refused (see A-III, 6.2).

Art. 87(1) The expression "the same invention" in Art. 87(1) means that the subject-matter of a claim in a European application may enjoy the priority of a previous application only if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole. This means that the specific combination of features present in the claim must at least implicitly be disclosed in the previous application (see F-VI, 2.2 and G 2/98).

1.4 First application

Art. 87(1) The filing date of the "first application" must be claimed as a priority, i.e. the application disclosing for the first time any or all of the subject-matter of the European application. If it is found that the application to which the priority claim is directed is in fact not the first application in this sense, but some or all of the subject-matter was disclosed in a still earlier application filed by the same applicant or a predecessor in title, the priority claim is invalid in so far as the subject-matter was already disclosed in the still earlier application (see F-VI, 1.4.1).

To the extent the priority claim is invalid, the effective date of the European application is the date of its filing. The previously disclosed subject-matter of the European application is not novel if the still earlier application referred to above was published prior to the effective date of the European application (Art. 54(2)) or if the still earlier application is also a European application which was published on or after the effective date of the European application in question (Art. 54(3)).

1.4.1 Subsequent application considered as first application

Art. 87(4) A subsequent application for the same subject-matter and filed in or for the same state or member of the WTO is considered as the "first application" for priority purposes if, at the date this subsequent application was filed, the still earlier application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The EPO will not consider this question unless there is evidence of the existence of a still earlier application as, for example, in the case of a United States continuation-in-part application. Where it is clear that a still earlier application for the same subject-matter exists, and where the priority right is important because of intervening prior art (see F-VI, 2.1), the applicant is required to establish by evidence from an appropriate authority (normally a national patent office) that there were no rights outstanding in the still earlier application in respect of the subject-matter of the application being examined.

Examples of applications that cannot be recognised as a "first application" within the meaning of Art. 87(4) are:

(i) US applications which are a "continuation" of a previous application ("con");

(ii) US applications which are a "continuation in part" of a previous application ("cip"), in so far as the subject-matter in question was already disclosed in the original US application;

(iii) national applications claiming priority from a previous national application or national utility model.

In the case of US con or cip applications, the first sentence of the description reads as follows: "This application is a continuation in part (continuation) of Serial Number .... filed .....". The following information is found on the title page under the heading "CONTINUING DATA******": "VERIFIED THIS APPLICATION IS A CIP (or CON) OF ....." A form headed "Declaration for Patent Application" must also be attached to the end of the application (in this case the priority document), listing earlier foreign or US applications under the heading "foreign priority benefits under Title 35, United States Code, 119" or "benefit under Title 35, U.S.C., 120 of any United States application(s)".

Applications may be filed by reference to a previously filed application (see A-II, 4.1.3.1). If no priority is claimed from this previously filed application, the filing by reference itself does not generate outstanding rights according to Art. 87(4). *Rule 40(1)(c)*

For example, in the case of national applications GB1 (filed on 1 February 2002, without claiming priority) and GB2 (filed on 2 January 2008, without claiming priority), pertaining to the same subject-matter, a European application EP1 (filed on 2 January 2009) claims priority of GB2 but refers to GB1 for its content according to Rule 40(1)(c). If GB1 is withdrawn, abandoned or refused, without being open to public inspection and without having served as a basis for claiming a right of priority, the mere reference to it under Rule 40(1)(c) does not amount to an outstanding right within the meaning of Art. 87(4). Consequently, in this case the priority claim to GB2 has to be considered valid for EP1.

1.5 Multiple priorities and partial priorities

"Multiple priorities may be claimed" – i.e. a European application may claim rights of priority based on more than one previous application (G 2/98). *Art. 88(2) and (3)*

"Partial priority" refers to a situation in which only a part of the subject-matter encompassed by a generic "OR" claim is entitled to the priority date of a previous application (G 1/15).

The previous application may have been filed in or for the same or different states or members of the WTO, but in all cases the earliest application must have been filed not more than 12 months before the date of filing of the European application. Subject-matter of a European application will be

accorded the priority date of the earliest priority application which discloses it.

If, for instance, the European application describes and claims two embodiments (A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the preceding 12 months, the priority dates of both the French and German applications may be claimed for the appropriate parts of the European application; embodiment A will have the French priority date and embodiment B the German priority date as effective dates. If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have the different priority dates as effective dates.

If, on the other hand, a European application is based on one previous application disclosing a feature C and a second previous application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the European application itself. In other words, it is not permitted to "mosaic" priority documents. An exception might arise where one priority document contains a reference to the other and explicitly states that features from the two documents can be combined in a particular manner.

According to G 1/15, entitlement to partial priority may not be refused for a claim encompassing alternative subject-matter by virtue of one or more generic expressions or otherwise (generic "OR" claim) provided that said alternative subject-matter has been disclosed for the first time, directly, or at least implicitly, unambiguously and in an enabling manner in the priority document. No other substantive conditions or limitations apply in this respect.

In assessing whether subject-matter within a generic "OR" claim may enjoy partial priority, the first step is to determine the subject-matter disclosed in the priority document that is relevant, i.e. relevant in respect of prior art disclosed in the priority interval. This is to be done in accordance with the disclosure test laid down in the conclusion of G 2/98 and on the basis of explanations put forward by the applicant or patent proprietor to support the claim to priority, in order to show what the skilled person would have been able to derive from the priority document. The next step is to examine whether this subject-matter is encompassed by the claim of the application or patent claiming said priority. If the answer is yes, the claim is *de facto* conceptually divided into two parts, the first corresponding to the invention disclosed directly and unambiguously in the priority document, the second being the remaining part of the subsequent generic "OR" claim not enjoying this priority but itself giving rise to a right to priority as laid down in Art. 88(3).

For example, if the priority document discloses the use of a specific composition whereas the application claims the use of a composition defined in more generic terms, two alternative groups of subject-matters are identified as being encompassed by the claim, even if the claim does not expressly spell them out:

– alternative (a), concerning the use of a specific composition (e.g. calcium salt of the active ingredient and tribasic phosphate salt in which the cation was multivalent) and

– alternative (b), concerning the use of a composition defined in more generic terms (e.g. acid form or acceptable salt thereof as the active, inorganic salt in which the cation was multivalent, wherein active ingredient and inorganic salt were other than calcium salt of the acid and tribasic phosphate salt in combination).

Alternative (a) is the subject-matter disclosed in the priority document, not defined as such in the claim but encompassed by it. Alternative (b) is the remaining subject-matter of the claim, which was not disclosed in the priority document. In such a situation, the subject-matter of alternative (a) enjoys priority whereas that of alternative (b) does not.

The rationale of decision G 1/15 also applies in the context of deciding whether an application from which priority is claimed is the first application within the meaning of Art. 87(1). Just as a priority application and a patent claiming priority from it may partially relate to the same invention, the priority application and an earlier application filed by the same applicant may also partially relate to the same invention. In that case, the priority application would be the first application in respect of only that part of the invention which is not the same as in the earlier application (T 282/12).

Partial priority may also be transferable separately. This, however, has consequences for the remaining priority right because the assignor is left with a limited right and may no longer keep claiming that partial priority (an applicant can only claim a right which they own). The transfer agreement of the partial priority gives a respective partial priority right to the assignor and the assignee corresponding to two clearly distinct and precisely defined alternatives.

2. Determining priority dates

2.1 Examining the validity of a right to priority

As a general rule, the division does not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if prior art has to be taken into account which has been made available to the public within the meaning of Art. 54(2) on or after the priority date claimed and before the date of filing (e.g. an intermediate document, see G-IV, 3) or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of Art. 54(3), such other application claiming a priority date within that period. In such cases (i.e. cases where the art in question would be relevant if of earlier date), the division must investigate whether the priority date(s) claimed may be accorded to the appropriate parts of the application it is examining and informs the applicant of the outcome and whether, in consequence, the particular prior art under consideration, e.g. the intermediate document, or the other European application forms part of the state of the art within the meaning of Art. 54. Also, in the case of possible conflict with another European application under Art. 54(3), it may

be necessary in addition to allocate effective dates to the appropriate parts of that other application and to communicate this to the applicant analogously (see also G-IV, 3). When the division needs to consider the question of priority date, it has to bear in mind all the matters which are mentioned in F-VI, 1.3 to 1.5 above.

If in the case of a Euro-PCT application, where the EPO is acting as a designated or elected Office, the priority document is not on file, substantive examination may nevertheless be started. In such a case, without the priority document being on file, the application may even, where appropriate, be refused because the claimed subject-matter lacks novelty or inventive step, provided that the relevant state of the art is neither an intermediate document nor an Art. 54(3) application. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

If intermediate documents or Art. 54(3) applications exist and the patentability of the subject-matter claimed depends on the validity of the priority right, substantive examination cannot be finalised as long as the priority document is missing. Where the applicants have complied with Rule 17.1(a), (b) or (b-*bis*) PCT, they may not be requested to file the priority document. The proceedings have to be stayed and the applicant is informed that, since the patentability of the subject-matter claimed depends on the validity of the priority right, substantive examination cannot be finalised as long as the priority document is not on file.

2.2 The same invention

The basic test to determine whether a claim is entitled to the date of a priority document is, as far as the requirement of "the same invention" is concerned (see F-VI, 1.3(iv)), the same as the test for determining whether or not an amendment to an application satisfies the requirement of Art. 123(2) (see H-IV, 2). That is to say, for the priority date to be valid in this respect the subject-matter of the claim must be directly and unambiguously derivable from the disclosure of the invention in the priority document, also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document (see G 2/98). As an example of an implicit disclosure, a claim to an apparatus including "releasable fastening means" would be entitled to the priority date of a disclosure of that apparatus in which different embodiments of releasable fastening elements such as a nut and bolt, a spring catch and a toggle-operated latch are shown.

Art. 88(4)

It is not necessary that the subject-matter for which priority is claimed be found among any claims in the previous application. It is sufficient that the documents of the previous application taken as a whole "specifically disclose" such subject-matter. The description and any claims or drawings of the previous application are, therefore, to be considered as a whole in deciding this question, except that account is not taken of subject-matter found solely in that part of the description referring to prior art, or in an explicit disclaimer.

The requirement that the disclosure must be specific means that it is not sufficient if the subject-matter in question is merely referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. Exact literal correspondence is not required, however. It is enough that, on a reasonable assessment, there is in substance a disclosure of the same subject-matter of the claim.

A disclaimer which is allowable under Art. 123(2) (see H-V, 4.2.1 and 4.2.2) does not change the identity of the invention within the meaning of Art. 87(1). Therefore, such a disclaimer could be introduced when drafting and filing a successive European patent application, without affecting the right to priority from the first application not containing the disclaimer (see G 1/03, G 2/03 and G 2/10).

2.3 Priority claim not valid

If the tests set out in F-VI, 2.2 are not satisfied in relation to a particular previous application, then the effective date of the subject-matter of the claim in question will either be the filing date of the earliest application which does provide the required disclosure and of which the priority is validly claimed (see G 3/93) or, in the absence of such, will be the date of filing of the European application itself (or the new date of filing if the application has been re-dated under Rule 56).

2.4 Some examples of determining priority dates

Note: the dates used are merely illustrative; they do not take account of the fact that the filing offices of the EPO are closed on weekends and certain public holidays.

2.4.1 Intermediate publication of the contents of the priority application

P is the application from which priority is claimed by EP, D is the disclosure of the subject-matter of P.

1.1.90	1.5.90	1.6.90
Filing	Publication	Filing
P	D	EP

D is state of the art under Art. 54(2) if the priority claim of P is not valid.

2.4.2 Intermediate publication of another European application

P1 is the application from which priority is claimed by EP1, P2 the one from which EP2 claims priority. EP1 and EP2 are filed by different applicants.

1.2.89	1.1.90	1.2.90	1.8.90	1.1.91
Filing	Filing	Filing	Publication	Filing
P1	P2	EP1	EP1	EP2
A + B	A + B	A + B	A + B	A + B

EP1 is state of the art under Art. 54(3) if the respective priority claims of P1 and P2 are valid. This does not change if the publication of EP1 takes place

after the filing date of EP2. The publication of EP1 is state of the art under Art. 54(2) if the priority claim of P2 is not valid.

2.4.3 Multiple priorities claimed for different inventions in the application with an intermediate publication of one of the inventions

EP claims priority of P1 and P2, D is the disclosure of A+B.

1.1.90	1.2.90	1.3.90	1.6.90
Filing	Publication	Filing	Filing
P1	D	P2	EP
A + B	A + B	A + B + C	claim 1: A + B
			claim 2: A + B + C

Claim 1 has a valid priority of P1 for its subject-matter, thus publication D is not state of the art under Art. 54(2) against this claim. Claim 2 cannot benefit from the priority of P1, as it does not concern the same subject-matter. Thus publication D is state of the art under Art. 54(2) for this claim (see G 3/93). It is immaterial whether claim 2 is in the form of a dependent or an independent claim.

2.4.4 A situation in which it has to be checked whether the application from which priority is actually claimed is the "first application" within the meaning of Art. 87(1)

P1 is the earliest application of the same applicant containing the invention. EP claims the priority of the later US application P2, which is a "continuation-in-part" of P1. D is a public disclosure of A+B.

1.7.89	1.1.90	1.6.90	1.12.90
Filing	Filing	Publication	Filing
P1	P2 (cip)	D	EP
A + B	A + B	A + B	claim 1: A + B
	A + B + C		claim 2: A + B + C

The priority claim of P2 for claim 1 is not valid as P2 is not the "first application" for this subject-matter within the meaning of Art. 87(1), but P1 is, which has "left rights outstanding" in that P2 is a "continuation-in-part" thereof. Therefore Art. 87(4) does not apply and this is not altered by an abandonment, withdrawal, refusal or non-publication of P1. D is prior art pursuant to Art. 54(2) against claim 1, but not against claim 2, as the latter claim has the earlier priority of P2.

3. Claiming priority

3.1 General remarks

Art. 88(1)
Rule 52(1)
Rule 53(1) and
Rule 53(3)

An applicant who wishes to claim priority must file a declaration of priority giving particulars of the previous filing, as specified in Rule 52(1), together with a certified copy of the previous application and, if necessary for the assessment of patentability, a translation of it into one of the EPO official languages (see A-III, 6.7 and A-III, 6.8).

3.2 Declaration of priority

A declaration of priority from an earlier filing should preferably be made at the time of filing the European application, although this can be done at any time within 16 months from the earliest priority date claimed (see A-III, 6.5.1). The declaration of priority must indicate the date of the priority application, the relevant state party to the Paris Convention or member of the WTO, and the file number. *Rule 52(1) and Rule 52(2)*

A declaration of priority may be corrected within 16 months from the earliest priority date. This time limit cannot expire earlier than four months after the filing date (see A-III, 6.5.2). *Rule 52(3)*

3.3 Certified copy of the previous application (priority document)

The certified copy of the previous application, i.e. the priority document, must be filed within 16 months of the priority date (see A-III, 6.7; for Euro-PCT cases see, however, E-IX, 2.3.5), unless such a copy is already on file because it has been supplied in the context of Rule 40(3), see A-II, 4.1.3.1, or of a request pursuant to Rule 56, see A-II, 5.4.3. *Rule 53(1)*

Moreover, in accordance with Rule 53(2) and the Decision of the President of the EPO dated 9 August 2012, OJ EPO 2012, 492, the EPO will include a copy of the previous application in the file of the European patent application without charging a fee in the cases indicated in A-III, 6.7. *Rule 53(2)*

As soon as the EPO has included in the file of the European patent application a copy of the previous application, it informs the applicant accordingly.

3.4 Translation of the previous application

A translation of the previous application into one of the official languages of the EPO is required only if it is needed for determining the validity of the priority claim, where this is of relevance to the patentability of the underlying invention. The translation must be filed within the time limit set by the EPO. For more details on the procedure, see A-III, 6.8 and subsections. *Art. 88(1) Rule 53(3)*

Alternatively, under Rule 53(3), a declaration that the European patent application is a complete translation of the previous application may be submitted within that same time limit. This declaration must be unambiguous, stating that the translation is "complete" or, for example, "identical" or "literal". Declarations in diluted or modified form (stating, for example, that the translation is "practically complete" or that the contents "are essentially the same") cannot be accepted. The same applies to cases where the declaration is obviously incorrect (e.g. if several priorities are claimed for a single European application or if the European application contains more or less text than is contained in the previous application as filed). In all these cases a complete translation must be filed. Where the European application contains claims on its date of filing and the priority application did not contain claims on its filing date or contained fewer claims on its filing date than the subsequent European application, the declaration cannot be accepted. A merely different arrangement of the various elements of the application (e.g. presenting the claims before the

description, or vice versa) does not affect the validity of such a declaration. See also A-III, 6.8.6.

The translation or declaration under Rule 53(3) must also be filed in those cases where the EPO adds a copy of the previous application to the file (see the Notice from the EPO, OJ EPO 2002, 192).

Rule 56

If the applicant has already provided the EPO with a translation of the priority document as part of a request under Rule 56 (see A-II, 5.4(vi)) to base missing parts of the description or drawings on the priority application itself, then there is no need for the applicant to file the translation a second time.

The request for translation cannot be made by telephone (regardless of whether this is mentioned in the minutes). Because of the time limit and its possible legal consequences, the request must always be made in writing. In examination proceedings it may be issued alone or may accompany a communication under Art. 94(3). The translation of the priority document may become necessary only at later stages of the examination procedure, when documents are retrieved by carrying out a "topping-up" search for conflicting applications under Art. 54(3) (see C-IV, 7.1 and A-III, 6.8.2). This may also happen during opposition proceedings where the applicant was not requested to file the translation before grant and the opponent raises patentability issues which require examination of the validity of the priority.

If the required translation or declaration is not filed within the time limit, the right of priority is lost and the applicant or proprietor is informed accordingly (see A-III, 6.11). This has the effect that the intermediate document(s) will become prior art under Art. 54(2) or Art. 54(3), as applicable, and therefore relevant for the assessment of patentability (see A-III, 6.8.3). However, for reasons of legal certainty the right of priority remains effective for determining the state of the art for the purposes of Art. 54(3) (see F-VI, 2.1 and 3.5) in respect of any other European patent application. In that respect it is immaterial whether the translation or declaration has been filed, as changes taking effect after the date of publication do not affect the application of Art. 54(3).

If the required translation or declaration is filed within the time limit, ideally with accompanying observations, the extent of the validity of the priority and the co-dependent substantive issues will be examined.

3.5 Withdrawal of priority claim

Applicants may voluntarily withdraw a claimed priority at any time. If they do so before the technical preparations for publication have been completed, then the priority date is not effective and the publication is deferred until 18 months after the filing date. If it is withdrawn after the technical preparations for publication have been completed, then the application is still published 18 months after the priority date originally claimed (see A-VI, 1.1 and G-IV, 5.1.1).

3.6 Re-establishment of rights in respect of the priority period

Art. 122
Rule 136(1)

Applicants may file a request for re-establishment of rights in respect of the priority period under Art. 122 (see A-III, 6.6). Any request for re-establishment of rights in respect of the period specified in Art. 87(1) must be filed within two months of expiry of that period, according to Rule 136(1), second sentence. Where a request for re-establishment in respect of the priority period has been allowed, the examining division carefully reviews the relevance of prior-art documents cited previously in the search report or communications.

Part G

Patentability

Contents

Chapter I – Patentability

1. Patentability requirements

There are four basic requirements for patentability: *Art. 52(1)*

(i) there must be an "invention", belonging to any field of technology (see G-II);

(ii) the invention must be "susceptible of industrial application" (see G-III);

(iii) the invention must be "new" (see G-IV to VI); and

(iv) the invention must involve an "inventive step" (see G-VII).

2. Further requirements of an invention

In addition to these four requirements, an invention must fulfil the following:

(i) the invention must be such that it can be carried out by a person skilled in the art (after proper instruction by the application); this follows from Art. 83. Instances where the invention fails to satisfy this requirement are given in F-III, 3; and *Art. 83*

(ii) the invention must be of "technical character" to the extent that it must relate to a technical field (Rule 42(1)(a) – see F-II, 4.2), must be concerned with a technical problem (Rule 42(1)(c) – see F-II, 4.5) and must have technical features in terms of which the matter for which protection is sought can be defined in the claim (Rule 43(1) – see F-IV, 2.1). *Rule 42(1)(a) and (c)* *Rule 43(1)*

3. Technical progress, advantageous effect

The EPC does not require explicitly or implicitly that an invention, to be patentable, must entail some technical progress or even any useful effect. Nevertheless, an advantageous effect, if any, with respect to the state of the art should be stated in the description (Rule 42(1)(c)), as any such effect is often important in determining "inventive step" (see G-VII, 5).

Chapter II – Inventions

1. General remarks

Art. 52(2) and (3)

The EPC does not define what is meant by "invention", but Art. 52(2) contains a non-exhaustive list of "non-inventions", i.e. subject-matter which is not to be regarded as an invention within the meaning of Art. 52(1). The items on this list are all either abstract (e.g. discoveries or scientific theories) and/or non-technical (e.g. aesthetic creations or presentations of information). In contrast to this, an "invention" within the meaning of Art. 52(1) must have a technical character (see G-I, 2(ii)). It may be in any field of technology.

2. Examination practice

The question of whether there is an invention within the meaning of Art. 52(1) is separate and distinct from the questions of whether it is susceptible of industrial application, is new and involves an inventive step.

The exclusions from patentability under Art. 52(2) play a role in assessing both patent eligibility and inventive step because patent protection is reserved for inventions involving a "technical teaching", i.e. an instruction addressed to a skilled person as to how to solve a particular technical problem using particular technical means. This twofold assessment is referred to as the "two-hurdle approach" (G 1/19).

The first hurdle, also referred to as the patent eligibility hurdle, requires that the claimed subject-matter as a whole must not fall under the "non-inventions" defined in Art. 52(2) and (3). The exclusion from patentability of the subject-matters and activities referred to in Art. 52(2) is limited by Art. 52(3) to such subject-matters or activities that are claimed "as such". This limitation is a bar to a broad interpretation of the non-inventions. It implies that one technical feature is sufficient for eligibility: If the claimed subject-matter is directed to or uses technical means, it is an invention within the meaning of Art. 52(1). This assessment is made without reference to the prior art.

The second hurdle is where inventive step is assessed. In addition to technical features, claims may also comprise non-technical features. In this context, the term "non-technical features" refers to features which, on their own, would be considered "non-inventions" under Art. 52(2). Inventive step of claims comprising such a mix of technical and non-technical features is assessed using the COMVIK approach (G-VII, 5.4). This approach is a special application of the problem-solution approach that involves establishing which features of the invention contribute to its technical character (i.e. contribute to the technical solution of a technical problem by providing a technical effect). A feature may support the presence of an inventive step if and to the extent that it contributes to the technical character of the invention. Whether any feature contributes to the technical character of the invention has to be assessed in the context of the invention as a whole.

3. List of exclusions

The items on the list in Art. 52(2) will now be dealt with in turn, and further examples will be given in order better to clarify the distinction between what is patentable in the sense of not being excluded from patentability under Art. 52(2) and (3) and what is not.

3.1 Discoveries

Art. 52(2)(a)

If a new property of a known material or article is found, that is mere discovery and unpatentable because discovery as such has no technical effect and is therefore not an invention within the meaning of Art. 52(1). If, however, that property is put to practical use, then this constitutes an invention which may be patentable. For example, the discovery that a particular known material is able to withstand mechanical shock would not be patentable, but a railway sleeper made from that material could well be patentable. To find a previously unrecognised substance occurring in nature is also mere discovery and therefore unpatentable. However, if a substance found in nature can be shown to produce a technical effect, it may be patentable. An example of such a case is that of a substance occurring in nature which is found to have an antibiotic effect. In addition, if a microorganism is discovered to exist in nature and to produce an antibiotic, the microorganism itself may also be patentable as one aspect of the invention. Similarly, a gene which is discovered to exist in nature may be patentable if a technical effect is revealed, e.g. its use in making a certain polypeptide or in gene therapy.

For further specific issues concerning biotechnological inventions see G-II, 5, 5.3 to 5.5, and G-III, 4.

3.2 Scientific theories

Art. 52(2)(a)

These are a more generalised form of discoveries, and the same principle as set out in G-II, 3.1 applies. For example, the physical theory of semiconductivity would not be patentable. However, new semiconductor devices and processes for manufacturing these may be patentable.

3.3 Mathematical methods

Art. 52(2)(a)

Mathematical methods play an important role in the solution of technical problems in all fields of technology. However, they are excluded from patentability under Art. 52(2)(a) when claimed as such (Art. 52(3)).

The exclusion applies if a claim is directed to a purely abstract mathematical method and the claim does not require any technical means. For instance, a method for performing a Fast Fourier Transform on **abstract data** which does not specify the use of any technical means is a mathematical method as such. A purely **abstract** mathematical object or concept, e.g. a particular type of geometric object or of graph with nodes and edges, is not a method but is nevertheless not an invention within the meaning of Art. 52(1) because it lacks a technical character.

If a claim is directed either to a method involving the use of technical means (e.g. a computer) or to a device, its subject-matter has a technical character as a whole and is thus not excluded from patentability under Art. 52(2) and (3).

Merely specifying the technical nature of the data or parameters of the mathematical method may not be sufficient on its own to define an invention within the meaning of Art. 52(1). Even if the resulting method would not be considered a purely abstract mathematical method as such within the meaning of Art. 52(2)(a) and (3), it may still fall under the excluded category of methods for performing mental acts as such if no use of technical means is implied (Art. 52(2)(c) and (3); see G-II, 3.5.1).

Once it is established that the claimed subject-matter as a whole is not excluded from patentability under Art. 52(2) and (3) and is thus an invention within the meaning of Art. 52(1), it is examined in respect of the other requirements of patentability, in particular novelty and inventive step (G-I, 1).

For the assessment of inventive step, all features which contribute to the technical character of the invention must be taken into account (G-VII, 5.4). When the claimed invention is based on a mathematical method, it is assessed whether the mathematical method contributes to the technical character of the invention.

A mathematical method may contribute to the technical character of an invention, i.e. contribute to producing a **technical effect** that serves a technical purpose, by its application to a field of technology and/or by being adapted to a specific technical implementation (T 2330/13). The criteria for assessing these two situations are explained below.

Technical applications

When assessing the contribution made by a mathematical method to the technical character of an invention, it must be taken into account whether the method, in the context of the invention, produces a technical effect serving a technical purpose.

Examples of technical contributions of a mathematical method are:

– controlling a specific technical system or process, e.g. an X-ray apparatus or a steel cooling process;

– determining from measurements a required number of passes of a compaction machine to achieve a desired material density;

– digital audio, image or video enhancement or analysis, e.g. de-noising, detecting persons in a digital image, estimating the quality of a transmitted digital audio signal;

– separation of sources in speech signals; speech recognition, e.g. mapping a speech input to a text output;

– encoding data for reliable and/or efficient transmission or storage (and corresponding decoding), e.g. error-correction coding of data for transmission over a noisy channel, compression of audio, image, video or sensor data;

– encrypting/decrypting or signing electronic communications; generating keys in an RSA cryptographic system;

– optimising load distribution in a computer network;

– determining the energy expenditure of a subject by processing data obtained from physiological sensors; deriving the body temperature of a subject from data obtained from an ear temperature detector;

– providing a genotype estimate based on an analysis of DNA samples, as well as providing a confidence interval for this estimate so as to quantify its reliability;

– providing a medical diagnosis by an automated system processing physiological measurements.

A **generic** purpose such as "controlling a technical system" is not sufficient to confer a technical character to the mathematical method. The technical purpose must be a **specific** one.

Furthermore, the mere fact that a mathematical method may serve a technical purpose is not sufficient, either. The claim is to be functionally **limited** to the technical purpose, either explicitly or implicitly. This can be achieved by establishing a sufficient link between the technical purpose and the mathematical method steps, for example, by specifying how the input and the output of the sequence of mathematical steps relate to the technical purpose so that the mathematical method is causally linked to a technical effect.

Defining the nature of the data input to a mathematical method does not necessarily imply that the mathematical method contributes to the technical character of the invention (T 2035/11, T 1029/06, T 1161/04).

If steps of a mathematical method are used to derive or predict the physical state of an existing real object from measurements of physical properties, as in the case of indirect measurements, those steps make a technical contribution regardless of what use is made of the results.

Technical implementations

A mathematical method may also contribute to the technical character of the invention independently of any technical application when the claim is directed to a **specific technical implementation** of the mathematical method and the mathematical method is particularly **adapted** for that implementation in that its design is motivated by technical considerations of the **internal functioning** of the computer system or network (T 1358/09, G 1/19). This may happen if the mathematical method is designed to exploit particular technical properties of the technical system on which it is implemented to bring about a technical effect such as efficient use of computer storage capacity or network bandwidth. For instance, the adaptation of a polynomial reduction algorithm to exploit wordsize shifts matched to the word size of the computer hardware is based on such

technical considerations and can contribute to producing the technical effect of an efficient hardware implementation of said algorithm. Another example is assigning the execution of data-intensive training steps of a machine-learning algorithm to a graphical processing unit (GPU) and preparatory steps to a standard central processing unit (CPU) to take advantage of the parallel architecture of the computing platform. The claim should be directed to the implementation of the steps on the GPU and CPU for this mathematical method to contribute to the technical character.

Computational efficiency

If the mathematical method does not serve a technical purpose and the claimed technical implementation does not go beyond a generic technical implementation, the mathematical method does not contribute to the technical character of the invention. In such a case, it is not sufficient that the mathematical method is algorithmically more efficient than prior-art mathematical methods to establish a technical effect (see also G-II, 3.6).

However, if it is established that the mathematical method produces a technical effect due to having been applied to a field of technology and/or adapted to a specific technical implementation, the computational efficiency of the steps affecting that established technical effect is to be taken into account when assessing inventive step. See G-II, 3.6.4 for examples where an improvement in computational efficiency qualifies as a technical effect.

3.3.1 Artificial intelligence and machine learning

Artificial intelligence and machine learning are based on computational models and algorithms for classification, clustering, regression and dimensionality reduction, such as neural networks, genetic algorithms, support vector machines, k-means, kernel regression and discriminant analysis. Such computational models and algorithms are per se of an abstract mathematical nature, irrespective of whether they can be "trained" based on training data. Hence, the guidance provided in G-II, 3.3 generally applies also to such computational models and algorithms.

Terms such as "support vector machine", "reasoning engine" or "neural network" may, depending on the context, merely refer to abstract models or algorithms and thus do not, on their own, necessarily imply the use of a technical means. This has to be taken into account when examining whether the claimed subject-matter has a technical character as a whole (Art. 52(1), (2) and (3)).

Artificial intelligence and machine learning find applications in various fields of technology. For example, the use of a neural network in a heart monitoring apparatus for the purpose of identifying irregular heartbeats makes a technical contribution. The classification of digital images, videos, audio or speech signals based on low-level features (e.g. edges or pixel attributes for images) are further typical technical applications of classification algorithms. Further examples of technical purposes for which artificial intelligence and machine learning could be used may be found in the list under G-II, 3.3.

Classifying text documents solely in respect of their textual content is however not regarded to be *per se* a technical purpose but a linguistic one (T 1358/09). Classifying abstract data records or even "telecommunication network data records" without any indication of a technical use being made of the resulting classification is also not *per se* a technical purpose, even if the classification algorithm may be considered to have valuable mathematical properties such as robustness (T 1784/06).

Where a classification method serves a technical purpose, the steps of generating the training set and training the classifier may also contribute to the technical character of the invention if they support achieving that technical purpose.

3.3.2 Simulation, design or modelling

Claims directed to methods of simulation, design or modelling typically comprise features which fall under the category of mathematical methods or of methods for performing mental acts. Hence, the claimed subject-matter as a whole may fall under the exclusions from patentability mentioned under Art. 52(2)(a)(c) and (3) (see G-II, 3.3 and 3.5.1).

The methods considered in this section, however, are at least partially computer-implemented so that the claimed subject-matter as a whole is not excluded from patentability.

Computer-implemented methods of simulating, designing or modelling should be examined according to the same criteria as any other computer-implemented inventions (G-VII, 5.4, G 1/19).

For establishing the presence of a technical effect, it is not decisive whether the simulated system or process is technical or whether the simulation reflects technical principles underlying the simulated system and how accurately it does so.

Simulations interacting with the external physical reality

Computer-implemented simulations that comprise features representing an interaction with an external physical reality at the level of their input or output may provide a technical effect related to this interaction. A computer-implemented simulation that uses measurements as input may form part of an indirect measurement method that calculates or predicts the physical state of an existing real object and thus make a technical contribution regardless of what use is made of the results.

Purely numerical simulations

A computer-implemented simulation without an input or output having a direct link with physical reality may still solve a technical problem. In such a "purely numerical" simulation, the underlying models and algorithms may contribute to the technical character of the invention by their adaptation to a **specific technical implementation** or by an **intended technical use** of the **data resulting from the simulation**.

Models and algorithms that do not make a contribution to the technical character of the invention form constraints that may be included in the formulation of the objective technical problem when following the COMVIK approach outlined in G-VII, 5.4.

Specific technical implementation of a numerical simulation

The technical contribution that may be made by a model or algorithm because of their adaptation to the internal functioning of the computer system or network on which they are implemented is assessed in the same manner as adaptations of mathematical methods to specific technical implementations, see G-II, 3.3.

Intended technical use of the calculated numerical output data of a numerical simulation

Calculated numerical data reflecting the physical state or behaviour of a system or process existing only as a model in a computer usually cannot contribute to the technical character of the invention, even if it reflects the behaviour of the real system or process adequately.

Calculated numerical data may have a "**potential technical effect**", which is the technical effect that would be produced when the data is used according to an intended technical use. Such a potential technical effect may **only** be relied on for the formulation of the objective technical problem if the intended technical use is either explicitly or implicitly specified in the claim.

If the data resulting from a numerical simulation is **specifically adapted** for an intended technical use, e.g. it is control data for a technical device, a potential technical effect of the data can be considered "**implied**" by the claim. The specific adaptation implies that the claim does not encompass other non-technical uses because the intended technical use is then inherent to the claimed subject-matter over substantially the whole scope of the claim (see also G-II, 3.6.3). On the other hand, if the claim also encompasses non-technical uses of the simulation results (such as gaining scientific knowledge about a technical or natural system), the potential technical effect is not achieved over substantially the whole scope of the claim and therefore cannot be relied on in the assessment of inventive step.

Accuracy

Whether a simulation contributes to the technical character of the claimed subject-matter does not depend on the quality of the underlying model or the degree to which the simulation represents reality.

However, the accuracy of a simulation is a factor that may have an influence on an already established technical effect going beyond the mere implementation of the simulation on a computer. It may be that an alleged improvement is not achieved if the simulation is not accurate enough for its intended technical use. This may be taken into account in the formulation of the objective technical problem (Art. 56) or in the assessment of sufficiency of disclosure (Art. 83), see F-III, 12. Conversely, a technical effect may still

be achieved by a method where certain simulation parameters are inaccurate but sufficient for its intended technical use.

Design processes

The aforementioned principles apply equally if a computer-implemented simulation is claimed as part of a design process.

If a computer-implemented method results merely in an abstract model of a product, system or process, e.g. a set of equations, this *per se* is not considered to be a technical effect, even if the modelled product, system or process is technical (T 49/99, T 42/09). For example, a logical data model for a family of product configurations has no inherent technical character, and a method merely specifying how to proceed to arrive at such a logical data model would not make a technical contribution beyond its computer-implementation. Likewise, a method merely specifying how to describe a multi-processor system in a graphical modelling environment does not make a technical contribution beyond its computer-implementation. Reference is made to G-II, 3.6.2 related to information modelling as an intellectual activity.

3.4 Aesthetic creations

Art. 52(2)(b)

Subject-matter relating to aesthetic creations will usually have both technical aspects, e.g. a "substrate" such as a canvas or a cloth, and aesthetic aspects, the appreciation of which is essentially subjective, e.g. the form of the image on the canvas or the pattern on the cloth. If technical aspects are present in such an aesthetic creation, it is not an aesthetic creation "as such" and it is not excluded from patentability.

A feature which might not reveal a technical aspect when taken by itself could have a technical character if it brings about a technical effect. For example, the pattern of a tyre tread may actually be a further technical feature of the tyre if, for example, it provides improved channelling of water. On the contrary, this would not be the case when a particular colour of the sidewall of the tyre serves only an aesthetic purpose.

The aesthetic effect itself is not patentable, neither in a product nor in a process claim.

For example, features relating solely to the aesthetic or artistic effect of the information content of a book, or to its layout or letter font, would not be considered as technical features. Nor would features such as the aesthetic effect of the subject of a painting or the arrangement of its colours or its artistic (e.g. Impressionist) style be technical. Nevertheless, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not of a technical character, the means of obtaining it may be. For example, a fabric may be provided with an attractive appearance by means of a layered structure not previously used for this purpose, in which case a fabric incorporating such structure might be patentable.

Similarly, a book defined by a technical feature of the binding or pasting of the back is not excluded from patentability under Art. 52(2) and (3), even though it has an aesthetic effect too. A painting defined by the kind of cloth, or by the dyes or binders used, is likewise not excluded.

A technical process, even if it is used to produce an aesthetic creation (such as a cut diamond), is nevertheless a technical process which is not excluded from patentability. Similarly, a printing technique for a book resulting in a particular layout with aesthetic effect is not excluded, and nor is the book as a product of that process. Again, a substance or composition defined by technical features serving to produce a special effect with regard to scent or flavour, e.g. to maintain a scent or flavour for a prolonged period or to accentuate it, is not excluded.

3.5 Schemes, rules and methods for performing mental acts, playing games or doing business

3.5.1 Schemes, rules and methods for performing mental acts

Art. 52(2)(c)

The exclusion from patentability of schemes, rules and methods for performing mental acts under Art. 52(2)(c) concerns instructions to the human mind on how to conduct cognitive, conceptual or intellectual processes, for instance how to learn a language. The exclusion applies only when such schemes, rules and methods are claimed as such (Art. 52(3)).

If a method claim encompasses a purely mental realisation of all method steps, it falls under the category of methods for performing mental acts as such (Art. 52(2)(c) and (3)). This applies regardless of whether the claim encompasses also technical embodiments and of whether the method is based on technical considerations (T 914/02, T 471/05, G 3/08).

An example is a claim defining a method for designing an arrangement for loading nuclear reactor fuel bundles into a reactor core in order to maximise the amount of energy that is generated before the reactor fuel needs to be refreshed. The method involves determining optimal values for specific technical parameters of the arrangement by starting with initial values, performing simulations based on these values, and iteratively changing the values based on simulation results until a stopping criterion is met. Such a method is based on technical considerations related to the technical field of nuclear reactors. However, as long as the claim does not exclude that all method steps may be carried out mentally, the claimed subject-matter is excluded from patentability. This objection also applies when the simulation involves real world values obtained by a technical measurement, if the claim does not include either a step of carrying out the technical measurement or a step of receiving the measured real world values using technical means.

In general, the complexity of a method cannot disqualify it as a method for performing mental acts as such. If technical means (e.g. a computer) are necessary to carry out the method, they are included in the claim as an essential feature (Art. 84, F-IV, 4.5). See also G-II, 3.3 for aspects related to algorithmic efficiency.

A claimed method is not a method for performing mental acts as such if it requires the use of technical means (e.g. a computer, a measuring device, etc.) to carry out at least one of its steps or if it provides a physical entity as the resulting product (e.g. if it is a method of manufacturing a product comprising steps of designing the product and a step of manufacturing the product so designed).

Once it is established that the claimed method as a whole is not excluded from patentability under Art. 52(2) and (3), it is examined in respect of the other requirements of patentability, in particular novelty and inventive step (G-I, 1).

Where a claim defining a method for performing mental acts as such is limited by specifying that the method is carried out by a computer, not only the use of a computer but also the steps carried out by the computer themselves may make a technical contribution if they then contribute to a technical effect. The presence of technical considerations, such as those related to the technical field of nuclear reactors in the example above, is not in itself sufficient to acknowledge the presence of a technical effect (G 1/19).

A method comprising steps which involve the use of technical means may also specify steps which are to be carried out mentally by the user of the method. These mental steps contribute to the technical character of the method only if, in the context of the invention, they contribute to producing a technical effect serving a technical purpose.

For example, a method may specify steps which result in the selection of a product among a family of products based on various criteria, as well as a step of manufacturing the selected product. If said selection steps are carried out mentally, they contribute to the technical character of the method only to the extent that a technical effect can be derived from the features characterising the sub-family of selected products over the generic family of suitable products (T 619/02). If the selection steps rely on purely aesthetic criteria, they result in a non-technical selection and thus do not contribute to the technical character of the method. As another example, in a method of affixing a driver to a Coriolis mass flowmeter, steps specifying how to select the position of the driver so as to maximise the performance of the flowmeter make a technical contribution to the extent that they define that particular position (T 1063/05).

For additional information about methods of simulation, design and modelling, see G-II, 3.3.2. For methods of information modelling and the activity of programming a computer, see G-II, 3.6.2.

3.5.2 Schemes, rules and methods for playing games

Art. 52(2)(c)

Under Art. 52(2)(c) and (3), schemes, rules and methods for playing games are excluded from patentability, if claimed as such. The exclusion applies to rules for traditional games such as card or board games, as well as to game rules that underlie contemporary forms of gameplay such as in gambling machines or video games.

Game rules define a conceptual framework of conventions and conditions that govern player conduct and how a game evolves in response to decisions and actions by the players. They comprise the setup of the game, options that arise as gameplay unfolds, as well as goals defining progress in the game. They are normally perceived (or even agreed to) by the players as rules serving the explicit purpose of playing the game. Game rules are hence of an abstract, purely mental nature and are meaningful only in the gaming context (T 336/07). For example, a condition requiring two randomly drawn numbers to match for winning is a game rule.

Contemporary games, and in particular video games, are often characterised by complex interactive and narrative elements of a virtual game world. Such game elements govern how the game proceeds of its own accord (e.g. evolving characters and storylines) as well as how it proceeds in interaction with the player(s) (e.g. tapping along with the game soundtrack to make your character dance if rhythms match). Given that these elements are conceptual in nature, they qualify, in a wider sense, as rules for playing games according to Art. 52(2)(c) (T 12/08). This holds true irrespective of the fact that they might be untold or revealed only while playing.

If the claimed subject-matter specifies technical means for implementing game rules, it has a technical character. For example, when implementing the aforementioned condition of matching random numbers, the use of a computer calculating a pseudo-random sequence or of mechanical means such as cubic dice or uniformly sectored reels is sufficient to overcome an objection under Art. 52(2)(c) and (3).

Inventive step of a claim comprising a mix of game rules and technical features is examined in accordance with the problem-solution approach for mixed-type inventions as set out under G-VII, 5.4. As a principle, inventive step cannot be established by the game rules themselves, irrespective of how original they may be, or by their mere automation. It must rather be based on further technical effects of a technical implementation of the game, i.e. technical effects that go beyond those already inherent to the rules. For example, a networked implementation of a game of chance like bingo, in which numbers physically drawn by an operator undergo a random mapping prior to transmission to remote players, makes a technical contribution since the scrambling of results has the technical effect of securing a data transmission, analogous to encryption, while having no bearing on the actual playing of the game. In contrast, a reduction of memory, network, or computational resources achieved by limiting the complexity of a game does not overcome a technical constraint by a technical solution. Rather than solving the technical problem of improving the efficiency of an implementation, such a limitation would at best circumvent it (G-VII, 5.4.1). Similarly, the commercial success of a game product resulting from simplified rules is an incidental effect without a direct technical cause.

Inventive step of an implementation is to be assessed from the point of view of the skilled person, typically an engineer or a game programmer, who is tasked with implementing game rules as set by a game designer.

Mere claim drafting exercises such as paraphrasing non-technical game elements ("win computation means" for monitoring the number of game tokens) or abstracting them ("objects" instead of "game tokens") using terms that are technical only on the surface have no bearing on inventive step.

Game rules often are designed to entertain and keep the interest of players by way of psychological effects such as amusement, suspense, or surprise. Such effects do not qualify as technical effects. Similarly, giving rise to a balanced, fair or otherwise rewarding gameplay are psychological effects, not technical ones. Hence, rules and corresponding computations which determine a game score or a skill rating for players, even if computationally complex, are usually considered non-technical.

Highly interactive gameplay such as in video games involves technical means for sensing user input, updating the game state and outputting visual, audio or haptic information. Features defining such presentations of information and user interfaces are assessed according to G-II, 3.7 and 3.7.1. Cognitive content that informs the player about the current game state at a non-technical level, e.g. about a game score, the arrangement and suits of playing cards, the state and attributes of a game character is regarded as non-technical information. This equally holds for instructions presented on game boards or cards such as "go back to square one". An example of a technical context in which the manner of presenting information can make a technical contribution is the interactive control of real-time manoeuvres in a game world, the display of which is subject to conflicting technical requirements (T 928/03).

Aside from rules, the state of a game world may also evolve in accordance with numerical data and equations that model physical principles or pseudo-physical behaviour, especially in video games. The systematic calculation of updates to such game states amounts to a computer-implemented simulation based on these models (G 1/19). For the purpose of assessing inventive step in this context, the models are to be understood as defining a given constraint for a corresponding implementation on a computer (G-VII, 5.4). In contrast to effects that reside within the virtual game world or are otherwise inherent to the model already, a specific implementation of a simulation, if adapted to the internal functioning of a computer system, produces a technical effect. For instance, merely predicting the virtual trajectory of a billiard ball shot by the player, even if highly accurate, fails to solve a technical problem beyond its implementation. In contrast, adjusting the step sizes used in the distributed simulation of bullets fired in a multi-player online game based on current network latencies produces a technical effect.

Features which specify how to provide user input normally make a technical contribution (G-II, 3.7.1). However, a mapping of parameters obtained from known input mechanisms to parameters of a computer game qualifies as a game rule in a wider sense if it reflects the choice of the game designer, set for the purpose of defining the game or making it more interesting or challenging (e.g. a condition specifying that a slide gesture on a touchscreen determines both the power and the spin of a virtual golf shot).

3.5.3 Schemes, rules and methods for doing business

Subject-matter or activities which are of a financial, commercial, administrative or organisational nature fall within the scope of schemes, rules and methods for doing business, which are as such excluded from patentability under Art. 52(2)(c) and (3). In the rest of this section, any such subject-matter or activities will be subsumed under the term "business method". *Art. 52(2)(c)*

Financial activities typically include banking, billing or accounting. Marketing, advertising, licensing, management of rights and contractual agreements, as well as activities involving legal considerations, are of a commercial or administrative nature. Personnel management, designing a workflow for a business process or communicating postings to a target user community based on location information are examples of organisational rules. Other activities typical of doing business concern operational research, planning, forecasting and optimisations in business environments, including logistics and scheduling of tasks. These activities involve collecting information, setting goals, and using mathematical and statistical methods to evaluate the information for the purpose of facilitating managerial decision-making.

If the claimed subject-matter specifies technical means, such as computers, computer networks or other programmable apparatus, for executing at least some steps of a business method, it is not limited to excluded subject-matter as such and thus not excluded from patentability under Art. 52(2)(c) and (3).

However, the mere possibility of using technical means is not sufficient to avoid exclusion, even if the description discloses a technical embodiment (T 388/04, T 306/04, T 619/02). Terms like "system" or "means" are to be looked at carefully, because a "system" might e.g. refer to a financial organisation and "means" to organisational units if it cannot be inferred from the context that these terms refer exclusively to technical entities (T 154/04).

Once it is established that the claimed subject-matter as a whole is not excluded from patentability under Art. 52(2) and (3), it is examined with respect to novelty and inventive step (G-I, 1). The examination of inventive step requires an assessment of which features contribute to the technical character of the invention (G-VII, 5.4).

Where the claim specifies a technical implementation of a business method, the features which contribute to the technical character of the claim are in most cases limited to those specifying the particular technical implementation.

Features which are the result of technical implementation choices and not part of the business method contribute to the technical character and thus have to be duly taken into account. This is illustrated with the following example: The claim defines a computerised networked system which allows customers to obtain audio-visual content about selected products using computers installed at each sales outlet of a company, all connected

to a central server with a central database storing the audio-visual content as electronic files. The distribution of the electronic files from the central server to the sales outlets could be technically implemented either by enabling download of individual files directly from the central database to the computer on request of a customer or, alternatively, by transferring a plurality of selected electronic files to each sales outlet, storing these files in a local database of the sales outlet and retrieving the corresponding file from the local database when audio-visual content is requested by a customer at the sales outlet. Choosing one implementation among these two options lies within the competence of a technically skilled person, such as a software engineer, as opposed to, for example, specifying that the set of audio-visual contents offered is different for each sales outlet, which would typically be within the competence of a business expert. Features of the claim specifying any of these two possible technical implementations contribute to the technical character of the invention, whereas features specifying the business method do not.

In the case of claims directed to a technical implementation of a business method, a modification to the underlying business method aimed at circumventing a technical problem, rather than addressing this problem in an inherently technical way, is not considered to make a technical contribution over the prior art. In the context of an automation of a business method, effects which are inherent in the business method do not qualify as technical effects (G-VII, 5.4.1).

For instance, an automated accounting method that avoids redundant bookkeeping may be considered to require fewer computer resources in terms of computer workload and storage requirements. These advantages, in so far as they result from a reduction of the number of operations to be performed and the amount of data to be considered due to the business specification of the accounting method, are inherent to the accounting method itself and hence do not qualify as technical effects.

Another example is based on an electronic auction that is performed by successively lowering the price until the price is fixed by the remote participant who first transmits a message. Since messages may be received out of order due to possible transmission delays, each message contains timestamp information. Changing the auction rules to obviate the need for timestamp information amounts to circumventing the technical problem of transmission delays rather than solving it with technical means (T 258/03). As a further example, in a method for carrying out electronic financial transactions with credit cards at a point of sale, the administrative decision to dispense with the need to obtain the name or address of the buyer to authorise the transaction may result in saving time and reducing data traffic. However, this measure, on its own, is not a technical solution to the technical problem of the bandwidth bottleneck of communication lines and the limited capacity of server computers, but an administrative measure which does not contribute to the technical character of the claimed subject-matter.

The mere fact that the input to a business method is real-world data is not sufficient for the business method to contribute to the technical character of

the claimed subject-matter, even if the data relate to physical parameters (e.g. geographic distances between sales outlets) (T 154/04, T 1147/05, T 1029/06). See also G-II, 3.3.

In a computer-implemented method for facilitating managerial decision-making, automatically selecting from a set of business plans the most cost-effective one which also enables meeting certain technical constraints (e.g. to achieve a targeted reduction in environmental impact) is not considered to make a technical contribution beyond the computer-implementation.

The mere possibility of serving a technical purpose is not enough for a method to contribute to the technical character of the invention. For example, a claim to a "method of resource allocation in an industrial process" encompasses pure business processes and services in finance, administration, or management, without limiting the method to any specific technical process due to the breadth of meaning of the term "industry".

The result of a business method may be useful, practical or saleable but that does not qualify as a technical effect.

Business method features, e.g. administrative features, can be found in different contexts. For example, a medical support system may be configured to deliver information to the clinician on the basis of data obtained from patient sensors, and only if such data is not available, on the basis of data provided by the patient. The prioritisation of the sensor data over the data provided by the patient is an administrative rule. Establishing it lies within the competence of an administrator, e.g. the head of the clinic, rather than within that of an engineer. As an administrative rule with no technical effect, it does not contribute to the technical character of the claimed subject-matter and may be used in the formulation of the objective technical problem as a constraint that has to be met when assessing inventive step (G-VII, 5.4). For further examples of applying the problem-solution approach to assess inventive step for subject-matter comprising business-method features, see G-VII, 5.4.2.1-5.4.2.3.

3.6 Programs for computers

Computer programs are excluded from patentability under Art. 52(2)(c) and (3) if claimed as such. However, following the generally applicable criteria for Art. 52(2) and (3) (G-II, 2), the exclusion does not apply to computer programs having a **technical character**. *Art. 52(2)(c)*

In order to have a technical character, and thus not be excluded from patentability, a computer program must produce a "**further technical effect**" when run on a computer. A "further technical effect" is a technical effect going beyond the "normal" physical interactions between the program (software) and the computer (hardware) on which it is run. The normal physical effects of the execution of a program, e.g. the circulation of electrical currents in the computer, are not in themselves sufficient to confer technical character to a computer program (T 1173/97 and G 3/08).

Examples of further technical effects which confer technical character to a computer program are the control of a technical process or of the internal functioning of the computer itself or its interfaces (see G-II, 3.6.1).

The presence of a further technical effect is assessed without reference to the prior art. It follows that the mere fact that a computer program serving a non-technical purpose requires less computing time than a prior-art program serving the same non-technical purpose does not on its own establish the presence of a further technical effect (T 1370/11). Likewise, comparing a computer program with how a human being would perform the same task is not a suitable basis for assessing if the computer program has a technical character (T 1358/09).

If a further technical effect of the computer program has already been established, the computational efficiency of an algorithm affecting the established technical effect contributes to the technical character of the invention and thus to inventive step (e.g. where the design of the algorithm is motivated by technical considerations of the internal functioning of the computer; see also G-II, 3.3).

A computer program cannot derive a technical character from the mere fact that it has been designed such that it can be automatically performed by a computer. "Further technical considerations", typically related to the technical considerations of the internal functioning of the computer, going beyond merely finding a computer algorithm to perform a task are needed. They have to be reflected in claimed features that cause a further technical effect (G 3/08).

If a claim is directed to a computer program which does not have a technical character, it is objected to under Art. 52(2)(c) and (3). If it passes the test for having technical character, the examiner then proceeds to the questions of novelty and inventive step (see G-VI and G-VII, in particular G-VII, 5.4).

Computer-implemented inventions

"Computer-implemented invention" is an expression intended to cover claims which involve computers, computer networks or other programmable apparatus wherein at least one feature is realised by means of a computer program. Claims directed to computer-implemented inventions may take the forms described in F-IV, 3.9 and subsections.

A computer program and a corresponding computer-implemented method are distinct from each other. The former refers to a sequence of computer-executable instructions specifying a method while the latter refers to a method being actually performed on a computer.

Claims directed to a computer-implemented method, a computer-readable storage medium or a device cannot be objected to under Art. 52(2) and (3) as any method involving the use of technical means (e.g. a computer) and any technical means itself (e.g. a computer or a computer-readable storage

medium) have technical character and thus represent inventions within the meaning of Art. 52(1) (T 258/03, T 424/03, G 3/08).

3.6.1 Examples of further technical effects

If a method has a technical character over and above the mere fact that it is computer-implemented, a corresponding computer program specifying that method produces a further technical effect when run on a computer. For example, a computer program which specifies a method of controlling an anti-lock braking system in a car, determining emissions by an X-ray device, compressing video, restoring a distorted digital image, or encrypting electronic communications brings about a further technical effect when it is run on a computer (see G-II, 3.3).

Furthermore, if a computer program is designed based on specific technical considerations of the internal functioning of the computer on which it is to be executed, such as by being adapted to the specific architecture of the computer, it may be considered to produce a further technical effect. For example, computer programs implementing security measures for protecting boot integrity or countermeasures against power analysis attacks have a technical character since they rely on a technical understanding of the internal functioning of the computer.

Similarly, computer programs controlling the internal functioning or operation of a computer, such as processor load balancing or memory allocation, normally produce a further technical effect (see, however, G-VII, 5.4.2.3 for an example of a case where the controlling is based on a non-technical scheme).

Programs for processing code at low level, such as builders or compilers, may well have a technical character. For example, when building runtime objects from development objects, regenerating only those runtime objects resulting from modified development objects contributes to producing the further technical effect of limiting the resources needed for a particular build.

3.6.2 Information modelling, activity of programming and programming languages

Information modelling is an intellectual activity devoid of technical character and typically carried out by a systems analyst in a first stage of software development, to provide a formal description of a real-world system or process. Consequently, specifications of a modelling language, the structure of an information modelling process (e.g. use of a template) or the maintenance of models likewise have no technical character (T 354/07). Similarly, properties inherent to information models, like re-usability, platform-independence or convenience for documentation, are not regarded as technical effects (T 1171/06).

If an information model is purposively used in the context of an invention to solve a specific technical problem by providing a technical effect, it can contribute to the technical character of the invention (see also G-II, 3.3.2 and 3.5.1).

Features specifying how the model is actually stored (e.g. using relational database technology) can also make a technical contribution.

Conceptual methods describing the process of software development (meta-methods) normally have no technical character. For example, in a computer-implemented method for generating program code for a control task, a feature specifying that a platform-independent model is converted to a platform-dependent model, from which program code adapted to the target platform is derived, makes no technical contribution in so far as the performance of the control task itself is not affected.

The **activity of programming**, in the sense of writing code, is an intellectual, non-technical activity, to the extent that it is not used in the context of a concrete application or environment to contribute in a causal manner to the production of a technical effect (G 3/08, T 1539/09).

For example, reading a data type parameter from a file as input to a computer program, rather than defining the data type in the program itself, is merely a programming option when writing code, which has *per se* no technical character. The same applies to naming conventions for object names for facilitating the intelligibility and the management of program code.

Defining and providing a **programming language** or a programming paradigm such as object-oriented programming does not *per se* solve a technical problem, even if its particular syntax and semantics enable the programmer to develop a program with greater ease. Easing the intellectual effort of the programmer is *per se* not a technical effect.

When assessing an invention relating to a **programming environment**, the features pertaining to the programming language do not normally contribute to its technical character. For example, in a visual programming environment, the provision of specific graphical building blocks is part of the programming language and makes no technical contribution if the only effect is easing the intellectual effort of the programmer. The provision of particular programming constructs may enable a programmer to write shorter programs, but that does not qualify as a technical effect since any resulting reduction of program length ultimately depends on how the programming constructs are used by a human programmer. In contrast, automatically processing machine code by dividing it into an instruction chain and an operand chain and replacing repeating instruction sets by macro-instructions so as to generate optimised code of reduced memory size makes a technical contribution. In this case, the effect does not depend on how a human programmer makes use of the macro-instructions.

Features of a programming environment that relate to its graphical user interface, e.g. visualisations and data input mechanisms, are to be assessed as indicated in G-II, 3.7 and 3.7.1.

3.6.3 Data retrieval, formats and structures

A computer-implemented data structure or data format embodied on a medium or as an electromagnetic carrier wave has technical character as a whole and thus is an invention within the meaning of Art. 52(1).

A data structure or format contributes to the technical character of the invention if it has an intended technical use and it causes a technical effect when used according to this intended technical use. Such a potential technical effect related to an implied technical use is to be taken into account in assessing inventive step (G 1/19). This may happen if the data structure or format is functional data, i.e. if it has a technical function in a technical system, such as controlling the operation of the device processing the data. Functional data inherently comprise, or map to, the corresponding technical features of the device (T 1194/97). Cognitive data, on the other hand, are those data whose content and meaning are only relevant to human users and do not contribute to producing a technical effect (see however, G-II, 3.7 for presentation of information to a user in a continued and/or guided human-machine interaction process).

For example, a record carrier for use in a picture retrieval system stores coded pictures together with a data structure defined in terms of line numbers and addresses which instruct the system how to decode and access the picture from the record carrier. This data structure is defined in terms which inherently comprise the technical features of the picture retrieval system, namely the record carrier and a reading device for retrieving pictures therefrom in which the record carrier is operative. It thus contributes to the technical character of the record carrier, whereas the cognitive content of the stored pictures (e.g. photograph of a person or landscape) does not.

Similarly, an index structure used for searching a record in a database produces a technical effect since it controls the way the computer performs the search operation (T 1351/04).

Another example is an electronic message with a header and a content section. Information in the header comprises instructions which are automatically recognised and processed by the receiving message system. This processing in turn determines how the content elements are to be assembled and presented to its final recipient. The provision of such instructions in the header contributes to the technical character of the electronic message, whereas the information in the content section, representing cognitive data, does not (T 858/02).

A data structure or a data format may have features which may not be characterised as cognitive data (i.e. not for conveying information to a user) but which nevertheless do not make a technical contribution. For example, the structure of a computer program may merely aim at facilitating the task of the programmer, which is not a technical effect serving a technical purpose. Furthermore, data models and other information models at an abstract logical level have *per se* no technical character (see G-II, 3.6.2).

Digital data is used to control devices in additive manufacturing (AM), which is the general term for technologies manufacturing physical objects by successive addition of material based on a digital representation of the geometry of the object. If the data defines the instructions for operating the AM device, it makes a technical contribution as illustrated in the following example:

Example

A computer-readable medium storing data which defines both a digital representation of the product of claim 1 and operating instructions adapted to control an AM device to fabricate the product using the digital representation of the product when said data is relayed to the AM device.

Remarks

A computer-readable medium is a technical object, so no objection under Art. 52(2) and (3) arises.

Since the data comprises both a digital description of the (physical) product of claim 1 and associated operating instructions adapted to control an AM device, it is *intended* to be used to control an AM device to fabricate the product. This technical use of the data is implied across substantially the whole scope of the claim. Construing the present claim to encompass a non-technical use of merely visualising the data would be artificial. The technical effect of fabricating the physical product defined in claim 1 that is achieved when the data is used according to its intended use is thus a potential technical effect that is to be taken into account when assessing inventive step. The digital representation of the product makes a technical contribution to the extent that it defines technical features of the fabricated physical product.

However, if such a technical use of the data were not implied by the claim, the potential technical effect of the data of fabricating the physical product could not be taken into account when assessing inventive step as it would not be implied across substantially the whole scope of the claim. This would be the case, for instance, if the data defined only a digital description or 3D model of the product that is not adapted to additive manufacturing of the product and could be used to merely visualise the product in a CAD software tool. Abstract descriptions or models are not considered technical even if the described entities are technical (see G-II, 3.3.2). In such a case, the stored non-technical data would not make a technical contribution.

3.6.4 Database management systems and information retrieval

Database management systems are technical systems implemented on computers to perform the technical tasks of storing and retrieving data using various data structures for efficient management of data. A method performed in a database management system is thus a method which uses technical means and is therefore not excluded from patentability under Art. 52(2) and Art. 52(3).

Features specifying the internal functioning of a database management system are normally based on technical considerations. Therefore, they contribute to the technical character of the invention and are taken into account for the assessment of inventive step. For instance, technical considerations are involved in improving system throughput and query response times by automatically managing data using various data stores with different technical properties such as different levels of consistency or performance (T 1924/17, T 697/17).

Database management systems execute structured queries, which formally and precisely describe the data to be retrieved. Optimising the execution of such structured queries with respect to the computer resources needed (such as CPU, main memory or hard disk) contributes to the technical character of the invention since it involves technical considerations concerning the efficient exploitation of the computer system.

However, not all features implemented in a database management system necessarily make a technical contribution by virtue of this fact alone. For example, a feature of a database management system for accounting costs related to the use of the system by different users may be regarded as not making a technical contribution.

Data structures, such as an index, hash table or a query tree, used in database management systems to facilitate access to data or for the execution of structured queries contribute to the technical character of the invention. Such data structures are functional since they purposively control the operation of the database management system to perform said technical tasks. Conversely, data structures defined solely by the cognitive information they store are not considered to contribute to the technical character of the invention beyond the mere storage of data (see also G-II, 3.6.3).

A distinction is made between executing structured queries by a database management system and information retrieval. The latter includes searching for information in a document, searching for documents themselves, and also searching for metadata that describe data such as texts, images or sounds. The query may be formulated by the user in need of information, typically informally using natural language without a precise format: the user may enter search terms as a query in web search engines to find relevant documents or submit an exemplary document to find similar documents. If the method of estimating relevance or similarity relies solely on non-technical considerations, such as the cognitive content of the items to be retrieved, purely linguistic rules or other subjective criteria (e.g. items found relevant by friends in social networks), it does not make a technical contribution.

The translation of linguistic considerations into a mathematical model with the aim of enabling the linguistic analysis to be done automatically by a computer can be seen as involving, at least implicitly, technical considerations. However, this is not enough to guarantee the technical character of the mathematical model. Further technical considerations such

as those relating to the internal functioning of the computer system are needed.

For example, a mathematical model for calculating the probability that a given term is similar in meaning to another term by analysing the co-occurrence frequency of the two terms in a collection of documents does not make a technical contribution *per se* since it is based on considerations of a purely linguistic nature (i.e. based on the assumption that terms which are related are more likely than unrelated terms to occur in the same documents). The search results produced using this method of similarity calculation would differ from prior art that adopts another mathematical model only in that information with different cognitive content would be retrieved. This is a non-technical distinction and does not qualify as a technical effect. In this context of retrieval based on similarity of meaning of terms, the concept of "better search" is subjective (T 598/14). In contrast, optimising the execution time of structured queries in a database management system as discussed above is a technical effect.

See also G-II, 3.3.1, for artificial intelligence and machine learning algorithms.

3.7 Presentations of information

Art. 52(2)(d)

Presentations of information within the meaning of Art. 52(2)(d) are understood as the conveying of information to a user. It concerns both the cognitive content of the information presented and the manner of its presentation (T 1143/06, T 1741/08). It is not limited to visual information, but also covers other presentation modalities, e.g. audio or haptic information. However, it does not extend to the technical means used for generating such presentations of information.

Furthermore, conveying information to a user is to be distinguished from technical representations of information directed to a technical system which will process, store or transmit that information. Features of data encoding schemes, data structures and electronic communication protocols which represent functional data as opposed to cognitive data are not regarded as presentations of information within the meaning of Art. 52(2)(d) (T 1194/97).

When assessing exclusion from patentability under Art. 52(2) and (3), the claimed subject-matter has to be considered as a whole (G-II, 2). In particular, a claim directed to or specifying the use of any technical means for presenting information (e.g. a computer display) has, as a whole, technical character and is thus not excluded from patentability. As another example, a claim directed to a kit comprising a product (e.g. a bleaching composition) and further features such as instructions for use of the product or reference information for evaluating the results obtained, wherein said further features have no technical effect on the product, is not excluded since the claim has a technical feature: a product comprising a composition of matter.

Once it is established that the claimed subject-matter as a whole is not excluded from patentability under Art. 52(2) and (3), it is examined in

respect of the other requirements of patentability, in particular novelty and inventive step (G-I, 1).

During the assessment of inventive step, features related to the presentation of information are analysed to determine if, in the context of the invention, they contribute to producing a technical effect serving a technical purpose. If not, they make no technical contribution and cannot support the presence of an inventive step (G-VII, 5.4). To determine whether a technical effect is produced, the examiner assesses the context of the invention, the task the user carries out and the actual purpose served by the particular presentation of information.

A feature defining a presentation of information produces a technical effect if it credibly assists the user in performing a technical task by means of a continued and/or guided human-machine interaction process (T 336/14 and T 1802/13). Such a technical effect is considered credibly achieved if the assistance to the user in performing the technical task is objectively, reliably and causally linked to the feature. This would not be the case if the alleged effect depends on subjective interests or preferences of the user. For example, for some users it is easier to understand data when it is displayed as numerical values, whereas others might prefer a colour-coded display. The choice of the one or other manner of displaying the data is thus not considered to have a technical effect (T 1567/05). Similarly, whether or not it is easier to understand audio information conveyed as a musical scale instead of spoken words is a matter concerned only with the cognitive abilities of the user. As another example, allowing the user to set parameters determining the information to be presented or to select the manner of its presentation does not make a technical contribution if it merely accommodates subjective user preferences.

Determining the extent to which a particular presentation of information may be considered to credibly support the user in performing a technical task may be difficult. It may be simplified during the assessment of inventive step by comparing the invention with the prior art, thus allowing the analysis to be limited to the distinguishing features (G-VII, 5.4, paragraph 5). This comparison may reveal that the potential support for the performance of the technical task is already achieved in the prior art, with the consequence that the distinguishing features make no technical contribution (e.g. relate only to non-technical subjective user preferences).

A feature relating to the presentation of information may commonly be considered to specify:

(i) the cognitive content of the information presented, i.e. defining "what" is presented; or

(ii) the manner in which the information is presented, i.e. defining "how" the information is presented.

This categorisation is adopted to allow for a more detailed discussion of technical effects in the rest of this section. It is noted that these categories are not meant to be exhaustive. Also, there are cases in which a feature

falls into both categories. For example, a step of "displaying the surname of a customer in capital letters" in a claimed method defines both the cognitive content of the presented information (surname of a customer) and the manner of its presentation (in capital letters). Such a feature may be considered to consist in fact of two features: the displayed text is the surname of a customer (falling into the first category) and the displayed text is shown in capital letters (falling into the second category). The manner of presentation itself might additionally convey cognitive information. For example, the capitalised part of a name may, as a matter of convention, indicate which part is the surname.

(1) What (which information) is presented?

If the cognitive content of the information presented to the user relates to an internal state prevailing in a technical system and enables the user to properly operate this technical system, it has a technical effect. An internal state prevailing in a technical system is an operating mode, a technical condition or an event which is related to the internal functioning of the system, may dynamically change and is automatically detected. Its presentation typically prompts the user to interact with the system, for example to avoid technical malfunctions (T 528/07).

Static or predetermined information about technical properties or potential states of a machine, specifications of a device or operating instructions do not qualify as an internal state prevailing in the device. If the presentation of static or predetermined information merely has the effect of helping the user with the non-technical tasks preceding the technical task, it does not make a technical contribution. For example, the effect that the user is not required to know or memorise a sequence of buttons to be operated prior to configuring a device is not a technical effect.

Non-technical information such as the state of a casino game, a business process or an abstract simulation model is exclusively aimed at the user for subjective evaluation or non-technical decision-making. It is not directly linked to a technical task. Therefore, such information does not qualify as an internal state prevailing in a technical system.

(2) How is the information presented?

A feature in this category typically specifies the form or arrangement in which, or the timing at which, information is conveyed to the user (e.g. on a screen). One example is a diagram designed solely for conveying information. Specific technical features related to, for example, the way audio signals or images are generated are not regarded as a manner in which information is presented.

Features defining a visualisation of information in a particular diagram or layout are normally not considered to make a technical contribution, even if the diagram or layout arguably conveys information in a way which a viewer may intuitively regard as particularly appealing, lucid or logical.

For instance, dealing with limited available screen space is part of designing presentations of information for human viewing and therefore not an indication of technicality *per se*. The general idea of giving an overview of a plurality of images in a limited display area by displaying a single image and sequentially replacing it with other images is not based on technical considerations, but is a matter of layout design. Similarly, arranging objects within available screen space by eliminating "white space" between window panes follows the same layout principles as would apply to the layout of a magazine cover and does not involve technical considerations.

On the other hand, if the manner of presentation credibly assists the user in performing a technical task by means of a continued and/or guided human-machine interaction process, it produces a technical effect (T 1143/06, T 1741/08, T 1802/13). For example, displaying several images side by side in low resolution and allowing selection and display of an image at higher resolution conveys information to the user in the form of a technical tool that enables the user to perform the technical task of interactively searching and retrieving stored images more efficiently. Storing digital images at different resolutions gives rise to the technical effect of allowing the simultaneous overview display of several images (T 643/00). As another example, in a video soccer game, the particular manner of conveying to the user the location of the nearest teammate by dynamically displaying a guide mark on the edge of the screen when the teammate is off-screen produces the technical effect of facilitating a continued human-machine interaction by resolving conflicting technical requirements: displaying an enlarged portion of an image and maintaining an overview of a zone of interest which is larger than the display area (T 928/03). As a further example, in the context of a visual aid for a surgeon, if, in the course of surgery, the current orientation of a medical ball joint implant is displayed in a manner which credibly assists the surgeon to correct the position of the implant in a more precise manner, this is considered to provide a technical effect.

Effects relying on human physiology

When a manner of presenting information produces in the mind of the user an effect which does not depend on psychological or other subjective factors but on physical parameters which are based on human physiology and can be precisely defined, that effect may qualify as a technical effect. The manner of presenting information then makes a technical contribution to the extent that it contributes to this technical effect. For example, displaying a notification on one of a plurality of computer screens near the user's current visual focus of attention has the technical effect that it is more or less guaranteed to be seen immediately (compared e.g. with an arbitrary placement on one of the screens). In contrast, the decision to show only urgent notifications (compared e.g. to all notifications) is based only on psychological factors and thus makes no technical contribution. Minimising information overload and distraction is not considered to qualify *per se* as a technical effect (T 862/10). As another example, displaying a stream of images in which the parameters for delay and change in the content between successive images are computed on the basis of physical

properties of human visual perception in order to achieve a smooth transition is considered to make a technical contribution (T 509/07).

If information (e.g. a visual or audio stimulus) is presented to a person for the purpose of producing in that person a physiological reaction (e.g. involuntary eye gaze) which can be measured in the context of assessing a medical condition (e.g. eyesight, hearing impairment or brain damage), that presentation of information may be considered to produce a technical effect.

Effects relying on mental activities of the user

Where the claimed subject-matter comprises a feature of presenting information to a user, be it of category (i) or (ii), an evaluation by the user is involved. Although such an evaluation *per se* is a mental act (Art. 52(2)(c)), the mere fact that mental activities are involved does not necessarily qualify subject-matter as non-technical. For example, in T 643/00 discussed above, the user makes an evaluation based on an overview of low-resolution images in order to locate and objectively recognise a desired image. This mental evaluation may be considered to be an intermediate step steering the image search and retrieval process and thus forms an integral part of a solution to a technical problem. Such a solution relies neither on facilitating the human tasks of understanding, learning, reading or memorising nor on influencing the user's decision as to which image is to be searched. It provides a mechanism for inputting a selection which would not be possible if the images were not displayed in that specific arrangement.

On the other hand, if the choice or layout of information presented aims exclusively at the human mind, in particular to help the user to take a non-technical decision (e.g. which product to buy based on a diagram showing properties of products), no technical contribution is made.

3.7.1 User interfaces

User interfaces, in particular graphical user interfaces (GUIs), comprise features of presenting information and receiving input in response as part of human-computer interaction. Features defining user input are more likely to have a technical character than those solely concerning data output and display, because input requires compatibility with the predetermined protocol of a machine, whereas output may be largely dictated by the subjective preferences of a user. Features concerning the graphic design of a menu (such as its look and feel) which are determined by aesthetic considerations, subjective user preferences or administrative rules do not contribute to the technical character of a menu-based user interface. Evaluation of features related to output of data is addressed in G-II, 3.6.3. The present section focuses on evaluating features relating to how a user can provide input.

Features which specify a mechanism enabling user input, such as entering text, making a selection or submitting a command, are normally considered to make a technical contribution. For example, providing in a GUI an alternative graphical shortcut allowing the user to directly set different

processing conditions, such as initiating a printing process and setting the number of copies to be printed by dragging and reciprocated movement of a document icon onto a printer icon, makes a technical contribution. On the other hand, supporting user input by providing information facilitating only the user's mental decision-making process during this task (e.g. helping the user in deciding what to input) is not considered as making a technical contribution (T 1741/08).

Assisting a user in entering text in a computer system by providing a predictive input mechanism is a technical function. However, generating word variants to be displayed for the predictive input mechanism is, in itself, a non-technical problem. The linguistic model used to solve this non-technical problem does not, on its own, make a technical contribution. If technical considerations are involved to implement the linguistic model on a computer, such as those relating to the internal functioning of a computer, then a technical effect may arise.

Where the actual achievement of effects like simplifying the user's actions or providing more user-convenient input functions depends exclusively on subjective user abilities or preferences, such effects may not form the basis of an objective technical problem to be solved. For example, a reduction of the number of interactions required to perform the same input is not credibly achieved if it materialises only for some usage patterns that occur depending on the user's level of expertise or subjective preferences.

Manners of providing input, such as gestures or keystrokes, that merely reflect subjective user preferences, conventions or game rules and from which a physical ergonomic advantage cannot be objectively established, do not make a technical contribution. However, performance-oriented improvements to the detection of input, such as allowing faster or more accurate gesture recognition or reducing the processing load of the device when performing recognition, do make a technical contribution.

4. Exceptions to patentability

4.1 Matter contrary to "*ordre public*" or morality

Art. 53(a)

Any invention the commercial exploitation of which would be contrary to "*ordre public*" or morality is specifically excluded from patentability. The purpose of this is to deny protection to inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour (see also F-II, 7.2). Antipersonnel mines are an obvious example. Examples in the area of biotechnological inventions as laid down in Rule 28 are listed in G-II, 5.3. G 1/03 explains that practical examples under Art. 53(a) arise from the fact that not everything can be done to human beings that can be done to other living beings. For example, the avoidance of offspring that are unwanted because of certain properties (sex, colour, health) and for economic reasons may be quite legitimate for domestic animals but when applied to human beings it would be contrary to "*ordre public*" or morality.

This provision is likely to be invoked only in rare and extreme cases. A fair test to apply is to consider whether it is probable that the public in general

would regard the invention as so abhorrent that the grant of patent rights would be inconceivable. If it is clear that this is the case, an objection is raised under Art. 53(a); otherwise not. The mere possibility of abuse of an invention is not sufficient to deny patent protection pursuant to Art. 53(a) EPC if the invention can also be exploited in a way which does not and would not infringe "*ordre public*" and morality (see T 866/01). If difficult legal questions arise in this context, then refer to C-VIII, 7.

Where it is found that the claims relate in part to such excluded subject-matter, this may have led to the issuing of a partial European or supplementary European search report under Rule 63 (see B-VIII, 1, 3.1 and 3.2). In such cases, in the absence of appropriate amendment and/or convincing arguments provided by the applicant in response to the invitation under Rule 63(1) (see B-VIII, 3.2) or to the search opinion under Rule 70a (see B-XI, 8), an objection under Rule 63(3) will also arise (see H-II, 5).

4.1.1 Prohibited matter

Art. 53(a)

Exploitation is not to be deemed to be contrary to "*ordre public*" or morality merely because it is prohibited by law or regulation in some or all of the contracting states. One reason for this is that a product could still be manufactured under a European patent for export to states in which its use is not prohibited.

4.1.2 Offensive and non-offensive use

Special attention must be paid to applications in which the invention has both an offensive and a non-offensive use, e.g. a process for breaking open locked safes, where use by a burglar is offensive and use by a locksmith in an emergency non-offensive. In such a case, no objection arises under Art. 53(a). Similarly, if a claimed invention defines a copying machine with features resulting in an improved precision of reproduction and an embodiment of this apparatus could comprise further features (not claimed but apparent to the skilled person) the only purpose of which would be that it also allows reproduction of security strips in banknotes strikingly similar to those in genuine banknotes, the claimed apparatus would cover an embodiment for producing counterfeit money which could be considered to fall under Art. 53(a). There is, however, no reason to consider the copying machine as claimed to be excluded from patentability, since its improved properties could be used for many acceptable purposes (see G 1/98, Reasons 3.3.3). However, if the application contains an explicit reference to a use which is contrary to "*ordre public*" or morality, deletion of this reference is required under the terms of Rule 48(1)(a).

4.1.3 Economic effects

The EPO has not been vested with the task of taking into account the economic effects of the grant of patents in specific areas of technology and of restricting the field of patentable subject-matter accordingly (see G 1/98 Reasons 3.9, and T 1213/05). The standard to apply for an exception under Art. 53(a) is whether the commercial exploitation of the invention is contrary to "*ordre public*" or morality.

4.2 Surgery, therapy and diagnostic methods

Art. 53(c)

European patents are not to be granted in respect of "methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body; this provision shall not apply to products, in particular substances or compositions, for use in any of these methods." Hence, patents may be obtained for surgical, therapeutic or diagnostic instruments or apparatuses for use in such methods. The manufacture of prostheses or artificial limbs could be patentable. For instance, a method of manufacturing insoles in order to correct the posture or a method of manufacturing an artificial limb is patentable. In both cases, taking the imprint of the footplate or a moulding of the stump on which an artificial limb is fitted is clearly not of a surgical nature. Furthermore, the insoles as well as the artificial limb are manufactured outside the body. However, a method of manufacturing an endoprosthesis outside the body, but requiring a surgical step to be carried out for taking measurements, would be excluded from patentability under Art. 53(c) (see T 1005/98).

The exception under Art. 53(c) does not extend to **new** products, particularly substances or compositions, for use in these methods of treatment or diagnosis.

Where a substance or composition is already known, (notional) novelty can be derived from a new medical use in accordance with Art. 54(4) and (5).

Art. 54(4)

Pursuant to Art. 54(4), a known substance or composition may still be patented for use in a method referred to in Art. 53(c) if the known substance or composition has not previously been disclosed for use for any such method ("**first medical use**"). A claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods must be in a form such as: "Substance or composition X" followed by the indication of the use, for instance "... for use as a medicament" or "... for use in therapy/in vivo diagnostics/surgery" (see G-VI, 7.1).

Art. 54(5)

Furthermore, if the known substance or composition was previously disclosed for use in surgery, therapy or diagnostic methods practised on the human or animal body, a patent may still be obtained according to Art. 54(5) for any second or further use of the substance in these methods provided that said use is novel and inventive ("**further medical use**"). A claim to a further medical use of a known substance must be in the form: "Substance or composition X" followed by the indication of the **specific** therapeutical/in vivo diagnostic/surgical use, for instance, "... for use in treating disease Y" (see G-VI, 7.1).

4.2.1 Limitations of exception under Art. 53(c)

Art. 53(c)

Exceptions under Art. 53(c) are confined to methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body. It follows that other methods of treatment of living human beings or animals (e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool) or other methods of measuring or recording characteristics of the human or animal body are patentable, provided that such methods are

of a technical and not essentially biological character (see G-II, 5.4.2). For example, an application containing claims directed to the purely cosmetic treatment of a human by administration of a chemical product is considered as being patentable (see T 144/83). A cosmetic treatment involving surgery or therapy would, however, not be patentable (see below).

To be excluded from patentability, a treatment or diagnostic method must actually be carried out on the living human or animal body. A treatment of or diagnostic method practised on a dead human or animal body would therefore not be excluded from patentability by virtue of Art. 53(c). Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon, are not excluded from patentability as long as these tissues or fluids are not returned to the same body. Thus the treatment of blood for storage in a blood bank or diagnostic testing of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body would be excluded.

Regarding methods which are carried out on or in relation to the living human or animal body, it must be borne in mind that the intention of Art. 53(c) is only to free from restraint non-commercial and non-industrial medical and veterinary activities. Interpretation of the provision must avoid the exceptions from going beyond their proper limits (see G 5/83, G 1/04, and G 1/07).

Whether or not a method is excluded from patentability under Art. 53(c) cannot depend on the person carrying it out (see G 1/04 and G 1/07, Reasons 3.4.1).

However, in contrast to the subject-matter referred to in Art. 52(2) and (3) which is only excluded from patentability if claimed as such, a method claim is not allowable under Art. 53(c) if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy. In that case, whether or not the claim includes or consists of features directed to a technical operation performed on a technical object is legally irrelevant to the application of Art. 53(c) (see G 1/07, Reasons 3.2.5).

Claims to medical devices, computer programs and storage media which comprise subject-matter corresponding to that of a method for treatment of the human or animal body by surgery or therapy or to that of a diagnostic method practised on the human or animal body are not to be objected to under Art. 53(c), because only method claims may fall under the exception of Art. 53(c).

4.2.1.1 Surgery

The meaning of the term "treatment by surgery" is not to be interpreted as being confined to surgical methods pursuing a therapeutic purpose (see G 1/07, Reasons 3.3.10). Accordingly, the term "surgery" defines the nature of the treatment rather than its purpose. Thus, for example, a method of treatment by surgery for cosmetic purposes or for embryo transfer is excluded from patentability, as well as surgical treatment for therapeutic

purposes. The term "treatments by surgery" further covers interventions performed on the structure of an organism by conservative ("closed, non-invasive") procedures such as repositioning or by operative (invasive) procedures using instruments.

Whether a claimed method is to be considered as surgical treatment falling under the exception of Art. 53(c) should be assessed on a case-by-case basis, taking the individual merits of each case into account. The reason for the exception is to allow medical and veterinary practitioners to use their skills and knowledge of the best available treatments to achieve the utmost benefit for their patients uninhibited by any worry that some treatment might be covered by a patent (see G 1/07, Reasons 3.3.6).

Thus, any definition of the term "treatment by surgery" must cover the kind of interventions which constitute the core of the medical profession's activities i.e. the kind of interventions for which their members are specifically trained and for which they assume a particular responsibility (G 1/07, Reasons 3.4.2.3).

The exclusion applies to substantial physical interventions on the body which require professional medical expertise to be carried out and which entail a substantial health risk even when carried out with the required professional care and expertise. The health risk must be associated with the mode of administration and not solely with the agent as such (G 1/07, Reasons 3.4.2.3). Examples of excluded treatments by surgery are the injection of a contrast agent into the heart, catheterisation and endoscopy.

Invasive techniques of a routine character which are performed on uncritical body parts and generally carried out in a non-medical, commercial environment are not excluded from patentability. They include e.g. tattooing, piercing, hair removal by optical radiation and micro-abrasion of the skin.

Similar considerations apply to routine interventions in the medical field. Thus, uncritical methods involving only a minor intervention and no substantial health risks, when carried out with the required care and skill, do not fall under the scope of Art. 53(c). This narrower understanding of the exclusion still protects the medical profession from the concerns indicated above. An example is a method for retraction of the sulcus of a tooth using a paste and a cap to prepare an impression of the tooth to manufacture a dental crown: the possible damage is limited to the superficial epithelium, the only risks are the superficial bleeding and inflammation which rapidly heal and the specific training needed to perform the method is minimal.

The required medical expertise and the health risk involved may however not be the only criteria which may be used to determine that a claimed method actually constitutes "treatment by surgery" within the meaning of Art. 53(c). Other criteria, such as the degree of invasiveness or the complexity of the operation performed, could also determine that a physical intervention on the human or animal body constitutes such treatment (see G 1/07, Reasons 3.4.2.4).

The exclusion under Art. 53(c) applies to multi-step methods which comprise or encompass at least one surgical step, as defined in the previous paragraph. The non-patentable subject-matter must be removed from the scope of the claim. This may be done either by means of a disclaimer or by omitting the surgical step from the wording of the claim (G 1/07, Reasons 4.2.2). For the general principles governing disclaimers, see H-V, 4. The overall patentability of the amended claim will however depend on its compliance with the other requirements of the EPC, which are assessed on a case-by-case basis.

If a surgical method claim is open to objection under Art. 53(c), this also applies to a corresponding claim directed to a computer-assisted surgical method. In other words, surgical methods for which European patents cannot be granted according to Art. 53(c) do not avoid exclusion merely through computer assistance.

Finally, when interpreting the scope of the exclusion under Art. 53(c), no distinction is to be made between human beings and animals.

4.2.1.2 Therapy

Therapy implies the curing of a disease or malfunction of the body and covers prophylactic treatment, e.g. immunisation against a certain disease (see T 19/86) or the removal of plaque (see T 290/86). It is concerned with bringing the body from a pathological state back into its normal, healthy state or preventing a pathological state. Where a method is directed to the treatment of a human or animal body that is in a normal, healthy state and, even if subject to some discomfort, not likely to develop a pathological state due to the discomfort, providing relief from the discomfort is not necessarily a therapy. For example, cooling an animal subject to hot weather conditions does not cure or lessen the symptoms of any disorder or malfunction of the animal's body, nor does it reduce the possibility of contracting any disorder or malfunction, since no such disorder or malfunction would normally occur if the animal were not cooled (T 385/09).

A method for therapeutic purposes concerning the functioning of an apparatus associated with a living human or animal body is not excluded from patentability if no functional relationship exists between the steps related to the apparatus and the therapeutic effect of the apparatus on the body (see T 245/87).

As clinical trials have a therapeutic aspect for the human subjects undergoing them, an objection under Art. 53(c) is raised if a claim includes a step relating to a method of treatment of the human body by therapy (see G-II, 4.2.2).

The exclusion under Art. 53(c) applies to multi-step methods which comprise or encompass at least one therapeutic step. The non-patentable subject-matter must be removed from the scope of the claim. This may be done either by means of a disclaimer or by omitting the step of treatment by therapy from the wording of the claim (G 1/07). For the general principles governing disclaimers, see H-V, 4. The overall patentability of the amended

claim will however depend on its compliance with the other requirements of the EPC, which are assessed on a case-by-case basis.

If a method claim directed to therapy is open to objection under Art. 53(c), this also applies to a corresponding claim directed to a computer-implemented therapeutic method (T 1680/08). In this respect, the same observations as in G-II, 4.2.1.1, for computer-implemented surgical methods apply.

4.2.1.3 Diagnostic methods

Diagnostic methods likewise do not cover all methods related to diagnosis.

To determine whether a claim is directed to a diagnostic method within the meaning of Art. 53(c) and thus excluded from patentability, it must first be established whether all of the necessary phases are included in the claim (G 1/04).

The claim must include method steps relating to **all** of the following phases:

(i) the **examination phase,** involving the collection of data,

(ii) the **comparison** of these data with standard values,

(iii) the **finding of any significant deviation**, i.e. a symptom, during the comparison,

(iv) the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary **decision phase** (diagnosis for curative purposes *stricto sensu*).

If features pertaining to any of these phases are missing and are essential for the definition of the invention, those features are to be included in the independent claim (see Example 6 in the Annex to F-IV). Due account must be taken of steps which may be considered to be implicit: for example, steps relating to the comparison of data with standard values (phase (ii)) may imply the finding of a significant deviation (phase (iii) – see T 1197/02). The deductive medical or veterinary decision phase (iv), i.e. the "diagnosis for curative purposes *stricto sensu*", is the determination of the nature of a medical or veterinary medicinal condition intended to identify or uncover a pathology; the identification of the underlying disease is not required (see T 125/02).

Additionally, a method is only regarded as a diagnostic method within the meaning of Art. 53(c), and thus excluded from patentability, if all method steps of a technical nature belonging to the preceding steps which are constitutive for making the diagnosis, i.e. phases (i)-(iii), satisfy the criterion "practised on the human or animal body". However, the steps of phases (ii) and (iii) which consist in comparing the data collected in the examination phase with standard values and in finding a significant deviation resulting from the comparison are not subject to this criterion, because these activities are predominantly of a non-technical nature and are normally not practised on the human or animal body. Therefore, in most cases only

phase (i), which relates to the examination phase and involves the collection of data, can actually be of a technical nature within the meaning of G 1/04 and therefore concerned with the criterion "practised on the human or animal body" (see T 1197/02, T 143/04, T 1016/10).

It is noted that only the steps strictly describing phases (i)-(iv) have to be taken into account in determining the diagnostic character of the claimed method. Additional, preparatory or intermediate steps which may be introduced into the claimed method are irrelevant for this question (see T 1197/02, T 143/04, T 1016/10). For example, preparatory steps which concern the adjustment or preparation of the apparatus with which the collection of data will be performed may be comprised in a method claim. However, these additional features are not part of any of phases (i)-(iii), which are constitutive for making the diagnosis. Likewise, data processing using an automated apparatus is not actually part of the examination phase which involves the collection of data, but it results from a subsequent step, intermediate between data collection and the comparison of the collected data with standard values. The issue of whether or not such additional steps are of a technical nature and practised on the human or animal body is, therefore, irrelevant for the assessment of whether a claimed method is a diagnostic method falling under the exception clause of Art. 53(c).

In order to determine whether a method step of a technical nature fulfils the criterion "practised on the human or animal body" it must be ascertained whether an interaction with the human or animal body takes place. The type or intensity of the interaction is not decisive: this criterion is fulfilled if the performance of the method step in question necessitates the presence of the body. Direct physical contact with the body is not required.

It is noted that a medical or veterinary practitioner does not have to be involved, either by being present or by bearing the overall responsibility, in the procedure.

If all of the above criteria are satisfied, then the claim defines a diagnostic method practised on the human or animal body, and an objection will be raised under Art. 53(c).

Accordingly, methods for merely obtaining information (data, physical quantities) from the living human or animal body (e.g. X-ray investigations, MRI studies, and blood pressure measurements) are not excluded from patentability under Art. 53(c).

4.2.2 Methods for screening potential medicaments and clinical trials

Art. 53(a)

Although in general a medical claim directed to tests carried out on "animals" must exclude from its scope the use of human beings as "test animals" (e.g. by means of a disclaimer), in some infrequent cases, a claim may, in the light of the description, be interpreted as exclusively relating to a clinical trial of an experimental medicament carried out on human beings. It is assumed that, unless there is evidence to the contrary, such trials are performed under strictly controlled conditions and with the informed

consent of the patient concerned. In such cases, no objection under Art. 53(a) is raised (see however G-II, 4.2.1.2).

5. Exclusions and exceptions for biotechnological inventions

5.1 General remarks and definitions

"Biotechnological inventions" are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. "Biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

Rule 26(2) and (3)

5.2 Patentable biotechnological inventions

In principle, biotechnological inventions are patentable under the EPC. For European patent applications and patents concerning biotechnological inventions, the relevant provisions of the EPC are to be applied and interpreted in accordance with the provisions of Rules 26 to 29. European Union Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions (OJ EPO 1999, 101) is to be used as a supplementary means of interpretation. In particular the recitals (abbreviated as rec.) preceding the provisions of the Directive are also to be taken into account. Judgments of the Court of Justice of the European Union on the interpretation of EU Directive 98/44/EC are not binding on the EPO. Still, they may be considered as being persuasive (T 2221/10 and T 1441/13).

Rule 27
Rule 26(1)

Biotechnological inventions are also patentable if they concern an item on the following non-exhaustive list:

(i) Biological material which is **isolated** from its natural environment or produced by means of a technical process even if it previously occurred in nature

Rule 27(a)

Hence, biological material may be considered patentable even if it already occurs in nature (see also G-II, 3.1).

Although the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions (see G-II, 5.3), an element isolated from the human body or otherwise produced by means of a technical process, which is susceptible of industrial application, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. Such an element is not *a priori* excluded from patentability since it is, for example, the result of technical processes used to identify, purify and classify it and to produce it outside the human body, techniques which human beings alone are capable of putting into practice and which nature is incapable of accomplishing itself (EU Dir. 98/44/EC, rec. 21).

Rule 29(1) and (2)

Rule 29(3)

The examination of a patent application or a patent for gene sequences or partial sequences is subject to the same criteria of patentability as in all other areas of technology (EU Dir. 98/44/EC, rec. 22). The industrial application of a sequence or partial sequence must be disclosed in the patent application as filed (see G-III, 4);

Rule 27(b)
Rule 28(2)

(ii) Plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety and if said plants or animals are not exclusively obtained by means of an essentially biological process

Inventions which concern plants or animals are patentable provided that the application of the invention is not technically confined to a single plant or animal variety (EU Dir. 98/44/EC, rec. 29). However, said plants or animals must not be exclusively obtained by means of an essentially biological process (see G-II, 5.4).

The exclusion regarding plants and animals exclusively obtained by means of an essentially biological process applies to patent applications with a filing date and/or a priority date after 1 July 2017. It does not apply to patents granted before that date or to pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, OJ EPO 2020, A119).

If a technical feature of a claimed plant or animal, e.g. a single nucleotide exchange in the genome, can be the result of both a technical intervention (e.g. directed mutagenesis) and an essentially biological process (a natural allele), a disclaimer is necessary to delimit the claimed subject-matter to the technically produced product (see examples in G-II, 5.4.2.1 and G-II, 5.4). Such a disclaimer will only be necessary for patent applications with a filing date and/or a priority date after 1 July 2017. A disclaimer will not be required for patents granted before that date or for pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, OJ EPO 2020, A119). If, on the other hand, the feature in question can be obtained by technical intervention only, e.g. a transgene, no disclaimer is necessary. For the general principles governing disclaimers, see H-V, 4.

The subject-matter of a claim covering but not identifying plant varieties is not a claim to a variety or varieties (see G 1/98, Reasons 3.8). In the absence of the identification of a specific plant variety in a product claim, the subject-matter of the claimed invention is neither limited nor directed to a variety or varieties within the meaning of Art. 53(b) (G 1/98, Reasons 3.1 and 3.10) and therefore is not excluded from patentability. More detailed instructions on the exclusions on plant varieties can be found in G-II, 5.4.1.

Rule 27(c)

(iii) A microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety.

"Microbiological process" means any process involving or performed upon or resulting in microbiological material. *Rule 26(6)*

5.3 List of exceptions (Rule 28)

In the area of biotechnological inventions, the following list of exceptions to patentability under Art. 53(a) and Art. 53(b) is laid down in Rule 28. Under Art. 53(a) the list is illustrative and non-exhaustive and is to be seen as giving concrete form to the concept of "*ordre public*" and "morality" in this technical field. A possible immoral use is only to be taken into account if it is specifically considered or at least suggested in the application and can thus be found to constitute an avowed use (G-II, 4.1 and T 866/01).

According to Rule 28(2), plants and animals exclusively obtained by means of an essentially biological process are excluded from patentability. This exclusion regarding plants and animals exclusively obtained by means of an essentially biological process applies to patent applications with a filing date and/or a priority date after 1 July 2017. It does not apply to patents granted before that date or to pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, OJ EPO 2020, A119).

Under Art. 53(a), in conjunction with Rule 28(1), European patents are not to be granted in respect of biotechnological inventions which concern: *Rule 28(1)*

(i) Processes for cloning human beings *Rule 28(1)(a)*

For the purpose of this exception, a process for the cloning of human beings may be defined as any process, including techniques of embryo splitting, designed to create a human being with the same nuclear genetic information as another living or deceased human being (EU Dir. 98/44/EC, rec. 41).

(ii) Processes for modifying the germ line genetic identity of human beings *Rule 28(1)(b)*

(iii) Uses of human embryos for industrial or commercial purposes *Rule 28(1)(c)*

A claim directed to a product which at the filing date of the application could be **exclusively** obtained by a method which necessarily involved the destruction of human embryos from which the said product is derived is excluded from patentability under Rule 28(1)(c), even if said method is not part of the claim (see G 2/06). The point in time at which such destruction takes place is irrelevant (T 2221/10).

When examining subject-matter relating to human embryonic stem cells under Art. 53(a) and Rule 28(1)(c), the following has to be taken into account:

(a) the **entire teaching** of the application, not only the claim category and wording, and

(b) the **relevant disclosure in the description** in order to establish whether products such as stem cell cultures are

obtained exclusively by the use, involving the destruction, of a human embryo or not. For this purpose, the disclosure of the description has to be considered in view of the state of the art at the date of filing.

An application pertaining to human pluripotent stem cells, including human embryonic stem cells, uses thereof or products derived therefrom cannot be regarded as excluded from patentability under Art. 53(a) and Rule 28(1)(c) (T 0385/14) if (i) the application has an effective date (i.e. a valid priority date or, if no priority is claimed or the priority is not valid, a filing date) on or after 5 June 2003, and (ii) its technical teaching can be put into practice using human embryonic stem cells derived from parthenogenetically activated human oocytes.

Foetal and post-natal human cells are in principle not excluded from patentability.

Culture media, supports and apparatuses "suitable for" use with human embryonic cells, or even "specifically designed" for this purpose, are not *per se* excluded from patentability. Their production normally does not require the use of human embryos as base material.

The exclusion of the use of human embryos for industrial or commercial purposes does not affect inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it (EU Dir. 98/44/EC, rec. 42).

Rule 28(1)(d) (iv) Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes

A claim directed to genetically modified animals or to processes for genetically modifying animals needs to meet the requirements of Rule 28(1)(d) and Art. 53(a) (see T 315/03 and T 19/90).

To fulfil the requirements of Rule 28(1)(d), the following needs to be established:

(a) that the subject-matter in question concerns a process for modifying the genetic identity of animals or animals resulting from that process,

(b) the likelihood of animal suffering,

(c) the likelihood of substantial medical benefit and

(d) the necessary correspondence between suffering and substantial medical benefit in terms of the animals claimed.

The level or standard of proof for establishing animal suffering and substantial medical benefit is likelihood. The correspondence has to be established according to the balance-of-probabilities approach (E-IV, 4.3).

For Article 53(a), a careful weighing-up of the suffering of animals and possible risks to the environment, on the one hand, and the invention's usefulness to mankind, on the other hand, are used to the extent that those two aspects are supported by evidence (see T 19/90 and T 315/03).

The substantial medical benefit referred to above includes any benefit in terms of research, prevention, diagnosis or therapy (EU Dir. 98/44/EC, rec. 45).

The above must be applied to the whole scope of the claim.

For applications relating to non-genetically modified animals, in all cases where animal suffering or possible risks to the environment is involved, the provisions of Article 53(a) have to be assessed by considering the invention's usefulness to mankind (T 1553/15).

Rule 29(1)

In addition, the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions (see, however, G-II, 5.2). Such stages in the formation or development of the human body include germ cells (EU Dir. 98/44/EC, rec. 16).

A parthenote is neither a human body at a stage of its formation and development nor one of its elements (i.e. human germ cell); thus a parthenote or cells derived therefrom are in principle not excluded from patentability under Rule 29(1).

Also excluded from patentability under Art. 53(a) are processes to produce chimeras from germ cells or totipotent cells of humans and animals (EU Dir. 98/44/EC, rec. 38).

5.4 Plant and animal varieties or essentially biological processes for the production of plants or animals

Art. 53(b)

The list of exceptions to patentability under Art. 53(b) also includes "plant or animal varieties or essentially biological processes for the production of plants or animals".

Rule 28(2)

Rule 28(2) excludes products (plants/animals and plant/animal parts) exclusively obtained by non-technical, i.e. essentially biological, processes. This exclusion regarding plants and animals exclusively obtained by means of an essentially biological process applies to patent applications with a filing date and/or a priority date after 1 July 2017. It does not apply to patents granted before that date or to pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, OJ EPO 2020, A119).

The exclusion extends to plants and animals exclusively obtained by means of an essentially biological process where no direct technical intervention in the genome of the plants or animals takes place, as the relevant parental plants or animals are merely crossed and the desired offspring is selected for. This is the case even if technical means are provided serving to enable or assist the performance of the essentially biological steps. In contrast, plants or animals produced by a technical process which modifies the genetic characteristics of the plant or animal are patentable.

The term **exclusively** is used here to mean that a plant or animal originating from a technical process or characterised by a technical intervention in the genome is not covered by the exclusion from patentability even if in addition a non-technical method (crossing and selection) is applied in its production.

Determining whether a plant or animal is obtained by exclusively biological means entails examining whether there is a change in a heritable characteristic of the claimed organism which is the result of a technical process exceeding mere crossing and selection, i.e. not merely serving to enable or assist the performance of the essentially biological process steps.

Thus transgenic plants and technically induced mutants are patentable, while the products of conventional breeding are not.

Both targeted mutation, e.g. with CRISPR/Cas, and random mutagenesis such as UV-induced mutation are such technical processes. When looking at the offspring of transgenic organisms or mutants, if the mutation or transgene is present in said offspring it is not produced exclusively by an essentially biological method and is thus patentable.

Furthermore, for living matter to be patentable, it must be possible to reproduce it in a way that has exactly the same technical features. Reproducibility can be assured for example:

(1) By a deposit of the living matter (seeds, microbiological strains). The deposited material must be publicly available and such that the invention can actually be reproduced starting from it. If, for example, a novel and inventive trait is due to a single transgene, a skilled person can reproduce the invention from a living sample. If, instead, the claimed trait is dependent on a large number of structurally undefined loci in the genome, these will segregate in subsequent generations and it will be an undue burden to reproduce the invention from the deposited sample (T 1957/14).

(2) By disclosing in the application as filed the gene sequence responsible for the claimed trait together with instructions on how to reproducibly introduce by technical means such an altered sequence in a target organism (e.g. by CRISPR-Cas).

If a technical feature of a claimed plant or animal, e.g. a single nucleotide exchange in the genome, might be the result of either a technical

intervention (e.g. directed mutagenesis) or an essentially biological process (a natural allele), a disclaimer is necessary to delimit the claimed subject-matter to the technically produced product in order to comply with the requirements of Art. 53(b) and Rule 28(2). Otherwise the subject-matter is directed to excluded subject-matter and is to be refused on the basis of Art. 53(b) in conjunction with Rule 28(2). A disclaimer is required in all cases and, in particular, even if the description only mentions a technical method of production and is silent on the use of an essentially biological process. If, on the other hand, the feature in question can unambiguously be obtained by technical intervention only, e.g. a transgene, no disclaimer is necessary.

This should apply also if such a disclaimer relates to subject-matter that was not disclosed in the application as filed. In such a case the disclaimer fulfils the requirements laid down in G 1/03, G 2/03 and G 1/16 because it is introduced to exclude subject-matter not eligible for patent protection (for the general principles governing disclaimers see also H-V, 4).

Such a disclaimer will only be necessary for patent applications with a filing date and/or a priority date after 1 July 2017. A disclaimer will not be required for patents granted before that date or for pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, OJ EPO 2020, A119).

The technicality of a claimed plant or animal product may lie in a non-heritable physical feature imparted directly to the claimed organism, e.g. a seed coated with a beneficial chemical.

The technical method of production of the plant or animal may be included in the claims, in the form of product-by-process claims (see F-IV, 4.12).

Plant products that are not propagation material, such as flour, sugars or fatty acids, have to be considered on the basis of their chemical properties only. Thus provided the general patentability requirements are fulfilled, it will not be relevant whether the subject-matter (e.g. a sugar molecule) is isolated from a product (e.g. a living plant) of an essentially biological process or is produced in a laboratory.

Examples are provided below under G-II, 5.4.2.1.

This exclusion regarding plants and animals exclusively obtained by means of an essentially biological process does not apply to patents granted before 1 July 2017 or to pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, OJ EPO 2020, A119).

For these applications and these granted patents, the exclusion from patentability of essentially biological processes for the production of plants does not have a negative effect on the allowability of a product claim directed to plants or plant material such as seeds or other plant propagation material. This applies even if the only method available at the filing date for generating the claimed plants or plant material is an essentially biological process for the production of plants, and also if the claimed product is

defined in terms of such a process (product-by-process claim, see F-IV, 4.12). In this context it is of no relevance that the protection conferred by the product claim encompasses the generation of the claimed product by means of an essentially biological process for the production of plants (see G 2/12 and G 2/13). The same principle applies *mutatis mutandis* with regard to animals produced by means of essentially biological processes (see also F-IV, 4.12).

5.4.1 Plant varieties

Rule 26(4)
Rule 27(b)
Rule 28(2)

The term "plant variety" is defined in Rule 26(4). A patent is not to be granted if the claimed subject-matter is directed to a specific plant variety or specific plant varieties. The method for the plant's production, be it by recombinant gene technology or by a classical plant breeding process, is irrelevant for considering this issue (see T 1854/07). Therefore, plant varieties containing genes introduced into an ancestral plant by recombinant gene technology are excluded from patentability (G 1/98). However, if the invention concerns plants or animals, which are not exclusively obtained by means of an essentially biological process (see G-II, 5.4, above and G 3/19), and if the technical feasibility of the invention is not confined to a particular plant or animal variety, the invention is patentable (see G-II, 5.2).

A claimed plant grouping is not excluded from patentability under Art. 53(b) if it does not meet the definition of a plant variety set out in Rule 26(4).

When a claim to a process for the production of a plant variety is examined, Art. 64(2) is not to be taken into consideration (see G 1/98). Hence, a process claim for the production of a plant variety (or plant varieties), which is not exclusively essentially biological, is not *a priori* excluded from patentability merely because the resulting product constitutes or may constitute a plant variety.

Controlled hybrids with inbred parents are excluded from patentability under Article 53(b), as they define either a seed or a plant which necessarily belongs to a particular plant grouping within the meaning of plant variety pursuant to Rule 26(4).

A claim cannot escape the exclusion of plant varieties under Article 53(b) by consisting of a large number of varieties, not even if there are hundreds of them. Only if the subject-matter of the claim comprises at least one embodiment which does not constitute a variety is the claim allowable under Art. 53(b) (see T 1208/12). For instance, a claim directed to a hybrid of a specific deposited Brassica variety with any high-yielding Brassica variety results in a Brassica hybrid variety, which is not patentable.

5.4.2 Essentially biological processes for the production of plants or animals

Rule 26(5)

A process for the production of plants or animals which is based on the sexual crossing of whole genomes and on the subsequent selection of plants or animals is excluded from patentability as being essentially biological. This applies even if the process comprises human intervention, including the provision of technical means, serving to enable or assist the

performance of the process steps or if other technical steps relating to the preparation of the plant or animal or its further treatment are present in the claim before or after the crossing and selection steps (see G 1/08 and G 2/07).

To take some examples, a method of crossing, interbreeding, or selectively breeding, say, horses involving merely selecting for breeding and bringing together those animals (or their gametes) having certain characteristics would be essentially biological and therefore excluded from patentability. Also selfing of a transgenic plant is excluded from patentability, as selfing, like crossing, is the mixing of entire genomes. These methods remain essentially biological and thus excluded from patentability even if they contain an additional feature of a technical nature, for example the use of genetic molecular markers to select either parent or progeny. Patent protection is available for any such additional technical steps *per se* which are performed either before or after the process of crossing and selection. However, such steps are ignored when determining whether or not the process as a whole is excluded from patentability under Article 53(b) EPC (see G 1/08, G 2/07).

However, if a process of sexual crossing and selection includes within it an additional step of a technical nature, which step by itself introduces a trait into the genome or modifies a trait in the genome of the plant produced, so that the introduction or modification of that trait is not the result of the mixing of the genes of the plants chosen for sexual crossing, then such a process is not excluded from patentability under Art. 53(b) but qualifies as a potentially patentable technical teaching (see G 1/08, G 2/07).

Genetic engineering techniques applied to plants which techniques differ profoundly from conventional breeding techniques as they work primarily through the purposeful insertion and/or modification of one or more genes in a plant are patentable (see T 356/93). However, in such cases the claims must not, explicitly or implicitly, include the sexual crossing and selection process.

Processes for selecting plants or animals using genetic molecular markers without crossing the plants or animals are not excluded from patentability. Technical means, such as genetic molecular markers, used in such processes are not excluded, either.

A process for producing triploid seedless melon fruit which involves the pollination of sterile female flowers of a triploid plant, unable to carry out successful meiosis, with pollen of the diploid polliniser plant and which therefore does not concern sexually crossing two whole genomes of plants (implying meiosis and fertilisation) and the subsequent selection of plants is not an essentially biological process and is hence not excluded from patentability (T 1729/06).

A process of treating a plant or animal to improve its properties or yield or to promote or suppress its growth, e.g. a method of pruning a tree, would not be an essentially biological process for the production of plants or animals since it is not based on the sexual crossing of whole genomes and

subsequent selection of plants or animals; the same applies to a method of treating a plant characterised by the application of a growth-stimulating substance or radiation. The treatment of soil by technical means to suppress or promote the growth of plants is also not excluded from patentability (see also G-II, 4.2.1).

Claims to breeding methods leaving out an explicit reference to either a crossing or selection step, but where such a step is an essential feature, lack clarity and support (Art. 84).

The abbreviation NBT stands for "new breeding techniques". This is not a technical term, but a general one which is used for a variety of methods, some clearly technical but others either comprising or consisting of essentially biological processes. Therefore it is not suitable to differentiate whether claimed subject-matter is allowable under Article 53(b) and has no relevance in terms of patentability.

5.4.2.1 Examples

The following subject-matter relates to essentially biological processes excluded from patentability:

– Method for the production of plants having trait X comprising crossing plants A and B and selecting progeny having marker X.

– Use of a (transgenic) plant for generating further plants by crossing and selection.

– Use of a (transgenic) animal for breeding.

– Introgression of a (transgenic) gene X into a plant, i.e. introducing it into the genome by crossing and selection.

– Methods for plant breeding by crossing of whole genomes and selection of plants comprising the step of embryo rescue.

The following subject-matter relates to products exclusively obtained by means of an essentially biological process excluded from patentability and having a filing date or priority date after 1 July 2017 (see G 3/19):

– A plant produced by introgression of gene A, i.e. by introducing it into the genome by crossing and selection.

– A plant produced exclusively by crossing and selection, wherein molecular markers are used to assist the selection process.

– A plant part obtained exclusively by means of an essentially biological process which is propagation material, e.g. a seed or plant embryo.

– A cultivated pepper plant expressing a mutant AHAS enzyme

The following subject-matter is not excluded from patentability under Art. 53(b):

– Method of producing a (transgenic) plant having trait X comprising introducing by transformation a vector comprising the sequence of SEQ ID NO: 1.

– Method for selecting animals having phenotype Y by screening for the presence of a marker having the sequence shown in SEQ ID NO: 1.

– Use of the nucleic acid of SEQ ID NO: 1 to select a plant having trait X.

– A mutant of a plant carrying a heritable exchange in a nucleotide sequence effected by technical means, e.g. UV mutagenesis or CRISPR/Cas with the proviso that the plant is not exclusively obtained by means of an essentially biological process (EBP).

– A transgenic plant carrying transgene X.

– Progeny of a mutant (wherein the mutant is not exclusively produced by EBP) or a transgenic plant which carries the mutation/the transgene.

– A seed of a wild-type plant covered with a chemical which inhibits fungal growth.

– Flour or oil produced from plant X (even if it is apparent from the description that said plant was exclusively obtained by means of an essentially biological method).

5.5 Microbiological processes

5.5.1 General remarks

As expressly stated in Art. 53(b), second half-sentence, the exception referred to in the first half-sentence does not apply to microbiological processes or the products thereof. *Art. 53(b)* *Rule 26(6)*

"Microbiological process" means any process involving or performed upon or resulting in microbiological material. Hence, the term "microbiological process" is to be interpreted as covering not only processes performed upon microbiological material or resulting in such, e.g. by genetic engineering, but also processes which as claimed include both microbiological and non-microbiological steps.

The product of a microbiological process may also be patentable *per se* (product claim). Propagation of the microorganism itself is to be construed as a microbiological process for the purposes of Art. 53(b). Consequently, the microorganism can be protected *per se* as it is a product obtained by a microbiological process (see G-II, 3.1). The term "microorganism" includes bacteria and other generally unicellular organisms with dimensions beneath *Rule 27(c)*

the limits of vision which can be propagated and manipulated in a laboratory (see T 356/93), including plasmids and viruses and unicellular fungi (including yeasts), algae, protozoa and, moreover, human, animal and plant cells. Isolated plant or animal cells or in vitro plant or animal cell cultures are treated as microorganisms, since cells are comparable to unicellular organisms (G 1/98, 5.2).

On the other hand, product claims for plant or animal varieties cannot be allowed even if the variety is produced by means of a microbiological process (Rule 27(c)). The exception to patentability in Art. 53(b), first half-sentence, applies to plant varieties irrespective of the way in which they are produced.

However, plant cells or tissues are usually totipotent and are able to regenerate the full plant. Therefore, even if plant cells or cell cultures may be regarded as the product of a microbiological process, plant material which is able to propagate the full plant is excluded from patentability if the plant from which the material originates has been exclusively produced by an essentially biological process (G 3/19) (for the meaning of the term "exclusively" in relation, for example, to offspring of transgenic organisms or mutants, see G-II, 5.4). Said exclusion does not apply to patents granted before 1 July 2017 nor to pending patent applications with a filing date and/or a priority date before 1 July 2017 (see G 3/19, XXIX).

5.5.2 Repeatability of results of microbiological processes

Rule 33(1)

In the case of microbiological processes, particular regard has to be had to the requirement of repeatability referred to in F-III, 3. As for biological material deposited under the terms of Rule 31, repeatability is assured by the possibility of taking samples (Rule 33(1)), and there is thus no need to indicate another process for the production of the biological material.

5.6 Antibodies

5.6.1 General remarks

Antibodies exist in a number of different formats. The most frequently used format is an immunoglobulin G (IgG), which is a large, Y-shaped protein composed of two identical light chains and two identical heavy chains, both containing variable and constant domains. Antibodies bind specifically to antigen targets via the antigen binding region which contains complementarity-determining regions (CDRs). In the case of an IgG, the antigen binding region consists of a heavy and light chain variable domain, each variable domain having three CDRs.

Other immunoglobulin structures are also known, such as heavy-chain-only antibodies that consist of only two identical heavy chains (with variable and constant domains) and the antigen-binding region consists of a single variable domain with only three CDRs.

Furthermore, knowledge of the structure-function relationships of parts of the antibody has allowed for the creation of antibody derivatives for a multitude of applications. These include antibody fragments, bispecific or multispecific antibodies and antibody fusion products.

In general, antibodies can be defined by (but are not limited to):

(a) their own structure (amino acid sequences);

(b) nucleic acid sequences encoding the antibody;

(c) reference to the target antigen;

(d) target antigen and further functional features;

(e) functional and structural features;

(f) the production process

(g) the epitope

(h) the hybridoma producing the antibody.

5.6.1.1 Definition by structure of the antibody

Since the three CDRs of each of the variable domains of the light and heavy chains of an IgG are normally responsible for binding to the antigen, the IgG, in order to be uniquely defined by its structure only and have its characteristic binding specificity, needs to be defined by the number of CDRs required for its binding to fulfil the requirements of Art. 84.

CDRs when not defined by their specific sequence must be defined according to a numbering scheme, for example, chosen from that of Kabat, Chothia or IMGT.

If an IgG is defined by fewer than the six sequences of its CDRs, the claim will be objected to under Art. 84 because it lacks an essential technical feature unless it is experimentally shown that one or more of the six CDRs do not interact with the target epitope or if it concerns a specific antibody format allowing for epitope recognition by fewer CDRs.

5.6.1.2 Definition by reference to the target antigen

An antibody can be functionally defined by the antigen it binds to, as long as the antigen is clearly defined in the claims. If the antigen is defined by a protein sequence, no sequence variability and no open language (e.g. an antigen comprising …) can be used in the definition of the antigen. Otherwise the subject-matter of the claim will be considered to lack novelty over any known antibody because existing antibodies will bind to the undefined region of the target antigen.

Examples of accepted antigen-defined antibody claim wording are:

– antibody binding to X;

– anti-X antibody;

– antibody reacting with X;

– antibody specific for antigen X or

– antibody binding to antigen X consisting of the sequence defined by SEQ. ID. NO: y.

An antibody can also be defined by its ability to bind to a well-defined antigen in combination with a negative feature as for example: "Antibody binding to antigen X and not binding to antigen Y".

5.6.1.3 Definition by target antigen and further functional features

In addition to the functional definition by the antigen it binds to, claims directed to antibodies can be further characterised by functional features defining further properties of the antibodies; for example, the binding affinity, neutralising properties, induction of apoptosis, internalisation of receptors, inhibition or activation of receptors (c.f. e.g. T 299/86, Reasons 3 - 6, and T 1300/05, Reasons 4 - 7).

If an antibody is claimed exclusively by functional features and the prior art discloses in an enabling manner an antibody directed to the same antigen using an immunisation and screening protocol that arrives at antibodies having the claimed properties, it has to be assumed that the prior-art antibody inherently displays the same functional properties as the claimed antibody, which thus lacks novelty (cf. G-VI, 6). On the other hand, if the antibody is defined by unusual parameters, care has to be taken that these do not disguise a lack of novelty (F-IV, 4.11.1). In both these cases the burden of proof of novelty resides with the applicant.

If an antibody is defined exclusively by functional properties, it has to be carefully assessed whether the application provides an enabling disclosure across the whole scope claimed and whether the functional definition allows the skilled person to clearly determine the limits of the claim.

5.6.1.4 Definition by functional and structural features

Antibodies can also be defined by both functional properties and structural features. It is possible to claim an antibody characterised by the sequences of both variable domains or CDRs with less than 100% sequence identity when combined with a clear functional feature.

5.6.1.5 Definition by production process

Antibodies can be defined by the process of their production, i.e. either by the immunisation protocol of a non-human animal with a well-characterised antigen or by the specific cell line used to produce them; for more details see F-IV, 4.12.

However, such a product-by-process definition, based on the immunisation by an antigen comprising a sequence less than 100% identical to a defined sequence does not fulfil the requirements of Art. 84 because the use of variants renders the scope of the antibodies obtained by the immunisation process unclear.

5.6.1.6 Definition by the epitope

An antibody may be defined also by its epitope, i.e. the set of specific amino acids of the antigen which are specifically recognised and bound by the antibody.

However, since an antibody defined in this way cannot be easily compared with known antibodies binding to the same antigen, the same principles as for the functional features apply (see G-II, 5.6.1.3).

If the epitope is a "linear epitope" (i.e. the antibody interacts with continuous amino acids on the antigen), it needs to be defined as a clearly limited fragment using closed wording (e.g. epitope consisting of).

If the epitope is "non-linear" or "discontinuous" (i.e. the antibody interacts with multiple, distinct segments from the primary amino-acid sequence of the antigen), the specific amino acid residues of the epitope need to be clearly identified.

The method for determining this discontinuous epitope must also be indicated in the claim and the application must provide an enabling disclosure allowing the skilled person to determine whether further antibodies bind this epitope. The application must also enable the production without undue burden of additional antibodies binding to the same epitope.

5.6.1.7 Definition by hybridoma

Antibodies may also be defined through a deposited hybridoma cell producing the antibodies. The general requirements for deposited biological materials apply, see F-III, 6.3.

5.6.2 Inventive step of antibodies

The subject-matter of a claim defining a novel, further antibody binding to a known antigen does not involve an inventive step unless a surprising technical effect is shown by the application or unless there was no reasonable expectation of success of obtaining antibodies having the required properties (see also G-VII, 13). Examples of surprising technical effects when compared to known and enabled antibodies are, for example, an improved affinity, an improved therapeutic activity, a reduced toxicity or immunogenicity, an unexpected species cross-reactivity or a new type of antibody format with proven binding activity.

If inventive step of a functionally defined antibody relies on an improved property versus the enabled antibodies of the prior art, the main characteristics of the method for determining the property must also be indicated in the claim or indicated by reference to the description (F-IV, 4.11.1).

If the surprising technical effect involves the binding affinity, the structural requirements for conventional antibodies inherently reflecting this affinity must comprise the required CDRs and the framework regions because the framework regions also can influence the affinity (T 1628/16).

If a novel antibody binds to the same antigen as known antibodies, inventive step is not acknowledged solely on the basis that the novel antibody is structurally different from the known antibodies. Arriving at alternative antibodies exclusively by applying techniques known in the art is considered to be obvious to the skilled person. The fact that the structure of the thus obtained alternative antibodies, i.e. their amino acid sequences, is not predictable is not a reason for considering these antibodies as non-obvious (see T 605/14, section 24; T 187/04, section 11).

Nevertheless, antibodies can be inventive if the application overcomes technical difficulties in generating or manufacturing the claimed antibodies.

Chapter III – Industrial application

1. General remarks

"An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture". "Industry" is understood in its broad sense as including any physical activity of "technical character" (see G-I, 2), i.e. an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog or for converting energy from one form to another. Thus, Art. 57 excludes from patentability very few "inventions" which are not already excluded by the list in Art. 52(2) (see F-II, 1). One further class of "invention" which would be excluded, however, would be articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g. a perpetual motion machine. An objection could arise under Art. 57 only in so far as the claim specifies the intended function or purpose of the invention, but if, say, a perpetual motion machine is claimed merely as an article having a particular specified construction, then an objection is made under Art. 83 (see F-III, 3).

Art. 57

2. Method of testing

Methods of testing generally are regarded as inventions susceptible of industrial application and therefore patentable if the test is applicable to the improvement or control of a product, apparatus or process which is itself susceptible of industrial application. In particular, the utilisation of test animals for test purposes in industry, e.g. for testing industrial products (for example for ascertaining the absence of pyrogenetic or allergic effects) or phenomena (for example for determining water or air pollution) would be patentable.

3. Industrial application vs. exclusion under Art. 52(2)

"Susceptibility of industrial application" is not a requirement that overrides the restriction of Art. 52(2), e.g. an administrative method of stock control is not patentable, having regard to Art. 52(2)(c), even though it could be applied to the factory storeroom for spare parts. On the other hand, although an invention must be "susceptible of industrial application" and the description must indicate, where this is not apparent, the way in which the invention is thus susceptible (see F-II, 4.9), the claims need not necessarily be restricted to the industrial application(s).

4. Sequences and partial sequences of genes

In general it is required that the description of a European patent application must, where this is not self-evident, indicate the way in which the invention is capable of exploitation in industry. The invention claimed must have such a sound and concrete technical basis that the skilled person can recognise that its contribution to the art could lead to practical exploitation in industry (see T 898/05). In relation to sequences and partial sequences of genes, this general requirement is given specific form in that the industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application. A mere nucleic acid sequence

Rule 42(1)(f)
Rule 29(3)

without indication of a function is not a patentable invention (EU Dir. 98/44/EC, rec. 23). In cases where a sequence or partial sequence of a gene is used to produce a protein or a part of a protein, it is necessary to specify which protein or part of a protein is produced and what function this protein or part of a protein performs. Alternatively, when a nucleotide sequence is not used to produce a protein or part of a protein, the function to be indicated could e.g. be that the sequence exhibits a certain transcription promoter activity.

Chapter IV – State of the art

1. General remarks and definition

An invention is "considered to be new if it does not form part of the state of the art". The "state of the art" is defined as "everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application". The width of this definition is to be noted. There are no restrictions whatever as to the geographical location where or the language or manner in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information. There are, however, certain specific exclusions (see G-V). However, since the "state of the art" available to the examiner will mainly consist of the documents listed in the search report, G-IV, 3 to 6, deals with the question of public availability only in relation to written description (either alone or in combination with an earlier oral description or use).

Art. 54(1) and (2)

The principles to be applied in determining whether other kinds of prior art (which could be introduced into the proceedings e.g. by a third party under Art. 115) have been made available to the public are set out in G-IV, 7.1 to 7.4.

For the examination of the novelty of claimed subject-matter, see G-VI.

Art. 52(1)

A written description, i.e. a document, is regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. For instance, German utility models ("Gebrauchsmuster") are already publicly available as of their date of entry in the Register of utility models ("Eintragungstag"), which precedes the date of announcement in the Patent Bulletin ("Bekanntmachung im Patentblatt"). The search report also cites documents in which doubts with regard to the fact of public availability (for "in-house state of the art", see F-II, 4.3) and doubts concerning the precise date of publication (see B-VI, 5.6 and G-IV, 7.5) of a document have not, or not fully, been removed (see B-VI, 5.6 and G-IV, 7.5).

If the applicant contests the public availability or assumed date of publication of the cited document, the examiner needs to consider whether to investigate the matter further. If the applicant shows sound reasons for doubting whether the document forms part of the "state of the art" in relation to the application and any further investigation does not produce evidence sufficient to remove that doubt, the examiner does not pursue the matter further. The only other problem likely to arise for the examiner is where:

(i) a document reproduces an oral description (e.g. a public lecture) or gives an account of a prior use (e.g. display at a public exhibition); and

(ii) only the oral description or lecture was publicly available before the "date of filing" of the European application, the document itself being published on or after this date.

In such cases, the examiner starts with the assumption that the document gives a true account of the earlier lecture, display or other event and therefore regards the earlier event as forming part of the "state of the art". If, however, the applicant gives sound reasons for contesting the truth of the account given in the document then again the examiner does not pursue the matter further.

2. Enabling disclosure

Subject-matter can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1), if the information given is sufficient to enable the skilled person, at the relevant date (see G-VI, 3) and taking into account the common general knowledge in the field at that time, to practise the technical teaching which is the subject of the disclosure (see T 26/85, T 206/83 and T 491/99).

Where a prior-art document discloses subject-matter which is relevant to the novelty and/or inventive step of the claimed invention, the disclosure of that document must be such that the skilled person can reproduce that subject-matter using common general knowledge (see G-VII, 3.1). Subject-matter does not necessarily belong to the common general knowledge simply because it has been disclosed in the state of the art: in particular, if the information can only be obtained after a comprehensive search, it cannot be considered to belong to the common general knowledge and cannot be used to complete the disclosure (see T 206/83).

For example, a document discloses a chemical compound (identified by name or by structural formula), indicating that the compound may be produced by a process defined in the document itself. The document, however, does not indicate how to obtain the starting materials and/or reagents used in the process. If the skilled person moreover cannot obtain these starting materials or reagents on the basis of common general knowledge (e.g. from text books), the document is insufficiently disclosed with respect to that compound. Hence, it is not considered to belong to the state of the art according to Art. 54(2) (at least in as far as it relates to that compound) and consequently it does not prejudice the patentability of the claimed invention.

If, on the other hand, the skilled person knows how to obtain the starting materials and reagents (e.g. they are commercially available, or are well-known and appear in reference text books), the document is sufficiently disclosed with respect to the compound and therefore belongs to the state of the art according to Art. 54(2). The examiner can then validly rely upon this document to raise objections against the claimed invention.

3. Date of filing or priority date as effective date

Art. 89

The "date of filing" in Art. 54(2) and (3) is to be interpreted as meaning the date of priority in appropriate cases (see F-VI, 1.2). Different claims, or

alternative subject-matters claimed in one claim, may have different effective dates, i.e. the date of filing or (one of) the claimed priority date(s). The question of novelty must be considered against each claim (or part of a claim). The state of the art in relation to one claim or one part of a claim may include matter, e.g. an intermediate document (see B-X, 9.2.4), which cannot be cited against another claim or another alternative subject-matter encompassed by the same claim because it has an earlier effective date.

The priority right of the application being examined or the patent being opposed may also be lost as a result of failure to provide a translation of the priority document when requested in accordance with Rule 53(3) (see A-III, 6.8 and subsections).

Of course, if all the matter in the state of the art was made available to the public before the date of the earliest priority document, the examiner need not (and must not) be concerned with the allocation of effective dates.

Rule 56

If the applicant files missing parts of the description, or drawings (see A-II, 5.1), late under Rule 56, the accorded date of the application is the date of filing of these missing elements under Rule 56(2) (see A-II, 5.3), unless they are completely contained in the priority document and the requirements given in Rule 56(3) are satisfied (see A-II, 5.4), in which case the original filing date is maintained. The date of the application as a whole is thus either the date of filing of the missing elements or the original filing date.

Rule 58

Claims filed in response to a communication under Rule 58 do not result in a change in the filing date of the application (see A-III, 15), as they are considered as amendments to the application as filed (see H-IV, 2.2.3).

4. Documents in a non-official language

If the applicant

(i) disputes the relevance of a document in a non-official language cited in the search report (for procedure at the search stage, see B-X, 9.1.2 and 9.1.3), and

(ii) gives specific reasons,

the examiner needs to consider whether, in the light of these reasons and of the other prior art available, it is justified to pursue the matter. If so, the examiner must obtain a translation of the document (or merely the relevant part of it if that can be easily identified). If, after the translation, the document remains relevant, the examiner sends a copy of the translation to the applicant with the next official communication.

The requirement to provide a translation of a document in a non-official language also applies if the applicant is proficient in the language concerned. The translation enables the boards of appeal to examine whether the examining division's decision was justified (T 655/13).

4.1 Machine translations

In order to overcome the language barrier constituted by a document in an unfamiliar non-official language, it might be appropriate for the examiner to rely on a machine translation of said document (see T 991/01), which is sent to the applicant (see B-X, 9.1.3). If only part of the translated document is relevant, the particular passage relied upon must be identified (see B-XI, 3.2). A translation has to serve the purpose of rendering the meaning of the text in a familiar language (see B-X, 9.1.3). Therefore mere grammatical or syntactical errors which have no impact on the possibility of understanding the content do not hinder its qualification as a translation (see T 287/98).

A general statement that machine translations as such cannot be trusted is not sufficient to invalidate the probatory value of the translation. If a party objects to the use of a specific machine translation, that party bears the burden of adducing evidence (in the form of, for instance, an improved translation of the whole or salient parts of the document) showing the extent to which the quality of the machine translation is defective and should therefore not be relied upon.

When the party provides substantiated reasoning for questioning the objections raised based on the translated text, the examiner must take these reasons into account, similarly to when the publication date is questioned (see G-IV, 7.5.3).

5. Conflict with other European applications

5.1 State of the art pursuant to Art. 54(3)

Art. 54(3)
Art. 56
Art. 85
Art. 89

The state of the art also comprises the content of other European applications filed or validly claiming a priority date earlier than – but published under Art. 93 on or after – the date of filing or valid date of priority of the application being examined. Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step. The "date of filing" referred to in Art. 54(2) and (3) is thus to be interpreted as meaning the date of priority in appropriate cases (see F-VI, 1.2). By the "content" of a European application is meant the whole disclosure, i.e. the description, drawings and claims, including:

(i) any matter explicitly disclaimed (with the exception of disclaimers for unworkable embodiments);

(ii) any matter for which an allowable reference (see F-III, 8, penultimate paragraph) to other documents is made; and

(iii) prior art in so far as explicitly described.

However, the "content" does not include any priority document (the purpose of such document being merely to determine to what extent the priority date is valid for the disclosure of the European application (see F-VI, 1.2)) nor, in view of Art. 85, the abstract (see F-II, 2).

It is important to note that it is the content of the earlier application as filed which is to be considered when applying Art. 54(3). Where an application is filed in a non-official language as permitted by Art. 14(2) (see A-VII, 1.1), it may happen that matter is erroneously omitted from the translation in the language of the proceedings and not published under Art. 93 in that language. Even in this case, it is the content of the original text which is relevant for the purposes of Art. 54(3).

5.1.1 Requirements

Whether a published European application can be a conflicting application under Art. 54(3) is determined firstly by its filing date and the date of its publication; the former must be before the filing or valid priority date of the application under examination, the latter must be on or after that date. If the published European application validly claims priority, the priority date replaces the filing date (Art. 89) for that subject-matter in the application which corresponds to the priority application. If a priority claim was abandoned or otherwise lost with effect from a date prior to publication, the filing date and not the priority date is relevant, irrespective of whether or not the priority claim might have conferred a valid priority right.

Further it is required that the conflicting application was still pending at its publication date (see J 5/81). If the application was withdrawn or otherwise lost before the date of publication, but published because the preparations for publication had been completed, the publication has no effect under Art. 54(3), but only under Art. 54(2). Art. 54(3) must be interpreted as referring to the publication of a "valid" application, i.e. a European patent application in existence at its publication date.

Changes taking effect after the date of publication (e.g. withdrawal of a designation or withdrawal of the priority claim or loss of the priority right for other reasons) do not affect the application of Art. 54(3) (see H-III, 4.2 for transitional provisions concerning Art. 54(4) EPC 1973 and A-III, 11.1 and 11.3 for transitional arrangements concerning non-payment of designation fees for applications filed before 1 April 2009).

5.1.2 Accorded date of filing still subject to review

The prior art considered by the examiner might comprise documents (European or international patent applications) for which the accorded date of filing may still be under review before the EPO. This might be the case, for instance, when:

(i) a European patent application contains parts of the description and/or drawings filed under Rule 56, or

(ii) an international patent application contains elements or parts of the description, drawings or claims filed under Rule 20.5 or 20.6 PCT.

The examiner checks whether a final decision on the accorded date of filing has already been taken before considering the documents as being state of the art under Art. 54(3). If the date of filing has not yet been established, the examiner temporarily deals with the documents (if relevant for assessing the patentability of the claimed subject-matter) as if their

accorded date of filing were correct, revisiting the issue at a later point in time.

5.2 Euro-PCT applications

Art. 153
Rule 165

The above principles also apply to PCT applications designating EP, but with an important difference. Art. 153(5), in conjunction with Rule 165, makes it clear that a PCT application is included in the state of the art for the purposes of Art. 54(3) if the PCT applicant has paid the required filing fee under Rule 159(1)(c) and has supplied the PCT application to the EPO in English, French or German (this means that a translation is required where the PCT application was published in Japanese, Chinese, Spanish, Russian, Korean, Portuguese or Arabic).

Therefore, it is not required that all conditions for entry into the European phase be fulfilled for a Euro-PCT application to be considered a conflicting European application under Art. 54(3) EPC.

5.3 Commonly designated states

See H-III, 4.2 for the transitional applicability of Art. 54(4) EPC 1973 to applications which were pending on 13 December 2007 and patents which had already been granted on that date.

5.4 Double patenting

As acknowledged by the Enlarged Board, the prohibition on double patenting is applicable under Art. 125 (G 4/19). It is a principle of procedural law generally recognised in the contracting states that two patents cannot be granted to the same applicant for the same subject-matter.

The prohibition of double patenting applies to three types of combinations of European applications by the same applicant: two applications filed on the same day, parent and divisional applications, or an application and its priority application.

It is permissible to allow an applicant to proceed with two applications having the same description which do not claim the same subject-matter (see also T 2461/10).In cases where there are two or more European applications from the same applicant designating the same state or states and the claims of those applications have the same filing or priority date and relate to the same invention, the applicant should be required to perform one of the following: amend one or more of the applications in such a manner that the subject-matter of the claims of the applications is not identical, or withdraw overlapping designations, or choose which one of those applications is to proceed to grant. If the applicant does not do so, once one of the applications is granted, the other(s) will be refused under Art. 97(2) in conjunction with Art. 125 (G 4/19). If the claims of those applications are merely partially overlapping, no objection should be raised (see T 877/06). Should two applications of the same effective date be received from two different applicants, each must be allowed to proceed as though the other did not exist.

6. Conflict with national rights of earlier date

Where a national right of an earlier date exists in a contracting state designated in the application, there are several possibilities of amendment open to the applicant. First, that designation may be withdrawn from the application for the contracting state of the national right of earlier date. Second, for such state, the applicant may file claims which are different from the claims for the other designated states (see H-II, 3.3 and H-III, 4.4). Third, the applicant can limit the existing set of claims in such a manner that the national right of earlier date is no longer relevant. *Rule 138*

In opposition or limitation proceedings, the proprietor may file claims which are different from the claims for the other contracting states or limit the existing set of claims in such a manner that the national right of earlier date is no longer relevant (see H-III, 4.4 and D-X, 10.1).

In opposition proceedings, the proprietor may also request the revocation of the patent for the contracting state of the national right of earlier date (see D-I, 3; D-VIII, 1.2.5; E-VIII, 8.4). However, this is not possible in limitation or revocation proceedings (see D-X, 3).

Amendment of the application to take account of prior national rights is neither required nor suggested (see also H-III, 4.4). However, if the claims have been amended, then amendment of the description and drawings is required if necessary to avoid confusion.

7. State of the art made available to the public "by means of a written or oral description, by use, or in any other way"

7.1 Types of use and instances of state of the art made available in any other way

Use may be constituted by producing, offering, marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange.

The state of the art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on online media platforms.

Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the state of the art concerned.

Instances of public prior use or availability in any other way will typically be raised in opposition proceedings. They may rarely arise in examination proceedings.

7.2 Matters to be determined by the division as regards prior use

When dealing with an allegation that an object or process has been used in such a way that it is comprised in the state of the art (prior use), the division will have to determine the following details:

(i) the date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use);

(ii) what has been used, in order to determine the degree of similarity between the object used and the subject-matter of the European patent; and

(iii) all the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject-matter having become available to the public.

On the basis of the submissions and the evidence already available, e.g. documents confirming sale, or affidavits related to the prior use, the division will first establish the relevance of the alleged prior use. If on the basis of this assessment it is of the opinion that the prior use is sufficiently substantiated and relevant, and if the prior use is not contested, the division may take a decision using the submissions and the evidence already available. If the prior use or certain circumstances relating to it are contested, the division will need to take further evidence (e.g. hearing witnesses or performing an inspection) for those facts which are relevant to the case and which cannot yet be considered proven on the basis of the evidence already submitted. According to the circumstances of a particular case, such further evidence might have to be submitted by the party(ies). Evidence is always taken under participation of the party(ies), normally in oral proceedings. For details concerning means of evidence see E-IV, 1.2.

7.2.1 General principles

Subject-matter is regarded as made available to the public by use or in any other way if, at the relevant date, it was possible for members of the public to gain knowledge of the subject-matter and there was no bar of confidentiality restricting the use or dissemination of such knowledge (see also G-IV, 1 with reference to written descriptions). This may, for example, arise if an object is unconditionally sold to a member of the public, since the buyer thereby acquires unlimited possession of any knowledge which may be obtained from the object. Even where in such cases the specific features of the object may not be ascertained from an external examination, but only by further analysis, those features are nevertheless to be considered as having been made available to the public. This is irrespective of whether or not particular reasons can be identified for analysing the composition or internal structure of the object. These specific features only relate to the intrinsic features. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g. reactants or the like, in order to provide a particular effect or

result or to discover potential results or capabilities, therefore point beyond the product *per se* as they are dependent on deliberate choices being made. Typical examples are the first or further application as a pharmaceutical product of a known substance or composition (see Art. 54(4) and (5)) and the use of a known compound for a particular purpose, based on a new technical effect (see G 2/88). Thus, such characteristics cannot be considered as already having been made available to the public (see G 1/92). T 1833/14 contains an example where a commercially available product was found by the board not to have been made available to the public as the skilled person was not able to reproduce it without undue burden, i.e. the alleged public prior use did not amount to an enabling disclosure.

If, on the other hand, an object could be seen in a given place (a factory, for example) to which members of the public not bound to secrecy, including persons with sufficient technical knowledge to ascertain the specific features of the object, had access, all knowledge which an expert was able to gain from a purely external examination is to be regarded as having been made available to the public. In such cases, however, all concealed features which could be ascertained only by dismantling or destroying the object will not be deemed to have been made available to the public.

7.2.2 Agreement on secrecy

The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken.

In order to establish whether there is a tacit agreement, the division must consider the particular circumstances of the case especially whether one or more parties involved in the prior use had an objectively recognisable interest in maintaining secrecy. If only some of the parties had such an interest, it must be established if the other parties implicitly accepted to act accordingly. For example, this is the case when the other parties could be expected to maintain secrecy in accordance with the usual business practice in the relevant industry. For establishing a tacit agreement important aspects to be considered are, *inter alia*, the commercial relationship between the parties and the exact object of the prior use. The following may be indicators of a tacit secrecy agreement: A parent company – subsidiary relationship, a relationship of good faith and trust, a joint venture, the delivery of test specimens. The following may be indicators of the absence of such an agreement: An ordinary commercial transaction, the sale of parts for serial production.

As a rule, the general standard "balance of probabilities" applies. However, if practically all evidence lies within the power of the party bearing the burden of proof, the facts must be proven beyond reasonable doubt. For example, an opponent alleging that subject-matter was made available without any express or tacit agreement on secrecy must substantiate and, if contested, convincingly prove the circumstances from which public availability can be derived (e.g. ordinary sale to a customer, parts supplied for serial production). The proprietor can challenge this by demonstrating inconsistencies and gaps in the chain of proof or by substantiating facts

from which secrecy can be derived (e.g. joint development, samples for test purposes). If these elements lead to reasonable doubts as to public availability, public prior use has not been established.

Art. 55(1)(a) For the particular case of a non-prejudicial disclosure arising from an evident abuse in relation to the applicant, see G-IV, 7.3.2 and G-V.

7.2.3 Use on non-public property

As a general rule, use on non-public property, for example in factories and barracks, is not considered as use made available to the public, because company employees and soldiers are usually bound to secrecy, save in cases where the objects or processes used are exhibited, explained or shown to the public in such places, or where specialists not bound to secrecy are able to recognise their essential features from the outside. Clearly the above-mentioned "non-public property" does not refer to the premises of a third party to whom the object in question was unconditionally sold or the place where the public could see the object in question or ascertain features of it (see the examples in G-IV, 7.2.1 above).

7.2.4 Example of the accessibility of objects used

A press for producing light building (hard fibre) boards was installed in a factory shed. Although the door bore the notice "Unauthorised persons not admitted", customers (in particular dealers in building materials and clients who were interested in purchasing light building boards) were given the opportunity of seeing the press although no form of demonstration or explanation was given. An obligation to secrecy was not imposed as, according to witnesses, the company did not consider such visitors as a possible source of competition. These visitors were not genuine specialists, i.e. they did not manufacture such boards or presses, but were not entirely laymen either. In view of the simple construction of the press, the essential features of the invention concerned were bound to be evident to anyone observing it. There was therefore a possibility that these customers, and in particular the dealers in building materials, would recognise these essential features of the press and, as they were not bound to secrecy, they would be free to communicate this information to others.

7.2.5 Example of the inaccessibility of a process

The subject of the patent concerns a process for the manufacture of a product. As proof that this process had been made available to the public by use, a similar already known product was asserted to have been produced by the process claimed. However, it could not be clearly ascertained, even after an exhaustive examination, by which process it had been produced.

7.3 State of the art made available by means of oral description

7.3.1 Cases of oral description

Art. 54(2) The state of the art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public, such as in the course of a conversation or a lecture or by means of television, podcast or sound reproduction equipment.

7.3.2 Non-prejudicial oral description

Art. 55(1)(a)

The state of the art will not be affected by oral descriptions made by and to persons who were bound to, and preserved, secrecy, nor by an oral disclosure which was made no earlier than six months before the filing of the European patent application and which derives directly or indirectly from an evident abuse in relation to the applicant or that party's legal predecessor. In determining whether evident abuse has occurred, note G-V, 3.

7.3.3 Matters to be determined by the division in cases of oral description

Once again, in such cases the following details will have to be determined:

(i) when the oral description took place;

(ii) what was described orally; and

(iii) whether the oral description was made available to the public; this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall; see also G-IV, 7.2(iii)).

7.3.4 Standard of proof

Unlike a written document, the contents of which are fixed and can be read again and again, an oral presentation is ephemeral. Therefore, the standard of proof for ascertaining the content of an oral disclosure is high. Whether the amount of evidence provided is sufficient to establish the content of the oral disclosure based on this standard of proof has to be evaluated on a case-by-case basis and depends on the quality of the evidence in each case. However, evidence from the lecturer alone usually does not provide a sufficient basis for determining the content of the oral disclosure.

7.4 State of the art made available to the public in writing and/or by any other means

For this state of the art, details equivalent to those defined in G-IV, 7.3.3 have to be determined if they are not clear from the written or other disclosure itself or if they are contested by a party.

If information is made available by means of a written description and use or by means of a written and oral description, but only the use or the oral description is made available before the relevant date, then in accordance with G-IV, 1, the subsequently published written description may be deemed to give a true account of that oral description or use, unless the proprietor of the patent can give good reason why this is not the case. In this case, the opponent must adduce proof to the contrary in respect of the reasons given by the proprietor of the patent. Caution must be exercised when considering the type of evidence presented to substantiate the content of an oral description. For example, a report of a lecture written by the actual person who delivered the talk may not be an accurate account of what was in fact conveyed to the public. Similarly, a script from which the

lecturer purportedly read may not actually have been completely and comprehensibly read (see T 1212/97).

In opposition, if the publication date of a document originating from the opponent is in dispute, the opponent must prove that date beyond reasonable doubt. However, if the document is a brochure for advertising, it must be taken into account that such brochures are not normally kept secret for long after printing (T 2451/13, T 804/05, T 743/89).

7.5 Internet disclosures

As a matter of principle, disclosures on the internet form part of the state of the art according to Art. 54(2). Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was publicly posted. Internet websites often contain highly relevant technical information. Certain information may even be available only on the internet from such websites. This includes, for example, online manuals and tutorials for software products (such as video games) or other products with a short life cycle. Hence for the sake of a valid patent it is often crucial to cite publications only obtainable from such internet websites.

7.5.1 Establishing the publication date

Establishing a publication date has two aspects. It must be assessed separately whether a given date is indicated correctly and whether the content in question was indeed made available to the public as of that date.

The nature of the internet can make it difficult to establish the actual date on which information was made available to the public: for instance, not all web pages mention when they were published. Also, websites are easily updated, yet most do not provide any archive of previously displayed material, nor do they display records which enable members of the public – including examiners – to establish precisely what was published and when.

Neither restricting access to a limited circle of people (e.g. by password protection) nor requiring payment for access (analogous to purchasing a book or subscribing to a journal) prevent a web page from forming part of the state of the art. It is sufficient if the web page is in principle available without any bar of confidentiality.

Finally, it is theoretically possible to manipulate the date and content of an internet disclosure (as it is with traditional documents). However, in view of the sheer size and redundancy of the content available on the internet, it is considered very unlikely that an internet disclosure discovered by an examiner has been manipulated. Consequently, unless there are specific indications to the contrary, the date can be accepted as being correct.

7.5.2 Standard of proof

When an internet document is cited against an application or patent, the same facts are to be established as for any other piece of evidence, including standard paper publications (see G-IV, 1). This evaluation is made according to the principle of "free evaluation of evidence" (see T 482/89 and T 750/94). That means that each piece of evidence is given

an appropriate weight according to its probative value, which is evaluated in view of the particular circumstances of each case. The standard for assessing these circumstances is the balance of probabilities. According to this standard, it is not sufficient that the alleged fact (e.g. the publication date) is merely probable; the examining division must be convinced that it is correct. It does mean, however, that proof beyond reasonable doubt ("up to the hilt") of the alleged fact is not required.

The publication dates of internet disclosures submitted by a party to opposition proceedings are assessed according to the same principles as are applied in examination proceedings, i.e. they are assessed in view of the specific circumstances of the case. In particular, the timing of the submission as well as the interests of the party submitting the disclosure are to be taken into account.

In many cases, internet disclosures contain an explicit publication date which is generally considered reliable. Such dates are accepted at face value, and the burden of proof will be on the applicant to show otherwise. Circumstantial evidence may be required to establish or confirm the publication date (see G-IV, 7.5.4). If the examiner comes to the conclusion that – on the balance of probabilities – it has been established that a particular document was available to the public at a particular date, this date is used as publication date for the purpose of examination.

7.5.3 Burden of proof

It is a general principle that, when raising objections, the burden of proof lies initially with the examiner. This means that objections must be reasoned and substantiated, and must show that, on the balance of probabilities, the objection is well-founded. If this is done, it is then up to the applicant to prove otherwise – the burden of proof shifts to the applicant.

If an applicant provides reasons for questioning the alleged publication date of an internet disclosure, the examiner will have to take these reasons into account. If the examiner is no longer convinced that the disclosure forms part of the state of the art, this disclosure will not be used further as prior art against the application unless the examiner is able to present further evidence to maintain the disputed publication date.

The later the examiner sets out to obtain such evidence, the more difficult it may become. The examiner has to judge whether it is worth spending a short amount of time at the search stage to find further evidence in support of the publication date.

If an applicant refutes the publication date of an internet disclosure with no reasoning or merely with generic statements about the reliability of internet disclosures, this argument will be given minimal weight and is therefore unlikely to sway the examiner's opinion.

While the dates and content of internet disclosures can be taken at face value, there are of course differing degrees of reliability. The more reliable a disclosure, the harder it will be for the applicant to prove that it is

incorrect. The following sections look at the reliability of various popular types of internet disclosure.

7.5.3.1 Technical journals

Of particular importance for examiners are online technical journals from scientific publishers (e.g. IEEE, Springer, Derwent). The reliability of these journals is the same as that of traditional paper journals, i.e. very high.

It should be noted that the internet publication of a particular issue of a journal may be earlier than the date of publication of the corresponding paper version. Furthermore, some journals pre-publish on the internet manuscripts which have been submitted to them, but which have not yet been published, and in some cases before they have even been approved for paper publication (for example, the "Geophysics" journal). If the journal then does not approve the manuscript for publication, this pre-publication of the manuscript may be the only disclosure of its content. Examiners must also remember that the pre-published manuscript may differ from the final, published version.

Where the given publication date of an online journal publication is too vague (e.g. only the month and year is known), and the most pessimistic possibility (the last day of the month) is too late, the examiner may request the exact publication date. Such a request may be made directly through a contact form that the publisher may offer on the internet, or via the EPO library.

7.5.3.2 Other "print equivalent" publications

Many sources other than scientific publishers are generally deemed to provide reliable publication dates. These include for example publishers of newspapers or periodicals, or television or radio stations. Academic institutions (such as academic societies or universities), international organisations (such as the European Space Agency ESA), public organisations (such as ministries or public research agencies) or standardisation bodies also typically fall into this category.

Some universities host so-called eprint archives to which authors submit reports on research results in electronic form before they are submitted or accepted for publication by a conference or journal. In fact, some of these reports are never published anywhere else. The most prominent such archive is known as arXiv.org (*www.arxiv.org*, hosted by the Cornell University Library), but several others exist, e.g. the Cryptology eprint archive (*eprint.iacr.org*, hosted by the International Association for Cryptology Research). Some such archives crawl the internet to automatically retrieve publications which are publicly available from researchers' web pages, such as Citeseer or ChemXseer (*citeseer.ist.psu.edu* and *chemxseer.ist.psu.edu*, both hosted by Pennsylvania State University).

Companies, organisations or individuals use the internet to publish documents that had previously been published on paper. These include manuals for software products such as video games, handbooks for products such as mobile phones, product catalogues or price lists and

white papers on products or product families. Evidently, most of these documents address the public – e.g. actual or potential customers – and are thus meant for publication. Hence the date given can be taken as a date of publication.

7.5.3.3 Non-traditional publications

The internet is also used to exchange and publish information in ways which did not exist before, via, for example, Usenet discussion groups, blogs, email archives of mailing lists or wiki pages. Documents obtained from such sources also constitute prior art, although it may be more involved to establish their publication date, and their reliability may vary.

The content of a transmitted email cannot be considered to be public merely for the reason that it could have been intercepted (T 2/09).

Computer-generated timestamps (usually seen, for example, on blogs, Usenet or the version history available from wiki pages) can be considered as reliable publication dates. While such dates could have been generated by an imprecise computer clock, this should be weighed against the fact that in general many internet services rely on accurate timing and will often stop functioning if time and date are incorrect. In the absence of indications to the contrary, the frequently used "last modified" date can be treated as the publication date.

7.5.4 Disclosures which have no date or an unreliable date

Where an internet disclosure is relevant for examination but does not give any explicit indication of the publication date in the text of the disclosure, or if an applicant has shown that a given date is unreliable, the examiner may try to obtain further evidence to establish or confirm the publication date. Specifically, the examiner may consider using the following information:

(a) Information relating to a web page available from an internet archiving service. The most prominent such service is the Internet Archive accessible through the so-called "Wayback Machine" (*www.archive.org*). The fact that the Internet Archive is incomplete does not detract from the credibility of the data it does archive. It is also noted that legal disclaimers relating to the accuracy of any supplied information are routinely used on websites (even respected sources of information such as Espacenet or IEEE), and these disclaimers are not to be taken to reflect negatively on the websites' actual accuracy.

(b) Timestamp information relating to the history of modifications applied to a file or web page (for example, as available for wiki pages such as Wikipedia and in version control systems as used for distributed software development).

(c) Computer-generated timestamp information as available from file directories or other repositories, or as automatically appended to content (e.g. forum messages and blogs).

(d) Indexing dates given to the web page by search engines (see also T 1961/13). These will be later than the actual publication date of the disclosure, since the search engines take some time to index a new website.

(e) Information relating to the publication date embedded in the internet disclosure itself. Date information is sometimes hidden in the programming used to create the website but is not visible in the web page as it appears in the browser. Examiners may, for example, consider the use of computer forensic tools to retrieve such dates. In order to allow a fair evaluation of the accuracy of the date by both the applicant and the examiner, these dates can be used only if the examiner knows how they were obtained and can communicate this to the applicant.

(f) Information about replication of the disclosure at several sites (mirror sites) or in several versions.

It may also be possible to make enquiries with the owner or the author of the website when trying to establish the publication date to a sufficient degree of certainty. The probative value of statements so obtained will have to be assessed separately.

If no date can be obtained (other than the date of retrieval by the examiner, which will be too late for the application in question), the disclosure cannot be used as prior art during examination. If a publication, although undated, is highly relevant to the invention and can therefore be considered to be of interest to the applicant or third parties, it may be cited in the search report as an "L" document. The search report and the written opinion must explain why this document was cited. Citing the disclosure will also make it citable against future applications, using the date of retrieval as the date of publication.

7.5.5 Problematic cases

Web pages are sometimes divided into frames the content of which is drawn from different sources. Each of these frames may have its own publication date which may have to be checked. In an archiving system, for instance, it may happen that one frame contains the archived information with an old publishing date whereas other frames contain commercials generated at the time of retrieval. The examiner must ensure that the right publication date is used, i.e. that the cited publication date refers to the intended content.

When a document retrieved from the Internet Archive contains links, there is no guarantee that the links point to documents archived on the same date. It may even happen that the link does not point to an archived page at all but to the current version of the web page. This may in particular be the case for linked images, which are often not archived. It may also happen that archived links do not work at all.

Some internet addresses (URLs) are not persistent, i.e. they are designed to work only during a single session. Long URLs with seemingly random

numbers and letters are indicative of these. The presence of such a URL does not prevent the disclosure being used as prior art, but it does mean that the URL will not work for other people (e.g. for the applicant at the time of receipt of the search report). For non-persistent URLs, or if, for other reasons, it is considered prudent, the examiner indicates how that specific URL is arrived at from the main home page of the respective website (i.e. which links were followed, or which search terms were used).

7.5.6 Technical details and general remarks

When printing a web page, care must be taken that the complete URL is clearly legible. The same applies to the relevant publication date on a web page.

It has to be borne in mind that publication dates may be given in different formats, especially in either the European format dd/mm/yyyy, the US format mm/dd/yyyy or the ISO format yyyy/mm/dd. Unless the format is explicitly indicated, it will be impossible to distinguish between the European format and the US format for days 1-12 of each month.

If a publication date is close to the relevant priority date, the time zone of publication may be crucial to interpret a publication date.

The examiner must always indicate the date on which the web page was retrieved. When citing internet disclosures, the examiner must explain the prior-art status of the document, e.g.:

(i) how and where the publication date was obtained (for example, that the eight digits in the URL represent the date of archiving in the format yyyymmdd), and

(ii) any other relevant information (for example, where two or more related documents are cited, how they are related, indicating for instance that following link "xyz" on the first document leads to the second document).

7.6 Standards and standard preparatory documents

Standards define sets of characteristics or qualities for products, processes, services or materials (e.g. the properties of an interface) and are usually developed by Standards Development Organisations (SDOs) by consensus amongst the relevant economic stakeholders.

Final standards themselves in principle form part of the state of the art under Art. 54(2), although there are important exceptions. One of these relates to private standards consortia (e.g. in the field of CD-ROM, DVD and Blu-ray discs), which do not publish the final standards but make them available to the interested circles subject to acceptance of a non-disclosure agreement (categorically forbidding the recipients of the documents to disclose their content).

Before an SDO reaches agreement on the establishment or further development of a standard, various types of preparatory documents are submitted and discussed. These preparatory documents are treated like

any other written or oral disclosures, i.e. in order to qualify as prior art they must have been made available to the public prior to the filing or priority date without any bar of confidentiality. Thus if a standard preparatory document is cited against an application during search or examination, the same facts are to be established as for any other piece of evidence (see G-IV, 1 and T 738/04).

The existence of an explicit confidentiality obligation must be determined case by case on the basis of the documents allegedly setting forth this obligation (see T 273/02 and T 738/04). These may be general guidelines, directives or principles of the SDO concerned, licensing terms or a Memorandum of Understanding resulting from interaction between the SDOs and their members. In case of a general confidentiality clause, i.e. one that is not indicated on or in the relevant preparatory document itself, it must be established that the general confidentiality obligation actually extended to the document in question until the relevant point in time. This does not however require the document itself to be explicitly marked as confidential (see T 273/02).

If the preparatory documents are available in the EPO's in-house databases or at freely accessible sources (for example, on the internet), the examiner is allowed to cite them in the search report and to refer to them during the procedure. The public availability of the documents, if at all necessary, may be further investigated during examination and opposition in accordance with the principles set out above.

While documents in the EPO's in-house databases are regarded as being available to the public, no general indication can be given for documents obtained from other sources.

Norms and standards are comparable with trade marks in that their content can vary with time. Therefore, they have to be identified properly by their version number and publication date (see also F-III, 7, F-IV, 4.8 and H-IV, 2.2.8).

8. Cross-references between prior-art documents

If a document (the "primary" document) refers explicitly to another document (the "secondary" document) as providing more detailed information on certain features, the teaching of the latter is to be regarded as incorporated into the primary document if the document was available to the public on the publication date of the primary document (see T 153/85) (for the state of the art pursuant to Art. 54(3), see G-IV, 5.1 and F-III, 8, penultimate paragraph). The relevant date for novelty purposes, however, is always the date of the primary document (see G-IV, 3).

9. Errors in prior-art documents

Errors may exist in prior-art documents.

When a potential error is detected, three situations may arise depending on whether the skilled person, using general knowledge,

(i) can directly and unambiguously derive from the prior art document that it contains an error and what the only possible correction should be;

(ii) can directly and unambiguously derive from the prior art document that it contains an error, but is able to identify more than one possible correction; or

(iii) cannot directly and unambiguously derive from the prior art document that an error has occurred.

When assessing the relevance of a document to patentability,

in case (i), the disclosure is considered to contain the correction;

in case (ii), the disclosure of the passage containing the error is not taken into account;

in case (iii), the literal disclosure is taken into account as is.

For possible errors concerning compound records in online databases, see B-VI, 6.5. For non-enabling disclosures, see G-IV, 2.

Chapter V – Non-prejudicial disclosures

1. General

There are two specific instances (and these are the only two) in which a prior disclosure of the invention is not taken into consideration as part of the state of the art, viz. where the disclosure was due to, or in consequence of: *Art. 55(1)*

(i) an evident abuse in relation to the applicant or that party's legal predecessor – e.g. the invention was derived from the applicant or that party's legal predecessor and disclosed against their wish; or *Art. 55(1)(a)*

(ii) the display of the invention by the applicant or that party's legal predecessor at an officially recognised international exhibition as defined in Art. 55(1)(b). *Art. 55(1)(b)*

2. Time limit

An essential condition, in both instances G-V, 1(i) and (ii), is that the disclosure in point must have taken place not earlier than six months preceding the filing of the application. For calculating the six-month period the relevant date is that of the actual filing date of the European patent application, not the priority date (G 3/98 and G 2/99).

3. Evident abuse

Regarding instance G-V, 1(i), the disclosure might be made in a published document or in any other way. As a particular instance, the disclosure might be made in a European application of earlier priority date. Thus, for example, a person B who has been told of A's invention in confidence, might apply for a patent for this invention. If so, the disclosure resulting from the publication of B's application will not prejudice A's rights provided that A has already made an application, or applies within six months of such publication. In any event, having regard to Art. 61, B may not be entitled to proceed with the application (see G-VI, 2).

For "evident abuse" to be established, there must be, on the part of the person disclosing the invention, either actual intent to cause harm or actual or constructive knowledge that harm would or could ensue from this disclosure (see T 585/92). This must be proven on the balance of probabilities (see T 436/92).

4. International exhibition

In instance G-V, 1(ii), the application must be filed within six months of the disclosure of the invention at the exhibition if the display is not to prejudice the application. Furthermore, the applicant must state, at the time of filing the application, that the invention has been so displayed, and must also file a supporting certificate within four months, giving the particulars required by Rule 25 (see A-IV, 3). The exhibitions recognised are published in the Official Journal. *Art. 55(2)* *Rule 25*

Chapter VI – Novelty

1. State of the art pursuant to Art. 54(2)

An invention is considered to be new if it does not form part of the state of the art. For a definition of "state of the art", see G-IV, 1. It is to be noted that in considering novelty (as distinct from inventive step; see G-VII, 6), it is not permissible to combine separate items of prior art together. It is also not permissible to combine separate items belonging to different embodiments described in one and the same document, unless such combination has specifically been suggested (see T 305/87). For the specific case of selection inventions see G-VI, 8.

Furthermore, any matter explicitly disclaimed (with the exception of disclaimers which exclude unworkable embodiments) and prior art acknowledged in a document, in so far as explicitly described therein, are to be regarded as incorporated in the document.

It is further permissible to use a dictionary or similar document of reference in order to interpret a special term used in a document.

An unclear term cannot be used to distinguish the invention from the prior art and is not allowable under Art. 84 (see F-IV, 4.6.1).

2. Implicit features or well-known equivalents

A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a document as embracing well-known equivalents which are not disclosed in the documents; this is a matter of obviousness.

3. Relevant date of a prior-art document

In determining novelty, a prior-art document is to be read as it would have been read by a person skilled in the art on the relevant date of the document. By "relevant" date is meant the publication date in the case of a previously published document and the date of filing (or priority date, where appropriate) in the case of a document according to Art. 54(3) (see G-IV, 5.1).

4. Enabling disclosure of a prior-art document

Subject-matter described in a document can only be regarded as having been made available to the public, and therefore as comprised in the state of the art pursuant to Art. 54(1), if the information given therein is sufficient to enable the skilled person, at the relevant date of the document (see G-VI, 3), to practise the technical teaching which is the subject of the document, taking into account also the general knowledge at that time in the field (see T 26/85, T 206/83 and T 491/99).

Similarly, it is to be noted that a chemical compound, the name or formula of which is mentioned in a prior-art document, is not thereby considered as known, unless the information in the document, together, where appropriate, with knowledge generally available on the relevant date of the document, enables it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.

5. Generic disclosure and specific examples

In considering novelty, it is to be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.

6. Implicit disclosure and parameters

In the case of a prior-art document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior-art document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind is raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching (for a second non-medical use, however, see G-VI, 7). Situations of this kind may also occur when the claims define the invention, or a feature thereof, by parameters (see F-IV, 4.11). It may happen that in the relevant prior art a different parameter, or no parameter at all, is mentioned. If the known and the claimed products are identical in all other respects (which is to be expected if, for example, the starting products and the manufacturing processes are identical), then in the first place an objection of lack of novelty arises. The burden of proof for an alleged distinguishing feature lies with the applicant. No benefit of doubt can be accorded if the applicant does not provide evidence in support of the allegations (see T 1764/06). If, on the other hand, the applicant is able to show, e.g. by appropriate comparison tests, that differences do exist with respect to the parameters, it is questionable whether the application discloses all the features essential to manufacture products having the parameters specified in the claims (Art. 83).

7. Examination of novelty

In determining novelty of the subject-matter of claims, the examiner must have regard to the guidance given in F-IV, 4.5 to 4.21. Particularly for claims directed to a physical entity, non-distinctive characteristics of a particular intended use are to be disregarded (see F-IV, 4.13.1). For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (e.g. the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated, but implied by the particular use, are to be taken into account (see the example

of a "mold for molten steel" in F-IV, 4.13.1). For claims to a first medical use, see G-II, 4.2.

A known compound is not rendered novel merely because it is available with a different degree of purity if the purity can be achieved by conventional means (see T 360/07).

7.1 First or further medical use of known products

Where a substance or composition is already known, it may still be patentable under Art. 54(4) if the known substance or composition was not previously disclosed for use in a method referred to in Art. 53(c).

Where a substance or composition is already known to have been used in a "first medical use", it may still be patentable under Art. 54(5) for any second or further use in a method according to Art. 53(c), provided that said use is novel and inventive.

Art. 54(4) and (5) thus provide for an exception from the general principle that product claims can only be obtained for novel products. However, this does not mean that product claims for the first and further medical uses need not fulfil all other requirements of patentability, especially that of inventive step (see T 128/82).

A claim in the form "Use of substance or composition X for the treatment of disease Y..." will be regarded as relating to a method for treatment explicitly excluded from patentability under Art. 53(c) and therefore will not be accepted. A claim in the form "Substance X for use as a medicament" is acceptable, even if X is a known substance, but its use in medicine is not known. Likewise, it is acceptable to have a claim in the form "Substance X for use in the treatment of disease Y", provided that such a claim involves an inventive step over any prior art disclosing the use of X as a medicament.

If an application discloses for the first time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, normally independent claims each directed to the substance or composition for one of the various uses are allowed; i.e. an *a priori* objection of lack of unity of invention is not, as a general rule, raised (see F-V, 7). *Art. 82*

Where the subject-matter of a claim is rendered novel only by a new therapeutic use of a medicament, the claim may no longer have the format of a so-called "Swiss-type" claim as instituted by decision G 5/83 ("Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z") if the application has a filing or earliest priority date of 29 January 2011 or later (see the Notice from the EPO dated 20 September 2010, OJ EPO 2010, 514).

The effect of the different claim formulations on patentability is summarised in the table below:

Examples

#	Claim	Patentable?	Article
A	Use of product X for the treatment of asthma	No	53(c)
B	1. Product X for use as a medicament [X known as e.g. herbicide] 2. Product according to claim 1 for use in the treatment of asthma	Yes (even if X is a known product, but its use in medicine is not known) Yes	54(4)
C	Product X for use in the treatment of cancer*	Yes (even if case B is prior art, provided that such a claim is inventive over B and any other prior art)	54(5)
D	Product X for use in the treatment of leukaemia*	Yes (even if cases B and C are prior art, provided that D is inventive over B and C and any other prior art because leukaemia is a specific type of cancer)	54(5)

* Note: The corresponding Swiss-type claims for cases C and D (required under EPC 1973) would be "The use of Product X for the manufacture of a medicament for the treatment of cancer/leukaemia".

In cases where an applicant simultaneously discloses more than one "subsequent" therapeutic use, claims of the above type directed to these different uses are allowable in the one application, but only if they form a single general inventive concept (Art. 82). Regarding use claims of the above type, it is also to be noted that a mere pharmaceutical effect does not necessarily imply a therapeutic application. For instance, the selective occupation of a specific receptor by a given substance cannot be considered in itself as a therapeutic application; indeed, the discovery that a substance selectively binds a receptor, even if representing an important piece of scientific knowledge, still needs to find an application in the form of a defined, real treatment of a pathological condition in order to make a technical contribution to the art and to be considered as an invention eligible for patent protection (see T 241/95). See also F-IV, 4.22 for the functional definition of a pathological condition.

A claim in the format of a Swiss-type claim is a purpose-related process claim, whereas a claim drafted in accordance with Art. 54(5) is a purpose-related product claim. Therefore, such claims have different categories. This has the following consequences:

(i) If a parent application has been granted with a Swiss-type claim, granting a patent on the basis of the purpose-related product claim in its divisional application would not lead to double patenting (T 13/14; see also G-IV, 5.4).

(ii) Since a claim to a particular physical activity (e.g. method, process, use) confers less protection than a claim to the physical entity *per se* (G 2/88, Reasons 5.1), a Swiss-type claim confers less protection than a claim formulated according to Art. 54(5). Therefore a change from a Swiss-type claim to a claim drafted in accordance with Art. 54(5) contravenes Art. 123(3) (T 1673/11; see also H-IV, 3.4).

7.1.1 Products that may be claimed for a further medical use

The scope of protection of use-related product claims under Art. 54(5) is limited to the substance or composition in the context of its medical use which confers novelty and non-obviousness, if any, on the claimed product.

This principle applies only to substances and compositions and cannot be extended to other products. A claim directed to a device for an intended medical use (e.g. pacemaker or implantable chemical sensor for use in ...) must be construed as claiming a device which is suitable for that medical use (F-IV, 4.13).

A product qualifies as a "substance or composition" in the sense of Art. 54(5) if it is the active agent or ingredient in the specific medical use and if the therapeutic effect can be ascribed to its chemical properties (see G 5/83 and T 1758/15). For example, consider a filler material which is injected between a first tissue targeted for radiation treatment and a second sensitive tissue which is desired to be protected from radiation. If the shielding effect of the filler material is achieved by a mere mechanical displacement of the sensitive tissue relative to the target tissue, due to the volume it occupies between the two tissues, the filler material qualifies as a device rather than a substance or composition. On the other hand, if the filler material produced a radiation-reducing effect on the sensitive tissue which could be attributed to its chemical properties, it would be considered as a "substance or composition" in the sense of Art. 54(5).

7.1.2 Therapeutic uses pursuant to Art. 54(5)

The treatment of a disease with a substance or composition which is already known to be used for treating said disease, where the only difference from the known treatment is in the dosage regime, is a specific further medical use within the meaning of Art. 54(5) (see G 2/08). Thus, therapeutic uses of a substance/composition may be based not only on the treatment of a different disease but also on the treatment of the same disease by a different therapeutic method differing for example in the dosage, administration regime, group of subjects or route of administration (G 2/08).

A claim directed to the further therapeutic use of a substance/composition must indicate the illness/disease to be treated, the nature of the therapeutic compound used for that purpose and, if relevant for establishing novelty and inventive step, the subject to be treated. If the further therapeutic use relates to a different therapy of the same disease using the same substance/composition, the claim must also define all technical features of the therapy giving rise to the desired technical effect (G 2/08).

An independent claim directed to a further therapeutic use of a substance/composition which is based on the use of said product in the treatment of a different disease must be formulated as follows:

Substance X or Composition comprising X	for use	in a method for the treatment of Y, or in the therapy of Y, or in a method of treating Y, or in a method of therapy of Y, or as a medicament defined by its function, (e.g. as an anti-inflammatory medicament)

The presence of the term "for use" is mandatory, to closely adhere to the wording of Art. 54(5).

If the independent claim is directed to a composition, the definition of the composition may be inserted before or after the term "for use". For example: "Composition comprising X for use in the therapy of Y" or "Composition for use in the therapy of Y comprising X".

If the further therapeutic use is based on the use of the same product in a different treatment of the same disease, the independent claim must be formulated as follows:

Substance X for use or Composition comprising X for use	in a method for the treatment of Y, or in the therapy of Y, or in a method of treating Y, or in a method of therapy of Y, or as a medicament defined by its function (e.g. as an anti-inflammatory medicament)	characterised in that/ wherein	other features (e.g. the substance/ composition is administered topically, three times daily...)

Purpose-related product claims which do not define exclusively (see claim 4 in the table below) a medical use excluded from patentability under Art. 53(c) are construed as claims directed to a product *per se* which is suitable for the claimed use.

The table below shows some examples of claims which do not define a further medical use within the meaning of Art. 53(c).

		... because ...
1. Substance X or Composition comprising X in/for	a method for the treatment of Y, or the therapy of Y, or a method of treating Y, or a method of therapy of Y, or the (topical) treatment of Y, or the (topical) therapy of Y	without the term "for use" it is not evident if the claim is directed to the product suitable for the specified use or if the claim is limited by the medical use
2. (Anti-inflammatory) medicament, or Pharmaceutical comprising substance X, or Composition comprising X	for topical treatment	the claim indicates neither a therapeutic role nor a therapeutic application of the claimed product. Moreover, without the term "for use" it is not evident if the claim is directed to the product suitable for the specified use or if the claim is limited by the medical use
3. Substance X or Composition comprising X	as an anti-inflammatory agent	without the term "for use" it is not evident if the claim is directed to the product suitable for the specified use or if the claim is limited by the medical use
4. Substance X or Composition comprising X	for use as an antifungal /antibacterial agent	the claim does not define a specific medical use of the claimed product. It encompasses non-medical uses, because antifungal/ antibacterial agents are also used in e.g. agriculture for treating plants

If the prior art discloses either the product *per se* in a form which could be considered suitable for the claimed use, or its first medical application, claims 1 to 4 would lack novelty. The novelty objection could be overcome by reformulating the claim as described above (first table of G-VI, 7.1.2).

These amendments may be proposed by the examining division in the Rule 71(3) communication without the need to consult the applicant beforehand (see C-V, 1.1, point (f)).

The following are examples of claims which would not be considered novel:

Example 1

Composition comprising X for use by topical treatment/application

It is assumed that a composition comprising X is already known in the prior art.

Reasons for objection: Since the claim fails to identify the specific therapeutic indication for X, the feature "for topical treatment/application" remains *de facto* purely illustrative and does not limit the scope of the claim to that specific application.

Furthermore, the term "topical treatment/application" does not necessarily relate to use in a method referred to in Art. 53(c) since it could refer to a cosmetic treatment. Consequently, the subject-matter of the claimed composition would be anticipated if said composition comprising X is already known in the prior art.

Example 2

Composition comprising X for use in therapy by topical administration

It is assumed that a composition comprising X is already known in the prior art for a medical use.

Reasons for objection: The mode of administration may be a critical factor in a medical treatment and has been considered as a limiting feature, but only in relation to a further (specific) medical indication (T 51/93). "Topical administration" specifies only the mode of delivery, but does not relate to any therapeutic effect obtained thereby. Consequently, since the claim fails to identify the specific therapeutic indication, the feature "by topical administration" is merely illustrative and not a restrictive technical feature capable of establishing novelty. The subject-matter of the claimed composition would thus be anticipated if said composition comprising X is already known in the prior art for any medical use.

Example 3

Product X for use in a method of contraception

Reasons for objection: Such a claim would not be considered novel over the disclosure of product X *per se* because pregnancy is not a disease. This claim can usually be reformulated as a method of contraception using product X. Reformulation may not be possible in so far as the contraception method involves the personal and private sphere, i.e. it does not fulfil the requirement of industrial application (T 74/93).

7.1.3 Diagnostic uses pursuant to Art. 54(5)

A suitable formulation of a diagnostic claim according to Art. 54(5) may read:

Substance X or Composition comprising X	for use in a method of diagnosis	"in vivo"	of disease Y

The wording "in vivo" limits the scope of the claim to diagnostic methods which are excluded from patentability pursuant to Art. 53(c).

If the independent claim is directed to a composition, the definition of the composition may be inserted before or after the term "for use".

Purpose-related product claims which do not define a diagnostic use excluded from patentability under Art. 53(c) are construed as claims directed to a product *per se* which is suitable for the claimed use.

The following table shows some examples of claims which do not define a diagnostic use within the meaning of Art. 53(c):

1. Substance X or Composition comprising X	for use in the diagnosis of disease Y, or for use in the "in vitro"/"ex vivo" diagnosis of disease Y
2. Substance X or Composition comprising X	for use as a contrast agent for imaging blood flow

Claims 1 and 2 would lack novelty over prior art disclosing either the product *per se* in a form which could be considered suitable for the claimed use, or its first medical application.

Claim 1 could be reformulated as "Use of [...] in the "in vitro/ex vivo" diagnosis of disease Y". If the application as filed discloses, either explicitly or implicitly, that the claimed diagnostic methods are to be carried out "in vivo", the wording of claim 1 could also be limited to encompass only "in vivo" methods, as described above.

Claim 2 could be reformulated as "Use of [...] as contrast agent for imaging blood flow".

Claims 1 and 2 could also be reformulated as method claims, e.g. "A method for in vitro/ex vivo diagnosing disease Y using substance X [...]" or " A method for diagnosing disease Y in a sample by using substance X [...]" or "A method of imaging blood flow using substance X [...]".

These amendments may be proposed by the examining division in the Rule 71(3) communication without the need to consult the applicant beforehand (see C-V, 1.1, point (f)).

7.1.4 Surgical uses pursuant to Art. 54(5)

A claim defining a second surgical use may read "Substance X/ Composition comprising X for use in a method of intracardiac catheterisation as a protector of blood vessel walls".

If the independent claim is directed to a composition, the definition of the composition may be inserted before or after the term "for use".

Purpose-related product claims which do not define a surgical use excluded from patentability under Art. 53(c) are construed as claims directed to a product *per se* which is suitable for the claimed use.

The following table shows an example of a claim which does not define a surgical use within the meaning of Art. 53(c):

1. Substance X or Composition comprising X	for use in a method for hair removal by laser radiation

The claim would lack novelty over prior art disclosing either the product *per se* in a form which could be considered suitable for the claimed use, or its first medical application.

The claim could be reformulated as "Use of [...] for hair removal by laser radiation" or as "Method for removing hair by laser radiation by using substance X [...]".

This amendment may be proposed by the examining division in the Rule 71(3) communication without the need to consult the applicant beforehand (see C-V, 1.1, point (f)).

7.1.5 Dependent claims pursuant to Art. 54(5)

The wording of the dependent claims must clearly reflect their dependency on the independent claim (T 2106/10). A suitable formulation may read:

Substance (X) or Composition (comprising X) (according to claim #)	for use in the therapy of disease Y according to claim # or for use according to claim #	wherein	other features (e.g. it is provided as water-soluble granulates)

In the following example, the dependent claim is not correctly formulated according to Art. 54(5).

Claim 1: Composition comprising X for use in the treatment of Y.

Claim 2: Composition according to claim 1, comprising 5 mg X.

The category of claim 2 is unclear and the dependency is doubtful. The claim appears to depend on a claim directed to a product *per se*.

The claim would also lack novelty over prior art disclosing a composition comprising 5 mg X, or a first medical application thereof.

The claim must be reformulated as indicated above by inserting "for use" between "Composition" and "according". This amendment may be proposed by the examining division in the Rule 71(3) communication without the need to consult the applicant beforehand (see C-V, 1.1, point (f)).

7.2 Second non-medical use

A claim to the use of a known compound for a particular purpose (second non-medical use) which is based on a technical effect is interpreted as including that technical effect as a functional technical feature. Accordingly, said claim is not open to objection under Art. 54(1), provided that such technical feature has not previously been made available to the public (G 2/88, and G 6/88). The novelty of the use of the known compound for the known production of a known product cannot be deduced from a new property of the produced product. In such a case, the use of a compound for the production of a product has to be interpreted as a process for production of the product with the compound. It can be regarded as novel only if the process of production as such is novel (see T 1855/06). For claims to a second or further medical use, see G-II, 4.2.

However, a feature of a step in a chemical process which merely serves to explain the technical effect obtained is not a functional technical feature which could render a claim novel over prior art which discloses the same process with the same step which provides the same effect, even if it does not comprise a corresponding indication of technical effect. It is rather considered to be a discovery (T 151/13).

8. Selection inventions

Selection inventions deal with the selection of individual elements, subsets, or sub-ranges, which have not been explicitly mentioned, within a larger known set or range.

(i) In determining the novelty of a selection, it has to be decided whether the selected elements are disclosed in an individualised (concrete) form in the prior art (see T 12/81). A selection from a single list of specifically disclosed elements does not confer novelty. However, if a selection from two or more lists of a certain length has to be made in order to arrive at a specific combination of features then the resulting combination of features, not specifically disclosed in the prior art, confers novelty (the "two-lists principle"). Examples of such selections from two or more lists are the selection of:

(a) individual chemical compounds from a known generic formula whereby the compound selected results from the selection of specific substituents from two or more "lists" of substituents given in the known generic formula. The same applies to specific mixtures resulting from the selection of individual components from lists of components making up the prior art mixture;

(b) starting materials for the manufacture of a final product;

(c) sub-ranges of several parameters from corresponding known ranges.

(ii) A sub-range selected from a broader numerical range of the prior art is considered novel if both of the following two criteria are satisfied (see T 261/15 and T 279/89):

(a) the selected sub-range is narrow compared to the known range;

(b) the selected sub-range is sufficiently far removed from any specific examples disclosed in the prior art and from the end-points of the known range;

The meaning of "narrow" and "sufficiently far removed" has to be decided on a case by case basis.

(iii) In the case of overlapping ranges (e.g. numerical ranges, chemical formulae) of claimed subject-matter and the prior art, the same principles apply for the assessment of novelty as in the cases discussed in (i) and (ii) above. It has to be decided which subject-matter has been made available to the public by a prior-art disclosure and thus forms part of the state of the art. In this context, it is not only examples, but the whole content of the prior-art document which has to be taken into consideration. Matter that is "hidden" in a prior-art document, in the sense of being reconditely submerged rather than deliberately concealed, is not considered to have been made available to the public (see T 666/89).

As to overlapping ranges or numerical ranges of physical parameters, novelty is destroyed by an explicitly mentioned end-point of the known range, explicitly mentioned intermediate values or a specific example of the prior art in the overlap. It is not sufficient to exclude specific novelty-destroying values known from the prior-art range, it must also be considered whether the skilled person, in the light of the technical facts and taking into account the general knowledge in the field, would seriously contemplate applying the technical teaching of the prior-art document in the range of overlap. If it can be fairly assumed that the skilled person would do so, it must be concluded that no novelty exists. In T 1571/15, regarding an alloy defined by its composition, the skilled person would not seriously contemplate working in the area of overlap, despite it falling in the centre region of the ranges disclosed in the prior-art document, since said prior-art document contained a pointer to another region.

As far as overlapping chemical formulae are concerned, novelty is acknowledged if the claimed subject-matter is distinguished from the prior art in the range of overlap by a new technical teaching, see T 12/90, point 2.6 of the Reasons. There is a new technical teaching if certain technical elements are new in comparison to the

prior-art disclosure. An example of a new technical element is a specifically selected chemical residue which is covered in general terms by the prior art in the overlapping area, but which is not individualised in the prior art document. If this is not the case, then it must be considered whether the skilled person would seriously contemplate working in the range of overlap and/or would accept that the area of overlap is directly and unambiguously disclosed in an implicit manner in the prior art (see for example T 536/95). If the answer is yes, then novelty is lacking.

The concept of "seriously contemplating" is fundamentally different from the concept used for assessing inventive step, namely whether the skilled person "would have tried, with reasonable expectation of success", to bridge the technical gap between a particular piece of prior art and a claim whose inventiveness is in question (see G-VII, 5.3), because in order to establish anticipation, there cannot be such a gap (T 666/89).

8.1 Error margins in numerical values

The skilled person knows that numerical values relating to measurements are subject to measurement errors which place limits on their accuracy. For this reason, the general convention in the scientific and technical literature is applied: the last decimal place of a numerical value indicates its degree of accuracy. Where no other error margins are given, the maximum margin is ascertained by applying the rounding-off convention to the last decimal place (see T 175/97), e.g. for a measurement of 3.5 cm, the error margin is 3.45-3.54. When interpreting ranges of values in patent specifications, the skilled person proceeds on the same basis.

9. Novelty of "reach-through" claims

"Reach-through" claims are defined as claims attempting to obtain protection for a chemical product (and also uses thereof, compositions thereof, etc.) by defining that product functionally in terms of its action (e.g. agonist, antagonist) on a biological target such as an enzyme or receptor (see F-III, 9). In many such cases, the applicant functionally defines chemical compounds in this way by reference to a newly identified biological target. However, compounds which bind to and exercise this action on that biological target are not necessarily novel compounds simply because the biological target which they act on is new. Indeed in many cases, the applicants themselves provide test results in the applications, whereby known compounds are shown to exert this action on the new biological target, thus demonstrating that compounds falling within the functional definition of the "reach-through" claim are known in the state of the art and so establishing that a reach-through claim relating to compounds defined in this way lacks novelty.

Chapter VII – Inventive step

1. General

An invention is considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the Art. Novelty (see G-VI) and inventive step are different criteria. The question – "is there inventive step?" – only arises if the invention is novel. *Art. 56*

2. State of the art; date of filing

The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) (see G-IV, 1). It is to be understood as concerning such kind of information as is relevant to some field of technology. It does not include later published European applications referred to in Art. 54(3). As mentioned in G-IV, 3, "date of filing" in Art. 54(2) means date of priority where appropriate (see F-VI). The state of the art may reside in the relevant common general knowledge, which need not necessarily be in writing and needs substantiation only if challenged (see T 939/92).

3. Person skilled in the art

The "person skilled in the art" is presumed to be a skilled practitioner in the relevant field of technology who is possessed of average knowledge and ability (average skilled person). The person skilled in the art is aware of what was common general knowledge in the art at the relevant date (see T 4/98, T 143/94 and T 426/88). The skilled person is also presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have been in possession of the means and capacity for routine work and experimentation which are normal for the field of technology in question. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The skilled person is involved in constant development in the relevant technical field (see T 774/89 and T 817/95). The skilled person may be expected to look for suggestions in neighbouring and general technical fields (see T 176/84 and T 195/84) or even in remote technical fields, if prompted to do so (see T 560/89). Assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability (see T 32/81). There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, rather than a single person (see T 164/92 and T 986/96). It is to be borne in mind that the skilled person has the same level of skill for assessing inventive step and sufficient disclosure (see T 60/89, T 694/92 and T 373/94).

3.1 Common general knowledge of the skilled person

Common general knowledge can come from various sources and does not necessarily depend on the publication of a specific document on a specific date. An assertion that something is common general knowledge need only be backed by documentary evidence (for example, a textbook) if this is contested (see G-IV, 2).

A single publication (e.g. a patent document, but also the content of a technical journal) cannot normally be considered as common general knowledge (see T 475/88). In special cases, articles in technical journals can be representative of common general knowledge (see T 595/90). This applies in particular to articles providing a broad review or survey of a topic (see T 309/88). For the skilled person addressing the problem of bringing together certain starting materials, the conclusions of research on these materials carried out by only a very few manufacturers form part of the relevant general technical knowledge, even if the studies in question have only been published in technical journals (see T 676/94). Another exception is that it can also be the information contained in patent specifications or scientific publications, if the invention lies in a field of research which is so new that the relevant technical knowledge is not yet available from textbooks (see T 51/87).

Basic textbooks and monographs can be considered as representing common general knowledge (see T 171/84); if they contain references which direct the reader to further articles dealing with specific problems, these articles too may be counted as part of such knowledge (see T 206/83). Information does not become common general knowledge because it has been published in a particular textbook, reference work, etc.; on the contrary, it appears in books of this kind because it is already common general knowledge (see T 766/91). This means that the information in such a publication must have already become part of common general knowledge some time before the date of publication.

4. Obviousness

Thus the question to consider, in relation to any claim defining the invention, is whether before the filing or priority date valid for that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is not allowable for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty (see G-VI, 3), it is fair to construe any published document in the light of knowledge up to and including the day before the filing or priority date valid for the claimed invention and to have regard to all the knowledge generally available to the person skilled in the art up to and including that day.

5. Problem-solution approach

In order to assess inventive step in an objective and predictable manner, the so-called "**problem-solution approach**" is applied.

In the problem-solution approach, there are three main stages:

(i) determining the "closest prior art",

(ii) establishing the "objective technical problem" to be solved, and

(iii) considering whether or not the claimed invention, starting from the closest prior art and the objective technical problem, would have been obvious to the skilled person.

5.1 Determination of the closest prior art

The closest prior art is that which in one single reference discloses the combination of features which constitutes the most promising starting point for a development leading to the invention. In selecting the closest prior art, the first consideration is that it must be directed to a similar purpose or effect as the invention or at least belong to the same or a closely related technical field as the claimed invention. In practice, the closest prior art is generally that which corresponds to a similar use and requires the minimum of structural and functional modifications to arrive at the claimed invention (see T 606/89).

In some cases there are several equally valid starting points for the assessment of inventive step, e.g. if the skilled person has a choice of several workable solutions, i.e. solutions starting from different documents, which might lead to the invention. If a patent is to be granted, it may be necessary to apply the problem-solution approach to each of these starting points in turn, i.e. in respect of all these workable solutions.

However, applying the problem-solution approach from different starting points, e.g. from different prior-art documents, is only required if it has been convincingly shown that these documents are equally valid springboards. In particular in opposition proceedings the structure of the problem-solution approach is not that of a forum where the opponent can freely develop as many inventive step attacks as desired in the hope that one of said attacks has the chance of succeeding (T 320/15, Reasons 1.1.2).

In the event of refusal or revocation, it is sufficient to show on the basis of one relevant piece of prior art that the claimed subject-matter lacks an inventive step: there is no need to discuss which document is "closest" to the invention; the only relevant question is whether the document used is a feasible starting point for assessing inventive step (see T 967/97, T 558/00, T 21/08, T 308/09 and T 1289/09). This is valid even if the problem identified in a problem-solution reasoning may be different from the one identified by the applicant/patentee.

As a consequence the applicant or proprietor cannot refute the argument that the claimed subject-matter lacks inventive step by submitting that a more promising springboard is available: a piece of prior art on the basis of which the claimed invention is considered non-obvious cannot be "closer" than a document on the basis of which the claimed invention appears obvious, because it is evident in this situation that the former does not represent the most promising springboard from which to arrive at the invention (T 1742/12, Reasons 6.5; T 824/05, Reasons 6.2).

The closest prior art must be assessed from the skilled person's point of view on the day before the filing or priority date valid for the claimed invention. The examiner must not make an artificial interpretation of the

closest prior art based on prior knowledge of the application (see also G-VII, 8).

In identifying the closest prior art, account is taken of what the applicant acknowledges in the description and claims to be known. Any such acknowledgement of known art is regarded by the examiner as being correct, unless the applicant states that a mistake was made (see C-IV, 7.2(vii)).

5.2 Formulation of the objective technical problem

In the second stage, one establishes in an objective way the **technical problem** to be solved. To do this one studies the application (or the patent), the closest prior art and the difference (also called "the **distinguishing feature(s)**" of the claimed invention) in terms of features (either structural or functional) between the claimed invention and the closest prior art, identifies the technical effect resulting from the distinguishing features, and then formulates the technical problem.

Features which cannot be seen to make any contribution, either independently or in combination with other features, to the technical character of an invention cannot support the presence of an inventive step (see T 641/00). Such a situation can occur for instance if a feature only contributes to the solution of a non-technical problem, for instance a problem in a field excluded from patentability. For the treatment of claims comprising technical and non-technical features, see G-VII, 5.4. The criteria for determining whether a feature, even if non-technical in isolation, contributes to producing a technical effect in the context of the invention are explained in G-II, 3 and subsections, for different types of subject-matter listed under Art. 52(2).

In the context of the problem-solution approach, the technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the invention provides over the closest prior art. The technical problem thus defined is often referred to as the "**objective technical problem**".

The objective technical problem derived in this way may not be what the applicant presented as "the problem" in the application. The latter may require reformulation, since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the application was filed. In particular, the prior art cited in the search report may put the invention in an entirely different perspective from that apparent from reading the application only. Reformulation might lead to the objective technical problem being less ambitious than originally envisaged by the application. An example of such a case would be where the originally stated problem is the provision of a product, process or method demonstrating some improvement, but where there is no evidence that the claimed subject-matter is thereby improved over the closest prior art uncovered in the search; rather, there is only evidence with respect to more distantly related prior art (or possibly none at all). In this case, the problem

has to be reformulated as the provision of an alternative product, process or method. The obviousness of the claimed solution to that reformulated problem must then be assessed in the light of the cited prior art (see T 87/08).

The extent to which such reformulation of the technical problem is possible has to be assessed on the merits of each particular case. As a matter of principle any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the application as filed (see T 386/89). It is also possible to rely on new effects submitted subsequently during the proceedings by the applicant, provided that the skilled person would recognise these effects as implied by or related to the technical problem initially suggested (see G-VII, 11 and T 184/82).

It is noted that the objective technical problem must be so formulated as not to contain pointers to the technical solution, since including part of a technical solution offered by an invention in the statement of the problem must, when the state of the art is assessed in terms of that problem, necessarily result in an *ex post facto* view being taken of inventive activity (see T 229/85). Where the claim refers to an aim to be achieved in a non-technical field, however, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem to be solved, in particular as a constraint that has to be met (see G-VII, 5.4 and G-VII, 5.4.1).

The expression "technical problem" is interpreted broadly; it does not necessarily imply that the technical solution is an improvement to the prior art. Thus the problem could be simply to seek an alternative to a known device or process which provides the same or similar effects or is more cost-effective. A technical problem may be regarded as being solved only if it is credible that substantially all claimed embodiments exhibit the technical effects upon which the invention is based. Criteria for deciding whether lack of reproducibility of the claimed invention is to be treated under Art. 56 or 83 are explained in F-III, 12.

Sometimes, the objective technical problem must be regarded as an aggregation of a plurality of "**partial problems**". This is the case where there is no technical effect achieved by all the distinguishing features taken in combination, but rather a plurality of partial problems is independently solved by different sets of distinguishing features (see G-VII, 6 and T 389/86).

5.3 Could-would approach

In the third stage the question to be answered is whether there is any teaching in the prior art as a whole that **would** (not simply could, but would) have prompted the skilled person, faced with the objective technical problem, to modify or adapt the closest prior art while taking account of that teaching, thereby arriving at something falling within the terms of the claims, and thus achieving what the invention achieves (see G-VII, 4).

In other words, the point is not whether the skilled person could have arrived at the invention by adapting or modifying the closest prior art but whether the skilled person **would have done** so because the prior art provided motivation to do so in the expectation of some improvement or advantage (see T 2/83). Even an implicit prompting or implicitly recognisable incentive is sufficient to show that the skilled person would have combined the elements from the prior art (see T 257/98 and T 35/04). This must have been the case for the skilled person before the filing or priority date valid for the claim under examination.

When an invention requires various steps to arrive at the complete solution of the technical problem, it is nevertheless regarded as obvious if the technical problem to be solved leads the skilled person to the solution in a step-by-step manner and each individual step is obvious in the light of what has already been accomplished and of the residual task still to be solved (see T 623/97 and T 558/00).

5.4 Claims comprising technical and non-technical features

It is legitimate to have a mix of technical and non-technical features appearing in a claim, as is often the case with computer-implemented inventions. The non-technical features may even form a major part of the claimed subject-matter. However, in the light of Art. 52(1), (2) and (3), the presence of an inventive step under Art. 56 requires a non-obvious technical solution to a technical problem (T 641/00, T 1784/06).

When assessing the inventive step of such a mixed-type invention, all those features which contribute to the technical character of the invention are taken into account. These also include the features which, when taken in isolation, are non-technical, but do, in the context of the invention, contribute to producing a technical effect serving a technical purpose, thereby contributing to the technical character of the invention. However, features which do not contribute to the technical character of the invention cannot support the presence of an inventive step ("COMVIK approach", T 641/00, G 1/19). Such a situation may arise, for instance, if a feature contributes only to the solution of a non-technical problem, e.g. a problem in a field excluded from patentability (see G-II, 3 and subsections).

The problem-solution approach is applied to mixed-type inventions in such a way as to ensure that inventive step is not acknowledged on the basis of features not contributing to the technical character of the invention, while all those features which do contribute are properly identified and taken into account in the assessment. To this end, where the claim refers to an aim to be achieved in a non-technical field, this aim may legitimately appear in the formulation of the objective technical problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met (T 641/00; see step (iii)(c) below and G-VII, 5.4.1).

The steps below outline the application of the problem-solution approach to mixed-type inventions following the COMVIK approach:

(i) The features which contribute to the technical character of the invention are determined on the basis of the technical effects achieved in the context of the invention (see G-II, 3.1 to 3.7).

(ii) A suitable starting point in the prior art is selected as the closest prior art with a focus on the features contributing to the technical character of the invention identified in step (i) (see G-VII, 5.1).

(iii) The differences from the closest prior art are identified. The technical effect(s) of these differences, in the context of the claim as a whole, is(are) determined in order to identify from these differences the features which make a technical contribution and those which do not.

(a) If there are no differences (not even a non-technical difference), an objection under Art. 54 is raised.

(b) If the differences do not make any technical contribution, an objection under Art. 56 is raised. The reasoning for the objection is that the subject-matter of a claim cannot be inventive if there is no technical contribution to the prior art.

(c) If the differences include features making a technical contribution, the following applies:

– The objective technical problem is formulated on the basis of the technical effect(s) achieved by these features. In addition, if the differences include features making no technical contribution, these features, or any non-technical effect achieved by the invention, may be used in the formulation of the objective technical problem as part of what is "given" to the skilled person, in particular as a constraint that has to be met (see G-VII, 5.4.1).

– If the claimed technical solution to the objective technical problem is obvious to the person skilled in the art, an objection under Art. 56 is raised.

Determination of the features contributing to the technical character of the invention should be performed for all claim features in step (i) (T 172/03, T 154/04). However, in practice, due to the complexity of this task, the examiner can normally perform the determination in step (i) on a first-glance basis only and perform the analysis at the beginning of step (iii) in a more detailed manner. In step (iii), the technical effects achieved by the differences over the selected closest prior art are determined. The extent to which the differences contribute to the technical character of the invention is analysed in relation to these technical effects. This analysis, limited to the differences, can be performed in a more detailed manner and on a more concrete basis than the one performed at step (i). It may therefore reveal

that some features considered in step (i) at first glance as not contributing to the technical character of the invention do, on closer inspection, make such a contribution. The reverse situation is also possible. In such cases, the selection of the closest prior art in step (ii) might need to be revised.

When performing the analysis in steps (i) and (iii) above, care must be taken to avoid missing any features that might contribute to the technical character of the claimed subject-matter, in particular if the examiners reproduce their understanding of the subject-matter of the claim in their own words during the analysis (T 756/06).

The examples in G-VII, 5.4.2.1 to 5.4.2.5 illustrate the application of the COMVIK approach.

5.4.1 Formulation of the objective technical problem for claims comprising technical and non-technical features

The objective technical problem must be a technical problem which the skilled person in the particular technical field might have been asked to solve at the relevant date. It must not be formulated in such a way as to refer to matters of which the skilled person would only have become aware by knowledge of the solution claimed (G-VII, 5.2). In other words, the objective technical problem must be so formulated as not to contain pointers to the technical solution. However, this principle only applies to those features of the subject-matter claimed which contribute to the technical character of the invention and hence are part of the technical solution. Merely because some feature appears in the claim does not automatically exclude it from appearing in the formulation of the problem. In particular, where the claim refers to an aim to be achieved in a non-technical field, this aim may legitimately appear in the formulation of the problem as part of the framework of the technical problem that is to be solved, in particular as a constraint that has to be met (T 641/00).

In other words, the formulation of the objective technical problem may refer to features which do not make a technical contribution, or to any non-technical effect achieved by the invention, as a given framework within which the technical problem is posed, for example in the form of a requirements specification provided to the person skilled in a technical field. The aim of formulating the technical problem according to these principles is to ensure that inventive step is acknowledged only on the basis of features which contribute to the technical character of the invention. The technical effects used for formulating the objective technical problem have to be derivable from the application as filed when considered in the light of the closest prior art. They must be achieved over the whole scope of the claim. A claim must therefore be limited in such a way that substantially all embodiments encompassed by the claim show these effects (G 1/19, G-VII, 5.2).

For technical effects which are not directly achieved by the claimed invention but are only "potential technical effects", see G-II, 3.3.2.

Regarding technical effects arising from specific technical implementations where the design of algorithms is motivated by technical considerations of the internal functioning of the computer, see G-II, 3.3.

In the case of claims directed to a technical implementation of a non-technical method or scheme, in particular of a business method or game rules, a modification to the underlying non-technical method or scheme aimed at circumventing a technical problem, rather than addressing this problem in an inherently technical way, is not considered to make a technical contribution over the prior art (T 258/03, T 414/12). Rather, such a solution constitutes a modification to the constraints given to the technically skilled person tasked with the implementation of the given non-technical method or scheme.

In such cases, consideration must be given to any further technical advantages or effects associated with the specific features of the technical implementation over and above the effects and advantages inherent in the underlying non-technical method or scheme. The latter are at best to be regarded as incidental to that implementation (T 1543/06). They do not qualify as technical effects for the purpose of defining the objective technical problem.

Example

In a game played online over a distributed computer system, the effect of reduction in network traffic obtained by reducing the maximum number of players cannot form the basis for formulating the objective technical problem. It is rather a direct consequence of changing the rules of the game, which is inherent in the non-technical scheme. The problem of network traffic reduction is not addressed by a technical solution but circumvented by the non-technical gaming solution offered. The feature defining the maximum number of players thus constitutes a given constraint which forms part of the non-technical scheme that the skilled person, e.g. a software engineer, would be tasked to implement. Whether the claimed specific technical implementation would have been obvious to the skilled person would still have to be assessed.

5.4.2 Examples of applying the COMVIK approach

The following examples aim at illustrating the application of the COMVIK approach using the steps listed in G-VII, 5.4 in various scenarios. The scenarios are adapted from case law. The claims are greatly simplified for illustrative purposes.

5.4.2.1 Example 1

Claim 1:

Method of facilitating shopping on a mobile device wherein:

(a) the user selects two or more products to be purchased;

(b) the mobile device transmits the selected products data and the device location to a server;

(c) the server accesses a database of vendors to identify vendors offering at least one of the selected products;

(d) the server determines, on the basis of the device location and the identified vendors, an optimal shopping tour for purchasing the selected products by accessing a cache memory in which optimal shopping tours determined for previous requests are stored; and

(e) the server transmits the optimal shopping tour to the mobile device for displaying.

Application of the steps of the problem-solution approach according to G-VII, 5.4:

Step (i): The features contributing to the technical character are at first glance identified as a distributed system comprising a mobile device connected to a server computer which has a cache memory and is connected to a database.

Step (ii): Document D1, which discloses a method for facilitating shopping on a mobile device wherein the user selects a single product and the server determines from a database the vendor selling the selected product nearest to the user and transmits this information to the mobile device, is selected as the closest prior art.

Step (iii): The differences between the subject-matter of claim 1 and D1 are:

(1) The user can select two or more products to purchase (instead of a single product only).

(2) An "optimal shopping tour" for purchasing the two or more products is provided to the user.

(3) The optimal shopping tour is determined by the server by accessing a cache memory in which optimal shopping tours determined for previous requests are stored.

Differences (1) and (2) represent modifications of the underlying business concept, since they define producing an ordered list of shops to visit which sell these products. No technical purpose is served, and no technical effects can be identified from these differences. Hence, these features make no technical contribution over D1. On the other hand, difference (3) makes a technical contribution as it relates to the technical implementation of differences (1) and (2) and has the technical effect of enabling rapid determination of the optimal shopping tour by accessing previous requests which are stored in a cache memory.

Step (iii)(c): The objective technical problem is to be formulated from the perspective of the person skilled in the art as an expert in a technical field (G-VII, 3). Such a person is not deemed to have any expertise in business-related matters. In the present case, the skilled person can be defined as an expert in information technology who gains knowledge of the business-related features (1) and (2) as part of the formulation of the technical problem to be solved, as would be the case in a realistic situation in the form of a requirement specification. The objective technical problem is thus formulated as how to modify the method of D1 to implement in a technically efficient manner the non-technical business concept defined by the differences (1) and (2), which is given as a constraint to be met.

Obviousness: Following requirement (1), it would have been a matter of routine for the skilled person to adapt the mobile device used in D1 so as to enable the user to select two or more products instead of a single one. It would also have been obvious to assign the task of determining the optimal shopping tour (arising from requirement (2)) to the server, by analogy with the server likewise determining the nearest vendor in D1. Since the objective technical problem further requires a technically efficient implementation, the skilled person would have looked for efficient technical implementations of the determination of a tour. A second document D2 discloses a travel planning system for determining travel trips, listing a set of places to visit, and addresses this technical problem: the system of D2 accesses for this purpose a cache memory storing results of previous queries. The skilled person would thus have considered the teaching of D2 and adapted the server in D1 to access and use a cache memory as suggested in D2 so as to provide a technically efficient implementation of the determination of the optimal shopping tour, i.e. difference (3). Hence, no inventive step is involved within the meaning of Art. 52(1) and 56.

Remarks: The example shows a typical application of the approach developed in T 641/00 (COMVIK). The analysis of technical effects is performed in detail at step (iii) to see if the differences from the closest prior art comprise features making a technical contribution. This analysis refines the initial finding of step (i) by identifying the feature of accessing the cache memory for results of previous requests in the step of determining the tour as a technical feature. Note that in this case step (i) would not need to be indicated explicitly in the reasoning. In step (iii)(c), the non-technical modifications to the business concept are given to the skilled person as a constraint to be met. Whether or not the new business concept is innovative is here irrelevant for the assessment of inventive step, which has to be based on the features of its technical implementation.

5.4.2.2 Example 2

Claim 1:

A computer-implemented method for brokering offers and demands in the field of transporting freight, comprising the following steps:

(a) receiving transportation offers/demands from users, including location and time data;

(b) receiving current location information of the users from GPS terminals with which the users are equipped;

(c) after receiving a new offer/demand request, verifying if there are previous offers/demands not yet satisfied that can respond to the new request;

(d) if so, selecting the one for which the current locations of both users are closest; and

(e) otherwise storing the new request.

Application of the steps of the problem-solution approach according to G-VII, 5.4:

Step (i): Underlying the claimed method is the following business method:

A method for brokering offers and demands in the field of freight transportation, comprising:

– receiving transportation offers/demands from users, including location and time data;

– receiving information regarding the current location of the users;

– after receiving a new offer/demand request, verifying if there are previous offers/demands not yet satisfied that can respond to the new request;

– if so, selecting the one for which the current locations of both users are closest; and

– otherwise storing the new request.

Such a business method is *per se* non-technical and excluded under Art. 52(2)(c) and (3). Brokering offers and demands is a typical business activity. Using the geographical location of users is the kind of criterion which a transportation broker could specify as part of a business method based on non-technical, business considerations only. This business method does not serve any technical purpose in the context of the invention and thus does not contribute to its technical character.

Therefore, only the features related to the technical implementation of this business method can be identified as the features contributing to the technical character of the invention:

– The business method steps are carried out by a computer.

– The current location information is received from GPS terminals.

Step (ii): As a suitable starting point, document D1, which discloses a method of order management in which a server computer receives location information from GPS terminals, is selected as the closest prior art.

Step (iii): The difference between the subject-matter of claim 1 and D1 is thus the computer implementation of the steps of the business method defined above.

The technical effect of this difference is merely the automation of the business method underlying claim 1. The conclusion reached in step (i) holds, since the only distinguishing feature making a technical contribution is the technical implementation of this business method.

Step (iii)(c): The objective technical problem is formulated as how to adapt the method of D1 so as to implement the business method of brokering offers and demands according to the user's current location. The person skilled in the art is considered to be a software project team and is given the knowledge of the business method in the form of a requirement specification.

Obviousness: Adapting the method of D1 to execute the business method steps is straightforward and requires routine programming only. Therefore, no inventive step is involved within the meaning of Art. 52(1) and Art. 56.

Remarks: In this example, it was clear from the initial analysis at step (i) that underlying the claimed method was a method for brokering offers and demands, which as such is a business method. The features defining the business method were easily separable from the technical features of its computer implementation. Therefore, this example illustrates a line of argument in which it was possible in step (i) to determine all the features which contribute to the technical character of the invention and all those which do not. This line of argument pertains more to the field of computer-implemented business methods and might be less suitable in other fields.

5.4.2.3 Example 3

This example illustrates the two-level technicality analysis set forth in section G-VII, 5.4.

Claim 1:

A system for the transmission of a broadcast media channel to a remote client over a data connection, said system including:

(a) means for storing an identifier of the remote client and an indication of an available data rate of the data connection to the remote client, said available data rate being lower than the maximum data rate for the data connection to the remote client;

(b) means for determining a rate at which data is to be transmitted based on the indication of the available data rate of the data connection; and

(c) means for transmitting data at the determined rate to said remote client.

Application of the steps of the problem-solution approach according to G-VII, 5.4:

Step (i): At first glance, all features appear to contribute to the technical character of the invention.

Step (ii): Document D1, which discloses a system for broadcasting video over an xDSL connection to the set-top boxes of subscribers, is selected as the closest prior art. The system comprises a database storing identifiers of subscribers' computers and, in association with them, an indication of the maximum data rate for the data connection to each subscriber's computer. The system further comprises means for transmitting the video to a subscriber's computer at the maximum data rate stored for said computer.

Step (iii): The differences between the subject-matter of claim 1 and D1 are:

(1) Storing an indication of an available data rate of the data connection to the remote client, said available data rate being lower than the maximum data rate for the data connection to the remote client.

(2) Using said available data rate to determine the rate at which the data is transmitted to the remote client (instead of transmitting the data at the maximum data rate stored for said remote client as in D1).

The purpose served by using an "available data rate" which is lower than a maximum data rate for the data connection to the remote client is not apparent from the claim. Therefore, the relevant disclosure in the description is taken into account. In the description, it is explained that a pricing model is provided which allows a customer to choose from several service levels, each service level corresponding to an available data-rate option having a different price. A user may select an available data rate lower than the maximum data rate possible with the connection in order to pay less. Hence, using an available data rate which is lower than the maximum data rate for the connection to the remote client addresses the aim of allowing a customer to choose a data-rate service level according to that pricing model. This is not a technical aim, but an aim of a financial, administrative or commercial nature and thus falls under the exclusion of schemes, rules and methods for doing business in Art. 52(2)(c). It may thus be included in the formulation of the objective technical problem as a constraint to be met.

The features of *storing* the available data rate and of *using it to determine the rate at which the data is transmitted* have the technical effect of implementing this non-technical aim.

Step (iii)(c): The objective technical problem is therefore formulated as how to implement in the system of D1 a pricing model which allows the customer to choose a data-rate service level.

Obviousness: Given the task of implementing this choice of data-rate service level in accordance with the pricing model, it would be obvious to the skilled person that the data rate purchased by a subscriber (i.e. the "available data rate" of claim 1), which can only be lower or equal to the maximum data rate of the data connection to the subscriber's computer (i.e. the "remote client" of claim 1), would have to be stored for each subscriber and used by the system to determine the rate at which data is to be transmitted to a subscriber. Therefore, no inventive step is involved within the meaning of Art. 52(1) and Art. 56.

Remarks: This example illustrates a claim which involves a complex mix of technical and non-technical features. On a first-glance basis in step (i), all features appeared to contribute to the technical character of the invention. After comparison with D1, a detailed analysis of the technical character of the contribution made by the invention over D1 was possible at step (iii). This detailed analysis revealed that the differentiating features addressed a non-technical aim. This non-technical aim could thus be incorporated into the formulation of the objective technical problem (T 641/00).

5.4.2.4 Example 4

Claim 1:

A computer-implemented method of determining areas in which there is an increased risk of condensation for a surface in a building comprising the steps of:

(a) controlling an infrared (IR) camera to capture an image of the temperature distribution of the surface;

(b) receiving mean values for the air temperature and the relative air humidity measured inside the building over the last 24 hours;

(c) calculating, based on said mean air temperature and mean relative air humidity, a condensation temperature at which there is a risk of condensation on the surface;

(d) comparing the temperature at each point on the image to said calculated condensation temperature;

(e) identifying the image points having a temperature lower than the calculated condensation temperature as areas at increased risk of condensation on the surface; and

(f) modifying the image by colouring the image points identified in step (e) in a particular colour to indicate the areas at increased risk of condensation to a user.

Application of the steps of the problem-solution approach according to G-VII, 5.4:

Step (i): The control of an IR camera in step (a) clearly makes a technical contribution. The question is whether steps (b) to (f) also contribute to the technical character of the claimed subject-matter.

Considered in isolation, steps (b) to (e) relate to algorithmic/mathematical steps and step (f) defines a presentation of information. However, the claim is not directed to a mental act, a mathematical method or presentation of information as such (which would be excluded from patentability under Art. 52(2)(a), (c), (d) and (3)) because the claimed subject-matter involves technical means such as a computer.

Therefore, it has to be assessed whether the algorithmic and mathematical steps as well as the step related to presentation of information do, in the context of the invention, contribute to producing a technical effect, thereby contributing to the technical character of the invention.

Since the above-mentioned algorithmic and mathematical steps (b) to (e) are used to predict the physical state (condensation) of an existing real object (surface) from measurements of physical properties (IR image, measured air temperature and relative air humidity over time), they contribute to a technical effect serving a technical purpose. This applies regardless of what use is made of the output information about the risk of condensation on the surface (see G-II, 3.3, in particular subsection "Technical applications"). Thus, steps (b) to (e) contribute also to the technical character of the invention.

A decision on whether step (f) makes a technical contribution is deferred to step (iii) below.

Step (ii): Document D1 discloses a method for monitoring a surface to determine the risk of condensation forming on it. The risk of condensation is determined based on the difference of the temperature reading obtained via an IR pyrometer for a single point on the surface and the condensation temperature calculated based on the actual ambient air temperature and the relative air humidity. The numerical value of the difference is then shown to a user as an indication of the likelihood of condensation at said point. This document is taken as the closest prior art.

Step (iii): The differences between the subject-matter of claim 1 and D1 are:

(1) an *IR camera* is used (instead of the IR pyrometer of D1, which only captures the temperature at a single point of the surface);

(2) *mean* values for air temperature and relative air humidity measured inside the building *over the last 24 hours* are received;

(3) the condensation temperature is calculated *on the basis of the mean air temperature and mean relative air humidity* and compared to the temperature at each point on the IR image of the surface;

(4) image points having a temperature lower than the calculated condensation temperature are identified as *areas* at increased risk of condensation on the surface;

(5) *colours* are used to indicate areas at increased risk of condensation.

As mentioned above, distinguishing features (1)-(4) contribute to the technical character of the claimed subject-matter and must be taken into consideration for the formulation of the technical problem. These features produce the technical effect of a more precise and reliable prediction of the risk of condensation as a result of considering all surface areas (as opposed to a single point) and accounting for temperature variations during a day.

Distinguishing feature (5) defines a particular manner of presenting information to a user (Art. 52(2)(d)) which does not produce a technical effect since any effect of the choice of displaying data using colours rather than numerical values depends on subjective preferences of the user: some users may prefer the former and other the latter (see G-II, 3.7). This feature thus does not make a technical contribution. It cannot support the presence of an inventive step and is not discussed further in the analysis since it has no bearing on the other distinguishing features.

Step (iii)(c): The objective technical problem is therefore formulated as how to determine the risk of condensation on a surface in a more precise and reliable manner.

Obviousness: The use of an IR camera for obtaining temperature readings on a surface can be considered a normal technical development in the field of thermography without exercising any inventive activity: IR cameras were well known at the effective date of the application. Using an IR camera is a straightforward alternative to measuring the temperature at several points on the monitored surface using an IR pyrometer for the skilled person to arrive at a temperature distribution of the surface.

However, D1 does not suggest considering a temperature distribution on a surface (as opposed to at a single point) and calculating mean values for air temperature and taking relative air humidity measured inside the building over the last 24 hours into consideration. Neither does it suggest taking into account different conditions which may realistically occur inside the building over time for predicting the risk of condensation.

Assuming that no other prior art suggests the technical solution of the objective technical problem defined by distinguishing features (1)-(4), the subject-matter of claim 1 involves an inventive step.

Remarks: This example illustrates the situation addressed in G-VII, 5.4, second paragraph: features which, when taken in isolation, are

non-technical but do, in the context of the claimed invention, contribute to producing a technical effect serving a technical purpose (features (b) to (e), which are algorithmic/mathematical steps). Since said features contribute to the technical character of the invention, they may support the presence of an inventive step.

5.4.2.5 Example 5

Claim 1:

A method for coating a workpiece using a thermal spray coating process, the method comprising:

(a) applying, using a spray jet, a material to the workpiece by thermal spray coating;

(b) monitoring the thermal spray coating process in real time by detecting properties of particles in the spray jet and supplying the properties as actual values;

(c) comparing the actual values with target values;

and, in the event that the actual values deviate from the target values,

(d) adjusting process parameters for the thermal spray coating process automatically by a controller on the basis of a neural network, said controller being a neuro-fuzzy controller which combines a neural-network and fuzzy logic rules and thereby maps statistical relationships between input variables and output variables of the neuro-fuzzy controller.

Background: The invention relates to the control of an industrial process, i.e. thermal spray coating of a workpiece. The material used for the coating is injected with the help of a carrier gas into the high-temperature jet, where it is accelerated and/or molten. The properties of the resulting coatings are subject to great fluctuations, even with seemingly constant parameters of the coating operation. The spray jet is monitored visually with a CCD camera. The image picked up by the camera is sent to an image processing system, from which the properties of particles in the spray jet (e.g. velocity, temperature, size, etc) can be derived. A neuro-fuzzy controller is a mathematical algorithm which combines a neural network with fuzzy-logic rules.

Application of the steps of the problem-solution approach according to COMVIK:

Step (i): The method is directed at thermal spray coating, i.e. a specific technical process, comprising various concrete technical features, e.g. particles, workpiece, a spray coating device (implicit).

Step (ii): Document D1 discloses a method for the control of a thermal spray coating process by applying material to a workpiece using a spray jet,

detecting deviations in the properties of the particles in said spray jet and adjusting process parameters automatically on the basis of the outcome of a neural network analysis. This document represents the closest prior art.

Step (iii): The difference between the method of claim 1 and D1 concerns the use of a neuro-fuzzy controller combining a neural network and fuzzy logic rules as specified in the second part of step (d).

Computational models and algorithms related to artificial intelligence are, on their own, of an abstract mathematical nature (G-II, 3.3.1). The feature of combining results of a neural network analysis and fuzzy logic defines a mathematical method when taken on its own. However, together with the feature of adjusting the process parameters, it contributes to the control of the coating process. Hence, the output of the mathematical method is directly used in the control of a specific technical process.

Control of a specific technical process is a technical application, see G-II, 3.3 (subsection "Technical applications"). In conclusion, the differentiating feature contributes to producing a technical effect serving a technical purpose and thereby contributes to the technical character of the invention. Therefore, it is taken into account in the assessment of inventive step.

Step (iii)(c): The objective technical problem must be derived from technical effects that are based on objectively established facts and that are directly and causally related to the technical features of the claim.

In the present case, the mere fact that the parameters are calculated using a combination of results of a neural network analysis and fuzzy logic – without any details on specific adaptation to the thermal spray coating process – cannot credibly ensure any technical effect beyond a different adjustment of the process parameters. In particular, no evidence can be found to acknowledge any increase in the quality of coating properties or of the thermal spraying method that would result from the combination of features of claim 1. In the absence of such evidence, the objective technical problem is to provide an alternative solution to the problem of adjusting the process parameters which control the thermal spray coating process which is already solved in D1.

Obviousness: Starting from the teaching of D1 and tasked with the above objective technical problem, the person skilled in the field of control engineering (G-VII, 3) would look for an alternative solution to determine the control parameters of the process.

A second prior-art document D2 discloses a combination of a neural network and fuzzy logic rules providing a neuro-fuzzy controller in the technical field of control engineering. From this prior art, it has become apparent that at the date of filing of the application, neuro-fuzzy controllers were well known and applied in the field of control engineering. The present solution is therefore considered to be an obvious alternative, rendering the subject-matter of claim 1 not inventive.

Remarks: This example illustrates the case where a mathematical feature which, when taken in isolation, is non-technical but contributes to producing a technical effect serving a technical purpose in the context of the claim. The feature of using a combination of neural network results and fuzzy logic for adjusting process parameters for controlling thermal spraying contributes to the technical character of the invention and may therefore support the presence of an inventive step.

However, in the present case, claim 1 does not contain any information about the coating properties to be achieved. The input and output variables of the neuro-fuzzy controller, how the controller is trained or how the output is used in the regulation of the process parameters are not defined. No features of the neuro-fuzzy controller are linked to any technical properties of the spray coating. The neuro-fuzzy controller is therefore not adapted for the specific application of thermal spray coating. There is no evidence of any particular technical effect which is credibly achieved over the whole claimed scope other than that of providing different process parameters as input to the controller.

6. Combining pieces of prior art

In the context of the problem-solution approach, it is permissible to combine the disclosure of one or more documents, parts of documents or other pieces of prior art (e.g. a public prior use or unwritten general technical knowledge) with the closest prior art. However, the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be an indication of the presence of an inventive step, e.g. if the claimed invention is not a mere aggregation of features (see G-VII, 7).

A different situation occurs where the invention is a solution to a plurality of independent "partial problems" (see G-VII, 7 and 5.2). Indeed, in such a case it is necessary to separately assess, for each partial problem, whether the combination of features solving the partial problem is obviously derivable from the prior art. Hence, a different document can be combined with the closest prior art for each partial problem (see T 389/86). For the subject-matter of the claim to be inventive, it suffices however that one of these combinations of features involves an inventive step.

In determining whether it would be obvious to combine two or more distinct disclosures, the examiner also has regard in particular to the following:

(i) whether the content of the disclosures (e.g. documents) is such as to make it likely or unlikely that the person skilled in the art, when faced with the problem solved by the invention, would combine them – for example, if two disclosures considered as a whole could not in practice be readily combined because of inherent incompatibility in disclosed features essential to the invention, the combining of these disclosures is not normally regarded as obvious;

(ii) whether the disclosures, e.g. documents, come from similar, neighbouring or remote technical fields (see G-VII, 3);

(iii) the combining of two or more parts of the same disclosure would be obvious if there is a reasonable basis for the skilled person to associate these parts with one another. It would normally be obvious to combine with a prior-art document a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the **common general knowledge** in the art. It would, generally speaking, also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other (for references which are considered an integral part of the disclosure, see G-IV, 5.1 and G-VI, 1). In determining whether it is permissible to combine a document with an item of prior art made public in some other way, e.g. by use, similar considerations apply.

7. Combination vs. juxtaposition or aggregation

The invention claimed must normally be considered as a whole. When a claim consists of a "combination of features", it is not correct to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. However, where the claim is merely an "aggregation or juxtaposition of features" and not a true combination, it is enough to show that the individual features are obvious to prove that the aggregation of features does not involve an inventive step (see G-VII, 5.2, last paragraph). A set of technical features is regarded as a combination of features if the functional interaction between the features achieves a combined technical effect which is different from, e.g. greater than, the sum of the technical effects of the individual features. In other words, the interactions of the individual features must produce a synergistic effect. If no such synergistic effect exists, there is no more than a mere aggregation of features (see T 389/86 and T 204/06).

For example, the technical effect of an individual transistor is essentially that of an electronic switch. However, transistors interconnected to form a microprocessor synergically interact to achieve technical effects, such as data processing, which are over and above the sum of their respective individual technical effects (see also G-VII, Annex, 2).

According to T 9/81, patentability has been accepted for a preparation in the form of a "kit-of-parts" in which the individual active compounds, representing known therapeutic agents, are physically separated, provided that the use of those compounds, either simultaneously, separately or sequentially, produces a new and unexpected joint therapeutic effect which cannot be attained by the compounds independently of each other.

8. "*Ex post facto*" analysis

An invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated, it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner must be wary of *ex post facto* analysis of this kind. When combining documents cited in the search report, it always has to be borne in mind that the documents produced in the search have, of necessity, been obtained with

foreknowledge of what matter constitutes the alleged invention. In all cases the examiner must attempt to visualise the overall state of the art confronting the skilled person before the applicant's contribution, and must seek to make a "real-life" assessment of this and other relevant factors. The examiner has to take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage which is new and surprising and which is not merely achieved as a bonus effect in a "one-way street" situation (see G-VII, 10.2), and this technical advantage can convincingly be related to one or more of the features included in the claim defining the invention, the examiner has to be hesitant in pursuing an objection that such a claim lacks inventive step.

9. Origin of an invention

While the claim must in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that an invention may, for example, be based on the following:

(i) the devising of a solution to a known problem;

Example: the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze-branding") consists in applying the discovery that the hide can be permanently depigmented by freezing.

(ii) the arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious);

Example: the agreeable flavour of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious.

Many inventions are of course based on a combination of the above possibilities – e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

10. Secondary indicators

10.1 Predictable disadvantage; non-functional modification; arbitrary choice

If an invention is the result of a foreseeable disadvantageous modification of the closest prior art, which the skilled person could clearly predict and correctly assess, and if this predictable disadvantage is not accompanied by an unexpected technical advantage, then the claimed invention does not involve an inventive step (see T 119/82 and T 155/85). In other words, a mere foreseeable worsening of the prior art does not involve an inventive step. However, if this worsening is accompanied by an unexpected

technical advantage, an inventive step might be present. Similar considerations apply to the case where an invention is merely the result of an arbitrary non-functional modification of a prior-art device or of a mere arbitrary choice from a host of possible solutions (see T 72/95 and T 939/92).

10.2 Unexpected technical effect; bonus effect

An unexpected technical effect may be regarded as an indication of inventive step. It must, however, derive from the subject-matter as claimed, not merely from some additional features which are mentioned only in the description. The unexpected effect must be based on the characterising features of the invention, in combination with the known features of the claim. It cannot be based merely on features which are, in combination, already comprised in the prior art.

However, if, having regard to the state of the art, it would already have been obvious for a skilled person to arrive at something falling within the terms of a claim, for example due to a lack of alternatives thereby creating a "one-way street" situation, the unexpected effect is merely a bonus effect which does not confer inventiveness on the claimed subject-matter (see T 231/97 and T 192/82). If the skilled person would have to choose from a range of possibilities, there is no one-way street situation and the unexpected effect may very well lead to the recognition of an inventive step.

The unexpected property or effect must be described in precise terms. A vague statement such as "The new compounds have shown unexpectedly good pharmaceutical properties" cannot support the presence of an inventive step.

However, the product or process does not have to be "better" than known products or processes. It is sufficient that the property or effect would not have been expected.

10.3 Long-felt need; commercial success

Where the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need, this may be regarded as an indication of inventive step.

Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

11. Arguments and evidence submitted by the applicant

The relevant arguments and evidence to be considered by the examiner for assessing inventive step may be either taken from the originally-filed patent application or submitted by the applicant during the subsequent proceedings (see G-VII, 5.2 and H-V, 2.2 and 2.4).

Care must be taken, however, whenever new effects in support of inventive step are referred to. Such new effects can only be taken into account if they are implied by or at least related to the technical problem initially suggested in the originally filed application (see also G-VII, 5.2, T 386/89 and T 184/82).

Example of such a new effect:

The invention as filed relates to a pharmaceutical composition having a specific activity. At first sight, having regard to the relevant prior art, it would appear that there is a lack of inventive step. Subsequently, the applicant submits new evidence which shows that the claimed composition exhibits an unexpected advantage in terms of low toxicity. In this case, it is allowable to reformulate the technical problem by including the aspect of toxicity, since pharmaceutical activity and toxicity are related in the sense that the skilled person would always contemplate the two aspects together.

The reformulation of the technical problem may or may not give rise to amendment or insertion of the statement of the technical problem in the description. Any such amendment is only allowable if it satisfies the conditions listed in H-V, 2.4. In the above example of a pharmaceutical composition, neither the reformulated problem nor the information on toxicity could be introduced into the description without infringing Art. 123(2).

12. Selection inventions

The subject-matter of selection inventions differs from the closest prior art in that it represents selected subsets or sub-ranges. If this selection is connected to a particular technical effect, and if no hints exist leading the skilled person to the selection, then an inventive step is accepted (this technical effect occurring within the selected range may also be the same effect as attained with the broader known range, but to an unexpected degree). The criterion of "seriously contemplating" mentioned in connection with the test for novelty of overlapping ranges must not be confused with the assessment of inventive step. For inventive step, it has to be considered whether the skilled person would have made the selection or would have chosen the overlapping range in the expectation of some improvement or advantage. If the answer is negative, then the claimed matter involves an inventive step.

The unexpected technical effect must apply to the entire range as claimed. If it occurs in only part of the claimed range, the claimed subject-matter does not solve the specific problem to which the effect relates, but only the more general problem of obtaining, for example, "a further product X" or "a further process Y" (see T 939/92).

Decision T 261/15 confirmed that the requirement for a sub-range to represent a purposive selection is a matter of inventive step and not necessary for establishing novelty (see also G-VI, 8).

13. Inventive step assessment in the field of biotechnology

In the field of biotechnology, obviousness is considered at hand not only when results are clearly predictable, but also when there is a reasonable expectation of success. In order to render a solution obvious, it is sufficient to establish that the skilled person would have followed the teaching of the prior art with a reasonable expectation of success. Likewise, a mere "try and see" attitude in light of the closest prior art does not necessarily render the solution inventive.

On the other hand, a "reasonable expectation of success" is not to be confused with the "hope to succeed". If researchers are aware when embarking on their research that, in order to reach a technical solution, they will need not only technical skill but also the ability to make the right non-trivial decisions along the way, this cannot be regarded as a "reasonable expectation of success".

For the assessment of inventive step of antibodies, see G-II, 5.6.2.

14. Dependent claims; claims in different categories

If the subject-matter of an independent claim is new and non-obvious, there is no need to investigate the novelty and non-obviousness of the subject-matter of any claims dependent thereon, except in situations where the subject-matter of a dependent claim has a later effective date than the independent claim and intermediate documents are to be considered (see F-VI, 2.4.3).

Similarly, if the subject-matter of a claim to a product is new and non-obvious there is no need to investigate the novelty and non-obviousness of the subject-matter of any claims for a process which inevitably results in the manufacture of that product or of any claims for a use of that product. In particular, analogy processes, i.e. processes which themselves would otherwise not involve an inventive step, are nevertheless patentable in so far as they provide a novel and inventive product (see T 119/82). However, in cases where the product, process and use claims have different effective dates, a separate examination as to novelty and inventive step may still be necessary in view of intermediate documents.

15. Examples

The annex to this chapter gives examples of circumstances where an invention may be regarded as obvious or where it may involve an inventive step. It is to be stressed that these examples are only for illustrative purposes and that the applicable principle in each case is "was it obvious to a person skilled in the art?" (see G-VII, 5). Examiners must avoid attempts to fit a particular case into one of these examples if it is not clearly applicable. Also, the list is not exhaustive.

Annex
Examples relating to the requirement of inventive step – indicators

1. Application of known measures?

1.1 Inventions involving the application of **known measures** in an obvious way and in respect of which an inventive step is therefore to be ruled out:

(i) The teaching of a prior-art document is incomplete and at least one of the possible ways of "**filling the gap**" which would naturally or readily occur to the skilled person results in the invention.

Example: The invention relates to a building structure made from aluminium. A prior-art document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) The invention differs from the known art merely in the use of **well-known equivalents** (mechanical, electrical or chemical).

Example: The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor.

(iii) The invention consists merely in a new use of a well-known material employing the **known properties** of that material.

Example: Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

(iv) The invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use ("**analogous substitution**").

Example: An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particular newly developed adhesive known to be suitable for polymer-metal bonding.

(v) The invention consists merely in the use of a known technique in a closely analogous situation ("**analogous use**").

Example: The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

1.2 Inventions involving the application of **known measures** in a **non-obvious** way and in respect of which an inventive step is therefore to be recognised:

(i) A known working method or means when used for a **different purpose** involves a new, **surprising effect.**

Example: It is known that high-frequency power can be used in **in**ductive butt welding. It should therefore be obvious that high-frequency power could also be used in **con**ductive butt welding with similar effect. However, if high-frequency power were used for the continuous conductive butt welding of coiled strip but without removing scale (such scale removal normally being necessary during conductive welding in order to avoid arcing between the welding contact and the strip), there is the unexpected additional effect that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric. In that case, an inventive step would exist.

(ii) A new use of a known device or material involves **overcoming technical difficulties** not resolvable by routine techniques.

Example: The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

2. Obvious combination of features?

2.1 Obvious and consequently **non-inventive combination** of features:

The invention consists merely in the **juxtaposition** or association of known devices or processes functioning in their normal way and not producing any non-obvious working interrelationship.

Example: Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

2.2 Not obvious and consequently **inventive combination** of features:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself. However, if the combination of features is a bonus effect, e.g. as the result of a "one-way street" situation, the combination might lack an inventive step.

Example: A mixture of medicines consists of a painkiller (analgesic) and a tranquilliser (sedative). It was found that through the addition of the tranquilliser, which intrinsically appeared to have no painkilling effect, the

analgesic effect of the painkiller was intensified in a way which could not have been predicted from the known properties of the active substances.

3. Obvious selection?

3.1 Obvious and consequently **non-inventive selection** among a number of known possibilities:

(i) The invention consists merely in choosing from a number of **equally likely alternatives**.

Example: The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a number of well-known alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

(ii) The invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of **normal design procedures**.

Example: The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner.

(iii) The invention can be arrived at merely by a **simple extrapolation** in a straightforward way from the known art.

Example: The invention is characterised by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapolation on a straight-line graph, obtainable from the known art, relating thermal stability to the content of substance X.

(iv) The invention consists merely in **selecting** particular chemical compounds or compositions (including alloys) **from a broad field**.

Example: The prior art includes disclosure of a chemical compound characterised by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or particular group of radicals from amongst those referred to as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior-art document

since the question would then be one of lack of novelty rather than obviousness). The resulting compounds:

(a) are neither described as having nor shown to possess any advantageous properties not possessed by the prior-art examples; or

(b) are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art, but these properties are ones which the persons skilled in the art would expect such compounds to possess, so that they are likely to be led to make this selection.

(v) The invention follows inevitably from developments in the prior art, in such a way that there was no choice between several possibilities (the "**one-way street**" situation).

Example: From the prior art it is known that when you reach a particular compound in a series of known chemical compounds, expressed in terms of the number of carbon atoms, there is a consistently increasing insecticidal effect as you move up the series. With regard to insecticidal effect, the next member of the series after the member previously known then lies in a "one-way street". If this member of the series, in addition to exhibiting the expected enhanced insecticidal effect, proves also to have the unexpected effect of being selective, i.e. of killing some insects but not others, it nevertheless remains obvious.

3.2 Not obvious and consequently **inventive selection** among a number of known possibilities:

(i) The invention involves **special selection** in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection producing **unexpected effects** in the operation of the process or the properties of the resulting product.

Example: In a process where substance A and substance B are transformed at high temperature into substance C, it was known that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130°C. It is now found that in the temperature range from 63 to 65°C, which previously had not been explored, the yield of substance C was considerably higher than expected.

(ii) The invention consists in selecting **particular** chemical compounds or compositions (including alloys) from a broad field, such compounds or compositions having **unexpected advantages**.

Example: In the example of a substituted chemical compound given at G-VII, Annex, 3.1(iv) above, the invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior disclosure. In this case, however, not

only does the selection embrace a particular area of the possible field, and result in compounds that can be shown to possess advantageous properties (see G-VII, 10 and H-V, 2.2) but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the advantageous properties.

4. Overcoming a technical prejudice?

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle.

Example: Drinks containing carbon dioxide are, after being sterilised, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

Part H

Amendments and Corrections

Contents

Chapter I – The right to amend

A European patent application or European patent may be amended in examination, opposition and limitation proceedings. With regard to amendments filed in such proceedings, there are a number of important aspects to consider. Firstly, amendments must be admissible, i.e. they must meet the requirements for being admitted into the proceedings (see H-II, H-III).

Secondly, amendments must be allowable, which means, in particular, that they must not:

(i) add to the application or patent subject-matter which was not disclosed in the application as originally filed (Art. 123(2))

(ii) introduce other deficiencies (such as lack of clarity in the claims – Art. 84)

(iii) extend the protection conferred by a granted patent (Art. 123(3)).

Chapters H-II and H-III deal with the admissibility of amendments, while Chapters H-IV and H-V deal with their allowability. Chapter H-VI is dedicated to the correction of errors.

Chapter II – Admissibility of amendments – general rules

1. Introduction

How the admissibility of amendments is assessed will depend on the type of procedure (examination, opposition or limitation) and on the stage of the proceedings, as detailed in the following sections.

2. Admissibility during examination procedure

2.1 Before receipt of the search report – Rule 137(1)

Rule 137(1)

In the case of a European patent application filed directly at the EPO (not via the PCT), it is not possible for the applicant to amend the application before receiving the European search report (Rule 137(1)).

In the case of a Euro-PCT application requiring a supplementary European search according to Art. 153(7), the applicant may amend the originally filed claims, description and/or drawings before the application is subject to the supplementary search either by maintaining amendments filed in the international phase under Art. 19 PCT and/or Art. 34(2)(b) PCT or by filing amendments on and/or after entry into the European phase under Rule 159(1)(b) and/or Rule 161(2) respectively (see also E-IX, 3 and B-III, 3.3.2).

For replies to an invitation under Rule 62a or 63, see H-II, 5.

2.2 After receipt of the search report – Rule 137(2)

Rule 137(2)

After receiving the European search report and the search opinion, applicants must respond to the search opinion (see B-XI, 8) and may amend the description, claims and drawings of their own volition, provided that the amendment and their reply are filed within the time limit for responding to the search opinion (see C-II, 1, C-II, 3.1 and C-III, 2.1). Likewise, for applications for which no supplementary European search report is prepared (see B-II, 4.3) when entering the European phase from the PCT, the applicant is required to respond to the WO-ISA, IPER or SISR where the ISA and, if applicable, the IPEA or SISA was the EPO (see E-IX, 3.1 and 3.2). This response to the WO-ISA, IPER or SISR may include amendments made by the applicant of their own volition to the description, claims and drawings. After expiry of the relevant time limit for the reply (or, if the applicant waives the remainder of the reply period, after the reply), the applicant may amend the application only with the consent of the examining division.

For applications:

Rule 71(1)

(i) for which no search opinion is prepared (see B-XI, 1.1 and B-XI, 7),

(ii) for which a search opinion was prepared, but where the search report was drawn up before 1 April 2010 (in which case Rule 70a does not apply and the applicant is not required to respond to the search opinion), or

(iii) which enter the European phase from the PCT, where the EPO was the ISA, IPEA or SISA and prepared a written opinion, but for which a communication under Rule 161 was already issued before 1 April 2010,

it is after receipt of the first communication from the examining division in examination proceedings that applicants may "of their own volition, amend once the description, claims and drawings", provided that the amendment and the reply are filed within the time limit for replying to that communication.

2.3 After receipt of the first communication – Rule 137(3)

Subsequent to the applicable event mentioned in H-II, 2.2, the prosecution of further amendments proposed by the applicant is within the discretion of the examining division. Giving the examining division this discretion is intended to ensure that the examination procedure is brought to a conclusion in as few actions as possible (see C-IV, 3). In exercising its discretion the examining division must consider all relevant factors; in particular, it must balance the applicant's interest in obtaining a patent which is legally valid and the EPO's interest in bringing the examination procedure to a close in an effective way (in accordance with the principles set out in G 7/93).

Furthermore, the exercise of discretion to refuse amendments under Rule 137(3) must be reasoned (see T 755/96). The examining division also cannot refuse to admit amendments in advance (T 1105/96; T 246/08).

As an exception to Rule 137(3), paragraph (b) of Rule 164(2) provides for a right to amend the application in response to the results of any search under Rule 164(2). This means that applicants may make amendments of their own volition once in response to the communication under Art. 94(3) to which the search results under Rule 164(2) are annexed (see also H-II, 7.4.1).

If an amendment is admitted, subsequent proceedings are based on the description, claims and drawings as amended. Admitting an amendment does not necessarily imply that the application as amended is allowable, i.e. free from any objection under the EPC.

In exercising its discretion under Rule 137(3), the examining division will take into account the circumstances of each individual case and the stage of the proceedings which the application has reached to date. A further important element is whether the applicant has already had sufficient opportunity to make amendments. In particular, amendments reintroducing deficiencies previously pointed out by the examining division and removed by the applicant are not admitted (see T 1326/11 and T 1064/04).

The applicant has to bear in mind that it is easier to secure an amendment at an earlier rather than at a later stage: the later amendments are filed, the more important the aspect of procedural economy becomes in balancing the interest of the applicant in obtaining a patent and the EPO's interest in bringing the examination procedure to a close (see T 951/97 and G 7/93).

On the other hand, amendments limiting a claim which is already considered allowable are normally admitted. The same applies to amendments improving the clarity of the description or claims in a clearly desirable manner (see T 1929/13).

If amendments clearly remedy a deficiency in response to the preceding communication, they are always admitted, provided they do not give rise to some new deficiency. *Art. 94(3)*

A further factor is the amount of alteration to the application documents involved. Extensive reworking of the description or claims may be a proper response to highly relevant further prior art of which the applicant has only just become aware (e.g. either through further citation by the examining division or through knowledge obtained from another source). Regarding less extensive amendments, the examining division will adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the EPO.

Additional reasons for not admitting amendments according to Rule 137(3) include the non-admittance of:

– auxiliary requests in certain circumstances (see H-III, 3.3.2.1), and

– a request filed in, or in preparation for, oral proceedings, where Rule 137(4) is not complied with in respect of the request in question (see H-III, 2.1.3),

for reasons of procedural economy (taking into account the applicant's right to comment according to Art. 113(1)).

Additional limitations on possible amendments of the application may apply if the European or supplementary European search report was a partial one due to Rule 63 or restricted in accordance with Rule 62a (see H-II, 6, and subparagraphs). *Rule 62a* *Rule 63* *Rule 137(5)*

Further limitations may apply after a remittal by a board of appeal under Art. 111(2).

2.3.1 Examples of the exercise of discretion under Rule 137(3)

2.3.1.1 Rule 137(3) in conjunction with Article 83

The examining division has raised an objection under Article 83 that the entire application, i.e. claims, description and drawings, does not disclose to a person skilled in the art how to carry out the invention without using inventive skill.

The examining division will not admit any (further) amendment under Rule 137(3) unless the applicant is able to demonstrate to the satisfaction of the examining division that the application contains enough information to enable the person skilled in the art to carry out the invention; for example

the applicant could demonstrate that an embodiment in the description is sufficiently disclosed for the person skilled in the art to put it into practice.

If the applicant cannot demonstrate the above, then the objection under Article 83 EPC can only be overcome by adding information to the application as filed, which usually infringes Article 123(2) EPC.

2.3.1.2 Rule 137(3) in conjunction with Article 123(2)

The examining division has raised an objection under Article 123(2) indicating that a certain feature introduced into the claims extends the subject-matter of the application as filed.

Unless the applicant is able to demonstrate to the satisfaction of the examining division that the application as filed disclosed this feature directly and unambiguously, the examining division will normally not admit under Rule 137(3) any further set of claims containing the feature in question.

2.3.1.3 Rule 137(3) in conjunction with Article 84 – missing essential feature

The examining division has raised an objection under Article 84 that the claims are missing an essential feature (see F-IV, 4.5).

Unless the applicant is able to demonstrate to the satisfaction of the examining division that the indicated feature is not essential for carrying out the invention, the examining division will normally not admit under Rule 137(3) any further set of claims not containing the feature in question.

2.3.1.4 Rule 137(3) in conjunction with auxiliary requests

See H-III, 3.3.2.1.

2.4 At an advanced stage of the proceedings

Rule 137(3)

Any request by an applicant to replace the text of the application on the basis of which a patent could be granted by a text that has been extensively revised is refused unless the applicant gives good reasons for proposing the changes only at this stage in the proceedings. This applies particularly in cases where the examining division has indicated that a version of the claims proposed by the applicant is grantable and that the applicant has only to bring the description into line with that version.

2.5 Amendments filed in reply to a Rule 71(3) communication

Rule 71(6)

If, in reply to the communication under Rule 71(3) and within the period specified in Rule 71(6), the applicant files a request for amendments and/or a correction of errors, the procedure is as defined in C-V, 4. This applies regardless of whether the request is an explicit request for amendment or is drafted as an approval which is conditional on the filed amendments and/or corrections.

2.5.1 Criteria for admitting such amendments

Decision G 7/93 dealt with the criteria to be applied when examining the admissibility of late-filed amendments in examination. The particular case to which that decision relates arose when the rules were differently

formulated, and in a situation where the applicant had already consented to the version proposed by the examining division. However, what was said by the Enlarged Board in that case can be considered generally applicable to new requests put forward at a late stage of the proceedings, i.e. when the applicant has already had at least one opportunity to amend the application and the examining division has already completed substantive examination of the application (see T 1064/04).

Rule 71(3)
Rule 137(3)

In particular, applying the principles of G 7/93 to amendments filed in response to the communication under Rule 71(3) (see C-V, 1 to C-V, 3) means that this communication does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure. In deciding whether to admit such amendments, a balance must be struck between the applicant's interest in obtaining a patent which is valid in all of the designated states and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. At this stage of the proceedings, the substantive examination has already been completed and the applicant has had the opportunity to amend the application and therefore normally only those amendments which do not appreciably delay the preparations for grant of the patent will be admitted under Rule 137(3). It is, however, appropriate to admit separate sets of claims for one or more designated states for which prior national rights exist (see H-III, 4.4).

The rejection of amendments proposed by the examining division in a Rule 71(3) communication which have been introduced without prior consultation and agreement of the applicant (C-V, 1.1) does not amount to a request for amendment to which discretion under Rule 137(3) applies.

2.5.2 Further course of proceedings

Rule 71(6)

If the examining division gives its consent under Rule 137(3) to these amendments and/or the correction and considers them allowable without issuing a further communication under Art. 94(3), it issues a second communication under Rule 71(3) based on the amended/corrected text (see C-V, 4.6), after which it then proceeds to the grant of the patent pursuant to Art. 97(1).

Rule 71a(2)

Where amendments or corrections are not admitted, or where they are admitted but not considered allowable, examination will be resumed (see C-V, 4.7).

2.5.3 Exceptional case where amendments must be admitted

Rule 137(3)

If the application was one of the exceptional cases (i), (ii) or (iii) mentioned in H-II, 2.2 and no communication under Art. 94(3) has preceded the communication under Rule 71(3), the applicant may amend the description, claims and drawings of their own volition (see C-III, 2; see also C-II, 3.1) within the time limit for replying to the communication under Rule 71(3). If the examining division finds that these amendments are allowable, a second communication according to Rule 71(3) is issued based on the text as amended (see C-V, 4.6).

However, if the examining division is of the opinion that the amendments are not allowable (a finding of inadmissibility with regard to these amendments not being possible), the examination procedure is normally resumed in accordance with C-V, 4.7.

2.5.4 Rule 137(4) applies to amendments filed at this stage

Amendments filed in reply to the communication under Rule 71(3) must satisfy the requirements of Rule 137(4) by identifying the amendments and indicating the basis for them in the application as filed (see H-III, 2.1 and in particular the transitional provisions in H-III, 2.1.4). If these requirements are not met:

(i) if the application is of one of the types mentioned in H-III, 2.1.4, the examining division may send a Rule 137(4) communication before proceeding further, as provided for in H-III, 2.1.1;

(ii) otherwise, if the basis for any amendments is not apparent, the examining division objects to these amendments under Art. 123(2).

In case (i), if the applicant replies to the communication under Rule 137(4) in time, the examining division will then decide if it consents to the amendments and will proceed accordingly as indicated in C-V, 4.

2.6 Further requests for amendment after approval

Rule 71(5)
Rule 137(3)

Once the applicant has approved the text communicated to him pursuant to Rule 71(3), by paying the fees and filing the translation of the claims, further requests for amendment will only exceptionally be admitted under the discretionary power of the examining division given by Rule 137(3). A clear example of an admissible request is where the applicant files separate sets of claims for designated states for which prior national rights exist (see H-III, 4.4). Similarly, it is appropriate to admit minor amendments which do not require re-opening of the substantive examination and which do not appreciably delay the issue of the decision to grant (see G 7/93).

If amendments are filed and do not comply with the requirements of Rule 137(4), the examining division may send a communication under Rule 137(4) (see H-III, 2.1.1).

When exercising its discretion under Rule 137(3) an examining division must consider and balance the applicant's interest in obtaining a patent which is legally valid in all of the designated states and the EPO's interest in bringing the examination procedure to a close by the issue of a decision to grant the patent. The criteria for exercising its discretion under Rule 137(3) at this late stage are whether the request can be decided on in a reasonable period of time, and whether the amendments are allowable. If either of these criteria is not satisfied, the request for amendments is refused by the division in the exercise of its discretion according to Rule 137(3).

Refusal of amendments must be reasoned, and both Art. 113(1) and Art. 116(1) must be observed (see C-V, 4.7.1). It must be shown that the conditions defined in G 7/93 are not met. This means that arguments must

be given as to why the amendments are not minor in nature but in fact necessitate resuming substantive examination while considerably delaying the issue of a decision to grant the patent.

Rule 140

However, once the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant, the examining division is bound by it (see G 12/91) and can only amend it to the limited extent provided for in Rule 140 (see H-VI, 3.1). In examination procedure, this corresponds to the date on which the centrally generated Form 2006, "Decision to grant a European patent pursuant to Art. 97(1) EPC", is forwarded to the postal service. This date is shown at the bottom right-hand corner of Form 2006. The examining division is no longer competent to decide on a request for amendments or corrections under Rule 139 if the filing of the request and the completion of the proceedings occur on the same date (T 798/95).

2.7 Late-filed requests after summons to oral proceedings in examination

If requests are filed after the final date set in accordance with Rule 116(2), they are usually treated as late-filed unless a summons to oral proceedings was issued as the first action of the examining division. Another exception is a request filed in response to a change of the subject of the proceedings, e.g. when a further relevant document is cited for the first time during the oral proceedings. In such a case, the request has to be admitted under Rule 116(2) (T 951/97).

The examining division will first consider the requests before deciding on their admissibility. The mere fact that they are filed late is not *per se* a reason for not admitting them. This issue will normally be dealt with during oral proceedings.

In exercising its discretion under Rule 137(3) (see G 7/93), the examining division needs to take into account whether the applicant has good reasons for filing the request late. In the absence of such reasons, and if the applicant has already had sufficient opportunity to address the reasoned objections, when balancing the relevant interests the examining division may give more weight to bringing the examination procedure to a close.

In such cases, late-filed requests will be subject to the "clear allowability" criterion (see H-II, 2.7.1) in addition to the criteria indicated in H-II, 2.3.

2.7.1 Concept of "clear allowability"

The examining division will apply the criterion of "clear allowability" in exercising its discretion under Rule 137(3) for treating requests filed after the final date set in accordance with Rule 116(2) without proper justification (T 153/85).

These late-filed claims will only be admitted into the proceedings if they are clearly allowable. This means that it must be immediately apparent to the examining division that the amendments successfully overcome the objections without giving rise to new ones (*prima facie* assessment).

For example, late-filed requests will not be admitted if they do not clearly meet the requirements under Art. 123(2) or Art. 84. Likewise, late-filed requests may be rejected if the newly defined subject-matter does not constitute a convergent development of the subject-matter which has been the subject of examination (for a definition of convergence, see H-III, 3.3.2.2).

For ascertaining whether or not the claims are clearly allowable, the examining division must take into account the reasons given by the applicant which explain why the amendments have been made and how they are intended to overcome the objections raised.

If, after discussions, the examining division comes to the conclusion that the late-filed requests are not clearly allowable, it rejects them under Rule 116(2) and Rule 137(3) on the grounds that they do not contain subject-matter which is clearly allowable, i.e. because the subject-matter does not clearly meet the requirements of the EPC (for cases where the applicant does not attend the oral proceedings, see H-III, 3.3.3 and E-III, 8.3.3). In the decision, reasoning is also to be given as to why the specific requirement(s) for allowability is (are) not met.

The "clear allowability" criterion is generally also applied to patent proprietors' late-filed requests in opposition proceedings (see E-VI, 2.1, and E-VI, 2.2; see also T 98/96 with regard to opposition appeal proceedings).

3. Admissibility in opposition procedure

3.1 Amendments in reply to the notice of opposition

Rule 80

Any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100. That is to say, amendments are admissible only if they are required in order to meet a ground for opposition. However, the ground for opposition does not actually have to have been invoked by the opponent. For example, in opposition proceedings admissibly opened on grounds of non-patentability, the patent proprietor can also submit amendments to remove added subject-matter. Opposition proceedings cannot be used merely to tidy up and improve the disclosure in the patent specification (see T 127/85). The mere addition of new claims to the claims as granted is inadmissible because such amendments cannot be said to meet a ground for opposition. However, the replacement of one independent claim as granted by multiple, e.g. two, independent claims each directed to a respective specific embodiment covered by the independent claim as granted is admissible if such a replacement is occasioned by a ground for opposition specified in Art. 100 (see T 223/97).

3.2 Amendments not related to the grounds for opposition

If the proprietor proposes amendments to the patent in reply to the grounds for opposition and the opposition division intends to maintain the patent in amended form pursuant to those grounds, other amendments not related to the grounds for opposition (e.g. clarifications), or corrections (H-VI, 3.1), may be allowed provided that the patent thus amended still fulfils the requirements of the EPC and that the amendments are considered

necessary and appropriate. In particular, if one part of a claim has been amended, it may be necessary or appropriate to amend other parts of the claim as well.

Moreover, where a "clarification" can be considered as a limitation of the claim, it would be admissible under Rule 80 and could form the basis for maintaining the patent in amended form, provided the other requirements of the EPC are also met by the amended text (with the exception of unity of invention – G 1/91). If the division is of the opinion that such a limiting clarification is not necessary, it needs to consider that the practice of interpreting a claim in a contracting state may be quite different from that of the EPO, and hence the patentee may see a need for such a limiting clarification.

Such amendments, however, are not proposed by the opposition division and they can only be taken into consideration up to the pronouncement of the decision (in oral proceedings) or until the date the decision is handed over to the EPO's internal postal service for transmittal to the parties (in written proceedings) (see G 12/91).

If an otherwise allowable request for maintenance of the opposed patent either as granted or in amended form has been submitted, the following amendments are not allowed:

(a) filing of further claims (see T 829/93);

(b) comprehensive redrafting of the dependent claims;

(c) comprehensive redrafting of the description.

In the absence of any amendments submitted by the patent proprietor with a view to meeting the grounds for opposition, there is no possibility to make any other amendments (see for example T 223/97). Publication errors and exceptionally formatting/editing errors may however be corrected (see H-VI, 4).

3.3 Amendments occasioned by national rights

Apart from the above (H-II, 3.1 and H-II, 3.2), amendments occasioned by national rights of earlier date are admissible pursuant to Rule 138 (see also G-IV, 6, H-III, 4.4 and H-III, 4.5).

3.4 Insistence on unallowable amendments

If the patent proprietors request amendments going beyond those permissible under Rule 80 (see H-II, 3.1 and H-II, 3.2), they are invited to withdraw them. If they then maintain their request, it is not admitted (for the reasoning see for example T 127/85, Headnote, and T 406/86, Headnote 1).

If, in addition to requests containing unnecessary amendments, there is an auxiliary request which meets the requirements of the Convention and in particular does not comprise amendments not complying with Rule 80, the

decision must include the grounds for not admitting the higher-ranking requests.

It may occur that there is only one request which would be allowable, but for amendments which clearly do not comply with Rule 80. If the amendments cannot be admitted, the opposition division explains to the patentee that revocation of the patent is to be expected solely for reasons of the request's non-compliance with Rule 80.

3.5 Late-filed requests in opposition proceedings

With respect to how late-filed requests are dealt with in opposition proceedings, reference is made to E-VI, 2.1 (general examples) and E-VI, 2.2 (examples concerning oral proceedings).

4. Amendments in limitation procedure

For admissibility of amendments in the limitation procedure, reference is made to D-X, 4 and D-X, 10.

5. Amendments required by a limitation of the search under Rule 62a and/or Rule 63

Rule 63(3)

Where the search was limited to certain subject-matter by application of Rule 63 (see B-VIII, 3.1 and 3.2), the claims must be amended in such a way as to remove the unsearched subject-matter and the description adapted accordingly.

Rule 62a(2)

Where the search was limited to certain claims by application of Rule 62a (see B-VIII, 4.1 and 4.2), the claims must be amended in such a way as to remove the unsearched independent claims and the description adapted accordingly. To this end, the claims may be amended, for example, by deleting an unsearched independent claim or, where this complies with Art. 123(2) and Art. 84, by making an unsearched independent claim dependent on another independent claim of the same category which *has* been searched.

In both of these cases, a specific amendment is necessary unless the examining division finds that the limitation of the search under Rule 62a and/or Rule 63 or the declaration of no search under Rule 63 was not justified, e.g. in view of arguments provided by the applicant.

Such amendments may, however, be made only in examination proceedings or, preferably, in reply to the search opinion (see F-IV, 3.3). Since the applicant may not amend the claims before receipt of the search report (Rule 137(1)), any claims filed in reply to an invitation under Rule 62a or Rule 63 will be taken only as an indication of what the applicant wants the EPO to search and dealt with accordingly (see B-VIII, 3.2 and B-VIII, 4.2). The applicant will then have to confirm maintenance of these amendments formally on entry into the examination phase (see A-V, 2.2).

6. Amendments relating to unsearched matter – Rule 137(5)

Rule 137(5) sets out two further conditions for amendments to claims, namely that amended claims may not relate to (i) unsearched subject-matter which does not combine with the originally claimed invention or

group of inventions to form a single general inventive concept and (ii) subject-matter not searched in accordance with Rule 62a and Rule 63 (see, however, H-II, 5).

6.1 Rule 62a and/or Rule 63 cases

Rule 137(5), second sentence

Amended claims may not relate to subject-matter not searched in accordance with Rule 62a or Rule 63 (see, however, H-II, 5). Consequently, the presence of this subject-matter in the description cannot be used as a basis for its re-introduction into the claims (see also B-VIII, 3.2.2 and B-VIII, 4.2.2).

However, the examining division does not raise an objection under Rule 137(5), second sentence, if the applicant only further limits a searched claim by introducing subject-matter taken from the description unless this subject-matter was explicitly declared as not searched under Rule 62a and/or Rule 63.

When assessing the allowability of an amendment under Rule 137(5), second sentence, the examining division also evaluates if the limitation of the search under Rule 62a and/or Rule 63 or the declaration of no search was justified (see B-VIII, 3.2.2, B-VIII, 4.2.2, H-II, 5). If the invitation was not appropriate or the limitation not justified, an additional search may be necessary (see C-IV, 7.2).

6.2 Subject-matter taken from the description

Rule 137(5), first sentence

Within the framework of Art. 123(2) and Art. 82, Rule 137(5), first sentence, should be construed as permitting any limitation of searched subject-matter which is unitary with the originally claimed subject-matter, irrespective of whether the technical feature(s) used for the limitation has/have been searched.

Thus, the addition to a claim of a technical feature which further defines an element that was already a feature of the original main claim or makes a contribution to the effect(s) of the features of the originally claimed invention(s) and which was expressly not searched but was disclosed in the context of the invention in the application as filed (usually in the description) will not result in an amended claim lacking a single general inventive concept with respect to the originally claimed invention(s). Consequently no objection under Rule 137(5), first sentence, should be raised in these circumstances, even though an additional search may be required (see C-IV, 7.2).

If amended claims are directed to subject-matter which has not been searched because it only appeared in the description (and the search division did not find it appropriate to extend the search to this subject-matter; see B-III, 3.5) and which does not combine with the originally claimed and searched invention or group of inventions to form a single general inventive concept, such amendments are not allowable.

In other words, in order to assess whether or not amended claims fulfil the requirements of Rule 137(5), first sentence, the examining division needs to establish first whether or not the subject-matter to which they relate has or

should have been searched (see B-III, 3.5) and second whether or not an objection of lack of unity would have been raised if the amended claims had been present in the set of claims on file at the time of the search.

As a consequence, an objection under Rule 137(5), first sentence, will normally arise if the applicant attempts to replace a technical feature contained in a claim with a different technical feature taken from the description.

Similarly, an objection under Rule 137(5), first sentence, would also arise if a technical feature taken from the description which has an effect unrelated to the effect(s) of the features of the originally claimed invention(s) were added to a claim.

If an objection under Rule 137(5), first sentence is raised, applicants are informed that they may continue to pursue such subject-matter only in the form of a divisional application under Art. 76.

The situation described above is different from amendments corresponding to an invention originally claimed but not searched under Rule 64, or Rule 164(1) or (2), which are dealt with in H-II, 7.2.

Rule 137(3)

Applicants should bear in mind that the examination procedure should be brought to a conclusion in as few actions as possible. In this case, therefore, the examining division may exercise its right not to admit further amendments under Rule 137(3) (see H-II, 2.3).

For Euro-PCT applications where the EPO acted as ISA or as SISA, the examining division has to issue an invitation under Rule 164(2) for any now claimed but unsearched invention contained in the originally filed application documents (description, claims and drawings, if any) which are to serve as the basis for examination upon expiry of the six-month time limit set in the communication under Rule 161 or Rule 162 (see C-III, 2.3).

7. Amendments in the case of non-unity

7.1 Restriction to a single, searched invention

In reply to an objection of lack of unity, the applicant must restrict the claims to a single invention which has been searched unless the applicant can convince the examining division that the objection was not justified.

If the claims have been restricted to a single searched invention, the examination can be continued as for a unitary application but limited to that invention (see C-III, 3). If the objection is withdrawn in view of the arguments put forward by the applicant, an additional search may be necessary (see C-IV, 7.2) in order for the examination of the claimed invention to be continued.

However, if in response to a negative opinion concerning that invention the applicant later amends the claims to switch to a different searched invention, the division will exercise its discretion under Rule 137(3) and refuse to admit the amendments since only one invention in each

application can be examined for conformity with the requirements of the EPC (see G 2/92 and T 158/12).

7.2 Restriction to an unsearched invention

If not all of the claimed inventions have been searched, in accordance with G 2/92 the applicant must restrict the claims to one of the searched inventions. Thus, if in reply to the search opinion the applicant then restricts the claims to one of the originally claimed inventions which has not been searched, the examining division will write a first communication repeating the lack-of-unity objection raised in the search opinion. Any arguments of the applicant must be duly considered and dealt with in the communication.

If the application is restricted to an unsearched but originally claimed invention, it can be refused under Rule 64 in line with G 2/92 (subject to the applicant's rights under Art. 113(1) and Art. 116(1)).

Rule 137(5) cannot be invoked. It does not apply when the applicant has not paid the search fee in respect of a non-unitary invention relating to the originally filed claims.

If the application is a Euro-PCT application (see also H-II, 7.4) the examining division, depending on the case:

– either objects under Rule 164(2)(c) to the restriction of the claims to an invention searched neither (on grounds of lack of unity) by the EPO as (Supplementary) International Searching Authority nor as part of a search under Rule 164(2)(a),

– or objects under Rule 164(1) in line with G 2/92 in the context of a supplementary search in the European phase (see B-II, 4.3.2, B-VII, 2.3 and E-IX, 4.2).

In both cases, if the applicant declines to limit the claims to a searched invention, the application is refused under Rule 164 in accordance with G 2/92 (subject to the applicant's rights under Art. 113(1) and Art. 116(1)).

Concerning the application of G 2/92, it is to be kept in mind that the prohibition on pursuing an application for subject-matter for which no search fees have been paid applies to inventions; it does not apply to features which were originally claimed with a different invention and had not been searched, but which were originally disclosed in combination with the searched invention or group of inventions (see T 998/14).

7.3 No restriction to a single invention searched

If in response to the search opinion the applicant does not restrict the application to a single invention searched, the objection of lack of unity raised at the search stage will be reviewed and if the examining division considers that it remains valid, a first communication repeating the lack-of-unity objection raised in the search opinion will be issued.

In Rule 164(2) cases, a lack of unity objection is addressed in the communication under Rule 164(2)(b) (see also H-II, 7.4.1).

If the applicant does not restrict the application at all, or does restrict it, but still maintains two or more inventions, the application can be refused under Art. 82 (subject to the applicant's rights under Art. 113(1) and 116(1)).

If the claims still cover an unsearched invention, an objection under Rule 64 would also apply, in line with decision G 2/92 as discussed in H-II, 7.2.

If the claims have not been simply restricted, but have instead, or additionally, been amended, such amendments can often result in the previously raised lack-of-unity objection no longer being valid, or in the arguments on which the objection was based no longer being complete. Such amendments would thus result in the objection having to be either withdrawn or at least newly argued.

Sometimes lack of unity of invention arises only during substantive examination, for example following an amendment of one or more claims so as to overcome an objection of lack of inventive step. In such situations the examining division may raise an objection, but only in very clear cases.

7.4 Further procedural aspects concerning Euro-PCT applications

7.4.1 Where the EPO does not perform a supplementary search

Where the EPO does not perform a supplementary search, the application must be limited to an invention searched either in the international phase by the EPO or in the European phase in a search under Rule 164(2)(a). The above principles (H-II, 7.1 to H-II, 7.3) then apply *mutatis mutandis* (see also E-IX, 4.2).

In Rule 164(2) cases, a further communication according to Art. 94(3) and Rules 71(1) and (2) repeating a lack of unity objection is not necessary, as a communication according to Art. 94(3) and Rule 71(1) and Rule 71(2) addressing (also) unity of invention has already been issued under Rule 164(2)(b) (see also H-II, 2.3 and H-II, 7.2).

7.4.2 Where the EPO performs a supplementary search

Where the EPO performs a supplementary search on an application which is considered to lack unity, the applicant will be invited to pay additional fees, and the supplementary search report will be established for those inventions for which a search fee has been paid. The application must then be limited to one of the inventions searched in the supplementary search. The above principles (H-II, 7.1 to H-II, 7.3) then apply *mutatis mutandis* (see also E-IX, 4.2).

Chapter III – Admissibility of amendments – other procedural matters

1. Introduction

This chapter deals with procedural matters and formal requirements relating to the admissibility of amendments. An important requirement dealt with is the applicant's obligation to identify amendments and indicate the basis for them in the application as filed (Rule 137(4); for transitional provisions, see H-III, 2.1.4). The chapter also deals with the format of and procedure for making amendments, as well as issues relating to auxiliary requests and how to deal with different texts for different contracting states.

2. Procedure for amendments to documents

2.1 Indication of amendments and their basis under Rule 137(4)

Rule 137(4)

When filing amendments, the applicant must identify them and indicate the basis for them in order to enable the division to assess compliance of the amendments with the provisions of Art. 123(2). To this end, the division may request that amendments have to be indicated either with respect to the immediate previous amendments in the sequence or with respect to the application as filed. The requirement to indicate amendments is to be understood as an opportunity for the applicant to provide convincing arguments to the division as to why the amendment(s) is/are directly and unambiguously derivable from the application as filed. These arguments are particularly important for the outcome of the division's assessment of Art. 123(2) where literal support for the amendment(s) is not present in the application as filed.

The requirement that the basis for amendments be indicated is met if, on consulting those parts of the application indicated, it is not necessary to look further in order to assess the amendment's compliance with Art. 123(2). Non-specific indications such as "see the description as filed" or "see the claims as filed" or "see the examples as filed" are generally not considered sufficient. This requirement also applies in cases where the applicant requests the examining division to amend the application (see H-III, 2.4).

Whether the requirements of Rule 137(4) are met is assessed independently of whether the amendments in question comply with Art. 123(2). For example, the applicant may indicate that a particular amendment is based on a technical feature disclosed only in a schematic drawing. If the feature supposedly forming the basis for the amendment is indeed disclosed in the drawing indicated by the applicant, the requirements of Rule 137(4) are met, irrespective of whether the amendment based on that technical feature is allowable according to Art. 123(2) (see H-IV, 2.4).

Rule 7

Where the application was not filed in an official language of the EPO, in the absence of evidence to the contrary, for the purpose of assessing compliance with Art. 123(2) the EPO assumes that any translation of the application as filed is accurate. Consequently, in order to comply with

Rule 137(4) it is sufficient to indicate the basis of an amendment in the translation of the application as filed.

2.1.1 Rule 137(4) communication and response thereto

Rule 137(4)

If the amendments and/or their basis cannot be properly identified such that compliance with Art. 123(2) cannot be assessed, the examining division notes a failure to meet either requirement of Rule 137(4). It consequently issues a communication requesting the correction of this deficiency within a period of one month. The amendments in respect of which such a communication may be sent include, *inter alia*:

(i) claims filed after the date of filing under Rule 58 (see A-III, 15)

(ii) amendments filed before entry into the European phase from the PCT under Art. 19 PCT and/or Art. 34 PCT, if maintained on entry (see E-IX, 3)

(iii) amendments filed on entry into the European phase from the PCT under Art. 28 PCT or Art. 41 PCT (see E-IX, 3)

(iv) amendments filed after entry into the European phase from the PCT under Rule 161(1) or Rule 161(2) (see E-IX, 3)

(v) amendments filed in response to the search opinion (see B-XI, 8)

(vi) amendments filed during the examination procedure (see, however, H-III, 2.1.3), including those filed after the communication according to Rule 71(3).

Such a communication can only be sent in respect of amendments which are part of a current request. It cannot relate to amendments which have since been withdrawn or superseded. A communication under Rule 137(4) can only be issued by the examining division (see B-XI, 2).

Art. 94(4)

If the applicant fails to comply with either requirement of Rule 137(4) within the above-mentioned period of one month, the application is deemed to be withdrawn, because the applicant is considered not to have replied to the communication from the examining division. The applicant may request further processing for failure to observe this time limit (see E-VIII, 2).

If the amendments are filed in response to a communication according to Rule 71(3) and the requirements of Rule 137(4) are not satisfied in respect of them, the examining division may send a Rule 137(4) communication. Thereafter, if the applicant replies in time, the examining division will then decide whether to admit the amendments (see H-II, 2.5.4).

Regarding the application of Rule 137(4) to auxiliary requests, see H-III, 3.3.1.

2.1.2 Amendments withdrawn or superseded in the Rule 137(4) period

If the applicant replies in time to the Rule 137(4) communication by withdrawing the amendments in respect of which the communication was sent but without identifying those amendments or indicating their basis in the application as filed, then no loss of rights will occur according to Rule 137(4). However, where the withdrawal results in the re-introduction of subject-matter that has already been objected to, the amendment introducing this subject-matter may be deemed to be inadmissible according to Rule 137(3) (see H-II, 2.3).

No further Rule 137(4) communication will be sent in respect of further amendments filed in a timely response to the Rule 137(4) communication. By the expiry of the one-month period, the applicant must have identified and indicated the basis of:

(i) amendments in respect of which the Rule 137(4) communication was sent and which are not superseded by further amendments filed during the one-month period under Rule 137(4), and

(ii) amendments filed during that one-month period.

The applicant does not need to comply with Rule 137(4) in respect of amendments which are superseded by further amendments filed in the one-month period. For example:

03.06.2010	Application filed: 10 claims
25.03.2011	Extended European search report drawn up
21.08.2013	Amended claims 1-10 filed in examination proceedings, no basis indicated
03.09.2013	Examining division sends a Rule 137(4) communication in respect of amended claims 1-10 filed on 21.08.2013
07.10.2013	Amended claims 6-10 filed
14.10.2013 (Monday)	One-month period under Rule 137(4) expires

In the above example, the applicant must, by expiry of the one-month period according to Rule 137(4) on 14.10.2013, indicate the basis for amended claims 1-5 as filed on 21.08.2013 and for amended claims 6-10 as filed on 07.10.2013, and failure to do so results in the application being deemed to be withdrawn according to Art. 94(4). It is not necessary for the applicant to indicate the basis for the superseded amendments to claims 6-10 filed on 21.08.2013. Note in particular that, where the basis for the amendments to claims 6-10 filed on 07.10.2013 is not indicated by 14.10.2013, then no further Rule 137(4) communication is sent in

respect of these amendments and the application is deemed to be withdrawn on expiry of the one-month period on 14.10.2013.

2.1.3 Rule 137(4) and oral proceedings

A Rule 137(4) communication will not be sent where the amendments in question are filed during oral proceedings. Nonetheless, it is a requirement of Rule 137(4) that amendments and their basis be identified. If the applicant fails to fulfil this requirement in respect of amendments filed during oral proceedings, the amendments may, for reasons of procedural economy and taking into account the applicant's right to be heard in accordance with Art. 113(1), be rejected as inadmissible by the examining division, exercising its discretion under Rule 137(3).

Amendments filed in preparation for oral proceedings in response to the invitation according to Rule 116(2) will be dealt with in those oral proceedings as indicated above. However, if the oral proceedings are cancelled or applicants do not attend and the procedure is continued in writing after the oral proceedings are held in their absence, a Rule 137(4) communication may be sent by the examining division in respect of those amendments.

2.1.4 Transitional provisions relating to Rule 137(4)

The procedure described in H-III, 2.1.1 to H-III, 2.1.3 applies to the following applications (see Art. 2(2) of the Decision of the Administrative Council of 25 March 2009, OJ EPO 2009, 299):

(i) European applications for which the search report is drawn up on or after 1 April 2010,

(ii) Euro-PCT applications for which the supplementary European search report is drawn up on or after 1 April 2010, and

(iii) Euro-PCT applications for which the international search report is drawn up by the EPO acting as International Searching Authority on or after 1 April 2010 (Art. 153(6); see also E-IX, 3.4).

2.2 Amendment by submitting missing documents or by filing replacement pages

The content of a European patent application or patent may be amended within the limits laid down in Art. 123(2) and (3). (For the conditions governing amendments, see also A-V, 2, H-II, H-IV, H-V and D-V, 6.) This will normally be done by submitting missing documents or by filing replacement pages. Where replacement pages are filed, the applicant or patent proprietor is advised, in the interests of procedural efficiency, to identify clearly all amendments made, and indicate on which passages of the original application these amendments are based. Where whole paragraphs have been added or deleted, it is not necessary to renumber the paragraphs throughout the entire application or patent.

If handwritten amendments are filed during oral proceedings in opposition, the proprietor is invited in a Rule 82(2) communication to submit

replacement paragraphs and/or claims only, and not replacement pages (see E-III, 8.7.3, and OJ EPO 2016, A22, points 8 to 14).

Amendments should preferably be identified using functions available in a text editor to clearly indicate deletions and insertions in the amended text. Pages with such indications should be submitted in addition to clean copies. Alternatively, handwritten form is appropriate to fulfil the requirements of Rule 137(4), provided that clean copies are free from handwritten amendments.

The basis for amendments should preferably be indicated by including in the letter of reply a list of the amendments made and the precise basis for amendments in the application as filed (see H-III, 2.1). Where the basis is not explicit, e.g. where a different wording is used or features are taken only from drawings or generalised from a specific embodiment, it is advisable to give a short explanation of why Art. 123(2) is fulfilled.

2.3 Amendments using copies

Amendments, particularly to the description or claims, may be made by using copies in accordance with the following procedure:

If deemed expedient, the examining division or formalities officer may, on a copy of one or more pages of the documents to be amended, put forward suggestions as to how amendments should be made in such a way as to take account of the objections raised. The annotated copies (not the working documents which are to remain in the dossier) will then be forwarded to the applicant or, in opposition proceedings, to the proprietor of the patent and the other parties, in the communication setting out the objections. In this communication, the applicant or proprietor will not only be informed of the deficiencies recorded and invited to adopt a position or submit amendments within a fixed time limit, but will also be invited simultaneously to resubmit the said copy and – as an alternative to submitting replacement pages – to indicate on this copy, separately from the comments of the examining division (typewritten and in such a way as to be well legible after photocopying), any amendments to be made to the pages concerned. Opponents may also be invited to submit their comments in the same way.

The parties may also submit copies of one or more amended pages on their own initiative. The filing of completely retyped documents is normally objected to, for reasons of procedural economy, as these documents will have to be checked for correspondence with the original documents (see T 113/92). Requests to this effect will, therefore, normally not be admitted under Rule 137(3). Only where the amendments are so extensive as to affect the legibility of the copies, replacement pages must be filed. In this case such pages may also be requested by the examining division on its own initiative.

2.4 Amendments made by the EPO at the request of a party

Where necessary, deficient documents may also be amended at the request of a party by the competent department of the EPO. This could be the procedure for minor amendments, e.g. where it is necessary to insert

details which were omitted in the request for grant, and the number of amendments involved is reasonable, or where whole pages or paragraphs are to be deleted. The party concerned is advised to submit a list summarising the amendments to be undertaken by the EPO. It is, however, at the discretion of the examining division to decide whether the number of changes requested is in fact unreasonable and would take a considerable amount of time to deal with. If so, the examining division will require that the party makes the amendments and submits amended pages. This procedure could also be followed for minor amendments to drawings, e.g. for amending a reference number or deleting one or more whole figures (as regards the removal of references following an amendment to the description, see F-II, 4.8). In the case of complicated amendments to drawings, where it is not immediately clear how the changes are to be made, the party concerned, who as a rule is the applicant or proprietor, must submit replacement pages.

2.5 Withdrawal of amendments/abandonment of subject matter

Any subsequent request to withdraw an amendment is itself a request for further amendment; thus, if this subsequent request occurs after reply to the first communication from the examining division, the corresponding amendment will be admitted only if the examining division consents.

In deleting subject-matter from an application, the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise the subject-matter cannot be reinstated (see J 15/85, confirmed in G 1/05 and G 1/06).

3. Auxiliary requests

In examination, opposition and limitation proceedings, parties may submit a main request followed by one or more auxiliary requests (see also D-IV, 5.3).

Example 1:

"We request grant of a patent as per the documents originally filed or, alternatively, as per the amended documents now enclosed."

Example 2:

"We request that the opposition be rejected or, alternatively, that the patent be maintained in amended form as per the enclosed documents."

Such further (auxiliary) requests are made in case the examining or opposition division cannot allow the main (first) request.

If in examination proceedings applicants file text labelled as an auxiliary request, but also indicate that they are not yet willing to restrict themselves to that request, the text is not to be considered as a true auxiliary request within the meaning of this chapter, such that it is not possible to proceed directly to the issue of a communication under Rule 71(3) based on this text (see C-V, 1.1). In such circumstances it is appropriate to contact applicants by telephone to establish whether they are prepared to proceed to grant on

the basis of that text. The applicant's agreement or non-agreement that a Rule 71(3) communication can be based on such an auxiliary request must be mentioned in the minutes of the telephone conversation or, in the case of agreement, in the Rule 71(3) communication (see C-VII, 2.5).

3.1 General principles

If the main request is allowable, the division will ignore any auxiliary requests.

If the main request is not allowable, the division will consider the auxiliary requests, in the sequence chosen by the requester.

If an auxiliary request is allowable, the division will ignore all subsequent requests.

3.1.1 Sequence of requests

When a group of auxiliary requests is filed, these requests must be filed in a clear order and must not be worded such that they leave it for the examining division to identify and speculate on the intended text of the claims (R 14/10). Furthermore, all auxiliary requests must relate to one invention: the examining division will exercise its discretion under Rule 137(3) and will refuse to admit auxiliary requests which involve switching from the searched invention chosen for examination to another invention (see C-III, 3.4 and H-II, 7).

Under Art. 113(2), the EPO decides upon European patent applications or patents only in the text submitted to it, or agreed, by applicants or proprietors. These parties must therefore clearly indicate the text they are proposing or, if they are submitting more than one text, the sequence in which they want the EPO to consider them. Otherwise the division does not know which version to base its decision on and would ultimately have to refuse the application, revoke the patent or reject the request for limitation for lack of any clear request.

3.1.2 Obligation to give reasons

In examination, opposition and limitation proceedings, whenever a request by any of the parties is refused, reasons must always be given.

3.1.3 Neither main nor auxiliary requests allowable

If the examining or opposition division cannot allow the main request or any of the auxiliary requests, it must issue a decision to that effect, taking Art. 113(1) and 116 into account. The decision must include the reasons for rejecting/refusing the main request and each of the auxiliary requests, except where the requests in question have been withdrawn.

3.2 In the search phase

In the search phase, under Rule 137(1) amendments to the claims are not admissible before the applicant receives the European search report, and therefore no auxiliary requests can be submitted. If auxiliary requests are submitted before the establishment of a supplementary European search report (see H-II, 2.1), only the main request will be taken into account in the search (see, however, B-VIII, 3.2.2 and B-VIII, 4.2.2).

3.3 In examination proceedings

3.3.1 Indication of the amendments made in the requests and of their basis

Where requests (main and/or auxiliary) are filed in examination proceedings and the applicant does not identify the amendments and/or does not indicate the basis for them in the application as filed, a communication according to Rule 137(4) may also be sent in respect of one or more of the newly filed main and/or auxiliary requests.

For requests filed in preparation for oral proceedings, late filed requests or requests filed during oral proceedings, see H-III, 2.1.3.

3.3.2 Admissibility of auxiliary requests

3.3.2.1 Criteria for admissibility of auxiliary requests

As a matter of principle, the examining division must, when exercising its discretion under Rule 137(3) not to admit one or more auxiliary requests, balance the interests of the applicant and procedural efficiency (see also H-II, 2.3, H-II, 2.5.1, H-II, 2.6 and H-II, 2.7).

Thus, an auxiliary request which contains minor deficiencies but otherwise complies with the requirements of the EPC is normally admitted into the procedure.

When deciding on the admissibility of auxiliary requests the principles set out in H-II are considered for each of the requests, since each request is in fact a set of amended claims.

Auxiliary requests reintroducing subject-matter which has already been considered unallowable and has been removed by the applicant will not be admitted (see also H-II, 2.3). The same may apply to auxiliary requests introducing new deficiencies.

3.3.2.2 Timeliness and structure of auxiliary requests

If auxiliary requests are filed after the final date set in accordance with Rule 116(2), they are usually treated as late-filed unless a summons to oral proceedings was issued as the first action.

For late-filed requests, in addition to the criteria set out in H-III, 3.3.2.1, the subject-matter of the new claims must not diverge considerably from the claims already filed. The requests normally need to represent a convergent development, i.e. the subject-matter of the auxiliary requests constitutes a sequential limitation in the direction of an intended invention and does not make use of different characteristics in order to branch out in different directions (T 1273/04). In particular, the applicant cannot shift to the examining division the responsibility for defining the subject-matter of the application by filing a large number of unstructured requests or requests involving different variants (R 14/10): this leads to the requests not being admitted.

3.3.3 Preparing the decision

If the examining division is able to allow an auxiliary request (but not the main request or any higher-ranking auxiliary requests), it will inform the applicant accordingly in a communication under Rule 71(2) or in an annex to the communication according to Rule 71(3), giving a brief indication of the essential reasons for refusing the main and higher-ranking auxiliary requests (see C-V, 1.1).

Where an auxiliary request appears to comprise subject-matter that offers a good starting point for an allowable request, but it is considered expedient to issue a communication under Article 94(3), a brief indication is given of the essential reasons for the non-allowability or non-admissibility of the subject-matter of the higher-ranking requests, and a suggestion is provided as to the most promising request (see C-III, 4.1.2).

Care needs to be taken where oral proceedings have been specifically requested in cases where the examining division has not allowed the main request: the applicant must be summoned to oral proceedings even if the examining division considers one of the auxiliary requests to be patentable. In such cases it may be appropriate to ask applicants in a telephone call whether, in view of the examining division's intention to issue a communication under Rule 71(3) for the allowable auxiliary request, they would be prepared either to withdraw the request for oral proceedings for the main request or to replace the main request with the allowable auxiliary request.

During oral proceedings, the division addresses the main request and decides on the admissibility of the auxiliary requests, if any, filed in reply to the summons to oral proceedings (see H-II, 2.3 and H-III, 2.1.3). Moreover, it may be appropriate to ask applicants whether, in view of an allowable request, they would be prepared to withdraw the unallowable higher-ranking request(s). However, the applicant is not obliged to do so.

The summons to oral proceedings must indicate the essential reasons that led the examining division not to allow or not to admit the auxiliary requests already filed so that the applicant is not taken by surprise by the refusal of the application in case the applicant decides not to attend the oral proceedings (C-V, 1.1 and C-V, 4.9). This applies regardless of whether oral proceedings are held in the absence of the applicant or are cancelled.

In deciding on the admissibility of the auxiliary requests, the examining division will apply the criteria set out in:

(i) H-III, 3.3.2.1 if auxiliary requests are submitted by the date set according to Rule 116(1);

(ii) H-III, 3.3.2.1 and H-III, 3.3.2.2 if auxiliary requests are submitted after the date set according to Rule 116(1).

The examining division may then exercise its discretion under Rule 137(3) not to admit one or more of the requests (see H-II, 2.3, H-II, 2.7, H-II, 2.7.1 and H-III, 3.3.1), and it may do so in the absence of the

applicant/representative. A decision to refuse the application in these circumstances must not take the applicant by surprise (E-III, 8.3.3.1, and E-III, 8.3.3.3).

3.3.4 Complete text for auxiliary request not yet available

If a complete text corresponding to the allowable auxiliary request does not yet exist, the applicant must be asked to make the necessary amendments.

In oral proceedings, the division does always try to have the description brought into line with the version of the claims it considers allowable. If necessary, the oral proceedings are interrupted for this purpose.

3.3.5 Complete text for auxiliary request available

If a complete text of the application according to the allowable auxiliary request already exists, a communication under Rule 71(3) is issued. In an annex to this communication the division must give a brief indication of the reasons on which the refusal of the higher-ranking requests is based (see also C-V, 1.1). Where appropriate, this may be done by reference to earlier communications. If applicants approve this proposed text, then in accordance with Rule 71(3) they indicate this by filing the translations of the claims and paying the fees for grant and publishing without filing any request for amendment or correction of the proposed text (if such a request is filed, the procedure is as indicated in C-V, 4). If they do so, the application proceeds to grant on the basis of the text of the auxiliary request as proposed in the communication under Rule 71(3) (see C-V, 2).

3.3.6 Applicant does not approve the text proposed for grant

If the applicant does not approve the text according to the auxiliary request as proposed in the communication under Rule 71(3), the procedure is as set out in C-V, 4 (see in particular C-V, 4.7 and C-V, 4.6.2).

3.4 In opposition proceedings

In opposition proceedings, if an auxiliary request by the proprietor for maintenance of the patent in amended form is allowable, the division cannot revoke the patent (see T 234/86).

3.4.1 Written procedure

If the opposition division, after examining the parties' submissions, considers it can maintain the patent only in amended form as per an auxiliary request from the proprietor, it must first ensure that the parties have been allowed to comment under Art. 113(1) on the grounds and evidence behind the non-allowance of the higher-ranking request(s) and on the grounds and evidence behind the allowance of the lower-ranking request (where oral proceedings have been requested, see also H-III, 3.5.2).

If, despite the existence of an allowable request, the proprietor continues to maintain one or more unallowable higher-ranking requests, an interlocutory decision is issued. This decision must include the finding that the patent and the invention to which it relates, as amended in accordance with the allowable auxiliary request, meet the requirements of the EPC. It must also set out the reasons, based on grounds and evidence already

communicated to the parties, for refusing the higher-ranking requests and for allowing the lower-ranking request.

3.4.2 Oral proceedings

If the opposition division is able to allow an auxiliary request but not the main or higher-ranking auxiliary requests, the chair informs the parties (possibly after interrupting the proceedings) which request is allowable and that the higher-ranking request(s) is/are not allowable (and on which grounds they are not allowable), ensuring beforehand that the parties have already had the opportunity to comment on all grounds and evidence underlying this finding. The chair will then normally ask proprietors if they are prepared to convert the allowable auxiliary request into a main request (by abandoning all higher-ranking unallowable requests). The division cannot, however, insist on the proprietor making such a declaration.

If, despite the existence of an allowable auxiliary request, the proprietor continues to maintain higher-ranking unallowable requests, the division issues an interlocutory decision to the effect that:

(a) the main request and possibly one or more auxiliary requests is/are not allowable

(b) in respect of the allowable auxiliary request, the amended patent and the invention to which it relates satisfy the requirements of the EPC.

If, on the other hand, the proprietor withdraws the higher-ranking requests such that the allowable auxiliary request becomes the main request, the division will issue an interlocutory decision to the effect that this request satisfies the EPC.

The division tries as far as possible to ensure that, if it allows an auxiliary request at oral proceedings, the complete final text is available at the end of the proceedings.

3.5 In limitation proceedings

3.5.1 General principles

The filing of auxiliary requests (e.g. claim versions) together with a main request is possible in limitation proceedings, just as in examination proceedings. However, there are restrictions with regard to the possibility of filing amendments in limitation proceedings (see D-X, 4.3 and D-X, 4.5).

The procedure to be applied, subject to any request for oral proceedings, is slightly different to that applicable in pre-grant proceedings under Rule 71(3), especially in view of the requirements of Art. 113(1) and (2). In particular, in a case where an auxiliary request is allowable and the main request is not, if this were communicated under Rule 95(3), this would no longer leave the requester the option of having the main request rejected with an appealable decision. Thus, the following applies:

(a) if the main request is allowable, the invitation under Rule 95(3) to file the translations and pay the fees will be issued on that basis;

(b) if an auxiliary request is allowable, but not the main request (and possibly other higher-ranking requests), proprietors will be informed of the reasons in a communication under Rule 95(2) and invited to abandon the non-allowable request(s); if they do not do so, the request will be rejected as in (c) below;

(c) if none of the requests is allowable, initially a communication under Rule 95(2) setting out the reasons and indicating a possible remedy is sent to the requester; if no remedy is undertaken, a decision rejecting the request is issued, and the annex prepared by the examining division will need to set out the reasons why none of the requests are allowable.

In cases (b) and (c), the decision may be appealed by the requester.

3.5.2 Written procedure

If the examining division, after examining the request for limitation, considers that the patent can be limited only on the basis of an auxiliary request, it informs the requester accordingly in a communication under Rule 95(2), giving reasons why the main request and any higher-ranking auxiliary requests are not allowable and informing the requester which auxiliary request is considered allowable. Where appropriate, the division also informs the requester what amendments must be made to the patent specification documents to bring them into line (Art. 105b(1) and Rule 95(2)).

If in response to the communication under Rule 95(2) the requester withdraws the unallowable request(s) and (where applicable) makes any amendments still outstanding, the examining division will issue a communication under Rule 95(3) inviting him to pay the prescribed fee and to file the translation of the limited claims of the allowable request (see D-X, 5).

If the requesters insist on maintaining an unallowable request, and fail to comply with the examining division's request that they file documents corresponding to the allowable auxiliary request, the request for limitation must be rejected (Art. 105b(2) and Rule 95(4)). The decision must give the reasons for not allowing the higher-ranking request(s) and must point out, as regards the allowable auxiliary request, that the requester failed to comply with the division's request to submit a text enabling the patent to be limited on the basis of the allowable request.

3.5.3 Oral proceedings

If the examining division is able to allow an auxiliary request but not the main or higher-ranking requests, the chair informs the requesters (possibly after interrupting the proceedings) which request is allowable and why the higher-ranking request(s) is/are not. The requesters will then normally be asked if they are prepared to convert the allowable auxiliary request into a main request. The division cannot however insist on the requester making such a declaration.

If, despite the existence of an allowable text, the requester continues to maintain an unallowable higher-ranking request, the request for limitation shall be rejected (Rule 95(4)). The division will issue a decision giving the reasons for not allowing the higher-preference requests and pointing out that, as regards the allowable auxiliary request, the requester failed to comply with its request to submit a text enabling the patent to be limited on the basis of the allowable request.

4. Different texts in respect of different contracting states

In the cases discussed in H-III, 4.2 to H-III, 4.4, an application or a patent may contain a different set of claims (and descriptions) for different contracting states (also see G-IV, 6). For examination and opposition proceedings, see H-III, 4.1 to H-III, 4.4; for limitation proceedings, see D-X, 10.

It is not possible to have different text in respect of extension or validation states, as the relevant provisions allowing an exception to the principle of unity of the European patent application/patent relate only to EPC contracting states. However, where there are different text versions for the contracting states, the applicant may determine which one applies to the respective extension/validation state.

4.1 Dealing with different texts in examination

If the examining or opposition division considers that the description and drawings are so inconsistent with any set of claims as to create confusion, it will require the applicant or proprietor to amend the description and drawings to remedy this. If the applicant or proprietor voluntarily proposes such an amendment the examining or opposition division will admit it only if it considers this necessary. In particular, different descriptions and drawings will be required only if it is not possible to set out clearly in a common description which subject-matter is to be protected in the different contracting states. For adaptation of the description in the case of national rights of earlier date, see H-III, 4.4.

Hence this type of application or patent will, after amendment, either consist of two or more distinct sets of claims each supported by the same description and drawings, or two or more sets of claims each supported by different descriptions and drawings.

For the application of Rules 80 and 138 in opposition proceedings, see H-III, 4.2, H-III, 4.4 and H-III, 4.5.

4.2 Different text in respect of the state of the art according to Art. 54(3) EPC and Art. 54(4) EPC 1973

If the EPO notes that in respect of one or more of the designated contracting states the content of an earlier European patent application forms part of the state of the art pursuant to Art. 54(3), two situations can arise:

(i) the application under examination was pending at the date of entry into force of the EPC 2000 (13 December 2007), or the patent under examination had already been granted at that date. Art. 54(4)

EPC 1973 is still transitionally applicable (see Art. 1, Decision of the Administrative Council of 28 June 2001, OJ EPO 2003 Special edition No. 1, 202), with Rule 23a EPC 1973 and the first part of Rule 87 EPC 1973 as implementing regulations thereto. Here, if conflicting prior art gives rise to different texts of the claims for different contracting states and if the relevant designation fee(s) for the earlier European patent application has/have been paid, different sets of claims for the contracting states concerned may be filed, if required to establish novelty over that prior art. In opposition proceedings, Rule 80 also applies to amendments occasioned by the state of the art according to Art. 54(4) EPC 1973.

(ii) the application or patent under examination is not one of those covered under (i). As Art. 54(4) EPC 1973 has been deleted, the conflicting prior art belongs to the state of the art for all contracting states, irrespective of the effected designations (see also F-II, 4.3). Likewise, it is irrelevant if the designation fee(s) for the earlier European patent application has/have been paid, since there is no provision in the EPC 2000 corresponding to Rule 23a EPC 1973. Consequently, the possibility of having different texts for different contracting states on the basis of Art. 54(3) no longer exists.

4.3 Different text where a transfer of right takes place pursuant to Art. 61 or Rule 78 in respect of certain designated states

4.3.1 Different text where a transfer of right takes place pursuant to Art. 61 in examination proceedings

Art. 61(1)(b)
Rule 17
Rule 18(1) and (2)

If by a final decision pursuant to Art. 61 it is adjudged that a third party is entitled to the grant of a European patent, the original European patent application must contain, "where appropriate", for the designated contracting states in which the decision was taken or recognised or must be recognised on the basis of the Protocol on Recognition, claims, a description and drawings which are different from those for the other designated contracting states (see also H-III, 4.1 and C-IX, 2).

4.3.2 Different texts where a transfer of the patent in respect of certain designated states takes place in opposition proceedings

Rule 78(2)

Where a third party has, in accordance with Art. 99(4), replaced the previous proprietor for one or some of the designated contracting states (see D-I, 6, third paragraph), the patent as maintained in opposition proceedings may for those states contain claims, a description and drawings which are different from those for the other designated contracting states (see also D-VII, 3.2). However, Rule 80 applies to amendments by each of the proprietors.

4.3.3 Opposition cases with different texts where a transfer of rights by virtue of a final decision pursuant to Art. 61 takes place in examination proceedings

The substance of H-III, 4.3.2 applies *mutatis mutandis* (see also D-I, 6, third paragraph and D-VII, 3.2).

4.4 Different texts where national rights of earlier date exist

Art. 139(2)

National rights of earlier date are not comprised in the state of the art (Art. 54) for the purposes of the EPO examination for patentability. However, under Art. 139(2), national rights of earlier date can be invoked, after the grant of the European patent, in national proceedings as a ground for revocation. These rights represent exceptions to the uniformity of European substantive patent law. Where national rights exist, therefore, the applicant or proprietor has a legitimate interest in submitting different claims to ensure that the patent granted will not be partly revoked in some contracting states (see Rule 80 and Rule 138). The filing of different claims is, however, neither required nor suggested.

If an applicant or proprietor produces evidence in examination/opposition proceedings of the existence of pertinent national rights of earlier date in a particular (designated) contracting state, it is appropriate to admit separate claims for the contracting state in question. The evidence must be in the form of a specification or, where applicable, a copy of the utility model or utility certificate or of the application for it (see Art. 140); this is necessary to prevent unjustified deviation from the unity of the European patent.

In opposition proceedings, a national right of earlier date is neither a ground for opposition nor a ground for revocation. Hence, it is not admissible for an opponent to introduce a national right of earlier date into opposition proceedings to support a novelty attack.

The effect of the national right of earlier date is determined by the relevant national provisions. The examining or opposition division does not decide whether the applicant or proprietor has limited the scope of the application/patent to the extent required to overcome the effect of the national right (see G-IV, 6). That is the responsibility of the applicant or proprietor.

The examining or opposition division must check that the separate claims do not contravene Art. 123(2) and Art. 123(3), and that they meet the other requirements of the EPC. The same applies to a separate description (see H-III, 4.1).

Moreover, in general, there is no justification for a separate description. However, at a suitable point in the preamble to the description, preferably in a separate paragraph following the information pursuant to Rule 42(1)(a), a reference to this situation must be made, for example along the following lines:

"With reference to ... (e.g. earlier application No. ... in ...), the applicant has voluntarily limited the scope of the application /patent for... (contracting state) by submitting separate claims for this (these) state(s)."

4.5 Opposition proceedings where the claims as granted are different for different contracting states

Where a patent has been granted with different sets of claims for the reasons set out in H-III, 4.2 to H-III, 4.4, the proprietor might wish to bring the claims into line either by applying a limitation already introduced for one

or more contracting states to the other contracting states or by filing a new single set of claims for all contracting states.

In such a case, the amendments to each different set of claims as granted must separately fulfil the requirements of Rule 80 and Art. 123(3) (and Rule 138, if applicable).

5. Calculation of claims fees

The claims fees are calculated in accordance with A-X, 11.2, C-V, 1.4, C-V, 4.2 and C-V, 4.8.1.

Chapter IV – Allowability of amendments – Art. 123(2) and (3)

1. Introduction

Chapters H-II and H-III deal with the admissibility of amendments, i.e. whether the competent department of the EPO will admit amended application documents or an amended patent specification into the procedure. After an amendment has been admitted into the procedure, the competent department must then decide whether the amendment is allowable, i.e. whether it satisfies the requirements of the EPC. It is important to note that an admissible amendment is not automatically allowable.

2. Allowability of amendments under Art. 123(2)

2.1 Basic principle

The question of allowability of amendments is legally a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the EPC including, in particular, inventive step and the other matters listed in B-XI, 3.6 (see also C-III, 2).

If, however, the applicant seeks to amend the description (other than references to the prior art, see H-IV, 2.2.6), the drawings or the claims in such a way that subject-matter which extends beyond the content of the application as filed is thereby introduced, the application as so amended cannot be allowed.

The underlying idea of Art. 123(2) is that applicants are not allowed to improve their position by adding subject-matter not disclosed in the application as filed, which would give him an unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application (see G 1/93).

An amendment is regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art (see G 2/10).

2.2 Content of the application as "originally" filed – general rules

Under Art. 123(2), it is impermissible to add to a European application subject-matter which the skilled person cannot derive directly and unambiguously, using common general knowledge and also taking into account any features implicit to a person skilled in the art in what is expressly mentioned in the document, from the disclosure of the application as filed. Literal support is, however, not required by the wording of Art. 123(2) (see T 667/08).

The term "implicit disclosure" means no more than the clear and unambiguous consequence of what is explicitly mentioned in the application as filed. Thus, the common general knowledge must be taken into account in deciding what is clearly and unambiguously implied by the explicit disclosure of a document. However, the question of what may be rendered obvious by that disclosure in the light of common general knowledge is not relevant to the assessment of what is implicitly disclosed by that document (T 823/96, T 1125/07).

When assessing the conformity of the amended claims with the requirements of Art. 123(2), the focus is placed on what is really disclosed to the skilled person by the documents as filed as directed to a technical audience. In particular, the examining division needs to avoid disproportionally focusing on the structure of the claims as filed to the detriment of the subject-matter that the skilled person would directly and unambiguously derive from the application as a whole.

Furthermore, the assessment of the requirements of Art. 123(2) is made from the standpoint of the skilled person on a technical and reasonable basis, avoiding artificial and semantic constructions (T 99/13).

2.2.1 Features described in a document cross-referenced in the description

Features which are not disclosed in the description of the invention as originally filed but which are only described in a cross-referenced document which is identified in such description are *prima facie* not within "the content of the application as filed" for the purpose of Art. 123(2). It is only under particular conditions that such features can be introduced by way of amendment into the claims of an application.

Such an amendment would not contravene Art. 123(2) if the description of the invention as originally filed leaves no doubt to a skilled reader (see T 689/90) that:

(i) protection is or may be sought for such features;

(ii) such features contribute to solving the technical problem underlying the invention;

(iii) such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)) and thus to the content of the application as filed (Art. 123(2)); and

(iv) such features are precisely defined and identifiable within the disclosure of the reference document.

Moreover, documents not available to the public on the date of filing of the application can only be considered if (see T 737/90):

(a) a copy of the document was available to the EPO, or to the receiving Office if the application is a Euro-PCT application which was not filed

at the EPO as the receiving Office, on or before the date of filing of the application; and

(b) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

2.2.2 Missing parts of the description or missing drawings filed after the date of filing

Rule 56

The procedure under Rule 56 allows the applicant to file missing drawings or parts of the description subsequently, and to rely on the priority document in order to avoid re-dating of the application to the date of filing of the missing parts. Under Rule 56(3), re-dating is only avoided where the missing parts were "completely contained" in the priority document (see C-III, 1 and A-II, 5). The provisions of Rule 56(3) apply only to the filing stage of the application, without further implications: in particular, it is not permissible at later stages of the procedure to rely on the priority documents to correct or amend the application as filed (in keeping with G 3/89 and G 11/91). For Euro-PCT applications a similar provision exists under Rule 20.6 PCT, whereby a review by the EPO as elected or designated Office is possible under Rule 82*ter* PCT.

Missing parts of the description and/or missing drawings allowed under Rule 56(3) are always considered to be part of the application documents "as originally filed".

2.2.3 Claims filed after the date of filing

Rule 58

Claims filed after the date of filing under Rule 58 are never considered to be part of the application documents "as originally filed" and must therefore comply with the requirements of Art. 123(2) (see A-III, 15). For this reason, the examining division has to check that the claims satisfy the requirements of Art. 123(2), according to the same practice and standards as established in examination for amendments filed in other phases of the procedure (see H-V).

2.2.4 Sequence listings filed after the date of filing

A standardised sequence listing filed after the date of filing does not form part of the description (Rule 30(2)). Such a standardised sequence listing is not published either as an annex to the application or together with the specification (see the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542, IV.2).

Pages and electronic files disclosing sequences or constituting a non-standardised sequence listing which were filed at the date of filing are an integral part of the application as originally filed and are treated like any other parts of the description.

A subsequently filed standardised sequence listing may contain only the sequence information – in a standardised form – already contained in the original application, and in particular the number of sequences and their numbering needs to be the same as in the original description (see the

Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542, I.2.4). To this end the applicant must file a statement confirming that the subsequently filed standardised sequence listing does not include matter which goes beyond the content of the application as originally filed (Art. 2(2) of the Decision of the President dated 28 April 2011, OJ EPO 2011, 372). In line with this, a subsequently filed standardised sequence listing cannot be used to determine the originally disclosed content of the application, but only for search purposes (see the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542, I.2.5).

A subsequently filed standardised sequence listing is not to be examined for compliance with the requirements of Art. 123(2), as it is not part of the description.

Without prejudice to Rule 30, a sequence listing forming part of the description may be corrected or amended in accordance with Rule 139 and/or Art. 123(2). In this case a complete new sequence listing in TXT format containing the corrections or amendments is to be filed (see the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542, I.2.6).

2.2.5 Priority documents

Under Art. 123(2) it is impermissible to add to a European application matter present only in the priority document for that application (see T 260/85) unless this is done under the provisions of Rule 56(3) (H-IV, 2.3.2). For correction of errors, see H-VI, 4.

2.2.6 Citation of prior art in the description after the filing date

Art. 123(2)

There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant; indeed this may be required by the examining division (see F-II, 4.3 and F-III, 8).

2.2.7 Clarifications

The removal of a lack of clarity will normally not be objected to, provided that the change does not extend beyond the disclosure of the application as originally filed (Art. 123(2)).

2.2.8 Trade marks

If an amendment is made in order to clarify the meaning of a trade mark or to replace a registered trade mark with a corresponding technical term, the examining division needs to be particularly careful to ascertain that the amendment does not conflict with Art. 123(2). The composition of a trade-marked product may have changed over time.

2.3 Content of the application as "originally" filed – special applications

2.3.1 Applications filed by reference to an earlier application

According to Rule 40(1)(c), the applicant may file a European application by reference to a previously filed application (A-II, 4.1.3.1). Since claims are no longer required in order for a date of filing to be accorded, the applicant has three options:

(i) when filing the European application, indicate that the reference to the previously filed application includes the claims

(ii) at the time of filing, file a new set of claims together with an indication that the description and any drawings are filed by reference to a previously filed application

(iii) when filing the European application, indicate the reference to a previously filed application and file the claims after the date of filing (Rule 58).

In cases (i) and (ii) the claims will form part of the application as originally filed, whereas in case (iii) the claims filed after the date of filing will not and will thus have to fulfil the requirements of Art. 123(2) (see H-IV, 2.2.3).

2.3.2 Divisional applications

Under Art. 76(1), the subject-matter of a divisional application may not extend beyond the content of the parent application as originally filed. Furthermore, amendments made to the divisional application subsequent to its filing may not extend beyond the content of the divisional application as originally filed (Art. 123(2); for more details see C-IX, 1.4).

2.3.3 Applications resulting from a decision under Art. 61

If, as a result of a final decision, it is adjudged that a person other than the applicant is entitled to the grant of a patent, that person may file a new European patent application under Art. 61(1)(b). In this case, the provisions of Art. 76(1) apply *mutatis mutandis* to the new application filed under Art. 61(1)(b).

This means that the new application must not contain any subject-matter extending beyond the content of the earlier (unentitled) application as originally filed. Furthermore, Art. 123(2) means that this new application may not be amended in such a way as to extend its subject-matter beyond its content as originally filed, even where the subject-matter in question is contained in the earlier application (for more details see C-IX, 2.1).

2.3.4 International applications

For the purposes of Art. 123(2), the documents as originally filed are those originally filed in the PCT phase (normally published as a WO publication), a copy of which can always be obtained from the International Bureau. Therefore amendments made during the PCT phase (including amended, substitute or rectified sheets, even if attached to the WO publication) or upon entry into the regional phase before the EPO must, if maintained in

the European phase, fulfil the requirements of Art. 123(2), and all such amendments must be carefully considered.

2.4 Assessment of "added subject-matter" – examples

If an application relates to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that a further ingredient may be added, then this amendment is normally objected to as infringing Art. 123(2).

In the case of a disclosure of both a general and a preferred range, a combination of the preferred disclosed narrower range and one of the part-ranges lying within the disclosed overall range on either side of the narrower range may be derivable from the original disclosure of the application.

In an application which describes and claims an apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support, an objection is raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs.

If, however, the applicant were able to demonstrate that the drawings, as interpreted by the skilled person, show helical springs, the specific mention of helical springs would be allowable, at least in the context of the specific embodiment where it is disclosed (see also H-V, 3.2.1).

3. Allowability of amendments under Art. 123(3)

3.1 Basic principles

Art. 69(2)

The European patent as granted or as amended in opposition, limitation or revocation proceedings determines retroactively the protection conferred by the European patent application.

Opposition proceedings will frequently give rise to amendments to the claims, following from grounds for opposition raised under Art. 100. Reasoned requests filed independently by proprietors of the patent for an amendment to the claims, e.g. for limitation of the patent in view of an aspect of the state of the art which has come to their knowledge, may also result in amendments to the claims after examination by the opposition division.

Art. 123(3)

In such cases the claims of the European patent may not be amended in such a way as to extend the protection conferred by the patent.

Art. 123(3) is directly aimed at protecting the interests of third parties by prohibiting any broadening of the claims of a granted patent, even if there is a basis for such broadening in the application as filed (see G 1/93, Reasons 9).

3.2 Protection conferred by the patent as granted

Art. 69(1)

The extent of protection conferred by a European patent is determined by the claims. Nevertheless, the description and drawings are to be used to interpret the claims.

The Protocol on the Interpretation of Art. 69, which is, pursuant to Art. 164(1), an integral part of the EPC, specifies how Art. 69 is to be interpreted.

Since, pursuant to Art. 69(1), amendments to the description and drawings will also influence the interpretation of the claims, and may therefore extend the protection conferred, any such amendments extending protection in this way are not allowable (see G 1/93).

3.3 Version of the granted patent to be considered

In order to verify the criteria of Art. 123(3) the examining or opposition division needs to compare the text of the amended claims with the claims of the patent as granted or as amended in opposition or earlier limitation proceedings, whichever claims are the most recent in force.

3.4 Assessment of impermissible extension of the protection conferred

In view of the above considerations, all amendments made to claims and any connected amendments to the description and drawings in the course of opposition proceedings, such as a change in the technical features of the invention, must be examined to determine whether such amendments could result in the extension of the subject-matter beyond the content of the application as originally filed (Art. 123(2)) or in the extension of the protection conferred (Art. 123(3)).

If, in view of Art. 84, the application documents have been adapted to amended claims before grant, thereby deleting part of the subject-matter originally disclosed in order to avoid inconsistencies in the patent specification, as a rule, subject-matter deleted for this reason cannot be reinserted either into the patent specification or into the claims as granted without infringing Art. 123(3) (the cut-off effect). An analogous finding applies to subject-matter retained in the patent specification during such adaptation for reasons of comprehensibility, but indicated as not relating to the claimed invention (see T 1149/97).

The requirements of Art. 123(2) and Art. 123(3) have to be dealt with separately:

(a) Examination for compliance with Art. 123(2) is conducted in the same way as in examination proceedings.

(b) Examination for compliance with Art. 123(3), on the other hand, is based on the claims as granted, or as amended in opposition or earlier limitation proceedings, where necessary using the description and drawings to interpret the claims (Art. 69 and the Protocol on the Interpretation of Art. 69).

A composition which is specified in a claim as comprising a component in an amount which is defined by a numerical range of values is subject to an implicit proviso excluding the presence of that component in an amount outside of that range. An amendment restricting the breadth of that component, for instance by narrowing down a generic class or a list of

chemical compounds defining that component, has the consequence of limiting the scope of this implicit proviso. However, a composition which is defined as comprising the components indicated in the claim is open to the presence of any further components unless otherwise specified. Therefore in a claim directed to such an openly defined composition, the restriction of the breadth of a component present therein may have the effect of broadening the scope of protection of that claim, with the consequence that in opposition/appeal proceedings such amended claim may extend the protection conferred by the granted patent (Art. 123(3)) (see T 2017/07 and T 287/11). Restricting the breadth of the component means that certain materials are no longer explicitly limited by the claim and therefore can be present in amounts which were excluded from the granted claim.

3.5 Conflicts between Art. 123(2) and Art. 123(3)

A possible conflict between the requirements of Art. 123(2) and (3) may occur where, in the procedure before grant, a feature was added to the application which is considered unallowable under Art. 123(2) in opposition proceedings. In that case, Art. 123(2) would require deletion of such a feature whereas Art. 123(3) would not allow deletion, as this would extend the protection conferred by the patent as granted. In such a case the patent will have to be revoked under Art. 100(c). However, where this feature can be **replaced** by a feature for which there is a basis in the application as filed **and** which does not extend the protection conferred by the patent as granted, maintenance in this amended form can be allowed. If the added feature, **without providing a technical contribution to the subject-matter of the claimed invention**, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, this feature may be maintained (see G 1/93). The technical significance of a feature in a claim is governed by its contribution to the technical definition of the claimed subject-matter, and that contribution is to be assessed by the skilled person in the light of the original disclosure (see T 518/99).

3.6 Conflicts between Art. 123(3) and other requirements of the EPC

Art. 123(3)

Other requirements of the EPC may also interact with Art. 123(3) after grant. For instance, if a patent as granted only contains claims that in fact define a "method for treatment of the human or animal body by therapy or surgery practised on the human or animal body" or contain such a method step, and such a patent is opposed under Art. 53(c), then Art. 53(c) and 123(3) may operate in combination so that the patent must inevitably be revoked, in that:

– the patent cannot be maintained as granted because its claims define subject-matter which is excluded from patentability under Art. 53(c); and

– the patent cannot be maintained in amended form because amendment of the claims as granted by deletion of such "method features" would be contrary to Art. 123(3) (see T 82/93).

4. Compliance of amendments with other EPC requirements

4.1 General principles

The other EPC requirements with which amendments have to comply will depend on whether the amendments are filed in examination, opposition or limitation proceedings (see below).

4.2 In examination proceedings

The question of allowability of amendments is legally a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the EPC including, in particular, inventive step and the other matters listed in B-XI, 3.6 (see also C-III, 2). Also, however, especially when the claims have been substantially limited, the examining division needs to bear in mind that the following questions may require special consideration at the amendment stage.

(i) Unity of invention

Do the amended claims still satisfy the requirements of Art. 82? If the search report seems to reveal lack of novelty or inventive step in the concept common to all the claims, but the amended claims do not necessitate further search, the examining division will consider carefully whether an objection of lack of unity is justified at this stage of the proceedings (see F-V, 6). If, however, the claims lack a common inventive concept and a further search is necessary, then an objection is raised.

(ii) Agreement of description and claims

If the claims have been amended, will the description require corresponding amendment to remove serious inconsistency between them? For example, is every embodiment of the invention described still within the scope of one or more claims? (see F-IV, 4.3 and H-V, 2.7). Conversely, are all of the amended claims supported by the description? (see F-IV, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment (see H-V, 8)?

4.3 In opposition proceedings

The proprietors of the patent generally have to indicate the basis in the original application documents or claims of the granted patent from which the amendments may be derived (Art. 100(c) and Art. 123(2)). In addition, they should file observations as regards the patentability of the subject-matter of the patent as amended (with reference to Art. 100(a) and (b)), taking into account the state of the art and objections raised in the opposition notice together, where appropriate, with the evidence presented in support.

Opposition is not an opportunity to re-examine the whole patent; it is the amendments introduced into the patent which must be examined as to whether they comply with the EPC as a whole (see G 3/14, T 227/88 and T 301/87). Therefore the opposition division will check that the patent, by

the amendments themselves, does not contravene the requirements of the EPC (with the exception of Art. 82, see G 1/91 and D-V, 2). With respect to Art. 84, see D-V, 5. For the form of amended documents, see H-III, 2.2 to H-III, 2.4. The formal requirements, in particular Rules 30 to 34 and Rules 42, 43, 46, 48 and 50, must also be satisfied (see Rule 86).

4.4 In limitation proceedings

Limitation is not an opportunity to re-examine the whole patent; only the amended claims are to be examined with regard to Art. 84 and Art. 123(2) and (3), i.e. what needs to be considered is whether the requested amendments introduce a deficiency within the meaning of those provisions. Claims as granted or as maintained are not examined anew.

4.4.1 Art. 84

It is also to be verified that the amended claims are in conformity with Art. 84. For the interpretation of clarity under Art. 84 in limitation proceedings, the usual standards apply (see F-IV, 4, 5 and 6). Note in this respect that mere clarifications made to the claims, in particular to dependent claims, cannot be allowed unless they are necessitated by the limitation(s) introduced elsewhere in the claims.

4.4.2 Examination of the description and/or drawings

Rule 95(2) requires only the amended claims to be examined in limitation proceedings. Nonetheless, if the applicant has not filed amendments to the description, the examining division checks whether the amended claims are still supported by the description. If this is not the case, in accordance with Rule 95(2) the proprietor is requested to amend either the description or the claims, in order to comply with Art. 84. In this context it is pointed out that the examining division may not adapt the description of its own motion.

If, however, for the purpose of limitation an amended description and/or drawings are presented together with the claims, these are to be checked, but only for compliance with the requirements of Art. 123(2) and (3) and Art. 84. Note that in this respect amendments made to the description solely in order to improve the patent, or cosmetic changes which are not necessitated by the limited claims, cannot be allowed.

4.4.3 Points to be disregarded

In limitation proceedings there is no examination as to why a request for limitation was filed or whether the goal of the limitation has been achieved, for example if the amended and limited claims are truly novel vis-à-vis a particular prior art document.

In general there is no need to verify whether the limited claims contravene any of Art. 52 to 57. It may however happen that limitation results in *prima facie* non-compliance with the patentability criteria, e.g. Art. 53, in which case the examining division will communicate this non-compliance to the requester.

Examples:

A granted claim directed to a generic plant is limited to a specific plant variety. As the amended claim then relates to a plant variety *per se* it is excluded from patentability under Art. 53(b) (G 1/98).

A claim granted to a device comprising a controlled explosion system is limited to a claim reciting an anti-personnel mine comprising the controlled explosion system, which would be contrary to Art. 53(a).

Chapter V – Allowability of amendments – examples

1. Introduction

Chapter H-V provides additional guidance and examples relating to a number of typical situations where compliance with Art. 123(2) and/or Art. 123(3) is an issue. However, it must be borne in mind that the allowability of a specific amendment is ultimately to be decided on a case-by-case basis.

2. Amendments in the description

2.1 Clarification of a technical effect

Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application as filed, subsequent clarification of that effect in the description does not contravene Art. 123(2).

2.2 Introduction of further examples and new effects

Amendment by the introduction of further examples always needs to be looked at very carefully in the light of the general considerations outlined in H-IV, 2. The same applies to the introduction of statements of new (i.e. previously not mentioned) effects of the invention such as new technical advantages. For example, if the invention as originally presented related to a process for cleaning woollen clothing consisting of treating the clothing with a particular fluid, the applicant is not allowed to introduce later into the description a statement that the process also has the advantage of protecting the clothing against moth damage. *Art. 123(2)*

Under certain circumstances, however, later filed examples or new effects, even if not allowed into the application, may nevertheless be taken into account by the examining division as evidence in support of the patentability of the claimed invention. For instance, an additional example may be accepted as evidence that the invention can be readily applied, on the basis of the information given in the originally filed application, over the whole field claimed (see F-IV, 6.3). Similarly a new effect may be considered as evidence in support of inventive step, provided that this new effect is implied by or at least related to an effect disclosed in the originally filed application (see G-VII, 10). *Art. 123(2)*

2.3 Supplementary technical information

Any supplementary technical information submitted after the filing date of the application will be added to the part of the file which is open to public inspection unless excluded from public inspection pursuant to Rule 144(d). From the date on which the information is added to the open part of the file, it forms part of the state of the art within the meaning of Art. 54(2). In order to notify the public of the existence of such information submitted after the application was filed and not included in the specification, an appropriate mention will be printed on the cover page of the patent specification.

2.4 Revision of stated technical problem

Care must also be taken to ensure that any amendment to, or subsequent insertion of, a statement of the technical problem solved by the invention meets Art. 123(2). For example it may happen that following restriction of the claims to meet an objection of lack of inventive step, it is desired to revise the stated problem to emphasise an effect attainable by the thus restricted invention but not by the prior art.

It must be remembered that such revision is only permissible if the effect emphasised is one deducible by a person skilled in the art without difficulty from the application as filed (see H-V, 2.1 and 2.2 above).

If the suggested amendment would contravene Art. 123(2), it will be necessary to amend the description in some other way, e.g. by defining the problem in more general terms or by omitting any express statement of the problem altogether.

2.5 Reference document

Features from a cross-referenced document can, under particular conditions be introduced by way of amendment into the claims of an application (see H-IV, 2.2.1).

2.6 Alteration, excision or addition of text in the description

Alteration or excision of the text, as well as the addition of further text, may introduce fresh subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene or to omit this layer altogether would not normally be allowable. In each case, the panel disclosed by the amendment example would be quite different from that originally disclosed and, hence, the amendment would introduce fresh subject-matter and therefore be unallowable.

2.7 Bringing the description into line with amended claims

The description must be brought into line with amended claims by amending it as needed to meet the requirements set out in F-II, 4.2, F-IV, 4.3(iii) and F-IV, 4.4.

If the applicant does not amend the description as required despite being asked to do so, the examining division's next action may be to issue a summons to oral proceedings; for the time limit, E-III, 6(iii) applies.

3. Amendments in claims

Replacement or removal of features from a claim, as well as the addition of further features, may introduce fresh subject-matter not only in the claim itself, but also in the claims when considered as a whole. In fact, such amendments could result in a combination of features not disclosed in the application as filed when the amended claim is considered together with its dependent claims and/or the claims on which it depends.

3.1 Replacement or removal of features from a claim

The requirements of Art. 123(2) are only met if the replacement or removal of a feature lies within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing (or the date of priority according to Art. 89), from the whole of the application documents (G 3/89, G 11/91 and G 2/10). *Art. 123(2)*

If the amendment by replacing or removing a feature from a claim fails to pass the following test by at least one criterion, it necessarily contravenes the requirements of Art. 123(2):

(i) the replaced or removed feature was not explained as essential in the originally filed disclosure;

(ii) the skilled person would directly and unambiguously recognise that the feature is not, as such, indispensable for the function of the invention in the light of the technical problem the invention serves to solve (in this context special care needs to be taken in cases where the technical problem is reformulated during the proceedings, see H-V, 2.4 and G-VII, 11); and

(iii) the skilled person would recognise that the replacement or removal requires no modification of one or more features to compensate for the change (it does not in itself alter the invention).

However, even if the above criteria are met, the division must still ensure that the amendment by replacing or removing a feature from a claim satisfies the requirements of Art. 123(2) as they also have been set out in G 3/89 and G 11/91, referred to in G 2/10 as "the gold standard".

If several features are deleted from an independent claim, so that for example it is restricted to only part of the originally claimed subject-matter, the subject-matter of the amended claim must be directly and unambiguously derivable from the application as filed as being an invention *per se*, i.e. it must solve a technical problem and be able to work in the absence of any of the particular features being deleted.

The removal of a limiting feature from an independent granted claim is likely to result in broadening the scope of protection afforded and could therefore contravene Art. 123(3). Likewise, if a feature in a granted claim is replaced, compliance with Art. 123(3) has to be carefully checked. *Art. 123(3)*

3.2 Inclusion of additional features

A claim may be limited by the inclusion of additional features, provided the resulting combination was directly and unambiguously disclosed in the application as originally filed in an explicit or implicit manner (see H-IV, 2.1) and does not relate to an invention which was not searched (see H-II, 6 and H-II, 7.2). If the resulting combination is novel over the application as originally filed (see the test for novelty given in G-VI, 2), the amended claim does not fulfil the requirements of Art. 123(2). *Art. 123(2)*

The fact that the resulting combination can be seen as:

– "not inconsistent" with the description (T 495/06) or

– "reasonably plausible" (T 824/06) or

– "obvious" in view of the application (T 329/99)

is not sufficient for an amendment to be allowable under Art. 123(2), since its direct and unambiguous disclosure is required.

A claim may be limited by inclusion of additional features, for example:

(a) from dependent claims, which were dependent on the claim to be limited;

(b) from the description (see also H-V, 3.2.1);

(c) from drawings (see H-V, 6);

(d) arising from the conversion of an independent claim to a dependent claim;

provided the above requirements are fulfilled.

3.2.1 Intermediate generalisations

Art. 123(2)

Extracting a specific feature in isolation from an originally disclosed combination of features and using it to delimit claimed subject-matter may be allowed only if there is no structural and functional relationship between the features.

When evaluating whether the limitation of a claim by a feature extracted from a combination of features fulfils the requirements of Art. 123(2), the content of the application as filed must not be considered to be a reservoir from which individual features pertaining to separate embodiments can be combined in order to artificially create a particular combination.

When a feature is taken from a particular embodiment and added to the claim, it has to be established that:

– the feature is not related or inextricably linked to the other features of that embodiment and

– the overall disclosure justifies the generalising isolation of the feature and its introduction into the claim.

These conditions are to be understood as an aid to assessing, in the particular case of an intermediate generalisation, if the amendment fulfils the requirements of Art. 123(2). In any case it has to be ensured that the skilled person is not presented with information which is not directly and unambiguously derivable from the originally filed application, even when

account is taken of matter which is implicit to a person skilled in the art using the common general knowledge.

Example 1

The amended claim relates to a heddle for the harness of a loom. The original claim was limited by introducing features that were disclosed only in connection with a specific embodiment in which the eyelet of the heddle had the shape of a spindle. This shape was not included in the amended claim. In the general part of the description it was also mentioned that the eyelet could also have other shapes such as an elliptic shape. Therefore the board concluded that the amendment was allowable under Art. 123(2) (T 300/06).

Example 2

Claim 1 relates to a water dispersible and flushable absorbent article. Amended claim 1 specifies that each of the first and second fibrous assemblies is a wet laid tissue. The application as filed referred, in connection with the first fibrous assembly, to a wet laid tissue in combination with other features (tissue is apertured; tissue is provided with fibrils or sufficient inherent porosity).

Since the first fibrous assembly is disclosed in the application as filed as being a wet laid tissue only in combination with other features which are not present in claim 1, the amendments made constitute a generalisation of the originally disclosed technical information and thereby introduce subject-matter extending beyond the content of the application as filed (T 1164/04).

Example 3

Original claim 1 relates to a coating composition comprising at least one rosin compound, at least one polymer and an antifoulant.

After amendment a new claim was introduced relating to a method for preparing a coating composition comprising the mixing of at least one rosin compound, at least one polymer and an antifoulant. The only basis for the method is the examples. The board observed that for some solutions the amount of added rosin was extremely low whereas for others it was extremely high. The subject-matter of the amended claim was considered to be an unallowable generalisation of the examples, since nothing in the description indicated to the person skilled in the art that the observed variations were not essential to make a coating composition (T 200/04).

Example 4

Original claim 1 relates to a multi-processing system comprising a shared memory, a directory and a serialisation point. The serialisation point is defined in functional terms. Claim 1 was amended by adding features that were addressed in the description as part of the cache coherence strategy. The board held that the incorporated features, albeit disclosed as such, had been isolated in an arbitrary manner from the overall disclosure of the cache coherent memory access architecture. At least one feature had been

omitted although its function was presented as being essential to achieving cache coherence. Therefore amended claim 1 was not directly and unambiguously derivable from the original application (T 166/04).

3.3 Deletion of part of the claimed subject-matter

Art. 123(2)

It is permissible to delete parts of the claimed subject-matter if the corresponding embodiments were originally described, e.g. as alternatives in the claim or as embodiments explicitly set out in the description.

Example:

Original application:	"A polymer blend XY ... containing, as a filler, graphite, talc, asbestos or silica"
Prior art:	"A polymer blend XY ... containing asbestos".
Limited claim:	"A polymer blend XY ... containing, as a filler, graphite, talc or silica".

The deletion of alternatives from more than one list is only allowable if this does not result in the creation of new technical information that is not directly and unambiguously derivable from the application as originally filed.

In particular, limitations that do not result in the singling out of a particular combination of specific features but maintain the remaining subject-matter as a generic group which differs from the original group only by its smaller size will normally fulfil the requirements of Article 123(2) EPC.

Deletion of part of the claimed subject-matter resulting in a combination of specific features may be allowable if the application as filed provides a pointer towards that particular combination, e.g. by reference to particular embodiments.

These principles also apply to the combination of features resulting from dependent claims.

Example

Original claim 1	"A composition for therapeutic use comprising a therapeutic agent and a glass-forming carbohydrate."
Original claim 22	"A composition according to claim 1 wherein the therapeutic agent is selected from the group enzymes, biopharmaceuticals, growth hormones, growth factors, insulin, monoclonal antibodies, interferons, interleukins and cytokines."
Original disclosure	In the description, inhalation is listed as one of several ways of administration. In the description, insulin is listed as one of several therapeutic agents.
Limited claim 1	"A composition for therapeutic use suitable for administration by inhalation comprising a therapeutic agent and a glass-forming carbohydrate".
Dependent claim 10	"A composition according to claim 1 wherein the therapeutic agent is insulin"

The limitation to inhalation in claim 1 results from a choice from one list and has a basis in the application as originally filed.

The combination of the subject-matter of dependent claim 10 with the subject-matter of claim 1 results from a selection from multiple lists which is not disclosed directly and unambiguously in the application as originally filed.

The number of amendments held to have been combined to arrive at the amended claimed subject-matter is not decisive in order to assess whether the claimed subject-matter extends beyond the content of the application as filed. What is required is an analysis of whether the claimed subject-matter is explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed.

Wherever possible, the claim should be limited by a positive indication of what subject-matter remains instead of stating what is being deleted from the subject-matter (as a disclaimer would do).

Example:

– "... a polyether of molecular weight from 600 to 10 000" restricted to "... above 1 500 to 10 000" (T 433/86).

3.4 Further cases of broadening of claims

The deletion of a statement regarding use or intended purpose in an independent product claim fulfils the requirements of Art. 123(2) only if the *Art. 123(2)*

application as filed offers a basis for the assumption that the product can also be used in some other way (and if the statement of purpose does not amount to a functional limitation).

The broadening of a claim by exchanging a particular feature for a more general feature cannot be based on an indication that it would be obvious for a skilled person (see also H-V, 3.2.1).

Art. 123(3) Moreover, the deletion of a particular feature or its replacement by a more general feature usually leads to a broadening of the claim. Therefore, the requirements of Art. 123(3) are not fulfilled.

4. Disclaimers

4.1 Disclaimer disclosed in the application as originally filed

In this case, the original application already indicates that specific subject-matter is not part of the invention.

Art. 123(2) Negative features help to define the claimed invention in the same way as positive ones, and must be examined on the same basis. In other words, they may confer novelty and, like positive features, are assessed as to their relevance to inventive step. They must also fulfil the requirements of Art. 84 (clarity, conciseness and support), and their inclusion in the claims must not infringe Art. 123(2) (T 170/87, T 365/88).

Examples:

– "... said delivery means does not comprise a capacitor element";

– "... with the proviso that blends having a melt index of lower than 0.05 are excluded".

Negative features, like positive ones, may be structural or functional, and may relate to either a physical entity or an activity.

4.2 Disclaimers not disclosed in the application as originally filed

4.2.1 The subject-matter to be excluded is not disclosed in the application as originally filed (so-called undisclosed disclaimers)

Limiting the scope of a claim by using a "disclaimer" to exclude a technical feature not disclosed in the application as filed may be allowable under Art. 123(2) in the following cases (see G 1/03 and G 1/16 and F-IV, 4.20):

(i) restoring novelty over a **disclosure under Art. 54(3);**

(ii) restoring novelty over an **accidental anticipation** under Art. 54(2). "An anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention". The status of "accidental" is to be ascertained without looking at the available further state of the art. A related document does not become an accidental anticipation merely because there are other

disclosures even more closely related. The fact that a document is not considered to be the closest prior art is insufficient for achieving the status of "accidental". An accidental disclosure has nothing to do with the teaching of the claimed invention, since it is not relevant for examining inventive step. For example, this is the case when the same compounds serve as starting materials in entirely different reactions yielding different end products (see T 298/01). A prior art, the teaching of which leads away from the invention, however, does not constitute an accidental anticipation; the fact that the novelty destroying disclosure is a comparative example is also insufficient for achieving the status of "accidental" (see T 14/01 and T 1146/01);

(iii) removing subject-matter which, under Art. 52 to Art. 57, is excluded from patentability for **non-technical reasons**. For example, the insertion of "non-human" in order to satisfy the requirements of Art. 53(a) is allowable.

These criteria notwithstanding the introduction of the undisclosed disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. The undisclosed disclaimer (which inevitably quantitatively reduces the original technical teaching) may not qualitatively change the original technical teaching in the sense that the applicant's or patent proprietor's position with regard to other requirements for patentability is improved. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. Hence, the evaluation of inventive step has to be carried out disregarding the undisclosed disclaimer (see G 1/16).

The disclaimer may not remove more than necessary either to restore novelty (cases (i) and (ii) above) or to disclaim subject-matter excluded from patentability for non-technical reasons (case (iii) above).

An undisclosed disclaimer is, in particular, **not** allowable if:

(i) it is made in order to exclude **non-working embodiments** or remedy **insufficient disclosure**;

(ii) it makes a technical contribution.

(iii) the limitation is relevant for assessing inventive step;

(iv) the disclaimer, which would otherwise be allowable on the basis of a conflicting application alone (Art. 54(3)), renders the invention novel or inventive over a separate prior art document under Art. 54(2), which is a **not accidental** anticipation of the claimed invention;

(v) the disclaimer based on a conflicting application also serves another purpose, e.g. it removes a deficiency under Art. 83.

Art. 84 applies equally to the claim *per se* and to the disclaimer itself (see T 2130/11).

In the interest of the patent's transparency, the excluded prior art must be indicated in the description in accordance with Rule 42(1)(b) and the relation between the prior art and the disclaimer must be shown.

4.2.2 The subject-matter to be excluded is disclosed in the application as originally filed

The test to be applied is whether the subject-matter remaining in the claim after the introduction of the disclaimer is, be it explicitly or implicitly, directly and unambiguously disclosed in the application as filed to the skilled person using its common general knowledge at the date of filing (or the date of priority according to Art. 89), see G 2/10, Headnote 1a.

This test is the same as that applied when the allowability of a limitation of a claim by a positively defined feature is to be determined (see H-V, 3.2).

When it comes to determining whether, after the introduction of the disclaimer, the claim infringes Art. 123(2) or whether it is in conformity with it, this cannot be decided solely by establishing that the disclaimed subject-matter is disclosed in the application as filed.

Whether the skilled person is presented with new information depends on how he or she would understand the amended claim, i.e. the subject-matter remaining in the amended claim and on whether, using common general knowledge, he or she would regard that subject-matter as at least implicitly disclosed in the application as filed.

What is required is an assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.

In this respect it has to be established whether the disclaiming of subject-matter leads for example to the singling out of compounds or sub-classes of compounds or other so-called intermediate generalisations not specifically mentioned or implicitly disclosed in the application as filed (see G 2/10).

Whether the invention works for the claimed subject-matter and what problem is credibly solved by it are questions which are not relevant for assessing whether this subject-matter extends beyond the content of the application as filed (see T 2130/11).

5. Amendments to drawings

It sometimes occurs that the drawings used for publication of the application are not those originally filed but are subsequently filed drawings, because the latter are more suitable for reproduction (for drawings filed under Rule 56, see A-II, 5 and subsections). In this case, the formalities officer in the Receiving Section will check that the subsequently filed drawings are identical to the originals.

However, the ultimate responsibility for ensuring that the subsequently filed drawings do not contain new technical information, which would conflict with Art. 123(2), rests with the examining division.

If the examining division considers that these drawings conflict with Art. 123(2), it requires the applicant to submit other drawings which correspond exactly in substance to the drawings originally filed.

It is not normally possible under Art. 123(2) to add completely new drawings to an application, since in most cases a new drawing cannot be unambiguously derivable from the mere text of the description. For the same reasons, amendments to drawings are carefully checked for compliance with Art. 123(2).

6. Amendments derived from drawings

Care needs to be taken when amendments are based on details which may only be derived from the schematic drawings of the original application (see also H-IV, 2.4).

In particular, a figure which serves only to give a schematic explanation of the principle of the subject-matter of the invention and not to represent it in every detail does not allow the conclusion that the disclosed teaching purposively excluded a feature not represented (T 170/87).

The manner in which a particular feature is depicted in the drawings may be accidental. The skilled person must be able to clearly and unmistakably recognise from the drawings, in the context of the whole description, that the added feature is the deliberate result of the technical considerations directed to the solution of the technical problem involved.

For example, the drawings may depict a vehicle in which approximately two thirds of the height of the engine is located below a plane tangent to the top of the wheels. An amendment which defines that the major portion of the engine is located below the given level would not infringe Art. 123(2) if the skilled person would recognise that such a spatial arrangement of the engine with respect to the wheels is in fact a deliberate measure directed to the solution of the technical problem (see T 398/00).

7. Changes in claim category in opposition

Rule 80
Art. 123(2) and (3)

An amendment can be in the form of a change in the category of a claim, possibly combined with a change in the technical features of the invention. Firstly it must be clear that this amendment is necessitated by grounds for opposition (see H-II, 3.1). If that is not the case, a change of category is refused.

Even if this condition is fulfilled, the opposition division exercises great caution in allowing a change of claim category, since the protection as conferred by the claims may thus be extended (Art. 123(3)). Examples are given in the following sections. Note that these examples could also give rise to issues under Art. 123(2).

7.1 Product claim to use claim

If a patent is so amended that a claim to a product (a physical entity) is replaced by a claim to the use of this product, the degree of protection is not extended, provided that the use claim in reality defines the use of a particular physical entity to achieve an effect and does not define such a use to produce a product (see G 2/88).

7.2 Product claim to method claim

If a patent is so amended that a claim to a product is replaced by a claim to a method for producing the product, this change of category is allowable, provided that the method now claimed only results in the product previously claimed. As it is a fundamental principle of European patent law that the protection conferred by a product claim covers all methods for production of the product, the limitation to one of these methods cannot extend the protection conferred originally (see T 5/90 and T 54/90).

7.3 Method claim to product claim

In general, a change in claim category from a method in which an apparatus is used to the apparatus itself is not allowable (see T 86/90).

However, it may exceptionally be allowable to replace a claim directed to a method of operating a device by a claim directed to the device itself if the original claim contains the claimed features of the device exhaustively, whether in structural or functional terms (see T 378/86 and T 426/89).

This exception, however, does not apply if the device as now claimed is for its features no longer dependent on the circumstances of its operation whereas it depended on them under the terms of the prior method claim (see T 82/93).

Moreover, changing the category from a purpose-limited process claim in the format of a Swiss-type claim in accordance with G 5/83 to a purpose-limited product claim in accordance with Art. 54(5) contravenes Art. 123(3), because a purpose-limited process claim confers less protection than a purpose-limited product claim (T 1673/11).

7.4 Method claim to use claim

The change from a process for the preparation of a product to the use of the product for a purpose other than previously claimed is not allowable (see T 98/85 and T 194/85).

On the other hand, the change in a claim from a method in which a certain product is used to a claim to the use of that product in performing that same method is allowable (see T 332/94).

8. Changes in the title

The sole purpose of the title is to inform the public about the technical information disclosed in the application. The title has no bearing on the content of the application as filed or on the protection conferred by the patent, once granted. Furthermore, the title is not part of the documents to be approved by an applicant before a patent can be granted.

Thus the ultimate responsibility for the title rests with the division, and it is within the division's discretion to accept or not any request from the applicant for a change in the title (see also A-III, 7).

Chapter VI – Correction of errors

1. Introduction

Documents filed with the EPO may contain errors, e.g. in the bibliographic data, the description, the claims or the drawings (see H-VI, 2). Errors may also occur in the decision to grant or other decisions of the EPO (see H-VI, 3), as well as in printing the specification (see H-VI, 4).

These errors can be corrected as set out below.

2. Corrections of errors in documents filed with the EPO

Corrections under Rule 139 concern linguistic errors, errors of transcription and other mistakes in documents filed with the EPO, especially in application documents (see H-VI, 2.2.1). *Rule 139*

However, see also A-VII, 7 for the correction of errors in a translation of a patent application, A-III, 3.5 for the correction of the designation of inventor and A-III, 6.5.2 for the correction/addition of a priority claim.

Requests for correction under Rule 139 are dealt with by the department responsible for the proceedings:

(i) In examination and opposition proceedings, the correction of errors under Rule 139 is the responsibility of the formalities officer, with the exception of errors in the description, claims and drawings (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6, Art. 1, point 22, and Art. 2, point 21).

(ii) Where the Receiving Section is responsible (Rule 10(1)), it decides on requests for correction unless the request requires technical examination. In the latter case, the examining division will decide on the request once it has assumed responsibility (see J 4/85).

2.1 Admissibility

The correction of linguistic errors, errors of transcription and other mistakes in any document filed with the EPO may in principle be requested as long as proceedings are pending before the EPO (J 42/92). However, during examination proceedings, such requests for correction can be considered only if the decision-making process has not yet been concluded, in other words until the day on which the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant (see G 12/91; date "to EPO postal service" printed at the bottom of Form 2006A). See also H-II, 2.6, last paragraph. *Rule 139*

Moreover, other time limitations apply to requests under Rule 139:

(i) The request has to be made without undue delay after the error is discovered (G 1/12, J 16/08).

(ii) In the case of correction of bibliographic data (e.g. priority, designation) or of procedural declarations (e.g. withdrawal), time

limitations may derive from the protection of the interests of the public. For instance, in the absence of any special circumstances, a request for correction of a priority claim by the addition of a first priority needs to be made sufficiently early for a warning to be included in the publication of the application (J 6/91). Otherwise, correction is possible only where it is apparent on the face of the published application that a mistake has been made (see also A-V, 3). An erroneous withdrawal of an application may only be corrected if, at the time when the request for correction is made, the public has not yet been officially notified of the withdrawal (J 25/03).

(iii) Limitations on requesting the correction of an error in a document filed with the EPO also exist where a decision has already been taken or a procedural phase terminated on the basis of the document containing the error. A request under Rule 139 cannot reinstate an applicant into an earlier procedural phase or reverse the effects of a decision already taken (J 3/01, see also H-VI, 3.1). Such a request is therefore inadmissible in these cases.

2.1.1 Admissibility in opposition and limitation proceedings

Errors in documents filed during opposition and limitation proceedings may be corrected under Rule 139 (G 1/12) as long as the corresponding proceedings are pending before the EPO.

In opposition and limitation, requests to correct an error under Rule 139 may not, however, be used to correct the content of the decision to grant, thereby circumventing the restrictions under Rule 140.

2.1.1.1 Errors in the description, claims and drawings

The submission by the proprietor of an amended specification containing the correction of an obvious error will be admitted:

Rule 80

– in opposition proceedings if the correction is part of an amendment going beyond the mere removal of an error, namely an amendment occasioned by a ground for opposition (see H-II, 3);

Therefore, if the proprietor files an amended specification fulfilling the requirements of Rule 80, they can additionally request the correction of an obvious error under Rule 139 (see T 657/11). This request for correction will be dealt with by the opposition division (see H-VI, 2.1), as described in H-VI, 2.2 to H-VI, 2.2.2.

Rule 95(2)

– in limitation proceedings if the correction is part of an amendment going beyond the mere removal of an error, namely an amendment constituting a limitation vis-à-vis the claims as granted or amended, and complies with Art. 84 and Art. 123 (see D-X, 4.3).

In other words, if an amended set of claims fulfilling the requirements of Rule 95(2) is filed in limitation proceedings, obvious errors can be corrected under Rule 139.

2.2 Allowability

Corrections of clerical or grammatical errors are usually allowed, insofar as it is evident that an error has occurred and what the correction should be. *Rule 139* *Art. 123(2)*

However, correction of errors in the description, claims and drawings is a special form of amendment and is bound by Art. 123(2) (G 2/95; see also H-VI, 2.2.1). These errors can be corrected as set out below.

2.2.1 Correction of description, claims and drawings

Where the mistake is in the description, claims or drawings, both the error and the correction must be such that it is immediately evident:

(i) that an error has occurred; and

(ii) what the correction should be.

Regarding (i), the incorrect information must be objectively recognisable for a skilled person, using common general knowledge, from the originally-filed application documents (description, claims and drawings) taken by themselves.

Regarding (ii), the correction needs to be within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the originally-filed application documents.

In other words, the requirements of Art. 123(2) apply *mutatis mutandis*.

Evidence of what was common general knowledge on the date of filing may be furnished in any suitable form.

The priority documents cannot be used for the purposes mentioned under (i) and (ii) above (see G 3/89 and G 11/91).

Correction under Rule 139, second sentence, is of a strictly declaratory nature and establishes what a skilled person, using common general knowledge, would derive on the date of filing from the parts of a European patent application, seen as a whole, relating to the disclosure (see G 3/89 and G 11/91 mentioned above). Therefore, the complete replacement of the application documents (i.e. description, claims and drawings) by other documents is not possible (see G 2/95).

Some examples of allowable corrections:

(I) The replacement of "respectfully" by "respectively" in a claim (T 34/03).

(II) The addition of the plural "s" to the word "particle" as the corresponding verb "have" was in the plural form, and the application as originally filed described a particle size distribution. Since particle size distributions can be defined only for a plurality of particles, the correction was held allowable (T 108/04).

On the other hand, the applicant/proprietor cannot rely on:

(a) A mere count of the number of instances of the relevant words in the application as originally filed for obtaining the replacement of one word by another word, for instance the substitution of "included" for "excluded", if it is not clear that an error has occurred and not possible to ascertain that nothing other than "included" was intended by the drafter (T 337/88).

(b) Usual practice or industry standards for measuring concentrations of compounds in the relevant technical field, if the application as originally filed merely refers to "%", without clarification as to whether by weight or volume, and the description contains no clear guidance as to whether "%" refers to concentration by % by weight or % by volume or something different (T 48/02).

(c) Common general knowledge in the absence of further evidence, such as an encyclopaedia or basic textbook, to argue for instance that the skilled person would have immediately recognised that an ASTM standard with a six-digit number did not exist before the priority date of a patent (T 881/02).

2.2.2 Missing parts of description and missing drawings filed as corrections under Rule 139

The applicant may also request that missing parts of the description and/or missing drawings be included in the application documents by way of a correction according to Rule 139. In virtually all cases this will not be possible (see J 1/82).

In **extremely rare cases** the other application documents might allow the skilled person to reconstruct the missing parts of the description and/or missing drawings such that they may be filed by way of a correction according to Rule 139.

By contrast with missing parts of the description and/or missing drawings filed under Rule 56(3), corrections under Rule 139 can never be filed by reference to the priority document (see H-VI, 2.2.1).

3. Correction of errors in decisions

Correction of errors in decisions under Rule 140 must be clearly distinguished from correction of errors in documents filed by the applicant (or patentee) pursuant to Rule 139. For the latter, see A-V, 3 and H-VI, 2 and subsections. Correction of errors made by the applicant (or patentee) in application (or patent) documents cannot be arrived at in a roundabout manner through correction of the decision to grant (or to maintain in amended form).

Correction of a decision is allowable only if the text of the decision is manifestly other than intended by the department concerned. An error in the text of the patent that forms the basis for the decision cannot be imputed to the division by suggesting that the division did not intend to make a decision that in fact included the very text approved by the

applicant (or patent proprietor) himself as a means of bringing the error within the ambit of Rule 140. Thus only linguistic errors, errors of transcription and obvious mistakes in decisions can be corrected. The correction of a mistake in a decision under Rule 140 has a retrospective effect (see T 212/88). Therefore, when the decision to be corrected is the refusal of the application or the revocation of the patent, the time limit for filing a notice of opposition or an appeal is not changed by the publication or the notification of the corrected decision.

The competence to correct errors under Rule 140 lies with the body which took the decision (see e.g. G 8/95, J 12/85, J 16/99).

Hence, even during opposition (or appeal) proceedings, the examining division is competent to correct errors in bibliographic data contained in the decision to grant (see H-VI, 3.3). Examining or opposition divisions are competent to correct errors in the text of the patent that was the subject of their respective decisions, including editing/formatting errors (see H-VI, 3.3).

3.1 Admissibility

Rule 140 is not available to correct errors in documents filed by a patent applicant or proprietor (G 1/10). The correction of such documents is admissible only under Rule 139 and only as long as proceedings are pending (see H-VI, 2.1). Once the decision to grant is handed over to the EPO's internal postal service (G 12/91), only errors in bibliographic data, printing errors in the publication of the patent specification and formatting/editing errors may be corrected (see H-VI, 3.2 and H-VI, 3.3).

Since the final responsibility for the text of the patent lies with applicants or patentees, it is their duty to properly check all the documents making up the communication under Rule 71(3) (i.e. Form 2004 and the Druckexemplar). The same applies to documents as proposed for maintenance in amended form (see Rules 71(5), 82(1) and 95(2), Art. 113(2) and G 1/10).

However, requests for correction under Rule 139 of documents on which the patent is granted may under certain conditions be submitted in opposition and limitation proceedings (see H-VI, 2.1.1).

Corrections of decisions are to be made at the reasoned request of one of the parties or by the EPO of its own motion. If the request for correction is refused, this decision must be reasoned (see T 850/95). These reasons must previously have been communicated to the requester (Art. 113(1)).

3.2 Allowability of the correction of bibliographic data

The sole reason for allowing the correction of linguistic errors, errors of transcription and obvious mistakes is to ensure that the decision says what the division actually intended at the time of issue. If the bibliographic data referred to in the examining division's decision to grant or limit a patent or in the opposition division's communication under Rule 82(2) that a decision to maintain a patent in amended form has become final is not and obviously cannot be the bibliographic data corresponding to the real intention of the division, the bibliographic data erroneously indicated can be corrected

under Rule 140. In this respect, it is irrelevant whether the error was originally introduced by the applicants in their submissions or by the division itself.

In particular, misspellings or similar errors in the name of the patent proprietor may be corrected under Rule 140 wherever it does not result in the designation of a person different than the one originally named on filing (or their successor in title) and to whom the examining division intended to grant the patent.

In accordance with the Decision of the President of the EPO dated 23 November 2015 (OJ EPO 2015, A104), requests for the correction of errors in bibliographic data are dealt with by formalities officers.

3.3 Correction of errors under Rule 140 while opposition proceedings are pending – procedural aspects

Even during opposition proceedings, the examining division is competent to correct errors in its decision to grant, in particular errors in the decision's reasoning and bibliographic data, or formatting/editing errors in the text of the B1 publication (see H-VI, 3.2 and H-VI, 4).

Thus the opposition division refers to the examining division any request under Rule 140 to correct such errors filed by the patent proprietor while opposition proceedings are pending.

However, if the request for correction under Rule 140 is clearly inadmissible, i.e. the requested correction does not concern errors in bibliographic data contained in the decision to grant or formatting/editing errors in the text of the B1 publication, the opposition division continues the proceedings until the decision under Art. 101 is taken without waiting for closure of the proceedings before the examining division concerning the correction (in line with the reasoning of G 1/10). The procedural decision to continue the proceedings is appealable together with the opposition decision.

If the request for correction is admissible, the examining division processes it without delay in order to minimise or avoid delays to the opposition proceedings. The opposition division may adjourn the opposition proceedings to wait for closure of the proceedings before the examining division.

4. Correction of formatting/editing errors

Formatting/editing errors which were already contained in the text approved by the applicant may be corrected by the EPO of its own motion or at the request of the patent proprietor. Formatting/editing errors are alterations in the patent documents which occur during the preparation of the Druckexemplar and which are indicated neither by standard marks nor in Form 2004.

Example 1

In the Druckexemplar, page 10 contains two changes:

- the first change is indicated with standard marks;

- the second change is in a different paragraph on page 10 to the first change, and consists in the absence of the two top lines, but the deletion is not indicated by any standard mark (i.e. the two lines have just disappeared).

After publication of the grant, the applicant spots the errors and requests:

(a) the correction of a spelling error in the first change introduced by the examining division;

(b) the re-insertion of the top two lines that have disappeared.

Request (a) cannot be accepted, as the error is in the marked change. However, request (b) regarding the second change is a formatting/editing error. Thus, the request to reinstate the two top lines can be granted.

Example 2

EPO Form 2004 indicates inter alia page 10 as amended by the examining division; other pages of the description have been amended.

In the Druckexemplar, page 10 as originally filed is present; no amendments are present.

In this case, no correction can be made after issuance of the decision to grant as the error does not qualify as a formatting/editing error.

If any correction in the text of the specification as published is allowed, a corrected version of it will be published. However, such a correction has no influence on the start of the opposition period.

In any other case of discrepancy between the Druckexemplar and Form 2004, the patent proprietor has to file an appeal to seek remedy.

5. Correction of the translations of the claims

According to Art. 70(1), the text of a patent in the language of the proceedings is the authentic text. It therefore follows that the translations of the claims of the patent specification required by Art. 14(6) are for information only. Hence no examination of the translations takes place (C-V, 1.3); in particular, the translations do not form part of the decision to grant the patent. Therefore they cannot be corrected under Rule 140, either. However, if when a corrected version of a translation of the claims is received, the stage of preparations for the B publication still allows the exchange of documents, the EPO will publish the corrected version instead of the original version of the translation.

Where corrected translations of claims are not submitted to the EPO in time to be taken into account for the B publication, the only possibilities for the patent proprietor to amend them are when the patent is maintained in amended form (Rule 82(2)) or, as indicated in Art. 70(4), before a national authority.

6. Errors in publication

Errors in publication occur where the content of the printed specification differs from the documents (Druckexemplar) transmitted to the applicant with the communication under Rule 71(3) (Form 2004), if these documents form the basis of the decision to grant.

Errors in publication have to be distinguished from changes introduced in the text to be granted after the applicant's approval but before the decision to grant (G 1/10). In such cases, the patent proprietor has to file an appeal to seek remedy.

The above errors in publication can be corrected at any time (see also C-V, 10). The same applies *mutatis mutandis* to errors in the process for publication of the application and of the amended patent specification following a decision to maintain the patent as amended.

The competence to correct errors in publication lies with the body before which proceedings are or were last pending.

Therefore a request for correction of errors in the publication of the B1 specifications filed during opposition proceedings is dealt with by the opposition division.

Formalities officers are responsible for the correction of publication errors (see the Decision of the President of the EPO dated 23 November 2015, OJ EPO 2015, A104).

Index for Computer-Implemented Inventions

A computer-implemented invention (CII) is one which involves the use of a computer, computer network or other programmable apparatus, where one or more features are realised wholly or partly by means of a computer program.

The following collection of hyperlinks is provided in order to facilitate access to the sections of the Guidelines for Examination in the EPO which give instructions particularly useful for the search and examination of CIIs.

It is noted that this collection is not a separate publication about CIIs. Instead, following a hyperlink will lead to the section of the most recent and applicable version of the Guidelines which has the stated number and title.

The collection of sections essentially comprises the teaching about assessing patentability requirements, in particular in case of claims comprising a mix of technical and non-technical features, which are common in CII. Sections providing teaching about how to evaluate features related to the list of Article 52(2) are included as well as sections describing the search practice and requirements of Article 83 and 84.

The collection of sections should not be regarded as an exhaustive list. The whole of the Guidelines apply for any European patent application or patent.

As with the rest of the Guidelines, the updating of sections relating particularly to CIIs is an ongoing process to take account of developments in European patent law and practice. The list below also serves to point out which sections have recently been updated as indicated by the dates which follow the section title.

Patentable inventions

G-I, 1 Basic requirements

G-I, 2 Further requirements

G-II, 1 General remarks (updated in GL 2022)

G-II, 2 Examination practice (updated in GL 2022)

Features related to the list of Art. 52(2) and technical contribution

G-II, 3.3 Mathematical methods (updated in GL 2022)

– G-II, 3.3.1 Artificial intelligence and machine learning (introduced in GL 2018)

– G-II, 3.3.2 Simulation, design or modelling (updated in GL 2022)

G-II, 3.4 Aesthetic creations

G-II, 3.5 Schemes, rules and methods for performing mental acts, playing games or doing business

– G-II, 3.5.1 Schemes, rules and methods for performing mental acts (updated in GL 2022)

– G-II, 3.5.2 Schemes, rules and methods for playing games (updated in GL 2022)

– G-II, 3.5.3 Schemes, rules and methods for doing business (introduced in GL 2018)

G-II, 3.6 Programs for computers (updated in GL 2018)

– G-II, 3.6.1 Examples of further technical effects (introduced in GL 2018)

– G-II, 3.6.2 Information modelling, activity of programming and programming languages (introduced in GL 2018)

– G-II, 3.6.3 Data retrieval, formats and structures (updated in GL 2022)

– G-II, 3.6.4 Database management systems and information retrieval (introduced in GL 2021)

G-II, 3.7 Presentations of information (updated in GL 2018)

– G-II, 3.7.1 User interfaces (updated in GL 2021)

Novelty and inventive step

G-VII, 5.4 Claims comprising technical and non-technical features (updated in GL 2022)

– G-VII, 5.4.1 Formulation of the objective technical problem (updated in GL 2022)

– G-VII, 5.4.2 Examples of applying the COMVIK approach (updated in GL 2022)

  – G-VII, 5.4.2.1 Example 1

  – G-VII, 5.4.2.2 Example 2

  – G-VII, 5.4.2.3 Example 3

  – G-VII, 5.4.2.4 Example 4 (updated in GL 2022)

  – G-VII, 5.4.2.5 Example 5 (introduced in GL 2022)

Search practice

B-VIII, 2.2 Subject-matter excluded from patentability under Art. 52(2) and (3) (introduced in GL 2015)

– B-VIII, 2.2.1 Computer-implemented business methods (updated in GL 2015)

Requirements of Art. 84 EPC

F-IV, 3.9 Claims directed to computer-implemented inventions (introduced in GL 2016, with its sub-sections)

– F-IV, 3.9.1 Cases where all method steps can be fully implemented by generic data processing means

– F-IV, 3.9.2 Cases where method steps define additional devices and /or specific data processing means (updated in GL 2021)

– F-IV, 3.9.3 Cases where the invention is realised in a distributed computing environment (introduced in GL 2018)

Requirements of Art. 83 EPC

F-III, 1 Sufficiency of disclosure (see par. 4)

Formal requirements for the description part

F-II, 4.12 Computer programs

Guidelines for Examination
Alphabetical keyword index

The Alphabetical keyword index is added for the convenience of the reader; it does not form part of the Guidelines.

A

B

This alphabetical keyword index is not exhaustive.

C

D

This alphabetical keyword index is not exhaustive.

E

This alphabetical keyword index is not exhaustive.

Examining

Example 1 G-VII, 5.4.2.1

Example 2 G-VII, 5.4.2.2

Example 3 G-VII, 5.4.2.3

Example 4 G-VII, 5.4.2.4

Example 5 G-VII, 5.4.2.5

F

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List of sections amended in 2022 revision

MAJOR AMENDMENTS

PART A	A-II, 1.2.2	Updated in view of OJ EPO 2021, A42
	A-III, 5.3; A-III, 5.4	Updated in view amended Rule 19 [former subsection A-III, 5.4 has been deleted]
	A-III, 6.7	Updated in view of the termination of the PDX Agreements concerning the electronic exchange of priority documents with the USPTO, KIPO and CNIPA (OJ EPO 2021, A83 and OJ EPO 2021, A84)
	A-III, 6.12	Applicants from the People's Republic of China and Sweden are exempted from filing a copy of search results under Rule 141(1)
	A-X, 4.2.3; A-X, 4.4	Amended in view of the new Central Fee Payment online service (OJ EPO 2021, A61)
PART E	E-III, 8.3.1	Updated practice regarding checking the identity of the participants to oral proceedings by videoconference
	E-III, 8.6; E-VI, 2; E-VI, 2.1; E-VI, 2.2; E-VI, 2.2.1; E-VI, 2.2.2; E-VI, 2.2.3; E-VI, 2.2.4; E-VI, 2.2.5; E-X, 2.10	Updated to include further details about the practice regarding late-filed submissions, and restructured by moving subsections to E-VI, 2
	E-XIV, 3	Updated in view of OJ EPO 2021, A86 – electronic signatures on assignment documents
PART F	F-VI, 1.5	Subsection updated by integrating the teaching of G 1/15 about partial priorities

PART G	G-II, 1; G-II, 2; G-II, 3.3; G-II, 3.3.2; G-II, 3.5.1; G-II, 3.5.2; G-II, 3.6; G-II, 3.6.2; G-II, 3.6.3; G-VII, 5.4; G-VII, 5.4.1; G-VII, 5.4.2; G-VII, 5.4.2.4	Updated in view of decision G 01/19
	G-II, 4.1	Updated in view of decision G 01/03
	G-IV, 5.4	Updated in view of decision G 04/19

MINOR AMENDMENTS

General Part		
PART A	A-II, 4.1.4	Clarified application of Rule 40(1)(a), Rule 40(1)(b) and Rule 40(1)(c)
	A-III, 3.2.2	Clarified practice when deficiencies in the physical requirements are communicated
	A-III, 6.1	Clarified practice concerning claiming priority from an application with joint applicants
	A-III, 6.7	Amended in view of new online filing tools Outdated information deleted Clarified practice regarding missing copy of the priority document
	A-III, 9	Clarified practice regarding the possibility of filing a divisional for pursuing any feature of a claim that is deemed abandoned due to non-payment of the claims fee
	A-III, 13.2	Clarified practice regarding the calculation of the additional fee for application documents comprising more than 35 pages
	A-IV, 1.1.3	Clarified practice regarding the persons entitled to file a divisional application
	A-IV, 4.1	Clarified practice regarding the applicability of Rule 31(1)(d) EPC – depositor of biological material – in respect of Euro-PCT applications
	A-IV, 5; A-IV, 5.2; A-IV, 5.3	Text of subsections updated to avoid standard-specific references in view of implementation of sequence listing Standard ST.26 on 1 July 2022
	A-IV, 5.1;	Clarified practice regarding filing a sequence listing under Rule 56
	A-VI, 1.2	Clarification about recommended practice regarding withdrawal of an application
	A-VI, 1.3	Clarified practice regarding the publication of application documents of bad quality

	A-VI, 2.4	Amended in view of digital transformation
	A-VII, 1.1	Clarified practice regarding language in which application documents may be filed
	A-VIII, 2.5; A-X, 4.2.3; A-X, 4.3; A-X, 5.2.4; A-X, 10.3.1	Amended in view of new online filing tools
	A-VIII, 3.3	Clarification about which types of digital signature the EPO accepts
	A-X, 7.1.1	Clarified practice regarding payments via credit card and application of Rule 139 to payments
	A-X, 9.2.1	Clarified practice regarding checks carried out under Rule 6
	A-X, 9.2.3 A-X, 9.3.2	Clarified practice regarding reduction of the examination fee
	A-X, 9.3.1	Obsolete information deleted
	A-X, 10.3.2	Amended in view of change of internet address
PART B	B-VII, 1.2.1	Clarified practice regarding final decision on the question of unity of invention
PART C	C-IV, 3	Clarified practice regarding what constitutes a reply to a communication under Art. 94(3)
	C-IV, 7.2	Clarified practice regarding additional searches during examination
	C-V, 6.2	Obsolete information deleted
PART D	D-III, 3.2	Amended in view of new online filing tools
	D-III, 3.4	Clarified practice regarding signature of a notice of opposition filed in electronic form
	D-IV, 5.2	Updated practice regarding the transmission of documents supporting parties' submissions

	D-VI, 3.2	Clarified practice regarding postponement of date under Rule 116
PART E	E-III, 1	Clarified practice regarding oral proceedings before the Receiving Section and Legal Division
	E-III, 2	Clarified practice regarding holding oral proceedings at the request of a party
	E-III, 7.1.1; E-III, 11.1.1; E-III, 11.3	Clarified practice regarding oral proceedings
	E-III, 8.5.2	Clarified practice regarding signature on documents filed during oral proceedings by videoconference
	E-VII, 1.5	Clarified practice regarding payment of renewal fees under Rule 142
	E-VIII, 1.6.2.3	Clarified practice regarding periods to which Rule 134 applies
	E-VIII, 6; E-XII, 8	Clarified practice regarding accelerated processing before the boards of appeal
	E-IX, 2.1.1	Clarified practice regarding which application documents are considered as being part of the procedure on entry into the regional phase before the EPO
	E-IX, 2.1.3; E-IX, 2.4.2	Text of subsections updated to avoid standard-specific references in view of implementation of sequence listing Standard ST.26 on 1 July 2022
	E-IX, 2.5.1	Clarified practice regarding the publication of Art. 19 PCT amendments and for which files Rule 165 EPC becomes applicable
	E-X, 2.3	Clarified practice regarding the signature on a decision by a division
PART F	F-II, 6.1	Text of subsections updated to avoid standard-specific references in view of implementation of sequence listing Standard ST.26 on 1 July 2022

	F-III, 12	Clarified practice regarding applications where successful performance of the invention is inherently impossible
	F-IV, 3.2	Obsolete example deleted
	F-IV, 4.3; F-IV, 4.4	Clarified practice regarding adaptation of the description[5]
	F-IV, 4.7.1; F-IV, 4.7.2	Clarified practice regarding terms such as about, approximately or substantially
	F-IV, 4.20	Clarified scope of the subsection
	F-V, 3; F-V, 3.2	Clarified practice regarding the assessment of unity of invention
	F-V, 3.2.4	Updated to include example about multiple dependent claims and assessment of unity
PART G	G-II, 5.3(iv)	Clarified practice regarding the exceptions under Rule 28(1)(d)
	G-II, 5.6.1; G-II, 5.6.1.1; G-II, 5.6.2	Clarified practice regarding antibodies
	G-VI, 8	Clarified practice regarding selection inventions
	G-VII, 5.4.2.5	Updated to include example to illustrate the application of the COMVIK approach in the field of artificial intelligence
PART H	H-II, 5	Clarification explaining that the examining division has to assess the limitation of the search under Rule 62a and/or Rule 63, or the declaration of no search
	H-II, 6.1	Clarified practice regarding the application of Rule 137(5), second sentence
	H-II, 6.2	Clarification about the legal status of claims not fulfilling the requirements of Rule 137(5), first sentence

[5] The amendments introduced are intended to remove potential misinterpretation of EPO practice. These amendments have been extensively discussed with external and internal users to clarify how the established practice is applied. This work will continue in future editions of the Guidelines, for example by including further examples to illustrate EPO practice.

	H-III, 2.1.1	Clarification that only the examining division can issue a communication under Rule 137(4)
	H-V, 2.7	Updated for alignment with EPO practice
	H-V, 4; H-V, 4.1; H-V, 4.2; H-V, 4.2.1; H-V, 4.2.2;	Subsections about disclaimers have been grouped together and the subsections renumbered

EDITORIAL CHANGES

General Part	
PART A	A-II, 3.1; A-III, 4.1; A-IV, 1.5; A-V, 3; A-VI, 2.6; A-VIII, 1.6; A-VIII, 3.1; A-VIII, 3.2; A-X, 5.2.1; A-X, 5.2.4; A-X, 9.2.2; A-X, 10.3
PART B	B-X, 11.6; B-XI, 9
PART C	C-V, 1.1; C-V, 1.3; C-V, 15.2
PART D	D-I, 6; D-III, 3.3; D-IV, 1.2.1; D-IV, 1.2.2.1; D-IV, 1.4.2; D-IV, 3; D-VI, 1; D-VI, 5; D-VI, 7.2.1; D-VII, 4.1.2; D-X, 4.4
PART E	E-III, 5; E-III, 7.2.2; E-III, 8.3.3.2; E-III, 8.5.1.1; E-III, 8.5.1.2;
PART F	F-II, 4.3; F-II, 7.2; F-III, 6.3; F-III, 11; F-IV, 3.8; F-IV, 4.12; F-VI, 1.3; F-VI, 2.2
PART G	G-II, 4.2.1.1; G-II, 4.2.1.2; G-II, 5.2; G-II, 5.4; G-II, 5.5.1; G-IV, 7.1; G-IV, 7.3.1; G-IV, 7.3.2; G-IV, 7.5.3; G-V, 1; G-VI, 1; G-VII, 3; G-VII, 5.3; G-VII, 13