EPC Guidelines – Consultation results on the combined comments received via the public user consultation (01.02. – 02.04.2024) and the members of the SACEPO WP/G

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
	GP					
1				Das EPA fördert Vielfalt und Integration. Dies geschieht bereits im Rahmen zahlreicher Aktivitäten, seien es Konferenzen, E-Learning-Materialien, Sensibilisierungskampagnen, Networking oder andere Veranstaltungen. Es wäre wünschenswert, dies auch auf die Richtlinien auszuweiten, die von allen Nutzern des EPÜ verwendet werden, indem genderinklusive Begriffe wie "Fachperson" anstelle von "Fachmann" in die Richtlinien aufgenommen werden.	"Fachperson" könnte anstelle des Begriffs "Fachmann" verwendet werden.	The Office stated that use of gender-neutral language throughout the Guidelines in the three languages is in preparation. For example, the German word "Fachmann" and the French "homme du métier" will be changed to "Fachperson" and "personne du métier" respectively. The SACEPO WP/G members welcomed the change, while stressing that readability of the text should not be sacrificed to complex gender-neutral expressions. The EPC text as the basis for the Office's procedures should still be reflected and recognisable.
2				L'OEB encourage la diversité et l'inclusion. Il le fait déjà dans de nombreuses activités, qu'il s'agisse de conférences, de matériel d'apprentissage en ligne, de campagnes de sensibilisation, de mise en réseau ou d'autres événements. Il serait souhaitable d'étendre cette démarche aux directives, qui sont utilisées par tous les utilisateurs de la CBE, en y incluant un langage inclusif, comme "personne du métier" au lieu de "homme du métier".	"personne du métier" au lieu de "homme du métier"	See #1 above.
3				**General comment**	Delete references to fees in Rule 82(2), Rule 82(3), Rule 95(3), Rule 123(3) (See OJ 2024, A3) Update fee for recording transfer or	The Office thanked the commenter and explained that the Guidelines revision cycle makes it difficult to include changes which enter into force after the Guidelines come into

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					license RFees 3 - with/without MyEPO (See OJ 2024, A5)	force, especially when the secondary legislation in question is published only shortly beforehand. Any changes which have an impact on practice will be included in the Guidelines during this year's revision cycle. The SACEPO WP/G members understood the situation and referred to their proposal to delay the date on which the Guidelines come into force to 1 April (see minutes of this meeting, point 2).
4	**A**	**II**	**many**	In many places (but not everywhere), "date of filing" was replaced by "filing date" in the 2024 version. However, Article 80 and Rule 40 use the term "date of filing". Similarly, was "official language of the EPO" (Art. 14 EPC) replaced by "official EPO language". Similarly was "Notice from the EPO dated..." (official name as used in the OJ EPO) amended into "EPO notice dated", whereby an incorrect name of the referred notice is introduced. It shall be remembered that the Guidelines target an informed, educated audience (EPO formalities, EPO examiners, European patent attorneys), such that correct and unambiguous language is needed rather than an informal and somewhat ambiguous language (which could be suitable for informal communications targeting a general, non-informed audience).	It is requested to (go back to) consistently using the official legal terms, i.e. "date of filing", "official language of the EPO". Similar for "Notice from the EPO", etc.	See also minutes, point 4. The Office stated that the main goal of modernising the Guidelines is to replace outdated language with shorter and simpler expressions commonly used in modern written English. The members were assured that the Office will ensure consistent alignment of modern English with the provisions of the EPC.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
5	**A**	**II**	**1.3**	**Comment 8 of the SACEPO WP/G meeting on 10.10.2023 (repeated in the new comments)** This wording has lost its meaning, because the EPO has no intention to allow filing application by e-mail.	**A-II, 1.3** – please delete "at present".	The Office agreed to the suggestion.
6	**A**	**II**	**5.1**	**Comment 10 of the SACEPO WP/G meeting on 10.10.2023 (repeated in the new comments)**	**A-II, 5.1** – Add clarification that "Missing parts of the claims cannot be filed under Rule 56 EPC" since Rule 56 does not refer to missing parts of the claims.	The Office agreed to add the requested clarification.
7	**A**	**II, III**	**4.1**	in A-II,4.1..1, which is under the title of 4.1 "minimum requirements for according a date of filing", it says "Applicants must use the prescribed request for grant form (EPO Form 1001)", i.e. the use of the form for obtaining the date of filing seems mandatory. In A-III,4.1 it is said "the request (the indication that a patent is sought, referred to in A-II, 4.1(i)) need initially be in no particular form." These two instances seem to be in contradiction. While it is clear that the form 1001 must be filed in order for the application to proceed further, it is not mandatory for obtaining a date of filing, as is confirmed in A-III,4.1.	In a-II,4.1.1, change the "Applicants must use the prescribed request for grant form (EPO Form 1001)" to for example "The indication that a patent is sought is preferably done by using the request for grant form (EPO Form 1001)".	The Office agreed to clarify the wording in A-II, 4.1.1.
8	**A**	**III**	**6.1**	In the 2024 edition, the headnote of G 1/22 was added to replace the former paragraphs on transfer of priority and the former CRISPR citation. It is suggested to add some further important guidance from G 1/22 in this section.	It is suggested to add (large parts of) reasons 103-110 and 117 of G 1/22 to this section (or to introduce a subsection titled, e.g., "rebuttable presumption") – this inclusion will clarify why the presumption exists, who owns the burden of proof, and when it may be rebutted: The~~se~~ formal requirements for claiming priority in accordance with Article 88(1) EPC, <u>in particular the</u>	The Office stated that it cannot agree to the suggestion. Mindful of the character of the Guidelines and the need to be concise, the Office stated that incorporating the full text of the grounds of decision in G 1/22 appears superfluous when it can be read from the hyperlinked decision itself. The major findings of the decision are reproduced, allowing sufficient

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					requirement a copy of the priority application certified as correct by the authority where the priority application was filed, must be filed with the EPO, can only be met by the subsequent applicant if the priority applicant provides the necessary support completely and in time. The fulfilment of these requirements can thus be seen as strong factual evidence of the priority applicant's approval of the subsequent applicant's entitlement to priority (G 1/22, Reason 103-104, edited). The Enlarged Board comes to the conclusion that entitlement to priority should in principle be presumed to exist to the benefit of the subsequent applicant of the European patent application if the applicant claims priority in accordance with Article 88(1) EPC and the corresponding Implementing Regulations. This conclusion is reached taking into account (i) that the priority applicant or its legal predecessor must under normal circumstances be presumed to accept the subsequent applicant's reliance on the priority right, (ii) the lack of formal requirements for the transfer of priority rights and (iii) the necessary cooperation of the priority applicant with the subsequent applicant in order to allow the latter to rely on the priority right (G 1/22, Reason 105). The considerations leading to the presumption of priority entitlement apply to **any case in which the**	understanding of the applicable legal framework. The Office confirmed that it monitors related decisions of the Boards of Appeal and would update this section as required. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					subsequent applicant is not identical with the priority applicant but receives the support of the priority applicant required under Art. 88(1) EPC; it does not matter whether the subsequent European application stems from a PCT application; it is also not relevant whether and to which extent the members of a plurality of co-applicants for the priority application overlap with the group of co-applicants for the subsequent application (G 1/22, Reasons 107). The presumption ~~should be~~ is rebuttable since in rare exceptional cases the priority applicant may have legitimate reasons not to allow the subsequent applicant to rely on the priority; such circumstances could, for example, be related to bad faith behaviour on the side of the subsequent applicant or to the outcome of other proceedings such as litigation before national courts about the title to the subsequent application (G 1/22. Reasons 108). Priority entitlement is not relevant before the priority is claimed by the subsequent applicant in accordance with Rule 52 EPC, normally at the filing date of the subsequent application or otherwise within sixteen months from the filing date of the priority application; consequently, **the presumption of entitlement exists on the date on which the priority is claimed and the rebuttal of the presumption must also relate to**	

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					this date. Later developments cannot affect the rebuttable presumption (G 1.22, Reasons 109). The rebuttable presumption involves the reversal of the burden of proof, i.e. the party challenging the subsequent applicant's entitlement to priority has to prove that this entitlement is missing;. ~~If there is a strong presumption, the hurdle for rebutting it is higher than in the case of a weak presumption (see T 63/06, Reasons, point 3.2 for the rebuttal of the presumption of sufficiency of disclosure).~~ The presumption that the subsequent applicant is entitled to the priority right is a strong presumption under normal circumstances since the other priority requirements (which establish the basis for the presumption of priority entitlement) can usually only be fulfilled with the consent and even cooperation of the priority applicant (see G 1/22, Reasons 104 ff); the party challenging the entitlement to priority can thus not just raise speculative doubts but must demonstrate that specific facts support serious doubts about the subsequent applicant's entitlement to priority (G 1/22, Reasons 110). Like the priority entitlement in general ~~(see above points 85 f)~~, the presumption of its existence and the rebuttal of this presumption is subject to the autonomous law of the EPC only; consequently, there is no room for the application of national laws on	

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					legal presumptions and their rebuttal (G 1/22, Reasons 111). As the EPO is competent to assess all aspects of priority together with all patentability requirements ex officio in examination proceedings or on the request of an opponent, the EPO cannot refuse to assess a priority entitlement objection based on who raised the objection; the rebuttable presumption concerning priority entitlement however substantially limits the possibility of third parties, including opponents, to successfully challenge priority entitlement (G 1/22, Reasons 117).	
9	**A**	**III**	**6.6**	The phrase "Where the date of a priority claim precedes the date of filing of the European patent application by more than twelve months, ..." was amended in the 2024 edition to "Where a priority claim's date precedes the European patent application's filing date by more than twelve months, ...". This amendment rendered the phrase very difficult to read and has to risk to be misunderstood.	Please go back to the previous, clear and unambiguous wording: "Where the date of a priority claim precedes the date of filing of the European patent application by more than twelve months,"	The Office agreed to re-formulate the entire sentence.
10	**A**	**III**	**6.7**	**Comment from last year** We have information from users that certain countries may issue certified copies of the priority documents with signatures accepted by the EPO but which miss other requirements of the EPO's online filing. An example is Portugal, which for at least one year did not issue documents according to the PDF/A format, the issued copies being rejected by the online filing platforms of the EPO. Thus, it seems that at least for certain countries the list included in this section is not accurate.	**New suggestion**: Why not mentioning DAS option in the 1st paragraph?	The Office clarified that the DAS service enables electronic exchange of priority documents between participating Offices and thus fulfils the requirements under Rule 53(2) EPC. Where it is used, applicants do not have to file the priority document themselves as provided for in Rule 53(1) EPC. Therefore these options are treated separately in this section.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				No amendment/insertion that addresses the problem of the format.		To make the difference clearer, the Office proposed arranging the two options into sub-sections. It agreed to the members' suggestion to add a link to the DAS participating Offices. Concerning electronic priority documents, the Office stressed that the list of issuing Offices in this section is not exhaustive, since practices of Offices may change and new Offices may join during the year. Referring to e-signatures (e.g. on assignment documents), one member mentioned that some PDFs are locked. Users would welcome better guidance from the Office on which e-signatures it can accept. The Office stated that the technical issues mentioned with PDF documents will be brought to the attention of the IT department. There were no further comments from the SACEPO WP/G members.
11	**A**	**III**	**11 and sub-sections**	The readability of the text has become worse by the introduction of phrases like "the application's filing date", "the patent's grant", "a contracting state's designation", "the designation's deemed withdrawal", ... Rather than a simplification of language (as it was announced), this renders the wording less clear, certainly for non-native speakers, but presumably also for native speakers. It shall be remembered that the Guidelines target an informed, educated audience (EPO	Please go back to clear and unambiguous wording from before, using "XX of YY" rather than "YY's XX" (where XX and YY could be verbs or nouns),	See #4 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				formalities, EPO examiners, European patent attorneys), such that correct and unambiguous language is needed rather than informal and somewhat ambiguous language.		
12	**A**	**III**	**11.2.1**		To be included: 7a(3) reductions: reference to A-X, 9.nn.mm	See minutes, point 2; also #3 above.
13	**A**	**III**	**13.1**	Refers to **A-X, 9.2.1** and **9.2.2,** which may need to be re-written in view of new under Rule 7a?	Refer to rewritten A-X, 9.2?	See #12 above.
14	**A**	**III**	**15**	The phrase "and the applicant indicated on the date of filing that the previously filed were to take the place of claims in the application as filed" was amended into " and the applicant indicated on the filing date that the previously filed application's claims were to take the place of claims in the application as filed". In particular the term "the previously filed application's claim" is unclear, while the original phrasing was correct, clear and unambiguous.	Please go back to clear and unambiguous wording from before, using "XX of YY" rather than "YY's XX" (where XX and YY could be verbs or nouns), i.e., here to: "and the applicant indicated on the date of filing that the previously filed were to take the place of claims in the application as filed"	See #4 above.
15	**A**	**IV**	**1.1 and sub-sections**	Similar as above, terms " the earlier application's effective entry into the European phase", " the divisional application's date of receipt" were introduced and replaced clear and unambiguous terms	Please go back to clear and unambiguous wording from before, using "XX of YY" rather than "YY's XX" (where XX and YY could be verbs or nouns),	See #4 above.
16	**A**	**IV**	**1.4.1.1**	Refers to **A-X, 9.2.1** and **9.2.2,** which may need to be re-written in view of new under Rule 7a?	Refer to rewritten A-X, 9.2?	See #12 above.
17	**A**	**IV**	**1.4.3**	Wording of Rule 51(3) EPC seems to be inaccurately portrayed in the GL, leading to an unjustified practice on the part of the EPO to require payment of all renewal fees due in respect of a parent application when a divisional application is filed.	Amend the GL to reflect the interpretation of Rule 51(3) EPC that only renewal fees on the parent application that are outstanding when filing the divisional application must be paid.	The SACEPO WP/G members did not agree with the commenter and confirmed that the Guidelines are in line with the relevant legal provisions.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
18	**A**	**IV**	**2.2.4**	The title was amended by replacing "period" by "time limit". However, the correct legal term under Rule 14(4) is "period".	Correct to "period"	The Office agreed to the suggestion.
19	**A**	**IV**	**2.6**	Refers to **A-X, 9.2.1** and **9.2.3,** which may need to be re-written in view of new under Rule 7a?	Refer to rewritten A-X, 9.2?	See #12 above.
20	**A**	**VI**		**Previous comment**: How can an applicant request to change the order of the inventors after receiving the Communication pursuant to R 71(3), without delaying the grant? It should be noted, that for some inventors the order of inventors is highly sensitive.	**New suggestion**: The Office confirmed that a request to change the order of inventors could be filed at any time, including in reply to the Rule 71(3) communication. This would not delay the grant of the European patent. Why not inserting a section clarifying this?	The Office agreed to the proposal and will add corresponding information to A-III, 5 ("Designation of inventor").
21	**A**	**VIII**	**1.4**	Added text is: "In the case of joint applicants for whom a change of representative is requested, any authorisation must be signed by all applicants. If this is not the case, the parties will likewise be invited to appoint a common representative before registration can take place." However, it is not indicate what will happen if they do not appoint one: will the EPO appoint the common representative? Please add	Please add for clarity	The Office agreed to the suggestion.
22	**A**	**VIII**	**3.1**	Refers to smart cards "Submissions filed electronically must be signed by an entitled person, although they may be transmitted using a smart card issued to another person."	Replace with "Submissions filed electronically must be signed by an entitled person, although they may be transmitted electronically by another person."	The Office agreed to the suggestion.
23	**A**	**X**		5th paragraph.	It is suggested to add a reference to T40/21 https://www.epo.org/en/boards-of-appeal/decisions/t210480eu1	The Office reiterated its general practice to not quote T decisions in the Guidelines (see General Part, 3). The findings of T 0480/21 confirm the Office's safeguards, which are already

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						included in A-X, 4.2.3 (see #35 below).
24	**A**	**X**	**5.2.4**	**Comment 31 of the SACEPO WP/G meeting on 10.10.2023 (repeated and supplemented in new comments)** Due dates for fees	Add (as a third example) an example with the date of mention of the grant between the beginning of the patent year and the due date, all dates within the same month; for example anniversary of filing 5 May, due date 31 May and mention of the grant in between. **EPO**: To this end the Office asked members to specify the issue more clearly. Example Where the date of mention of the grant is between the beginning of the patent year and the due date, all dates within the same month; for example EP filing 5 May 2019, so due date for renewal under R.51(1) 31 May 2024, and mention of the grant in between, on 15 May 2024.	The Office agreed to consider adding the requested example or clarification.
25	**A**	**X**	**5.2.7**	Needs amendment to conform to 1st April changes – e.g. to refer to 0 fee for certified copy if ordered on MyEPO		The Office agreed to the suggestion.
26	**A**	**X**	**9 and sub-sections**	Rule 7a(1)/(2) and 7a(3) and 7a(4)-(6) and 7b were introduced per 1.4.2024. OJ 2024, A8 gave some clarification, but not in full. In particular is the situation w.r.t. eligibility in case of multiple applicants not clear: Rule 7a(5) says something different than item 15 of the Notice OJ 2024, A8 -- I suggest that this is clarified in the GL	To be included: details on Rule 7a(1)/(2) and 7a(3) and 7a(4)-(6) and 7b for all applicable fees	The Office confirmed that the commenter's observations are correct. It also stressed that its practice would nevertheless continue to follow J 4/18, which has been confirmed in the recently published FAQ. The practice applied will be clearly described when updating the Guidelines. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				▪ Notice OJ 2024, A8 says "15. Under Rule 7a(5) EPC, where there is more than one applicant, **each must be an entity within the meaning of Rule 7a(2)** or (3) EPC for the reduction of fees under the language- and/or micro-entity-related support scheme to apply." (emphasis added). This may be understood to just relate to the category of applicants (as in J 4/18 with former Rule 6(4)(7)) and not to the nationality/residence and language of Rule 7a(1)/Art.14(4). So that "A Dutch and German SME may together get a fee reduction when using Dutch", as they are both of such category and the Dutch SME is entitled to use Dutch as admissible non-EPO language. (Note the wording in the current notice reflects the wording of former Notice OJ 2014, A23, item 6: "6. If there are multiple applicants, each one must be an entity or a natural person within the meaning of Rule 6(4) EPC for the fee reduction to apply.", which reflected the wording of former R.6(7): "(7) In case of multiple applicants, each applicant shall be **an entity or a natural person within the meaning of paragraph 4**.") ▪ Rule 7a(5) says: "(5) In the case of multiple persons filing a European patent application or a Euro-PCT application, **the reduction under paragraph 1** or 3 shall be available **only if each applicant fulfils the applicable eligibility criteria**." (emphasis added) and the eligibility criteria of par 1 include the use of an admissible non-EPO language by		

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				an Art.14(4) person. Thus, the rule was changed from a category-based requirement to an eligibility-based requirement. In view of this change, Rule 7a(5) seems to require a Dutch applicant and a German applicant both to be eligible, so both to be Art.14(4) people by themselves. This would imply that "A Dutch and German SME can together **NOT** get a fee reduction when using Dutch", as the German SME is not eligible under Art.14(4). This conclusion, based on Rule 7a(5), is opposite from what it was under R.6(7), OJ 2014, A23 and J 4/18 due to the different wording of Rule 7a(5). Further, it may even be understood as that the admissible non-EPO language used is one to which both applicants shall be eligible. This may result in a presumably unintended non-eligibility when not all applicant are eligible to the use of the same admissible non-EPO language. E.g., a Dutch applicant must use Dutch to be eligible and an Italian applicant must use Italian to be eligible… however, there is no admissible non-EPO language to which they are both eligible, so they cannot benefit from the fee reduction. ▪ Thus, the wording in the new Notice OJ 2024, A8, item 15 seems to wrongly reflect the wording of old Rule 6(7) and Old Notice OJ 2014, A23, item 6, rather than the wording of the current Rule 7a(5). So, I suggest to review the wording of item 15 of Notice OJ		

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				2024, A8, and to also publish a clarification of eligibility for a reduction under R. 7a(1) for: a) a joint filing by an Art.14(4) person and a non-Art.14(4) person, both of the categories of R. 7a(2) (as Ditch-German above); b) a joint filing by two Art.14(4) persons which are however entitled to different admissible non-EPO languages, both applicants being of the categories of R. 7a(2) (as Dutch-Italian above).		
27	**A**	**X**	**9.2**	Obsolete in view of cumulation with new fee arrangements for micro enterprises	Re-write in its entirety to include section on each type of discount	The Office agreed to the suggestion.
28	**A**	**X**	**9.2.1**	**Comment 33 of the SACEPO WP/G meeting on 10.10.2023** Paragraph I: This is in our opinion clearly erroneous. As it stands, this Guideline make no sense (and would appear to invite applicants not to notify changes in their status). OJ EPO 2018, A5 (**Notice from the EPO dated 18 December 2017 concerning the reduced fee for appeal (Article 108 EPC**) for an appeal filed by a natural person or an entity referred to in Rule 6(4) EPC) This one contains correct wording: 9. For eligibility for the reduced appeal fee, an appellant's status under Rule 6(4) EPC when filing the notice of appeal is relevant. Changes subsequent to the procedural act of filing the notice of appeal have no retroactive effect on the validity of the appeal fee payment made. The procedural act of filing the request for examination is completed when both the request has been filed and the fee paid (with reduction, when applicable).	It should read: Changes in the status of an entity under Rule 6(4) which occur after the procedural act has been completed will not have a retroactive effect on the reduction that was justified when granted.	The Office agreed to consider the requested clarification when redrafting this section.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
29	**A**	**X**	**9.2.1, 9.2.3**	**Comment 34 of the SACEPO WP/G meeting on 10.10.2023 (repeated in the new comments)**	It is proposed to add, after "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)." In this context, it is to be noted that the request for examination will only be considered filed once the examination fee is paid; hence, a submission of a request for examination in any official EPO language, e.g. by submission of EPO form 1001 or 1200, before the filing of the request for examination in an admissible non-EPO language, still provides for eligibility for the fee reduction for the examination fee if the (reduced) examination fee is paid no earlier than simultaneously with the filing of the request for examination in the admissible non-EPO language (e.g., on the dame day).	The Office agreed to consider the requested clarification when redrafting this section.
30	**A**	**X**	**9.2.2**	**Previous comment**: If the description is in part in English and in part in an admissible non-EPO language (as is allowed by amended A-VII, 1.1), e.g. Dutch for a Dutch applicant, can the applicant get the 30% fee reduction on the filing fee? (Does it depend on the relative amount of Dutch text)?	**EPO**: comment which will not be taken up for the 2025 revision cycle since such a situation has not yet occurred in practice. The Office therefore does not see any need to include such information in the Guidelines, which are not intended to cover hypothetical or rare circumstances. **New reaction**:	The Office upheld its previous position. It stressed that the new PCT provision which enters into force on 1 July 2024 cannot be compared to the scenario in this comment, since there are no fee reductions involved in the PCT procedure. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					The Guidelines could anticipate such situations, so as the applicant knowns what to expect, and as also the PCT introduced provisions on mixed-language applications per 1 July 2024 (PCT Rule 26.3ter(e) - https://www.wipo.int/wipolex/en/treaties/notifications/details/treaty_pct_224-annex1)	
31	**A**	**X**	**9.2.3**	**Comment 36 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** GL/EPO A-X, 9.2.3 which now says "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)." This is however incorrect, as the translation of the request for examination may be filed in any of the official EPO languages, regardless of the language of the proceedings. See Rule 3(1) and A-VII, 3.2. The cited sentence is also incorrect, or at least may be misunderstood, in the use of the term "re-filed": there is no need to again file a translation of the request for examination as it was already submitted and will only be considered filed once the examination fee is paid whereby is becomes considered filed "no earlier than simultaneously" if the fee is paid "no earlier than simultaneously" as the request for examination in an admissible non EPO language – G 6/91. Nothing in G 6/91 requires the re-filing of the translation of the request. On the contrary, if the request would already have been legally filed	It is therefore proposed to **delete** the cited sentence from GL/EPO A-X, 9.2.3, and to replace it by a reference to A-X, 9.2.1, amended as proposed (see above): "Where the request for examination in an admissible non-EPO language is filed subsequent to EPO Form 1001 or EPO Form 1200, see A-X, 9.2.1." Alternatively, amend complete A-X, 9.2.3 (also introducing some Newlines) to: 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 <u>and a translation into any of the official EPO languages, regardless of the language of the proceedings, is filed not earlier than simultaneously (see G 6/91). Further, a declaration under Rule 6(6) must be filed.</u> 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	See #29 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				(=sentence filed and fee paid) before filing the request for examination in an admissible non EPO language, the latter is ignored and no fee reduction is available, because the translation would have not haver been filed "no earlier than simultaneously". So, not only is the reference to G 6/91 incorrect for the alleged need for a re-filing, it is also incorrect that there is the need for any re-filing in case form 1001 or 1200 were already submitted. If the EPO maintain that a re-filing of the translation of the request for examination is required, please explain the reasons for this.	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). ,~~ it is to be noted that the request for examination will only be considered filed once the examination fee is paid. Hence, a submission of a request for examination in any official EPO language, e.g. by submission of EPO form 1001 or 1200, before the filing of the request for examination in an admissible non-EPO language, still provides for eligibility for the fee reduction for the examination fee if the (reduced) examination fee is paid no earlier than simultaneously with the filing of the request for examination in the admissible non-EPO language (e.g., on the dame day) (G 6/91). Subsequent documents related to examination proceedings need not be filed in the admissible non-EPO language.	

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					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.	
32	**A**	**X**	**10.1.3**	The text of the German, English and French versions differ ("auf"="at", "up to", " égal ou inférieur à"="upto and including": Zu viel gezahlte Gebührenbeträge werden nicht zurückerstattet, wenn es sich um Bagatellbeträge handelt und der Verfahrensbeteiligte eine Rückerstattung nicht ausdrücklich beantragt hat. Die Höhe des Bagatellbetrags ist **auf** 16 EUR festgesetzt worden (siehe Beschluss des Präsidenten des EPA vom 14. Februar 2020, **ABl. EPA 2020, A17**). 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**). Lorsque le montant acquitté est supérieur à la somme due, la somme en excès ne sera pas remboursée si le montant en est très faible et si la partie concernée ne l'a pas expressément demandé. Est considéré comme insignifiant un montant **égal ou inférieur** à 16 EUR (cf. Décision du Président de l'OEB en date du 14 février 2020, **JO OEB 2020, A17**).	Bring the three languages into conformity with each other (also align the texts of the 3 language versions of RFees 12). In particular, unambiguously provide whether it is < 16 euro (as English "upto" and German version suggest), or ≤ 16 euro (as French " égal ou inférieur à " provides; English would need to be changes to "upto and including")	The Office agreed to the clarification requested. Amending Article 12 of the Rules relating to Fees is not within the scope of the WP/G's remit.
33	**A**	**X**	**10.2.6**	**Comment 39 of the SACEPO WP/G meeting on 10.10.2023**	Add a remark about G3/03, r.3,4,3:" i.e. granting interlocutory revision under Article 109(1) EPC and	The Office stated that the teaching of G 3/03 is already reflected in the last

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					remitting the request of the appellant for reimbursement of the appeal fee to a board of appeal,"	paragraph of this section and in E-XII, 7.3. It agreed to add a reference to E-XII, 7.3. Upon a member's request, the Office agreed to add the explicit statement that Boards of Appeal are competent to decide on a refund of the appeal fee where the appeal is withdrawn (Rule 103(6) EPC).
34	**A**	**X**	**10.2.6**	Thanks for inserting this paragraph. Is the department of first instance not also competent to order a full refund of the appeal fee in case of Rule 103(1)(b), i.e., if the appeal is withdrawn before the filing of the statement of grounds of appeal and before the period for filing that statement has expired? And also not in case the appeal fee was paid but the notice was filed too late or not at all, so that the appeal is deemed not filed and the fee needs to be reimbursed (G 1/18)?	Please clarify	See #33 above.
35	**A**	**X**	**4.2.3**	A-X, 4.2.3 as the decision makes it clear that a failure attributable a bug in EPO software triggers the relevant safeguards of R134(5) EPC and (now) Article 11 ADA. At the least, the EPO's attention should be drawn to expanding the concept of "unavailability" to encompass EPO attributable software error.		See also #23 above. The Office stated that this section already contains a reference to the arrangements for deposit accounts, point 11, and OJ EPO 2020, A120, both of which describe applicants' safeguards if one of the EPO's filing or payment tools is not available. However, the Office agreed to look into the matter and add further information if required.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
36	**A**	**XI**	**2.5**	Similar as above, terms like "European divisional application's publication", " that earlier application's publication", "relevant applicant's consent" were introduced and replaced clear and unambiguous terms	Please go back to clear and unambiguous wording from before, using "XX of YY" rather than "YY's XX" (where XX and YY could be verbs or nouns).	See #4 above.
37	**B**	**Many**		See above for Part A: "official language of the EPO" (Art. 14 EPC) replaced by "official EPO language". Similarly was "Notice from the EPO dated..." (official name as used in the OJ EPO) amended into "EPO notice dated", whereby an incorrect name of the referred notice is introduced It shall be remembered that the Guidelines target an informed, educated audience (EPO formalities, EPO examiners, European patent attorneys), such that correct and unambiguous language is needed rather than an informal and somewhat ambiguous language (which could be suitable for informal communications targeting a general, non-informed audience).	Please go back to clear and unambiguous wording from before, using "XX of YY" rather than "YY's XX" (where XX and YY could be verbs or nouns). It is requested to (go back to) consistently using the official legal terms, i.e. "official language of the EPO". Similar for "Notice from the EPO", etc.	See #1 and 4 above.
38	**B**	**I**	**2**	In the preview version of the 2024 Guidelines posted on the EPO website on 1 Feb 2024, a sentence was added at the end of B-I, 2 reading: " All search actions are endorsed by the other two members of the examining division". However, at some point during the preview period this sentence was again deleted and it also did not appear in the official March 2024 version. However, at the DG1-EPPC meeting on 28.02.2024, Steve Rowan indicated that this early involvement of the other members of the Examining Division has been introduced per 1 November 2023, so it seems appropriate to (re)introduced this sentence. Presumably, this practice is now only available as Internal Instructions and only available for examiners, but not for applicant and representatives.	It is requested to add information on new practice of early involvement of the other members of the Examining Division already at the search stage in B-I, 2 (general principle) as well as in the other applicable paragraphs in Part B.	The Office stated that it cannot agree to the suggestion. The Office explained that this sentence from the version of the Guidelines pre-published on 1 February was removed from the version entering into force on 1 March as implementation is in progress. The need to reflect this practice in the Guidelines will be assessed in the course of the current revision cycle. There were no further comments from the SACEPO WP/G members

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
39	**B**	**II**	**2**	Appears to limit the scope of the art to what the examiner finds and does not recognise that other art may be on file and relevant to assessing patentability.	Amend penultimate sentence "Both the content of the search opinion and the later substantive examination depend on the outcome of the search as it, together with art cited in the application or in third party observations, establishes what state of the art is to be taken as the basis for assessing the patentability of the invention".	The Office explained that state of the art may be cited in different sources. These include prior art cited in the application, prior art cited by the ISA or third-party observations during the international phase, and prior art cited by a national patent office for the priority document. Other parts of the Guidelines relate to what comprises the state of the art (see e.g. B-IV, G-IV). More specifically, E-VI, 3 relates to third-party observations and B-IV, 1.3 to the prior art cited in the application. This section will be reviewed and may be redrafted in light of the above. There were no further comments from the SACEPO WP/G members.
40	**B**	**III**	**6.3.3**	The indication of how the office proceeds in the different scenarios is considered useful.		Thank you for the positive comment.
41	**B**	**IV**	**1**	It would be useful to have more information about the pre-search algorithm		The Office stated that it cannot agree to the suggestion. The pre-search algorithm depends on the information considered relevant to the application by the search division, such as keywords, classes, applicant(s), inventor data, prior art cited in the application, information from the international phase (third-party observations, for instance) when applicable etc., as already explained in consultation result 39. The Guidelines are not the right place for such details.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						The algorithm may also evolve over time and the information provided in the Guidelines would rapidly become obsolete. There were no further comments from the SACEPO WP/G members
42	**B**	**VI**	**5.4**	First paragraph says: "The search normally does not cover documents published after the filing date of the application accorded by the Receiving Section" I suppose that this is not entirely true since the examining division also search for potential Art. 54(3) prior art.		The Office stated that it cannot agree to the suggestion. Although some intermediate documents are retrieved during the search phase for some applications (divisionals, Euro-PCT, second filings, etc.), the search is usually not considered to be exhaustive. The examining phase comes at a later stage (after 18 months), when intermediate documents have in the meanwhile been published and classified, and can be retrieved by the examining division while performing an XTopUp search. SACEPO WP/G members agreed.
43	**B**	**VII**	**1.3**	If the search has found documents relevant to other inventions, non-inclusion in the search report prejudges the Examination Division assessment. In addition, inclusion of such documents in the partial search report may also avoid wasted work by applicants and the Office. It will also provide useful information to third parties. Providing such documents with the partial search report appears a win-win by decreasing the number of failed divisional applications.	Change practice and change the guideline.	The Office stated that it cannot agree to the suggestion. The Office indicated that documents concerning further inventions are provided, if they become relevant, once the further search fees have been paid. Furthermore, the present Guidelines already state that documents used for a posteriori non unity objection(s) are mentioned in the partial search report. The examining division and third

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						parties are thus already well aware of them. There were no further comments from the SACEPO WP/G members
44	**B**	**VIII**	**4.1**	This guideline is not in compliance with the relevant rule. The sentence *"If the search division 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 compliant claims** on which the search can be based within two months."* Indicates that an invitation is voluntary and further could be interpreted as inviting the applicant to file fresh claims. It may be better to use language closer to Rule 62a	Replace entire guideline. If the search division considers that the claims as filed do not comply with Rule 43, paragraph 2, it **shall** invite the applicant to indicate, within a period of two months, the claims complying with Rule 43, paragraph 2, on the basis of which the search is to be carried out. If the applicant fails to provide such an indication in due time, the search shall be carried out on the basis of the first claim in each category.	The Office explained that even though there may be multiple independent claims which do not comply with Rule 43(2), their subject matter may already be covered by the search. Discretion is left to the search division as to whether to invite for a limitation at the search stage, or later (see F-IV, 3.3.) during examination, if needed. (Amendments when the application enters the examination phase may overcome the objection). This allows the division to choose the approach which is best for the applicant in each individual case. This approach is similar to the approach for non-unitary cases, where the search division may decide to perform a full search and not issue an invitation to pay additional fees (B-VII, 2.2). This is done even though Rule 64 also refers to "shall". Similarly, in a scenario where multiple independent claims do not satisfy Rule 43(2) EPC but their subject matter is so overlapping that the search could cover them all, it may be left to the discretion of the search division to invite for a limitation. In that case, an objection under Rule 43(2) can still be made (F-IV, 3.3). The SACEPO WP/G members explained that, before the present rule

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						was introduced, the independent claim to be searched used to be chosen by the Office. In their view "shall" is important, as it indicates that there is no discretion on the part of the Office to choose which claim should be searched. The applicant must be invited to choose. They were not convinced by the parallel between the two rules drawn by the Office, because in the case of Rule 64 a search on the first invention has already taken place before issuing the invitation, whereas in the case of Rule 62a the invitation is sent prior to any search. However, they understood from the explanation provided by the Office that the procedure is in favour of the applicant. They thus asked for this paragraph to be redrafted to include exactly what the Office had explained and remove any ambiguity. The Office agreed to find a way to best address these points to remove any ambiguity.
45	**B**	**X**	**9.3**	First sentence says "Each document cited in the search report is accompanied by an indication of the claims to which it relates, unless it falls in category "L" (see B-X, 9.2.8)." But 9.2.8 says sometimes category "L" documents will be linked to claims so carrying an implicit contradiction. Clarify.	"For all except category "L" documents, each document cited in the search report is accompanied by an indication of the claims to which it relates. For category "L" see B-X, 9.2.8."	The Office stated that it cannot agree to the suggestion. The Office explained that "L" documents are cited in several cases. For instance they can be cited regarding the (lack of) priority of specific claims or the whole application (see B-X, 9.2.8).

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						"L" may also be used when Rule 56 or Rule 56a are invoked and a redating of the application may be expected, which would modify the relevance of some documents (B-III, 3.3.1, penultimate paragraph). There were no further comments from the SACEPO WP/G members.
46	**B**	**X**	**9.4**	Paragraph 1 states: "If a cited document is very long, the search division will identify the specific parts (e.g. claim, example, figure, table, text passage on a particular page, or a specific time or time range in a video and/or audio media fragment) which contain the technical subject-matter closest to (or coinciding with) the searched invention. This is particularly important where the document is relied on to support objections to novelty or inventive step."	Why only if the cited document is very long? It suggested to add or modify that where the document is relied on to support objections to novelty or inventive step the examining division should always identify the portions that they rely on.	The Office explained that, regardless of the length of the document, the search report is not the place to link a specific passage of a cited document to a specific feature of the subject matter. This type of substantiation is provided in the search opinion accompanying the search report (see B-XI, 3.2.1: "For example, where a prior-art document is cited but only part of it is relevant, the specific passage relied on should be specified"). The SACEPO WP/G members indicated that it was not clear from B-X, 9.4 which documents could be considered "long". This led to a lack of substantiation in some cases. They indicated that the right balance in providing too much or too little detail needed to be found. In any case, specific passages relating to the distinguishing feature(s) in the closest prior art and combining document(s) needed to be specific and present in the extended search report. They requested this also be made explicit in the Guidelines.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						The Office agreed to see how to best address this point in Part B of the Guidelines to remove any ambiguity. There were no further comments from the SACEPO WP/G members
47	**C**	**Many**		Se above for Part A: "official language of the EPO" (Art. 14 EPC) replaced by "official EPO language". Similarly was "Notice from the EPO dated..." (official name as used in the OJ EPO) amended into "EPO notice dated", whereby an incorrect name of the referred notice is introduced It shall be remembered that the Guidelines target an informed, educated audience (EPO formalities, EPO examiners, European patent attorneys), such that correct and unambiguous language is needed rather than an informal and somewhat ambiguous language (which could be suitable for informal communications targeting a general, non-informed audience).	Please go back to clear and unambiguous wording from before, using "XX of YY" rather than "YY's XX" (where XX and YY could be verbs or nouns). It is requested to (go back to) consistently using the official legal terms, i.e. "official language of the EPO". Similar for "Notice from the EPO", etc.	See #4 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
48	**C**	**I**	**2**	The sentence "they should have a sense of proportion and not pursue unimportant objections" was deleted in the 2024 edition. It is requested to reinstate it, as it is an important aspect of, e.g., mindset.	Wording not consistent with C-VIII, 4 to which it refers: use wording of C-VIII, 4 to which it refers.	The Office stated that it cannot agree to the suggestion. There was (and still is) no clear definition of the terms "sense of proportion" and "trivial objections", which was the reason the phrase was removed. Examiners usually reach a reasonable agreement and there is no need to clarify this in the Guidelines. There is no inconsistency between the wording of the last sentence of C-I.2 and C-VIII.4. Both stipulate that the other division members should not repeat the work of the first member. The SACEPO WP/G members commented that the sentence deleted was important and brought some balance. They suggested clarifying these terms by re-introducing the sentence with a different wording referring to "a person skilled in the art". The Office agreed to reflect on the rewording of the deleted sentence and to come back with a proposal. There were no further comments from the SACEPO WP/G members.
49	**C**	**III**	**1.3**	**Comment 48 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)**	Clarification is requested! What will the ED do in this situation where the entry documents contain	The Office explained that the situation of Rule 20.5*bis*(d) described in C-III.1.3 is where a correction (not an amendment) is made to the

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				C-III, 1.3 – The effect of erroneous/corrections on Rule 159 EPC, Rule 161(1)/162 EPC and Rule 161(2)/162 EPC is not addressed in Rule 56a EPC, nor in the Notice (OJ EPO 2022, A71, items 21-23) clarifying its introduction. Also, the Guidelines do not provide clear guidance. C-III, 1.3 rather indicates only that: *"On entry into the European phase, **the normal procedures apply** on the basis that the correct and erroneously filed parts are thus part of the application as filed (see E-IX, 2)".* It would be better to explain that the applicant is expected to amend the Euro-PCT application by removing the erroneously filed part and to limit to the correct parts upon entry under Rule 159(1)(b) EPC following a PCT Rule 20.5*bis*(d) situation. If not done upon entry, it seems likely that the applicant will be invited thereto in the communication under Rule 161(1)/(2) EPC. Further, if the entry documents contain non-searched matter at the end of the Rule 161/162 period, will the EPO issue a communication under Rule 164(1) or Rule 164(2) EPC, and during the related searches possibly a communication under Rule 62a EPC (multiple independent claims) or Rule 63 EPC (no meaningful search)?	non-searched matter at the end of the Rule 161/162 period? Specify what is meant by "the normal procedure".	application originally filed and the correct element is considered to have been contained in the original application, in which case the erroneously filed element remains in the application and the filing date is not changed. As such, the application is not expected to be amended to remove the erroneously filed part to satisfy Rule 159(1)(b) EPC; according to Rule 20.5*bis*(d) "the erroneously filed element or part concerned shall remain in the application", and according to OJ EPO 2022, A71 (referred to in C-III.1.3) "The erroneously filed documents may only be removed by amending the application during the grant proceedings". Also, the correction under Rule 20.5*bis*(d) is not likely to invite a communication under Rule 161(1)/(2) EPC, at least not more likely than a "normal" application. Therefore, the "normal procedures" in the second paragraph of C-III.1.3 refer to procedures followed when any Euro-PCTbis application enters the regional phase. If there is non-searched matter, the guidelines under C-III.3.2 will be followed, i.e. the "normal procedure". The Office stated that there was no need to change the Guidelines. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
50	**C**	**III**	**3.4**	"if these requirements are fulfilled"	SACEPO WP/G members indicated that, similarly to C-III, 3.4, the passages in chapter A, in particular A-X, 10.1 and 10.2, should also be looked at to clarify the refund of fees. The Office responded that this suggestion would be considered during the next revision cycle.	The Office stated that this suggestion had already been dealt with in the last revision cycle. The phrase "if these requirements are fulfilled" is not present in the current version. There were no further comments from the SACEPO WP/G members.
51	**C**	**V**	**4.7.1**	(Editorial)"The examining division may also issue a summons to oral proceedings or, if the necessary requirements are met, refuse the application directly. The application may be refused directly if the following criteria are satisfied:"	Replace by "The examining division may also issue a summons to oral proceedings or the application may be refused directly if the following criteria are satisfied:"	The Office noted that this comment refers to Part C-V, 4.7.1. The Office agreed to the editorial suggestion. There were no further comments from the SACEPO WP/G members.
52	**C**	**V**	**1.1**	Omnibus claim defined at its second occurrence.	Move the definition of omnibus claim to the first occurrence.	The Office agreed to the suggestion. The definition of the term "omnibus claim" is already reflected in Part B-III, 3.2.1. A reference to Part B-III, 3.2.1 will be included in the first occurrence in C-V.1.1, point (i). There were no further comments from the SACEPO WP/G members.
53	**C**	**V**	**4 and sub-sections**	Can title be amended or corrected under Rule 71(6) in response to Rule 71(3)?	Please clarify in C-V, 4 or a sub-section Please add "the title or its translations" to the list in the last sentence of C-V, 4	The Office agreed to the suggestion to add "the title or its translations" to the examples in the last sentence of C-V, 4. The title is not part of the application under Art. 78 EPC, but part of the request for grant under Rule 41(2)(b). According to Rule 71(3) and (5) (see also Guidelines H-V.8), the title is not part of the text to be approved by an

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						applicant before a patent can be granted; therefore it cannot be amended or corrected under Rule 71(6) and the procedure under C-V, 4.6 does not take place. The Office explained that Rule 71(5) and (6) distinguishes between the communicated text that can be amended or corrected within the Rule 71(3) period and the bibliographic data. The SACEPO WP/G members and the Office confirmed that the title is the responsibility of the examining division (see GL A-III, 7.2) and grant cannot be delayed for making changes to it.
54	**C**	**VIII**	**1**	This section indicates: "However, within the examining division responsible for the application, **one** member (the first member) will, **as a general rule, be entrusted to carry out all** substantive examination work up to the point of a decision to grant a patent, issue a summons to oral proceedings or refuse the application. While acting on behalf of the examining division in all communications with the applicant up to that point, this examiner **may confer informally** with the other members of the division at any time on specific points of doubt or difficulty. The term "examiner" as used in this part of the Guidelines is normally understood to mean the "first" member. " So, unlike since 01.01.2023 for search, the other two examiners al not ready involved as of the	Clarification is requested	See #38 above. The Office stated that C-VIII, 1 already indicates that if the first member has any doubts or difficulties they will consult the other members. C-V,14 also refers to consultation with the other members of the division if refusal is envisaged. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				start and not all products (esp. not all Art. 94(3)/ Rule 71(1)) are endorsed by all three members? The "may" provides an option, not an obligation, It would be consistent, appropriate and preferred if also during examination the other members must (not just may) be involved in all products, also the substantive work before the 71(3) stage. (NB: For search, the other two members of the examining division are already being involved as of early in the search stage, since 1 November 2023 (information Steve Rowan, DG1-EPPC meeting 28.02.2024)).		
55	**C**	**VIII**	**5.1**	in the last paragraph of C-VIII,5.1, it seems a word is missing in the sentence "In examination proceedings, where the applicant has been invited to provide a translation of the priority according to Rule 53(3)".	"In examination proceedings, where the applicant has been invited to provide a translation of the priority application according to Rule 53(3)"	The Office agreed to the proposed editorial change. There were no further comments from the SACEPO WP/G members.
56	**D**	**II**	**2.1**	The "definition" of members as those who have not had "*participation in proceedings of a patent family member, e.g. a parent or priority application of the opposed patent, is not considered as participation in the proceedings for grant of the patent to which the opposition relates for the purposes of Art. 19(2)*." is not welcomed. Involvement of more than one examiner who has already formed a view on a very closely related patent as a member of an opposition division is against the perception that an opposition division is impartial and is a backwards step and not in accordance with the spirit of Article 19(2) EPC. It is proposed that this the emphasis of this amendment is reversed and instead an opposition division should consist of no more than one technically qualified member who has participated in proceedings of a patent family member		The Office did not agree to the proposal. Priority and divisional applications are separate and independent applications (see Guidelines C-IX, 1.1; G 1/05, point 8.1 and G 4/98, point 5). Art. 19(2) EPC is not an exception to this rule. Therefore, and also in view of the wording of Art. 19(2) EPC, participation in the proceedings for a patent family member, e.g. a parent or priority application of an opposed patent, is not considered participation "in the proceedings for grant of the patent to which the opposition relates." The SACEPO WP/G members proposed that the EPO change its

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						practice for allocating members of the opposition division without changing the Guidelines.
57	**D**	**II**	**7**		It is suggested to replace the deleted word "examiner" by "members".	The Office did not agree to this proposal. The current wording is more linguistically fluent. There were no further comments from the SACEPO WP/G members.
58	**D**	**III**	**5**	The last paragraph ("The following allegations, for example, do not constitute grounds for opposition: ..." does not mention double patenting yet. It is suggested to include that - supported by T 0885/21, reason 1.3 and T 0098/19, reason 2.3 (both decided after G 4/19 and citing G 4/19).	It is suggested to add the following to the last paragraph: The prohibition of double patenting as recognized in G 4/19 does not represent a ground of opposition	The Office agreed that double patenting is not a ground for opposition. Although section D-III, 5 unambiguously states that opposition may only be filed based on the grounds specified in Art. 100 and therefore other allegations do not constitute grounds for opposition, it will be considered to include the example of double patenting in the list of counter-examples for grounds of opposition in the last paragraph of D-III, 5, in particular in view of the fact that the question about double patenting recurs frequently. The SACEPO WP/G members had differing opinions. One stated that given the different practice concerning double patenting in different states it would be useful to add this clarification. Another expressed the view that D-III, 5 made it very clear that the only grounds for opposition were those mentioned in Art. 100 EPC. Any other objections did not constitute grounds

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						for opposition, so the list of counter examples could be dispensed with entirely.
59	**D**	**IV**	**1.4.2**	The section is amended to reflect that a formalities officer can now adjudicate as to whether an opinion expressed by them has been "successfully" refuted and issue a decision. We consider the extension of powers of the formalities officer into areas previously reserved for opposition divisions to be an unwelcome development. However, the change to the Guidelines is an appropriate reflection of the decision of the President of the EPO dated 12 December 2013 (OJ EPO 2014, A6) that grants formalities offers the power to exercise judgment in reaching decisions even when their opinion is refuted. As a consequence of this change it is important that E-X, 2.3 and 2.6 are amended to clarify that it is incumbent on formalities officers to issue decisions in the correct form, with proper notification and with full reasoning such that it can be appealed.		The Office did not agree to this proposal. The amendments in D-IV, 1.4.2 do not reflect an extension of the power of the formalities officer. As before, and as conceded in the comment, this section is in line with the corresponding decision of the President to entrust formalities officers with examination and decisions under Rules 76 and 77 on the inadmissibility of the opposition, with the exception of the cases provided for in Rule 76(2)(c) (see OJ EPO 2014, A6). E-X, 1.1 specifies that the principles described in E-X also apply to decisions taken by formalities officers to whom the work is entrusted. Hence it is clear that the instructions given in E-X apply to decisions on inadmissibility under Rules 76 and 77 taken by the formalities officer on behalf of the opposition division. Therefore there is no need to amend sections E-X, 2.3 and 2.6. There were no further comments from the SACEPO WP/G members.
60	**D**	**IV**	**3**	The insertion of "successfully" is considered appropriate, the opposition division having the		The Office expressed its thanks for the positive comment.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				power to decide the admissibility of an opposition according to Rule 77(1) and (2) EPC.		
61	**D**	**IV**	**5.1**	The addition at the beginning of the section to specify that admissibility of an opposition must be continually examined is considered appropriate.		The Office expressed its thanks for the positive comment.
62	**D**	**V**	**2.1**	The sentence "In particular, the opposition division cannot decide on the revocation of the patent beyond the extent to which it was opposed in the notice of opposition" (based on T 809/21) has been added in the 2024 version, but it does not indicate what must be the course of action. It is suggested to add that.	It is suggested to add the following: In a case where the patent is not opposed in its entirety, the opposition being directed at certain claims only, and where the Opposition Division decides that all of the proprietor's requests in relation to the opposed claims must fail, only the unopposed claims, which are not part of any opposition proceedings, are left standing. Hence, provided the requirements of Rule 82(1) EPC are met (either during oral proceedings or, in a written procedure, by means of a separate communication), the patent may be maintained on the basis of the unopposed claims, irrespective of whether the proprietor has filed an explicit request for this during the proceedings. Such a request would, in fact, be superfluous, since the unopposed claims have been granted and are not the subject of any opposition. The unopposed claims of the granted patent are therefore always available to the proprietor as the minimum basis on which the patent may be maintained (T 809/21, headnote & Reasons 5.2).	The Office did not agree with this comment. A SACEPO WP/G member further pointed out that it was unclear what happened to the unopposed part if the opposed part could not be maintained, and proposed summarising missing information about the maintenance of the unopposed part in a single sentence. However, the statement that "the opposition division cannot decide on the revocation of the patent beyond the extent to which it was opposed in the notice of opposition" makes it clear the patent cannot be revoked in its entirety if it has been partly opposed. The statement thus also implies the further conclusions in T 809/21 that the procedure under Rule 82 EPC is to be followed regarding the maintenance of at least the unopposed claims. For this reason, and in view of the very low number of patents partly opposed, the Office does not consider it appropriate to include further details of T 809/21.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					If the Opposition Division, not having the power to decide on the revocation of the patent in suit beyond the extent to which it was opposed in the notice of opposition, a decision to directly revoke the patent in its entirety, including the unopposed claims, must be considered a substantial procedural violation within the meaning of Rule 103(1)(a) EPC (T 809/21, Reasons 7.3).	There were no further comments from the SACEPO WP/G members.
63	**D**	**V**	**2.1**	Clarification that the opposition division cannot decide on the revocation of the patent beyond the extent to which it was opposed in the notice of opposition is welcomed.		The Office expressed its thanks for the positive comment.
64	**D**	**V**	**2.2**	Clarification that not only is unity of invention under Article 82 EPC is not to be examined during opposition but also that the requirement of Rule 43(2) EPC do not apply is welcomed.		The Office expressed its thanks for the positive comment.
65	**D**	**V**	**5**	The change confirming that examination of compliance of the description with Article 84 EPC should only be undertaken when necessitated by amendments made during opposition proceedings or when requested by the proprietor is welcomed.		The Office expressed its thanks for the positive comment.
66	**D**	**VI**	**3.2**	"2nd §. This is consistent with D-V 2.2: **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 In the same way the OD shall give preliminary opinion on the claim request filed by the proprietor only.	In 2nd paragraph. After "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." It is suggested to add:	The Office did not agree to this proposal. It does not seem appropriate to make statements about content that should not be included. For reasons of impartiality the opposition division will not suggest claim amendments in the summons to oral proceedings.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					"The opposition division should refrain from suggesting claim amendments"	The SACEPO WP/G members confirmed their wish to add this instruction or similar guidance concerning the impartiality of the division. Since divisions sometimes make suggestions for amendments, a passage highlighting the impartiality of the division would be desirable. Whether this should be included in Part D or E-XI was irrelevant.
67	**D**	**VI**	**7.2.3**	**Comment 70 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** D-VI, 7.2.3. The normal procedure is to file translations of <u>any amended claims</u> in the two official languages of the EPO other than the language of the proceedings. It may happen that during opposition, a separate set of claims is filed for State XX. At the same time, the claims may remain identical for the other States. However, the Guidelines require (emphasis added): *If the European patent in the amended form contains different claims for different contracting states, a <u>translation of all sets of claims</u> – in the text communicated to the patent proprietor – into all official languages other than the language of the proceedings must be filed.* To be clear, this is nonsense. Only translations of amended claims are required by R82(2): "*to file a translation of any amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months.*"		The Office did not agree with this comment. This section reflects the Office's established practice. Translations of all claims need to be submitted, as they are needed for publication. In any case, the proprietor needs to indicate which translation corresponds to which set of claims. The invitation under Rule 82(2) is issued by a formalities officer, but the content of the translated claims is not examined in substance by them. If claim sets applicable in specific countries have not been changed during the opposition proceedings, the patent proprietor can avail themselves of the translations already at hand. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
68	**D**	**VIII**	**1**	In the EPPC-DG1 meeting of 28.02.2024, reference was made of a Best Practice Document on structuring decisions. It is suggested to include relevant information thereof in the Guidelines.	It is suggested to include relevant information from the Best Practice Document on structuring decisions in the Guidelines.	The Office did not agree to this proposal. Relevant information on the structure of decisions is given in E-X, which also applies to opposition. There were no further comments from the SACEPO WP/G members.
69	**D**	**X**	**4.3**	Does G 3/14 also apply to (examination of clarity with) amendments made during limitation? One could argue both ways. I am not aware of any case law on this. Is there any case law, or internal instructions on this?	If there is case law, or internal instructions on this, please add.	G 3/14 relates to the examination of clarity in opposition proceedings and therefore does not apply to amendments made during limitation proceedings. D-X, 4.3 comprises a reference to H-IV, 5.4, which makes it clear that limitation is not an opportunity to re-examine the whole patent and in particular that the claims as granted are not examined anew. With respect to clarity, what needs to be considered is whether the requested amendments introduce a deficiency. The Office will look at the issue and consider whether it is more appropriate to incorporate content from H-IV, 5.4 in section D-X, 4.3. There were no further comments from the SACEPO WP/G members.
70	**E**	**II**	**2.3**	It is appreciated that the EPO adopted a more determined language by using the wording "establish".		The Office expressed its thanks for the positive comment.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
71	**E**	**III**	**8.1**		It is suggested to indicate that the chairperson requests the members of the public to at least temporarily switch on their camera to allow the participants to ascertain their identity just as if they were attending the oral proceedings in person on the premises of the EPO. However, the chairperson should avoid that the name of any member of the public is used in order to ensure that no additional information is provided about the identity of the members of the public when compared with attending the oral proceedings in person on the premises of the EPO.	The Office did not agree to the proposal. The Office does not see any need to change current practice; the opposition division does not have to perform checks on members of the public, either as to their identity or to verify that they are in fact the person who requested access. However, if a party so requests, the chair has the discretion to ask members of the public to briefly switch on their camera to allow videoconference participants to see who they are. There were no further comments from the SACEPO WP/G members.
72	**E**	**III**	**10.3**	The Guidelines define essentials of the oral proceedings as new statements arguing the presence or lack of novelty, inventive step and other patentability criteria – this should extend to any ground of objection/opposition. So, any argument made only in the opposition proceedings should be included. There is concern that the requirement "if they are relevant for the decision" could be problematic as, generally, the reason a party wants them in the minutes is because they haven't worked in opposition (i.e. the OD didn't think they were relevant) and you want to try them again in appeal but you don't want it to be a new argument. This seems to imply that the OD will only include new arguments that they agreed with. A broader problem is that often we observe that the minutes don't include specific statements forming part of the essentials of the oral		The Office concluded that it will consider a clarification in the relevant section. It explained that the opposition division does not need to include statements which are not relevant. If statements and arguments are relevant but simply not convincing and the opposition division cannot agree on them, they are included in the minutes. The SACEPO WP/G members explained that in their experience relevant arguments are not always reflected in the minutes, and that sometimes the opposition division equates "relevant" with "convincing".

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				proceedings meaning that parties often have to file submissions after the final submissions deadline to deal with arguments made by the other side in their final submissions, so that they are in writing. EPO has inserted a new paragraph, but this does not solve the above issue.		They suggested clarifying that "relevant" is not necessarily "convincing", i.e. an argument that is relevant, but not convincing should still be included in the minutes. The Office replied that the wording of that section had already been extended last year and was sufficiently detailed; the problem is likely to arise when applying it in practice. The Office will look into the matter and consider clarifying the relevant section.
73	**E**	**VI**	**2.1, 2.2.2**	T 0364/20 states that it deviates from the Guidelines, Sections E-VI-2.1 and E-VI-2.2.2. The board held with reference to R 6/19 that under Article 123(1) EPC, a patent proprietor does not always have the right to amen d its patent and that "amendments and their admission into the proceedings shall be in accordance with the provisions of the implementing regulations". The Enlarged Board referred to Rule 81(3) EPC, which gives the opposition divisi on the discretion not to admit claim requests. The Board further stated that it cannot be held that any claim request submitted after the expiry of th e time limit set under Rule 79(1) EPC and before th e expiry of the time limit set under Rule 116(1) EPC I automatically filed in due time and thus was admissibly raised.		The Office expressed its thanks for the citation of T 0364/20 and noted that the comment did not include a suggestion. The Office explained that E-VI, 2.2.2 defines "late-filed" in relation to Rule 116(1). However, E-VI, 2.2 and E-VI, 2.2.2 do not state that any claim request submitted after the expiry of the time limit set under Rule 79(1) EPC and before the expiry of the time limit set under Rule 116(1) EPC is automatically admissible. The division may also find such requests inadmissible for example if they consider them to be an abuse of the proceedings or if they are not properly substantiated. The Office considers this approach appropriate

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				The board holds that whether or not a claim requestfiled after the expiry of the time limit set under Rule 79(1) EPC and before the expiry of the time limit set under Rule 116(1) EPC is to be considered to have been filed in due time depends on whether it was submitted as a direct and timely response to a change of the subject of the proceedings introduced by the opponent or the opposition division.		and does not intend to change E-VI, 2.2 and 2.2.2. There were no further comments from the SACEPO WP/G members.
74	**E**	**VI**	**3**	This section does not take into account what the search division should do in the event of third party observations received before they commence their search [e.g. where the application is published without search, or with a Euro-PCT requiring supplementary search.	Change penultimate sentence "The **search or** examining division will make every effort to issue the next office action within three months after expiry of the period under Rule 161, 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.	The Office did not agree to the proposal. The Office explained that third-party observations are always taken into account, both in search and during examination. In addition, it is the Office's practice to draw up search reports in a timely manner. If third-party observations are filed during the international phase and available to the search division, they will consider them when drawing up the supplementary search report. Only once the examining division has assumed responsibility will the Office make every effort to issue its next action within three months of expiry of the period under Rule 161 EPC if the conditions in E-VI, 3 are met; see also OJ EPO 2017, A86. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
75	**E**	**VIII**	**5**	Beyond the OJ publication, the EPO has published a news item (!!!) with details applying with immediate effect: https://www.epo.org/en/news-events/news/acceleration-opposition-proceedings-cases-parallel-court-actions	**Insert the details:** The specific acceleration measures depend on when the EPO is notified of parallel court proceedings, as outlined below: ▪ **During the opposition period (i.e. in the nine months after grant of the European patent)** After expiry of the period, the proprietor will be invited to comment on the opposition within three months (instead of the usual four months) and summons will be issued within two months of receipt of the proprietor's reply, summoning the parties at minimum notice (Rule 115(1) EPC). ▪ **After expiry of the opposition period but before the proprietor's reply to the opposition** Summons to oral proceedings will be issued within two months of receipt of the proprietor's reply. The parties will be summoned at minimum notice (Rule 115(1) EPC). ▪ **After the proprietor has replied but before summons has been issued** Summons to oral proceedings will be issued within two months of receipt of the information on parallel proceedings. The parties will be summoned at minimum notice (Rule 115(1) EPC).	The Office agreed to the proposal and will include details of the specific measures. Some SACEPO WP/G members supported the proposal. However, others submitted that adding information from website announcements would bring too much detail into this section of the Guidelines and make it unnecessarily long. Website announcements may also change at any time, so information from this source should not be added.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					▪ **After summons has been sent** Oral proceedings are rescheduled to the earliest possible date (provided that the time saving is significant). **After the decision has been pronounced** The decision and the minutes will be issued within one month.	
76	**E**	**IX**	**2.1.3**	The GL state that it is not possible to change the language of the proceedings on entry into the European phase where an international application was **filed and** published in the international phase in an official language of the EPO (see G 4/08). It does not state what happens when the international application was filed in another language, however G 4/08 contains the answer in reason 3.11.	Delete the words "filed and".	The Office agreed to the proposal. The interpretation of G 4/08 seems to be correct: "filed and" can be deleted. The key question is whether the language of publication is an official EPO language or not. If it is, this will become the language of the proceedings. There were no further comments from the SACEPO WP/G members.
77	**E**	**IX**	**2.1.4**		It is suggested to include that an eligible applicant (microenterprise, natural person, non-profit organisation, university or public research organisation) may, when/after entering the European phase, obtain a 30% in the filing fee, search fee, examination fee and designation fee (Rule 7a(3)(a/b/c/d)), as well as a 30% reduction of the previously paid international search fee where the EPO acted as ISA (Rule 7a(3)©)	The Office agreed to include information from OJ EPO 2024, A8 concerning fee-related support measures for small entities in Part A, and include cross-references in Part E. There were no further comments from the SACEPO WP/G members.
78	**E**	**IX**	**2.3.11**		It is suggested to include that an eligible applicant (microenterprise,	See #77 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					natural person, non-profit organisation, university or public research organisation) may, when/after entering the European phase, obtain a 30% in the designation fee (Rule 7a(3)(d))	
79	**E**	**IX**	**2.3.12**		It is suggested to include that an eligible applicant (microenterprise, natural person, non-profit organisation, university or public research organisation) may, when/after entering the European phase, obtain a 30% in renewal fees (Rule 7a(3)(f))	See #77 above.
80	**E**	**X**	**5**	The decision to grant is an appealable decision. Now that notification is mostly electronic, it is time to apply R. 111(2) to that decision.	Insert: "This also applies to the decision to grant."	The Office did not agree to the proposal. It explained that the proposal is not entirely clear; in any case, it appears to be superfluous. E, X-5 is broadly formulated and applies to "decisions of the EPO which are open to appeal". There were no further comments from the SACEPO WP/G members.
81	**E**	**XII**	**7.3**	**Comment 111 of the SACEPO WP/G meeting on 10.10.2023 (repeated in the new comments)** E-XII, 7.3 The last paragraph states: *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).* This would appear to be incorrect.	In other words, the last paragraph of Guidelines E-XII, 7.3 should read: *A request for reimbursement of the appeal fee will be remitted to the board of appeal **only if it was filed before the contested decision had been rectified under Article 109(1) EPC** (see G 3/03 and T 21/02).*	The Office concluded that it will consider clarifying the relevant section. It explained that the time of filing "before the contested decision had been rectified" is not precise enough and may lead to the request for reimbursement of the appeal fee overlapping with the rectified decision.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				T21/02 states that where a request for reimbursement of the appeal fee pursuant to Rule 67 EPC was submitted only after the contested decision had been rectified under Article 109(1) EPC, no legal basis exists for the Board of Appeal to decide on that request. However, it does not state that the request cannot be submitted after the appeal, as long as it is on file before a decision has been taken as to the rectification.		The current formulation provides more legal certainty. The SACEPO WP/G members argued that T 21/02 provides for a precise time limit to file a request for reimbursement of the appeal fee, i.e. as long as the appeal is on file before taking the decision on rectification. The Office explained that this needs to be translated in practice into a precise time limit in the proceedings to avoid confusion. The SACEPO WP/G members suggested that the Office follow a procedure analogous to examination proceedings, i.e. as long as the decision has not been passed to the Office's postal service. The Office will look into the matter and consider whether that section may be clarified.
82	**F**	**II**	**2.3 (vi)**	Each **main** feature mentioned in the abstract	'Each essential feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign placed in parentheses	The Office agreed to the proposal.
83	**F**	**II**	**6.1**	European Molecular Biology Laboratory EMBL	European Molecular Biology Laboratory **[EMBL]**	The Office agreed to the proposal.
84	**F**	**II**	**6.2.1**	According to ST.26, "specifically..	According to **WIPO Standard** ST.26, "specifically...	The Office agreed to the proposal.
85	**F**	**II**	**6.2.1**	Table 1 of ST.26	Table 1 of **WIPO Standard** ST.26	The Office agreed to the proposal.
86	**F**	**II**	**6.2.2**	Paragraph 7 **or** ST.26	Paragraph 7 **of WIPO Standard** ST.26	The Office agreed to the proposal.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
87	**F**	**II**	**6.2.3**	Paragraph 95 of ST.26	Paragraph 95 of **WIPO Standard** ST.26	The Office agreed to the proposal.
88	**F**	**II**	**Annex 1**	**Abstractor** (mentioned 3 times in the first paragraph)	**Examiner/search division**	The Office did not agree to the proposal and will keep the text of the WIPO document cited as a reference in the Annex. ST.12/A.
89	**F**	**II**	**Annex 2.1.4**	May be used for the **litre unit**	(1) May be used for the **unit litre**	The Office indicated that it will look into the matter.
90	**F**	**II**	**Annex 2.2**	Units which	Units**,** which	The Office indicated that it will look into the matter.
91	**F**	**III**	**1**	The first paragraph reads: "the application must contain [...] to perform the invention over the whole area claimed without undue burden and without needing inventive skill [...]". Concerning the "over the whole area claimed" a difference may be made between mechanics and chemistry. According to established case law, such as T500/20 (reasons 3.6), the approach mainly developed in the field of chemistry does not necessarily apply in mechanics.	I would propose a reference to such case law to put the above sentence "over the whole area claimed" into perspective.	The Office did not agree to the proposal, since this section already contains a reference to T727/95. There were no further comments from the SACEPO WP/G members.
92	**F**	**III**	**3**	"[...] insufficient detail to reproduce the technical effect over the whole range claimed [...]" While "insufficient detail" stems from Article 83 EPC, "over the whole range claimed" (and also "substantially all embodiments falling within the ambit of the claims") introduces a criterion not clearly distinguishable from "the scope of protection" and "scope of the claim" and the-like used throughout the Guidelines. What is, for example, the further need to speak about the "whole" scope (or the "whole range")? There is only the scope (of a claim) and it is always (to be interpreted as) the broadest possible scope (and	consolidate wording w.r.t. scope/range/ambit of the claim throughout the Guidelines	The Office is of the opinion that "over the whole range of the claim" could be replaced by "over the whole scope of the claim", which matches the French and German versions of F-III, 3. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				thus the whole scope). This creates uncertainty for all users (including examiners).		
93	**F**	**III**	**3**	The addition of the AI example is welcomed (this also applies to G-II 3.3.1).		The Office expressed its thanks for the positive comment
94	**F**	**III**	**10**	Missing parts under Rule 56 and correct application documents or parts under Rule 56a	Missing parts under Rule 56 and correct application documents or parts **filed** under Rule 56a	The Office agreed to the proposal
95	**F**	**IV**	**3.8**	Independent claims containing a reference to another claim or to features from a claim of another category 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 the use explicitly or implicitly implements all features of the product claim (see T 642/94 and T 1144/07).	Not clear: T1144/07 refers to an apparatus to produce a product (claim 1) and the product as such (claim 11). Claim 11 includes the features of the apparatus.	The Office agreed to the proposal. T 1477/07 refers to an apparatus, not a product. The Office suggested keeping the first sentence of the third paragraph mentioned in the comment and adding a new sentence as follows: "The same reasoning applies mutatis mutandis to an apparatus and the use of this apparatus", just before the reference to T 1444/07, in brackets. In addition, the Office suggested deleting the reference to T 692/94, which is irrelevant for this section.
96	**F**	**IV**	**3.8**	The addition of "explicitly or implicitly implements" is welcomed		The Office expressed its thanks for the positive comment
97	**F**	**IV**	**4.3 (iii)**	- Procedural aspects and examples See paragraph (i) above	- Procedural aspects and examples See paragraph (i) **(F.IV.4.3.)** above	The Office agreed to the proposal.
98	**F**	**IV**	**4.3**	The added	Delete paragraph.	The Office did not take any position on this comment: it has decided not to

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				Subject-matter in the description regarded as an exception to patentability under Art. 53 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 (see G II, 4.2 for adaptation of the description for methods of treatment of the human and animal body, G II, 5.3 for adaptation of the description for the use of human embryonic stem cells and G II, 5.4 for adaptation of the description for plant and animals).* Does the EPO consider the reader/skilled person to be STUPID!		modify section F-IV, 4.3 at this stage, as it is highly likely that any referral on this issue would be addressed to the Enlarged Board of Appeal. The Office expressed the opinion that it would be preferable to wait for the outcome of that future decision.
99	**F**	**IV**	**4.3**	Such disclaimer would also be contrary to TRIPS/ UPCA/ etc definition of right conferred from a product claim.	Add: Where the description comprises a description of a method of using a claimed device and there is no claims directed to the method, a disclaimer is not required even where the method in itself is regarded as an exception to patentability,	See #98 above.
100	**F**	**IV**	**4.3**	Due to the conflicting case law and a possible referral to the EBoA relating the issue of mandatory adaptation of the description - T56/21 - we strongly advise to refrain at this stage from any amendments which further emphasise that adaptation of the description is mandatory. We advise to take into account that T56/21 mentions that "The board queries whether the EPO Guidelines are in line with the wording and purpose of Article 84 EPC and with the case law on clarity requiring that claims should be clear in themselves without having to resort to the description for an interpretation." A restrained	Maintain the tekst of GL2023 to see if a referral to EBoA will be filed	See #98 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				approach to wait and see how this issue will develop is recommended.		
101	**F**	**IV**	**4.3**	We still disagree with EPOs strict requirement to delete embodiments or mark the as not covered by the claims etc. This requirement completely deprives a patentee for his rightfully scope of protection pursuant to Art. 69 EPC which according to the Convention also include equivalent matter as specified the Protocol on the Interpretation of Article 69 EPC. The SACEPO members have previously provided suggested amendments and we maintain these suggestions. In addition we wish to draw the EPO attention to the following: A posts on LinkedIn in relation to adaptation of the description: ▪ https://www.linkedin.com/posts/rose-hughes_adding-matter-by-amending-the-description-activity-7094598439824449536-QIOE (refers to https://ipkitten.blogspot.com/2023/08/adding-matter-by-amending-description.html'): which shows that there is a **considerable risk**! ▪ In our view it is not acceptable the applicant shall be forced to amend the description which terms like "embodiments falling outside the scope of the claims/ claimed invention/ invention as claimed / invention" ▪ https://www.linkedin.com/posts/activity-7089145426997567489-30oT/, referring to and giving credit to https://europeanpatentcaselaw.blogspot.com/202		See #98 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				3/07/t5621-vers-une-saisine-de-la-grande.html: possibly there will be a referral - the blog post indicates: "In proceedings T56/21 (15700545.5) Board 3.3.04 proposed a question for a referral to the Enlarged Board of Appeal: Is there a lack of clarity of a claim or a lack of support of a claim by the description within the meaning of Article 84 EPC if a part of the disclosure of the invention in the description and/or drawings of an application (e.g. an embodiment of the invention, an example or a claim-like clause) is not encompassed by the subject-matter for which protection is sought ("inconsistency in scope between the description and/or drawings and the claims") and can an application consequently be refused based on Article 84 EPC if the applicant does not remove the inconsistency in scope between the description and/or drawings and the claims by way of amendment of the description ("adaptation of the description") ?" (see "F3305 Communication of the Board of Appeal (ex parte/ inter partes)" dd 21.07.2023). ▪ https://www.linkedin.com/posts/johnny-haypee_ipmeme-ipabrmeme-activity-7095334188240789504-UG-t/ (…)		
102	**F**	**IV**	**4.3**	F-IV-4.3 and 4.4 do not seem to take into account all our previously proposed changes or comments, to which we refer to. However, considering that a referral to the EBoA on this issue seems possible (EP3094648 - T0056/21-3,3,04), we understand that no further changes made to the Guidelines are priority, especially before any EBoA decision is made on this topic. If any, and in light of the users experiences, it		See #98 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				should be defined and made clear the meaning of "'borderline' cases", so as to avoid inconsistencies across the divisions.		
103	**F**	**IV**	**4.4**	We still disagree with EPOs strict requirement to delete claim like clauses. The GI. Reasons this requirement in that such clauses otherwise do lead to unclarity, however as previously explained, it is established case-law that such clauses are not claims. (Case Law of the BoA, 10th edition II-A.8.1) and thus they do not give reasons for lack of clarity.		The Office did not take any position on this comment: it has decided not to modify section F-IV, 4.4 at this stage, as it is highly likely that any referral on this issue would be addressed to the Enlarged Board of Appeal. The Office expressed the opinion that it would be preferable to wait for the outcome of that future decision.
104	**F**	**IV**	**4.3**	The draft revision of Guideline F-IV 4.3 features a welcome change. In the sentence: « Any inconsistency between the description and the claims must be avoided if it casts doubt on the subject matter… » , the wording « if it casts doubt » (present tense) replaces the former wording « if it could cast doubt » (hypothetical). Importantly for applicants and for the desirable consistency between the PCT and EPO Guidelines, this will make the wording of the EPO Guideline much closer to the PCT ISPE Guidelines 5.29. This change implies that there is a compelling onus on the Examining Division to show by specific reasoning that an inconsistency between the description and the claims does cast doubt and that as a result, the inconsistency has to be addressed by adapting the description. A recent decision stressing that the burden of proof is on the Examining Division is T 2194/19, Reason 6.2.2. The Guideline should be complemented by a robust reminder to the Examining Divisions of the principle well settled in case law that the applicant is ultimately responsible for the content of the granted patent and of its implication, i.e. no	1. Insist in the Guideline that the onus is on the Examining Division to show by specific reasoning that an inconsistency between the description and the claims does cast doubt. 2. Add to the Guideline a robust reminder of the principle well settled in case law that the applicant is ultimately responsible for the content of the granted patent and of its implication, i.e. no substantial amendment of the description should be carried out by the Examining Division, without the applicant's formal approval., and support such a reminder by an explicit reference to Guideline C-V 1.1 specifically dealing with Rule 71(3) amendments, which includes the following guidance : « This text may include amendments and corrections made by the examining division on its own initiative which it can reasonably expect the applicant to acccept. The applicant	See #98 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				substantial amendment of the description should be carried out by the Examining Division, without the applicant's formal approval. It is suggested for such a reminder to be supported by an explicit reference to Guideline C-V 1.1 specifically dealing with Rule 71(3) amendments, which includes the following guidance : « This text may include amendments and corrections made by the examining division on its own initiative which it can reasonably expect the applicant to acccept. The applicant should be contacted by telephone or an official communication has to be written. » This guidance is at loggerheads with an authoritative implementation of Rule 71(3) by Examining Divisions imposing amendments the applicant is unlikely to accept, without prior communication, which amounts to arm-twisting the applicant. This guidance is clearly underpinned by the above-mentioned principle that the applicant is ultimately responsible for the content of the granted patent. Furthermore, recent decisions (T 447/21 Reason 13.1 and T 1628/11 Reason 1.1.16) consistently make it clear that the principle of the primacy of claims implies that such description amendments as disclaiming clauses or deletions of unclaimed embodiments are irrelevant to the interpretation of claims for the examination of novelty and inventive step, provided the wording of the claims is clear.	should be contacted by telephone or an official communication has to be written. »	
105	**F**	**IV**	**4.4**	T438/22 disapproved of the unconditional nature of the passage "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." and cited in support T1444/20.	Delete final two paragraphs	See #103 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
106	**F**	**IV**	**4.7**	The Guideline's approach supporting the deletion in claims of such words as « substantially » or « approximately », especially its reference to manufacturing tolerances, is unduly restrictive. The clarity of such words should not be considered out of context. They may be quite clear for the skilled person in the context of the disclosed function or operation of the feature to which it relates. For example, if a bar is defined in a claim as having a substantially cylindrical shape, this term will be clear for the skilled person if the function of the bar as disclosed in the description implies its ability to roll across a flat surface. Since such claim amendments are typically carried out by Examining Divisions at the Rule 71(3) stage, the Guideline should be complemented by a robust reminder of the principle well settled in case law that the applicant is ultimately responsible for the content of the granted patent and of its implication, i.e. no substantial amendment of the description should be carried out by the Examining Division, without the applicant's formal approval. It is further suggested for such a reminder to be supported by an explicit reference to Guideline C-V 1.1 specifically dealing with Rule 71(3) amendments, which includes the following guidance : « 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. The applicant should be contacted by telephone or an official communication has to be written. » It is also to be reminded in the Guideline that	1. Complement the Guideline by a robust reminder of the principle well settled in case law that the applicant is ultimately responsible for the content of the granted patent and of its implication, i.e. no substantial amendment of the claim should be carried out by the Examining Division, without the applicant's formal approval. It is further suggested for such a reminder to be supported by an explicit reference to Guideline C-V 1.1 specifically dealing with Rule 71(3) amendments, which includes the following guidance : « This text may include amendments and corrections made by the examining division on its own initiative which it can reasonably expect the applicant to acccept. The applicant should be contacted by telephone or an official communication has to be written. » 2. Include in the Guideline a reminder that claim amendments may raise new matter issues and that the Examining Divisions must absolutely keep away from any amendment raising a new matter issue.	The Office did not agree to the proposal. There is no specific need to refer to C-V 1.1 in F-IV 4.7, since objections may be raised **at any time** during search and examination, in particular at the time the opinion accompanying the European search report is established. It stated that section F-IV 4.7.1 **already gives good examples** of how the terms "substantially" and "approximately" can be understood by the skilled person. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				such claim amendments may raise new matter issues. Even if the applicant is ultimately responsible for the content of the granted patent, the Examining Divisions must absolutely keep away from any amendment raising a new matter issue. Taking the above-mentioned example of a substantially cylindrical bar, the deletion of « substantially » in a claim could raise a new matter issue, in view of the EPO's stringent assessment of new matter, if there is no disclosure in the description of a bar with a perfectly cylindrical geometry.		
107	**F**	**VI**		**F-VI** – Why do the Guideline deal with priority twice: in F-VI and in A-III, 6. Why not make one version (only in F) and refer in Part A to F-VI…? Parts of the texts are complete copies…	Simplify the GL where appropriate as here.	The Office did not agree to the proposal, but acknowledged that Parts A and F both deal with priority. However, Part A concerns purely formal aspects while Part F is mostly about the validity of a priority declaration and subsequent and partial priority. There were no further comments from the SACEPO WP/G members.
108	**G**	**II**	**3.3**	The recent updates to section G-II, 3.3 (most notably in 2018 and 2022) have been very useful for applicants, examiners and professional representatives and set out a clear framework for assessing patentability. G-II, 3.3 helpfully sets out several examples of "specific technical applications", but has only 2 examples of "specific technical implementations". The revision in 2022 following G1/19 was helpful in explaining that a mathematical method may contribute to technical character 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	Add: Another example includes assignment of different computation tasks to a quantum computer and to a classical computer in a hybrid quantum-classical computer system, to balance between the computational advantages of quantum computers and the problems of noise and decoherence. Additional examples involve adaptation of a mathematical method to assign specific quantum error detection or quantum error correction tasks to some of the qubits	The Office did not agree to adding an example of a specific technical implementation involving quantum computers, at least not at this stage. It is important to be very careful when providing examples in the Guidelines, especially when it comes to patentability and the technical contribution of claim features. Examples should ideally come from BoA decisions (e.g. the first examples of specific technical implementation come from T 1925/11) and should be

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				such as efficient use of computer storage capacity or network bandwidth. We welcomed the clear and helpful example in which different types of task for training an ML algorithm are assigned to a system's CPU than to its GPU to exploit parallelism within the system. EPO Examining Divisions seem to recognize that this provides a helpful analogy for assessing quantum computing algorithms which allocate some tasks to a classical computer and some to a quantum computer within a hybrid quantum-classical computer system, to exploit the capabilities of quantum computers while controlling circuit depth to mitigate the problems of noise and decoherence in current (NISQ) computers. I invite SACEPO WPG to consider whether we should add a quantum computing example so that the existing practice of the EPO is transparent to EPO customers.	of a resource-constrained quantum computer system.	sufficiently specific to not suggest that something contributes to the technical character when it is not certain it does. With regards to specific technical implementation in particular, there are very few positive examples (one is T 2330/13, quoted in G-II.3.3), and these are mainly related to parallelising algorithms. For example, specific technical implementation does not apply to a general-purpose computer; therefore, care should be taken when implying that hybrid quantum-classical computer systems are not general-purpose for the execution of programs involving q-bits. There were no further comments from the SACEPO WP/G members.
109	**G**	**II**	**3.3.1**	A bit confusing with comments seemingly related to sufficiency in this chapter. Could language be tweaked to somehow relate to the overall aim of giving help to decide whether there is an invention in the sense of EPC 52 .. or whether a seemingly non-technical feature contributes to technical character? What also need to be clarified... regulated... is the relationship to "essential features". If the effect depends on a particular characterisic of the training set.. Would features reflecting this be essential features? At least in the medical domains most objections related to lack of technical character for "algorithmic features" seem to relate to claim language aspects and not to insufficency as such.		The Office explained that it is clear in G-II.3.3.1 that the considerations about Art. 52 and technical effect (contributing to the technical character) of AI and machine-learning related inventions are identical to those of inventions that include other mathematical methods; it is particularly made clear by the ending of the first paragraph of G-II.3.3.1, which makes reference to G-II.3.3. Therefore the Office does not believe are needed. Regarding sufficiency and support (related to essential features) and the technical effect, the Office pointed out

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						that the last paragraph of G-II.3.3.1 describes a situation where a technical effect is present (based on the previous paragraphs) and makes the point that that effect has to be sufficiently disclosed in the application and supported by the description, as in any application. Specifically in training machine learning-related applications, the threshold of how detailed the disclosure of training data has to be is very much case-dependent, and a general rule would not be applicable. The Office is considering including in future revisions a reference to F-IV.4.5.2 and G-VII.5.4.1 to the effect that claims must be drafted so as to include all the technical features of the invention which are essential for its technical effect and that the technical effects must be achieved over the whole scope of the claim. There were no further comments from the SACEPO WP/G members.
110	**G**	**II**	**3.3.1**	"[...] technical effect that a machine learning algorithm achieves may be readily apparent or established by explanations, mathematical proof, experimental data or the like." The above wording contradicts the supersection G-II, 3.3, in that G-II, 3.3. stresses that a technical effect cannot be based on the algorithm/mathematical features alone. A specific technical implementation and/or a specific technical application of the algorithm/mathematical method is required.	"[...] technical effect that a machine learning algorithm achieves by its application to a field of technology and/or by being adapted to a specific technical implementation may be readily apparent or established by explanations, mathematical proof, experimental data or the like."	The Office explained that the text is clear as it is and a repetition of the conditions mentioned in G-II.3.3 is not necessary. By saying that "The technical effect that a machine learning algorithm achieves may be readily apparent …" it is assumed that there is a technical effect, and the conditions for that are indeed in G-II.3.3.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						There was one positive comment from a SACEPO WP/G member, pointing out that the proposed amendment could be perceived as a limitation
111	**G**	**II**	**3.3.2**	**GL/EPO G-II, 3.3.2, simulation, design or modelling, section titled "*Simulations interacting with the external physical reality*"** It is suggested to add a paragraph at the end of this section, to refer to the legal background of G 1/19 and the explanation in T 0761/20 (Automated script grading/UNIVERSITY OF CAMBRIDGE) of 22-05-2023. The proposed wording corresponds to the headnote of T 761/20:	"According to G 1/19, a direct link with physical reality is not required for a technical effect to exist. However an at least indirect link to physical reality, internal or external to the computer, is required. The link can be mediated by the intended use or purpose of the invention ("when executed" or when put to its "implied technical use") (T 761/20)."	The Office did not agree to insert this paragraph, which is based on a single T decision. The proposed wording of the link being mediated by "purpose of the invention" may be interpreted broadly when taken out of the context of that decision. Moreover, that section (G-II.3.3.2) is about simulations and the interaction with external physical reality; a paragraph about the possibly indirect connection with physical reality within the computer would be out of place and confusing. This issue may be reassessed if further decisions are issued using similar wording. There was one comment from a SACEPO WP/G members who agreed with the Office's comment.
112	**G**	**II**	**3.3**	T1910/20 disapproved of the passage "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."	Leave as is.	The Office proposed changing the sentence to "… what use is made of the results *of the prediction or the derivation*", so that the meaning is clearly what is intended in G 1/19, where the phrase "regardless of what use is made of the results" originates. The current phrase in the Guidelines could be interpreted as encompassing the possibility that use of the results does not comprise the prediction or derivation of a physical state, i.e. an indirect measurement.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						The SACEPO WP/G members responded positively to this clarification.
113	**G**	**II**	**3.3.1**	This section starts with: "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 algorithm." (emphasis added) We believe that the wording is too strict and has the risk to introduce an a priori bias when assessing an AI or ML invention as to it necessarily being non-technical, while that is not necessarily so: they may well be technical, and shall thus not be assessed with (a risk to) such a priori bias but shall be assesses as any invention, as also any other CII invention or any invention based on mathematical model is to be carefully assessed as to technical character (as is implicitly indicated by the reference to G-II, 3.3 - however, the relevance of this reference my be overlooked when the paragraph is read with an a priori bias of non-technicality. In particular, we believe that the terms "**are** based on" and "**are** per se" are too absolute and we propose to amend these so that the (risk to a) bias to non-technicality is removed and the	We therefor suggest to amend the opening paragraph to read: "Artificial intelligence and machine learning may use [~~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 **may** be as such [~~are per se~~] of an abstract mathematical nature [~~, irrespective of whether they can be "trained" based on training data~~]. In this case [~~Hence~~], the guidance provided in G II, 3.3 would generally apply [~~applies~~] also to inventions using such computational models and algorithms. However, the mere usage of computational models and algorithms, even if excluded as such, does not by itself render artificial intelligence and machine learning excluded subject matter. Artificial intelligence and machine learning **may have technical character** either as such or by contributing to the technical character of an invention."	The SACEPO WP/G members expressed their concern that the list in the first paragraph of G-II.3.3.1 gives the impression of being exhaustive, which is not true, especially since AI-related technology is growing rapidly. They also pointed out that whether AI/ML are based on mathematical models or not is irrelevant, as the character of the invention as a whole has to be examined, not what it is based on. The Office agreed that other algorithms or methods could in future be regarded as AI and take these points on board; clarification of the Guidelines will be considered. The SACEPO WP/G members also expressed their concern that readers may be biased against the technical character of AI-related methods, and a reader who is not an expert in the field may misinterpret the guidance in the first paragraph of G-II.3.3.1 and not assess the technical character of an AI-related invention properly. The proposed text, according to one SACEPO WP/G member, was the result of a long discussion in a larger user group, and it was not easy to arrive at that balanced proposal.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				examiner is directed to carefully assess the presence of technical character of the lack thereof, using the ""whole-claim approach" as for any invention where Art. 52(2) exclusions may play a role. For this same reason, we propose to not only explicitly address the reasons for possible exclusion, but to also explicitly address why the invention may not be included, by explicitly indicating that AI and ML may have technical character as such or may contribute thereto.		The Office will consider these new comments carefully and come back to this issue in the next SACEPO WP/G in October.
114	**G**	**II**	**4**	Also relevant to G II 4, G VI 7 for Pharma; in addition G II 4, G II 5 , G IV 9 and 13, for Biotech An index is required for both of these special technologies as for Computer Implemented Inventions; as the relevant Guidelines are spread over several areas of the GLs. The areas cited may not be complete.	Include: - an Index for Pharma relevant GLs; - an Index for Biotech relevant GLs.	The Office did not agree to the proposal. The Office believes that all the relevant biotech sections are clearly identified as such. While the Guidelines contain a separate CII index, the situation is different to Biotech & Pharma in that CII-specific information is spread across different parts of the Guidelines, whereas the information concerning biotech and pharma is mainly contained in a single place. This makes a CII index useful, because otherwise the user would have to search through many places in the Guidelines. There were no further comments from the SACEPO WP/G members.
115	**G**	**II**	**4.2**	Point 95 of 25th SACEPO. It refers to adoption of the description "*Subject-matter in the description regarded as an exception to patentability needs to be excised,*	At least adding " unless it is already clear from the context that such excluded matter is not forming part of the claimed subject matter, for example by simply stating that	The Office did not agree to the proposal. The Office notes that any amendment to the passage on adaptation of the

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				reworded such that it does not fall under the exceptions to patentability or prominently marked as not being according to the claimed invention (see F-IV, 4.3). For the latter case, in accordance with Art. 53(c the description may for example 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".	***methods of treatment by therapy or surgery or in vivo diagnosis methods are not claimed***.	description will be deferred until the referral to the Enlarged Board of Appeal has been issued and decided. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					We find that this new paragraph, introducing an entirely new requirement, should be removed from the guidelines. There are no legal support for this requirement. The claim defines what is covered by a patent. The description has the purpose of supporting the claims – NOT THE PURPOSE OF DEFINING SCOPE. If a medical device is claimed and the description describes how it may be used in for treatment of the human or animal body by surgery or therapy and diagnostic method, there should not be any reason to include any of the mentioned statements, because inventions directed to such methods - by law - are excepted from patentability. If this is not accepted, we find, that as a minimum the following modification is required: Subject-matter in the description regarded as an exception to patentability 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 (see F-IV, 4.3), unless it is already clear from the context that such excluded matter is not	

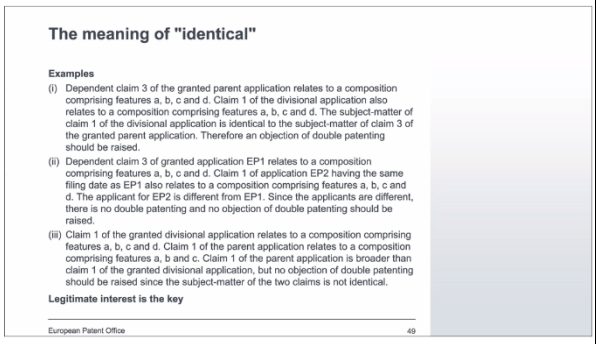
#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					forming part of the claimed subject matter. ~~For the latter case~~, In accordance with Art. 53(c), the description may for example be amended by adding an indication as follows: "The references to the methods of treatment 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".	
116	**G**	**II**	**4.2**	The newly introduced passage "Subject-matter in the description regarded as an exception to patentability 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 (see F-IV, 4.3). For the latter case, in accordance with Art. 53(c), the description may for example 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".	"Subject-matter in the description regarded as an exception to patentability 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 (see F-IV, 4.3). For the latter case, in accordance with Art. 53(c), the description may for example 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	The Office did not agree to the proposal. The Office notes that the comment concerns adaptation of the description in relation to Art. 53(c) EPC. It is considering adding information on devices. However, any revision (including information on devices) will be deferred until the referral to the Enlarged Board of Appeal on adaptation of the description has been issued and decided. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				refers in principle to therapy, surgery and diagnosis, and apparently tries to aim at (at least?) Article 54(5) EPC, but makes also explicit reference to Article 53(c) EPC. However, the general statement which is suggested refers only to "compounds, pharmaceutical compositions and medicaments". Why would this not be applicable in the same manner also to "devices" such as e.g. surgical instruments etc. Sure, it is explicitly presented as an "example", but what is the extent of this example - is a statement such as the following also suggested? "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 DEVICES of the present invention for use in those methods". If so, please add this also as an example. And if this is not suggested, please clarify the "examples" by giving more than one example.	medicaments, AND/OR DEVICES of the present invention for use in those methods".	
117	**G**	**II**	**6.2**	**Comment 140 of the SACEPO WP/G meeting on 10.10.2023** The final sentence of 6.2 (former 5.6.2) is welcome and addresses a point that EP practice should encourage not only the development and identification of specific, particular antibody molecules, but also the improvement and development of *general antibody technology*, such as novel formats, platforms etc. However, in practice reasonable broad protection for such inventions is notoriously difficult to obtain based on a limites proof-of-concept experiments that an applicant can usually manage to produce,	Importantly, it should be clearly stated that, ***to the extent such an invention is generally applicable to all or most antibodies, applicants should not have to limit their claims to amino acid sequences of the particular examples used to illustrate the general concept***.	The Office did not agree to the proposal. This issue is case-specific, and it is not possible to formulate a general line applicable to every instance. Therefore the Office does not consider that providing a non-exhaustive list of types of formats and modifications can assist in the assessment of an inventive step of a claimed format. In addition, the current wording is not restrictive, and the "disclaimer" appears neither

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				so while this sentence – "a novel type of functional antibody format may also be considered inventive" – is welcome, the **guidelines should ideally further elaborate on what kind of generic claims would be possible, e.g. inventions changing the traditional order or architecture of Ig domains in an engineered construct, general modifications addressing manufacturability and purification of antibodies, formats with bi-, tri- and multispecific binding functions**.		necessary nor justified. Finally, as also already discussed, this new comment is a matter of both Art. 56 and 83, while section 6.2 concerns inventive step. There were no further comments from the SACEPO WP/G members.
118	**G**	**II**	**6.2**	The whole chapter "Inventive step of antibodies" placed in this chapter should may be placed to Chapter VII, 13, dealing with inventive step.		The Office did not agree to the proposal. All relevant information on antibodies is provided in a single place. The Office trusts that this approach is more user-friendly than splitting up the information into clarity and inventive step sections in two separate places. This issue has already been discussed. There were no further comments from the SACEPO WP/G members.
119	**G**	**IV**	**5.4**	**Comment 142 of the SACEPO WP/G meeting on 10.10.2023** 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).	It is also permissible to allow **to proceed** with … even if they claim the same subject-matter.	The Office thanked the SACEPO WP/G members for their clarifying comments and will attempt to clarify this sentence.
120	**G**	**IV**	**5.4**	From the wording "... do not claim the **same subject-matter** ..." it is not clear whether it strictly refers to only literally identical claims or if it also covers the situations when the wording of claims	Please clarify.	The Office did not agree to the proposal.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				of the granted patent and of the pending application is different (e.g. different combination of dependencies) but the subject-matter overlaps.		The wording used In this passage is from G 4/19, which does not provide any further details on the exact definition of "same subject-matter". Case law in this respect is monitored and once a clearer definition emerges the Guidelines will be updated. See also the comments below. However, for the Office it is clear that "same subject-matter" does not mean "identical claims". There were no further comments from the SACEPO WP/G members.
121	**G**	**IV**	**5.4**	It appears that not all Board of Appeal decisions that refer to G 4/19 use the same interpretation of whether "it claims the same subject-matter as a European patent which has been granted to the same applicant". Thus, it seems appropriate to indicate in the Guidelines how first instance divisions, in particular the examining division, interprets and applies the test In particular, T 1128/19 reasons 5-10, 11-12 and 13-14; as well as T 1478/18 reason 56 compare not just the independent claims but also independent with dependent claims (granted 1+4+a alternative aa of 5 vs 1, granted 1+2+3 vs 1, granted 1+7 vs 1; resp. granted 1+4+7+8 vs 15) while T 2907/19 only compared the independent claims. E.g., T 1128/19, reasons 5-10: "5. To decide if the application under appeal was correctly refused *because it contravenes the principle of prohibition of double patenting, it must further be determined whether "it claims the same subject-matter as a*	It is suggested to add to G-IV, 5.4: In examining whether the application claims the same subject-matter as a European patent which has been granted to the same applicant, it must not only be checked whether there is correspondence between (one or kore of) the independent claim(s) of the granted patent with independent clam(s) of the application, but also whether there is correspondence between any independent and dependent claims and between dependent claims. E.g., a double patenting objection may arise: - if independent claim 1 of the application corresponds to independent claim 1 of the granted patent; - if independent claim 1 of the application corresponds to the subject-matter of dependent claim 2 of the granted patent (usually referred to	The Office did not agree to the proposal. As there is diverging case law, the Office will monitor relevant decisions for the time being. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				European patent which has been granted to the same applicant". *6. As noted in the decision under appeal (see point 15.1), claim 1 of the main request is a combination of claims 1 and 4 and a single embodiment (aa) from claim 5 of the granted patent. The wording of claim 1 of the application under appeal differs from that of the above mentioned claims of the patent in that it specifies that the first binding domain "is an antigen-interaction site".* *7. As also noted in the decision under appeal, the subject-matter of claim 1 of the main request is an explicit alternative defined in the claims of the parent patent, being a combination the claim 1 and 4 and embodiment (aa) of claim 5 as granted*. 8-9,[...] 10*. The main request and auxiliary requests 1 are not allowable in view of the prohibition of double patenting because they claim the same subject-matter* as claimed in the parent patent." **T 2907/19, reason 12.1-12,2: "12.1 [...]** The definition of "the same subject-matter was not subject of the referral and of decision G 4/19, see Reasons, points 3, 15 and 16. 12.2: [...] *Hence, independent claim 1 of the fifth auxiliary request is different from independent claim 1 of the granted parent application and thus does not define the same subject-matter. Hence, the prohibition of double patenting is not pertinent to the claims of the fifth auxiliary request. This is not precluded by the fact that claim 1 of the fifth auxiliary request corresponds to dependent claim 2 of the granted parent application*." In my view, the approach by T 1128/19 and T 1478/18 is to be followed: the prohibition shall	as "the combination of claim 1 and 2"); - if the subject-matter of dependent claim 2 ("the combination of claim 1 and 2") of the application corresponds to independent claim 1 of the granted patent.	

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				not just apply if the independent claim of the granted patent and the patent under examination are the same, but also in case of correspondence of a combination of an independent claim and one or more dependent claims with an independent claim or an independent claim and one or more dependent claims. This interpretation is fully in line with earlier G 3/14, e.g., reason 80, where the Enlarged Board emphasized that " a combination of claims, in reality consists of striking out the original independent claim and then writing out the previous dependent claim in full" (in (a)) and "the dependent claim could have been formulated as a separate independent claim" (in (c)), i.e., that the status of independent and dependent claims is the same and that referring to them as dependent claims and using references to the claim(s) that a dependent claim depends on is rather of purely formal, administrative and conciseness reasons. The approach by T 1128/19 and T 1478/18 is was also used by slide 49 of the Presentation "Double patenting" given by the EPO on Examination Matters 2021 (8 December 2021):  **The meaning of "identical"** **Examples** (i) Dependent claim 3 of the granted parent application relates to a composition comprising features a, b, c and d. Claim 1 of the divisional application also relates to a composition comprising features a, b, c and d. The subject-matter of claim 1 of the divisional application is identical to the subject-matter of claim 3 of the granted parent application. Therefore an objection of double patenting should be raised. (ii) Dependent claim 3 of granted application EP1 relates to a composition comprising features a, b, c and d. Claim 1 of application EP2 having the same filing date as EP1 also relates to a composition comprising features a, b, c and d. The applicant for EP2 is different from EP1. Since the applicants are different, there is no double patenting and no objection of double patenting should be raised. (iii) Claim 1 of the granted divisional application relates to a composition comprising features a, b, c and d. Claim 1 of the parent application relates to a composition comprising features a, b and c. Claim 1 of the parent application is broader than claim 1 of the granted divisional application, but no objection of double patenting should be raised since the subject-matter of the two claims is not identical. **Legitimate interest is the key** European Patent Office 49		

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				It is submitted that differing approaches at the Board are not a bar to selecting an approach for first instance divisions, in view of a need for a common approach at all fist instance divisions in view of a need for legal certainty - especially also as double patenting is not a ground for opposition, such that the examining division shall not be overly tolerant.		
122	**G**	**IV**	**5.4**	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).	It is also permissible to allow **to proceed** with … even if they claim the same subject-matter.	See #119 above
123	**G**	**IV**	**7.5.2, 7.5.3**	**Comment 143 of the SACEPO WP/G meeting on 10.10.2023** **GL/EPO G-IV, 7.5.2 & 7.5.3: "standard of proof", "free evaluation of evidence" and "burden of proof"** It is also noted that the principle of free evaluation of evidence is currently only described and defined in the context of internet disclosures in G-IV, 7.5, in particular subsection 7.5.2, and mentioned (but not defined) in the new text of G-VII, 11.	It is suggested to move this general principle of "free evaluation of evidence", as well as that of the "standard of proof" and "burden of proof" (now in G-IV, 7.5.3), e.g., to include it into section G-IV, 1 (General remarks and definition), where the last two paragraphs already relate to similar aspects. Further: It is suggested to add, based on T 0042/19 of 19-01-2023, catchword 6/reasons 3.2-3.6: "The evaluation of evidence only refers to establishing whether an alleged fact has been proven to the satisfaction of the deciding body. The discretion-like freedom is restricted to this question and does not extend to the further question of how the established facts are to be interpreted and what the legal consequences are (T 42/19)".	The Office did not agree to the proposal. The Office may consider overhauling some of the text in future revisions. However, the "principle of free evaluation" is already set out in detail in E-IV, 4.4. on "General Procedural Matters"; a repetition or reference in G-IV, 1 does not currently seem pertinent. The Office is of the opinion that the catchword of the T 42/19 decision should not be included. This primarily concerns the power of a Board of Appeal to review an appealed decision. It is also open to discussion whether and/or to what extent evidence may play a role or provide guidance on how the established facts should be interpreted. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
124	**G**	**IV**	**7.5.2, 7.5.3**	**GL/EPO G-IV, 7.5.2 & 7.5.3: "standard of proof", "free evaluation of evidence" and "burden of proof"** It is also noted that the principle of free evaluation of evidence is currently only described and defined in the context of internet disclosures in G-IV, 7.5, in particular subsection 7.5.2, and mentioned (but not defined) in the new text of G-VII, 11.	It is suggested to move this general principle of "free evaluation of evidence", as well as that of the "standard of proof" and "burden of proof" (now in G-IV, 7.5.3), e.g., to include it into section G-IV, 1 (General remarks and definition), where the last two paragraphs already relate to similar aspects. Further: It is suggested to add, based on T 0042/19 of 19-01-2023, catchword 6/reasons 3.2-3.6: "The evaluation of evidence only refers to establishing whether an alleged fact has been proven to the satisfaction of the deciding body. The discretion-like freedom is restricted to this question and does not extend to the further question of how the established facts are to be interpreted and what the legal consequences are (T 42/19)".	See #123 above
125	**G**	**VI**	**6.1.1**	See T 1252/20 (EMBOLIC SYSTEM / 3-D) 06-02-2024 | Epo.org which directly criticises G-VI, 7.1.1 [Now 6.1.1]. The decision appears well reasoned.	Replace the third paragraph by an extract from paragraph 12 of the Decision "*The question of whether a material, or an object is a "substance or composition" in the sense of Articles 53(c) and 54(4)or (5) EPC should be decided, in the first place, on the basis of the claimed material or object as such. If this analysis leads to the conclusion that indeed a substance or composition is present, this requirement of Article 54(4) or (5)*	The Office did not agree to the proposal. T 1252/20 is an isolated decision which needs first to be confirmed. It would be premature to change the Guidelines based on the conclusion of this decision alone. Case law is monitored. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					EPC is fulfilled. No additional restrictions relating to its mode of action are derivable from the EPC."	
126	**G**	**VI**	**7**	Under the title "(ii) Multiple selections identified", in the first paragraph it seems that "of" might be missing in "Depending on the type of the selections, this generally leads to one the following three scenarios" This updated passage on selection inventions is much appreciated!	Depending on the type of the selections, this generally leads to one OF the following three scenarios	The Office agreed to the proposal.
127	**G**	**VI**	**7.1**	**Comment 147 of the SACEPO WP/G meeting on 10.10.2023** The facts of T175/97 seems to be over-interpreted. Taking the example given in the Guideline the margin of error for a value of 3.5 is 3.45 to 3.54. On this interpretation there would be a range of values that could never exist. What happens to 3.54999999? Conventionally (and mathematically) this value would be rounded to 3.5 (i.e. 3.5 would be interpreted as having values from 3.45 to <3.55).	Delete ", e.g. for a measurement of 3.5 cm, the error margin is 3.45-3.54"	The Office did not agree to the proposal. An exact value is never rounded twice, i.e. first from eight digits after the decimal point down to two and only then to just one. The example in the Guidelines deals with decimal values with only two digits after the decimal point. This is considered to be clear to a skilled person with a technical education. There were no further comments from the SACEPO WP/G members.
128	**G**	**VI**	**7 and 7.1**	In G-VI, 7, end points are treated as examples. "Serious contemplating" and "Purposive selection" should no longer be used as a test for novelty. The "Gold standard" test is to be applied only. This is not consistent with the new text in G-IV, 7 and especially the paragraph:	Bee consistent. E.G. by amending G-VI, 7.1 to: 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	The Office did not agree to the proposal. The SACEPO WP/G members stated that selection inventions should also be assessed according to the gold standard and references to "sufficiently far removed" and

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				A claimed selection of a sub-range is not considered novel if any specific value disclosed in the prior art falls within the claimed range, irrespective of whether the value stems from a concrete example or is disclosed as the endpoint of a range.	applied: the last decimal place of a numerical value indicates its degree of accuracy, **irrespective of whether the value stems from a concrete example or is disclosed as the endpoint of a range**. 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.	"seriously contemplating" be removed. This cannot be done yet, as the Boards themselves still use these criteria. So far only one isolated decision (T 1688/20) that requires application of the gold standard has been published. In contrast, in 2022 were there six decisions by Boards still applying these two criteria and confirming the current practice of the Office: T 1695/17, Reasons 4 T 1516/18, Reasons 5.2.2, 5.2.3 T 1683/18, Reasons 4.4.2 T 2250/18, Reasons 3.1 T 1096/19, Reasons 5.1.2 - 5.1.3 T 1194/20, Reasons 3.3.1 The case law will be monitored. There were no further comments from the SACEPO WP/G members.
129	**G**	**VI**	**7.1.1**	T1252/20 is about what is a product/composition according to Art 54(4)(5). The last § of Guidelines G-VI, 7.1.1 would in my opinion deserve a clarification. *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,*		The Office did not agree to the proposal. T 1252/20 is an isolated decision which needs first to be confirmed. It would be premature to change the Guidelines based on the conclusion of this sole decision. Case law is monitored. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				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). These examples obviously come from case law, but by removing the references, they become difficult to understand: in my opinion, the decision would clarify the nature of the radiation, and also how an effect could be attributed to chemical properties. For example, it is unclear to me if the X-Ray absorption by lead is due to its chemical properties.		
130	**G**	**VII**	**5.2**	W.r.t. new effects submitted subsequently during the proceedings by the applicant, the terms "would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention" are not very clear. Whereas G 2/21, when read as a whole, seems to indicate that one is very limited in coming up with effects that were not directly derivable from the application as filed, this wording (taken in isolation/ out of context) suggests that any effect that may be argued to be encompassed by what was disclosed can be relied on. With the strict standard for amendments, G 2/21 cannot be understood as very lenient (nor meant to be so); on the contrary, the term "would" in " would derive" (not could, but would ;)) and "embodied by the same originally disclosed invention" suggest a strict requirement.	Please clarify what is meant with "new effect being encompassed by the technical teaching". Please clarify what is meant with "new effect embodied by the same originally disclosed invention".	The Office did not agree to the proposal. The term "… said effect … embodied by the same originally disclosed invention" is wording used in the headnote of G 2/21. There is no better definition in the decision. Case law is monitored for this case. However, consideration is being given to amending the Guidelines to stipulate that the "new" technical effect must not be explicitly disclosed. However, the wording "new effect" in this section will be reviewed, because the term "new" can be misleading. "New effect" might be replaced by

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				Some original terms encompass any type of effect, e.g., "a better device": does that give the applicant a carte blanche to later introduce any new effect as that makes the device better to some extent? If the original application presents as effect "a better car", can a "lower fuel consumption" be introduced as a new effect, even if the application nowhere mentions that but merely describes a car with an engine with a better rust inhibition?		"purported effect" (or alleged effect), as used in G 2/21. There were no further comments from the SACEPO WP/G members.
131	**G**	**VII**	**5.2**	The addition in view of G2/21 is welcomed (this also applies to G-VII 11).		The Office expressed its thanks for the positive comment.
132	**G**	**VII**	**11**	**Comment 148 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** The sentence "Such new effects can only be taken into account if they are implied by or at least related to a technical problem initially suggested in the originally filed application (see also G-VII, 5.2, T 386/89 and T 184/82)." has been deleted.	Suggestion to re-formulate as below: "Effects implied by or at least related to a technical problem initially suggested in the originally filed application are considered.", since these are not "new" effects.	The Office agreed to the proposal. Consideration could be given to replacing "new effect" with "purported effect" (or "alleged effect") as used in G 2/21. There were no further comments from the SACEPO WP/G members.
133	**G**	**VII**	**11**	See also G-VII, 11: with the wording "Such new effects can only be taken into account if the skilled person, having the common general knowledge at the effective filing date in mind, <u>and based on the application as originally filed,</u> would derive said effect as being encompassed by the technical teaching and embodied by the same originally disclosed invention (G 2/21, Headnote II).", the Enlarged Board indicated that one should start from the application as originally filed and consider not just whether the new effect is encompassed by the technical teaching, but also whether one **would** derive the new effect as **embodied by the same originally disclosed**		The Office did not agree to the proposal. The wording in the Guidelines corresponds to the headnote of G 2/21. Case law is monitored to observe any evolution in the interpretation of this headnote. Until then the wording will be maintained, except for the "new effect" terminology review. The use of "and" in the headnote implies that both criteria

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				invention. In online blogs, some persons have emphasized only the first "encompassed" requirement without considering the second, embodied by originally disclosed invention. It is suggested to emphasize that there are these, distinct two requirements.		("encompassed" and "embodied") must be met, so it does not seem pertinent to emphasise that they are distinct requirements. There were no further comments from the SACEPO WP/G members.
134	**H**	**I, II, II, IV and V**		The English text explains the difference between "admissible" and "allowable". […]. Chapters H-II and H-III deal with the admissibility of amendments, while Chapters H-IV and H-V deal with their allowability." The French translation is confusing. "Admissible" is translated as "recevable", what is fine, but explained "recevables, autrement dit elles doivent satisfaire aux exigences pour être **admises** dans la procédure". This is confusing because "allowable" is translated as "admissible". *This leads to confusing text, for example in H-IV, 1: "Après qu'une modification a été admise dans la procédure, l'instance compétente doit décider si cette modification est admissible […]." Or in H-IV, 3.2: "…de telles modifications étendant la protection ne sont pas admissibles…".* *Plenty of examples!*	Admissible, admitted and their variations should NOT be used in connection with allowability. "admissible" (in English) can be translated either by "recevable" (for a request or an appel) or by "admissible" (for evidence). French does not have a direct translation for "allowable" and its variations. Depending on the context, expressions should be used such as "à laquelle il est fait droit" or "bien-fondée" or possibly "accordée". *Re-writing of examples:* *H-IV, 1: "Après qu'une modification a été admise dans la procédure, l'instance compétente doit décider si elle peut faire droit à cette modification…"* *H-IV, 3.2: "…il ne peut être fait droit à de telles modifications étendant la protection…".*	The Office confirmed that it will review the French translation. There were no further comments from the SACEPO WP/G members.
135	**H**	**II**	**2.2**	**Comment 150 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-II, 2.2 The words "within the time limit for responding to the search opinion" do not reflect R137(2) which reads "together with any comments, corrections or amendments made in response to	It should be clarified that this also applies when responding with further processing (which is actually within a time limit for responding ...).	The Office did not agree to the proposal. Further processing is explained in detail in E-VIII, 2 and it is not apparent why this should be mentioned in H-II, 2.2 as well.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				communications by the European Patent Office under Rule 70a, paragraph 1 or 2, or Rule 161, paragraph 1".		There were no further comments from the SACEPO WP/G members.
136	**H**	**II**	**2.5.4, 2.6**	**Comment 151 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-II, 2.5.4 and 2.6 Isn't it time to delete H-III, 2.1.4? Ii is more efficient to send a R137(4) communication! Which applicant will object rather than simply reply? In the second § of 2.6, the reference to H-III, 2.1.4 is absent, and this appears fine.		The Office explained that this section will be removed when there are no more affected applications pending. There were no further comments from the SACEPO WP/G members.
137	**H**	**II**	**3.1**	The title "*Amendments in reply to the notice of opposition*" is incorrect, because this section relates to all amendments (see line 1) and the ground for opposition in R.80 does not actually have to have been invoked by the opponent. See also line 1 of section 3.2. Adopt title for 3.1 mirroring the title of 3.2.	Amend the title to read "*Amendments related to the grounds for opposition*"	The Office agreed to the proposal. For consistency reasons, the Office suggested moving the following sentences to H-II, 3.2: "*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."* There were no further comments from the SACEPO WP/G members.
138	**H**	**II**	**3.1**	When amendments are made in opposition proceedings, the description may have to be amended. It would be logical to place the reference to D-V, 5 in this section rather than in 3.2.	Introduce a reference to D-V, 5	The Office agreed to the proposal. There were no further comments from the SACEPO WP/G members.
139	**H**	**II**	**3.2**	The title is "Amendments not related to the grounds for opposition". Thus, the reference to D-V, 5 is incorrect because D-V, 5 relates to	Remove reference to D-V, 5	The Office did not agree to the proposal. The reference to D-V, 5 was included to make clear that

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				inconsistencies between the description and the claims resulting from amendments, which amendments to the claims must relate to grounds of opposition (R.80).		comprehensive redrafting of the description may be necessary, and is allowable in the circumstances described in D-V, 5. The Office explained that a reworded reference may be considered (e.g. "See D-V, 5 for allowable amendments to the description."). There were no further comments from the SACEPO WP/G members.
140	**H**	**II**	**3.2**	No redrafting of the dependent claims is allowed unless necessitated by an amendment allowed by R.80, thus dealt with in section 3.1.	Delete the word "comprehensive" in (b): 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: (b) ~~comprehensive~~ redrafting of the dependent claims;	The Office did not agree to the proposal. Even though the term "redrafting" implies that the amendments concerned are extensive, the Office prefers to keep the explicit term "comprehensive" for the sake of clarity. The present section exemplifies scenarios where amendments not related to the grounds for opposition (e.g. clarifications) or corrections may be allowed. There were no further comments from the SACEPO WP/G members.
141	**H**	**II**	**3.4**	The reference to T 127/85, Headnote, and T 406/86, Headnote 1, appears misplaced. It does not relate to *insistence* on inadmissible amendments but on inadmissibility of certain amendments.	Move the reference to T 127/85, Headnote, and T 406/86, Headnote 1 to H-II, 3.2.	The Office agreed to delete the references. There were no further comments from the SACEPO WP/G members.
142	**H**	**II**	**5**	Since these amendments may be made only in examination proceedings and preferably, in reply to the search opinion, this section should move as H-II, 2.3.2.	Move the whole section as H-II, 2.3.2.	The Office did not agree to the proposal. H-II, 5 should not be moved to a new section H-II, 2.3.2 because H-II, 2.3

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						relates to amendments after receipt of the first communication. There were no further comments from the SACEPO WP/G members.
143	**H**	**II**	**6.4.1**	The title is incorrect, contradicting the content: *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 search under R.164(2)(a) could be confused with a supplementary search. It would appear preferable to amend the title and text to reflect the wording of R.164(2).	Amend the title and text to read: "Where the supplementary European search report is dispensed with"	The Office agreed to improve the clarity of sections 6.4.1 and 6.4.2 by adding "European" in the title. There were no further comments from the SACEPO WP/G members.
144	**H**	**III**	**2.1**	The last paragraph gives the impression that the basis of an amendment can be indicated in the application as filed instead of the translation.	Amend the last sentence to read: "Consequently, in order to comply with Rule 137(4) the basis of an amendment must be indicated in the translation of the application as filed."	The Office agreed to the proposal. There were no further comments from the SACEPO WP/G members.
145	**H**	**III**	**2.1.2**	**Comment 155 of the SACEPO WP/G meeting on 10.10.2023** H-III, 2.1.2, second and last § Why not explain here that the R112 notification must indicate clear reason ?		The Office explained that communication under Rule 112 already indicates the reasons why the application is deemed to be withdrawn by referring to the applicable legal basis There were no further comments from the SACEPO WP/G members.
146	**H**	**III**	**2.1.3**	**Comment 156 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-III, 2.1.3, first § Unreasonable: the OD must request the basis extemporaneously.		The Office did not agree with the comment. It is not clear what is found unreasonable in H-III, 2.1.3. Assuming that "OD" is the abbreviation for "opposition division", the Office noted that Rule 137(4) EPC refers to the

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						applicant and the examining division, i.e. it is not applicable in opposition proceedings. There were no further comments from the SACEPO WP/G members.
147	**H**	**III**	**2.1.3**	The reference to R.116(2) appears incorrect.	Amend to refer to R.116(1)	The Office explained that Rule 116(1) fixes the final date for making submission, whereas Rule 116(2) refers to the invitation ("invited to submit"). There were no further comments from the SACEPO WP/G members.
148	**H**	**III**	**2.1.4**	**Comment 157 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-III, 2.1.4 Isn't it time to delete H-III, 2.1.4?		See #136 above. There were no further comments from the SACEPO WP/G members.
149	**H**	**III**	**2.2**	**Comment 158 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-III, 2.2 EXCELLENT, but should be adapted to OP by ViCo = delete "handwritten".		The Office did not agree to the proposal. H-III, 2.2 applies to amendments in general and the reference to oral proceedings is not limited to in-person oral proceedings. It is not apparent why the reference to handwritten amendments should be deleted as long as this option is still available. There were no further comments from the SACEPO WP/G members.
150	**H**	**III**	**2.2**	Text was deleted from E-III, 8.7.3, which should be inserted in this section. The title should be amended accordingly.	Amend title to read: "Amendment by submitting missing documents or by filing replacement pages or paragraphs" Insert: "The preferred way to amend the description during oral	The Office did not agree to the proposal. The deleted text in E-III, 8.7.3 has been moved to D-IV, 5.3 (of the Guidelines 2024), i.e. the part dealing with opposition. H-III, 2.2 deals with

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					proceedings in opposition is by submitting amended paragraphs replacing specific numbered paragraphs of the B-publication of the patent. This allows the opposition division and the opponents to verify the amendments efficiently. It is not necessary to supply entire amended pages."	amendments in general and is therefore not considered to be the appropriate section for the text. There were no further comments from the SACEPO WP/G members.
151	**H**	**III**	**2.3**	**Comment 159 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-III, 2.3, second § Looks complicated in practice Why not say that this is used only for discussion purposes, and that amended § are to be submitted.		The Office agreed to review this section. There were no further comments from the SACEPO WP/G members.
152	**H**	**III**	**3.3.5**	**Comment 160 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-III, 3.3.5 Specify the procedure during ex parte OP.		The Office did not agree to the proposal. Information on this procedure is already available in Part E-III, 8.11 and 9. There were no further comments from the SACEPO WP/G members.
153	**H**	**III**	**4**	In the case discussed in H-III, 4.3, there may be two applicants for different CS. It should be checked that each is free to select any set of claims or only one that it has filed.	Amend to read: "the applicant (or each applicant, as the case may be)"	Referring to the General Part of the Guidelines, the Office explained that the Guidelines cannot cover all possible eventualities and exceptions in every detail, but must be regarded as general instructions. There were no further comments from the SACEPO WP/G members.
154	**H**	**IV**	**4.1.2**		It is suggested to maintain the removed second paragraph as the	The Office did not agree to the proposal.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					reasons for removal of this paragraph is not clear and does not seem directly supported by recent case law for the Boards of Appeal.	H-IV, 4.1.2 has been amended to clarify the standards for assessing the requirements of Rule 137(5) EPC, first sentence. The reference to B-III, 3 and F-V, 3 indicates that the same criteria are used as for carrying out the search and for assessing unity under Article 82. Concrete examples are discussed in each of these sections. H-IV, 4.1.2 has been amended on and in line with user requests and one of the purposes was to emphasise that there are no separate (i.e. deviating from B-III, 3 and F-V, 3) standards for assessing Rule 137(5) EPC. There were no further comments from the SACEPO WP/G members.
155	**H**	**IV**	**4.4**	In §2, it seems a copy of the prior national right must always be provided, even though it will nearly always be available to the examiner. After all, the applicant or proprietor must provide evidence.	Delete "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."	The Office explained that there may be circumstances where the examiner does not already have access to the relevant copies of national prior rights, which is why the Guidelines should remain unchanged on this point. There were no further comments from the SACEPO WP/G members.
156	**H**	**III**	**4.4**	**Comment 161 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-III, 4.4, sixth § A reference to H-III, 4.1 should be preferred (much better than this §)		The Office did not agree to the proposal. H-III, 4.4 relates to the specific situation of national rights of earlier date, whereas H-III, 4.1 describes the general procedure and contains a reference to H-III, 4.4. Replacing the sixth paragraph of H-III, 4.4 with a reference to H-III, 4.1 would lead to a

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						circular reference and therefore does not appear to be appropriate. There were no further comments from the SACEPO WP/G members.
157	**H**	**III**	**5**	**Comment 162 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-III, 5 Mentioning claims fees after opposition gives the wrong impression. Maybe add that claims fees are last due in response to 71(3).		The Office explained that the calculation of claims fees is relevant for both different texts and auxiliary requests. The place of H-III, 5 is appropriate therefore considered appropriate. There were no further comments from the SACEPO WP/G members.
158	**H**	**IV**	**2.3.3**	The last sentence should be clarified.	Clarify last sentence, in particular what is "the subject-matter in question".	The Office explained that the expression "subject-matter in question" was considered clear from the contents of the section. There were no further comments from the SACEPO WP/G members.
159	**H**	**IV**	**2.3.4**	**Comment 164 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-IV, 2.3.4 This is unclear.	"normally" should be clarified (the WO publication is used, unless ...).	The Office did not agree to the proposal. The publication of the international application is under the responsibility of WIPO and its content is determined by Article 21 PCT and Rule 48 PCT. Under certain circumstances the international publication may include parts not originally filed (e.g. claims amended under Article 19 PCT) and omit parts that were originally filed (e.g. under Rule 48.2(l) PCT). The EPC Guidelines are not the appropriate place to discuss details of

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
						the process of the publication of the international application. There were no further comments from the SACEPO WP/G members.
160	**H**	**IV**	**3.6**	**Comment 165 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)** H-IV, 3.6 For clarity, this example should refer to a claim, not a patent, then state that if a patent only contains such claims, then it is inevitably revoked.		The Office explained that the paragraph correctly differentiated between the patent and its claims. There were no further comments from the SACEPO WP/G members.
161	**H**	**IV**	**5.3**	The passage "Opposition is not an opportunity to re-examine the whole patent" does not appear to correctly reflect what is meant.	Amend.	The Office did not agree to the proposal. The Office argued that it is not clear from the comment what is not "correctly reflect[ed]" and how the text should be amended. One of the SACEPO WP/G members suggested replacing "re-examine the whole patent" with "re-open examination". The Office does not see a need to change the wording, as similar wording is used in H-IV, 5.4 and in the Case Law of the Boards of Appeal of the European Patent Office, 10th edition, July 2022, V.A.2.4.2d)(iii), penultimate paragraph. Furthermore, the Office is not aware of any situations where the wording has caused misunderstandings. There were no further comments from the other SACEPO WP/G members.
162	**H**	**IV**	**5.3**	H-IV, 5.3, second §		The Office explained that it is only if amendments are introduced into the

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
				The first sentence appears incorrect, in the sense that it appears to consider that opposition always involves amendments.		patent that these amendments have to be examined for compliance with the EPC as a whole. There were no further comments from the SACEPO WP/G members.
163	**H**	**IV**	**5.6**	**Comment 166 of the SACEPO WP/G meeting on 10.10.2023** H-IV, 5.6, second § The first sentence appears incorrect, in the sense that it appears to consider that opposition always involves amendments.		See #162 above. There were no further comments from the SACEPO WP/G members.
164	**H**	**V**	**4.1**	The citation of T170/87 is inappropriate in this section entitled "Disclaimer disclosed in the application as originally filed", in the sense that the decision decided that the disclaimer was not disclosed. The citation of T365/88 does not appear useful.	Delete the reference to T170/87 and T365/88.	The Office agreed to the proposal. There were no further comments from the SACEPO WP/G members.
165	**H**	**V**	**4.2.1**	If Art 54(4) EPC1973 is retained in H-III, 4.2, then it should also be retained here as it was in the original G1/03.	Amend to specify "and Art 54(4) EPC1973 if still transitionally applicable, see ….".	See #153 above. There were no further comments from the SACEPO WP/G members.
166	**H**	**V**	**8**	The same applies to translations of the title in the other official languages of the EPO.	Amend to read: "… to accept or not any request from the applicant for a change in the title or its translations (see…)"	The Office suggested amending H-V, 8 in line with A-III, 7.2, where it is stated that the title in the three official languages is approved by the division. There were no further comments from the SACEPO WP/G members.
167	**H**	**V**	**8**	It should be clarified that since the title is not part of the documents to be approved by an applicant before a patent can be granted, a reasoned request to amend/correct the title or its translations does not trigger the issuance of a new communication under R71(3).	Amend the last sentence of §1 to read: "Furthermore, the title is not part of the documents to be approved by an applicant before a patent can be granted, thus a reasoned request to amend or correct the title or its translations does not trigger the	The Office did not agree to the proposal. The procedure for replying to the communication pursuant to Rule 71(3) EPC is explained in C-V, 4. The Office also referred to its reply to #53 above.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					issuance of a new communication under R71(3)."	There were no further comments from the SACEPO WP/G members.
168	**H**	**VI**	**2.2**	**Comment 167 of the SACEPO WP/G meeting on 10.10.2023 (repeated in new comments)**	**GL/EPO H-VI, 2.2, Allowability Rule 139 (general)** It is proposed to add the principles developed by the Boards of Appeal, in particular the Legal Board of Appeal, as phrased in G 1/12, r.37, to H-VI, 2.2: Principles for allowability of correction under Rule 139 EPC as developed by the Boards of Appeal, in particular the Legal Board of Appeal, are (G 1/12, J 8/80): a) the correction introduces what was originally intended. Possibility of correction cannot be used to enable a person to give effect to a change of mind or development of plans (J 8/80, J 6/91). It is the party's actual rather than ostensible intention which must be considered; b) where the original intention is not immediately apparent, the requester bears the burden of proof, which must be a heavy one; c) the error to be remedied may be an incorrect statement or an omission; and d) the request for correction must be filed without delay. As a rule, criteria (a) to (d) are to be assessed in the order (c), (a), if applicable, together with (b), and (d) (T 1678/21). Further, it includes balancing of the public interest in legal certainty with	The Office agreed to review the section. There were no further comments from the SACEPO WP/G members.

#	Part	Chapt.	Section	Comment	Suggested improvement	Consultation results
					the interest of the party requesting correction, with the factors (i.e. sub-criteria of this criterion) relevant to the specific case (T 1678/21), such as the time limitations described in H-VI, 2.1 (i)-(ii)	