



**GUIDELINES FOR EXAMINATION  
IN THE  
EUROPEAN PATENT OFFICE**

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(ii) Summary table of updates:

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- (iii) Amended or new text (as compared to the latest previous version only) is highlighted by a vertical line in the right-hand margin. Mere deletions are indicated by two horizontal lines in the right-hand margin.
- (iv) The following notices relating to the current complete version of the Guidelines have been published in the Official Journal of the European Patent Office:
  - Re July 1999 amendments: OJ 7/1999, 510 - 522;
  - Re June 2000 amendments: OJ 5/2000, 228 - 234;
  - Re February 2001 amendments: OJ 2/2001, 115 - 116;
  - Re October 2001 amendments: OJ 10/2001, 464 - 465.
- (v) Usually, updates only involve amendments to specific sentences or passages on individual pages, in order to bring at least part of the text more closely into line with patent law and EPO practice as these continue to evolve. It follows that no update can ever claim to be complete.

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## Preliminary Remarks

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

These Guidelines will be updated at regular intervals to take account of developments in European patent law and practice.

## Explanatory Note

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

Part A Guidelines for Formalities Examination

Part B Guidelines for the Search

Part C Guidelines for Substantive Examination

Part D Guidelines for Opposition Procedure

Part E Guidelines on General Procedural matters

Parts A and C deal with the requirements and procedure for the formalities and the substantive examination respectively, regardless of the stage in the procedure. Thus in particular Part A covers the formalities examination in the grant and opposition procedures.

Part E deals with procedural matters which are relevant to several or all of the stages in procedure at the EPO.

It will be noted that in each Part of the Guidelines the text has been divided into Chapters, each sub-divided into numbered Sections which are further sub-divided into paragraphs. Cross-references to other paragraphs within the same Part are in a standard form quoting in each case the Chapter, Section and paragraph number (thus e.g., III, 6.5 means paragraph 6.5 in Section 6 of Chapter III). Cross-references to another Part of the Guidelines include also the reference letter of that Part (thus e.g. C-III, 6.5 would be used if it were desired to refer to paragraph 6.5 of Chapter III of Part C in, say, Part A).

Marginal references indicate the Article or Rule of the European Patent Convention which provides authority for what is stated. It is believed that such references avoid the need for extensive quotation from the Convention itself, but where the Convention or the Implementing Regulations have been directly quoted this has been indicated by the use of quotation marks.

In the Guidelines to follow "European Patent Office" will be abbreviated to "EPO" and "Official Journal of the EPO" to "OJ". The reference to Articles and Rules - and their paragraphs - of the EPC will be as follows: "Article 123, paragraph 2" will be: "Art. 123(2)", "Rule 29, paragraph 7" will be: "Rule 29(7)". Decisions will only be referred to with their capital letter, their number and the number and page of the Official Journal they were published in, e.g. "T 152/82, OJ 7/1984, 301".

## GENERAL INTRODUCTION

### 1. General Remarks

1.1 These Guidelines give instructions as to the practice and procedure to be followed in the various aspects of the examination of European applications and patents in accordance with the European Patent Convention and its Implementing Regulations (see 3). They are addressed primarily to the staff in the EPO but it is hoped that they will also be of assistance to the parties to the proceedings and patent practitioners since the success of the European patent system depends on the good cooperation between the parties and their representatives on the one hand and the Office on the other.

1.2 The Guidelines are intended to cover normal occurrences. They should therefore be considered only as general instructions. The application of the Guidelines to individual European patent applications or patents is the responsibility of the examining staff and they may depart from these instructions in exceptional cases. Nevertheless, the parties can expect the Office to act as a general rule in accordance with the Guidelines until such time as they are revised. It should be noted also that the Guidelines do not constitute legal provisions. For the ultimate authority on practice in the EPO, it is necessary to refer firstly to the European Patent Convention itself including the Implementing Regulations and the Rules relating to Fees, and secondly to the interpretation put upon the Convention by the Boards of Appeal and the Enlarged Board of Appeal.

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

1.4 As well as ordinary European applications the EPO deals with international applications filed under the Patent Cooperation Treaty (PCT). The Guidelines explain the differences in procedure involved in dealing with such international applications. It is important to note that Art. 150 of the Convention states that in case of conflict between the PCT and the Convention, the provisions of the PCT prevail.

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

1.6 These Guidelines do not deal with the Community Patent Convention.

### 2. Work in the EPO

2.1 The setting up of the EPO represent a major step forward in the history of patents. Its reputation depends on all employees, regardless of nationality, working harmoniously together and giving of their best. But it is on the search and examination, more than anything else, that the EPO will be judged by the patent world.

2.2 Employees of the EPO work with colleagues who not only speak a different language but also come from a different patent background with different training. Some may also have had experience in their national patent office. It is important therefore to remember that all employees in the EPO are working



under a common system as laid down in the European Patent Convention. They should all apply the same standard and in some instances this will mean abandoning previous habits and ways of thought. This is particularly important for examiners working on the substantive examination and oppositions.

2.3 It is also important that the various departments of the Office and various staff in the same department should not attempt to duplicate one another's efforts. For example, the substantive examiner should not attempt to check the formalities work performed by the Receiving Section or to duplicate the search work performed by his colleague in the Search Division. One of the purposes of the Guidelines is to make clear where the demarcations of responsibility lie.

2.4 It should not be forgotten that the reputation of the EPO will depend not only on quality but also on the speed with which it deals with its work. The Convention imposes various time limits on the parties. Generally speaking there are no corresponding time limits imposed on the Office, but the European patent system will be judged a success only if examiners and other employees also operate with reasonable expedition.

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

### **3. Survey of the processing of an application and patent in the EPO**

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

- (i) the application, designating one or more Contracting States, is filed with a competent national authority or the EPO;
- (ii) the application, where filed with a national authority or the EPO in Munich or Berlin, is transmitted to the Hague branch of the EPO;
- (iii) the Receiving Section examines the application to determine if a date of filing can be accorded to the application;
- (iv) the Receiving Section completes the examination on filing by checking that the filing and search fees and, where relevant, a translation of the application, have been filed within the appropriate time limits;
- (v) the formal examination of the application is undertaken by the Receiving Section;
- (vi) in parallel with the formal examination the Search Division draws up a search report a copy of which is forwarded to the applicant;
- (vii) the application and the search report are published by the EPO either together or separately;
- (viii) on receipt of a request from the applicant, or, if the request has been filed before the search report has been transmitted to the applicant, on confirmation by the applicant that he desires to proceed further with the European patent application, the application is subjected to a substantive and, if necessary, a formal examination by the Examining Division;

#### IV

(ix) provided the requirements of the Convention are met a European patent is granted for the States designated;

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

(xi) any person may give notice of opposition to the European patent granted; after examining the opposition, the Opposition Division decides whether to reject the opposition, maintain the patent as amended, or revoke the patent;

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

3.2 Any decisions of departments of the EPO are subject to review before a Board of Appeal of the EPO. With the exception of matters of importance to the question of interlocutory revision, the appeals procedure is not dealt with in these Guidelines.

#### 4. Contracting States of the EPC

The following states are Contracting States of the EPC (date of effect of the ratification in brackets):

Austria	(1 May 1979)
Belgium	(7 October 1977)
Cyprus	(1 April 1998)
Denmark <sup>1</sup>	(1 January 1990)
Finland	(1 March 1996)
France <sup>2</sup>	(7 October 1977)
Germany	(7 October 1977)
Greece	(1 October 1986)
Ireland	(1 August 1992)
Italy	(1 December 1978)
Liechtenstein	(1 April 1980)
Luxembourg	(7 October 1977)
Monaco	(1 December 1991)
Netherlands <sup>3</sup>	(7 October 1977)
Portugal	(1 January 1992)
Spain	(1 October 1986)
Sweden	(1 May 1978)
Switzerland	(7 October 1977)
United Kingdom <sup>4</sup>	(7 October 1977)

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\* An up-to-date list of the Contracting States of the EPC is published each year in Number 4 of the Official Journal EPO.

<sup>1</sup> The EPC does not apply to Greenland and the Faroe Islands.

<sup>2</sup> The EPC also applies to the French territorial entity of Mayotte and the overseas territories.

<sup>3</sup> The EPC is not applicable to the territory of the Netherlands Antilles and Aruba.

<sup>4</sup> The EPC is also applicable to the Isle of Man. For further information on the registration of European patents, designating the United Kingdom, in overseas states and territories, see OJ 9/1997, 433.

**5. Extension to states not party to the EPC**

The following states are states to which European patent applications (direct or Euro-PCT) and thus patents can be extended (date of effect of the respective agreement with the EPO in brackets):

Slovenia	(1 March 1994)
Lithuania	(5 July 1994)
Latvia	(1 May 1995)
Albania	(1 February 1996)
Romania	(15 October 1996)
former Yugoslav Republic of Macedonia	(1 November 1997)



**PART A**

**GUIDELINES FOR FORMALITIES EXAMINATION**



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**CHAPTER I**

## INTRODUCTION

1. This part of the Guidelines deals with the following:

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

(ii) the modification to the requirements and procedure of (i) when dealing with international applications filed under the PCT (Chapter VII);

(iii) formalities matters of a more general nature which can arise at the application or the post-grant stage (Chapters VIII and IX),

(iv) the presentation and execution of drawings and figurative representations accompanying a European patent application (Chapter X);

(v) fee questions (Chapter XI);

(vi) inspection of files and communication of information contained in files (Chapter XII).

2.2. The matters covered by this Part are directed to the formalities staff of the EPO whether they be in The Hague or Munich. They are however directed primarily to the Receiving Section which is specifically responsible under the Convention for ensuring that the formal requirements for European patent applications are adhered to. Once the application is transferred to the Examining Division it accepts responsibility for the formalities of the application although it should be understood that reference to the Examining Division is intended to cover the formalities officer to which this work is entrusted.

3. The formalities staff should note that this Part of the Guidelines is intended to provide them with the knowledge and background which it is felt will assist them in carrying out their functions in a uniform and expeditious manner. It does not however provide authority for ignoring the provisions of the Convention and Implementing Regulations and in that regard specific attention is directed to paragraph 1.2 of the General Introduction to the Guidelines.

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

**CHAPTER II****FILING OF APPLICATIONS AND EXAMINATION ON FILING****1. Where and how applications may be filed**Art. 75(1)  
Rule 24(1)

1.1 European patent applications may be filed in writing, by hand or by post, at the EPO's filing offices in Munich, The Hague or Berlin. The EPO's sub-office in Vienna is not a filing office.

The opening hours of the filing offices of the EPO have been published in OJ 12/1994, 954. Dates on which at least one of the filing offices of the EPO is not open to receive documents are likewise announced at regular intervals in its Official Journal (see also E-VIII, 1.4).

The EPO filing offices in Berlin and Munich are equipped with automated mail-boxes, which may be used at any time. The automated mail-box facility is not currently available at the filing office at The Hague. Outside office hours documents may be handed in to the porter.

European patent applications may also be filed (with the exception referred to in IV, 1.3.1) at the central industrial property office or other competent authority of a Contracting State if the national law of that State so allows (see 1.2 below).

**1.1.1 Filing of applications by facsimile**

Applications may also be filed by **facsimile** with the filing offices of the EPO and with the competent national authorities of those Contracting States which so permit. This is at present the case with the Belgian Office de la propriété industrielle, the United Kingdom Patent Office, the Danish Patentdirektoratet, the Direction de l'Expansion Economique of Monaco, the German Patent- und Markenamt, the French Institut national de la propriété industrielle, the Cypriot Department of the Registrar of Companies and Official Receiver, the Austrian Patentamt, the Swedish Patent- och registreringsverket, the Irish Patents Office, the Portuguese Instituto Nacional da Propriedade Industrial, the Finnish Patentti- ja rekisterihallitus and the Swiss Eidgenössisches Institut für Geistiges Eigentum. Where a document transmitted using such technical means is illegible or incomplete, the document is to be treated as not having been received to the extent that it is illegible or that the attempted transmission failed and the sender must be notified as soon as possible (see Decision of the President of the EPO OJ 6/1992, 299). If a European patent application is filed by facsimile the hard-copy application documents (in three copies and complying with the Rules) and the duly signed Request for Grant (EPO Form 1001) should be forwarded

simultaneously, failing which the EPO will invite the applicant to supply such documents within a non-extendable period of one month. If the applicant fails to comply with this invitation in due time, the European patent application will be refused. To prevent duplication of files applicants are asked to indicate on the hard-copy documents the application number or facsimile date and the name of the authority with which the documents were filed and to make it clear that these documents represent "confirmation of an application filed by facsimile".

#### 1.1.2 Filing of applications by other means

European patent applications may also be filed on **diskette** accompanied by a paper print-out, provided they have been prepared by means of the EP-EASY software (see Notice from the President of the EPO OJ 8/1997, 377). These applications may only be filed with the filing offices of the EPO and with the Belgian Office de la propriété industrielle, the Finnish Patentti- ja rekisterihallitus, the French Institut national de la propriété industrielle, the Swedish Patent- och registreringsverket, the Swiss Eidgenössisches Institut für Geistiges Eigentum and the United Kingdom Patent Office.

The application is to be filed together with EPO Form 1001E, which is a paper print-out generated by the EP-EASY software after completion of the application in electronic form on the applicant's personal computer. Form 1001E is to be duly signed by the applicant or his representative and is to be accompanied by one paper copy of the technical documents, i.e. the description, the claims and any drawings referred to in the description or the claims, and preferably also of the abstract.

The paper documents mentioned must be accompanied by a diskette containing at least the request for grant, the description and the claims corresponding to the paper documents in the prescribed electronic format, and by a conformity statement. The conformity statement is generated as a paper print-out by the EP-EASY software and contains confirmation that the contents of the diskette are identical to the paper copy referred to above. The conformity statement is to be duly signed by the applicant or representative.

EPO Form 1001E and the paper copy of the technical documents accompanying this form will constitute the authentic version of the application. The date of receipt of these documents will be the date of filing of the application.

Other means of filing European patent applications, e.g. by **telex** or **e-mail**, are at present not allowed.

## 1.1.3 Subsequent filing of documents

For the subsequent filing of documents, see IX, 2.5.

## 1.1.4 Accompanying documents

Point 6.9 ADA  
Point 6.10 ADA  
Point 6.2 ADA

Cheques may accompany only those European patent applications filed with the EPO; the national authorities competent to receive European patent applications do not accept cash or cheques but do accept debit orders for deposit accounts. To avoid the risk of payment being debited twice, where a debit order is sent by facsimile the original should not be filed subsequently (cf. points 6.2, 6.9 and 6.10 of the Arrangements for deposit accounts, Supplement to OJ 2/1999, 7).

Art. 77

1.2 The central industrial property office of a Contracting State is obliged to forward to the EPO, in the shortest time compatible with national law concerning the secrecy of inventions, applications filed and documents subsequently filed (see II, 3.3) with that office or with other competent authorities in that State (for cheque and debit order enclosures, see 1.1.4).

The place of filing is indicated by the third and fourth digits (from left to right) of the application number allocated:

- 01 Munich, EPO
- 02 The Hague, EPO (branch)
- 25 Berlin, EPO (sub-office)
- 03 Newport and London, The Patent Office
- 39 Toulouse, INPI (regional office)
- 40 Paris, Institut national de la propriété industrielle (INPI)
- 41 Grenoble, INPI (regional office)
- 42 Lyon, INPI (regional office)
- 43 Marseille, INPI (regional office)
- 44 Strasbourg, INPI (regional office)
- 45 Bordeaux, INPI (regional office)
- 46 Rennes, INPI (regional office)
- 47 Nancy, INPI (regional office)
- 48 Nice, INPI (regional office)
- 49 Lille, INPI (regional office)
- 50 Madrid, Oficina Española de Patentes y Marcas
- 51 Barcelona (Autonomous Community Catalonia)
- 52 Seville (Autonomous Community Andalusia)
- 53 Tenerife (Autonomous Community Canary Islands)
- 54 Santiago de Compostela (Autonomous Community Galicia)
- 55 Pamplona (Autonomous Community Navarra)
- 56 Valencia (Autonomous Community Valencia)
- 57 Vitoria (Autonomous Community Basque Country)
- 60 Athens, Organismos Biomichanikis Idioktisias (OBI)
- 61 Taastrup, Patentdirektoratet
- 62 Nicosia, Department of the Registrar of Companies and Official Receiver

- 63 Luxembourg, Service de la propriété intellectuelle (Ministère de l'économie)
- 64 Monaco, Direction de l'Expansion Economique
- 65 Kilkenny and Dublin, The Patents Office
- 66 Helsinki, Patentii- ja rekisterihallitus
- 67 Lisbon, Instituto Nacional da Propriedade Industrial (INPI)
- 71 Munich, Deutsches Patent- und Markenamt (DPMA)
- 72 Jena, DPMA (Dienststelle Jena)
- 73 Berlin, Technisches Informationszentrum
- 81 Berne, Eidgenössisches Institut für Geistiges Eigentum
- 83 Rome, Ufficio Italiano Brevetti e Marchi
- 85 Stockholm, Patent- och registreringsverket
- 87 Brussels, Office de la propriété industrielle (Ministère des affaires économiques)
- 89 Vienna, Österreichisches Patentamt

Applications under the Patent Cooperation Treaty (PCT), in short "international applications", which designate the EPO, receive the digit "9" in third place.

Art.77(5)  
Art. 135(1)(a)

A time limit of six weeks after filing is specified for the onward transmission to the EPO of applications the subject-matter of which is obviously not liable to secrecy, this time limit being extended to four months or, where priority has been claimed, to fourteen months after the date of priority, for applications which require further examination as to their liability to secrecy. It should be noted however that an application received outside the specified time limits, either six weeks or four months, must be processed provided the application is received in Munich, The Hague or Berlin before the end of the fourteenth month after filing or, where appropriate, after the date of priority. Applications received outside this last mentioned time limit are deemed to be withdrawn. Re-establishment of rights in respect of the period under Art. 77(5) is not possible (see J 03/80, OJ 4/ 1980, 92), but a request for conversion under Art. 135 (1)(a) may be filed (see IV, 6).

If the time limit referred to in Art. 77(5) expires on a day on which there is an interruption or subsequent dislocation in the delivery of mail within the meaning of Rule 85(2), the time limit will extend to the first day following the end of the period of interruption or dislocation.

## 2. Persons entitled to file an application

Art. 58

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

Art. 60(3)

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

Art. 59  
Art. 118

2.2 The application may be in the name of one person or several persons may be named as joint applicants. The application may also be filed by two or more applicants designating different Contracting States. It may arise that a first applicant designates one group of Contracting States and a second designates a different group of Contracting States, while both applicants jointly designate a third group of Contracting States. If the applicants for a patent are not the same for different Contracting States they will be regarded as joint applicants in proceedings before the EPO (see III, 12.1 as to when and under what circumstances the matter dealt with in this paragraph need be considered).

Art. 61(1)

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

### 3. Procedure on filing

Rule 24(2)

3.1 The authority with which the application is filed - either the EPO (Munich, The Hague or Berlin) or the competent national authority - must mark the documents making up the application with the date of receipt and issue a receipt to the applicant (for the date of receipt of applications received by facsimile see the Notice from the EPO, OJ 6/1992, 306, point 5.1). The date of receipt should be so applied as not to obliterate any part of the documents or make them unsuitable for direct reproduction. The receipt must be issued without delay and include at least the application number, the nature and number of the documents and the date of their receipt. The receipt should also include the applicant's or representative's file reference number or any other information which would be helpful in identifying the applicant. On request, the Office also provides confirmation by telex or facsimile of the receipt of documents filed with it (see OJ 6/1992, 310). To ensure despatch of the receipt immediately after the documents are received:

- the request for the issue of a receipt by telex or facsimile must be transmitted at the same time as the documents filed;
- the postal, telex or fax address to which the receipt is to be sent must be stated;
- evidence of the payment of the prescribed administrative fee or a debit order must be enclosed.

The amount of the administrative fee is indicated in each Official Journal.

Rule 24(3)

3.2 If the application is filed with a competent national authority, that authority must "without delay inform the



EPO of receipt of the documents making up the application" and indicate "the nature and date of receipt of the documents, the application number and any priority date claimed". It is recommended that the competent national authority should indicate as well the applicant's or representative's reference number where such has been indicated.

Rule 24(4) 3.3 When the EPO has received an application which has been forwarded by the central industrial property office of a Contracting State, it notifies the applicant, indicating the date of receipt at the EPO (see OJ 7/1990, 306). Once this communication has been received, all further documents relating to the application must be sent directly to the EPO.

Art. 77(5)  
Rule 69(1)  
Rule 31(2) 3.4 Where an application is not received at the EPO from the central industrial property office of a Contracting State before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority and is consequently deemed to be withdrawn (see II. 1.2), the applicant must be notified accordingly; all fees must be refunded.

#### 4. Examination on filing

Art. 90(1)(a) 4.1 The Receiving Section examines applications to determine whether they meet the minimum requirements for according a date of filing. These requirements are satisfied where the documents filed contain:

- Art. 80(a) (i) "an indication that a European patent is sought;
- Art. 80(b) (ii) the designation of at least one Contracting State;
- Art. 80(c) (iii) information identifying the applicant;
- Art. 80(d) (iv) a description and one or more claims"

in either English, French or German, or in a language which is an official language of a Contracting State as provided for in Art. 14(2) (see VIII, 3.1).

4.2 To be accorded a date of filing the documents referred to in II, 4.1 do not have to meet any particular requirements as to form or presentation. It is essential however that the documents be sufficiently legible to enable the information to be discerned.

4.3 Use of the prescribed Request for Grant form or the EP-EASY software best provides the indication that a patent is sought (see III, 4).

4.4 The applicant is sufficiently identified whenever it is possible to establish the identity of the applicant beyond reasonable doubt on the basis of all data contained in the documents filed (cf. J 25/86, OJ 11/1987, 475). Where

there is more than one applicant each applicant must be similarly identified. Objection should not be raised at this stage with regard to the status of the applicant or his entitlement to apply, or where, in the case of joint applicants, there is doubt as to the Contracting States designated by the individual applicants.

4.5 The contents of the description and claims do not require close scrutiny - it is sufficient to identify a document (or documents) which appears to include a description and one or more claims.

Art. 90(2)  
Rule 39

4.6 If the Receiving Section notes deficiencies preventing the application being accorded a date of filing, it communicates them to the applicant and invites him to remedy them within a non-extendable period of one month of notification of the communication. If the applicant does not remedy the deficiencies in due time he is informed that the application will not be dealt with as a European application. Any fees which have been paid are refunded.

4.7 The date of filing accorded to the application is the date the application meets the requirements of II, 4.1 and is either (i) the date of receipt at the EPO or competent national authority or (ii) the date, not later than the one month period referred to above, on which the applicant rectifies any deficiencies. In the latter case, the applicant is informed of the date of filing accorded to his application.

It should be noted that where drawings are filed later than the date of filing, re-dating of the application may be required (see III, 10).

Art. 90(1) (b)(c)

4.8 An application that has been accorded a date of filing is checked by the Receiving Section to ascertain if:

(i) "the filing fee and the search fee have been paid in due time" and

(ii) "in the case provided for in Art. 14(2), the translation of the European patent application in the language of the proceedings has been filed in due time".

Art. 78(2)

4.9 The filing and search fees must be paid to the EPO within one month after the filing of the application (normal period). Where the application does not at first satisfy the requirements for the accordance of a date of filing, "the filing of the application" means the date of filing.

Rule 85a(1)  
Art. 2, No. 3b,  
RFees  
Rule 6(3)

If the fees have not been paid within the normal period, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is also paid. As indicated in XI 9.2, the filing fee is reduced when the

language of the application is not an official language of the EPO.

Rule 6(1)

4.10 The translation in English, French or German must be filed within three months after the filing of the application (see II, 4.9), but no later than thirteen months after the earliest date of priority claimed (see VIII, 1.1).

Art. 90(3)  
Rule 69(1)

4.11 An application that does not meet the requirements of II, 4.8 is deemed to be withdrawn. If the application is deemed withdrawn because of non-payment of the filing fee and search fee, loss of rights ensues on expiry of the normal period (see J 04/86, OJ 4/1988, 119, which applies *mutatis mutandis*). The applicant is notified accordingly.

Art. 122(5)  
Art. 122

Art. 122(5) excludes re-establishment of rights in respect of the time limits under Art. 78(2) and Rule 85a (cf. 4.9) (see J 12/82, OJ 6/1983, 221). However, in the event of failure to observe the time limit under Rule 6(1), an application for re-establishment of rights is admissible (cf. 4.10).

Art. 91(1)  
Art. 92(1)

4.12 If the application is not deemed withdrawn in accordance with the previous paragraph, it is subject to a formal examination by the Receiving Section. At the same time a copy of the application (the "search sub-dossier") is referred to the Search Division to draw up the search report.

**CHAPTER III****EXAMINATION OF FORMALITIES REQUIREMENTS****1. General**

1.1 The formal requirements that an application has to meet and which are the subject of an examination by the Receiving Section are those specified in Art. 91(1) (a) to (g). These requirements relate to the following:

- (i) Representation
- (ii) Physical requirements of application
- (iii) Abstract
- (iv) Request for grant
- (v) Claim to priority
- (vi) Designation fees (see also C-VI, 1.5)
- (vii) Designation of inventor
- (viii) Filing of drawings

Rule 34  
Rule 31(1)  
Rule 23  
Art. 55(1)(b)  
Rule 28  
Rule 27a

1.2 In addition to the above, it is necessary for the Receiving Section to carry out a preliminary check of the description and claims in order to ensure that prohibited matter referred to in Rule 34 is omitted from the application as published and that the title of the invention, which will appear in the published application, is in general accord with the requirements of Rule 26(2)(b). The Receiving Section should also check whether any claims fees due have been paid, whether the certificate of exhibition under Rule 23 has been filed where the invention has been displayed under Art. 55(1)(b), whether in the case of European patent applications relating to biological material the information pursuant to Rule 28(1)(c) and (d) is complete (see also III, 9 and IV, 3 and 4) and whether in the case of an application with nucleotide and/or amino acid sequences a prescribed Sequence Listing has also been filed (see Decision of the President of the EPO, Supplement No. 2 to OJ 11/1998).

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

**2. Representation**

2.1 The formalities examiner must ensure that the requirements with regard to representation as set out in IX, 1 are met. The main points to be considered are:

(i) the necessity for applicants who have neither a residence nor principal place of business in a Contracting State to be represented by an authorised professional representative, or by an authorised legal practitioner fulfilling the requirements of Art. 134(7),

(ii) that, where an applicant who is resident in or has his principal place of business in a Contracting State is represented by an employee, the employee is authorised, and

(iii) that the authorisation, if any is required (see IX, 1.5 and the Decision of the President of the EPO, OJ 9/1991, 489), is in order, duly signed (see IX, 3.2 and 3.5) and is filed in due time.

2.2 The effect of non-compliance with the provisions with regard to representation and the action to be taken by the formalities examiner in dealing with any deficiency is considered in III, 14.

### 3. Physical requirements

Art. 91(1)(b)

3.1 Every application that is subject to formal examination is examined for compliance with the requirements as to form set out below (non-compliance with the requirements is considered in III, 14).

3.2 It is the responsibility of the Receiving Section to ensure that the documents making up the application, i.e. request, description, claims, drawings and abstract, meet the requirements of Rule 35(2) to (11) and (14) and, with regard to drawings, the requirements of Rule 32, to the extent necessary for the purpose of a reasonably uniform publication of the application under Art. 93(2). The Receiving Section should therefore not draw the attention of the applicant to any deficiencies under Rule 32(2)(i) or (j) or question whether tables included in the claims meet the requirements of Rule 35(11). In the event of deficiencies under Rule 27a, the Receiving Section shall invite the applicant to remedy them (Decision of the President of the EPO, Supplement No. 2 to OJ 11/1998; see also IV, 5).

Art. 94(1)  
Art. 96(2)  
Rule 35(1)  
Rule 36(1)

Once the application is transferred to it, the Examining Division assumes responsibility for formal matters, and should pay particular attention to the more technical requirements of Rule 32 and Rule 35 including particularly the above-mentioned requirements under Rule 32(2)(i) and (j) and Rule 35(11) and those laid down in Rule 35(12) and (13). The particular requirements for drawings are dealt with in Chapter X. With regard to the more technical requirements, such as those of Rule 32(2)(f) and (h), the Receiving Section should, in case of doubt, consult and take the advice of the Search Division. The Receiving Section should also consider taking action when the Search Division draws its attention to a deficiency which it had overlooked. It should be noted that, in accordance

with Rule 32(3), flow sheets and diagrams are to be considered as drawings. As indicated in IX, 2.2, replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) are subject to the same requirements as the documents making up the application.

3.3 The formalities examiner ensures that documents other than those referred to in III, 3.2 meet the requirements set out in IX, 2.3 and are filed in a sufficient number of copies (see IX, 2.4). Documents, with the exception of annexed documents, filed after filing the application must be signed by the applicant or his representative (see IX, 3).

#### **4. Request for grant**

Rule 26(1)

4.1 The request for grant shall be made on the appropriate EPO form, even though the request (the indication that a patent is sought, referred to in II, 4.3) need initially be in no particular form. Printed forms are available to applicants free of charge from the EPO or competent national authorities with which applications may be filed. The form is furthermore available via the EPO's Web site on the Internet and is also included in the EP-EASY software, which is obtainable free of charge from the branch of the EPO in The Hague or from the EPO's Web site.

Whenever a new version of the Request for Grant form is issued, it is published in the Official Journal of the EPO. It is recommended always to use the latest version.

4.2 The Receiving Section examines the request to ensure that it contains the information listed in Rule 26(2). The request form provides for the entry of that information. The petition for the grant (paragraph 2(a)) is an integral part of the form. The applicant must be allowed to correct deficiencies in the request to the extent indicated in III, 14.

4.3 The request must contain, in the manner specified in Rule 26(2)(c), the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Where the application is in the name of more than one applicant, the requirement must be satisfied for each applicant. At this stage in the proceedings the formalities examiner should have regard to the provisions of II, 2 governing the entitlement of the person named as applicant to apply for a patent.

Rule 26(2)(i)

4.4 The request must be signed by the applicant or his representative. If there is more than one applicant, each applicant or his representative must sign the request. For further details as to the signature of the request, see IX, 3.2, 3.3 and 3.5.

(The provisions of Rule 26(2) (b), (e), (f), (g) and (h) dealing respectively with Title of the Invention, Divisional Applications, Art. 61 Applications, Claim to Priority and Designation of Contracting States are considered under these headings in subsequent sections of this Chapter and in Chapter IV.)

### 5. Designation of inventor

Art. 81  
Rule 26(2)(k)

5.1 Every application must designate the inventor. The designation is filed in a separate document where the applicant is not the inventor or the sole inventor; otherwise the designation must be effected in the Request for Grant form by placing a cross in the appropriate box in Section 22. Where the designation is effected in a separate document, a trilingual form available free of charge from the EPO or the central industrial property offices of the Contracting States may be used.

Rule 18(3)  
Rule 92(1)(g)

The inventor designated by the applicant may address to the EPO a written renunciation of his title as inventor, in which case his name is not mentioned in the Register of European Patents (Rule 92(1)(g)) or in the published European patent application and European patent specification, always provided that the renunciation is received in time.

Rule 17(1)

5.2 Where the designation is filed in a separate document it must contain the family name, given names and full address (to meet the customary requirements for postal delivery) of the inventor, the statement, referred to in Art. 81, indicating the origin of the right to the patent and the signature of the applicant or his representative.

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

The designation of inventor must be signed by the applicant or his representative. With regard to the signature, the provisions set out in IX, 3.2, 3.3 and 3.5 apply.

Rule 17(2)

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

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

Rule 17(3)  
Rule 17(4)

5.3 If the applicant is not the inventor or is not the sole inventor, the Receiving Section must notify the inventor of the data contained in the document designating the inventor together with the data mentioned in Art. 128(5) relating to the application. It should be noted however that

neither the applicant nor the inventor may invoke either the omission of this notification or any errors contained in it.

The inventor is notified at his address as indicated by the applicant. If the notification is returned to the EPO because the inventor is not known at the address indicated or has moved to an unknown new address, the applicant is asked if he knows the inventor's new address. If the applicant gives a new address, the inventor is notified at that address. Otherwise no further attempt at notification is made.

No notification is made where the inventor addresses to the EPO a written renunciation of the notification under Rule 17(3) (cf. Notice of the EPO, OJ 5/1991, 266). The renunciation must be filed with the designation of inventor and contain the information to be supplied to the inventor by the EPO under Rule 17(3), i.e.:

- (i) the number and date of filing of the European patent application, if known,
- (ii) where the priority of an earlier application is claimed, the date and State of the earlier application, and its number, if known;
- (iii) the name of the applicant;
- (iv) the title of the invention;
- (v) the Contracting States designated in Section 32.1 of the Request for Grant form;
- (vi) the name(s) of any co-inventor(s).

5.4 When using the interactive form of the EP-EASY software for preparing the European patent application, all data concerning the inventor(s) can be entered. The waiver of notification (see 5.3 above) and the renunciation of his title as inventor (see 5.1 above) will be automatically generated by the software when the respective boxes have been clicked.

Art. 91(1)(f)  
Rule 42(1)  
Art. 91(5)  
Art. 121  
Art. 122

5.5 Where a designation is not filed, or where the designation filed contains a major deficiency (e.g. inventor's name or the signature of the applicant is missing) so that it cannot be considered as validly filed, the applicant is informed that the European patent application will be deemed to be withdrawn if the deficiency is not remedied within the period prescribed under Art. 91(5) or within a minimum period of two months as from notification of this communication, whichever period is the longer. If the deficiencies are not rectified in due time, the application is deemed to be withdrawn and the applicant is notified accordingly (as regards divisional applications, see IV, 1.5). Re-establishment of rights under Art. 122 is possible



on request (see E-VIII, 2). If the designation filed presents only minor deficiencies (e.g. inventor's address is missing), the applicant is invited to correct these within a time limit set by the EPO pursuant to Art. 91(2). If this is not corrected in due time, the application is refused (analogous to Art. 91(3)). Further processing of the application under Art. 121 or re-establishment of rights under Art. 122 is possible on request. Regarding the designation of inventor in divisional applications, see IV, 1.5.

Rule 19(1)

5.6 An incorrect designation may be rectified provided a request is received accompanied by the consent of the wrongly designated person and by the consent of the applicant for or the proprietor of the patent where the request is not filed by that party. If a further inventor is to be designated, the consent of the inventor(s) previously designated is not necessary (see J 08/82, OJ 4/1984, 155). The provisions of III, 5.2 and 5.3 apply to the corrected designation *mutatis mutandis*.

Rule 19(2)  
Rule 19(3)

5.7 Where an incorrect designation has been rectified in accordance with III, 5.6 and where the incorrect designation was entered in the Register of European Patents or published in the European Patent Bulletin such entry or publication must be corrected. These provisions apply as well to the cancellation of an incorrect designation.

## 6. Claim to priority

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

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

(i) the previous application was filed in or for a State recognised as giving rise to a priority right in accordance with the provisions of the European Patent Convention,

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

(iii) the European application is made during a period of twelve months from the date of filing of the first application, and

(iv) the European application is in respect of the same invention as the invention disclosed in the previous application (see also C-V, 1).

As concerns (i) above, the previous application may be an application for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate. However, a priority right based on the deposit of an industrial design is not recognised (see J 15/80, OJ 7/1981, 213).

## Art. 87(3)

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

As concerns (ii) above, the transfer of the application (or of the priority right as such) must have taken place before the filing date of the later European application and must be a transfer valid under the relevant national provisions. Proof of this transfer can be filed later.

In the case of joint applicants it is sufficient when one of the applicants is (the successor in title to) the applicant or the applicants who made the previous application. There is no need for a special transfer of the priority right to the other applicants, as this is already clear from the fact that the later European application has been filed jointly.

6.2 The recognised States, referred to at III, 6.1(i) above, are States party to the Paris Convention for the Protection of Industrial Property or States, not party to that Convention, which have made an agreement, as provided for in Art. 87(5) of the European Patent Convention, with the EPO (to date, no such agreements have been concluded). In view of the wording of Art. 87(1) which refers to filings "in or for any State party to the Paris Convention", priority may be claimed of an earlier first filed national application, European application or international application. A list of States in respect of which the filing is recognised as giving rise to a priority right is annexed to this Chapter. These are the Contracting States to the Paris Convention for the Protection of Industrial Property. The countries of the Union under the Paris Convention are listed in the WIPO publications "Industrial Property" and "La Propriété Industrielle" (each January issue) and the EPO's Official Journal. The WIPO publications are available from WIPO, 34, chemin des Colombettes, CH-1211 Geneva 20.

## Art. 88(2)

6.3 The applicant may claim more than one priority based on previous applications in the same or different States. Where multiple priorities are claimed time limits which are calculated from the priority date run from the earliest date of priority and as a result the European application must be made within twelve months from the earliest priority; this applies if earlier applications have been filed both in States that are parties to the Paris Convention and also in States that have concluded an agreement as provided for in Art. 87(5).

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

Art. 88(1)  
Rule 38(1)  
Rule 38(2)  
Rule 26(2)(g)  
Rule 88

6.5 An applicant wishing to claim priority must file a declaration of priority indicating the date of the previous application, the State in or for which it was filed and its file number. The date and State of the previous application must be stated in the request for grant at the time of filing the European patent application. The request for grant may be corrected under Rule 88, first sentence, if it contains errors regarding the date and State of the earlier application, provided that the request for correction is made sufficiently early for the correction to be contained in the publication of the application or at least for a warning to be included in the published application (see V, 3 and other sources therein). The file number of the previous application must be indicated before the end of the sixteenth month after the date of priority claimed; failure to do so constitutes a deficiency which the applicant is requested to rectify (under application *mutatis mutandis* of the principles of J 01/80, OJ 9/1980, 289).

Rule 41(3)  
Rule 84a  
Rule 85

6.6 Where the date of the first filing given on filing the European patent application precedes the date of filing of the European patent application by more than one year, the applicant must be informed by the Receiving Section that there shall be no priority for the application unless within a period of one month he indicates a corrected date lying within the year preceding the date of filing. Rules 84a and 85 apply to the priority period under Art. 87(1). In the event that the date indicated for the previous application is subsequent to or the same as the date of filing, the applicant should be allowed a period of one month for indicating a corrected date (with regard to the possibility of effecting correction of clerical or similar errors, see V, 3).

Rule 38(3)  
Art. 88(2)

6.7 A copy of the previous application for which priority is claimed (priority document) must be filed before the end of the sixteenth month after the date of priority. Failure to do so constitutes a deficiency which the applicant is requested to rectify (see J 01/80, OJ 9/1980, 289). Where multiple priorities are claimed, the above-mentioned time limit runs from the earliest date of priority.

The copy must be certified as an exact copy of the previous application by the authority which received the previous application and must be accompanied by a certificate issued by that authority stating the date of filing of the previous application (Rule 38(3), second sentence). The priority document submitted must be the original, i.e. contain the original of the certificate issued by the receiving authority. Rule 38(3), third sentence, together with the Decision of the President of the EPO dated 22 December 1998 (OJ 2/1999, 80) provide for the following exception to the requirement that a priority document be filed: if the previous application is:

- (i) a European patent application,
- (ii) an international application filed with the EPO as receiving Office under the PCT,
- (iii) a Japanese patent or utility model application or
- (iv) an international application filed with the Japanese Patent Office as receiving Office under the PCT,

the EPO shall include free of charge a copy of the previous application in the file of the European patent application. No request is necessary to this end.

Art. 88(1)  
Rule 38(4)

6.8 Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed within the time limit set by the EPO, but at the latest within the non-extendable time limit laid down in Rule 51(6). Alternatively a declaration that the European patent application is a complete translation of the previous application may be submitted within those same time limits (see also C-V, 3.2 and 3.3). The declaration may already be made by crossing the appropriate box in the Request for Grant form (Form 1001, Section 25a). This declaration is only valid if the text of the European application as filed is an exact translation of the text of the earlier application (description and claims) of which priority is claimed. If not, or if the European application contains more or less text than is contained in the earlier application as filed, such a declaration cannot be accepted and a complete translation must be filed. A merely different arrangement of the various elements (i.e. the claims vs. the description) of the application does not affect the validity of such a declaration.

6.9 A European patent application has no right to priority if

Art. 87(1)  
Rule 41(3)

(i) the application was not filed within a period referred to in III, 6.1(iii) or the applicant has failed to indicate, within the period referred to in III, 6.6, a corrected date of priority preceding by no more than one year the date of filing of the European application;

Art. 87(1)

(ii) the previous application did not seek an industrial property right giving rise to a priority right (see III, 6.1) or

Art. 87(1)(5)

(iii) the previous application does not give rise to a priority right in respect of the State in or for which it was filed (see III, 6.1(i) and 6.2).

Art. 91(3)

6.10 The right to priority for a European patent application is lost where

(i) the declaration of priority is not filed in due time (see III, 6.5) or

(ii) the copy of the previous application or of any translation of the previous application is not filed in due time (see III, 6.7, 6.8).

Rule 69(1)

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

### 7. Title of the invention

Rule 26(2)(b)

7.1 The request for grant must contain the title of the invention. A requirement of Rule 26(2)(b) is that the title must "clearly and concisely state the technical designation of the invention and shall exclude all fancy names." In this regard the Receiving Section should take the following into account:

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

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

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

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

Rule 26(2)(b)

7.2 The ultimate responsibility for ensuring that the title accords with the provisions of the Implementing Regulations rests with the Examining Division. The Receiving Section should nevertheless take action to avoid, if possible, the publication of applications having titles which are clearly non-informative or misleading. It is necessary therefore that the Receiving Section takes cognisance of the provisions of Rule 26(2)(b) as set out in III, 7.1. In the event of obvious non-compliance with the provisions, the Office will of its own motion change the title, if this appears necessary, without informing the applicant there and then. Only when the application is about to be published will the applicant be notified whether the title proposed by him has been changed (see OJ 4/1991, 224).

**8. Prohibited matter**

Art. 53(a)  
Rule 34(1)(a)  
Rule 34(2)

8.1 The application must not contain statements or other matter contrary to "ordre public" or morality. Such matter must be omitted when the application is published, the published application indicating the place and number of words or drawings omitted. (Where drawings are omitted regard should be had to the physical requirements of III, 3.2). It therefore falls to the Receiving Section to check the description, claims and drawings to ascertain whether they contain offending matter. In order not to delay unduly the formalities examination it is sufficient that a cursory examination be undertaken to ensure that the application does not contain the following prohibited matter: statements constituting an incitement to riot or to acts contrary to "ordre public", racial, religious or similar discriminatory propaganda, or criminal acts and grossly obscene matter. The Receiving Section should also take action where the Search Division draws its attention to offending matter which it had overlooked. The applicant is notified of the material omitted.

Rule 34(1)(b)  
Rule 34(3)

8.2 According to Rule 34(1)(b), the application must not contain "statements disparaging the products or processes of any particular person other than the applicant, or the merit or validity of applications or patents of any such person. Mere comparisons with the prior art" are not however to "be considered disparaging per se". Statements clearly coming within this category that become evident from the cursory examination referred to in III, 8.1, or to which attention is drawn by the Search Division, should be omitted by the Receiving Section when publishing the application. In cases of doubt the matter should be left for consideration to the Examining Division. The published application must indicate the place and number of any words omitted and the EPO must furnish, upon request, a copy of the passage omitted. The applicant is again notified of the material omitted. (See also treatment of prohibited matter in proceedings before the Examining Division, C-II, 7).

**9. Claims fee**

Rule 31(1)  
Rule 31(2)  
Rule 69(1)  
Art. 77(5)

An application which contains more than ten claims at the time of filing incurs payment of a claims fee in respect of each claim over and above that number. The claims' order is their sequence at the time of filing. If an application contains more than one set of claims Rule 31 is only applicable for the set of claims containing the highest number of claims (see Legal Advice N°. 3/85 rev. OJ 11/1985, 347). The claims fees must be paid within one month after the filing of the application (see II, 4.9 as to what is understood by "filing of the application"). If the claims fees have not been paid in due time they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out

the failure to observe the time limit. If a claims fee is not paid within the period of grace, the claim concerned is deemed to be abandoned and the applicant is notified to that effect. If the claims fees paid are insufficient to cover all the claims (i.e. No. 11 onwards) incurring fees, and if when payment was made no indication was given as to which claims were covered by the fees paid, then the applicant is requested to specify which claims incurring fees are covered by the claims fees paid. The Receiving Section notifies the Search Division of claims that are deemed abandoned. Any claims fee duly paid shall be refunded only in the case referred to in Art. 77(5) (see II, 3.4).

#### 10. Filing of drawings

Art. 78(1)(d)  
Art. 91(6)  
Rule 43(1)  
Rule 43(2)

An application must contain drawings (even though they may not meet the physical requirements referred to in III, 3) where they are referred to in the description or the claims and it is necessary therefore for the Receiving Section to make a check in that regard. Where the drawings were filed later than the date of filing of the application the applicant is informed by the Receiving Section that the drawings and the reference to the drawings in the application will be deemed to be deleted unless the applicant requests within a period of one month that the application be re-dated to the date on which the drawings were filed. Similarly, if the applicant has omitted to file some or all of the drawings referred to in the description or claims, he is invited to file them within one month and is informed that the application will be re-dated to the date on which they are filed or, if they are not filed within that period, that any reference to them in the application will be deemed to be deleted.

Rule 88, 2nd sentence

If the applicant requests the insertion of drawings by way of correction under Rule 88, second sentence, this request is to be decided upon before a communication under Rule 43 is issued. For the principles governing correction see V, 3.

#### 11. Abstract

Art. 78(1)(e)  
Art. 91(1)(c)

11.1 Every application for a patent must contain an abstract. The effect of non-compliance with this requirement is dealt with in III, 14.

Rule 47(1)

11.2 The definitive content of the abstract is the responsibility of the Search Division. However where it is obvious that the abstract filed does not belong to the application, and this should normally be confirmed by the Search Division, the applicant is informed that the document filed does not constitute an abstract and that unless he corrects the deficiency the sanction referred to in III, 14 will apply.

Rule 33(4) 11.3 If the application contains drawings the applicant should indicate the figure (or exceptionally figures) of the drawings which he suggests should accompany the abstract. Where this requirement is not met, the applicant is allowed a short period (not more than one month) to indicate an appropriate figure. If the applicant does not respond within the time allowed, then the Search Division decides which figure(s) to publish. For the further procedure see B-XI, 5.

## 12. Designation of Contracting States

12.1 All the States designated must be Contracting States to the Convention at the filing date of the application (for a list of the EPC Contracting States, see Preliminary Remarks, 4). Any other State entered on the request for grant must be disregarded (see for the designation of contracting states on the request for grant form, 12.6 and 12.7 below). As indicated in II, 2.2, when the application is in the name of joint applicants each may designate different Contracting States; objection should be raised during the course of the examination for formal requirements if there is any ambiguity as to the States designated by the individual applicants.

Art. 79(2)  
Art. 149(1)  
Art. 2 Nr. 3 RFees  
Art. 2 Nr. 3a  
RFees 12.2 The designation of a Contracting State is subject to payment of a designation fee. A single joint designation fee is payable for Switzerland and Liechtenstein. The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee.

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

Rule 15(2)  
Rule 25(2) For divisional applications and new applications under Art. 61(1)(b), the designation fees must be paid within one month of filing the application; for such applications, however, the designation fees may be paid up to the expiry of the time limit applicable to the parent application under Art. 79(2), if this expires later (see IV, 1.4.1).

Rule 104b(1)(b)(ii) For Euro-PCT applications, the designation fees must be paid within 21 or 31 months of the filing or priority date respectively.

Rule 85a  
Art. 2, No. 3b,  
RFees 12.3 If the designation fees have not been paid within the normal period, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within that period a surcharge is also paid. Designation fees in respect of which the applicant has dispensed with notification under Rule 85a(1) may still be validly paid under Rule 85a(2)



within a non-extendable period of grace of two months of expiry of the normal period provided that within that period a surcharge is also paid (for calculation of aggregate time limits see Legal Advice No. 5/93 rev., OJ 4/1993, 229).

In cases where the time limits for subsequent payment of designation fees under paragraphs 1 and 2 of Rule 85a expire at different times, all designation fees can still validly be paid up to the later date (J 5/91, OJ 11/1993, 657).

Art. 7(2), 1st sentence, RFees

12.4 If during the periods of grace designation fees are paid without or without sufficient surcharge, it is first necessary to establish how many designation fees including surcharge are covered by the total sum paid for that purpose. The applicant must then be invited pursuant to Art. 7(2), first sentence, Rules relating to Fees to inform the Office for which Contracting States the designation fees plus surcharge are to be used (see J 23/82, OJ 4/1983, 127). For the subsequent procedure, see 12.8.

12.5 Where no designation fee is validly paid by expiry of the periods of grace under Rule 85a, the application is deemed to be withdrawn; the surrender of one or more priority claims subsequent to this legal consequence does not alter the position.

Rule 69(1)

Where the application is deemed to have been withdrawn because of failure to pay the designation fees, the loss of rights ensues on expiry of the normal period (see J 04/86, OJ 4/1988, 119, which applies *mutatis mutandis*). The applicant is notified of the loss of rights.

Art. 122(5)

Re-establishment of rights in respect of the periods under Art. 79(2) and Rule 85a is excluded under Art. 122(5) (see J 12/82, OJ 6/1983, 221).

Art. 79(1)(2)

12.6 The designation of the Contracting States in which protection for the invention is desired shall be contained in the request for grant of a European patent, whereas the designation fees may be paid later.

The use of the prescribed Request for Grant form (Form 1001) with its pre-crossed declaration designating all Contracting States belonging to the EPC at the filing of the application (Section 32.1) ensures that all designations are made on the day the application is filed, giving the applicant time - until expiry of the period for paying the designation fees (Art. 79(2), Rules 15(2), 25(2) and 85a(1)(2)) - to decide which Contracting States he actually wants his patent to cover. This he does by paying the designation fees for those States, including any surcharge(s).

Art. 2 Nr 3 RFees  
Art. 7(1) RFees

12.7 In respect of applications filed from 1 July 1999 onwards the designation fees are deemed paid for all Contracting States upon payment of seven times the

amount of one designation fee. Such payment simply need to be marked "Designation fees" in order for the purpose of the payment to be established.

If, on the other hand, the applicant intends to pay fewer than seven designation fees when filing the application, he should indicate the relevant Contracting States in Section 32.2 of the Request for Grant form (Form 1001). This helps to ensure that the designation fees paid are properly entered in the books and to avoid unnecessary communications under Rule 85a(1) and Rule 69(1) where the applicant has intentionally not paid the fees for certain States because he does not want a patent there. If designation fees are not paid within the basic time limit, communications under Rule 85a(1) and Rule 69(1) are issued only in respect of those States for which the applicant indicated his intention to pay. As regards the other designated States no communications are issued; he may, however, still pay the fees (plus surcharge) for these States up to the end of the period of grace under Rule 85a(2).

For applicants taking part in the automatic debiting procedure, see also XI, 7.2.

Art. 7(2), 1st sentence, RFees  
Art. 9(2), 2nd sentence, RFees  
Art. 91(4)  
Rule 69(1)

12.8 If, given the amount payable under the time limit in question, the sum paid for designation fees during the periods under Art. 79(2) or Rule 85a does not cover all the Contracting States indicated under Section 32.2 of the Request for Grant form (Form 1001), and the payer has failed to indicate for which Contracting States the fees are intended, then he is requested to indicate which States he wishes to designate, within a period stipulated by the EPO. If he fails to comply in due time, then Art. 9(2) of the Rules relating to Fees applies. The fees are deemed to have been paid only for as many designations as are covered by the amount paid, in the order in which the Contracting States have been designated (see J 23/82, OJ 4/1983, 127). The designation of Contracting States not covered by the fees are deemed withdrawn, and the applicant is notified of the loss of rights (see 12.5 paragraph 2, regarding the time at which loss of rights ensues).

Art. 97(4)(5)  
Art. 79(3)  
Rule 14

12.9 Subject to the final sentence of this paragraph, the designation of a Contracting State may be withdrawn by the applicant at any time up to the grant of the patent. The designation fee is not refunded when a designation is withdrawn. Withdrawal of the designation of all the Contracting States results in the application being deemed to be withdrawn and the applicant is notified accordingly. The designation of a Contracting State may not be withdrawn as from the time when a third party proves to the EPO that he has initiated proceedings concerning entitlement and up to the date on which the EPO resumes proceedings for grant.

### **13. Extension of European patent applications and patents to States not party to the EPC**

13.1 At the applicant's request and on payment of the prescribed fee European patent applications (direct or Euro-PCT) and thus patents can be extended to States for which an Extension Agreement with the EPO has become effective (Extension States).

Extension may be requested for the following States:

Slovenia (SI) since 1 March 1994

Lithuania (LT) since 5 July 1994

Latvia (LV) since 1 May 1995

Albania (AL) since 1 February 1996

Romania (RO) since 15 October 1996, and the former Yugoslav Republic of Macedonia (MK) since 1 November 1997.

A request for extension to such States is deemed to be made with any European application filed after entry into force of respective Extension Agreements. This applies also to Euro-PCT applications provided that the EPO has been designated for a European patent and the Extension State has been designated for a national patent in the international application. The request is deemed withdrawn if the extension fee is not paid within the prescribed time limit (see 13.2). It is by paying the extension fee that the applicant decides to extend his application to a certain Extension State. The declaration in Section 34 of the Request for Grant form (Form 1001) or Section 11 of Form 1200 for entry into the regional phase before the EPO, where the applicant is asked to state whether he intends to pay the extension fee, is merely for information purposes and intended to assist in recording fee payments.

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

13.2 Under the applicable national provisions of the Extension States the extension fee must be paid within the periods prescribed by the EPC for the payment of designation fees (see III, 12.2 and VII, 1.3). If the extension fee has not been paid within the applicable basic time limit (Art. 79(2), Rules 15(2), 25(2) and 104b(1)), a communication under Rule 85a(1) is not issued. However, the applicant may still validly pay the extension fee within a period of grace of two months after the expiry of the basic time limit provided that within this period a surcharge of 50% of the extension fee is also paid (Rule 85a(2)). As regards the ceiling of the surcharge, Art. 2, No. 3b of the Rules relating to Fees applies *mutatis mutandis*.

If the extension fee and where appropriate the surcharge are not paid within the specified periods, the request for extension is deemed withdrawn. No communication under Rule 69(1) is issued, nor is re-establishment of rights possible in respect of payment of the extension fee.

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

13.4 All Extension States are deemed requested and are therefore indicated in the published application. These States, and those for which the extension fee has been paid, are indicated in the Register of European Patents and in the European Patent Bulletin. Extension States publish in their national register the relevant data relating to European patent applications and patents extending to their territory.

Since Extension States are not EPC Contracting States, the files of published applications cannot be inspected on the premises of the national Offices of these States (see XII, 3.4).

#### **14. Correction of deficiencies**

Art. 91(2)

14.1 Where the formalities examiner notes during the examination for compliance with the requirements set out in earlier sections of this Chapter that there are deficiencies which may be corrected he must give the applicant the opportunity to rectify each such deficiency within a specified period. Some of these periods have been referred to previously (see periods specified in III, 5.5, 6.5, 6.6, 6.7, 9, 10 and 12.2), others are determined by the Receiving Section in accordance with Rule 84. The formalities examiner should in his first report to the applicant raise all the formal objections that become evident from a first examination of the application, except that, as noted in III, 3.2, the Receiving Section should not draw the attention of the applicant to deficiencies under Rule 32(2) (i) and (j) or question the inclusion of tables in the claims. It is likely that certain matters cannot be finally disposed of at this stage, e.g. filing of priority documents for which the period for filing has not expired, and further reports may be necessary. If the applicant is required to appoint a representative but has not done so the formalities examiner should in his first report not only cover this deficiency but any other obvious deficiencies as it should be assumed that the applicant on receipt of the report will appoint a representative within the period allowed.

Rule 41(1)(2)

14.2 The Receiving Section determines the periods for remedying the following deficiencies:

(i) non-appointment of a representative where the applicant has neither his residence nor principal place of business in a Contracting State, or failure to file an authorisation where this is necessary (see IX, 1.5 and the Decision of the President of the EPO, OJ 9/1991, 489)(see III, 2);

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

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

(iv) abstract not filed (see III, 11);

(v) non-payment of the claims fees (see III, 9);

(vi) priority document, file number of the previous application is missing (see III, 6).

Rule 84  
Art. 91(3)

The period allowed for remedying any of the above deficiencies, apart from (v), must not be less than two months and not more than four months; as a general rule the period is set at two months. If any of the listed deficiencies is not corrected within the time limit allowed the application is refused (in cases (i) to (iv) above) or (in cases (v) and (vi) above) a loss of right occurs, and the applicant receives a decision from the Receiving Section to that effect. The Search Division is informed of such refusal or loss of rights.

**List of States<sup>(1)</sup>**

in respect of which the filing is recognised as giving rise to a priority right (as at 1 March 1999)

Albania	Hungary	San Marino
Algeria	Iceland	Sao Tome and Principe
Argentina	India	Senegal
Armenia	Indonesia	Sierra Leone
Australia	Iran (Islamic Republic of)	Singapore
Austria	Iraq	Slovakia
Azerbaijan	Ireland	Slovenia
Bahamas	Israel	South Africa
Bahrain	Italy	Spain
Bangladesh	Japan	Sri Lanka
Barbados	Jordan	Sudan
Belarus	Kazakhstan	Suriname
Belgium	Kenya	Swaziland
Benin	Korea, Democratic	Sweden
Bolivia	People's Republic of	Switzerland
Bosnia and Herzegovina	Korea, Republic of	Syria
Botswana	Kyrgyzstan	Tajikistan
Brazil	Laos	Tanzania, United
Bulgaria	Latvia	Republic of
Burkina Faso	Lebanon	Togo
Burundi	Lesotho	Trinidad and Tobago
Cambodia	Liberia	Tunisia
Cameroon	Libya	Turkey
Canada	Liechtenstein	Turkmenistan
Central African Republic	Lithuania	Uganda
Chad	Luxembourg	Ukraine
Chile	Macedonia, the former	United Arab Emirates
China	Yugoslav Republic of	United Kingdom
Colombia	Madagascar	United States of America
Congo	Malawi	Uruguay
Congo, Democratic	Malaysia	Uzbekistan
Republic of the	Mali	Vatican
Costa Rica	Malta	Venezuela
Côte d'Ivoire	Mauritania	Viet Nam
Croatia	Mauritius	Yugoslavia
Cuba	Mexico	Zambia
Cyprus	Moldova, Republic of	Zimbabwe
Czech Republic	Monaco	
Denmark	Mongolia	
Dominican Republic	Morocco	
Egypt	Netherlands	
El Salvador	New Zealand	
Equatorial Guinea	Nicaragua	
Estonia	Niger	
Finland	Nigeria	
France	Norway	
Gabon	Panama	
Gambia	Paraguay	
Georgia	Peru	
Germany	Philippines	
Ghana	Poland	
Greece	Portugal	
Grenada	Romania	
Guatemala	Russian Federation	
Guinea	Rwanda	
Guinea-Bissau	Saint Kitts and Nevis	
Guyana	Saint Lucia	
Haiti	Saint Vincent and the	
Honduras	Grenadines	

<sup>(1)</sup> The States in question are the Contracting States to the Paris Convention for the Protection of Industrial Property. No agreements have so far been concluded pursuant to Art. 87 (5) (see III, 6.2).

**CHAPTER IV**

## SPECIAL PROVISIONS

**1. European divisional applications (see also C-VI, 9)**Art. 76  
Rule 25(1)

1.1.1 A European patent application may be divided. A European divisional application may be divided in turn. An international application for which the EPO acts as designated or elected Office is also deemed to be a European patent application (Art. 150(3)). To divide a European application, the applicant files one or more European divisional applications.

Rule 51(4)

1.1.2 The applicant may file a divisional application up to the time he approves in accordance with Rule 51(4), the text in which the European patent is to be granted.

Note that a request for amendment following a communication under Rule 51(4) is to be regarded as approval within the meaning of Rule 25, i.e. the applicant's approval of the text as amended in accordance with the documents he has filed (see Notice of the EPO in OJ 1-2/1989, 43). If the Examining Division consents to the amendments requested it continues the proceedings by issuing the communication under Rule 51(6) (see C-VI, 15.1.2). In such cases, the last date for filing a divisional application is the date on which the EPO received the request for amendments. If the Examining Division does not consent to the amendments requested, and continues the proceedings by issuing a reasoned communication (see C-VI, 15.1.3), the applicant can still file a divisional application up to the time he submits a text to which the Examining Division does consent.

1.1.3 Only the applicant on record may file a divisional application. This means that in the case of a transfer of an application a divisional application may only be filed by or on behalf of the new applicant if the transfer was duly registered and therefore effective (Rule 20) at the filing date of the divisional application.

1.1.4 The parent application must be pending when a divisional application is filed. In the case of an application being filed as a divisional application from an application which itself already is a divisional application, it is sufficient that the latter mentioned is still pending at the filing date of the second divisional application.

It is not therefore possible to file a divisional application if the parent application has been refused, withdrawn or is deemed to be withdrawn.

If an application is deemed to be withdrawn (e.g. following failure to file the designation of the inventor in due time under Art. 91(5)), the procedure is over when the period

not complied with expires, regardless of when the loss of rights is notified under Rule 69 (unless the loss of rights is remedied by means of an allowable request for further processing or re-establishment (see E-VIII, 2).

Once an application has been refused, no divisional application may be filed, unless the applicant files notice of appeal, in which case the decision to refuse cannot take effect until the appeal proceedings are over. As the provisions relating to the filing of divisional applications also apply in appeal proceedings (Rule 66(1)), a divisional application may be filed while such proceedings are under way.

#### 1.2 Dates of filing/priority of the divisional application

Art. 76(1), 2nd sentence

1.2.1 A European divisional application may be filed in respect of subject-matter which does not extend beyond the content of the parent application as filed. Provided this requirement is met, the divisional application is deemed to have been filed on the date of filing of the parent application (see 1.2.2) and enjoys that application's priority (see 1.2.3).

Art. 80

1.2.2 A divisional application filed in due form, i.e. meeting the requirements of Art. 80 (see II, 4.1 et seq.), is accorded the same date of filing as the parent application. The question of whether it is confined to subject-matter contained in the parent application is not decided until the examination procedure (see C-VI, 9.4 et seq.).

Rule 38(3)(4)

1.2.3 A priority claimed in the parent application may apply also to the divisional application. Provided the parent application's priority claim has not lapsed, the divisional application retains that priority; it is not necessary to claim it formally a second time. Similarly, if a copy and any translation of the earlier (priority) application have been filed in respect of the parent application before the divisional application is filed, it is not necessary to file the priority documents again in respect of the divisional application. The EPO makes a copy of these documents and places them in the file of the divisional application (see announcement concerning the application of Rule 38(3) and (4) to European divisional applications and to new European patent applications filed under Art. 61(1)(b), OJ 6-7/1979, 290).

If, when the divisional application is filed, no priority documents have been filed in respect of the parent application, they must be filed in respect of the divisional application and, if the priority of the parent application's remaining subject-matter is to be retained, in respect of the parent application also. The applicant can also inform the EPO, within the time limit set for filing priority documents in the divisional application proceedings, that he has in the meantime submitted these documents in respect of the



parent application. If the subject-matter of the divisional application relates only to some of the priorities claimed in the parent application, priority documents in respect of the divisional application need be filed for those priorities only.

Rule 38(2) This applies also as regards indicating the file number of the earlier (priority) application. For the time limits for filing the priority documents and indicating the file number, see III, 6.5, 6.7 et seq.

### 1.3 Filing the divisional application

Art. 76(1)  
Art. 75(3) 1.3.1 A divisional application must be filed by hand or by post with one of the filing offices of the EPO. The filing of a European divisional application with a national authority has no effect in law; the authority may however, as a service, forward the European divisional application to the EPO. If a competent national authority chooses to remit the application it is not deemed received until the documents are filed at the EPO.

Rule 26(2)(e) 1.3.2 The request for grant of a patent must contain a statement that a divisional application is sought and state the number of the parent application. If the request is deficient, as can arise if there is no indication that the application constitutes a divisional application, although some of the accompanying documents contain an indication to that effect, or if the number is missing, the deficiency may be corrected in the manner indicated in III, 14.

Rule 4  
Rule 6 1.3.3 As indicated in VIII, 1.3, a divisional application must be filed in the language of the proceedings of the parent application. If the applicant has availed himself of Art. 14(2) in filing the parent application, he may also use for the divisional application the original language of the parent application, provided he is entitled to do so. He must then file a translation in the language of the proceedings of the parent application. The application is not accorded the date of filing of the parent application if these requirements are not met. If the translation is not filed within the time limit mentioned in Rule 6, the divisional application is deemed withdrawn pursuant to Art. 90(3).

Art. 76(2)  
Rule 25(2) 1.3.4 In the divisional application only such Contracting States may be designated as, on the date it is filed, are still validly designated in the parent application. The designation of other States is without effect, and the applicant is notified of this.

1.3.5 For the extension to specific states not party to the EPC of European patents arising from divisional applications, see III, 13.1.

## 1.4 Fees

Art. 76(3)  
Rule 25(2)  
Art. 79(2)

1.4.1 The filing fee, the search fee and the designation fees for the divisional application must be paid within one month after filing of the application (basic time limit). The payment of designation fees however may still be made up to expiry of the Art. 79(2) time limit applicable to the parent application, if this date is later.

The search fee must be paid even if a further search fee has already been paid under Rule 46(1) in respect of the search report on the parent application for the part of the application which was lacking in unity and which is now the subject of the divisional application (for reimbursement of the search fee see XI, 10.2.1).

Rule 85a  
Art. 2, No. 3b,  
RFees

If the fees have not been paid within the normal period they may still be validly paid within the periods of grace under Rule 85a provided that within those periods a surcharge is also paid (see II, 4.9 and III, 12.2 and 12.3). The result of non-compliance with these provisions is as indicated in II, 4.11, for filing and search fees, and III, 12.4, 12.5 and 12.8 for designation fees.

Rule 31(1)

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

Art. 86(1)  
Art. 76(1)  
Rule 37(3), 2nd  
sentence  
Art. 86(2)  
Rule 37(3), 3rd  
sentence  
Rule 37(3)  
Art. 2, No. 5,  
RFees

1.4.3 For the divisional application, as for any other European patent application, renewal fees are payable to the EPO. They are due in respect of the third year and each subsequent year, calculated from the date of filing of the application. If when the divisional application is filed renewal fees for the parent application have already fallen due, they are payable also for the divisional application. Pursuant to Art. 76(1) the date of filing the parent application is also the date from which the time limits for payment of the renewal fees for the divisional application (Art. 86(1)) are calculated. The period for payment is four months after the filing of the divisional application. If not paid by the due date, the renewal fees may still be validly paid within six months of that date (i.e. when the divisional application was filed), provided that at the same time the additional fee of 10% of the renewal fees paid late is paid.

The same applies if on the date of filing of the divisional application a further renewal fee in addition to those to be made good falls due, or a renewal fee falls due for the first time.

Rule 37(3), 2nd  
sentence  
Art. 86(2)

If, within the four-month period referred to above, a further renewal fee falls due or a renewal fee falls due for the first time, it may be paid free of surcharge within that period. It

Rule 37(2)  
Art. 2, No. 5,  
RFees

may otherwise still be validly paid within six months of the due date, provided that at the same time the additional fee of 10% of the renewal fee paid late is paid. When calculating the additional period the principles developed by the Legal Board of Appeal should be applied (see J 4/91, OJ 8/1992, 402).

In the case of applications for re-establishment of rights in respect of renewal fees falling due within the four-month period laid down in Rule 37(3), second sentence, the period prescribed by Art. 122(2), third sentence, starts to run only after the four months have expired.

Example:

05.03.1990	Date of filing of parent application
13.01.1993	Filing of divisional application and due date of renewal fee for the third year
31.03.1993	Due date of renewal fee for the fourth year
13.05.1993	Expiry of four-month period under Rule 37(3)
13.05.1994	Expiry of one-year period under Art. 122(2).

#### 1.5 Designation of the inventor

Rule 42(2)

The provisions of III, 5.5 apply with regard to the designation of the inventor, except that the time limit for identifying the inventor may not expire less than two months after the notification of the communication of the Receiving Section informing the applicant of the omission of or deficiencies in the designation of inventor.

#### 1.6 Authorisations

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

#### 1.7 Other formalities examination

Other than for matters referred to in IV, 1.1 to 1.6, the formal examination of divisional applications is carried out as for other applications. The provisions of Rule 27a apply with regard to divisional applications relating to nucleotide or amino acid sequences filed after 1 January 1993 (see IV, 5).

#### 1.8 Further procedure

Divisional applications will be searched, published and examined in the same way as other European patent

applications. The search fee will be refunded if the conditions of Art. 10 (1) of the Rules relating to Fees are met. The time limit for filing the request for examination begins to run with the date of mention of the publication of the search report concerning the divisional application.

## 2. Art. 61 applications

### 2.1. General

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

Art. 61(1)(a) (i) prosecute the application as his own application in place of the applicant;

Art. 61(1)(b) (ii) file a new European patent application in respect of the same invention, or

Art. 61(1)(c) (iii) request that the application be refused.

In a case where the application is no longer pending due to it having been withdrawn, refused or being deemed to be withdrawn, the third party still can file a new European patent application in respect of the same invention, in accordance with Art. 61(1)(b) (see Decision G 3/92, OJ 9/1994, 607).

### 2.2 Suspension of the proceedings for grant

Rule 13(1) "If a third party provides proof to the EPO that he has opened proceedings against the applicant for the purpose of seeking a judgement that he is entitled to the grant of the European patent" - which proof may take the form of confirmation by the court - "the EPO shall stay the proceedings for grant unless the third party consents to the continuation of such proceedings. Such consent must be communicated in writing to the EPO; it shall be irrevocable. However, proceedings for grant may not be stayed before the publication of the European patent application." Suspension must be ordered by decision. This is an interim decision, which under Art. 106(3) may only be appealed together with the final decision. These matters are dealt with by the Legal Division (see OJ 9/1990, 404).

Under Art. 164(1), the Protocol on Recognition is an integral part of the European Patent Convention. It gov-

erns the jurisdiction and recognition of decisions for EPC Contracting States.

### 2.3 Resumption of the proceedings for grant

Rule 13(3)

2.3.1 "When giving the decision on the suspension of proceedings or thereafter the EPO may set a date on which it intends to continue the proceedings pending before it regardless of the stage reached in the proceedings against the applicant. The date is to be communicated to the third party, the applicant, and any other party. If no proof has been provided by that date that a decision which has become final has been given, the EPO may continue proceedings."

2.3.2 If a date is set for the resumption of the proceedings for grant, it should be chosen with due consideration for the interests of the third party who only becomes a party to the proceedings after a judgement has been given in his favour, on the basis of the probable duration of the court proceedings so as to enable them to be concluded within that period of time. If, by the date set, the court has not given a judgement, the proceedings for grant must at all events be further stayed if the judgement is expected in the near future. However, the proceedings for grant should be resumed if it is evident that delaying tactics are being employed by the third party or if the proceedings in the court of first instance have concluded with a judgement in favour of the applicant and the legal procedure is extended by the filing of an appeal.

Rule 13(2)

2.3.3 "Where proof is provided to the EPO that a decision which has become final has been given in the proceedings concerning entitlement to the grant of a European patent, the EPO shall communicate to the applicant and any other parties that the proceedings for grant shall be resumed as from the date stated in the communication unless a new European patent application pursuant to Art. 61(1)(b) has been filed for all designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the proceedings for grant."

### 2.4 Interruption of time limits

Rule 13(5)

"The time limits in force at the date of suspension other than time limits for payment of renewal fees shall be interrupted by such suspension. The time which has not yet elapsed shall begin to run as from the date on which proceedings are resumed: however, the time still to run after the resumption of the proceedings shall not be less than two months."

Example: the six-month time limit under Art. 94(2) began on 1 July 1982. Proceedings were suspended on 21

September 1982 and resumed on 1 August 1983. The last day of the period already elapsed is 20 September 1982. The time which has not elapsed is therefore 10 days and 3 months, begins on 1 August 1983 and ends on 10 November 1983.

#### 2.5 Limitation of the option to withdraw the European patent application

Rule 14 "As from the time when a third party proves to the EPO that he has initiated proceedings concerning entitlement" (see IV, 2.2) "and up to the date on which the EPO resumes the proceedings for grant" (see IV, 2.3), "neither the European patent application nor the designation of any Contracting State may be withdrawn."

Art. 61(1)(a) 2.6 Prosecution of the application by the third party

If the third party wishes to avail himself of the possibility open to him under Art. 61(1)(a) (see IV, 2.1(i)), he must declare his intention in writing to the EPO in due time. He then takes the place of the erstwhile applicant. The proceedings for grant are continued from the point reached when the third party filed his declaration, or when they were suspended (see IV, 2.2).

#### 2.7 Filing a new application

Art. 61(1)(b)  
Art. 75(1)  
Art. 77(3)(5)  
Rule 15(3) 2.7.1 A new European patent application under Art. 61(1)(b) may be filed with one of the filing offices of the EPO or with the competent authorities of a Contracting State, if the national law of that State so provides (for further details see II, 1.1). Rule 15(3) applies in respect of the forwarding of an application filed with a competent national authority.

2.7.2 The new application is in many respects treated as a European divisional application and corresponding provisions apply. In particular the following provisions relating to divisional applications apply *mutatis mutandis*:

Art. 61(2) (i) accordance of the date of filing of the earlier application and entitlement to priority date - see IV, 1.2;

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

Art. 61(3)  
Rule 15(2)  
Rule 85a (iii) filing, search, designation and claims fees - see IV, 1.4.1 and 1.4.2;

Rule 31(1) (iv) designation of inventor - see IV, 1.5.

Rule 37(4) However, arrangements for renewal fees are different. For the year in which the new application is filed and for the years beforehand, no renewal fees are payable.

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

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

Rule 15(1)

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

2.8 Refusal of the earlier application

Art. 61(1)(c)

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

2.9 Partial transfer of right by virtue of a final decision

Rule 16(1)

"If by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, Art. 61 and Rule 15 shall apply to such part."

### 3. Display at an exhibition

Art. 55(1)(b)  
Art. 55(2)  
Rule 23

3.1 Where an applicant states when filing his application that the invention which is the subject of the application has been displayed at an official or officially recognised international exhibition falling within the terms of the Convention on international exhibitions, he must file a certificate of exhibition within four months of the filing of the European patent application. The exhibitions recognised are published in the Official Journal. The certificate, which must have been issued during the exhibition by the authority responsible for the protection of industrial property at the exhibition, must indicate the following:

- (i) that the invention was exhibited at the exhibition;
- (ii) the opening date of the exhibition;
- (iii) the date of the first disclosure where this date did not coincide with the opening date of the exhibition.

The certificate must be accompanied by an identification of the invention authenticated by the authority referred to above.

3.2 The Receiving Section acknowledges receipt of the certificate and identification of the invention. The Receiving Section draws the applicant's attention to any manifest

defects in the certificate or the identification in case it is possible to rectify the deficiencies within the four-month period allowed. The applicant is notified if the certificate or identification is not furnished within the time allowed.

#### 4. Applications relating to biological material

- |                                               |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                          |
|-----------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Rule 28(1)(c)(d)<br>Rule 28(2)<br>Rule 23b(3) | 4.1 In accordance with Rule 23b(3), "biological material" means any material containing genetic information capable of reproducing itself or being reproduced in a biological system. Where in relation to an application concerning biological material an applicant states that he has deposited in accordance with Rule 28(1)(a) the biological material with a depositary institution recognised for the purposes of Rules 28 and 28a, he must, if such information is not contained in the application as filed, submit the name of the depositary institution and the accession number of the culture deposit and, where the biological material has been deposited by a person other than the applicant, the name and address of the depositor, within whichever of the following periods is the first to expire: |
| Rule 28(2)(a)                                 | (i) within a period of sixteen months of the date of filing of the European patent application or the date of priority, this time limit being deemed to have been met if the information is submitted before completion of the technical preparations for publication of the European patent application,                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                |
| Rule 28(2)(b)                                 | (ii) if a request for early publication of the application is submitted, up to the date of such submission, or                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                           |
| Rule 28(2)(c)                                 | (iii) if it is communicated that a right to inspection of the files pursuant to Art. 128(2) exists, within one month of such communication.                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                              |
| Rule 28(1)(d)                                 | Moreover, when the depositor and applicant are not identical, the same time limit applies for submitting a document satisfying the EPO that the depositor has authorized the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with Rule 28(3) or (4).                                                                                                                                                                                                                                                                                                                                                                                                          |
| Rule 28(9)                                    | The depositary institution must be one appearing on the list of depositary institutions recognised for the purposes of Rules 28 and 28a, as published in the Official Journal of the EPO. This list includes the depositary institutions, especially the International Depositary Authorities under the Budapest Treaty. An up-to-date list is regularly published in the Official Journal.                                                                                                                                                                                                                                                                                                                                                                                                                              |
| Art. 97(1)<br>Rule 28<br>Art. 83              | 4.2 When the Receiving Section notices that the information required under Rule 28(1)(c) (indication of the depositary institution and the accession number of the culture                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                               |



deposit) or the information and the document referred to in Rule 28(1)(d) (authorisation to refer to the deposit and the consent to it being made available) is not contained in or has not yet been submitted with the application, it should notify the applicant of this fact as this information can only be validly submitted within the time limits specified in Rule 28(2). In the case of missing information pursuant to Rule 28(1)(c) the deposit must be identified in the patent application as filed in such a way that the later submitted accession number can be traced back without ambiguity. This can normally be done by indicating the identification reference given by the depositor within the meaning of Rule 6.1 (iv) of the Budapest Treaty (see Decision G 2/93, OJ 5/1995, 275). The applicant is also informed when a deposit with a recognised depository institution is referred to but no receipt from the depository institution has been filed. Any further action is a matter for the Examining Division. See also C-II, 6, in particular 6.3(ii) as regards the Examining Division's treatment of applications relating to biological material.

Rule 28(4) 4.3 Under Rule 28(4)(a) and (b), until the date on which the technical preparations for publication of the application are deemed to have been completed, the applicant may inform the EPO that, until the publication of the mention of the grant of the European patent or, where applicable, for twenty years from the date of filing if the application has been refused or withdrawn or is deemed to be withdrawn, the availability referred to in Rule 28 is to be effected only by the issue of a sample to an expert.

The above communication must take the form of a written declaration addressed to the EPO. This declaration may not be contained in the description and the claims of the European patent application, but may be given in the Request for Grant form (Form 1001, Section 30).

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

Rule 28(5) 4.4 If the applicant duly informs the Office under Rule 28(4), the biological material is issued only to an expert recognised by the President of the EPO or approved by the applicant.

Rule 28(9) The list of recognised microbiological experts, giving their particulars and their fields of activity, is published in the Official Journal (see OJ 8/1992, 470).

#### **5. Applications relating to nucleotide and amino acid sequences**

Rule 27a(1)  
Rule 27a(4)  
Rule 27a(2) If nucleotide and amino acid sequences corresponding to the definition in WIPO Standard ST.25, paragraph 2(ii), are disclosed in the European patent application, they should

be represented in a sequence listing which conforms to this WIPO Standard. The sequence listing has to be filed as part of the description, although it may also be filed later, in which case it does not form part of the application. In addition to submission in written form, the sequence listing must also be submitted on an authorised electronic data carrier which complies with WIPO Standard ST. 25, paragraph 39ff. The information recorded on the electronic data carrier must be identical to the written sequence listing which is the authentic version. The applicant or his representative must submit a statement to that effect accompanying the data carrier in accordance with Rule 27a(2). See the Decision of the President of the EPO dated 2 October 1998 and the accompanying Notice from the EPO, Supplement No. 2 to OJ 11/1998.

Art. 91(2)  
Rule 41(1)  
Art. 91(1)(b)  
Art. 91(3)

The Receiving Section will inform the applicant of any deficiencies in the written sequence listing, the electronic data carrier or the statement under Rule 27a(2) and invite him to remedy the deficiencies within a period of two months. If the requirements of Rule 27a in conjunction with the Decision of the President of the EPO dated 2 October 1998 are not complied with in good time, where appropriate following the invitation to do so from the Receiving Section, the application will be refused.

Art. 121

The applicant may request further processing of the application.

#### **6. Conversion into a national application**

Art. 135  
Art. 136(2)

6.1 The central industrial property office of a Contracting State must apply the procedure for the grant of a national patent or another protective right provided for by the legislation of this State at the request of the applicant for or the proprietor of the European patent under the circumstances specified in Art. 135(1). If the request for conversion is not filed within the three-month period specified in Art. 135(2), the effect referred to in Art. 66 will lapse. The request for conversion is made to the EPO except where the application is deemed withdrawn pursuant to Art. 77(5); in this case the request is filed with the central industrial property office with which the application was filed.

Art. 136(1)

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

**CHAPTER V****TRANSMISSION OF COMMUNICATIONS AND AMENDMENT OF APPLICATION****1. Communicating formalities report**

1.1 After a formalities examination, the Receiving Section or, where appropriate, the Examining Division, issues a report to the applicant if the application is found to be formally defective. The report will identify all the particular requirements of the Convention and Implementing Regulations which the application does not satisfy and, in the case of deficiencies which can be corrected, will invite the applicant to correct such deficiencies within specified periods (see III, 14). The applicant will be notified of the consequences, e.g. application deemed withdrawn, priority right lost, which result from the deficiencies or failure to take appropriate action within due time.

1.2 In general a time limit will be specified for meeting each particular objection. These time limits are either fixed by the Convention or Implementing Regulations or left, subject to certain restrictions, to the discretion of the EPO (see E-VIII, 1). If a deficiency is not rectified within due time, then the legal effects that are envisaged will apply.

**2. Amendment of application**

Rule 41(1)  
Rule 86(2)  
Art. 123(1)  
Art. 123(2)  
Rule 49(3)

2.1 Prior to the receipt of the search report the applicant may amend his application only if the Receiving Section has invited him to remedy particular deficiencies. After receipt of the search report and before receipt of a first communication from the Examining Division, i.e. also during the period in which the application may still be with the Receiving Section, the applicant may of his own volition amend the description, claims and drawings. However, the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (regarding the publication of claims thus amended, see also VI, 1.3).

Rule 41(1)  
Rule 86(1)

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

content. Amendments which extend beyond the remedying of deficiencies and which are filed prior to receipt of the search report may be taken into consideration in the subsequent procedure provided that, on receipt of the search report, the applicant declares that he wishes them to be maintained. Examination as to formalities of amendments filed after the receipt of the search report and before the application is transferred to the Examining Division is the responsibility of the Receiving Section (the procedure for effecting amendments is dealt with in E-II).

### 3. Correction of errors in documents filed with the EPO

Rule 88

"Linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request." Requests for such amendments may be made at any time. However, if the error to be corrected concerns items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction (e.g. priority claims), the request for correction must be filed as soon as possible, and at least in time to be incorporated in the publication of the European patent application (see J 04/82, OJ 10/1982, 385 as well as J 02/92, J 03/91 and J 06/91, OJ 6/1994, 375, 365 and 349 respectively, as well as J 11/92, OJ 1-2/1995, 25 and J 7/94, OJ 12/1995, 817). Re correction of the date indicated for the previous filing, see also III, 6.6.

Rule 88, 2nd sentence

If the error is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else could have been intended than what is offered as the correction. Such a correction may be effected only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see Opinion G 3/89 and Decision G 11/91, OJ 3/1993, 117, 125; see also C-VI, 5.9). It is in particular not allowable to replace the complete application documents (i.e. description, claims and drawings) by other documents which the applicant had intended to file with his request for grant (see Decision G 2/95, OJ 10/1996, 555). The Examining Division decides on the request for correction. If a request for correction is pending before termination of the technical preparations for publication a reference to the request is published on the front page.

**CHAPTER VI****PUBLICATION OF APPLICATION AND TRANSMISSION TO EXAMINING DIVISION****1. Publication of application**

Art. 93(1)

1.1 The application is published as soon as possible after the expiry of a period of eighteen months from the date of filing or, where priority is claimed, from the priority date. The application may however be published before that date if requested by the applicant and provided the filing and search fees have been validly paid. If the decision granting the patent becomes effective before expiry of the period referred to above, the application and the patent specification will both be published early.

If the applicant abandons his priority date then the publication is deferred provided the notification of the abandonment is received by the EPO before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day seven weeks before the end of the eighteenth month from the date of priority, if priority is claimed, or from the date of filing, if the priority is abandoned or if no priority is claimed (see Decision of the President of the EPO dated 14 December 1992, OJ 1-2/1993, 55). The applicant is informed when they are actually completed, and also of the publication number and intended publication date. Where the notification of abandonment of the priority is received after that time publication, if it has not already taken place, takes place as if the priority date applied although a notice as to the abandonment of the priority will appear in the European Patent Bulletin (see C-V, 3.4). The same procedure is followed when the priority right is lost under Art. 91(3).

Rule 48(2)

1.2 The application is not published if it has been finally refused or deemed withdrawn or withdrawn before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day seven weeks before the end of the eighteenth month from the date of filing or priority (see Notice from the EPO, OJ 1-2/1993, 56). The application is however published if, upon termination of the technical preparations for publication, a request for a decision under Rule 69(2) EPC has been received but no final decision has yet been taken (see OJ 11/1990, 455).

If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed. The Office will however try (in accordance with the principles of J 05/81, OJ 4/1982, 155) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily.

## Rule 14

The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80, OJ 5/1981, 141). The applicant is bound by an effective declaration of withdrawal (see Legal Advice No. 8/80, OJ 1/1981, 6), but may make it subject to the proviso that the content of the application is not made known to the public. This takes into account the procedural peculiarity that the applicant who makes his declaration of withdrawal later than seven weeks before the date of publication cannot know whether publication can still be prevented. However, neither the application nor the designation of a Contracting State may be withdrawn as from the time a third party proves that he has initiated proceedings concerning entitlement and up to the date on which the EPO resumes the proceedings for grant.

Art. 93(2)  
 Rule 49(2)  
 Rule 18  
 Rule 49(3)  
 Rule 47(1)  
 Rule 88  
 Rule 28(4)  
 Rule 49(1)

1.3 The publication must contain the description, the claims and any drawings as filed, and specify, where possible, the person(s) designated as the inventor(s). It also indicates the designated Contracting States. When a European application is published, the States for which protection is actually sought may not yet be known, because the time limit under Art. 79(2) for paying the designation fees is still running. The publication therefore always shows as designated all States party to the EPC on the date the application was filed. Those definitively designated - through actual payment of designation fees - are announced later in the Register of European Patents and the European Patent Bulletin (see Information from the EPO, OJ 10/1997, 479).

With divisional applications, and new applications under Art. 61(1)(b), the position is different. When these are published, the time limit for paying the designation fees under Rules 25(2) and 15(2) has normally already expired (for exceptions, see III, 12.2, paragraph 3, and IV, 1.4.1), so those States for which protection is actually sought can be indicated. The publication also contains any new or amended claims filed by the applicant under Rule 86(2), together with the European search report and the abstract determined by the Search Division if the latter are available before termination of the technical preparations for publication. Otherwise the abstract filed by the applicant is published. If a request for correction under Rule 88 of errors in the documents filed with the EPO is allowed, it must be incorporated in the publication. If upon termination of the technical preparations for publication a decision is still pending on a request for correction of items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction (e.g. priority claims), this must be mentioned on the front page of the publication (see the case law in V, 3), as must a request for correction of errors in the description, claims or drawings (see A-V, 3). If the EPO has received a communication from the applicant under Rule 28(4), ("expert solution"), this too must be mentioned (see Announcement

of the President of the EPO, OJ 9/1981, 358). Further data may be included at the discretion of the President of the EPO. The publication may not contain any designation of States finally deemed withdrawn or withdrawn by the applicant before the termination of the technical preparations for publication.

1.4 The originals of documents filed are used for publication purposes where these documents meet the physical requirements for Chapter IX, 2, otherwise the amended or replacement documents meeting these requirements are used. Prohibited material is omitted from the documents before they are transferred to the publication section, the place and number of words or drawings omitted being indicated (see III, 8.1 and 8.2).

Sequence listings filed on the date of filing are published as part of the description, while sequence listings filed thereafter are published as an annex to the application documents or to the European patent specification (Art. 6 of the Decision of the President of the EPO, Supplement No. 2 to OJ 11/1998).

1.5 If not published with the application, the European search report is published separately.

## **2. Filing the request for examination, and transmission to Examining Division**

Rule 50(1)  
Rule 50(2)

2.1 The Receiving Section communicates to the applicant the date on which the European Patent Bulletin mentioned the publication of the search report and draws his attention to the provisions with regard to the request for examination as set out in Art. 94(2) and (3). The applicant may not invoke the omission of the communication. If the communication wrongly specifies a later date than the date of the mention of the publication, the later date is decisive as regards the time limit for filing the request for examination (see VI, 2.2) unless the error is apparent.

Art. 94(1)(2)  
Rule 85b  
Art. 2, No. 7,  
RFees

2.2 The request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report (normal period). The request for examination is not deemed to have been filed until a written request has been filed and the examination fee paid. If the request for examination is not filed within the normal period, it may still be validly filed within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within the period of grace a surcharge of 50% of the examination fee is also paid.

Rule 26(1)

Immediate filing of the written request for examination, provided for in the prescribed Request for Grant form (Form 1001), rules out the possibility of a loss of rights

where the applicant pays the examination fee during the prescribed period but fails to file the written request for examination. The applicant has only one more procedural act - payment in due time of the examination fee (Art. 94(2), Rule 85b) - to worry about.

Art. 10b RFees

On the other hand, there is nothing to stop him paying the examination fee at the same time as he files the application. If, after receipt of the search report, he decides to not pursue the application further and does not react to the invitation pursuant to Art. 96(1), the application will be deemed withdrawn pursuant to Art. 96(3) and the examination fee will be refunded in its entirety (see VI, 2.6).

Point 12 AAD

If the applicant has filed an automatic debit order the examination fee will only be debited at the end of the six month period. If he wishes the application to be transmitted earlier to the Examining Division, he should pay the fee separately (see the Supplement to OJ 2/1999, 19, re point 12 AAD).

Art. 14(4)  
Rule 6(3)  
Art. 12(1) RFees

Where applicants having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad avail themselves of the options provided for under Art. 14(2) or (4), the examination fee is reduced (Rule 6(3) in conjunction with Art. 12(1) of the Rules relating to Fees) (see XI, 9.2.1 and 9.2.3).

Art. 94(2)

The request for examination may not be withdrawn.

Art. 94(3)  
Rule 85b  
Rule 69(1)  
Art. 122(5)

2.3 If the request for examination is not validly filed before expiry of the period of grace under Rule 85b, the application is deemed to be withdrawn and the applicant is notified accordingly. The loss of rights ensues on expiry of the normal period (see J 04/86, OJ 4/1988, 119). Art. 122(5) excludes re-establishment of rights in respect of the periods under Art. 94(2) and Rule 85b (see J 12/82, OJ 6/1983, 221, and E-VIII, 2.2.4).

Art. 96(1)  
Art. 96(3)  
Rule 69(1)  
Art. 121  
Art. 122

If the applicant has validly filed a request for examination before the European search report has been transmitted to him, the Receiving Section invites him to indicate within six months from the date of the mention of the publication of the search report in the European Patent Bulletin whether he desires to proceed further with his application. If he fails to respond to this request in time, the application is deemed to be withdrawn and the applicant is notified accordingly. However, where this occurs the applicant may avail himself of the legal remedies under both Art. 121 (further processing of the application) and Art. 122 (restitutio in integrum). Regarding reimbursement of the examination fee, cf. VI, 2.2 and XI, 10.2.4. C-VI, 1.1.2 describes the procedure in respect of an unconditional request for examination.



Art. 16  
Art. 18(1)

2.4 If the Receiving Section finds that the request for examination was filed in due time, or the desire to proceed further with the application was indicated in due time (Art. 96(1)), it transmits the application to the Examining Division. Otherwise, it notes the loss of rights which has occurred (see Rule 69(1)).

2.5 The dossier as transmitted to the Examining Division contains the following:

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

(ii) any certificate filed in relation to display at an exhibition (see IV, 3) and any information furnished under Rule 28 when the application relates to biological material (see IV, 4);

(iii) the search report, the definitive content of the abstract as drawn up by the Search Division, and the internal search note if any;

(iv) copies of documents cited in the search report, and two copies of the publication document(s);

(v) all relevant correspondence. Copies of certain EPO communications to applicants or inventors - currently EPO Forms 1048, 1081, 1082 and 1133 - are not kept in the dossier but are computerised: their most important elements can at all times be printed out (as EPO Form 1190) and placed in the dossier.

The Receiving Section will direct attention to any aspects of the application which require urgent attention by the Examining Division, e.g. any letters which have to be answered before the application is examined in its proper turn.

Art. 10b RFees

2.6 The examination fee is refunded:

(i) in full if the European patent application is withdrawn, refused or deemed to be withdrawn before the Examining Divisions have assumed responsibility;

(ii) at a rate of 75% if the European patent application is withdrawn, refused or deemed to be withdrawn after the Examining Divisions have assumed responsibility but before substantive examination has begun. An applicant unsure whether substantive examination has begun and wanting to withdraw the application only if he will receive the 75% refund may make withdrawal contingent upon the refund ("conditional" withdrawal) (see OJ 9/1988, 354).

**CHAPTER VII****APPLICATIONS UNDER THE PATENT COOPERATION TREATY****1. General**

- Art. 150(3) 1.1 The general considerations relating to applications under the PCT for which the EPO acts are set out in E-IX. In particular reference is also made to the Information for PCT applicants concerning time limits and procedural steps before the EPO as a designated or an elected Office under the PCT (Supplement No. 1 to OJ 12/1992 and OJ 1-2/1994, 131 and 133) and to the information concerning the interface between the international phase and the regional phase before the EPO as elected Office (OJ 5/1992, 245). This Chapter deals with the differences from the practice set out in earlier Chapters of this Part of the Guidelines when dealing with such applications and which are referred to in what follows as international applications. However it is necessary to consider briefly some of the provisions applicable to international applications as set out in VII, 1.2, 1.3 and 1.4 below.
- Art. 23(1)PCT  
Art. 40(1)PCT  
Rule 49.1(a<sup>bis</sup>)PCT  
Art. 24(1)(iii)PCT 1.2 The initial processing and formal examination of international applications are carried out by PCT authorities and under provisions of the PCT. Unless there is a specific request from the applicant the EPO must not process or examine an international application prior to the expiry of 21 months or, if the applicant has validly availed himself of PCT Chapter II, 31 months from the earliest priority date. Since the EPO has not exercised the waiver referred to in PCT Art. 20(1)(a), a copy of the international application will be furnished by the International Bureau. The EPO does not require the applicant to furnish a copy of the international application under Art. 22 PCT, even if the International Bureau has not communicated a copy under Art. 20 PCT (see PCT Gazette 14/1986, 2367). Where the language is not an official language of the EPO, the applicant is required, in accordance with PCT Art. 22 or 39, to furnish a translation within 21 months or, if the applicant has validly availed himself of PCT Chapter II, 31 months of the earliest priority date claimed; the application is deemed withdrawn if the translation is not furnished within that period.
- Rule 104b(1)  
Rule 85a(1)  
Rule 104c(1)(2) 1.3 The applicant must pay the national fee which comprises the national basic fee, designation fees and, where applicable the claims fees. Where a supplementary European search report needs to be drawn up, a search fee to the EPO within the (normal) periods of 21, respectively 31 months as mentioned in VII, 1.2, also has to be paid. If these fees are not paid within the relevant normal period, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit,

provided that within this period a surcharge is paid. If the national basic fee and at least one designation fee are not paid in due time, the application is deemed withdrawn. Any designation of a Contracting State for which a designation fee has not been paid in due time is also deemed withdrawn. Loss of rights ensues on expiry of the normal period (analogous application of J 04/86, OJ 4/1988, 119). For the exclusion of the re-establishment of rights see E-VIII, 2.2.4.

Rule 85b

Where Chapter II PCT applies, a request for examination must be filed up to the end of 31 months (basic period) i.e. a written request for examination must be filed and the examination fee paid. If the request for examination has not been filed within the basic period it may still be validly filed within a period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is paid. If the request for examination is not validly filed the application will be deemed to be withdrawn. For the exclusion of the re-establishment of rights see E-VIII, 2.2.4. See also VII, 5.2.

Rule 31(1)  
Rule 104c(3)  
Rule 104b(1)

If applicable, the claims fees under Rule 31 must also be paid within the normal periods referred to above. If they are not, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit. The number of additional claims fees to be paid is determined by the number of claims applicable at the end of the normal period referred to above, see J 6/96, not published in OJ. Where a claims fee has not been paid by expiry of the period of grace, the claim concerned is deemed to be abandoned.

Art. 150(2)

1.4 In proceedings before the EPO relating to international applications, the provisions of the PCT are applied, supplemented by the provisions of the European Convention. In case of conflict the provisions of the PCT prevail. The EPO cannot require compliance with requirements relating to form or contents of the international application different from or additional to those which are provided for in the PCT. As a result of the overriding PCT provisions and the requirements of Part X of the Convention, the practice set out in the earlier Chapters of this Part of the Guidelines does not necessarily hold good for international applications. In particular, where the PCT international publication was in an official EPO language, it is not necessary for the Receiving Section to subject the copy of the application furnished to the EPO to a formalities examination except to the extent indicated later. On the other hand, where it is necessary to furnish a translation of the international application the Receiving Section must carry out for that translation a more extensive formalities examination. The formalities examination of an international application, insofar as it differs from that applicable

to other applications, is considered in what follows by reference to the provisions of appropriate sections of the earlier Chapters of this Part. Unless otherwise specified, the comments relate to the translation of the international application.

## **2. Provisions of Chapter II**

2.1 The provisions of II, 1 do not apply to international applications.

2.2 The PCT requirements corresponding to those of II, 2 are more restrictive as in general the applicant must be a resident or national of a PCT Contracting State and therefore no supplementary examination should be necessary.

2.3 The provisions of II, 3 do not apply.

2.4 The date of filing (II, 4) is that accorded under the PCT. With the exception of the payment of the filing ("national fee" in this instance) and search fees, the requirements of II, 4.8 to 4.11 do not apply. The period for payment of these fees is as specified in VII, 1.3. The application is referred to the Search Division for drawing up any supplementary report considered necessary.

## **3. Provisions of Chapter III**

3.1 The provisions of III, 2 apply to international applications whether furnished in an official language or in translation. A professional representative having a right to practice before the PCT International Authorities is not necessarily authorised to act before the EPO (see PCT Art. 27(7)). (For the representation of applicants before the EPO as designated or elected Office see Legal Advice No. 18/92, OJ 1-2/1992, 58).

3.2 The application must be examined for compliance with the physical requirements of III, 3. The requirements are in general identical with the corresponding requirements of the PCT and no supplementary examination should be necessary when the application is furnished in an official language.

3.3 The request for grant (III, 4) for international applications will appear on the PCT application form. This form corresponds in general with the EPO form and provides for the entry of the information listed in Rule 26.2, with the exception of the items referred to in sub-paragraphs (e) and (f).

Rule 104b(2)

3.4 The requirement, as set out in III, 5, that the designation of inventor is filed in a separate document where the applicant is not the inventor or the sole inventor has to be complied with irrespective of the language of the interna-

tional application, unless the inventor has already been named in the PCT request. If the inventor has not been designated in the international application at the expiry of the period of 21 months, or 31 months, whichever applies, of the date of filing, or, in the case of priority, after the earliest date of priority claimed, the EPO shall invite the applicant to file the designation of inventor within such period as it shall specify.

Rule 17.1 PCT  
Rule 17.2 PCT

3.5 The claim to priority (III, 6) for an international application refers to the date, or dates, claimed under the PCT. Normally the copy of the previous application, referred to in III, 6.7, is furnished by the International Bureau and not the applicant; in accordance with PCT Rule 17.2, the International Bureau will be requested by the EPO to furnish it with a copy as standard practice promptly but not earlier than international publication or, where the applicant has requested early examination (in accordance with Art. 23(2) of the PCT), not earlier than the date of the request.

Rule 104b(3)

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the period of 21 or 31 months, whichever applies, the EPO shall invite the applicant to furnish the number or copy within such period as it shall specify. Rule 38(3), third sentence, and the Decision of the President of the EPO referred to in III, 6.7 also apply to international applications entering the regional phase before the EPO as designated or elected Office.

Art. 88(1)  
Rule 38(4)

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed in accordance with Rule 38(4) (see III, 6.8 and 6.10);

3.6 In relation to III, 7 the title need only meet the less demanding requirements of PCT Rule 4.3 rather than those set out in III, 7.1 and 7.2.

3.7 As prohibited statements or matter may not necessarily be omitted under PCT Art. 21(6), the application must be examined to ensure that the provisions of III, 8 are complied with. Where the EPO is informed by the International Bureau that statements or matter were omitted from the published PCT application the Receiving Section should ensure that the corresponding material is excluded from the translation as furnished by the applicant.

3.8 The time limit for paying the claims fee referred to in III, 9, as in the case of the "national fee", does not expire before the expiry of the period referred to in VII, 1.3.

3.9 The provisions of III, 10 with regard to the filing of drawings are identical with the corresponding provisions of PCT Art. 14(2) and therefore no supplementary examination should be necessary.

3.10 The abstract (III, 11) is included in the copy of the international application supplied to the EPO.

3.11 The time limit for paying the designation fee (III, 12) which, as already indicated, forms part of the "national fee" does not expire before the expiry of the period referred to in VII, 1.3. If, subsequent to the receipt of the international application by the EPO and prior to the date on which processing or examination may start, the regional designation of the Contracting States of the EPC is withdrawn (PCT Rule 32.1(a)), the application, insofar as it has the effect of a European application, is deemed to be withdrawn.

#### **4. Provisions of Chapter IV**

4.1 In relation to IV, 1 there is no provision made in the PCT for filing divisional applications. One or more European divisional applications may be filed in respect of subject-matter contained in an earlier international application. The formal examination of such a divisional application is not undertaken before the formal examination of the earlier international application. The divisional application must be filed in the language of the earlier application if that language is an official language of the EPO, otherwise it must be filed in the language of the translation of the earlier application as furnished to the EPO.

4.2 Rules 5.2 and 13ter PCT apply to the filing of sequence listings (see IV, 5). The EPO as International Searching Authority makes use of the opportunity under Rule 13ter.1 PCT to invite the applicant where appropriate to furnish it with the prescribed sequence listing in written form or the prescribed data carrier. For the latter WIPO Standard ST. 25 paragraph 39 ff applies (see Art. 4 of the Decision of the President of the EPO dated 2 October 1998 together with the accompanying Notice from the EPO (point III), Supplement No. 2 to OJ 11/1998).

Rule 104b(3a) If a sequence listing is filed subsequently on entry of a Euro-PCT application into the regional phase before the EPO as designated or elected Office, Rule 104b(3a) will apply (see point IV of the above mentioned Notice).

#### **5. Provisions of Chapter VI**

Art. 158(1)  
Art. 158(3) 5.1 The publication of the international application under the PCT takes the place of the publication referred to in VI, 1 provided the international application is published in an official language of the EPO. Where the international application is published in a non-official language the translation of the international application as furnished by the applicant is published by the EPO; the provisions of VI, 1, insofar as they are relevant, apply to such publication.

Art. 157(1)  
Art. 150(2)

5.2 The time limit for filing the request for examination referred to in VI, 2 runs from the date of publication under PCT Art. 21 of the international search report. However, this time limit will not expire before the time prescribed by PCT Art. 22 or 39 (21 or 31 months from the priority date). See also VII, 1.3.

Art. 96(1)

5.3 If a supplementary European search report has to be drawn up in respect of an international application which is deemed to be a European patent application, the applicant is entitled to receive the invitation provided for in Art. 96(1) (see VI, 2.3 and J 08/83, OJ 4/1985, 102).

**CHAPTER VIII**

## LANGUAGES

**1. The languages of the proceedings**

Art. 14(1)  
Art. 14(2)  
Rule 6(1)  
Art. 90(3)

1.1 European patent applications must be filed in one of the official languages of the EPO, viz. English, French or German. However, a person having his residence or principal place of business in a Contracting State which has an official language other than English, French or German (the EPO official languages), or a national of such a State who is resident abroad, may file his application initially in that language (admissible non-EPO language). This means, for example, that a Belgian company may file in Dutch, and that a Swedish national may file in the Swedish language. In such a case, a translation in English, French or German must be filed within three months after the initial filing, but if the application claims priority, the translation must be supplied not later than thirteen months after the earliest priority date. (This could mean within one month of the initial filing of the application). Such translation may be subsequently brought into conformity with the original text of the application (but see VIII, 5.2). If the translation is not filed in time, the application is deemed withdrawn. Under Art. 122 the legal remedy of re-establishment of rights is admissible.

Art. 14(3)  
Rule 1

1.2 The language (chosen from English, French or German) in which the application is filed, or into which it is subsequently translated, constitutes the "language of the proceedings". Amendments to a European patent application or European patent must be filed in the language of the proceedings. This language is also used by the EPO in written proceedings. (As regards documents which are not filed in the correct language, see VIII, 3 below).

Rule 4  
Rule 6(1)

1.3 Any European divisional application must be filed in the language of the proceedings of the earlier application from which it is divided. However, where advantage is taken of Art. 14(2), the divisional application may be filed in the official language of the applicant's State (admissible non-EPO language, see VIII, 1.1) used for the earlier application but must then be translated into the language of the proceedings for the earlier application. The period for filing the translation is one month from the filing of the divisional application if that period expires later than the period referred to in Rule 6(1), first sentence (see VIII, 1.1); the same period applies for a new European patent application filed under Art. 61(1)(b).

**2. Derogation from the language of the proceedings in written proceedings**

Rule 1(1)  
Art. 14(3)

2.1 In written proceedings before the EPO any party may use any official language of the EPO. However, in such



- Rule 6(2) proceedings the EPO uses the language of the proceedings in the sense of Art. 14(3). If a document which has to be filed within a time limit is filed by the persons referred to in Art. 14(2) in an admissible non-EPO language (see VIII, 1.1), the prescribed translation may be filed in any of the official languages of the EPO. Normally, the period allowed for filing this translation is one month after filing of the document, but if the document is a notice of opposition or appeal, the period extends to the end of the opposition or appeal period, if this period expires later.
- Rule 1(3) 2.2 Documents which are to be used as evidence may be filed in any language. This applies during any proceedings before the EPO and applies especially to publications (for instance, an extract from a Russian periodical cited by an opponent to show lack of novelty or lack of inventive step). However, the department dealing with the case may require a translation in one of the languages of the EPO, at the choice of the person filing the document. If the document is filed by the applicant in pre-grant proceedings the Examining Division should require a translation unless the examiners are fully competent in the language concerned. In most cases, however, such documents will be filed in opposition proceedings and a translation should be required. The department concerned may require this translation to be filed within a time limit. This is to be fixed on a case-to-case basis. The period allowed must not be less than one month, and should depend on the particular language concerned and on the length of the document to be translated.
- Rule 5 When a translation of any document must be filed, the EPO may require the filing of a certificate that the translation corresponds to the original text within a period to be determined by it. Failure to file the certificate in due time shall lead to the document being deemed not to have been received unless the Convention provides otherwise.
- 3. Documents filed in the wrong language**
- Art. 78(1)  
Art. 80 3.1 As explained in VIII, 1.1, all the documents making up a European application (i.e. those listed in II, 4.1) must be filed in one of the languages referred to in Art. 14(1) and (2). If the description and claims are not filed in one of these languages a date of filing cannot be accorded (Art. 80(d)). This is particularly the case when the application is wrongly filed in an admissible non-EPO language (for instance in Italian by an applicant who is resident in Sweden and is not an Italian national).
- Art. 14(5)  
Rule 1(1)(2)  
Art. 14(2)  
Art. 128(4) 3.2 If any document other than those making up the application (e.g. a letter from the applicant in reply to an invitation under Art. 96(2) or a written observation under Art. 115) is not filed in one of the prescribed languages or, where the applicant avails himself of Art. 14(2), the required translation is not filed in due time, it is deemed not

to have been received. Third parties may present their observations in German, English or French. The person who has filed the document must be notified accordingly by the EPO. Accompanying documents relating to performance of a procedural act subject to a time limit (e.g. filing the designation of the inventor, the certified copy of the earlier application for which priority is claimed or that application's translation under Rule 38(4) into one of the official languages of the EPO) are dealt with as follows: if the European application number is given, the document goes into the dossier and the procedural act is recognised as having been performed, but any other contents are ignored. Regarding the signature of accompanying documents, see IX, 3.1. Even though deemed not to have been received, the document not filed in the prescribed language will become part of the file and therefore accessible to the public according to Art. 128(4). Observations by third parties and notices of oppositions will be communicated to the applicant or the patent proprietor, respectively, even if they have not been filed in the prescribed language (see E-VI, 3 and D-IV, 1.1, cf. Rule 56(1) and D-IV, 1.2.1 (e) regarding the legal consequences where a notice of opposition or notice of intervention of the assumed infringer is filed in a non-prescribed language, and Rule 65(1) in the case of appeals by the opponent or the intervening infringer filed in a non-prescribed language).

#### 4. Translation of the priority document

This point is dealt with in III, 6.8 and 6.10 and C-V, 3.2 and 3.3.

#### 5. Authentic text

Art. 70(1)

5.1 The text of an application or patent in the language of the proceedings is the authentic text. It follows therefore that the translation of the claim of the patent specification required by Art. 14(7) is for information only.

Rule 7  
Art. 70(2)  
Art. 14(2)

5.2 Where the facility provided for by Art. 14(2) has been used and the question arises as to whether a particular amendment proposed by the applicant or proprietor extends the content of the application or patent beyond the content of the application as filed and thus offends against Art. 123(2) the EPO should normally assume, in the absence of proof to the contrary, that the original translation into English, French or German is in conformity with the text in the original language, say Dutch. However, it is the original text which constitutes the basis for determining such a question. Similarly, it is the original text which determines the content of the application as filed for the purposes of Art. 54(3) (see C-IV, 6.1). An erroneous translation from Dutch or one of the other languages covered by Art. 14(2) may be brought into conformity with the original language at any time during proceedings before the EPO, i.e. during pre-grant proceedings and also

during opposition proceedings. But during opposition proceedings any amendment to bring the translation into conformity must not be allowed if it offends against Art. 123(3), that is if it is an amendment of the claims of the patent which extends the protection conferred.

#### **6. Certificate of translation**

Rule 5

The EPO has the power to require a certificate that any translation supplied corresponds to the original text. The exercise of this requirement should be determined on a case-to-case basis and ought to be used only when the official concerned has serious doubts as to the accuracy of the translation. The certificate could be called for either from the person who made the translation or from some other competent person.

Rule 51(6)

Certificates are not in principle required in respect of the translations of the claims into the other two official languages required under Rule 51(6).

#### **7. Derogations from the language of the proceedings in oral proceedings**

These derogations are dealt with in E-V.

**CHAPTER IX**

## COMMON PROVISIONS

**1. Representation**

Art. 133(1)  
Art. 91(1)(a)  
Art. 133(2)  
Rule 101(1)

1.1 Subject to the next sentence "no person shall be compelled to be represented by a professional representative in proceedings before the EPO"; this holds for all parties to such proceedings, e.g. applicants, proprietors, opponents. A party (natural or legal person) who has neither his residence nor principal place of business in a Contracting State must be represented by a professional representative; the party must act through this professional representative in all proceedings (other than filing the application including all acts leading to the assignment of a date of filing). To "be represented" is to be interpreted as meaning due representation, including not only notice of the appointment of a professional representative but also where applicable the filing of authorisations of the appointed representative (see 1.5). Should an opponent who is party to the proceedings and does not have either a residence or his principal place of business within the territory of one of the contracting states fail to meet the requirement set out under Art. 133(2) in the course of the opposition procedure (e.g. the representative withdraws from the opposition case or the appointed representative is deleted from the list of professional representatives), he is requested to appoint a new representative. Irrespective of whether he does so, he should nevertheless be informed of the date and location of any oral proceedings. However, it has to be drawn to his attention that if he appears only by himself he is not entitled to act before the Division.

Art. 133(3)  
Art. 134(1)  
Art. 134(7)  
Rule 101(1)

1.2 Parties having their residence or principal place of business in a Contracting State are not obliged to be represented by a professional representative in proceedings before the EPO. They may, irrespective of whether they are legal or natural persons, be represented by an employee, who need not be a professional representative but who must be authorised. However, where such parties wish to be represented professionally before the EPO, such representation may only be by a professional representative. The parties themselves may also act directly before the EPO, even if they are represented by an employee or a professional representative. When conflicting instructions are received from the party and his representative, each should be advised of the other's action.

Art. 133(4)  
Rule 100(1)

1.3 Joint applicants, joint proprietors of patents and more than one person giving joint notice of opposition or intervention may act only through a common representative. If the request for the grant of a European patent, the notice of opposition or the request for intervention does not name a common representative, the party first named in the

relevant document will be considered to be the common representative. This representative can thus be a legal person. However, if one of the parties is obliged to appoint a professional representative this representative will be considered to be the common representative unless the first named party in the document has appointed a professional representative. If during the course of proceedings transfer is made to more than one person, and such persons have not appointed a common representative, the preceding provisions will apply. If such application is not possible, the EPO will require such persons to appoint a common representative within two months. If this request is not complied with, the EPO will appoint the common representative.

For Rule 100 to apply, each party or his duly authorised representative must have signed the document (request for grant, notice of opposition, etc.) giving rise to his participation (see also III, 4.4 and IX, 3.2 and 3.5). Otherwise the party cannot take part in the proceedings, nor therefore be represented by a common representative.

Art. 134(1)  
Art. 134(7)

1.4 "Professional representation of natural or legal persons" or companies equivalent to legal persons "may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the EPO". (However see next sentence and IX, 1.2 above). "Professional representation may also be undertaken in the same way as by a professional representative by any legal practitioner qualified in one of the Contracting States and having his place of business within such State, to the extent that he is entitled, within the said State, to act as a professional representative in patent matters."

Rule 101(1)

1.5 Representatives acting before the EPO must on request file a signed (see IX, 3.2) authorisation within a period to be specified by the EPO. If the requirements of Art. 133(2) are not fulfilled the same period will be specified for the communication of the appointment and where applicable for the filing of the authorisation. Professional representatives who identify themselves as such will be required to file a signed authorisation only in certain cases (see Decision of the President of the EPO, OJ 9/1991, 489). However, a legal practitioner entitled to act as a professional representative in accordance with Art. 134(7), or an employee acting for an applicant in accordance with Art. 133(3) first sentence but who is not a professional representative, must file a signed authorisation; in Euro-PCT proceedings persons representing clients in these capacities are not required to file signed authorisations if they have already filed an authorisation expressly covering proceedings established by the EPC with the EPO as receiving Office.

Art. 133(2)  
Rule 101(2)  
Rule 101(5)  
Rule 101(6)  
Rule 101(7)

1.6 The authorisation can also be filed by the applicant. This also applies where the applicant is obliged to be represented, as fulfilling the requirement to be represented is not itself a procedural step under Art. 133(2) to which the rule of obligatory representation applies. An authorisation may cover more than one application or patent, in which case the authorisation is filed in the corresponding number of copies. However, in the case of a general authorisation enabling a representative to act in respect of all the patent transactions of the party making the authorisation, a single copy of this general authorisation may be filed. A corresponding procedure applies to the withdrawal of an authorisation. An authorisation remains in force until its termination is communicated to the EPO. The authorisation will not terminate upon the death of the person who gave it unless the authorisation provides to the contrary.

Rule 101(1)  
Rule 84  
Rule 101(4)

1.7 Where the appointment of a legal practitioner entitled to act as professional representative in accordance with Art. 134(7), or an employee acting for an applicant in accordance with Art. 133(3) first sentence but who is not a professional representative, is communicated to the EPO without an authorisation being filed, the representative is invited to file the authorisation within a period to be specified by the EPO. Where a party having neither residence nor principal place of business within a Contracting State has failed to fulfil the requirements of Art. 133(2) (cf. 1.1) the invitation will be sent to him. The same period will be specified for the communication of the appointment and where applicable for the filing of the authorisation. The period may be extended in accordance with Rule 84 on request by the representative or party as the case may be (see E-VIII, 1.6). If such authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application will, without prejudice to any other legal consequences provided for in the Convention, be deemed not to have been taken. The party is informed accordingly.

## 2. Form of documents

2.1 The physical requirements which the documents making up the European patent application, i.e. request, description, claims, drawings and abstract, must satisfy are set out in Rule 35, and with regard to drawings in Rule 32. Notes on the preparation of OCR-readable patent applications were published in OJ 1-2/1993, 59. In relation to the drawings the particular requirements are dealt with in Chapter X. This Chapter should also be consulted with regard to the other documents mentioned as the comments therein on the provisions of Rule 35 are of general application. Attention need only be drawn to Rule 35(9) which states that "the lines of each sheet of the description and of the claims shall preferably be numbered in sets of

five, the numbers appearing on the left side, to the right of the margin".

When preparing the application with the EP-EASY software, the printout of the request for grant will fulfil the requirements of Rules 26 and 35. As concerns the technical documents, at least the description and the claims of the application have to be created by using a standard word-processor and have to be stored on the diskette in the prescribed electronic format. The printout of the technical documents will have to satisfy the requirements of Rule 35, like any other of the application documents.

Rule 35(1)  
Rule 36(1) 2.2 Replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) are subject to the same requirements as the documents making up the application.

Rule 36(2) 2.3 Documents other than those referred to in the previous paragraphs should be "typewritten or printed" with a "margin of about 2.5 cm on the left-hand side of each page".

Rule 36(4) 2.4 "Such documents as must be communicated to other persons or as relate to two or more European patent applications or European patents must be filed in a sufficient number of copies" so that each party will have a document for each application or patent. If within a short period, which should be set at two to four weeks, "the party concerned does not comply with this obligation in spite of a request by the EPO the missing copies shall be provided at the expense of the party concerned".

Rule 36(5) 2.5 After a European patent application has been filed, documents as referred to in Rule 36 EPC, with the exception of authorisations and priority documents, may be filed by telegram, telex or facsimile at the EPO's filing offices (see II, 1.1). Such documents may not at present be filed on diskette or similar data carriers, by teletex, via the Internet or similar means. If documents relating to European patent applications are filed by telegram, telex or facsimile, written confirmation reproducing the contents of the documents filed by these means and complying with the requirements of the Implementing Regulations to the EPC must, at the invitation of the EPO department charged with the procedure, be supplied within a non-extendable period of one month. If the applicant fails to comply with this invitation in due time, the telegram, telex or facsimile is deemed not to have been received (cf. Decision of the President of the EPO, OJ 6/1992, 299).

Written confirmation is required if:

(i) the application or the designation of a Contracting State is withdrawn in the document;

(ii) the documents or drawings in question alter or replace application documents;

(iii) the documents so communicated are of inferior quality

(cf. Notice from the EPO, OJ 6/1992, 306).

Art. 14(4)  
Rule 6(2)  
Art. 122

If in a telegram, telex or facsimile a party avails himself of Art. 14(4), the subsequent copy must be filed in the same language as the telegram, telex or facsimile, in which case the copy is deemed to have been received on the date of filing of the telegram, telex or facsimile. The period under Rule 6(2) for filing the translation under Art. 14(4) begins on the day following the date of filing of the telegram, telex or facsimile. Reestablishment of rights may be requested in respect of the periods under Rules 36(5) and 6(2).

### 3. Signature of documents

Rule 36(3)  
Art. 133

3.1 All documents other than annexes filed after filing the European patent application must be signed by the person responsible. The principles of Art. 133 are that only the applicant or his representative may act in the European patent grant procedure. Documents filed after filing the European patent application may therefore be effectively signed only by these persons.

Documents such as the priority document or the translation thereof must be accompanied by a separate letter or at least bear a note on the document itself that it is addressed to the EPO, duly signed by a person authorised to act before the EPO. This also applies, for example, to the designation of inventor if this has been signed by an applicant with neither residence nor principal place of business in one of the Contracting States to the EPC. As regards the authorisation see 1.5. The signature of the entitled person confirming performance of a written act of procedure helps to clarify the state of the proceedings. It shows whether the act of procedure has been validly performed, and also prevents circumvention of the provisions relating to representation. Form 1038 (Letter accompanying subsequently filed items) may also be used as a separate letter. However, a separate form must be used for each file (see Notice from the EPO, OJ 1-2/1991, 64).

Rule 36(3)

If the signature is omitted on a document not falling within the meaning of IX, 3.2, the EPO must invite the party concerned to sign within a fixed time limit. This also applies if the document in question bears the signature of an unentitled person (e.g. the secretary of an authorised representative), a deficiency which for the purposes of the time limits under way is treated as equivalent to omission of the signature of an entitled person. "If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been received."



3.2 In addition to the documents referred to in IX, 3.1 above, certain documents forming part of the application must be signed. These documents include the request for grant, the designation of the inventor and where applicable the authorisation of a representative. In the case of European applications filed together with a diskette and a printout generated by the EP-EASY software, the conformity statement (stating that the contents of the diskette are identical to the paper print-out filed with the diskette) has to be signed as well.

With the exception of the authorisation of a representative, the documents may be signed by an appointed representative instead of the applicant.

3.3 A rubber stamp impression of a party's name, whether a natural or legal person, must be accompanied by a personal signature. Initials or other abbreviated forms will not be accepted as a signature. Where the party concerned is a legal person a document may in general be signed by any person who purports to sign on behalf of that legal person. The entitlement of a person signing on behalf of a legal person is not checked by the EPO except where there is reason to believe that the person signing is not authorised and in that case evidence of authority to sign should be called for.

3.4 The name of the person filing such documents will be accepted by way of signature on telegrams and telexes, as will the reproduction of their signature on facsimiles. The name and position of that person must be clear from the signature (cf. Notice of the EPO, OJ 6/1992, 306).

Rule 100(1)

3.5 If there is more than one applicant (see IX, 1.3), each applicant or his representative must sign the request for grant and, where applicable, the appointment of the common representative. This also applies if one of the applicants is considered the common representative pursuant to Rule 100(1), first sentence. However, the common representative may sign the designation of inventor and all documents filed after the filing of the application pursuant to Rule 36(3). Authorisations on behalf of more than one applicant must be signed by all applicants.

**CHAPTER X****DRAWINGS**

This Chapter of the Guidelines deals with the requirements to be met by drawings contained in the application or patent.

**1. Graphic forms of presentation considered as drawings****1.1 Technical drawings**

Rule 32(3) All types of technical drawings are considered drawings within the meaning of the Convention; this includes, for instance, perspectives, exploded views, sections and cross-sections, details on a different scale, etc. Drawings also cover "flow sheets and diagrams", under which are subsumed functional diagrams and graphic representations of a given phenomenon which express the relationship between two or more magnitudes.

Rule 35(11) There are also other graphic forms of presentation which may be included in the description, claims or abstract, in which case they are not subject to the same requirements as drawings. The forms concerned are chemical and mathematical formulae and tables. These are dealt with in X, 11. They may nevertheless be submitted as drawings, in which case they are subject to the same requirements as drawings.

**1.2 Photographs**

The EPC makes no express provision for photographs; they are nevertheless allowed where it is impossible to present in a drawing what is to be shown and provided that they are in black and white, directly reproducible and fulfil the applicable requirements for drawings (e.g. paper size, margins, etc.). Colour photographs are not accepted.

**2. Representation of drawings**

Rule 35(11) 2.1 All drawings must be grouped together on the sheets specifically for drawings and may in no event be included in the description, claims or abstract, even if these finish at the top of a page or leave sufficient room, and even if there is only one figure.

Rule 35(2)  
Rule 35(3) 2.2 In accordance with Rule 35(2) and (3) the drawings "shall be filed in three copies" and must be "so presented as to admit of electronic as well as of direct reproduction by scanning, photography, electrostatic processes, photo offset and micro-filming, in an unlimited number of copies."

If the application has been prepared with the EP-EASY software and the drawings are also included on the

diskette, the preparation of such drawings should preferably follow the recommendations of the EPO as detailed in the User's guide.

2.3 As regards the figure, or exceptionally figures, to accompany the abstract, where a European patent application contains drawings, reference should be made to III, 11.3 and B-XI, 4(vi) and 5. The figure(s) illustrating the abstract must be the figure(s) most representative of the invention and must be chosen from the drawings accompanying the application. It is therefore not permissible to draw a special figure for the abstract which differs from the other figures in the application.

### 3. Conditions regarding the paper used

Rule 35(4) Drawings must be on sheets of A4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable (recommended paper weight: 80-120 g/m<sup>2</sup>, see OJ 1-2/1994, 74).

Rule 35(3) All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used. The use of card is not allowed.

Rule 35(14) "Each sheet shall be reasonably free from erasures and shall be free from alterations, overwritings and interlineations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy."

Any corrections made must be durable and permanent, so that they cannot give rise to any doubt. They must be made on all copies of the application. Special products for corrections, such as white masking fluid, may be used, provided they are indelible and comply with the other requirements under Rule 35(14).

Rule 35(5) "The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again".

Permanent fastenings (for example, crimped eyelets) are not permitted. Only temporary fastenings (staples, paper clips and grips, etc.), which leave only slight marks in the margin, may be used.

### 4. Presentation of the sheets of drawings

#### 4.1 Usable surface area of sheets

Rule 32(1) "On sheets containing drawings, the usable surface area shall not exceed 26.2 cmx17 cm. These sheets shall not contain frames round the usable or used surface. The minimum margins shall be as follows: top side: 2.5 cm; left side: 2.5 cm; right side: 1.5 cm; bottom: 1 cm."

Rule 35(7) Under Rule 35(7) no entries may be made in the margins. The drawings must be so set out that they do not overlap into the minimum margin defined in Rule 32(1).

#### 4.2 Numbering of sheets of drawings

Rule 35(8) "All the sheets contained in the European patent application shall be numbered in consecutive arabic numerals. These shall be placed at the top of the sheet, in the middle, but not in the top margin".

Rule 32(1) The sheets of drawings must be numbered within the maximum usable surface area as defined in Rule 32(1). Instead of numbering the sheet in the middle, it will, however, be acceptable for it to be numbered towards the right-hand side if the drawing comes too close to the middle of the edge of the usable surface. This numbering should be clear, for example in numbers larger than those used for reference numbers.

Rule 35(5) Rule 35(8) requires all application sheets to be numbered consecutively. According to Rule 35(5) the application consists of all the following documents: the request, the description, the claims, the drawings and the abstract. The numbering should preferably be effected by using three separate series of numbering each beginning with one, the first series applying to the request only and being already printed on the form to be used, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable only to the sheets of the drawings and commencing with the first sheet of such drawings.

There are no objections to including the description, claims and drawings in one series of numbering beginning with one. The series of numbering must then commence with the first sheet of the description.

### 5. General layout of drawings

The various figures on the same sheet of drawings must be laid out according to certain requirements as to page-setting and numbering, and figures divided into several parts must comply with particular requirements.

#### 5.1 Page-setting

Rule 32(2)(h) As far as possible all figures of the drawings should be set out upright on the sheets. If a figure is broader than it is high, it may be set out so that the top and bottom of the figure lie along the sides of the sheet with the top of the figure on the left side of the sheet.

In this case, if other figures are drawn on the same sheet, they should be set out in the same way, so that all the figures on a single sheet lie along parallel axes.

Where the sheet has to be turned in order to read the figures, the numbering should appear on the right-hand side of the sheet.

### 5.2 Numbering of figures

Rule 32(2)(h) "The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets."

Rule 32(2)(d) This numbering should be preceded by the abbreviation "FIG", whatever the official language of the application. Where a single figure is sufficient to illustrate the invention, it should not be numbered and the abbreviation "FIG" must not appear. Rule 32(2)(d) also applies to numbers and letters identifying the figures, i.e. they must be simple and clear and may not be used in association with brackets, circles, or inverted commas. They should also be larger than the numbers used for reference signs.

An exception to Rule 32(2)(h) referred to above may be permitted only as regards partial figures intended to form one whole figure, irrespective of whether they appear on one or several sheets. In this case the whole figure may be identified by the same number followed by a capital letter (e.g. figures 7A, 7B).

### 5.3 Whole figure

Rule 32(2)(h) "Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures."

Partial figures drawn on separate sheets must always be capable of being linked edge to edge, that is to say no figure may contain parts of another.

The case may arise where the parts of a whole figure are drawn on a single sheet following a layout different from that of the whole figure, e.g. a very long figure divided into several parts placed one above the other and not next to one another on a sheet. This practice is permitted. However, the relationship between the different figures must be clear and unambiguous. It is therefore recommended that a scaled-down figure be included showing the whole formed by the partial figures and indicating the positions of the sections shown.

**6. Prohibited matter**

Rule 34(1)  
Rule 34(2)

The provisions as to the omission of prohibited matter within the meaning of Rule 34(1)(a) (see III, 8.1 and C-II, 7.1) apply also to drawings.

Rule 34(1)(c)

Statements or other matter of the type referred to under Rule 34(1)(c) (see C-II, 7.3) which are likely to appear in drawings are in particular various kinds of advertising, e.g. where the applicant includes in the drawing obvious business or departmental markings or a reference to an industrial design or model, whether registered or not. By so doing, matter would be introduced which is clearly irrelevant or unnecessary, which is expressly prohibited by Rule 34.

**7. Executing of drawings****7.1 Drawings of lines and strokes**

Rule 32(2)(a)  
Rule 35(3)

Rule 32(2)(a) sets certain standards for lines and strokes in the drawing, to permit of satisfactory reproduction by the various means described in Rule 35(3).

The drawings must be executed in black.

Heliographic prints seldom satisfy the requirements for drawings and it is therefore strongly advised that copies of this type are not filed.

In all cases the thickness of the lines and strokes must take into account the scale, nature, execution and perfect legibility of the drawing and of the reproductions.

Rule 32(2)(e)

All lines must be drawn with the aid of drafting instruments save those for which no instrument exists, e.g. irregular diagrams and structures.

**7.2 Shading**

The use of shading in figures is allowed provided this assists in their understanding and is not so extensive as to impede legibility.

**7.3 Cross-sections****7.3.1 Sectional diagrams**

Where the figure is a cross-section on another figure, the latter should indicate the position and may indicate the viewing direction.

Each sectional figure should be capable of being quickly identified, especially where several cross-sections are made on the same figure, e.g. by inscribing the words "Section on AB", or to avoid the use of lettering, by mark-

ing each end of the cross-section line on the diagram with a single Roman numeral. This number will be the same as the (arabic) numeral identifying the figure where the section is illustrated. For example, figure 22 illustrates a section taken along the line XXII-XXII of figure 21.

#### 7.3.2 Hatching

##### Rule 32(2)(b)

A cross-section must be set out and drawn in the same manner as a normal view whose parts in cross-section are hatched with regularly spaced strokes, the space between strokes being chosen on the basis of the total area to be hatched.

Hatching should not impede the clear reading of the reference signs and leading lines. Consequently, if it is not possible to place references outside the hatched area, the hatching may be broken off wherever references are inserted. Certain types of hatching may be given a specific meaning.

#### 7.4 Scale of drawings

##### Rule 32(2)(c)

If the scale of the figure is such that all the essential details would not be clearly distinguished if the figure is reproduced, electronically or photographically, with a linear reduction in size to two-thirds then the figure must be redrawn to a larger scale, and if necessary the figure should be split up into partial figures so that a linear reduction in size to two-thirds is still intelligible.

The graphic representation of the scale of drawings in cases where its inclusion is considered useful must be such that it is still usable when the drawing is reproduced in reduced format. This excludes indications of size such as "actual size" or "scale 1/2", both on the drawings and in the description, in favour of graphic representations of the scale.

#### 7.5 Numbers, letters and reference signs

##### Rule 32(2)(d)

Numbers, letters and reference signs and any other data given on the sheets of drawings, such as the numbering of figures, pages of the drawing, acceptable text matter, graduations on scales, etc., must be simple and clear, and not used in association with any brackets, inverted commas, circles or outlines whatsoever. Signs such as 6' and 35" are not regarded as including inverted commas and are therefore permitted.

Numbers, letters and reference signs should preferably all be laid out the same way up as the diagram so as to avoid having to rotate the page.

### 7.5.1 Leading lines

This means the lines between reference signs and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference sign and extend at least as far as the features indicated.

Rule 32(2)(a) Leading lines must be executed in the same way as lines in the drawing, viz. in accordance with Rule 32(2)(a).

### 7.5.2 Arrows

Arrows may be used at the end of the leading lines provided that their meaning is clear. They may indicate a number of points:

- (i) a freestanding arrow indicates the entire section towards which it points;
- (ii) an arrow touching a line indicates the surface shown by the line looking along the direction of the arrow.

### 7.5.3 Height of the numbers and letters in the drawings

Rule 32(2)(g) Under Rule 32(2)(g) a minimum size of 0.32 cm is required for all numbers and letters used on the drawings so that their reduction in size to two-thirds remains easily legible.

The Latin alphabet should normally be used for letters. The Greek alphabet is to be accepted however where it is customarily used, e.g. to indicate angles, wavelengths, etc.

### 7.5.4 Consistent use of reference signs as between description, claims and drawings

Rule 32(2)(i) "Reference signs not mentioned in the description and claims shall not appear in the drawing, and vice versa."

Reference signs appearing in the drawing must be given in the description and the claims taken as a whole. As regards use of these signs in the claims, reference should be made to C-III, 4.11

Rule 35(14) Features of a drawing should not be designated by a reference in cases where the feature itself has not been described. This situation may arise as a result of amendments to the description involving the deletion of pages or whole paragraphs. One solution would be to strike out on the drawing reference signs which have been deleted in the description. Such corrections would have to be made in accordance with Rule 35(14).

Where for any reason a figure is deleted then of course the applicant or proprietor ought to delete all reference signs



relating solely to that figure appearing in the description and claims.

In the case of applications dealing with complex subjects and incorporating a large number of drawings, a reference key may be attached to the end of the description. This key may take whatever form is appropriate and contain all the reference signs together with the designation of the features which they indicate. This method could have the advantage of standardising the terminology used in the description.

#### 7.5.5 Consistent use of reference signs as between drawings

#### Rule 32(2)(i)

"The same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs."

There would be considerable confusion if a single feature were allocated different reference signs in the various drawings. However, where several variants of an invention are described, each with reference to a particular figure, and where each variant contains features whose function is the same or basically the same, the features may, if this is indicated in the description, be identified by reference numbers made up of the number of the figure to which it relates followed by the number of the feature, which is the same for all variants, so that a single number is formed, e.g. the common feature "15" would be indicated by "115" in Fig. 1 while the corresponding feature would be indicated by "215" in Fig. 2. This system has the advantage that an individual feature and the figure on which it is to be considered can be indicated at the same time. It can also make complex cases involving many pages of drawings easier to read. Instead of the common reference sign being prefixed by the number of a figure, it may, when the individual variants are described with reference to particular groups of figures, be prefixed by the number of the particular variant to which it relates; this should be explained in the description.

#### 7.6 Variations in proportions

#### Rule 32(2)(f)

"Elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure."

As a preferred alternative to a difference in proportion within one figure for the purpose of achieving the necessary clarity, a supplementary figure may be added giving a larger-scale illustration of the element of the initial figure. In such cases it is recommended that the enlarged element shown in the second figure be surrounded by a finely drawn or "dot-dash" circle in the first figure pinpointing its location without obscuring the figure.

**8. Text matter on drawings**

Rule 32(2)(d)  
Rule 32(2)(g)

It should first be noted that Rule 32(2)(d) and (g) also applies to text matter on the drawings.

For indications of the type "section on AB" see X, 7.3.

Rule 32(2)(j)

"The drawings shall not contain text matter, except, when absolutely indispensable, a single word or a few words."

Where text matter is deemed indispensable for understanding the drawing, a minimum of words should be used, and a space free of all lines of drawings should be left around them for the translation.

As regards the justification for text matter on drawings, see C-II, 5.1, 5.2.

**9. Conventional symbols**

Rule 35(12)

Known devices may be illustrated by symbols which have a universally recognised conventional meaning, provided no further detail is essential for understanding the subject-matter of the invention. Other signs and symbols may be used on condition that they are not likely to be confused with existing conventional symbols, that they are readily identifiable, i.e. simple, and providing that they are clearly explained in the text of the description.

Different types of hatching may also have different conventional meanings as regards the nature of a material seen in cross-section.

**10. Amendments to drawings**

Amendments of the drawings are permitted, as well as of the other documents. These amendments may be made at the request of the party concerned or at the request of the EPO. The amendments may concern either clerical errors or more substantial changes.

Amendments to drawings are, in general, subject to the same rules as apply in respect of amendments to other application documents and therefore do not require further analysis here. Reference may be made to III, 14, to V, 2, to C-VI, 3, 4.6, 4.7 and 5 and to E-II.

The general rule governing the admissibility of amendments, which the examiner must always bear in mind, is that they must not extend the content of the application as filed, i.e. they must not have the effect of introducing new material.

If drawings which depart substantially from the physical requirements laid down in the Rules are filed in order to establish a particular date of filing or retain a priority date,

the Receiving Section will permit such drawings to be amended or replaced so as to provide drawings complying with the Rules, provided that it is clear that no new material is thereby introduced into the application. In view of this proviso, applicants should take care that any "informal" drawings which they file clearly show all the features necessary to illustrate the invention.

### **11. Graphic forms of presentation not considered as drawings**

#### 11.1 Chemical and mathematical formulae

Rule 35(10) Chemical or mathematical formulae may be written by hand or drawn if necessary but it is recommended that appropriate aids such as stencils or transfers be used. For practical reasons formulae may be grouped together on one or more sheets annexed to the description and paginated with it. It is recommended in such cases that each formula be designated by a reference sign and the description should contain references to these formulae whenever necessary.

Rule 35(13) The chemical or mathematical formulae must employ symbols in general use and must be drawn in such a way that they are completely unambiguous. Figures, letters and signs which are not typed must be legible and identical in form in the various formulae, irrespective of the document in which they appear.

Rule 35(10)  
Rule 32(2)(g) Chemical or mathematical formulae appearing in the text of the application or patent must have symbols the capital letters of which are at least 0.21 cm high. Where they appear on sheets of drawings, these symbols must be at least 0.32 cm high.

All mathematical symbols used in a formula which appears in a description, in an Annex or on sheets of drawings must be explained in the description, unless their significances is clear from the context. In any case the mathematical symbols used may be collated in a list.

#### 11.2 Tables

(i) - In the description

Rule 35(11) For the sake of convenience, the tables may also be grouped together in one or more sheets annexed to the description and paginated with it.

If two or more tables are necessary, each should be identified by a Roman number, independently of the pagination of the description or drawings or of the figure numbering, or by a capital letter, or by a title indicating its contents, or by some other means.

Each line or column in a table must begin with an entry explaining what it represents and, if necessary, the units used.

Rule 35(10)  
Rule 35(6)

It should be remembered that the characters must satisfy the requirements of Rule 35(10) and that Rule 35(6) regarding the maximum usable surface areas of sheets applies to tables as well.

(ii) - In the claims

The claims may include tables if this is desirable in view of the subject-matter involved. In this case, the tables must be included in the text of the relevant claim; they may not be annexed to the claims nor may reference be made to tables contained in or annexed to the description. Rule 29(6) (see C-III, 4.10) stipulates that the claims may refer to other application documents only where this is absolutely necessary. The mere desire to eliminate the need to prepare further copies does not constitute absolute necessity.

**CHAPTER XI****FEES****1. General**

Rules relating to Fees (RFees)

1.1 Various fees have to be paid for a European patent application, renewing a European patent and obtaining legal remedies. Fees also have to be paid by third parties, such as for applications to inspect the files of European patent applications or European patents. Fees may be validly paid by any person (see Legal Advice No. 6/91 rev., OJ 11/1991, 573). The amounts of the fees, the ways in which they are to be paid and the date of payment are determined in the Rules relating to Fees (RFees). Guidance for the payment of fees, costs and prices with information about

- the current version of the Rules relating to Fees and the schedule of fees
- important implementing rules to the Rules relating to Fees
- the payment and refund of fees and costs
- other notices concerning fees and prices
- Euro-PCT applications
- international applications

as well as the amounts of the principal fees for European, international and Euro-PCT applications and an extract from the Rules relating to Fees is published at regular intervals in the Official Journal. A list of bank and giro accounts opened in the name of the European Patent Organisation and corresponding currencies for payment appears each month on the inside back cover.

1.2 The Convention lays down the time limits for paying fees and the legal consequences of non-compliance with the time limits. The time limits for payment and the legal consequences of non-payment are dealt with in the Chapters of the Guidelines covering the respective stages of the procedure. The methods of payment, the date on which payment is considered to be made, due dates, particulars concerning the purpose of payments and reimbursement of fees are all dealt with below.

Art. 5 RFees

**2. Methods of payment**

Fees may be paid in the following ways:

- (i) by payment or transfer to a bank or giro account held by the European Patent Organisation;

(ii) (deleted)

(iii) by delivery or remittance of cheques made payable to the EPO;

(iv) (deleted)

(v) by debiting a deposit account opened in the records of the EPO in Munich (see XI, 3.6 and 3.7).

**Art. 6 RFees 2a. Currencies**

Payments are to be made in the following currencies:

Art. 6(1) RFees (i) payment or transfer to a bank account or a giro account held by the European Patent Organisation must be made in euro or in the currency of the State in which that account is held;

Art. 6(2) RFees (ii) payment by delivery or remittance of cheques must be made in euro or in the national currency of the country where the banking establishment on which the cheque is drawn is located, provided that the equivalents of the amounts of fees expressed in euro have been laid down in that currency by the President of the EPO;

(iii) (deleted)

(iv) (deleted)

Point 3 ADA (v) debit orders must always relate to an amount in euro. Until 31 December 2001, the end of the transitional period for replacement of national currencies in the member states of the European Union participating in the euro area, debit orders may be made out in euro or in Deutsche Mark (OJ 1/1999, 42).

**3. Date considered as date on which payment is made**

Art. 8(1)(a) RFees 3.1 Payment or transfer to a bank or giro account held by the European Patent Organisation.

Art. 8(3)(4) RFees The date on which the amount is actually entered in the European Patent Organisation's bank account is considered as the date on which payment is made. It is therefore also possible for the day following the inpayment or transfer to be considered as the date on which payment is made or an even later date in the event of delays within the bank or in the post. However, payment may still be considered to have been made in due time, despite being paid late, if the inpayment or transfer has been effected before expiry of the time limit for payment in a Contracting State and, where appropriate, a surcharge has been paid (see XI, 6).

	3.2 (deleted)	
	3.3 (deleted)	
Art. 8(1)(c) RFees	3.4 Delivery or remittance of a cheque made payable to the EPO	
	The payment is considered to be made on the date of delivery, where the cheque is delivered to one of the filing offices of the EPO and on the day the cheque is received at the EPO where it is sent by post. Outside office hours the cheque may also be posted in the automated mail-box of the EPO in Munich or Berlin and the day on which it was posted in the automated mail-box is considered to be the date of payment (Notice from EPO, OJ 6/1992, 306). That date of payment holds good only if the cheque is met.	
	3.5 (deleted)	
Art. 8(2) RFees	3.6 Deposit accounts with the EPO	
Arrangements for deposit accounts (ADA)	3.6.1 The Arrangements for deposit accounts (hereinafter abbreviated to "ADA") and their annexes have been revised and published in a Supplement to OJ 2/1999. Until 31 December 2001, the end of the transitional period for replacement of national currencies in the member states of the European Union participating in the euro area, transitional provisions will apply additionally (see OJ 1/1999, 42). A distinction must be drawn, in connection with deposit accounts, between:	
Point 4 ADA	(i) payments to replenish deposit accounts; and	
Point 6 ADA	(ii) payments of fees or of costs for publications or services of the EPO by debiting the deposit account.	
Point 4 ADA Point 3 ADA	3.6.2 Inpayments to replenish a deposit account are to be made in euro. Payments in a different currency will only be accepted if freely convertible. Payments can be made in any of the ways referred to in 3.1 to 3.5. However, the deposit account will always be credited in euro (the only currency in which these accounts are kept) after conversion at the current rate of exchange. In respect of the use of Deutsche Mark in the transitional period until 31 December 2001, see 3.6.1.	
Point 6.3 ADA Point 6.2 ADA	3.6.3 The debit order must contain particulars necessary to identify the purpose of the payment and must indicate the number of the account which is to be debited. The Boards of Appeal have decided that a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear (see T 152/82, OJ 7/1984, 301). Debit orders can be filed in writing or by fax, telegram or telex. In these latter cases no confirmation should be filed, to avoid the risk of payment being debited twice.	

Point 6.3 ADA  
Point 6.9 ADA  
Point 6.10 ADA

3.6.4 Provided that there is a sufficient amount in the deposit account the date of receipt of the debit order by the EPO will be considered as the date on which the payment is made. This is also applicable where a debit order is filed together with an application under point 6.9 ADA with a competent national authority of a Contracting State. If the debit order is not received at the EPO until after expiry of the period allowed for payment of fees due on filing, that period is deemed to have been observed if evidence is available or presented to the EPO to show that the debit order was filed with the competent authority of the Contracting State at the same time as the application, provided that sufficient funds were available in the account at the time the period expired.

Point 6.4 ADA  
Point 6.5 ADA  
Point 6.6 ADA

If on the date of receipt of a debit order, there are insufficient funds in the deposit account for the payment of a fee (shortfall), this fact will be communicated to the account holder by the Cash and Accounts Department of the EPO; by replenishing the account and paying an administrative fee, the holder can ensure that the date of receipt of the debit order is deemed to be the date on which payment was effected. The administrative fee is 30% of the shortfall; the Arrangements for deposit accounts further fix a maximum and a minimum amount for the administrative fee.

Point 7 ADA

3.7 Automatic debiting procedure

Arrangements for the automatic debiting procedure (AAD)

A deposit account may also be debited on the basis of an automatic debit order signed by the account holder (automatic debiting procedure). Such an order may only be filed on behalf of the applicant or the patent proprietor or his representative, and extends to all types of fees covered by the automatic debiting procedure and payable by him in respect of the proceedings specified in the automatic debit order. As the proceedings progress, each such fee shall be automatically debited and treated as having been paid in due time. The automatic debit order may not be restricted to specific types of fees. The Arrangements for the automatic debiting procedure (AAD) plus explanatory notes are published in the Supplement to OJ 2/1999. In respect of the use of Deutsche Mark during the transitional period until 31 December 2001, see 3.6.1

#### 4. Due date for fees

##### 4.1 General

Art. 4(1) RFees  
Rule 37(1)  
2nd sentence

4.1.1 In the EPC, the term "due date" has a special meaning, namely the first day on which payment of a fee may be validly effected, not the last day of a period for such payment (see XI, 6 "Payment in due time" below). The due date for fees is generally laid down by provisions of the Convention or of the PCT. If no due date is specified, the fee is due on the date of receipt of the request for



the service incurring the fee concerned. A fee may not be validly paid before the due date. The only exception from that principle is with renewal fees, which may be validly paid up to one year before the due date (see XI, 4.2.4).

4.1.2 Payments made before the due date which are not valid may be refunded by the EPO. If payment is made shortly before the due date, it is possible that the EPO will not return the payment. In this case, however, payment only takes effect on the due date. See XI, 4.2.4 regarding renewal fees for a European patent application.

4.1.3 When the fees are increased the date of payment is set as the relevant date for determining the amount of the fees (cf. most recently Art. 2 of the decision of the Administrative Council dated 5 June 1992, OJ 7/1992, 344). Setting the date of payment as the relevant date makes it unnecessary as a rule to ascertain the actual due date for determining the amount of the fee. Fees cannot validly be paid before the due date (with the exception of renewal fees - see XI, 4.1.1). Thus, for example, the fees for grant and printing cannot be validly paid in advance before notification of the communication under Rule 51(6).

#### 4.2 Due date for specific fees

4.2.1 The filing fee, the search fee, designation fees and any claims fees payable (for claims filed with the application) are due on the day the European patent application is filed.

4.2.2 The examination fee is due when the written request for examination is filed. Since the latter is contained in the prescribed form for the request for grant (Form 1001), the examination fee may be paid straight away on the date of filing of the European patent application if the application is filed with said prescribed Form 1001. It may be paid up to expiry of the period laid down in Art. 94(2).

4.2.3 The fee for grant, including the fee for printing, falls due on notification of the communication under Rule 51(6) requesting that these fees be paid. Under Rule 51(7), the same applies for the claims fees.

Rule 37(1)  
Art. 86(2)  
Rule 37(2)

4.2.4 Renewal fees for a European patent application in respect of the coming year are due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than one year before they fall due. Renewal fee payments which are not valid will be refunded by the EPO. If payment is made only shortly before the permissible prepayment period, the Office may elect not to return the payment. In this case, however, payment only takes effect on the first day of the permissible prepayment period. If the renewal fee has not been paid on or before the due date, it may be validly paid within six months of the

said date, provided that the additional fee is paid within this period. For the calculation of the additional period, see J 4/91, OJ 8/1992, 402. Whilst the applicant's attention is drawn to this possibility, he may not invoke the omission of such notification (see J 12/84, OJ 4/1985, 108, and J 1/89, OJ 1-2/1992, 17). See also Legal Advice No. 5/93 rev., OJ 4/1993, 229 for Euro-PCT applications under Art. 39(1) PCT. For renewal fees for European divisional applications see IV, 1.4.3.

The obligation to pay renewal fees terminates with the payment of the renewal fee due in respect of the year in which the mention of the grant of the European patent is published (Art. 86(4); see OJ 6/1984, 272).

Art. 6(4) RFees

#### **5. Equivalents in currencies other than Deutsche Mark**

5.1 For payments to the EPO in currencies other than euro, the President of the EPO lays down the equivalents in other currencies of the fees payable pursuant to the Rules relating to Fees which are expressed in euro. The equivalent payable is that applying on the day of payment. If the applicable equivalent of a fee is paid, the corresponding amount of the fee fixed by the Administrative Council in euro is considered to have been paid.

5.2 If new equivalents are fixed they will be binding on payments for fees which are made on or after the date laid down by the President of the EPO. If the old equivalent is paid within a period of six months after the entry into force of the new equivalents, the applicant will be requested to pay the shortfall between the old and the new equivalent within two months after communication of such request. No surcharge is payable (see the transitional provisions in the Decisions of the President of the EPO laying down new equivalents).

5.3 The ten-day fail-safe arrangement (see XI, 6.2) does not apply to the relevant dates from which new equivalents become effective (see XI, 6.2.6).

#### **6. Payment in due time**

##### **6.1 Basic principle**

A fee is considered to have been paid in due time if the date of payment (see XI, 3) fell on or before the last day of the relevant time limit - or the time limit extended pursuant to Rule 85.

##### **6.2 Ten-day fail-safe arrangement**

Art. 8(3)(4) RFees

6.2.1 If the payer provides evidence to the EPO that within the period in which the payment should have been made in an EPC Contracting State

- (i) he effected payment through a banking establishment or a post office, or
  - (ii) he duly gave an order to a banking establishment or a post office to transfer the amount of the payment, or
  - (iii) he despatched at a post office a letter bearing the address of one of the filing offices (see II, 1.1) of the EPO and containing a cheque made payable to the EPO provided that the cheque is met, or
  - Point 6.8 ADA (iv) he despatched at a post office a letter bearing the address of one of the filing offices of (see II, 1.1) the EPO containing the debit order, provided that there is a sufficient amount in the account on the date on which the time limit expires
- he is considered to have observed the period for payment even if the payment is not actually entered in the bank or giro account of the European Patent Organisation until after the expiry of the period or if a cheque or debit order despatched to the EPO is received there after the expiry of the period.
- Art. 8(3)(b) RFees  
Art. 8(4) RFees If the payment has been effected later than 10 days before expiry of the period for payment but within that period, a surcharge of 10% on the relevant fee or fees, but not exceeding EUR 153, must also be paid.
- Point 5.2 ADA 6.2.2 The ten-day fail-safe arrangement under Art. 8(3) and (4) RFees applies *mutatis mutandis* to payments to replenish deposit accounts. If one of the steps referred to under XI, 6.2.1(i) to (iii) is carried out in order to replenish a deposit account and, where appropriate, the surcharge is paid, the account is considered to have been replenished at the latest on the tenth day after one of those steps was taken for the purpose of complying with time limits for payment by issuing debit orders.
- Point 6.10 ADA 6.2.3 For debit orders accompanying applications filed with a competent national authority, see 3.6.4.
- 6.2.4 If a fee can be paid within a normal period at the normal fee rate or within a period of grace with a surcharge, the ten-day fail-safe arrangement also applies when determining whether the normal period was complied with.
- 6.2.5 If an applicant who has been sent a communication under Rule 69(1) noting non-compliance with a time limit for payment claims that the payment was made in due time pursuant to Art. 8(1), (3) and (4) of the Rules relating to Fees and points 5.2, 6.5, 6.8 or 6.10 of the Arrangements for deposit accounts, he must apply for a decision pursuant to Rule 69(2) and submit the requisite evidence.

6.2.6 The equivalent or revised fee payable is always that applying on the date of payment (Art. 6(4), last sentence, Rules relating to Fees and the transitional provisions in the Administrative Council decisions revising fees). The payer cannot therefore in this respect seek to rely on the ten-day fail-safe arrangement in order to benefit from the lower (old) equivalent even if he gave instructions for payment before the entry into force of new fees or equivalents (see J 18/85, OJ 8/1987, 356). Art. 8(3) and (4) RFees protects the applicant in the event of late payment from the legal consequences of expiry of the payment period but not from the obligation to make up any differences resulting from an increase in fees or equivalents.

## 7. Purpose of payment

### 7.1 General

7.1.1 An essential condition for a valid payment to the EPO in the case of payment or transfer to a bank or giro account held by the European Patent Organisation is that the amount is entered in that account. The payment is valid in respect of the amount entered. In the case of delivery or remittance of a cheque, the amount entered in the account of the EPO when the cheque is cashed is considered to be the amount paid. If an insufficient amount has been paid by mistake, it is not possible to rectify the error by having the shortfall paid subsequently deemed to be paid on the original date of payment. Payment is a matter of fact whereby a certain amount is transferred to and put at the disposal of the EPO. It is not, therefore, a procedural declaration which may be corrected pursuant to Rule 88. The same applies to debit orders (see T 170/83, Reasons No. 8, OJ 12/1984, 605).

### Art. 7 RFees

7.1.2 A distinction must be drawn between these conditions for valid payment and the indication of the purpose of the payment. Indication of the purpose of the payment serves to identify the proceedings for which the fee is intended (e.g. for fee payments, the application number) and the specific type of fee. If the purpose of the payments cannot immediately be established, the person making the payment will be requested to communicate the purpose in writing within a specified period. If he complies with this request in due time, the payment and the original payment date remain valid. This is also the case when the clarification involves re-assigning the payment to another application. Otherwise the payment will be considered not to have been made. The Boards of Appeal have decided that if the purpose of the payment has evidently been given incorrectly, this deficiency is not prejudicial if the intended purpose can be established without difficulty from the remaining information. The inadvertent use of a fee by the EPO for a different purpose from that evidently intended by the person making the payment has no effect on the purpose intended by that person (see J 16/84,

OJ 12/1985, 357). Similarly a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear. Instructions to carry out the order must be given by the EPO department qualified to recognise what is clearly intended (see T 152/82, OJ 7/1984, 301).

7.1.3 In the case of changes to the purpose of payment not arising from Art. 7(2) RFees, the date of payment is the date of receipt of the request for the change.

7.2 Indication of the purpose of the payment in the case of designation fees

Art. 2, No 3 RFees  
Art. 7(1) RFees

The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee. Such payments simply need to be marked "Designation fees" in order for the purpose of the payment to be established. If fewer than seven designation fees are paid and the payment agrees with the declaration in Section 32.2 of the Request for Grant form (Form 1001), payment should once again simply be marked "Designation fees". However, if the payment differs from the intended payment as stated in Section 32.2, the Contracting States for which the payment now is intended should be indicated with the payment. If there is no such indication and the amount paid is insufficient to cover all the Contracting States mentioned in Section 32.2, the procedure under III, 12.8 applies.

If an **automatic debit order** has been issued (Sections 43 and 32.3 of Form 1001), the applicant must inform the EPO prior to expiry of the basic period under Art. 79(2) if he wished to pay designation fees for Contracting States other than those indicated in Section 32.2. If not, an amount equal to seven times the amount of one designation fee or the designation fees for the Contracting States indicated in Section 32.2 is debited.

7.3 Indication of the purpose of payment in respect of claims fees

7.3.1 Claims fees payable on filing the European patent application

If the applicant pays the claims fees for all the claims incurring fees, the indication "claims fees" suffices to identify the purpose of the payment. If the amount paid is insufficient to cover all the claims fees, the procedure under III, 9 applies.

7.3.2 Claims fees payable before the grant of the European patent

In the communication under Rule 51(6), the applicant may be requested to pay claims fees due before grant of the

European patent. If the applicant fails to pay the fee for all the claims in due time, the application is deemed to be withdrawn (Rule 51(8)).

### **8. No deferred payment of fees, no legal aid**

The Convention makes no provision for deferring payment of fees (see J 02/78, OJ 6-7/1979, 283, paragraph 3 of the Reasons for the Decision, German text only) or for granting legal aid. An indigent party still has the possibility of applying for legal aid from the competent national authority. The time limit for payment is not extended in such a case however; a party claiming national legal aid must make the corresponding arrangements as early as possible so that he is in a position to pay the fee in due time.

### **9. Reduction of fees**

#### 9.1 General

9.1.1 The Convention provides in certain cases for the reduction of the filing fee, examination fee, opposition fee and fee for appeal. The reduction is fixed in the Rules relating to Fees as a percentage of the fee.

9.1.2 Where a fee is reduced - in contrast to cases of fee refunds - the reduced rate may be paid instead of the full fee. The factual conditions for a reduction of the fee must be met on or before the day the period for payment expires.

Rule 6(3)  
Art. 12(1) RFees

#### 9.2 Reduction under the language arrangements

##### 9.2.1 Conditions

Art. 14(2)(4)

The European patent application and documents which have to be filed within a time limit may also be filed in the official language of a Contracting State which is not an official language of the EPO (hereinafter "admissible non-EPO language") if the applicant has his residence or principal place of business within the territory of the Contracting State concerned or if the applicant is a national of that State. See VIII, 1.1 and 1.2.

Subject to certain conditions, where an admissible non-EPO language is used, a reduction in fees (20%) is allowed. It serves to compensate the parties for the disadvantages that result from the fact that not all official languages of the Contracting States are official languages of the EPO. The conditions to be fulfilled for the grant of a reduction in fees vary for each procedural step for which a reduction is claimed (see Decision G 6/91, OJ 9/1992, 491).

The reduction is only allowed if the translation into the language of the proceedings is filed in due time, that is to

say at the earliest at the same time as the European patent application or the document subject to a time limit in the admissible non-EPO language (see G 6/91).

#### 9.2.2 Reduction of the filing fee

The filing fee is reduced if the European patent application (at least the description and the claims) is filed in an admissible non-EPO language (see J 4/88, OJ 12/1989, 493).

#### 9.2.3 Reduction of the examination fee

The applicant will be allowed a reduction in the examination fee if the written request for examination is filed in an admissible non-EPO language and a translation of the written request for examination in the language of the proceedings is also filed. For the reduction to be allowed, the written request for examination in the admissible non-EPO language must be filed at the same time as the Request for Grant (Form 1001) since the form already contains a pre-printed box for the written request for examination in the official languages of the EPO; the written request for examination in the admissible non-EPO language should be entered in the box provided for the request for examination. In order to benefit from the reduction it is not necessary to file subsequent additional documents for the examination proceedings in an admissible non-EPO language.

#### 9.2.4 Reduction of the opposition fee

The opposition fee is reduced if the notice of opposition including the written reasoned statement of grounds is filed in an admissible non-EPO language as well as in the language of the proceedings in translation (see T 290/90, OJ 7/1992, 368). If, during the opposition procedure only, an opponent files a document that has to be filed within a time limit in an admissible non-EPO language, he is not given a reduction in the fees.

#### 9.2.5 Reduction of the appeal fee

A reduction in the appeal fee is allowed if the notice of appeal is filed in an admissible non-EPO language as well as in the language of the proceedings in translation. The grant of a reduction does not depend on the subsequent filing of the statement setting out the grounds of appeal in an admissible non-EPO language.

Rule 104b(6)  
Art. 12(2) RFees

#### 9.3 Reduction of the examination fee where the international preliminary examination report is being drawn up by the EPO

Where the EPO has drawn up the international preliminary examination report in respect of an international applica-

tion, the examination fee is reduced by 50% if the EPO is the designated Office (elected Office).

## 10. Refund of fees

### 10.1 General remarks

#### 10.1.1 Fee payments lacking a legal basis

There are two conditions for a fee payment to be fully valid:

- (i) the payment must relate to proceedings that are pending; and
- (ii) the date of payment (see XI, 3) must be on or after the due date.

If payment does not relate to a pending European patent application (e.g. it relates to a patent application already deemed to have been withdrawn), there is no legal basis for the payment; the amount paid must be refunded.

If the payment is made before or on the due date and if no later than that date the legal basis ceases to exist (e.g. because the patent application is deemed to be withdrawn or is withdrawn), the amount paid is to be refunded. This also applies to renewal fees validly paid before the due date (Rule 37(1), second sentence).

#### 10.1.2 Fee payments which are not valid

If fees have not been validly paid they must be refunded. Examples: filing fee, search fee, designation fees or examination fee paid late without the surcharge pursuant to Rule 85a or 85b. Fees paid on or after the due date are refunded only if there is a particular reason for a refund (see XI, 10.2).

#### Art. 10c RFees

#### 10.1.3 Insignificant amounts

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 EUR 10,20 constitutes an insignificant amount (Art. 1 of the decision of the President of the EPO dated 7 January 1999, OJ 1/1999, 42).

### 10.2 Special refunds

#### Art. 10 RFees

10.2.1 The search fee is refunded in the cases provided for in Art. 10 of the Rules relating to Fees. Further details are given in Legal Advice No. 14/83, OJ 5/1983, 189.

#### PCT Rule 16.2 PCT Rule 16.3

10.2.2 The international search fee will be refunded in the cases specified in the PCT (Rules 16.2, 16.3, 41) and in



- PCT Rule 41 the Agreement between WIPO and EPO under the PCT (OJ 11/1987, 515; OJ 10/1992, 603; OJ 12/1992, 821; OJ 9/1995, 658; OJ 1-2/1998, 85). If the applicant files a European and an international application at the same time, the refund of the international search fee is governed by Legal Advice No. 14/83, OJ 5/1983, 189, 197.
- Rule 46(2)  
Rule 104b(5) 10.2.3 If an applicant, following a communication from the Search Division, has paid an additional search fee but the Examining Division at the applicant's request has found that there was no justification for charging the additional fee, the latter will be repaid.
- Art. 10b RFees 10.2.4 The examination fee will be refunded in the situation described in Art. 10b of the Rules relating to Fees (see VI, 2.2 and 2.6).
- If an international application and a European application are consolidated in accordance with the conditions laid down by Legal Advice No. 10/92 rev., OJ 11/1992, 662, the examination fee paid in respect of the European patent application will be refunded either in full or at a rate of 75% depending on when consolidation was requested. This also applies where there has been an international preliminary examination under Chapter II PCT.
- Art. 77(5)  
Rule 31(2) 10.2.5 If a European patent application filed with a competent national authority is deemed to be withdrawn pursuant to Art. 77(5), the filing, search and designation fees and any claims fees paid will be refunded.
- 10.2.6 The fee for grant, including fee for printing, will be refunded if the European patent application is withdrawn before communication of the decision to grant. If it is withdrawn after communication of the decision to grant, fees cannot be refunded as the fee for printing is part of the fee for grant.
- 10.3 Method of refund
- Refunds will as a rule be made by means of a cheque. If the fee was paid in Deutsche Mark and the person to whom the refund is payable holds a deposit account with the EPO, the refund may take the form of crediting that deposit account. If the payer wishes any refund to be made to a deposit account, he can give the number of the account in the space provided in the Request for Grant form.
- 10.4 Person to whom refund is payable
- Fees will be refunded to the party concerned. However, if the party's representative is authorised to receive payments, the refund will be made to the representative. A refund will not be made to a third party who paid the fee

(see Legal Advice No. 6/91 rev., points 4 and 5, OJ 11/1991, 573).

#### 10.5 Re-allocation instead of refund

If a party files a written request, the payment may be re-allocated instead of being refunded. The date of receipt of the re-allocation instructions is then considered to be the date of payment for the new purpose of payment.

**CHAPTER XII****INSPECTION OF FILES AND COMMUNICATION OF INFORMATION CONTAINED IN FILES****1. General**

Provision is made for inspection of files and communication to the public of information contained in files. This applies to the files of European patent applications and European patents. For Euro-PCT applications still in the international phase, see E-IX, 4.8 and 6.5.

Art. 128  
Rule 93  
Rule 94  
Rule 95

The provisions governing inspection of files are contained in Art. 128 and Rules 93 and 94, those for communication of information in Rule 95.

Observations by third parties (Art. 115) are an integral part of the files and as such are open to inspection in accordance with Art. 128. If a third party asks that his observations or a part thereof be treated confidentially, that request cannot be granted and the third party will be notified accordingly.

The fees for inspection of files and communication of information contained in files are laid down by the President pursuant to Art. 3(1) RFees and are published regularly in the Official Journal.

**2. Request for inspection of files and communication of information contained in files**

Rule 94

2.1 No particular form is prescribed for the request except that it must be filed in writing with the EPO at one of its filing offices. The EPO offers a form via its Web site on the Internet. The request should contain information about the payment of the fee. Requests filed by telegram, telex or facsimile (see IX, 2.5) or submitted through the Internet will be processed without confirmation.

2.2 A fee falls due when the request is received. The method of payment and date on which payment is deemed to have been made are dealt with in the Rules relating to Fees (see XI). A fee that has been duly paid will not be refunded.

The parties and their representatives may inspect free of charge the files of proceedings in which they are involved. Thus an applicant for a patent may inspect the file on his own patent application, a patent proprietor that on his own patent, and an opponent the opposition file and the relevant patent files. Any fees referred to under XII, 3.5 are also payable here.

Art. 128(4)  
Rule 95

2.3 Subsequent to the publication of the European patent application any person may inspect and obtain information

- Rule 94  
Rule 93
- from the files. Inspection of files and communication of information are subject to the restrictions laid down in Rule 93. Papers marked "confidential" which are not excluded from file inspection under Rule 93 are returned to the sender, without note being taken of their contents (see T 516/89, OJ 8/1992, 436).
- Art. 128(3)
- Where a European divisional application or a new European patent application filed under Art. 61(1)(b) is published, the files of the earlier application may be inspected prior to the publication of that application and without the consent of the relevant applicant.
- Correspondence from the proceedings relating to the inspection of files and the communication of information conducted between the EPO and the person requesting the inspection or information is filed in the part of the file which is not accessible to the public. The EPO does not provide the applicant with any information about the proceedings relating to the inspection of files or the communication of information.
- Art. 128(1)
- 2.4 Until such time as the European patent application is published, the files may be inspected only with the consent of the applicant. If the applicant's consent is not submitted with the request, the EPO will only release the files for inspection once the requester has presented the approval of the applicant.
- Prior to publication of a European divisional application the files may only be inspected in the cases described in Art. 128(1) and (2). This also applies where the parent application has already been published.
- Art. 128(2)
- 2.5 Prior to publication of the European patent application, any person who can prove that the applicant has invoked his rights under the application against him may also inspect the files. The rights under a European patent application are also deemed to have been invoked where rights under a first filing in a Contracting State have been invoked and the subsequent European application is mentioned at the same time (see J 14/91, OJ 8/1993, 499). If such proof is not furnished together with the request, the EPO will invite the requester within a specified period to supply proof. If he fails to do so in due time, the request will be refused.
- Since a specified third party may obtain inspection of the files under Art. 128(2), the applicant is also entitled in such a case to notification of the third party's identity. Professional representatives requesting inspection of the files on behalf of a third party pursuant to Art. 128(2) must accordingly give the third party's name and address and file an authorisation.

A decision on a request for inspection of the files pursuant to Art. 128(2) is only taken once the applicant has been heard. If the applicant objects and provides grounds for his belief that the requirements under Art. 128(2) are not met within the period set by the EPO, a decision will be delivered; such decision is subject to appeal.

Art. 128(5)  
Rule 96(1)

2.6 The EPO has not hitherto availed itself of the power under Art. 128(5) to publish bibliographic data before the European patent application is published.

### 3. Procedure for the inspection of files

Rule 94(1)  
Rule 95a(2)

3.1 Inspection of the files of European patent applications and of European patents is granted in respect of the original documents or of copies thereof or, if the files are stored on other media, in respect of these media. All parts of the file compiled when conducting the examination, opposition and appeal procedure with the parties are open for inspection.

Art. 128(4)

The parts of the file excluded from inspection are:

Rule 93(a)

(i) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal;

Rule 93(b)

(ii) draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties;

Rule 93(c)

(iii) the designation of the inventor if he has renounced his title as inventor under Rule 18(3);

Rule 93(d)

(iv) any other document excluded from inspection by the President of the EPO on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent (see Decision of the President of the EPO, OJ 10/1985, 316);

Art. 38(1) PCT  
Rule 94 PCT

(v) subject to Rules 94.2 and 94.3 PCT the files of the international preliminary examination for a Euro-PCT application in respect of which the EPO is the international preliminary examining authority and for which no act for entry into the regional phase before the EPO has been performed (see also E-IX, 6.5).

The parts of the file excluded from inspection are kept separate in the files from those open to inspection. The excluded parts are removed from the file prior to inspection.

Rule 94(1)  
Rule 94(2)

3.2 Inspection of the files of European patent applications and of European patents takes place on the premises of the EPO. Provided the conditions for inspection of the files

laid down in Art. 128(1) to (4) are fulfilled and the administrative fee has been paid, the requester will be notified that the files may be inspected upon presentation of the notification at the EPO's Information Office in Munich, at The Hague or in Berlin.

### 3.3 (deleted)

Rule 94(2)

3.4 On request, files may be inspected on the premises of the central industrial property office of the Contracting State in whose territory the person making the request has his residence or place of business.

The request for inspection of the files must be filed with the EPO in this case as well. The administrative fee must likewise be paid to the EPO.

Provided the conditions for inspection of the files laid down in Art. 128(1) to (4) are fulfilled and the administrative fee has been paid, the EPO will forward a copy of the files to the central industrial property office concerned pending introduction of file inspection by electronic means. At the same time the EPO will inform the requester that the copy of the files has been sent to the central industrial property office and that he will be notified by the latter office for the purposes of inspecting the files.

The cost of copies made for inspection of the files must be paid to the central industrial property office concerned in accordance with its conditions.

Rule 94(3)

3.5 On request, inspection of the files will be effected by means of issuing copies of file documents. A separate fee is payable for the copies.

The request must indicate the part of the files of which copies are desired.

Provided the conditions for inspection of the files laid down in Art. 128(1) to (4) are fulfilled and the administrative fee has been paid, the EPO will forward the copies to the requester and invoice him for the cost of the copies.

If it is indicated, when the request is filed, that the cost should be debited from the requester's deposit account, the amount of the invoice will be charged to the deposit account.

#### **4. Communication of information from the files**

Rule 95

4.1 Subject to the restrictions provided for in Art. 128(1) to (4) and Rule 93, the EPO may, upon request, communicate information concerning any file of a European patent application or European patent subject to the payment of an administrative fee. Provided the conditions for inspection of the files laid down in Art. 128(1) to (4) are fulfilled

and the administrative fee has been paid, the EPO will communicate the desired information to the requester.

However, the EPO may require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

Art. 127  
Rule 92

4.2 Requests for the communication of information from the files are frequently made with a view to ascertaining the state of the proceedings and the legal status of patent rights. Attention is therefore drawn to the possibility of consulting free of charge the Register of European Patents, containing the particulars laid down in Rule 92, via the information desks in Munich, The Hague, Berlin or Vienna. However, entries are made in the Register of European Patents only up to the expiry of the period for opposition or the termination of opposition proceedings.

Rule 94(4)

#### **5. Certified copies of the European patent application**

The EPO will issue on request a certified copy of the European patent application, of other documents from the files of European applications and of patents, provided that the conditions for file inspection (Art. 128(1) to (4)) are fulfilled and the administrative fee has been paid.

Priority documents (i.e. the certified copy of the European application together with the certificate stating the date of filing thereof) will only be issued to the (original) applicant or his successor in title, upon payment of an administrative fee. In the case of applications filed under the provisions of Art. 14(2) the priority document relates to the application as originally filed, not to the translation in one of the official languages of the EPO.

Costs incurred in preparing the copies certified will be charged to the requester.

If it is indicated, when the request is filed, that the cost should be debited from the requester's deposit account, the amount of the invoice will be charged to the deposit account.





**PART B**  
**GUIDELINES FOR SEARCH**



**PART B  
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**CHAPTER I**

## INTRODUCTION

1. These Guidelines were drafted for, and apply to, European searches, i.e. searches performed by the EPO for European applications. In addition to these searches the Search Divisions of the EPO are called upon to carry out other types of searches (see III, 4). It is intended that these Guidelines should apply to these other types of searches to the largest extent possible, and any deviations from these Guidelines applying to these other searches are indicated where appropriate and are summarised in III, 4.
- Rule 86(2) 2. Special mention is made of international (PCT) searches carried out by the EPO acting as an International Searching Authority under the Patent Cooperation Treaty. Since the requirements of that Treaty and the European Patent Convention with respect to the search and search report are to a very large extent identical or at least compatible, when elaborating these Guidelines the opportunity was taken to make them applicable also to PCT searches to the largest extent possible. References to the relevant Articles and Rules of the PCT are included in these Guidelines in the appropriate places.
- Prot. Centr. I(1)(b) 3. The Search Divisions of the EPO have taken over the tasks of the former International Patent Institute (IIB) with respect to the searching of national applications of its Member States. These Guidelines are not necessarily fully applicable to these national searches, nor are the ways in which these searches differ from European searches specifically pointed out. Nevertheless it is to be expected that at least for those Member States of the IIB which are also party to the European Patent Convention, these national searches are to a large extent identical with, or compatible with, European searches.
- Art. 17  
Prot. Centr. I(1),  
I(3), IV(2), V 4. European searches are carried out in the Search Divisions of the Office and may also be entrusted to the central industrial property offices of certain Contracting States. Searches in documents in languages other than the official languages of the EPO may be entrusted to certain national patent offices. These Search Guidelines apply to the European searches carried out in all these places.

**CHAPTER II**

## GENERAL

- Art. 17  
Art. 18
1. The procedure through which a European patent application proceeds from the filing of the application to the granting of a patent (or the refusal thereof) comprises two clearly separated basic stages, i.e. the search and the substantive examination.
- Rule 44(1)
2. The objective of the search is to discover the state of the art (referred to as "prior art" in the PCT) which is relevant for the purpose of determining whether, and if so to what extent, the invention to which the application relates is new and involves an inventive step (PCT Art. 15(2), Rule 33.1(a)).
3. The search is essentially a documentary search in a document collection that is systematically arranged (or otherwise systematically accessible) according to the subject-matter contents of the documents. These are primarily patent documents of various countries, supplemented by a number of articles from periodicals and other non-patent literature (see Chapter IX). It can be complemented or even partially replaced by consultation of appropriate data banks.
- Art. 17  
Art. 92  
Rule 44(1)
4. A search report will be prepared containing the results of the search, in particular by identifying the documents constituting the relevant state of the art (PCT Art. 16(1), Rule 43.5).
- Art. 92(2)  
Art. 93
5. The search report serves to provide information on the relevant state of the art to the applicant, to the public and to the Examining Divisions of the EPO (PCT Art. 18(2), Art. 21(3), Art. 33(6)).
6. The responsibility for the search lies with the Directorate General for Searching, having its seat in The Hague; the Directorate General for Examination and Opposition, with its seat in Munich, is responsible for examination.
7. There are no facilities for systematic searching by the Examining Divisions, other than for conflicting European applications (see VI, 4). The Examining Divisions are, therefore, dependent on the work of the Search Divisions for their knowledge of the state of the art on which assessments of the patentability of the invention is based. The search must, therefore, be as complete and effective as possible, within the limitations necessarily imposed by economic considerations (see III, 2).
8. In order to be able to inform the Examining Division of the documents necessary to decide on patentability, and in order to be able to come to a conclusion concerning any



subject-matter to be excluded from the search, the search examiner must be familiar with the basic requirements of examination. These include novelty, inventive step, unity of invention, clarity, conciseness, support, sufficiency of disclosure, and subjects excluded from patentability either specifically or because of lack of industrial applicability (see VI to VIII and C-II to C-IV). A certain amount of feedback to the Search Division of the consequences of the search, in particular the actions taken by the applicant and the Examining Division as a result of the search report, is also necessary, in order to obtain searches well adapted to the needs of the examination.

Art. 17

9. The unit responsible for carrying out the search and drawing up the search report for an application is a Search Division, which consists normally of one search examiner. In exceptional cases, where the invention is of a nature requiring searching in widely dispersed specialised fields, a special Search Division consisting of two, or possibly three, examiners may be formed.

**CHAPTER III**

## CHARACTERISTICS OF THE SEARCH

**1. The objective of the search**

Rule 44(1)

1.1 As stated in II, 2, the objective of the search is to discover the relevant state of the art for the purpose of assessing novelty and inventive step. Decisions on novelty and inventive step are the province of the Examining Divisions. However, in many instances provisional opinions on these issues must be formed by the Search Division in order to enable an effective search to be carried out. Such provisional opinions are not explicitly expressed in the search report, except in cases of III, 1.4, and are subject to review by the Examining Division at the examination stage.

1.2 Examples illustrating the above are to be found in paragraphs III, 3.9 (Search for subject-matter of dependent claims), III, 2.5 to 2.7 (Search in analogous art), IV, 2.8 (Stopping search when only trivial matter remains) and VII, 1.3 (Lack of unity of invention).

1.3 Occasionally the Search Division has to form provisional opinions on matters of substantive examination other than novelty or inventive step, in order to be able to proceed with the search or to decide to restrict the search; here again these opinions are subject to review by the Examining Division (see III, 4.2(iii)).

1.4 Examples are to be found in VII - Unity of invention and VIII - Subject-matter to be excluded from the search.

**2. Scope of the search**

2.1 The European search is essentially a thorough, high quality, all-embracing search. Nevertheless, it must be realised that in a search of this kind, 100% completeness cannot always be obtained, because of such factors as the inevitable imperfections of any classification system and its implementation, and may not be economically justified if the cost is to be kept within reasonable bounds. The examiner should therefore organise his search effort and utilise his search time in such a manner as to reduce to a minimum the possibility of failing to discover existing highly relevant prior art, such as complete anticipations for any claims. For less relevant prior art, which often exists with a fair amount of redundancy amongst the documents in the search collection, a lower retrieval ratio can be accepted (see in this context, however, III, 2.7 at the end).

2.2 The PCT stipulates in Art. 15(4), that the International Searching Authority performing the search shall endeavour to discover as much of the relevant prior art as

its facilities permit, and shall, in any case, consult the documentation specified in the PCT Regulations. Since the EPO is an International Searching Authority (Art. 16(1) PCT; Art. 154 EPC; Agreement between WIPO and the EPO under the PCT, OJ 11/1987, 515; OJ 10/1992, 603; OJ 12/1992, 821; OJ 9/1995, 658; OJ 1-2/1998, 85), and it is clearly desirable for European and international searches to be fully compatible, the above definition of the scope of the search also applies to European searches.

2.3 This implies first of all that the Search Division in searching an application, in principle, consults all documents in the relevant classification units of the search files, irrespective of their language or age, or of the type of document. Nevertheless the search examiner should for reasons of economy exercise his judgment, based on his knowledge of the technology in question and of the documentation involved, to omit sections of the documentation in which the likelihood of finding any documents relevant to the search is negligible, for example documents falling within a period preceding the time when the area of technology in question began to develop. Similarly he need only consult one member of a patent family unless he has good reason to suppose that, in a particular case, there are relevant substantial differences in the content of different members of the same family (see IX, 2.7).

2.4 Certain categories of documents such as documents of the Scandinavian countries may be of special relevance to the European patent system, though they do not form part of the PCT minimum documentation. Conversely, certain categories of documents are of special relevance to the PCT, e.g. patent documents of certain countries not contracting to the European patent system. All these documents should be consulted for European searches, additional European searches, international searches and international-type searches, and also for national searches unless specifically excluded in the agreement with the State concerned.

2.5 The search is carried out on the basis of the search files which may contain material pertinent to the invention (PCT, Rule 33.2(a)). It should first cover all directly relevant technical fields, and may then have to be extended to analogous fields (PCT Rule 33.2(b)), but the need for this must be judged by the examiner in each individual case, taking into account the outcome of the search in the initial fields.

2.6 The question of which arts are, in any given case, to be regarded as analogous has to be considered in the light of what appears to be the essential technical contribution of the invention and not only the specific functions expressly indicated in the application (PCT Rule 33.2(c)).

2.7 The decision to extend the search to fields not mentioned in the application must be left to the judgment of the search examiner, who should not put himself in the place of the inventor and try to imagine all the kinds of applications of the invention possible. The over-riding principle in determining the extension of the search in analogous fields should be whether it is probable that a reasonable objection that there is lack of inventive step could be established on the basis of what is likely to be found by the search in these fields.

### 3. The subject of the search

Art. 92(1)  
Art. 69(1)  
PCT Art. 15(3)  
PCT Rule 33.3(a)

3.1 The search should be made on the basis of the claims, with due regard to the description and drawings (if any), (Art. 92(1), PCT Art. 15(3), PCT Rule 33.3(a)). The claims determine the extent of the protection which will be conferred by the European patent if granted (Art. 69(1)).

Prot. Art. 69

3.2 The search should on the one hand not be restricted to the literal wording of the claims, but on the other hand should not be broadened to include everything that might be derived by a person skilled in the art from a consideration of the description and drawings. The objective of the search is to discover prior art which is relevant to both novelty and inventive step (see II, 2). The search should be directed to what appear to be the essential features of the invention. It is clear that the nature of an invention may change as the search goes on, as the closest prior art at any given stage of the search (and therefore often the objective technical problem underlying the invention) itself changes (see IV, 2.5, 2.6 and C-IV, 9.5).

3.3 As a consequence the search should embrace all subject-matter that is generally recognised as equivalent to the subject-matter of the claimed invention for all or certain of its features, even though, in its specifics, the invention described in the application is different (PCT Rule 33.2(d)). For example, if the claim specified a cable clamp having a certain construction, the search should embrace pipe and similar clamps likely to have the specified construction. Likewise, if the claim is directed to an article consisting of several parts which are defined by their function and/or structure, and the claim stipulates that certain parts are welded together, the search should also embrace equivalent methods of connecting such as glueing or riveting, unless it is clear that welding possesses particular advantages required for the invention.

Rule 86(1)

3.4 Since the applicant may not amend the claims before receiving the search report, the search is directed to the claims as originally filed in the European application. Therefore, if the European application derives from an earlier international (PCT) application or national application, but has claims that are different from those of that

earlier application (e.g. as a consequence of an international or national search report), the claims as filed in the European application form the basis of the European search (see III, 4.3).

Rule 31(2)

3.5 Claims that are deemed to have been abandoned for non-payment of fees must be excluded from the search.

Rule 45  
PCT Art. 17(2)

3.6 In principle, and in so far as possible and reasonable, the search should cover the entire subject-matter to which the claims are directed or to which they might reasonably be expected to be directed after they have been amended (PCT Rule 33.3(b)). For example, where an application relating to an electric circuit contains one or more claims only directed to the function and manner of operation, and the description and drawings include an example with a detailed non-trivial transistor circuit, the search should include this circuit.

Art. 83  
Art. 84  
PCT Art. 5, 6

3.7 No special search effort need be made for searching unduly wide or speculative claims, beyond the extent to which they relate to matter which is sufficiently disclosed in the application (Art. 83, PCT Art. 5), and are supported by the description (Art. 84, PCT Art. 6). For example, if in an application relating to and describing in detail an automatic telephone exchange, the claims are directed to an automatic communication switching centre, the search should not be extended to automatic telegraph exchanges, data switching centres etc., merely because of the broad wording of the claim, but only if it is probable that such an extended search could produce a document on the basis of which a reasonable objection as regards lack of novelty or inventive step could be established. Likewise, if a claim is directed to a process for manufacturing an "impedance element" but the description and drawings relate only to the manufacture of a resistor element, and give no indication as to how other types of impedance element could be manufactured by the process of the invention, extension of the search to embrace, say, manufacture of capacitors, would not normally be justified. If the main claim relates to the chemical treatment of a substrate, whereas it appears from the description or all the examples that the problem to be solved is solely dependent on the nature of natural leather, it is clear that the search should not be extended to the fields of plastics, fabrics or glass. Similarly, if in an application, the description and drawings are directed to a lock with a safety cylinder whereas the claims refer to a device allowing the indexation of the angular position of a first element with respect to two other rotating elements, then the search should be limited to locks. In cases where the lack of disclosure or support is such as to render a meaningful search over the **whole** of the scope of the claim(s) impossible, a partial search or a declaration taking the place of a search report under Rule 45 or a declaration under PCT Art. 17(2)(a) may be appropriate (see VIII, 6).

## Rule 29(4)

3.8 The search carried out in the classification units of the search files to be consulted for the main claim(s) must include all dependent claims. Dependent claims should be interpreted as being restricted by all features of the claim(s) upon which they depend; therefore, where the subject-matter of the main claim is novel, that of the dependent claims will also be novel. When the patentability of the main claim is not questioned as a result of the search, there is no need to make a further search or cite documents in respect of the subject-matter of the dependent claims as such. For example, in an application relating to cathode ray oscilloscope tubes, in which the main claim is directed to specific means along the edge of the front of the tube for illuminating the screen, and a dependent claim is directed to a specific connection between the front and the main part of the tube, the search examiner should, in the search files he consults for searching the illumination means, also search for the connecting means whether in combination with the illumination means or not. When after this search the patentability of the illuminating means is not questioned, the examiner should not extend his search for the connecting means to further search files specifically provided for these connections. If in an application dealing with a pharmaceutical composition for treating nail infections the patentability of the main claim relating to specific combinations of the active ingredients is not questioned as a result of the search, there is no need to continue the search for dependent claims dealing with the use of a specific volatile organic solvent as a carrier in the composition.

3.9 However, where the patentability of the main claim is questioned, it may be necessary for assessing the inventive step of a dependent claim to establish whether the features of the dependent claim as such are novel by searching one or more additional classification units. No such special search should be made for features that are trivial or generally known in the art; however, if a handbook or other document showing that a feature is generally known can be found rapidly, it should be cited. When the dependent claim adds a further feature (rather than providing more detail of an element figuring already in the main claim), the dependent claim is to be considered in combination with the features in the main claim and should be dealt with accordingly (see C-III, 2.2).

3.10 For claims characterised by a combination of elements (e.g. A, B and C) the search should be directed towards the combination; however, when searching classification units for this purpose, sub-combinations, including the elements individually (e.g. AB, AC, BC and also A, B and C separately) should be searched in those units at the same time. A search in additional classification units either for sub-combinations or for individual elements of the combination should only be performed if this is still

necessary for establishing the novelty of the element in order to assess the inventive step of the combination.

3.11 When the application contains claims of different categories, all these must be included in the search. However, if a product claim clearly seems to be both new and non-obvious, the examiner should make no special effort to search claims for the manufacture or use of the product (cf. C-III, 3.7a and C-IV, 9.5a). When the application contains only claims of one category, it may be desirable to include other categories in the search. For example, generally, i.e. except when the application contains indications to the contrary, one may assume that in a claim directed to a chemical process, the starting products form part of the state of the art and need not be searched; the intermediate products are only searched when they form the subject of one or more claims; but the final products will always have to be searched, except when they are evidently known.

Rule 45  
PCT Art. 17(2)  
PCT Rule 39.1

3.12 The examiner may exclude certain subject-matter from his search. These exclusions may result from certain subject-matter not complying with the provisions of the EPC or PCT relating to exclusions to patentability or to susceptibility to industrial application (see VIII, 1 to 4). They may also arise where the application does not comply with the provisions of the EPC or the PCT to such an extent that a meaningful search is impossible for some or all of the claims, or for a part of a claim (see VIII, 6).

Rule 46

3.13 Also, when the claims of the application do not relate to one invention only, nor to a group of inventions linked so as to form a single general inventive concept, the search will normally be restricted to the invention, or the linked group of inventions first mentioned in the claims (see Chapter VII). Restriction of the search for the above reasons will be notified to the applicant in a communication accompanying the partial search report (see VII, 1.2).

3.14 In certain circumstances it may be desirable to extend the subject-matter of the search to include the "technological background" of the invention (see IV, 2.7). This would include:

- the preamble to the first claim, i.e. the part preceding the expression "characterised by";
- the prior state of the art which is deemed to be known in the introduction of the description of the application but not identified by specific citations;
- the general technological background of the invention (often called "general state of the art").

#### 4. Types of searches

##### 4.1 European searches

Art. 17

The task of the Search Division is of course primarily to carry out searches and draw up search reports in relation to European patent applications. In addition to these usual searches, the Search Divisions of the EPO may be called upon to perform various other types of searches, which are listed in the following paragraphs.

##### 4.2 Additional European searches

At the examination stage of a European patent application an additional search may be necessary. As the Examining Divisions are not expected to perform searches, all such search work is invariably referred back to the Search Division, which should promptly carry out this search. The reasons for such an additional search may be for example:

- (i) amendment of claims so that they embrace matter not covered by the original search (see, however, C-III, 7.10 for claims not searched because of lack of unity and C-III, 7.10a for amendments introducing subject-matter from the description which is not linked by a single general inventive concept to the subject-matter originally searched;
- (ii) removal by amendment or rebuttal, during substantive examination, of the deficiencies which resulted in the issuance of a partial search or a declaration taking the place of a search report under Rule 45, or a declaration under PCT Art. 17(2)(a) or (b) (see VIII, 6 and C-VI, 8.5 to 8.7);
- (iii) reversal, by the Examining Division, of a provisional opinion of the Search Division with respect to novelty or lack of inventive step (see III, 1.1 and 1.2), lack of unity of invention (see VII), or exclusions from the search (see III, 3.12 and VIII, 6);
- (iv) limitations or imperfections in the initial search.

Rule 45  
PCT Art. 17(2)

Rule 46

The Examining Division requesting such an additional search indicates precisely the reason for the request and the subject-matter to be searched. The Search Division transmits to the Examining Division an account containing the results obtained from the additional search carried out; this account is not sent to the applicant nor is it published by the Search Division, since any necessary communication resulting from it is the responsibility of the Examining Division.

In a similar way, an additional search may become necessary during examination of the oppositions against



a European patent (see D-VI, 5).

#### **4.3 Supplementary European searches**

Art. 150(3)  
Art. 157(1)  
Art. 157(2)(a)

An international (PCT) application, for which the EPO acts as designated Office or elected Office shall be deemed to be a European patent application. Where an international (PCT) search report is already available this will take the place of the European search report. In those cases the Search Division will draw up a supplementary European search report.

10b

Art. 157(3)

However, the Administrative Council decides under what conditions and to what extent the supplementary European search report is to be dispensed with. The following decisions have been taken:

(i) A supplementary European search report shall not be drawn up for PCT applications for which the EPO or the Swedish, Austrian or Spanish Patent Office was the International Searching Authority (OJ 1/1979, 4; 2/1979, 50; 6-7/1979, 248; 8/1995, 511).

(ii) A supplementary European search report shall be drawn up and the search fee shall be reduced (see OJ 9/1979, 368; 1/1981, 5; 1-2/1994, 6) for PCT applications for which the Patent Office of the USA, Japan, China, Australia or Russia was the International Searching Authority.

For the applications mentioned under (ii) the supplementary European search is carried out in all the search documentation of the EPO. It is left to the Search Division's judgement whether a limitation as to the search documents is chosen. No precise limits can at present be set to these supplementary searches since the documentation and search practice of these International Searching Authorities have not been fully harmonised in respect of the EPO; as a general rule the EPO should avoid any superfluous work and duplication of work, and should rely on the efficiency and quality of the international searches to the largest extent possible. The EPO as designated Office requests the International Searching Authority to supply together with the international search report, copies of the documents cited therein (PCT Art. 20(3), see also Rule 44.3(c)). When documents are cited that are not in one of the official languages of the EPO and the Search Division needs a translation into one of these languages, it should provide this itself, unless it is able to obtain it from any other source, e.g. the applicant or the International Searching Authority. When an Examining Division requests an additional search for an application in respect of which the EPO has made a supplementary search, this additional search will be carried out by the Search Divisions of the EPO.

#### 4.4 International (PCT) searches

Art. 154

When the EPO acts as an International (PCT) Searching Authority in accordance with Art. 154 (PCT Art. 16(1)) it adheres to the PCT-Search Guidelines (see PCT-Gazette S-06/1998 of 8 October 1998). In general these Guidelines are identical to the European Guidelines for Search. However, the following differences should be noted:

(i) Note that whereas the European Patent Convention sets no precise time limit for the preparation of the search

report, the PCT specifies that the search report is to be issued not later than 3 months from the receipt of the search copy by the International Searching Authority, or 9 months from the priority date, whichever time limit expires later (PCT Rule 42) (see II, 4).

(ii) In contrast to European Patent Convention Rule 31, the PCT makes no provision for payment of fees in respect of claims over and above the tenth. Therefore the search has to be carried out for all the claims of the application as filed (see III, 3.5; X, 8.2(i)).

(iii) When there is lack of unity of invention:

(a) The International Searching Authority notifies the applicant of the results of the partial search relating to the invention first mentioned in the claims and invites the applicant to pay additional search fees, specifying the reasons for which the application is not considered as complying with the requirement of unity of invention (Rule 40.1 PCT).

(b) where no additional payment was made the international search report will contain only the results of the partial search.

(c) where some or all additional search fees have been paid the international search report will cover also those inventions for which such fees have been paid.

(d) where the additional payment was made under protest according to PCT Rule 40.2(c), a review panel will review the justification of the invitation to pay additional search fees. For the review procedure and the subsequent protest procedure reference is made to E-IX, 3.2;

(iv) Note that the Guidelines have been drafted with the intention of removing the small difference between the PCT and the European Patent Convention as regards oral disclosures and the like (see VI, 2) (see PCT Search Guidelines Chapter VI, 1.2 (PCT-Gazette S-06/1998 of 8 October 1998)).

(v) Note that whereas the European Patent Convention only includes **European** applications of earlier filing date but published on or after the date of filing of the application under consideration in the state of the art, the PCT has no such restriction and therefore includes international, European and national applications (fulfilling the indicated conditions) in the state of the art (PCT Rule 33.1(c)) (see VI, 4) (see PCT Search Guidelines Chapter VI, 3.1 (PCT-Gazette S-06/1998 of 8 October 1998)).

(vi) Note that the PCT has no similar provision as regards non-prejudicial disclosures (see VI, 5.7).

(vii) Note that whereas under the European Patent Convention provisional opinions of the Search Divisions as regards subject-matter which can be excluded from the search pursuant to Rules 45 and 46 are subject to review by the Examining Division, under the PCT the International Searching Authority and the International Preliminary Examining Authority decide independently on matters excluded from search and from preliminary examination respectively (PCT Rules 39 and 67) (see VIII, 1 to 3).

The PCT does not contain a provision similar to Art. 54(5) EPC. Therefore, even if the search has disclosed one such use, it must be continued to establish whether the exact use claimed is novel (see VIII, 4).

(viii) For the transmission of the international search report to the applicant and the International Bureau the PCT headed form should be used (see X, 1.2).

(ix) In accordance with PCT Art. 20(3), the International Searching Authority sends copies of the documents cited in the international search report to the designated Office or the applicant at the request of one or other of the latter. This request for documents may be presented any time within 7 years from the International filing date of the international application to which the international search report relates (see PCT Rule 44.3(a)). International search reports which are established by the EPO are transmitted to the applicant together with copies of all the documents cited (see X, 11.1).

(x) When the International Searching Authority establishes the text of the abstract or makes amendments to the text submitted by the applicant, the text as established or amended accompanies the international search report (see PCT Rules 38.2 and 44.2) (see IV, 1.4 and XI, 2). The applicant is allowed one month from the mailing date of the international search report to comment on this abstract. If the International Searching Authority then amends the abstract it notifies the International Bureau of the amendment.

#### **4.5 International-type searches**

Under the PCT, the EPO, as an International Searching Authority, may be entrusted to carry out "international-type searches" for national patent applications (PCT Art. 15(5)). These searches are by definition similar to international searches, and the same considerations apply, except where unity of invention is lacking; the procedure is then brought into line with the European procedure.

**CHAPTER IV****SEARCH PROCEDURE AND STRATEGY****1. Procedure prior to searching**

1.1 When taking up an application to be searched, the search examiner should first consider the application in order to determine the subject of the claimed invention taking account of the guidance given in III, 3. For this purpose he should make a critical analysis of the claims in the light of the description and drawings. Although he need not study all details of the description and drawings, he should consider these sufficiently to identify the problem underlying the invention, the insight leading to its solution, the totality of the means essential to the solution as particularly reflected in the technical features thereof found in the claims, and the results and effects obtained.

Art. 91(1)  
Art. 92(1)  
Art. 78  
Rules 26-36  
Art. 53(a)  
Rule 34

1.2 The search is carried out in parallel with the formalities examination. If the search examiner notices any formal shortcomings which have been overlooked by the Receiving Section, he calls these to the attention of the Receiving Section (or of the Examining Division in the case of an additional search requested by that Division), which takes appropriate action. Similarly, if he notes matter contrary to "ordre public" or morality or disparaging statements which ought to be omitted from the application as published, he notifies the Receiving Section. Note, however, that fair comment as referred to in C-II, 7.2 is permitted.

1.3 Documents cited in the application under consideration should be examined if they are cited as the starting point of the invention, or as showing the state of the art, or as alternative solutions to the problem concerned, or when they are necessary for a correct understanding of the application; however, when such citations clearly relate only to details not directly relevant to the claimed invention, they may be disregarded. In the exceptional case that the application cites a document that is not published or otherwise not accessible to the Search Division, and the document appears essential to a correct understanding of the invention to the extent that a meaningful search would not be possible without knowledge of the content of that document, the Search Division should postpone the search and request the applicant to provide first a copy of the document, if possible doing so within the time limit for the preparation of the search report. If no copy of the document is received in time, the search examiner shall first attempt to carry out the search and then, if necessary, indicate in the partial search report under Rule 45 that the search needed to be restricted or declare that a meaningful search was not possible (see VIII, 6). Applicants must be aware that such later furnished information can only be

taken into account for sufficiency of disclosure pursuant to Article 83 under certain circumstances (see C-II, 4.18).

Rule 47  
Rule 33  
Art. 93(2)

1.4 The search examiner should then consider the abstract (together with the title of the invention and the figure, if any, of the drawings to be published with the abstract) in relation to the requirements laid down in the Implementing Regulations (see Chapter XI). Since the abstract should relate to the application as filed, the examiner should consider it and determine its definitive content before carrying out the search, in order to avoid being inadvertently influenced by the results of the search. If publication of the application is due before the search report is drawn up (A2 publication), the search examiner has to establish the classification of the application much earlier than he carries out the search (see V, 4.1); he examines then at the same time the abstract for the purpose of publication. This examination of the abstract does not go beyond ensuring that it relates to the application concerned and that no conflict exists with the title of the invention or with the classification of the application. Information in relation to the abstract, the title of the invention and the figure, if any, of the drawings to be published with the abstract are transmitted to the applicant in the communication accompanying the search report, in the case of an A1 publication. If the search report is published separately (A3 publication), this information is not given in the communication. The search examiner also translates the title of the invention into the two other official languages.

1.5 The examiner then determines the definitive classification of the application in accordance with the guidance given in V, 4.

## 2. Search strategy

Rule 45  
PCT Art. 17(2)

2.1 Having determined the subject of the invention as outlined in IV, 1.1, it may be desirable for the examiner to prepare first a search statement, defining the subject of his search as precisely as possible. In many instances one or more of the claims may themselves serve this purpose, but they may have to be generalised in order to cover all aspects and embodiments of the invention. At this time the considerations relating to subjects excluded from patentability (see VIII, 1 to 4), and lack of unity of invention (see VII, 1.1) should be borne in mind. The examiner may also have to restrict the search because the requirements of the EPC or the PCT are not met to such an extent that a meaningful search is impossible (see VIII, 6). Any such restrictions to the search shall be indicated in the partial search or declaration taking the place of the search report under Rule 45, or in the declaration under PCT Art. 17(2)(a) or (b). The declaration should indicate the reasons for the restrictions (see X, 8.2(iii)). In the European procedure, the declaration or the partial search

report shall be considered, for the purposes of subsequent proceedings, as the search report.

2.2 Next the examiner should select the units of the classification (or other sections of the documentation) to be consulted for the search, both in all directly relevant fields and in analogous fields. The selection of classification units in related fields should be limited to:

- (i) higher subdivisions allowing searching by abstraction (generalisation) inasmuch as this is justified from a technical viewpoint, and
- (ii) parallel subdivisions, bearing in mind the fact that the fields in question will become increasingly unrelated.

When the examiner is in doubt about the appropriate fields in which to conduct his search, he may request advice from the Classification and Documentation Directorate.

2.3 Often various search strategies are possible, and the examiner should exercise his judgment based on his experience and knowledge of the search files, to select the search strategy most appropriate to the case in hand, and establish the order in which various classification units are to be consulted accordingly. He should give precedence to the units in which the probability of finding relevant documents is highest. Usually the main technical field of the application will be given precedence, starting with the classification units most relevant to the specific example(s) of the claimed invention.

2.4 The examiner should then carry out the search, directing his attention primarily to novelty, but also at the same time paying attention to any prior art likely to have a bearing on inventive step. He should also note any documents that may be of importance for other reasons, such as conflicting applications (see VI, 4), or documents putting doubt upon the validity of any priority claimed (see VI, 3), contributing to a better or more correct understanding of the claimed invention, or illustrating the technological background; but he should not spend time in searching for these documents, nor in the consideration of such matters unless there is a special reason for doing so in a particular case.

2.5 The examiner should concentrate his search efforts on the classification units in which the probability of finding highly relevant documents is greatest, and in considering whether to extend the search to other less relevant areas he should always take account of the search results already obtained.

2.6 The examiner should continuously evaluate the results of his search, and if necessary reformulate the subjects of



the search accordingly. The selection of the classification units to be searched or the order of searching them may also require alteration during the search as a consequence of intermediate results obtained. The examiner should also use his judgment, taking into account results obtained, in deciding at any time during or after the systematic search, whether he should approach the search documentation in some different manner, e.g. by consulting documents cited in the description of documents produced by the search or in a list of references of such documents, or whether he should turn to documentation outside that which is available to the Search Divisions in the search files (see Chapter IX).

2.7 If no documents of a more relevant nature for assessing novelty and inventive step are available, the examiner should consider citing (see X, 9.2(ii)) any documents relevant to the "technological background" of the invention (see III, 3.14), which he may have noted during the search. Generally speaking no special search effort will be undertaken for this purpose; however, the examiner may exercise his discretion here in special cases. It is possible for a search to be completed without any relevant document having been found (see X, 9.1.3).

2.8 Reasons of economy dictate that the search examiner use his judgment to end his search when the probability of discovering further relevant prior art becomes very low in relation to the effort needed. The search may also be stopped when documents have been found clearly demonstrating lack of novelty in the entire subject-matter of the claimed invention and its elaborations in the description, apart from features which are trivial or common general knowledge in the field under examination, application of which features would not involve inventive step. The search for conflicting applications should, however, always be completed to the extent that these are present in the search files.

### **3. Procedure after searching**

3.1 After completion of the search, the examiner should select from the documents retrieved, the ones to be cited in the report. These should always include the most relevant documents (which will be specially characterised in the report, PCT Rule 43.5(c)) (see X, 9.2). Less relevant documents should only be cited when they concern aspects or details of the claimed invention not found in the documents already selected for citation. In cases of doubt or borderline cases in relation to novelty or inventive step, the search examiner should cite rather more readily in order to give the Examining Division the opportunity to consider the matter more fully.

3.2 To avoid increasing costs unnecessarily, the examiner should not cite more documents than is necessary, and therefore when there are several documents of equal relevance the search report should not normally cite more than one of them. In any case, the search report is accompanied by an annex, drawn up by the computer and listing the patent documents which are available and belong to the same patent family. In selecting from these documents for citation, the examiner should pay regard to language convenience, and preferably cite (or at least note) documents in the language of the application (see X, 9.1.2).

3.3 The examiner prepares the search report.

3.4 It may happen occasionally, that after completion of a search report, the Search Division discovers further relevant documents (e.g. in a later search for a related application). Copies of these documents should be sent with a note to the Receiving Section, which, depending upon the stage of procedure reached, will proceed under one of the following three variants. These documents should be added to the search report up to the time that preparations for its publication are completed. Up to the filing of a request for examination, such later discovered documents should be communicated to the applicant in an addition to the search report and this information will be published. Thereafter, such documents should be brought to the notice of the Examining Division by means of an internal communication.

3.5 When a material error is found to be present in a search report prior to publication thereof, a new search report will be drawn up which will cancel the preceding one. The error should immediately be notified to the applicant. When a serious error is noted following publication of the search report, a corrigendum will be published in the Bulletin, and the applicant and the Examining Division should be informed accordingly. If the error comprises the transmission of an incorrect document as citation, the correct document should be sent.

**CHAPTER V****CLASSIFICATION OF EUROPEAN PATENT APPLICATIONS****1. Definitions**

The classification of the European patent application is made by the search examiner who should use the classification symbols contained in the rules of the International Patent Classification for the inventions as claimed (Obligatory Classification). He can also assign any Classification symbol and/or indexing codes to any additional information (Non-Obligatory Classification) as defined in the Guide to the International Patent Classification in force at the time. By "preliminary classification" is meant a first stage of classification, for purposes of internal handling, whereby the subject of the claimed invention (or the invention first claimed, if there is more than one) is broadly identified by means of the appropriate classification symbols. By "definitive classification" is meant the assigning of the appropriate classification symbols identifying the technical subject of the claimed invention (or of the subjects of each of the claimed inventions, if there is more than one), such identification being as precise and comprehensive as the classification permits. In addition, non-obligatory classification or indexation symbols may be attributed to any additional information contained in the document to be classified, which should be identified according to the Guide to the International Patent Classification. These procedures are more fully explained below.

**2. Preliminary classification**

2.1 In order that an application may be allotted to the competent Search Directorate, a preliminary classification must be made. The level of classification at this stage should be as general as practicable so that the classification can be effected either by semi-technical or lower-grade technical staff, and on the basis of a quick and cursory scrutiny of the document (e.g. the title and main claim or claims). On the other hand the level should be specific enough to avoid the need for any intermediate stage of classification before allocation to the competent Search Directorate. The most appropriate level in the light of these considerations is usually that of the sub-class. Only rarely, when the sub-class is exceptionally large or heterogeneous and spread over different Search Directorates, is classification to main ("00") group necessary. This classification should be indicated by the use of the appropriate symbols in a space to be provided on the search sub-dossier.

2.2 The preliminary classification required for this first allotment should be made on the basis of the main claims.

If this results in classification in more than one sub-class, then whichever of these seems to be the most relevant to the claimed invention (or the invention first claimed, if there is lack of unity of invention), should be selected. This is the classification which should be indicated on the sub-dossier.

2.3 In most cases no further classification is required to enable applications to be allotted to the Search Divisions within a Directorate, but where it is necessary it falls within the authority of the Examiner in charge of the field to arrange for such allotment in an expedient manner.

### **3. Incorrect preliminary classification**

If, on reaching the Search Directorate, an application has been found to be incorrectly classified and thus inappropriately allotted it is re-classified and re-allotted by the Directorate receiving it, the indication on the sub-dossier being appropriately amended. Normally this is done by mutual agreement with the Directorate to which it is proposed to re-allot it. However, cases arise over which there is disagreement or uncertainty regarding classification boundaries, or where the Directorate dealing with the case is uncertain as to its correct classification, and in such instances the Directorate having the case should not spend time in trying to resolve the matter, but should consult the classification specialists in the Documentation Section and, if necessary, refer the case to that Section.

### **4. Definitive classification of the application**

4.1 The classification of the European patent application is made by the search examiner as described above in V, 1. Preferably this should be done when he has studied the content of the application in order to carry out the search; however, if publication of the application is due before the search report is drawn up, it is necessary for the search examiner to study the application sufficiently to determine the classification at this earlier stage.

4.2 The terms "Obligatory Classification" and "Non-Obligatory Classification" are defined in volume 10, paragraphs 86 and 87 of the sixth edition of the Guide to the International Patent-Classification (WIPO). The examiner should first of all identify and classify the technical subject or subjects of the invention in accordance with the guidance given under "Obligatory Classification". Further guidance, if required, will be found in III, 3.1 and III, 3.2.

4.3 If this results in classification in more than one sub-class, or more than one main ("00") group within a sub-class, then all such classifications should be assigned. The classification of the invention as claimed should be distinguished from any additional classification

and/or indexing code. In addition, where it is necessary to assign more than one symbol for the invention itself, the symbol which in the examiner's opinion most adequately identifies it, or when this presents difficulties, the symbol which identifies the invention for which most information is given, should be indicated first, e.g. in order to facilitate subsequent allotment of the applications.

4.4 The classification should be determined without taking into consideration the probable content of the application after any amendment, since this classification should relate to the disclosure in the published application, **i.e. the application as filed**. If, however, the examiner's understanding of the invention, or of the content of the application as filed, alters significantly as a result of the search (e.g. as a result of prior art found, or because of the clarification of apparent obscurities) he should amend the classification accordingly if the preparations for publication have not at that stage been completed.

#### **5. Classification of late published search report**

Where the search report is not available in time for publication of the application and is therefore published separately, and the examiner finds it necessary to amend the original classification for the reasons given in V, 4.4, he should state the amended classification on the search report, indicating that it constitutes the "definitive classification" in place of that published on the application (which thus becomes merely the "classification for publication"). Such amendment of the classification should not be made unless the examiner is quite certain that it is necessary.

#### **6. Classification when scope is obscure**

When the scope of the invention is not clear the classification has to be based on what appears to be the invention insofar as this can be understood. It is then necessary to amend it if obscurities are removed by the search, as discussed in V, 4.4.

#### **7. Lack of unity of invention**

Where objection of lack of unity of invention arises, all inventions must be classified since all will be disclosed in the published application. Each invention claimed is to be classified as set out in paragraphs V, 4.2 to 6.

#### **8. Verification of definitive classification**

8.1 As a general rule applications will not be systematically scrutinised after leaving the Search Division in order to verify the correctness of the definitive classification assigned by the examiner. The Principal Directorate Classification, Documentation may, however, institute such

sampling check procedures as are deemed necessary to ensure correctness and uniformity in the application of the International Classification. It is, of course, for the Director to arrange for such checks as he considers necessary, having regard to the experience of his examiners, before the applications leave his Directorate.

8.2 The ultimate responsibility in deciding classification matters lies with the Principal Directorate Classification, Documentation.

**CHAPTER VI**

## THE STATE OF THE ART

**1. General**

The general considerations relating to the state of the art, especially with regard to the determination of novelty and inventive step, are set out in C-IV.

**2. State of the art - oral disclosure, etc.**

The PCT according to its Rule 33.1(a) and (b) recognises oral disclosure, use, exhibition, etc., as prior art only when this is substantiated by a written disclosure. In contrast, according to Art. 54 of the European Patent Convention a public oral description, use, etc. is considered as prior art. However, the search examiner, in carrying out a European search, should cite an oral description etc. as prior art only if he has available a written confirmation or is otherwise convinced that the facts can be proved.

**3. Priority**

Since the Search Division does not verify the justification of the claimed priority dates, there may be uncertainty as regards which of two applications is the earlier one. Therefore the search for conflicting applications should be extended so as to cover all published applications filed up to one year after the filing date of the application under consideration (see IV, 2.4).

**4. Conflicting applications**

Art. 54(3)

4.1 Generally it will not be possible at the time of the search to make a complete search for conflicting European and International applications. This search therefore has to be completed at the examination stage by the Examining Division which for this purpose has available classified search files of these published applications. The Search Divisions should therefore neither attempt to discover as yet unpublished conflicting applications nor undertake special documentation efforts to allow a search therefor.

Art. 139(2)

4.2 There may also be national applications of one or more States designated in the European application of which the dates of filing are prior to the filing date of the European application, and which were published as national applications or patents on or after that date. Although such applications are not a bar to the grant of a European patent, but only a ground for revocation in the Contracting State(s) concerned, they may be of importance to the applicant. Therefore, any of these which are present in the search files are noted and mentioned in the search report

for information (see X, 9.2(vi)). However, no special search effort should be made for this purpose (PCT Rule 33.1(c)).

#### **5. Date of reference; filing and priority date**

Art. 80, 90  
Art. 54(2)

5.1 Since the Search Division is not responsible for the verification of any claimed priority date (which in the examination stage takes the place of the filing date for assessing prior art and determining precedence), the basic reference date for the search must be taken as the date of filing of the European application as accorded by the Receiving Section (similarly PCT Rule 33.1(a); for the reference date for the search with respect to conflicting applications, however, see VI, 3).

5.2 The Search Division takes into account documents published between the earliest priority date and the filing date of the application under consideration and these documents are identified as such in the search report (see X, 9.2(iv)). For identifying these documents when an application has more than one priority date, the oldest date is to be applied for this purpose. When deciding which documents to select for citing in the search report, the examiner refers to these dates and should preferably choose any published before the date of priority. Thus for example, where there are two documents, one published before the date of priority and the other after that date but before the date of filing, but otherwise equally relevant, he should choose the former (see IV, 3.2).

5.3 It is the responsibility of the Examining Division to check whether and to what extent the priority claim is justified; therefore the Search Division does not check whether the contents of the European application correspond to those of the priority application(s). Nevertheless, documents showing that a priority claim might not be justified (e.g. an earlier application or patent resulting therefrom, by the same applicant indicating that the application from which priority is claimed may not be the first application for the invention concerned), should be cited in the search report (see X, 9.2(viii)). No special search beyond the filing date of the application should normally be made for this purpose, except when there is a special reason to do so, e.g. when the priority application is a "continuation in part" of an earlier application from which no priority is claimed; also sometimes the country of residence of the applicant being different from the country of the priority application may be an indication that it is not a first filing, justifying a certain extension of the search.

5.4 When the search is extended for this purpose, it should cover the published applications filed up to one year after the filing date of the application under consideration, for the reasons given in VI, 3.



5.5 The search does not normally take into consideration documents published after the filing date of the application. However, some extension is necessary for specific purposes, as is apparent from VI, 2 to VI, 4 and VI, 5.3.

5.6 Certain other situations may occur in which a document published after the filing date is relevant; examples are a later document containing the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or a later document showing that the reasoning or the facts underlying the invention are incorrect. The search should not be extended for this purpose, but documents of this nature known to the examiner could be selected for citation in the report (see X, 9.2(v)).

Art. 55  
Rule 23

5.7 Disclosures of the invention should not be taken into consideration if they occurred no earlier than six months preceding the filing of the European patent application and if they were due to an evident abuse in relation to the applicant or his legal predecessor, or due to display at an official, or officially recognised international exhibition. The Search Division should, nevertheless, cite in the search report any documents it has reason to believe come within one of the categories mentioned in X, 9.2(viii). In this case too the reference date for the search will be the filing date of the application (see VI, 5.1). Since the matter of abuse will generally only be raised after the transmission of the search report, and the disclosure at an exhibition involves the question of identity between the displayed and claimed invention, both matters are better resolved by the Examining Division.

## **6. Contents of state of the art disclosures**

6.1 As a general rule the Search Division selects for citation only documents which are present in its search files or which it has access to in some other manner; in that way no doubt exists about the contents of the documents cited, since the search examiner generally has physically inspected each document cited.

6.2 However, under certain circumstances a document whose contents have not been verified may be cited, provided there is justification for the assumption that there is identity of contents with another document which the examiner has inspected; both documents should then be mentioned in the search report in the manner indicated at the end of X, 9.1.2. For example, instead of the document published before the filing date in an inconvenient language and selected for citation, the search examiner may have inspected a corresponding document (e.g. another member of the same patent family, or a translation of an article) in a more convenient language and possibly published after the filing date; also the Search Division

may assume that, in the absence of explicit indications to the contrary, the contents of an abstract are contained in the original document. Also the examiner should assume that the contents of a report of an oral presentation are in agreement with that presentation.

6.3 Before citing documents in a language with which he is not familiar, the search examiner should make sure that the document is relevant (e.g. through translation by a colleague, through a corresponding document or abstract in a familiar language, or through a drawing or chemical formula in the document).

## **7. Matters of doubt in the state of the art**

7.1 Since decisions with respect to novelty are not the responsibility of the Search Divisions but of the Examining Divisions, the Search Divisions should not discard documents because of doubt as regards for example the exact date of publication or public availability, or the exact contents of an oral disclosure, exhibition etc. to which such documents may refer. The Search Division should try to remove any doubt that may exist but should nevertheless always cite the documents concerned in the search report. Additional documents providing evidence in the matters of doubt may be cited.

7.2 Any indication in a document of the date of its publication should be accepted as correct unless proof to the contrary is offered, e.g. by the Search Division, showing earlier publication, or by the applicant, showing later publication. If the indicated date of publication is insufficiently precise (e.g. because a year or year and month only are given) to establish whether publication was before the reference date for the search, the Search Division should endeavour to establish the exact date with sufficient precision for the purpose. A date of receipt at the EPO stamped on the document, or a reference in another document, which must then be cited (see X, 9.2(vii)), may be of assistance in this respect.

## **8. Evaluating inventive step**

In evaluating inventive step the Examining Divisions will have to consider this in relation to all aspects of the claimed invention, such as the underlying problem (whether explicitly stated in the application or implied), the insight upon which the solution relies, the means constituting the solution, and the effect or results obtained. Therefore, the search takes all these aspects into consideration, as more fully explained in C-IV, 9.

**CHAPTER VII**

## UNITY OF INVENTION

**1. General remarks**

1.1 If the Search Division considers that the application does not comply with the requirement of unity of invention (see C-III, 7), it must search, and draw up the partial search report under Rule 46(1) for those parts of the application which relate to the invention (or group of inventions forming unity) first mentioned in the claims (PCT Art. 17(3)(a)). The partial search report is supplemented with a specification of the separate inventions.

Rule 46(1)

1.2 The Search Division will inform the applicant of the lack of unity of invention in a communication accompanying the partial search report and indicate that a further search fee must be paid for each invention other than the one first mentioned in the claims, if the search report is to cover these inventions as well. The payment of these fees must take place within a period to be set by the Search Division, which may not be less than two weeks and may not be more than six weeks (PCT Rule 40.3). The additional searches relating to inventions in respect of which further search fees have been paid within the fixed period, receives preferential treatment by the Search Division. The search report is to be drawn up for all those parts of the patent application which relate to inventions in respect of which search fees have been paid (PCT Art. 17(3)(a)). The search report identifies the separate inventions and indicates those claims for which a search has been made.

1.3 Lack of unity of invention may be directly evident "a priori", i.e. before considering the claims in relation to any prior art, or may only become apparent "a posteriori", i.e. after taking the prior art into consideration (see C-III, 7). The Search Division may raise the objection of lack of unity and restrict the search to the invention (or group of inventions) first mentioned in the claims, disregarding "trivial" claims as in III, 3.9.

1.4 Where the search examiner finds a situation of lack of unity of invention to exist, reasons of economy may make it advisable to search the additional invention(s) together with the invention mentioned first in the claims, in the classification units consulted for the latter invention if this takes little or no additional search effort. If objection of lack of unity is raised, the results of the search for the additional invention(s) may not be made part of the partial search report, but must be kept available for inclusion in the search report which is established at the end of the period fixed for the payment of the additional fees. The search for such additional invention(s) has then to be completed in any further classification units which may be relevant.

## 2. European applications

Rule 46(2)

2.1 At the examination stage the applicant may contest the allegation of non-unity and request a refund of the additional fee(s) paid. If the Examining Division finds this to be justified the fee(s) will be refunded.

2.2 From the preceding paragraph it is clear that the decision with respect to unity of invention rests with the Examining Division. Consequently the criteria to be applied in this respect by the Search Division should not be different from those applied by the Examining Division. In particular the Search Division should not raise an objection of lack of unity merely because the inventions claimed are classified in separate classification units, or merely for the purpose of restricting the search to certain classification units.

2.3 Occasionally in cases of lack of unity, especially "a posteriori", the examiner is able to make a complete search for all inventions with negligible additional work and cost, in particular when the inventions are conceptually very close. In those cases, the search for the additional invention(s) is completed together with that for the invention first mentioned. All results should then be included in a single search report, which raises the objection of lack of unity and identifies the different inventions. It further indicates that the Search Division did not invite the applicant to pay additional fee(s) because all claims could be searched without effort justifying such a fee.

Art. 157(2)(a)

2.4 When in a supplementary European search following an international (PCT) search a problem of unity of invention arises, the Search Division should avoid whenever possible deviations from the position taken by the International Searching Authority in the international search report, except where the claims have been changed, or the interpretation of the rules regarding unity of invention was clearly erroneous. When as a result of the supplementary search lack of unity "a posteriori" is found to exist, the Search Division should act accordingly (see VII, 1.3).

Rule 104b(5)

Any fee which has been paid under Rule 104b(4) due to lack of unity "shall be refunded if, during the examination of the European patent application by the Examining Division, the applicant requests a refund and the Examining Division finds that the communication referred to in the said paragraph was not justified".

## 3. International applications

3.1 When the EPO establishes an International Search Report for an international application and an objection to lack of unity is raised, this allegation can be contested by the applicant by paying the additional search fees under

protest. The subsequent review by a review panel and, if applicable, by a Board of Appeal is treated in E-IX, 3.2.

3.2 For specific details related to the question of unity of invention in international applications, see PCT Search Guidelines, Chapter VII (PCT-Gazette S-06/1998 of 8 October 1998).

**CHAPTER VIII****SUBJECT-MATTER TO BE EXCLUDED FROM THE SEARCH**

- |                                 |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                          |
|---------------------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| PCT Art. 17(2)<br>PCT Rule 39.1 | 1. Under PCT Art. 17(2)(a)(i) and PCT Rule 39.1, the International Searching Authority is not required to search certain specified subject-matter. A declaration to that effect may take the place of the search report (PCT Art. 17(2)(a)), though the search examiner should attempt to conduct the search based on subject-matter which might reasonably be expected to be claimed in response to an objection on the basis of an exclusion from patentability or a lack of susceptibility of industrial application.                                                                                                                                 |
| Art. 52(2) to (4)<br>Art. 53    | The subject-matter listed in PCT Rule 39.1 is also either considered not to be susceptible of industrial application or excluded from patentability under Art. 52(2) to (4), or Art. 53; for policy reasons, similar considerations to those set out in PCT Rule 39.1 apply also to the search for European applications. For the specific case of compositions for use in methods of treatment of the human or animal body, see VIII, 4, below.                                                                                                                                                                                                         |
| Rule 45<br>PCT Art. 17(2)       | 2. This situation may also occur for only some of the claims or for part of a claim. In these cases, this will be indicated in the partial search or the declaration taking the place of the search report under Rule 45 or in the declaration under PCT Art. 17(2)(a) or (b).                                                                                                                                                                                                                                                                                                                                                                           |
| Art. 52(1)                      | 3. While a decision on these matters rests with the Examining Division, provisional opinions on these matters must sometimes be formed by the Search Division, which has thus to consider the requirements for patentability other than novelty and inventive step, as set out in C-IV, 2 to 4.                                                                                                                                                                                                                                                                                                                                                          |
| Art. 54(5)                      | 4. With regard to methods for treatment of the human or animal body by surgery or therapy, or diagnostic methods practised on the human or animal body, it should be noted that products, in particular substances or compositions, for use in any of these methods, are not excluded from patentability, provided the use of the product for <b>any</b> such method is not comprised in the state of the art. It should be noted that a claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" may be allowable for either a first or "subsequent" such application (cf. C-IV, 4.2). |

Even if a claim is drafted as a method of medical treatment and is for this reason not directed to patentable subject-matter, a complete search may be possible if the determining technical feature is the effect of the substance, which can be searched. If, however, specific method features are present (e.g. dosing instructions for the user, combination

of pharmaceutical with physical treatment) a meaningful search may not be possible. —

5. In cases of doubt the Search Division should carry out the search to the extent that this is possible in the available documentation. —

Rule 45  
PCT Art. 17(2)

6. There is a further situation, where a declaration or partial search may take the place of the search report under Rule 45, or where a declaration may be issued under PCT Art. 17(2).

It should be noted that the EPC and PCT use slightly different terminology for dealing with these cases. For example, Rule 45 refers to a "partial ... search report", whereas PCT Art. 17(2) does not. Rule 45 also draws a distinction between a partial search on the one hand, and a "declaration" of no search on the other, whereas PCT Art. 17(2) refers to the Search Authority "declar[ing]" that no search is possible at all or "declar[ing]" that no search is possible in respect of certain claims. In these Guidelines, these distinctions are preserved.

A declaration or partial search taking the place of the search report under Rule 45, or a declaration under PCT Art. 17(2) may result from the application not meeting the relevant requirements of the EPC or the PCT to such an extent that a meaningful search of the claims, or of some of the claims, or of part of a claim, is impossible. In such cases, the Search Division should make a meaningful search to the extent that this is possible.

What is or is not "meaningful" is a question of fact for the Search Division to determine. The exercise of the discretion of the Search Division will depend upon the facts of the case. There are clearly cases where a search is rendered de facto impossible by the failure to meet the prescribed requirements of the EPC or PCT. But these are not the only circumstances under which Rule 45 or PCT Art. 17(2) may be invoked. The word "meaningful" should be construed reasonably.

On the one hand, the word "meaningful" should not be construed in such a way that Rule 45 and PCT Art. 17(2) are invoked simply because a search is difficult. On the other hand, it may be the case that a given claim could, theoretically, be search completely, but that nevertheless, the Search Division comes to the conclusion, under a proper consideration of the relevant provisions of the EPC or the PCT, that it would not be meaningful to do so, in the sense that it would not serve any useful purpose to do so having regard, for example, to any possible future prosecution of the application.

In other cases, it may be that the results of the search

themselves would be quite meaningless.

A number of non-limiting examples will illustrate where Rule 45 or PCT Art. 17(2) may find application.

One example would be the case of a broad or speculative claim supported by only a limited disclosure covering a small part of the scope of the claim. If the broadness of the claim is such as to render a meaningful search over the whole of the claim impossible, the Search Division will carry out the search on the basis of the narrower, disclosed invention. This may mean a search of the specific examples. In such a case, it will often be de facto impossible to do a complete search of the whole of the claim at all, because of the broad drafting style. In other cases, a search of the whole of the claim would serve no useful purpose, as the claim would not be defensible in any subsequent examination phase. Accordingly, a declaration or a partial search will be issued, indicating the extent of the search and the requirements of the EPC or the PCT which have not been complied with to such an extent that a meaningful complete search is considered possible. Here, these requirements would be those of sufficiency of disclosure and support set out in Art. 83 and 84, and in PCT Art. 5 and 6 (see C-II, 4.9, 4.9a, 4.10; C-III, 6).

Another example would be where there are so many claims, or so many possibilities within a claim, that it becomes unduly burdensome to determine the matter for which protection is sought. A complete search (or any search at all) may de facto be impossible, or alternatively may serve no useful purpose as the claim or claim set would be indefensible in any subsequent examination phase. Again, a partial search or a declaration of no search at all may be appropriate, on the grounds that the lack of conciseness of the claim(s) is such as to render a meaningful search impossible (see Art. 84, PCT Art. 6; C-III, 5).

A further example would be where the applicant's choice of parameter to define his invention renders a meaningful comparison with the prior art impossible, perhaps because the prior art has not employed the same parameter, or has employed no parameter at all. In such a case, the parameter chosen by the applicant may lack clarity (see Art. 84, PCT Art. 6; C-III, 4.7a). It may be that the lack of clarity of the parameter is such as to render a meaningful search of the claims or of a claim, or of a part of a claim impossible, because the results of any search would be meaningless, the choice of parameter rendering a sensible comparison of the claimed invention with the prior art impossible. If so, a partial search (or, in exceptional cases, no search at all) under Rule 45, or a declaration under PCT Art. 17(2) will be appropriate, the search possibly being restricted to the



worked examples, as far as they can be understood, or to the way in which the desired parameter is obtained.

These examples are not exhaustive. The basic principle is that there should be clarity and openness both for the applicant and for third parties as to what has and what has not been searched.

Exceptionally, the Search Division may, at its own discretion, where it thinks it is appropriate, ask the applicant informally for clarification before deciding whether or not to make a declaration that a meaningful search is impossible for some or all of the claims, or for part of a claim.

If the deficiencies which rendered a meaningful search impossible are subsequently corrected by amendment or if their existence is successfully refuted by the applicant during the substantive phase of examination, the Examining Division may request the Search Division to perform an additional search - see III, 4.2 and C-VI, 8.5.

**CHAPTER IX****SEARCH DOCUMENTATION****1. General****1.1 Organisation and composition of the documentation available to the Directorate-General for Searching**

The basic part of the search documentation consists of a collection of patent documents systematically arranged in a manner suitable for searching. Additionally, periodicals and other publications of technical literature are put at the disposal of the examiners. This non-patent literature is mainly arranged in the library in a manner suitable for consultation; parts thereof, such as particularly relevant articles, are selected and made available for direct access by incorporating these, or copies thereof, into the systematic documentation. The systematically arranged part of the search documentation includes the minimum documentation required for an International Searching Authority under the PCT (Rule 34, Rule 36.1(ii)), and extends somewhat beyond these minimum requirements.

Furthermore, the Directorate-General for Searching at The Hague has access to the documentation of the Netherlands Patent Office, and at Berlin has access to the documentation of the Technical Information Centre Berlin of the German Patent and Trademark Office. This documentation is in each case located in the same building, and consists mainly of a collection of numerically arranged patent documents and of patent gazettes, a restricted collection of systematically arranged patent documents (primarily intended for use by the public), and a library collection of technical and juridical works and periodicals. The situation at The Hague is described in IX, 2 to 5, whilst points of difference at Berlin are summarised in IX, 6.

**1.2 Systematic access systems**

The systematically accessible search documentation is primarily arranged so as to facilitate manual searching in a "pigeon-hole" filing system (practising multiple classification and filing where necessary) using the internal classification of the EPO which essentially consists of the International Classification but also comprises finer internal subdivisions. In certain areas the transfer to the International Classification has not yet been made or has only been completed for the more recent documents; gradually the transfer is becoming more complete. In a few fields, where manual search was considered unsatisfactory, search systems for instance based on term indexing have been introduced, and in the majority of these systems the search is not carried out manually but using a computer as search tool. In certain areas (especially in chemical fields)

the manual search is based primarily upon the scanning of keyword or term indexes of abstract journals.

Furthermore, all search examiners have access to on-line computer search facilities.

### 1.3 Numerical lists

The Principal Directorate Classification/Documentation operates a computerised patent family system for documents in the search files published since 1968, which is linked with a class-inventory system (for older documents written or typed lists are available). The family system is updated in co-operation with the national Offices on a basis of exchange of new input data. From these systems examiners can obtain the identification of corresponding patents of other countries ("family members") and the classification given to a given patent document.

## 2. Patent documents arranged for systematic access

### 2.1 PCT minimum documentation

The systematically accessible search documentation includes the national patent documents belonging to the PCT minimum documentation as specified in PCT Rule 34.1(b) (i) and (c):

(i) the patents and/or published patent applications, published in and after 1920 by France, the former Reichspatentamt of Germany and the Federal Republic of Germany, Switzerland (in the French and German languages only), the United Kingdom, and the United States of America;

**Note:** as regards the patents of Switzerland published between 1920 and 1940 (which were included after 1973) for reasons of economy only those in which no priority is claimed are included (by analogy with PCT Rule 34.1(c) (vi)).

(ii) the utility certificates, and/or published applications therefor, issued by France;

(iii) the patents and/or published patent applications in which no priority is claimed, published by Austria, Australia and Canada after 1970, as selected and made available by these countries;

(iv) the abstracts in English of the patents and/or published patent applications issued by Japan and the Soviet Union, and the inventors' certificates issued by the Soviet Union, for which abstracts in the English language are generally available, are included.

Also included are the published international (PCT) and regional (e.g. European) patent applications, patents, and inventors' certificates (PCT Rule 34.1(b) (ii)).

2.2 The search files furthermore include the following national patent documents:

- (i) patents published by France, Germany or the United Kingdom before 1920;
- (ii) patents and applications for patents published by the Netherlands (from 1912);
- (iii) patents published by Belgium since 1926 and Luxembourg since 1946.

**Note:** a small part of these, published in the French or German language, and not claiming priority, is analogous to the part of the PCT minimum documentation referred to in IX, 2.1(iii) above.

2.3 Since the completion of the search for conflicting applications that are not published at the time of the initial search is entrusted to the Examining Divisions, the search files do not include unpublished patent applications.

2.4 In order to reduce the bulk of the search files and the amount of classification work, whenever an application is republished as such or as a granted patent, normally only one of these documents is included in the search files (compare PCT Rule 34.1(d)).

### 2.5 Search Reports

The official European and international (PCT) search reports are normally published together with the European and international applications and are included in the search files together with these applications. The official search reports relating to national applications, as well as unofficial search reports, are also included in these files to the extent that they are available to the public. Search reports that are not normally or not yet accessible to the public in the form of a published document, are included in the search files separately from the state of the art documents, and searching thereof is not compulsory for all applications.

### 2.6 Arrangements for search

The manual search files consist of paper copy documents held loosely in folders which are kept in pigeon-hole filing cabinets; these cabinets are located in storage rooms close to the examiners' rooms to which the folders are taken when needed for search.

## 2.7 Patent family system

The practice of not including all members of a patent family (as accepted by PCT-TCO) is followed extensively. With respect to patent documents published after 1968 this is done using the computerised patent family system of the EPO; for older documents this is done mainly in the context of reclassification projects. The examiners can make use of the computerised patent family system to obtain the identification of other family members, which may then be consulted in the numerical files, or from which file copies may be obtained.

As regards new acquisitions the selection of the family member to be classified and incorporated in the search files is as follows:

- (i) all published European applications and international applications designating the EPO are incorporated in the search files;
- (ii) the family member which is received first at the Classification and Documentation Department, or the one of which the bibliographic data are first available at that department for inclusion in the computer file (when this is not an application as in (i) above), is incorporated in the search files;
- (iii) whenever a choice is available because of substantially simultaneous arrival, preference is given to documents published in the English, French or German languages;
- (iv) whenever the first family member included in the search files is not in an official language, and a further family member belonging to the minimum documentation is received, that document is also included in the search files (in particular the first one of these if more than one is received);
- (v) by way of exception, e.g. in complex technical fields, an additional family member may also be included in the search files when the information therein is more complete or presented in a more convenient way (e.g. US patents).

The selection of the documents incorporated in the search files under the family system as operated in the past, followed slightly different rules in some respects; for these documents the former situation is maintained in principle; nevertheless, whenever there is a reason to review the contents of a field, e.g. in case of reclassification, the opportunity is used to adapt the contents of the files to the above situation to the extent that this is practicable.

### **3. Non-patent literature arranged for systematic access**

3.1 The systematically accessible search documentation includes the relevant articles from the list of 169 periodicals belonging to the minimum documentation under the PCT as established by the competent PCT body (PCT-TCO). In principle copies of the articles selected as relevant for search purposes are included in the manual search files. However, where these documents as stored in the library are easily systematically accessible in some other manner commonly used by the examiners in the field concerned (e.g. through an indexed or classified abstract journal such as Chemical Abstracts), no copies are included in the search files.

3.2 The Directorate-General for Searching also subscribes to many further periodicals (in total about 930) including abstract journals. Furthermore records of conference proceedings, reports, books etc. covering the three official languages of the EPO and the various technically important geographical areas are obtained. Individual items are selected for inclusion in the search files in so far as they constitute useful additions to the state of the art as mainly reflected in the systematically accessible patent documents; such items are mainly primary articles from periodicals or conference proceedings and reports.

#### **3.3 Arrangements for search**

Whenever copies of non-patent literature items are included in the search files, they are stored together with the patent documents with the same classification, usually in separate folders (see IX, 2.6). Since experience shows that the importance of many of these non-patent items for purposes of search decreases strongly after a few years (e.g. five years), those that have lost interest will be removed periodically. The periodicals and other non-patent items themselves are stored in library manner and will be kept somewhat longer (e.g. 10 years) for the purpose of later consultation and copying. These items are stored together with non-patent literature kept for other purposes as indicated in IX, 5.

### **4. Patent documents. Library collection of Netherlands Patent Office**

#### **4.1 Numerically arranged collection of patent documents**

This collection included the following patent documents for the periods indicated and starting from the year listed:

## (i) PCT minimum documentation countries and international organisations

France	
patents	1802
patents of addition	1902
patents relating to medicines	1961
patents of addition to patents relating to medicine	1961
patent applications	1969

Germany, Federal Republic	
patents	1877
patent applications examined	1957
patent applications not examined	1968
utility models (abstracts)	1968

Switzerland	
patents	1888
patent applications	1955

United Kingdom	
patents	1630

United States	
Abstracts	1861-1931
patents	1920
reissues	1920
patent applications	1976
Defensive publications	1960

EPO	
patent applications	1978
patents	1980

WIPO	
patent applications	1978

OAPI	
patents	1966

## (ii) PCT minimum documentation countries if English abstracts available

Japan	
patents	1948
patent applications examined	1950
patent applications not examined	1971
utility models	1949
utility models applications examined	1950
utility models applications not examined	1971

Soviet Union	
patents	1945

(iii) PCT minimum documentation countries if available in English, French or German and if no priority claimed

Austria		
patents		1899
Australia		
patents		1904
patent applications		1963
Canada		
patents		1949
Countries potentially in the above category		
Belgium		
patents		1926
Luxembourg		
patents		1945
Germany, Democratic Republic		
abstracts		1951
patents		1964
Ireland		
patents		1929
India		
patents		1963
New Zealand		
patents		1980
(iv) Further EPO countries, not in English, French or German		
Spain		
patents		1960
Sweden		
patents		1885
patent applications		1968
Italy		
patents		1926
Netherlands		
patents		1913
patent applications examined		1912
patent applications not examined		1964
Denmark		
patents		1894
patent applications		1968



Finland	
patents	1944
patent applications	1968
(v) Other countries, not in English, French or German	
Brazil	
patents	1979
Bulgaria	
patents	1955
China	
patent applications examined	1985
patent applications not examined	1985
utility models not examined	1985
Hungary	
patents	1911
Norway	
patents	1899
patent applications	1968
Poland	
patents	1924
Romania	
patents	1957
Czechoslovakia	
patents	1919

The collection furthermore includes the gazettes of all the above-mentioned countries, in some instances going back even further than the patent collections themselves, as well as of many other countries.

#### 4.2 Arrangement and location

The numerical files mainly consist of paper copies bound in hundreds (for recent years of countries with high degree of use: in fifties) and stored on shelves in the two floors of the library storage space, which are located directly below the public reading room. The files of countries with a low intensity of use, and in the future also the old parts of countries with a high intensity of use, have been or will be replaced by 16 mm microfilm. Recent issues of a few countries are available solely or additionally in the form of 8-up aperture cards and/or 35 mm film in 8-up format; it is to be expected that this will gradually expand. These 16 and 35 mm microfilms are all located in the public reading room; the aperture cards are in a separate room nearby.

### 4.3 Systematically arranged patent documents

This relatively small collection is primarily intended for use by the public. It comprises the following:

- (i) patent documents issued by the Netherlands from 1912;
- (ii) patent applications of the Federal Republic of Germany as published after examination from 1957;
- (iii) patent applications published by the EPO from 1978;
- (iv) PCT patent applications published from 1985.

These documents are arranged according to the national Netherlands and German patent classifications up to 1973 and 1975 respectively, and from these years on according to the International Classification (in the case of the German and European applications, as printed or stamped on the documents), for which purpose they are loosely held in plastic covers that are stored on shelves in the public reading room.

### 4.4 Form of use

Both the reading room and the storage floors are accessible to the users, and use is in principle on a self-service basis. When needed, assistance from library personnel can be obtained. Viewing apparatus for the microfilm files is available in the reading room, and on all floors copiers are present; users are not allowed to remove patent volumes from the library.

## 5. Non-patent literature arranged for library type access

### 5.1 Composition

In addition to the non-patent literature mainly serving search purposes (see IX, 3), this also comprises such literature serving primarily as sources of information and education of the examiners both as regards general and background technical information and as regards new technical developments. The EPO subscribes to about 1 130 periodicals, and has about 20 000 technical works; furthermore the collection includes many reports, pamphlets, etc.

### 5.2 Arrangement and location

The technical library of the Directorate-General for Searching is strongly decentralised, e.g. to the level of Directorates or even individual examiners in exceptional cases. One or more library and reading rooms are present in the

building on most floors where examiners are located, with copying facilities close at hand. Documents are normally not to be removed from the library rooms for study, but are to be studied in the library rooms, and then if necessary to be copied for further study or use. A catalogue is available giving a complete inventory by patent classification and giving the location of the items.

### **5.3 Collection of the Netherlands Patent Office**

The Netherlands Patent Office also has for the use of its examiners a collection of technical periodicals, books, reports, etc.

The general and chemical part thereof, as well as many older book volumes, are located in the area of the public reading room, the remainder is to a large extent located in the rooms of the examiners concerned.

The Netherlands Patent Office furthermore has a large collection of juridical periodicals and works, specialised with respect to matters of industrial property. This collection is also located in the area of the public reading room. Catalogues are maintained for both parts.

## **6. Search documentation in the Berlin sub-office**

6.1 The search documentation of the Berlin sub-office is a continuation of the search documentation of the former Dienststelle Berlin of the German Patent and Trademark Office, including the numerical list relating thereto, which was transferred to the EPO. Furthermore, the Berlin sub-office has access to the library collection of the Technical Information Centre Berlin of the German Patent and Trademark Office.

6.2 The systematic documentation of the Berlin sub-office as regards patent documents shows the following main differences with respect to that at The Hague: it includes the utility models (mainly abstracts) of the Federal Republic of Germany and the patent documents of Austria and the German Democratic Republic, but includes the patent documents of Belgium and Luxembourg only as from 1978 and does not include the patent documents of the Netherlands. From 1978 the documentation is classified according to the internal Classification of the EPO. For the documents prior to 1978 the classification is arranged either according to the International Patent Classification or to the German classification with the exception of certain fields ("activated fields") where harmonisation with the internal EPO classifications is being introduced.

6.3 The numerical collection of patent documents of the Dienststelle Berlin, apart from minor distinctions with respect to the year from which the documents are present,

mainly differs from the collection at The Hague by the absence of the patent documents of Belgium, Canada, Ireland, Hungary, India and Luxembourg, and the presence of those from Brazil (since 1972) and Yugoslavia (since 1922). Also as regards patent gazettes the differences are of a minor nature.

6.4 The available non-patent literature at present contains subscriptions to 360 periodicals including the PCT minimum documentation list of periodicals, as well as about 21000 books.

### **7. Search documentation in national offices carrying out transferred searches on European patent applications**

#### **7.1 Search documentation in the Austrian Patent Office**

The search documentation of the Austrian Patent Office is used for European searches transferred to that Office under Section IV, paragraph 2, of the Protocol on Centralisation. It shows the following differences with respect to the search documentation of the Directorate-General for Searching of the EPO at The Hague: absence of the patent documents of the Netherlands and Belgium, and presence of those of the German Democratic Republic and all patent documents of Austria irrespective of year of publication and including all that claim priority.

The non-patent literature comprises 494 subscriptions to periodicals, including those of the PCT minimum documentation, and about 80 500 technical works.

The systematic documentation is practically all arranged according to the International Patent Classification. A few of the old documents are still arranged according to the former Austrian Patent Classification. However a list of concordance with the IPC exists for these.

#### **7.2 Search documentation in the Swedish Patent Office**

The search documentation of the Swedish Patent Office will be used for international searches carried out by that Office as an International Searching Authority. For international search work entrusted by the EPO to that Office and for European searches transferred to the Swedish Patent Office under Section III, paragraph 2, of the Protocol on Centralisation.

It shows the following main differences with respect to the search documentation of the Directorate-General for Searching at The Hague: absence of patent documents of

Belgium, Luxembourg, Netherlands, presence of those of Denmark, Finland, Norway and Sweden.

The non-patent literature includes subscriptions to 249 periodicals and about 8 000 technical works.

The systematic documentation in the search files is arranged according to the German patent classification up to 1970 and to the International Patent Classification since 1970, with the exception of US patent documents which are all arranged according to the US patent classification.

#### **8. Search documentation for searches carried out in Munich**

In some technical fields searches are also performed in Munich. The examiner there has at his disposal the relevant search documentation of the branch in The Hague via on-line computer search facilities.

**CHAPTER X****SEARCH REPORT****1. General**

1.1 The results of the search will be recorded in a search report. In addition to the search report, the declaration or the partial search report under Rule 45 and the partial search report under Rule 46(1) may be applicable. The search report, the declaration and the partial search report under Rule 45 are transmitted to the applicant, published and serve as a basis for the examination by the Examining Division. The partial search report under Rule 46 is transmitted only to the applicant.

1.2 The Search Division is responsible for drawing up of the European search report.

This Chapter contains the information which is necessary to enable the examiner to complete the form correctly.

A search report must contain no matter, in particular, no expressions of opinion, reasoning, arguments or explanations, other than as required by the form (PCT, Rule 43.9).

**2. Different types of search reports drawn up by the EPO****2.1 The EPO will draw up the following types of search report:**

- (i) European search report (see III, 4.1),
- (ii) Account of an additional European search (see III, 4.2),
- (iii) Supplementary European search report concerning a PCT application (see III, 4.3),
- (iv) International search report under the PCT (see III, 4.4),
- (v) International-type search report (see III, 4.5),
- (vi) "Standard Search" report based on a patent or a patent application filed in any country in the world,
- (vii) Search report drawn up on behalf of national offices and search report further to special work (see I, 3).

2.2 This Chapter sets out the requirements for search reports of type (i) to (vi) only, although it is the intention that all search reports drawn up by the Office will be as similar as possible.

### 3. Form and language of the search report

3.1 The standard search report form for use by the examiner contains a main page to be used for all searches for recording the important features of the search such as the classification of the application, the fields searched, and for citing the relevant documents revealed by the search, and supplemental sheets A and B. Supplemental sheet A is to be used for indicating approval or modifications of the title and for the abstract as submitted by the applicant, the figure to be published with the abstract and for the translation of the title into the two other official languages (see X, 7). Supplemental sheet B is optionally to be used for restrictions of the search when the search fee is refunded, when claims incurring fees are not searched, when unity of invention is lacking, when a meaningful search is not possible or when the search is incomplete.

Art. 14  
Rule 44(5)

3.2 The search report should be drawn up in the language of the proceedings or, in the case of an international application, in the language in which it is to be published (PCT, Rule 43.4).

3.3 Dates appearing in the report should be expressed according to the WIPO standard ST.2, e.g. 30 March 1972.

### 4. Identification of the patent application and type of search report

4.1 On the main page and supplemental sheets the European patent application is identified by its filing number.

4.2 The type of the search report must be indicated in the report. Where the search report is a EPO supplementary search report in respect of an international application, the international application should be identified by its number. Where the search report is the account of an additional European search, normally only the blocks for fields searched and relevant documents are filled in and the supplemental sheets are not applicable. Form PCT/ISA/206 (annex) is used for communications giving the result of a partial international search drawn up on those parts of the international application relating to the invention referred to first in the claims.

Art. 157(2)(a)

4.3 In case of joint publication of the application and the search report, the main page of the report is marked A1 (WIPO Standard ST.16). If publication of the application is due before the search, the main page is marked A2 (WIPO Standard ST.16). The subsequent search report is established on a new main page which is marked A3 (WIPO Standard ST.16). Where the search report is a supplementary search report in respect of an international application,

this search report is established on a new main page marked A4 (WIPO Standard ST.16).

### **5. Classification of the patent application**

Rule 44(6)

The main page of the report should give the definitive classification symbol(s) for the European or international patent application in accordance with V, 4 (PCT, Rule 43.3). If publication of the application is due before the search, the classification for publication alone is indicated on the main page (the search report being later established). When subsequently the search report is established (on a new main page marked A3), the examiner should place a cross in the box provided on the main page in order to indicate that the definitive classification differs from the classification for publication. In the case of difference the definitive classification is indicated on the main page of the report.

### **6. Areas of technology searched**

6.1 Although the European Patent Convention does not require the European search report to identify the areas of technology searched, this information should be included in the report in the form of a list of Int.Cl. symbols up to the sub-class or, where necessary, up to the main group level (PCT, Rule 43.6).

6.2 Where the search report is entirely or partly based on a previous search made for an application relating to a cognate subject, the search files consulted for this previous search must also be identified in the report as having been consulted for the application in question.

### **7. Title, abstract and figure(s) to be published with the abstract**

Rule 33(1)  
Rule 47  
Art. 14(8)(a)  
Art. 128(5)(d)  
Art. 129(a)

On supplemental sheet A the examiner indicates approval or amendment of the text of the abstract and of the title of the invention, and the selection of the figure which is to accompany the abstract (PCT, Rules 8 and 44.2) (see Chapter XI), as well as the translation of the title into the two other official languages. If the application and the search report are jointly published, also supplemental sheet A is marked A1. If publication of the application is due before the search, the abstract is briefly examined and its final contents are determined (see IV, 1.4). The title is determined and translated, the figure to be published determined and supplemental sheet A is also marked A2. When subsequently the search report is drawn up, the supplemental sheet A is marked A3. At this stage, it is not necessary to examine the abstract again (see XI, 2).

In the case of a supplementary search report in respect of an international application, the supplemental sheet A



should be marked A4. Title, abstract nor figure with the abstract will be determined.

### **8. Restriction of the subject of the search**

8.1 The report, the declaration and the partial search report must indicate whether the subject of the search was restricted and which claims have or have not been searched.

8.2 If any restrictions were applied, these should be detailed on supplemental sheet B, according to the categories of restrictions provided for on that sheet.

Rule 31(1) (i) claims above the number of ten for which no additional fee has been paid (see III, 3.5). The claims not searched are identified.

Rule 46(1) (ii) lack of unity of invention (see Chapter VII). The different inventions must be mentioned by indicating the claims and if necessary, their subject matter. For the partial search report an indication is made that it has been established for the invention first mentioned in the claims. This applies to a priori lack of unity and to a posteriori lack of unity. For the search report which will be drawn up for all those inventions in respect of which search fees have been paid, the claims which have or which have not been searched are indicated by deleting (YES or NO) as applicable.

Rule 45  
Art. 52(2)(4)  
Art. 53 (iii) claims in respect of which a meaningful search cannot or only an incomplete search can be carried out (see Chapter VIII). In the first case an indication is made for the declaration that a meaningful search has not been possible on the basis of all claims. In the second case claims searched completely, searched incompletely and not searched at all are mentioned for indication in the partial search report. In both cases, the reasons for not carrying out or only partially carrying out the search should be indicated (for example; subject-matter not patentable, insufficiently clear claims)

### **9. Documents noted in the search**

#### **9.1 Identification of documents in the European search report**

Note: For international search reports Section 503 of the Administrative Instructions under the PCT applies, referring to WIPO Standard ST. 14 (see PCT Gazette S-03/1998).

9.1.1 All documents cited in the search report shall be identified unambiguously by indicating the necessary bibliographic elements.

All citations in the search report should comply with WIPO Standard ST. 14 (Recommendation for the inclusion of references cited in patent documents), WIPO Standard ST. 3 (Two letter codes) and ST. 16 (Standard code for identification of different kinds of patent documents). This does not exclude deviations in those special cases, where strict adherence, whilst not necessary for the clear and easy identification of a document, would require considerable extra costs and efforts.

9.1.2 The following should **not** be included in the search report:

- the classification of the documents cited,
- the number of pages in each document cited,
- all equally relevant documents. In particular, if the document belongs to a patent family the examiner need not cite all the members of the family which are known or accessible to him, these are mentioned in the annex to the search report. However, he may mention one or more members in addition to the one cited (see IV, 3.2). Such documents should be set out, on a single line as far as possible, and should be identified by the Office of origin, type and number of document, and preceded by the sign ampersand (&). This same sign may be used to identify corresponding documents in the situations set out in VI, 6.2.

First example:

GB-A-749 024 (COMPAGNIE POUR LA FABRICATION  
DES COMPTEURS ET MATERIEL D'USINES A GAZ)  
\* page 2, line 67-119; fig. 5\*  
& FR-A-1 063 743  
& DE-C-947 254

Second example:

NL-A- 6 918 375 (MEAD) 11 June 1970  
\* page 5, line 20-34; fig. 2 \*  
& FR-A-2 025 686 11 September 1970

9.1.3 If the search reveals no documents to be cited, the words "no citations" should be entered on the form (see IV, 2.7).

## 9.2 Categories of documents

All documents cited in the search report are identified by placing a particular letter in the first column of the citation sheets. Where needed, combinations of different categories are possible.

(i) **Particularly relevant documents**

Where a document cited in the European search report is particularly relevant, it should be indicated by the letters "X" or "Y". Category "X" is applicable where a document is such that **when taken alone**, a claimed invention cannot be considered novel or cannot be considered to involve an inventive step.

Category "Y" is applicable where a document is such that a claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other documents of the same category, such combination being obvious to a person skilled in the art.

(ii) **Documents defining the general state of the art**

Where any document cited in the European search report is not considered to belong to either of the two categories "X" and "Y" but defines the general state of the art, it should be indicated by the letter "A".

(iii) **Documents which refer to a nonwritten disclosure**

Where a document cited in the search report refers to a non-written disclosure, the letter "O" should be entered (see VI, 2).

(iv) **Intermediate documents**

Documents published on dates falling between the date of filing of the application being examined and the date of priority claimed, or the earliest priority if there is more than one (see VI, 5.2), should be denoted by the letter "P". The letter "P" should also be given to a document published on the very day of the earliest date of priority of the patent application under consideration.

(v) **Documents relating to the theory or principle underlying the invention**

Where any document cited in the search report is a document whose publication date occurred after the filing date or the priority date of the application and is not in conflict with the said application, but is cited for the principle or theory underlying the invention, which may be useful for a better understanding of the invention, or is cited to show that the reasoning or the facts underlying the invention are incorrect, it should be indicated by the letter "T".

(vi) **Potentially conflicting patent documents**

Any patent document bearing a filing or priority date earlier

than the filing date of the application searched but published later than that date and the content of which would constitute relevant prior art should be indicated by the letter "E". Where the patent document and the application searched have the same date (see C-IV, 6.4), the patent document should also be identified by the letter "E". An exception is made for patent documents based on the priority under consideration.

(vii) **Documents cited in the application**

When the search report cites documents already mentioned in the description of the patent application for which the search is carried out, these should be denoted by the letter "D" (see IV, 1.3).

(viii) **Documents cited for other reasons**

Where in the search report any document is cited for reasons other than those referred to in the foregoing paragraphs, for example:

- (a) a document which may throw doubt on a priority claim (see VI, 5.3)
- (b) a document cited to establish the publication date of another citation (see VI, 7.2),

such document should be indicated by the letter "L". Brief reasons for citing the document should be given.

**9.3 Relationship between documents and claims**

Rule 44(2)

Each citation should be referred to the claims to which it relates. If necessary, various relevant parts of the document cited should each be related to the claims in like manner. The relationship between the claims and the documents (or parts of documents) cited should be indicated in the following manner:

- (i) where a document cited in a search report relates to the claims as a whole, this fact should be indicated by entering in the appropriate column provided in the search report next to the citation of the document:
  - (a) if there are only two claims, the numbers of the claims separated by a comma ("1, 2");
  - (b) if there are more than two claims, the lowest and the highest of the numbers assigned to the claims separated by a dash ("1-12");
- (ii) where a document cited in a search report relates to one or more claims but not to all the claims, the numbers of the claims in question should be indicated in the appro-

appropriate column provided in the search report next to the citation of the document.

This presentation should also be used for documents cited in connection with the technological background.

#### **10. Authentication and dates**

10.1 The date on which the search report was drawn up should be indicated on the report. This date should be that of the drafting of the report by the examiner who carried out the search (PCT Rule 43.2).

10.2 The name of the examiner must appear on the search report.

#### **11. Copies to be attached to the search report**

Art. 92(2)

11.1 One copy of the search report is sent to the applicant and another should be retained in the application file for subsequent transmission to the Examining Division. Both these copies of the report must be accompanied by copies of all documents cited (see also III, 4.4(ix); IV, 3.5).

11.2 In the case of a patent document, a complete copy should be supplied even if the patent is bulky, except such parts as are clearly irrelevant. In that case the examiner indicates the pages of which copies are to be added to the report; these should always include the title page containing the bibliographic data.

11.3 In the case of patent families, only a copy of the member of the family actually cited need be supplied. The other members are mentioned in an annex systematically produced by the computer for information only (see X, 9.1.2).

11.4 In the case of a review or a book, copies should be made of the title page and the relevant pages of the publication concerned.

11.5 Where a document cited is a summary, extract or abstract of another document, published separately, a copy of the summary, extract or abstract should be attached to the report. Photocopies of DERWENT abstracts must in addition bear the following text:

(c)1987 DERWENT Publications Ltd.

128, Theobald's Road London,

London WC1X BRP, England.

Unauthorised copying of this abstract not permitted.

If, however, the search examiner considers that the Examining Division will require the entire document, that document must be cited and a copy attached to the report (see X, 9.1.2). Copies of up to 5 documents cited in the description of the application are added to the file sent to the Directorate General for Examination/ Opposition. In the case of a reference obtained by an on-line search for which neither the printed version from the data bank (e.g. Pascal, Compendex) nor the original article is available at the EPO, the print-out is added to the file in lieu of the original.

11.6 The Examiner submits the search report together with the copies of the documents cited in his report to the search administration department for further processing.

## **12. Transmittal and publication of the search report**

12.1 After completion of the standard search report form by the examiner, this form is submitted for processing to the search administration, which then produces a typed definitive version thereof:

- (i) a search report form suitable for publication on which nearly all information from the main page and an extract from that on supplemental sheet B (if any) are combined; ══
- (ii) a communication intended for accompanying a copy of the one-page search report when transmitted to the applicant, in which communication will be included information from supplemental sheets A and B. ══

Item (ii) is not to be prepared in the case of an additional European search account.

12.2 The search administration transmits copies of these documents to the Receiving Section, except in the case of an additional European search account in which case it transmits a copy of the one-page search report directly to the Examining Division concerned.

12.3 The Receiving Section transmits the European Search report to the applicant immediately after it has been drawn up together with copies of any cited documents (see XI, 7).

Art. 92(2)

12.4 In the case of a European search report or a supplementary European search report, the Receiving Section inserts copies of the one-page search report and the communication to the applicant in the application dossier for later transmittal therewith to the Examining Division, and it also transmits a copy of the one-page search report together with the communication to the applicant.

12.5 In the case of a European search report, the Receiving Section also prepares the one-page search report for publication, either together with the application and abstract, or, where the application is published earlier, together with a new front page containing the abstract.

### **13. Effect of search report**

- Rule 86(2) 13.1 After receipt of the search report the applicant may amend the description, the drawings and (in particular) the claims (in line with PCT Art. 19(1)).
- Art. 96(1) Also if the request for examination was made before the issue of the search report, the applicant is invited to confirm the request.
- Art. 115  
Art. 95 13.2 After publication of the application (normally together with the search report) third parties may file observations which will be taken into consideration by the Examining Division at the examination stage (see C-VI, 12 and E-VI, 3).
- Art. 96(2)  
Rule 44(1) 13.3 After publication of the search report and filing (or confirmation) of a request for examination, the Examining Division will examine the application, basing its assessment of novelty and inventive step upon the prior art mentioned in the search report. This is dealt with in C-IV (PCT Art. 33(6), Rule 62.1(b)).

**CHAPTER XI**

## THE ABSTRACT

1. The application must contain an abstract. The purpose of the abstract is to give brief technical information about the disclosure as contained in the description, claims and any drawings.
- Rule 47(1)  
Rule 49
2. The abstract is initially supplied by the applicant. The search examiner has the task of determining its definitive content, which will normally be published with the application. In doing this he should consider the abstract in relation to the application as filed (see IV, 1.4) (PCT Rule 38.2(b); Rule 48.2(b) (iii)). If the search report is published later than the application, the abstract published with the application will be the one resulting from the examination referred to in IV, 1.4 third sentence.
- Art. 85  
Rule 33(5)
3. In determining the definitive content the search examiner should take into consideration that the abstract is merely for use as technical information, and in particular must not be used for the purpose of interpreting the scope of the protection sought. The abstract should be so drafted that it constitutes an efficient instrument for purposes of searching in the particular technical field, and should in particular make it possible to assess whether there is need for consulting the European patent application itself (PCT Rule 8.3).
4. The abstract must
- Rule 33(1)
- (i) indicate the title of the invention,
- Rule 33(2)
- (ii) indicate the technical field to which the invention pertains,
- (iii) contain a concise summary of the disclosure as contained in the description, claims and drawings, which must be so drafted as to allow a clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use of the invention, and where applicable, it should contain the chemical formula which, among those contained in the application, best characterises the invention,
- (iv) **not** contain statements on the alleged merits or value of the invention or its speculative application,
- Rule 33(3)
- (v) preferably not contain more than one hundred and fifty words,
- Rule 33(4)
- (vi) be accompanied by an indication of the figure or exceptionally more than one figure of the drawings which should accompany the abstract. Each main feature mentioned in the abstract and illustrated by a drawing,



should be followed by a reference sign in parenthesis (PCT Rule 8.1).

Rule 33(4)

5. The search examiner should consider not only the text of the abstract but also the selection of the figures for publication with it. He should alter the text to the extent that this may be necessary in order to meet the requirements set out in XI, 4. He will select a different figure, or figures, of the drawings if he considers that they better characterise the inventions (PCT Rule 8.2).

In determining the definitive content of the abstract, the examiner should concentrate on conciseness and clarity, and refrain from introducing alterations merely for the purpose of embellishing the language (see X, 7).

6. In considering the abstract the examiner should check it against the General Guidelines for the Preparation of Abstracts of Patent Documents, using the checklist contained WIPO Standard ST.12, the relevant parts of which are annexed to this Chapter.

Rule 47(2)

7. "The definitive content of the abstract shall be transmitted to the applicant together with the European search report" (see X,12.3).

CHECKLIST TO ACCOMPANY  
"GENERAL GUIDELINES FOR THE PREPARATION OF ABSTRACTS"

In the following checklist, the abstractor should, after having studied the disclosure to be abstracted, place a check in the second column after the applicable terms listed in the first column. The requirements listed in the third column corresponding to the checked items of the first column should be borne in mind by the abstractor as he prepares his abstract. Finally, the abstractor may compare his finished abstract with the checked requirements and place a corresponding checkmark in the fourth column if he is satisfied that the requirements have been met.

If the invention is a(n)	Check here	The abstract should deal with:	If so, check here
Article		its identity, use; construction, organization, method of manufacture	
Chemical compound		its identity (structure if appropriate)	
Mixture		its nature, properties, use; essential ingredients (identify, function); proportion of ingredients, if significant; preparation	
Machine, apparatus, system		its nature, use; construction, organization; operation	
Process or operation		its nature and characterizing features; material and conditions employed; product, if significant; nature of and relationship between the steps, if more than one	
If the disclosure involves alternatives		the abstract should deal with the preferred alternative and identify the others if this can be done succinctly; if this cannot be done, it should mention that they exist and whether they differ substantially from the preferred alternative	

Total number of words less than 250: ..... in range 50-150: .....

\*) Original: Handbook on Industrial Property Information and Documentation, Publication N° 208(E), 1998, WIPO, Geneva (CH).

**PART C**  
**GUIDELINES FOR SUBSTANTIVE EXAMINATION**



**PART C**  
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**CHAPTER I**

## INTRODUCTION

Art. 18

1. In this Part the term "examiner" is used to mean the examiner entrusted with substantive examination forming part of the Examining Division, which is responsible for the final decision. If any other kind of employee is intended, the term is qualified (e.g. "search examiner" in Chapter VI).

2. The attitude of the examiner is very important. He should always try to be constructive and helpful. While it would of course be quite wrong for an examiner to overlook any major deficiency in an application, he should have a sense of proportion and not pursue unimportant objections. He should bear in mind that, subject to the requirements of the Convention, the drafting of the description and claims of a European application is the responsibility of the applicant or his authorised representative.

3. The attention of examiners is also particularly directed to the instruction in paragraph 2.3 of the General introduction to the Guidelines. This applies not only in relation to other departments of the Office. It means, for example, that the other members of an Examining Division should not attempt to repeat the work of the primary examiner (see VI, 7.5).

4. In the remainder of this Part, an attempt has been made to deal with the requirements of the application in earlier Chapters and to concentrate matters of procedure in Chapter VI. However, it has not always proved practicable to draw a hard and fast line between these two aspects of the work.

**CHAPTER II****CONTENT OF EUROPEAN APPLICATION (OTHER THAN CLAIMS)**

Art. 78

**1. General**

The requirements of the European patent application are set out in Art. 78. The application must contain:

- |               |       |                                                            |  |
|---------------|-------|------------------------------------------------------------|--|
| Art. 78(1)(a) | (i)   | a request for the grant of a European patent;              |  |
| Art. 78(1)(b) | (ii)  | a description of the invention;                            |  |
| Art. 78(1)(c) | (iii) | one or more claims;                                        |  |
| Art. 78(1)(d) | (iv)  | any drawings referred to in the description or the claims; |  |
| Art. 78(1)(e) | (v)   | an abstract.                                               |  |

This Chapter deals with all these requirements, in so far as they are the concern of the examiner, with the exception of item (iii) which is the subject of Chapter III. Item (v) is dealt with first.

**2. Abstract**

Art. 85

The general considerations relating to the abstract are set out in B-XI. The abstract relates to the application as filed and published and its final form is settled by the Search Division. It is therefore not necessary to bring it into conformity with the content of the published patent even if this should differ in substance from that of the application. The examiner should therefore not seek any amendment of the abstract. He should, however, note that the abstract has no legal effect on the application containing it; for instance, it cannot be used to interpret the scope of protection or to justify the addition to the description of new subject-matter.

**3. The request for grant (the title)**

3.1 The items making up this request are dealt with in A-III, 4. They do not normally concern the examiner with the exception of the title.

Rule 26(2)(b)

3.2 The title should "clearly and concisely state the technical designation of the invention" and should "exclude all fancy names". While any obvious failures to meet these requirements are likely to be noted during the formalities examination, the examiner should review the title in the light of his reading of the description and claims and any amendments thereto, to make sure that the title, as well as being concise, gives a clear and adequate indication of the



subject of the invention. Thus, if amendments are made which change the categories of claims, the examiner should check whether a corresponding amendment is needed in the title (see also II, 4.2).

#### 4. Description

Art. 83  
Rule 27

4.1 The application must "disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art". The "person skilled in the art" for this purpose is considered to be the ordinary practitioner aware not only of the teaching of the application itself and the references therein, but also of what was common general knowledge in the art at the date of filing the application. He is assumed to have had at his disposal the means and the capacity for routine work and experimentation, which are normal for the technical field in question. As "common general knowledge" can generally be considered the information contained in basic handbooks, monographs and textbooks on the subject in question (see T 171/84, OJ 4/1986, 95). As an exception, it can also be the information contained in patent specifications or scientific publications, if the invention lies in a field of research which is so new that the relevant technical knowledge is not yet available from textbooks (see T 51/87, OJ 3/1991, 177). Sufficiency of disclosure must be assessed on the basis of the application as a whole, including the description, claims and drawings, if any. The provisions relating to the content of the description are set out in Rule 27. The purpose of the provisions of Art. 83 and Rule 27 is:

- (i) to ensure that the application contains sufficient technical information to enable a skilled person to put the invention as claimed into practice; and
- (ii) to enable the reader to understand the contribution to the art which the invention as claimed has made.

Rule 27(1)(a)

4.2 The invention should be placed in its setting by specifying the technical field to which it relates.

Rule 27(1)(b)  
Art. 123(2)

4.3 The description should also mention any background art of which the applicant is aware, and which can be regarded as useful for understanding the invention and its relationship to the prior art; identification of documents reflecting such art, especially patent specifications, should preferably be included. This applies in particular to the background art corresponding to the first or "prior art" portion of the independent claim or claims (see III, 2.2). The insertion into the statement of prior art of references to documents identified subsequently, for example by the search report, should be required, where necessary, to put the invention into proper perspective (T 11/82,

OJ 12/1983, 479). For instance while the originally filed description of prior art may give the impression that the inventor has developed the invention from a certain point, the cited documents may show that certain stages in, or aspects of, this alleged development were already known. In such a case the examiner should require a reference to these documents and a brief summary of the relevant contents. The subsequent inclusion of such a summary in the description does not contravene Art. 123(2). The latter merely lays down that, if the application is amended, for example by limiting it in the light of additional information on the background art, its subject-matter must not extend beyond the content of the application as filed. But the subject-matter of the European patent application within the meaning of Art. 123(2) is to be understood - starting off from the prior art - as comprising those features which, in the framework of the disclosure required by Art. 83, relate to the invention (see also VI, 5.3). References to the prior art introduced after filing must be purely factual. Any alleged advantages of the invention must be adjusted if necessary in the light of the prior art. New statements of advantage are permissible provided that they do not introduce into the description matter which could not have been deduced from the application as originally filed (see VI, 5.4).

- Art. 54(3) If the relevant prior art consists of another European patent application falling within the terms of Art. 54(3), it first has to be checked whether designation fees have been paid for corresponding Contracting States (see IV, 6.1a). Only if that is the case, the fact that this document falls under Art. 54(3) should be explicitly acknowledged. Thus the public is informed that the document is not relevant to the question of inventive step (see IV, 9.2). The above also applies to international applications designating the EPO, for which the national fee pursuant to Rule 104b(1)(b) has been validly paid and the translation into one of the official languages has been filed (Art. 158(1) and (2)) (see IV, 6.2).
- Rule 34(1)(c) 4.4 Since the reader is presumed to have the general background technical knowledge appropriate to the art, the examiner should not require the applicant to insert anything in the nature of a treatise or research report or explanatory matter which is obtainable from textbooks or is otherwise well known. Likewise the examiner should not require a detailed description of the content of cited prior documents. It is sufficient that the reason for the inclusion of the reference is indicated, unless in a particular case a more detailed description is necessary for a full understanding of the invention of the application (see also II, 4.18). Lists of several reference documents relating to the same feature or aspect of the prior art are not required; only the most appropriate need be referred to. On the

other hand the examiner should not insist upon the excision of any such unnecessary matter, except when it is very extensive (see II, 7.3).

Rule 27(1)(c)  
Rule 34(1)(b)

4.5 The invention as claimed should be disclosed in such a way that the technical problem, or problems, with which it deals can be appreciated and the solution can be understood. To meet this requirement, only such details should be included as are necessary for elucidating the invention. In cases where the subject matter of a dependent claim can be understood either by the wording of the claim itself or by the description of a way of performing the invention, no additional explanation of this subject matter will be necessary. A mention in the description that a particular embodiment of the invention is set out in the dependent claim will then be sufficient. Where the invention lies in realising what the problem is (see IV, 9.4(i)), this should be apparent, and, where the means of solving the problem (once realised) are obvious, the details given of its solution may, in practice, be minimal. When there is doubt, however, as to whether certain details are necessary, the examiner should not insist on their excision. It is not necessary, moreover, that the invention be presented explicitly in problem and solution form. Any advantageous effects which the applicant considers the invention to have in relation to the prior art should be stated, but this should not be done in such a way as to disparage any particular prior product or process. Furthermore, neither the prior art nor the applicant's invention should be referred to in a manner likely to mislead. This might be done, e.g. by an ambiguous presentation which gives the impression that the prior art had solved less of the problem than was actually the case. Fair comment as referred to in II, 7.2 is, however, permitted. Regarding amendment to, or addition of, a statement of problem, see VI, 5.7c.

Rule 27(1)(c)

4.6 If it is decided that an independent claim defines a patentable invention, it must be possible to derive a technical problem from the application. In this case the requirement of Rule 27(1)(c) is fulfilled (see T 26/81, OJ 6/1982, 211).

Rule 27(1)(d)

4.7 If drawings are included they should first be briefly described, in a manner such as: "Figure 1 is a plan view of the transformer housing; Figure 2 is a side elevation of the housing; Figure 3 is an end elevation looking in the direction of the arrow 'X' of Figure 2; Figure 4 is a cross-section taken through AA of Figure 1." When it is necessary to refer in the description to elements of the drawings, the name of the element should be referred to as well as its number, i.e. the reference should not be in the form: "3 is connected to 5 via 4" but, "resistor 3 is connected to capacitor 5 via switch 4".

- Rule 32(2)(i) 4.8 The description and drawings should be consistent with one another, especially in the matter of reference numbers and other signs, and each number or sign must be explained. However, where as a result of amendments to the description whole passages are deleted, it may be tedious to delete all superfluous references from the drawings and in such a case the examiner should not pursue an objection under Rule 32(2)(i), as to consistency, too rigorously. The reverse situation should never occur, i.e. all reference numbers or signs used in the description or claims must also appear on the drawings.
- Rule 27(1)(e)  
Art. 83 4.9 A detailed description of at least one way of carrying out the invention must be given. Since the application is addressed to the person skilled in the art it is neither necessary nor desirable that details of well-known ancillary features should be given, but the description must disclose any feature essential for carrying out the invention in sufficient detail to render it obvious to the skilled person how to put the invention into practice. A single example may suffice, but where the claims cover a broad field, the application should not usually be regarded as satisfying the requirements of Art. 83 unless the description gives a number of examples or describes alternative embodiments or variations extending over the area protected by the claims. However, regard must be had to the facts of the particular case. There are some instances where even a very broad field is sufficiently exemplified by a limited number of examples or even one example (see also III, 6.3). In these latter cases the application must contain, in addition to the examples, sufficient information to allow the person skilled in the art, using his common general knowledge, to perform the invention over the whole area claimed without undue burden and without needing inventive skill. If the Examining Division is able to make out a reasoned case that the application lacks sufficient disclosure, the onus of establishing that the invention may be performed and repeated over substantially the whole of the claimed range lies with the applicant (see VI, 2.4).
- Art. 83  
Rule 27(1)(c)(e) 4.9a In order that the requirements of Art. 83 and of Rule 27(1)(c) and (e) may be fully satisfied it is necessary that the invention is described not only in terms of its structure but also in terms of its function, unless the functions of the various parts are immediately apparent. Indeed in some technical fields (e.g. computers), a clear description of function may be much more appropriate than an over-detailed description of structure.
- Art. 83  
Art. 123(2) 4.10 It is the responsibility of the applicant to ensure that he supplies, when he first files his application, a sufficient disclosure, i.e. one that meets the requirements of Art. 83 in respect of the invention as claimed in all of the claims. If the claims define the invention, or a feature thereof, in

terms of parameters (see III, 4.7a), the application as first filed must include a clear description of the methods used to determine the parameter values, unless a person skilled in the art would know what method to use or unless all methods would yield the same result (see III, 4.10). If the disclosure is seriously insufficient, such a deficiency cannot be cured subsequently by adding further examples or features without offending against Art. 123(2), which requires that the subject-matter content of the application must not be extended (see VI, 5.3 to 5.8b). Therefore in such circumstances the application must normally be refused. If however the deficiency arises only in respect of some embodiments of the invention and not others, it could be remedied by restricting the claims to correspond to the sufficiently described embodiments only, the description of the remaining embodiments being deleted.

4.11 Occasionally applications are filed in which there is a fundamental insufficiency in the invention in the sense that it cannot be carried out by a person skilled in the art; there is then a failure to satisfy the requirements of Art. 83 which is essentially irreparable. Two instances thereof deserve special mention. The first is where the successful performance of the invention is dependent on chance. That is to say, the skilled person, in following the instructions for carrying out the invention, finds either that the alleged results of the invention are unrepeatable or that success in obtaining these results is achieved in a totally unreliable way. An example where this may arise is a microbiological process involving mutations. Such a case should be distinguished from one where repeated success is assured even though accompanied by a proportion of failures - as can arise, e.g. in the manufacture of small magnetic cores or electronic components; in this latter case, provided the satisfactory parts can be readily sorted by a non-destructive testing procedure, no objection arises under Art. 83. The second instance is where successful performance of the invention is inherently impossible because it would be contrary to well-established physical laws - this applies e.g. to a perpetual motion machine. If the claims for such a machine are directed to its function, and not merely to its structure, an objection arises not only under Art. 83 but also under Art. 52(1) that the invention is not "susceptible of industrial application" (see IV, 4.1).

Rule 27(1)(f)  
Art. 52(1)  
Art. 57

4.12 The description should indicate explicitly the way in which the invention is "capable of exploitation in industry", if this is not obvious from the description or from the nature of the invention. The expression "capable of exploitation in industry" means the same as "susceptible of industrial application", and indeed identical expressions are used in the French and German texts of the Convention. In view of the broad meaning given to the latter expression by Art. 57 (see IV, 4.1), it is to be expected that, in most cases, the way in which the invention can be exploited in industry will

be self-evident, so that no more explicit description on this point will be required; but there may be a few instances, e.g. in relation to methods of testing, where the manner of industrial exploitation is not apparent and must be made so.

Rule 23e(3) Also, in relation to certain biotechnological inventions, i.e. sequences and partial sequences of genes, the industrial application is not self-evident. The industrial application of such sequences must be disclosed in the patent application (see IV, 4.6).

Rule 27(2) 4.13 The manner and order of presentation of the description should be that specified in Rule 27(1), i.e. as set out above, "unless, because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation". Since the responsibility for clearly and completely describing the invention lies with the applicant, the examiner should not object to the presentation unless satisfied that such an objection would be a proper exercise of his discretion. Some departure from the requirements of Rule 27(1) is acceptable, provided the description is clear and orderly and all the requisite information is present. For example, the requirements of Rule 27(1)(c), may be waived where the invention is based on a fortuitous discovery, the practical application of which is recognised as being useful, or where the invention breaks entirely new ground. Also, certain technically simple inventions may be fully comprehensible with the minimum of description and but slight reference to prior art.

Rule 35(13) 4.14 Although the description should be clear and straightforward with avoidance of unnecessary technical jargon, the use of recognised terms of art is acceptable, and will often be desirable. Little known or especially formulated technical terms may be allowed provided that they are adequately defined and that there is no generally recognised equivalent. This discretion may be extended to foreign terms when there is no equivalent in the language of the proceedings. Terms already having an established meaning should not be allowed to be used to mean something different if this is likely to cause confusion. There may, however, be circumstances where a term may legitimately be borrowed from an analogous art. Terminology and signs must be consistent throughout the application.

4.14a In the particular case of inventions in the computer field, program listings in programming languages cannot be relied on as the sole disclosure of the invention. The description, as in other technical fields, should be written substantially in normal language, possibly accompanied by flow diagrams or other aids to understanding, so that the invention may be understood by those skilled in the art

who are deemed not to be programming specialists. Short excerpts from programs written in commonly used programming languages can be accepted if they serve to illustrate an embodiment of the invention.

4.15 When the properties of a material are referred to, the relevant units should be specified if quantitative considerations are involved. If this is done by reference to a published Standard (e.g. a Standard of sieve sizes), and such Standard is referred to by a set of initials or similar abbreviation, it should be adequately identified in the description.

Rule 35(12)

Physical values must be expressed in the units recognised in international practice, which is generally in the metric system, using SI units and the other units referred to in

8b



Chapter I of the Annex to EEC Directive 80/181/EEC of 20.12.79, the latter having been amended with EEC Directives 85/1/EEC of 18.12.84 and 89/617/EEC of 27.11.89, see the Annex to this Chapter. Any values not meeting this requirement must also be expressed in the units recognised in international practice. Values in the inch/pound system, in general, do not meet the criterion "recognised in international practice".

As Rule 35(12) indicates, for mathematical formulae the symbols in general use must be employed. For chemical formulae, the symbols, atomic weights and molecular formulae in general use must be employed.

In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

4.16 The use of proper names, trademarks or trade names or similar words to refer to materials or articles is undesirable in so far as such words merely denote origin or where they may relate to a range of different products. If such a word is used, then where it is necessary in order to satisfy the requirements of Art. 83, the product must be sufficiently identified, without reliance upon the word, to enable the invention to be carried out by the skilled person at the date of filing. However, where such words have become internationally accepted as standard descriptive terms and have acquired a precise meaning (e.g. "Bowden" cable, "Belleville" washer, "Panhard" rod, "Teflon" layer, "Caterpillar" belt) they may be allowed without further identification of the product to which they relate.

4.17 If the examiner has reason to suspect that a word used in the description is a registered trade mark, at least in certain States, he should ask the applicant either to acknowledge the word as such or to state that, so far as he is aware, the word is not a registered trade mark. If, on the other hand, an applicant states that a word is a registered trade mark in a certain State or States and the examiner happens to know that this statement is incorrect, he should ask the applicant to amend accordingly.

4.18 References in European patent applications to other documents may relate either to the background art or to part of the disclosure of the invention.

Where the reference relates to the background art, it may be in the application as originally filed or introduced at a later date (see II, 4.3 and 4.4).

Art.65

Where the reference relates directly to the disclosure of the invention (e.g. details of one of the components of a claimed apparatus) then the examiner should first consider whether knowing what is in the document is in fact essen-

tial for carrying out the invention as meant by Art. 83. If not, the usually used expression "which is hereby incorporated by reference", or any expression of the same kind should be deleted from the description. If matter in the document referred to is essential to satisfy the requirements of Art. 83, the examiner should require it to be expressly incorporated into the description, because the patent specification should, regarding the essential features of the invention, be self-contained, i.e. capable of being understood without reference to any other document. Otherwise problems arise concerning the translations required under Art. 65. Such incorporation is, however, subject to the following restrictions (see T 689/90, OJ 10/93, 616):

(i) it must not contravene Art. 123(2) in the sense that the description of the invention as filed leaves a skilled reader in no doubt:

(a) that the subject-matter for which protection is or may be sought comprises features disclosed in the reference document and not in the application,

(b) that these features contribute to achieving the technical aim of the invention and are thus comprised in the solution of the technical problem underlying the invention which is the subject of the application,

(c) that these features implicitly clearly belong to the description of the invention contained in the application and thus to the content of the application as filed and

(d) that such features are precisely defined and identifiable within the total technical information within the reference document.

(ii) documents not available to the public on the date of filing of the application can only be considered when (see T 737/90, not published in OJ):

(a) a copy of the document was furnished to the Office on or before the date of filing of the application; and

(b) the document was made available to the public no later than on the date of publication of the application under Art. 93 (e.g. by being present in the application dossier and therefore made public under Art. 128(4)).

It may be that the Search Division has requested the applicant to furnish the document referred to, in order to be able to carry out a meaningful search (see B-IV, 1.3).

If, for the disclosure of the invention, a document is referred to in an application as originally filed, the relevant content of the document is to be considered as forming part of the content of the application for the purpose of citing the application under Art. 54(3) against later applications. For documents not available to the public before the filing date of the application this applies only if conditions (ii)(a) and (ii)(b) above are fulfilled.

Because of this effect under Art. 54(3) it is very important that, where a reference is directed only to a particular part of the document referred to, that part should be clearly identified in the reference.

## 5. Drawings

### 5.1 Form and content

Rule 32  
Rule 32(2)(j)

The requirements relating to the form and content of drawings are set down in Rule 32. Most of these are formal (see A-X) but the examiner may sometimes need to consider the requirements of Rule 32(2)(f), (h), (i) and (j). Of these, the only question likely to cause difficulty is whether the textual matter included on the drawings is absolutely indispensable. In the case of circuit diagrams, block schematics and flow sheets, identifying catchwords for functional integers of complex systems (e.g. "magnetic core store", "speed integrator") may be regarded as indispensable from a practical point of view if they are necessary to enable a diagram to be interpreted rapidly and clearly.

### 5.2 Printing quality

The examiner has also to check whether the drawings in the printing copy ("Druckexemplar") are suitable for printing. If necessary, a copy of the original drawings must be prepared as the printing copy. If, however, the quality of the original drawings is also insufficient, then the examiner must request the applicant to present drawings of sufficient quality for printing. He should, however, beware of any extension of subject-matter (Art. 123(2)).

### 5.3 Photographs

The EPC makes no express provision for photographs; they are nevertheless allowed where it is impossible to present in a drawing what is to be shown and provided that they are in black and white, directly reproducible and fulfil the applicable requirements for drawings (e.g. paper size, margins, etc.). Colour photographs are not accepted. In case of photographs of insufficient original quality for printing the examiner should not request filing of better photographs, as the risk of infringing Art. 123(2) is obvious. In that case the insufficient quality is accepted for

reproduction.

### 6. Inventions relating to biological material

Rule 23b(3)  
Rule 28(1)

6.1 Applications relating to biological material are subject to the special provisions set out in Rule 28. In accordance with Rule 23b(3) the term "biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system. If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art the disclosure is not considered to have satisfied the requirements of Art. 83 unless the requirements of Rule 28(1), (2), first and second sentences, and (3), first sentence, have been met.

6.2 The examiner must form an opinion as to whether or not the biological material is available to the public. There are several possibilities. The biological material may be known to be readily available to those skilled in the art, e.g. baker's yeast or *Bacillus natto* which is commercially available; or it may be a standard preserved strain, or other biological material which the examiner knows to have been preserved in a recognised depository and to be available to the public. Alternatively the applicant may have given in the description sufficient information as to the identifying characteristics of the biological material and as to the prior availability in a depository institution recognised for the purposes of Rule 28(9) to satisfy the examiner. In any of these cases no further action is called for. If however the applicant has given no information, or insufficient information, on public availability, and the biological material is a particular strain not falling within the known categories such as those already mentioned, then the examiner must assume that the biological material is not available to the public. He must also examine whether the biological material could be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art (see, in particular, 4.11 and IV, 3.5).

6.3 If the biological material is not available to the public and if it cannot be described in the application in such a manner as to enable the invention to be carried out by a person skilled in the art, the examiner must check:

Rule 28(1)(2)

(i) whether the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material. The relevant information under this provision concerns the classification of the biological material and significant differences from known biological material. For this purpose, the applicant must, to the extent available to him, indicate morphological and bio-

chemical characteristics and the proposed taxonomic description.

The information on the biological material in question which is generally known to the skilled person on the date of filing is as a rule presumed to be available to the applicant and must therefore be provided by him. If necessary it has to be provided through experiments in accordance with the relevant standard literature.

For characterising bacteria, for example, the relevant standard work would be R.E. Buchanan, N.E. Gibbons: *Bergey's Manual of Determinative Bacteriology*.

Against this background, information should then be given on every further specific morphological or physiological characteristic relevant for recognition and propagation of the biological material, e.g. suitable media (composition of ingredients), in particular where the latter are modified.

Abbreviations for biological material or media are often less well known than the applicant assumes and should therefore be avoided or written in full at least once.

If biological material is deposited that cannot replicate itself but must be replicated in a biological system (eg viruses, bacteriophages, plasmids, vectors or free DNA or RNA), the above-mentioned information is also required for such biological system. If, for example, other biological material is required, such as host cells or helper viruses, that cannot be sufficiently described or is not available to the public, this material must also be deposited and characterised accordingly. In addition, the process for producing the biological material within this biological system must be indicated.

In many cases the above required information will already have been given to the depositary institution (see Rule 6.1(a)(iii) and 6.1(b) Budapest Treaty) and need only be incorporated into the application.

(ii) whether the name of the depositary institution and the accession number of the deposit have been supplied at the date of filing. If the name of the depositary institution and the accession number of the deposit have been submitted later it should be checked whether they have been filed within the relevant period under Rule 28(2). If that is the case it should then further be checked whether on the filing date any reference has been supplied which allows to relate the deposit with the later filed accession number. Normally the identification reference which the depositor himself gave to his deposit is used in the application documents. The relevant document for later filing the data pursuant to Rule 28(1)(c) could be a letter containing the name of the depositary institution, the acces-

sion number and the above mentioned identification reference or alternatively the deposit receipt, which contains all these data. (see also Decision G 2/93, OJ 5/1995, 275 and A-IV, 4.2).

(iii) whether the deposit was made by a person other than the applicant and, if so, whether the name and the address of the depositor are stated in the application or have been supplied within the relevant period under Rule 28(2). In such a case the examiner must also check whether the document fulfilling the requirements mentioned in Rule 28(1)(d) was submitted to the EPO within the same time limit.

The examiner, in addition to the checks referred to under (i) to (iii) above, asks for the deposit receipt issued by the depositary institution (see Rule 7.1 Budapest Treaty) or for equivalent proof of the deposit of a biological material if such proof has not been filed before (see (ii) above and A-IV, 4.2). This is to provide evidence for the indications made by the applicant pursuant to Rule 28(1)(c).

If this deposit receipt has already been filed within the relevant time period according to Rule 28(2), this document on its own is regarded as submission of the information according to Rule 28(1)(c).

Rule 28(9)

In addition, the depositary institution named must be one of the recognised institutions listed in the Official Journal of the European Patent Office. An up-to-date list is regularly published in the Official Journal.

If any of these requirements is not satisfied the biological material in question cannot be considered as having been disclosed pursuant to Art. 83 by way of reference to the deposit.

### **7. Prohibited matter**

Rule 34

Rule 34(1)(a)

7.1 There are three categories of specifically prohibited matter, these being defined in sub-paragraphs (a) to (c) of Rule 34(1) (see also IV, 3). It should be noted that the omission, from the publication of the application, of the first category only is mandatory. Examples of the kind of matter coming within this category are: incitement to riot or to acts of disorder; incitement to criminal acts; racial, religious or similar discriminatory propaganda; and grossly obscene matter.

Rule 34(1)(b)

7.2 It is necessary to discriminate in the second category between libellous or similarly disparaging statements, which are not allowed, and fair comment, e.g. in relation to obvious or generally recognised disadvantages, or disadvantages stated to have been found and substantiated by the applicant, which, if relevant, is permitted.

## Rule 34(1)(c)

7.3 The third category is irrelevant matter. It should be noted however that such matter is specifically prohibited under the Rule only if it is "obviously irrelevant or unnecessary", for instance, if it has no bearing on the subject-matter of the invention or its background of relevant prior art (see also II, 4.4). The matter to be removed may already be obviously irrelevant or unnecessary in the original description. It may, however, be matter which has become obviously irrelevant or unnecessary only in the course of the examination proceedings, e.g. owing to a limitation of the claims of the patent to one of originally several alternatives. When matter is removed from the description, it must not be incorporated into the patent specification by reference to the corresponding matter in the published application or in any other document (see also II, 4.18).

7.4 Generally the Receiving Section will deal with matter falling under category 1(a), and may have dealt with matter obviously falling within category 1(b), but if any such matter has not been so recognised and has therefore not been omitted from the publication of the application, it should be required to be removed during examination of the application together with any other prohibited matter. The applicant should be informed of the category under which matter is required to be removed.

**COUNCIL DIRECTIVE  
of 18 December 1984  
amending Directive 80/181/EEC on the approximation of the laws of the  
Member States relating to units of measurement <sup>12</sup>**

**(85/1/EEC)**

ANNEX

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Chapter I: Units of measurement referred to in Article 1(a) of the Directive

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3. Units defined independently of the seven SI base units.
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<sup>1</sup> Published in the Official Journal of the European Communities No L 2/11 of 3 January 1985

<sup>2</sup> The later Directive 89/617/EEC of 27 November 1989, Official Journal of the European Communities No L 357/28 of 7 December 1989, amending this Directive, has had no influence on the present Chapter I of the Annex.



## CHAPTER I

## UNITS OF MEASUREMENT REFERRED TO IN ARTICLE 1 (a)

## 1. SI UNITS AND THEIR DECIMAL MULTIPLES AND SUBMULTIPLES

## 1.1. SI base units

Quantity	Unit	
	Name	Symbol
Length	metre	m
Mass	kilogram	kg
Time	second	s
Electric current	ampere	A
Thermodynamic temperature	kelvin	K
Amount of substance	mole	mol
Luminous intensity	candela	cd

Definitions of SI base units:

*Unit of length*

The metre is the length of the path traveled in a vacuum by light during 1/299 792 458 seconds  
(Seventeenth CGPM (1983), resolution 1).

*Unit of mass*

The kilogram is the unit of mass; it is equal to the mass of the international prototype of the kilogramme.  
(Third CGPM (1901), page 70 of the conference report).

*Unit of time*

The second is the duration of 9 192 631 770 periods of the radiation corresponding to the transition between the two hyperfine levels of the ground state of the caesium 133 atom.  
(Thirteenth CGPM (1967), resolution 1).

*Unit of electric current*

The ampere is that constant current which if maintained in two straight parallel conductors of infinite length, of negligible circular cross-section and placed one metre apart in a vacuum, would produce between these conductors a force equal to  $2 \times 10^{-7}$  newton per metre of length.  
(CIPM (1946), resolution 2, approved by the ninth CGPM (1948)).

*Unit of thermodynamic temperature*

The kelvin, unit of thermodynamic temperature, is the fraction 1/273,16 of the thermodynamic temperature of the triple point of water.  
(Thirteenth CGPM (1967), resolution 4).

*Unit of amount of substance*

The mole is the amount of substance of a system which contains as many elementary entities as there are atoms in 0,012 kg of carbon 12.

When the mole is used the elementary entities must be specified and may be atoms, molecules, ions, electrons, other particles or specified groups of such particles.

(Fourteenth CGPM (1971), resolution 3).

*Unit of luminous intensity*

The candela is the luminous intensity, in a given direction, of a source which emits monochromatic rays with a frequency of  $540 \times 10^{12}$  hertz and whose energy intensity in that direction is 1/683 watt per steradian.

(Sixteenth CGPM (1979), resolution 3).

**1.1.1. Special name and symbol of the SI unit of temperature for expressing Celsius temperature**

Quantity	Unit	
	Name	Symbol
Celsius temperature	degree Celsius	° C

Celsius temperature  $t$  is defined as the difference  $t = T - T_0$  between the two thermodynamic temperatures  $T$  and  $T_0$ , where  $T_0 = 273,15$  kelvins. An interval of or difference in temperature may be expressed either in kelvins or in degrees Celsius. The unit of 'degree Celsius' is equal to the unit 'kelvin'.

**1.2. Other SI Units****1.2.1. Supplementary SI units**

Quantity	Unit	
	Name	Symbol
Plane angle	radian	rad
Solid angle	steradian	sr

(Eleventh CGPM, 1960, resolution 12).

Definitions of supplementary SI units:

*Plane angle unit*

The radian is the plane angle between two radii which, on the circumference of a circle, cut an arc equal in length to the radius.

(International standard ISO 31-I, December 1965).

*Solid angle unit*

The steradian is the solid angle which has its apex at the centre of a sphere and which describes on the surface of the sphere an area equal to that of a square having as its side the radius of the sphere.

(International standard ISO 31-I, December 1965).

**1.2.2. Derived SI units**

Units derived coherently from SI base units and supplementary SI units are given as algebraic expressions in the form of products of powers of the SI base units and/or supplementary SI units with a numerical factor equal to 1.

**1.2.3. Derived SI units having names and symbols**

Quantity	Unit		Expression	
	Name	Sym- bol	In other SI units	In terms of base or supplementary SI units
Frequency	hertz	Hz		$s^{-1}$
Force	newton	N		$m.kg.s^{-2}$
Pressure, stress	pascal	Pa	$N.m^{-2}$	$m^{-1}.kg.s^{-2}$
Energy, Work; quantity of heat	joule	J	$N.m$	$m^2.kg.s^{-2}$
Power <sup>(1)</sup> , radiant flux	watt	W	$J.s^{-1}$	$m^2.kg.s^{-3}$
Quantity of electricity, electric charge	coulomb	C		$s.A$
Electric potential, potential difference, electromotive force	volt	V	$W.A^{-1}$	$m^2.kg.s^{-3}.A^{-1}$
Electric resistance	ohm	$\Omega$	$V.A^{-1}$	$m^2.kg.s^{-3}.A^{-2}$
Conductance	siemens	S	$A.V^{-1}$	$m^2.kg^{-1}.s^3.A^2$
Capacitance	farad	F	$C.V^{-1}$	$m^2.kg^{-1}.s^4.A^2$
Magnetic flux	weber	Wb	$V.s$	$m^2.kg.s^{-2}.A^{-1}$
Magnetic flux density	tesla	T	$Wb.m^{-2}$	$kg.s^{-2}.A^{-1}$
Inductance	henry	H	$Wb.A^{-1}$	$m^2.kg.s^{-2}.A^{-2}$
Luminous flux	lumen	lm		$cd.sr$
Illuminance	lux	lx	$lm.m^{-2}$	$m^{-2}.cd.sr$
Activity (of a radionuclide)	becquerel	Bq		$s^{-1}$
Absorbed dose, specific energy imparted, kerma, absorbed dose index	gray	Gy	$J.kg^{-1}$	$m^2.s^{-2}$
Dose equivalent	sievert	Sv	$J.kg^{-1}$	$m^2.s^{-2}$

<sup>(1)</sup> Special names for the unit of power: the name volt-ampere (symbol 'VA') when it is used to express the apparent power of alternating electric current, and var (symbol 'var') when it is used to express reactive electric power. The 'var' is not included in CGPM resolutions.

Units derived from SI base units or supplementary units may be expressed in terms of the units listed in Chapter I.

In particular, derived SI units may be expressed by the special names and symbols given in the above table; for example, the SI unit of dynamic viscosity may be expressed as  $m^{-1}.kg.s^{-1}$  or  $N.s.m^{-2}$  or  $Pa.s$ .

### 1.3. Prefixes and their symbols used to designate certain decimal multiples and submultiples

Factor	Prefix	Symbol	Factor	Prefix	Symbol
$10^{18}$	exa	E	$10^{-1}$	deci	d
$10^{15}$	peta	P	$10^{-2}$	centi	c
$10^{12}$	tera	T	$10^{-3}$	milli	m
$10^9$	giga	G	$10^{-6}$	micro	$\mu$
$10^6$	mega	M	$10^{-9}$	nano	n
$10^3$	kilo	k	$10^{-12}$	pico	p
$10^2$	hecto	h	$10^{-15}$	femto	f
$10^1$	deca	da	$10^{-18}$	atto	a

The names and symbols of the decimal multiples and submultiples of the unit of mass are formed by attaching prefixes to the word 'gram' and their symbols to the symbol 'g'.

Where a derived unit is expressed as a fraction, its decimal multiples and submultiples may be designated by attaching a prefix to units in the numerator or the denominator, or in both these parts.

Compound prefixes, that is to say prefixes formed by the juxtaposition of several of the above prefixes, may not be used.

### 1.4. Special authorized names and symbols of decimal multiples and submultiples of SI units

Quantity	Unit		
	Name	Symbol	Value
Volume Mass Pressure, stress	litre tonne bar	l or L <sup>(1)</sup> t bar <sup>(2)</sup>	1 l = 1 dm <sup>3</sup> = 10 <sup>-3</sup> m <sup>3</sup> 1 t = 1 Mg = 10 <sup>3</sup> kg 1 bar = 10 <sup>5</sup> Pa
<p><sup>(1)</sup> The two symbols 'l' and 'L' may be used for the litre unit (Sixteenth CGPM (1979), resolution 5).</p> <p><sup>(2)</sup> Unit listed in the International Bureau of Weights and Measures booklet as among the units to be permitted temporarily.</p>			

**Note:** The prefixes and their symbols listed in 1.3 may be used in conjunction with the units and symbols contained in Table 1.4.

2. UNITS WHICH ARE DEFINED ON THE BASIS OF SI UNITS BUT ARE NOT DECIMAL MULTIPLES OR SUBMULTIPLES THEREOF

Quantity	Unit		
	Name	Symbol	Value
Plane angle	revolution* <sup>(1)</sup> (a)	gon*	1 revolution = $2\pi$ rad
	grade * or gon *		1 gon = $\pi / 200$ rad
	degree		1° = $\pi / 180$ rad
	minute of angle		1' = $\pi / 10\,800$ rad
Time	second of angle	"	1" = $\pi / 648\,000$ rad
	minute	min	1 min = 60 s
	hour	h	1 h = 3 600 s
	day	d	1 d = 86 400 s
<sup>(1)</sup> The character * after a unit name or symbol indicates that these do not appear in the lists drawn up by the CGPM, CIPM, or BIPM. This applies to the whole of this Annex. (a) No international symbol exists			

*Note:* The prefixes listed in 1.3 may only be used in conjunction with the names 'grade' or 'gon' and the symbols only with the symbol 'gon'.

3. UNITS DEFINED INDEPENDENTLY OF THE SEVEN SI BASE UNITS

The unified atomic mass unit is one-twelfth of the mass of an atom of the nuclide <sup>12</sup>C.

The electronvolt is the kinetic energy acquired by an electron passing in a vacuum from one point to another whose potential is one volt higher.

Quantity	Unit		
	Name	Symbol	Value
Mass	unified atomic mass unit	u	1 u $\approx 1,6605655 \times 10^{-27}$ kg
Energy	electronvolt	eV	1 eV $\approx 1,6021892 \times 10^{-19}$ J

The value of these units, expressed in SI units, is not known exactly.

The above values are taken from CODATA Bulletin No 11 of December 1973 of the International Council of Scientific Unions.

*Note:* The prefixes and their symbols listed in 1.3 may be used in conjunction with these two units and with their symbols.

## 4. UNITS AND NAMES OF UNITS PERMITTED IN SPECIALIZED FIELDS ONLY

Quantity	Unit		
	Name	Symbol	Value
Vergency of optical systems	dioptré *		1 dioptré = 1 m <sup>-1</sup>
Mass of precious stones	metric carat		1 metric carat = 2 x 10 <sup>-4</sup> kg
Area of farmland and building land	are	a	1 a = 10 <sup>2</sup> m <sup>2</sup>
Mass per unit length of textile yarns and threads	tex *	tex *	1 tex = 10 <sup>-6</sup> kg.m <sup>-1</sup>
Blood pressure and pressure of other body fluids	Millimetre of mercury	mm Hg (*)	1 mm Hg = 133,322 Pa
Effective cross-sectional area	Barn	b	1b = 10 <sup>-28</sup> m <sup>2</sup>

*Note:* The prefixes listed in 1.3 may be used in conjunction with the above units and symbols, with the exception of the millimetre of mercury and its symbol. The multiple of 10<sup>2</sup> a is, however, called a "hectare".

## 5. COMPOUND UNITS

Combinations of the units listed in Chapter I form compound units.

**CHAPTER III**

## THE CLAIMS

**1. General**

Art. 78(1)(c) 1.1 The application must contain "one or more claims".

Art. 84 1.2 These must:

- (i) "define the matter for which protection is sought";
- (ii) "be clear and concise";
- (iii) "be supported by the description".

Art. 69(1) 1.3 Since the extent of the protection conferred by a European patent or application shall be determined by the terms of the claims (interpreted with the help of the description and the drawings), clarity of claim is of the utmost importance (see also III, 4).

**2. Form and content of claims**

Rule 29(1) 2.1 The claims must be drafted in terms of the "technical features of the invention". This means that claims should not contain any statements relating, for example, to commercial advantages or other non-technical matters, but statements of purpose should be allowed if they assist in defining the invention. It is not necessary that every feature should be expressed in terms of a structural limitation. Functional features may be included provided that a skilled man would have no difficulty in providing some means of performing this function without exercising inventive skill. Claims to the use of the invention in the sense of the technical application thereof are allowable.

Rule 29(1)  
Rule 29(1)(a) 2.2 Rule 29(1)(a) and (b) define the two-part form which a claim should adopt "wherever appropriate". The first part should contain a statement indicating "the designation of the subject-matter of the invention" i.e. the general technical class of apparatus, process, etc., to which the invention relates, followed by a statement of "those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art". This statement of prior art features is applicable only to independent claims and not to dependent claims (see III, 3.5). It is clear from the wording of Rule 29 that it is necessary only to refer to those prior art features which are relevant to the invention. For example, if the invention relates to a photographic camera but the inventive step relates entirely to the shutter, it would be sufficient for the first part of the claim to read: "A photographic camera including a focal plane shutter" and there is no need to refer also to the other known features of a

camera such as the lens and view-finder. The second part or "characterising portion" should state the "technical features which, in combination with the features stated in sub-paragraph (a) (the first part), it is desired to protect" i.e. the features which the invention adds to the prior art. If a single document in the state of the art according to Art. 54(2), e.g. cited in the search report, reveals that one or more features in the second part of the claim were already known in combination with all the features in the first part of the claim and in that combination have the same effect as they have in the full combination according to the invention, the examiner should require that such feature or features be transferred to the first part. Where however a claim relates to a novel combination, and where the division of the features of the claim between the prior art part and the characterising part could be made in more than one way without inaccuracy, the applicant should not be pressed, unless there are very substantial reasons, to adopt a different division of the features from that which he has chosen, if his version is not incorrect.

2.3 Subject to what is stated in 2.3b, final sentence, the applicant should be required to follow the above two-part formulation in his independent claim or claims, where, for example, it is clear that his invention resides in a distinct improvement in an old combination of parts or steps. However as is indicated by Rule 29, this form need be used only in appropriate cases. The nature of the invention may be such that this form of claim is unsuitable, e.g. because it would give a distorted or misleading picture of the invention or the prior art. Examples of the kind of invention which may require a different presentation are:

- (i) the combination of known integers of equal status, the inventive step lying solely in the combination;
- (ii) the modification of, as distinct from addition to, a known chemical process e.g. by omitting one substance or substituting one substance for another; and
- (iii) a complex system of functionally interrelated parts, the inventive step concerning changes in several of these or in their inter-relationships.

In examples (i) and (ii) the Rule 29 form of claim may be artificial and inappropriate, whilst in example (iii) it might lead to an inordinately lengthy and involved claim. Another example in which the Rule 29 form of claim may be inappropriate is where the invention is a new chemical compound or group of compounds. It is likely also that other cases will arise in which the applicant is able to adduce convincing reasons for formulating the claim in a different form.



Art. 54(3)

2.3a There is also another special instance in which the Rule 29 form of claim should be avoided. This is when the only relevant prior art is another European patent application falling within the terms of Art. 54(3). Such prior art should however be clearly acknowledged in the description (see II, 4.3).

2.3b When examining whether or not a claim is to be put in the form provided by Rule 29(1), second sentence, it is important to assess whether this form is "appropriate". In this respect it should be borne in mind that the purpose of the two-part form of claim is to allow the reader to see clearly which features necessary for the definition of the claimed subject matter are, in combination, part of the prior art. If this is sufficiently clear from the indication of prior art made in the description, to meet the requirement of Rule 27(1)(b), the two-part form of claim should not be insisted upon.

Rule 35(11)

2.4 The claims, as well as the description, "may contain chemical or mathematical formulae" but not drawings. "The claims may contain tables" but "only if their subject-matter makes the use of tables desirable". In view of the use of the word "desirable" in the Rule, the examiner should not object to the use of tables in claims where this form is convenient.

### 3. Kinds of claim

#### Categories

Rule 29(2)

3.1 The Convention refers to different "categories" of claim ("products, process, apparatus or use"). For many inventions, claims in more than one category are needed for full protection. In fact, there are only two basic kinds of claim, viz, claims to a physical entity (product, apparatus) and claims to an activity (process, use). The first basic kind of claim ("product claim") includes a substance or compositions (e.g. chemical compound or a mixture of compounds) as well as any physical entity (e.g. object, article, apparatus, machine, or system of co-operating apparatus) which is produced by man's technical skill. Examples are: "a steering mechanism incorporating an automatic feed-back circuit..."; "a woven garment comprising..."; "an insecticide consisting of X, Y, Z"; or "a communication system comprising a plurality of transmitting and receiving stations". The second basic kind of claim ("process claim") is applicable to all kinds of activities in which the use of some material product for effecting the process is implied; the activity may be exercised upon material products, upon energy, upon other processes (as in control processes) or upon living things (see however IV, 3.4 and 4.3).

3.2 Sometimes an applicant will submit claims which, although worded differently, really fall within the same

category and have effectively the same scope. The examiner should bear in mind that the presence of such different claims may assist an applicant in obtaining full protection for his invention in all the designated countries, having regard to the fact that infringement of a European patent is dealt with by national law. Consequently, while an examiner should not allow an unnecessary proliferation of independent claims (see III, 5), he should not adopt an over-academic or rigid approach to the presence of a number of claims which are differently worded but apparently of similar effect.

## Rule 29(2)

3.3 Subject to the conditions for unity of invention being satisfied (see III, 7), Rule 29(2), states that an application may contain two or more independent claims in the same category "where it is not appropriate, having regard to the subject-matter of the application, to cover this subject-matter by a single claim: This means that the examiner may allow two or more independent claims in the same category in appropriate cases provided that there is a unifying inventive concept and that the claims as a whole satisfy the requirement of Art. 84 that they should be concise (see III, 5). In applying this principle the examiner should have regard to the remarks made in III, 3.2 concerning claims of apparently similar scope. However, there are other circumstances where it may not be appropriate to cover the subject-matter of an invention by a single independent claim in a particular category, for example, where the invention relates to an improvement in two separate but inter-related articles which may be sold separately, but each carry out the same inventive idea, such as an electric plug and socket or transmitter and receiver. As another example, for an invention concerned with electrical bridge-rectifier circuits it might be necessary to include separate independent claims to a single-phase and poly-phase arrangements incorporating such circuits since the number of circuits needed per phase is different in the two arrangements.

Further examples are where the invention resides in a group of new chemical compounds and there are a number of processes for the manufacture of such compounds, or where a known substance is disclosed for a number of distinct medical uses (see IV, 4.2).

**Independent and dependent claims**

## Rule 29(3)

3.4 All applications will contain one or more "independent" claims directed to the essential features of the invention. Any such claim may be followed by one or more claims concerning "particular embodiments" of that invention. It is evident that any claim relating to a particular embodiment must effectively include also the essential features of the invention, and hence must include all the features of at least one independent claim. The term "particular embodi-

ment" should be construed broadly as meaning any more specific disclosure of the invention than that set out in the main claim or claims.

## Rule 29(4)

3.5 "Any claim which includes all the features of any other claim" is termed a "dependent claim". Such a claim must "contain, if possible at the beginning, a reference to the other claim", all of whose features it includes (see, however, III, 3.7a for claims in different categories). Since a dependent claim does not by itself define all the characterising features of the subjectmatter which it claims, expressions such as "characterised in that" or "characterised by" are not necessary in such a claim but are nevertheless permissible. A claim defining further particulars of an invention may include all the features of another dependent claim and should then refer back to that claim. Also, in some cases a dependent claim may define a particular feature or features which may appropriately be added to more than one previous claim (independent or dependent). It follows that there are several possibilities: a dependent claim may refer back to one or more independent claims, to one or more dependent claims, or to both independent and dependent claims.

## Rule 29(4)

3.6 All dependent claims, however referred back, "must be grouped together to the extent and in the most appropriate way possible". The arrangement must therefore be one which enables the association of related claims to be readily determined and their meaning in association to be readily construed. The examiner should object if the arrangement of claims is such as to create obscurity in the definition of the subject-matter to be protected. In general, however, when the corresponding independent claim is allowable, the examiner should not concern himself unduly with the subject-matter of dependent claims, provided he is satisfied that they are truly dependent and thus in no way extend the scope of protection of the invention defined in the corresponding independent claim (see III, 3.7a).

3.6a If the two-part form is used for the independent claim(s), dependent claims may relate to further details of features not only of the characterising portion but also of the preamble.

3.7 A claim, whether independent or dependent, can refer to alternatives provided those alternatives are of a similar nature and can fairly be substituted one for another and provided also that the number and presentation of alternatives in a single claim does not make the claim obscure or difficult to construe (see also III, 7.4).

3.7a A claim may also contain a reference to another claim even if it is not a dependent claim as defined in Rule 29(4). One example of this is a claim referring to a claim of

different category (e.g. "Apparatus for carrying out the process of claim 1...", or "Process for the manufacture of the product of claim 1..."). Similarly, in a situation like the plug and socket example of III, 3.3, a claim to the one part referring to the other co-operating part (e.g. "plug for cooperation with the socket of claim 1...") is not a dependent claim. References from one claim to another may also occur where alternative features which may be substituted for one another are claimed in separate claims. Thus there may be a first independent claim 1 for a machine including, inter alia, a feature X followed by further claims for alternatives such as "A machine according to claim 1 modified in that feature X is replaced by feature Y". In all these examples, the examiner should carefully consider the extent to which the claim containing the reference necessarily involves the features of the claim referred to and the extent to which it does not. In the case of a claim for a process which results in the product of a product claim, if the product claim is patentable then no separate examination for the obviousness of the process claim is necessary (see IV, 9.5a), provided that all features of the product result from the process (see T 169/88, not published in OJ). This also applies in the case of a claim for the use of a product, when the product is patentable and is used with its features as claimed (see T 642/94, not published in OJ). In all other instances, the patentability of the claim referred to does not necessarily imply the patentability of the independent claim containing the reference.

#### 4. Clarity and interpretation of claims

Art. 84

4.1 The requirement that the claims shall be clear applies to individual claims and also to the claims as a whole. The clarity of the claims is of the utmost importance in view of their function in defining the matter for which protection is sought. Therefore the meaning of the terms of a claim should, as far as possible, be clear for the person skilled in the art from the wording of the claim alone (see also 4.2 below). In view of the differences in the scope of protection which may be attached to the various categories of claims, the examiner should ensure that the wording of a claim leaves no doubt as to its category.

Art. 14(7)

4.2 Each claim should be read giving the words the meaning and scope which they normally have in the relevant art, unless in particular cases the description gives the words a special meaning, by explicit definition or otherwise. Moreover, if such a special meaning applies, the examiner should, so far as possible, require the claim to be amended whereby the meaning is clear from the wording of the claim alone. This is important because it is only the claims of the European patent, not the description, which will be published in all the official languages of the Office. The claim should also be read with an attempt to make technical sense out of it. Such a reading may involve

a departure from the strict literal meaning of the wording of the claims.

4.3 Any inconsistency between the description and the claims should be avoided if having regard to Art. 69(1), second sentence, it may throw doubt on the extent of protection and therefore render the claim unclear or unsupported under Art. 84, second sentence or, alternatively, render the claim objectionable under Art. 84, first sentence. Such inconsistency can be of the following kinds:

(i) Simple verbal inconsistency.

For example, there is a statement in the description which suggests that the invention is limited to a particular feature but the claims are not so limited; also, the description places no particular emphasis on this feature and there is no reason for believing that the feature is essential for the performance of the invention. In such a case the inconsistency can be removed either by broadening the description or by limiting the claims. Similarly, if the claims are more limited than the description, the claims may be broadened or the description may be limited.

(ii) Inconsistency regarding apparently essential features.

For example, it may appear, either from general technical knowledge or from what is stated or implied in the description, that a certain described technical feature not mentioned in an independent claim is essential to the performance of the invention, or in other words is necessary for the solution of the problem to which the invention relates. In such a case the claim does not meet the requirements of Art. 84, because Art. 84, first sentence, when read in conjunction with Rules 29(1) and (3), has to be interpreted as meaning not only that an independent claim must be comprehensible from a technical point of view but also that it must define clearly the object of the invention, that is to say indicate all the essential features thereof (see T 32/82, OJ 8/1984, 354). If, in response to this objection, the applicant shows convincingly, e.g. by means of additional documents or other evidence, that the feature is not in fact essential, he may be allowed to retain the unamended claim and, where necessary, to amend the description instead. The opposite situation in which an independent claim includes features which do not seem essential for the performance of the invention is not objectionable. This is a matter of the applicant's choice. The examiner should therefore not suggest that a claim be broadened by the omission of apparently inessential features.

(iii) Part of the subject-matter of the description and/or drawings is not covered by the claims.

For example, the claims all specify an electric circuit employing semi-conductor devices but one of the embodiments in the description and drawings employs electronic tubes instead. In such a case, the inconsistency can normally be removed either by broadening the claims (assuming that the description and drawings as a whole provide adequate support for such broadening) or by removing the "excess" subject-matter from the description and drawings. However if examples in the description and/or drawings which are not covered by the claims, are presented, not as embodiments of the invention, but as background art or examples which are useful for understanding the invention, the retention of these examples may be allowed.

4.3a General statements in the description which imply that the extent of protection may be expanded in some vague and not precisely defined way should be objected to. In particular, objection should be raised to any statement which refers to the extent of protection being expanded to cover the "spirit" of the invention; objection should likewise be raised, in the case where the claims are directed to a combination of features, to any statement which seems to imply that protection is nevertheless sought not only for the combination as a whole but also for individual features or sub-combinations thereof.

4.4 An independent claim should specify clearly all of the essential features needed to define the invention except in so far as such features are implied by the generic terms used, e.g. a claim to a "bicycle" does not need to mention the presence of wheels. If a claim is to a process for producing the product of the invention, then the process as claimed should be one which, when carried out in a manner which would seem reasonable to a person skilled in the art, necessarily has as its end result that particular product; otherwise there is an internal inconsistency and therefore lack of clarity in the claim. In the case of a product claim, if the product is of a well-known kind and the invention lies in modifying it in certain respects, it is sufficient if the claim clearly identifies the product and specifies what is modified and in what way. Similar considerations apply to claims for apparatus.

Where patentability depends on a technical effect the claims must be so drafted as to include all the technical features of the invention which are essential for the technical effect (see T 32/82, OJ 8/1984, 354, point 15).

4.5 It is preferable not to use a relative or similar term such as "thin", "wide" or "strong" in a claim unless the term has a well-recognised meaning in the particular art, e.g. "high-frequency" in relation to an amplifier, and this is the meaning intended. Where the term has no well-recognised meaning it should if possible be replaced by a more

precise wording found elsewhere in the original disclosure. Where there is no basis in the disclosure for a clear definition, and the term is not essential having regard to the invention, it should normally be retained in the claim, because to excise it would generally lead to an extension of the subject-matter beyond the content of the application as filed - in contravention of Art. 123(2). However an unclear term cannot be allowed in a claim if the term is essential having regard to the invention. Equally, an unclear term cannot be used by the applicant to distinguish his invention from the prior art.

4.5a Particular attention is required whenever the word "about" or similar terms such as "approximately" are used. Such a word may be applied, for example, to a particular value (e.g. "about 200° C") or to a range (e.g. "about x to about y"). In each case, the examiner should use his judgment as to whether the meaning is sufficiently clear in the context of the application read as a whole. However, the word can only be permitted if its presence does not prevent the invention from being unambiguously distinguished from the prior art with respect to novelty and inventive step.

4.5b The use of trade marks and similar expressions in claims should not be allowed as it may not be guaranteed that the product or feature referred to is not modified while maintaining its name during the term of the patent. They may be allowed exceptionally if their use is unavoidable and they are generally recognised as having a precise meaning (see also II, 4.16 and 4.17).

4.6 Expressions like "preferably", "for example", "such as" or "more particularly" should be looked at carefully to ensure that they do not introduce ambiguity. Expressions of this kind have no limiting effect on the scope of a claim; that is to say, the feature following any such expression is to be regarded as entirely optional.

4.7 The area defined by the claims must be as precise as the invention allows. As a general rule, claims which attempt to define the invention, by a result to be achieved should not be allowed, in particular if they only amount to claiming the underlying technical problem. However, they may be allowed if the invention either can only be defined in such terms or cannot otherwise be defined more precisely without unduly restricting the scope of the claims and if the result is one which can be directly and positively verified by tests or procedures adequately specified in the description or known to the person skilled in the art and which do not require undue experimentation (see T 68/85, OJ 6/1987, 228). For example, the invention may relate to an ashtray in which a smouldering cigarette end will be automatically extinguished due to the shape and relative dimensions of the ashtray. The latter may vary consider-

ably in a manner difficult to define whilst still providing the desired effect (for functional features see III, 2.1 and 6.5). So long as the claim specifies the construction and shape of the ashtray as clearly as possible, it may define the relative dimensions by reference to the result to be achieved, provided that the specification includes adequate directions to enable the reader to determine the required dimensions by routine test procedures.

#### 4.7a Parameters

Where the invention relates to a product it may be defined in a claim in various ways, viz. as a chemical product by its chemical formula, as a product of a process (if no clearer definition is possible) or exceptionally by its parameters.

Parameters are characteristic values, which may be values of directly measurable **properties** (e.g. the melting point of a substance, the flexural strength of a steel, the resistance of an electrical conductor) or may be defined as more or less complicated mathematical combinations of several variables in the form of **formulae**.

Characterisation of a product mainly by its parameters should only be allowed in those cases where the invention cannot be adequately defined in any other way, provided that those parameters can be clearly and reliably determined either by indications in the description or by objective procedures which are usual in the art (see T 94/82, OJ 2/1984, 75). The same applies to a process related feature which is defined by parameters. Cases in which unusual parameters are employed or a non-accessible apparatus for measuring the parameter(s) is used are prima facie objectionable on grounds of lack of clarity, as no meaningful comparison with the prior art can be made. Such cases might also disguise lack of novelty (see IV, 7.5).

Whether the method of and the means for measurement of the parameters need also be in the claim is treated in 4.10.

4.7b Claims for products defined in terms of a process of manufacture are admissible only if the products as such fulfil the requirements for patentability, i.e. inter alia that they are new and inventive. A product is not rendered novel merely by the fact that it is produced by means of a new process (see T 150/82, OJ 7/1984, 309). A claim defining a product in terms of a process is to be construed as a claim to the product as such and the claim should preferably take the form "Product X obtainable by process Y", or any wording equivalent thereto, rather than "Product X obtained by process Y".

Art 64(2)

According to Art. 64(2), if the subject-matter of a European



patent is a process, the protection conferred by the patent extends to the products directly obtained by such process. The provisions of this Article are understood to apply to

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processes producing products completely different from the starting materials as well as to the processes producing only superficial changes (e.g. painting, polishing).

4.8 If a claim commences with such words as: "Apparatus for carrying out the process etc..." this must be construed as meaning merely apparatus suitable for carrying out the process. Apparatus which otherwise possessed all of the features specified in the claims, but which would be unsuitable for the stated purpose, or which would require modification to enable it to be so used, should not normally be considered as anticipating the claim. Similar considerations apply to a claim for a product for a particular use. For example if a claim refers to a "mold for molten steel", this implies certain limitations for the mold. Therefore a plastic ice cube tray with a melting point much lower than that of steel would not come within the claim. Similarly, a claim to a substance or composition for a particular use should be construed as meaning a substance or composition which is in fact suitable for the stated use; a known product which *prima facie* is the same as the substance or composition defined in the claim, but which is in a form which would render it unsuitable for the stated use, would not deprive the claim of novelty, but if the known product is in a form in which it is in fact suitable for the stated use, though it has never been described for that use, it would deprive the claim of novelty. An exception to this general principle of interpretation is where the claim is to a known substance or composition for use in a surgical, therapeutic or diagnostic method (see IV, 4.2).

4.8a Where a claim in respect of a physical entity (product, apparatus) seeks to define the invention by reference to features relating to the entity's use, a lack of clarity can result. This is particularly the case where the claim **not only** defines the entity itself but also specifies its relationship to a second entity which is not part of the claimed entity (for example, a cylinder head for an engine, where the former is defined by features of its location in the latter). Before considering a restriction to the combination of the two entities, it should always be remembered that the applicant is normally entitled to independent protection of the first entity **per se**, even if it was initially defined by its relationship to the second entity. Since the first entity can often be produced and marketed independently of the second entity, it will usually be possible to obtain independent protection by wording the claims appropriately (for example, by substituting "connectable" for "connected"). If it is not possible to give a clear definition of the first entity **per se**, then the claim should be directed to a combination of the first and second entities (for example, "engine **with** a cylinder head" or "engine **comprising** a cylinder head").

It may also be allowable to define the dimensions and/or shape of a first entity in an independent claim by general

reference to the dimensions and/or corresponding shape of a second entity which is not part of the claimed first entity but is related to it through use. This particularly applies where the size of the second entity is in some way **standardised** (for example, in the case of a mounting bracket for a vehicle number-plate, where the bracket frame and fixing elements are defined in relation to the outer shape of the number-plate). However, references to second entities which **cannot be seen as subject to standardisation** may also be sufficiently clear in cases where the skilled person would have little difficulty in inferring the resultant restriction of the scope of protection for the first entity (for example, in the case of a covering sheet for an agricultural round bale, where the length and breadth of the covering sheet and how it is folded are defined by reference to the bale's circumference, width and diameter, see T 455/92, not published in OJ). It is neither necessary for such claims to contain the exact dimensions of the second entity, nor do they have to refer to a combination of the first and second entities. Specifying the length, width and/or height of the first entity without reference to the second would lead to an unwarranted restriction of the scope of protection.

4.8b To avoid ambiguity, particular care should be exercised when assessing claims which employ the word "in" to define a relationship between different physical entities (product, apparatus), or between entities and activities (process, use), or between different activities. Examples of claims worded in this way include the following:

- (i) cylinder head in a four-stroke engine
- (ii) In a telephone apparatus with an automatic dialer, dial tone detector and feature controller, the dial tone detector comprising ...
- (iii) In a process using an electrode feeding means of an arc-welding apparatus, a method for controlling the arc welding current and voltage comprising the following steps:...
- (iv) In a process/system/apparatus etc. ... the improvement consists of ...

In examples (i) to (iii) the emphasis is on the fully functioning sub-units (cylinder head, dial tone detector, method for controlling the arc welding current and voltage) rather than the complete unit within which the sub-unit is contained (four-stroke engine, telephone, process). This can make it unclear whether the protection sought is limited to the sub-unit **per se**, or whether the unit as a whole is to be protected. For the sake of clarity, claims of this kind should be directed either to "a unit with (or comprising) a sub-unit" (eg, "four-stroke engine with a cylinder head"), or to the sub-unit **per se**, specifying its purpose (for example, "cylinder head for a four-stroke engine"). The latter course may be followed only at the applicant's express wish and only

if there is a basis for it in the application as filed, in accordance with Art. 123(2).

With claims of the type indicated by example (iv), the use of the word "in" sometimes makes it unclear whether protection is sought for the improvement only or for all the features defined in the claim. Here, too, it is essential to ensure that the wording is clear.

However, claims such as "use of a substance ... as an anticorrosive ingredient in a paint or lacquer composition" are acceptable on the basis of second non-medical use (see IV, 7.6, second paragraph).

4.9 For the purposes of examination, a "use" claim of a form such as "the use of substance X as an insecticide" should be regarded as equivalent to a "process" claim of the form "a process of killing insects using substance X". Thus a claim of the form indicated should not be interpreted as directed to the substance X recognisable (e.g. by further additives) as intended for use of an insecticide. Similarly, a claim for "the use of a transistor in an amplifying circuit" would be equivalent to a process claim for the process of amplifying using a circuit containing the transistor and should not be interpreted as being directed to "an amplifying circuit in which the transistor is used", nor to "the process of using the transistor in building such a circuit".

Rule 29(6)

4.10 The claims must not, in respect of the technical features of the invention, rely on references to the description or drawings "except where absolutely necessary". In particular they must not normally rely on such references as "as described in part... of the description", or "as illustrated in Figure 2 of the drawings". The emphatic wording of the excepting clause should be noted. The onus is upon the applicant to show that it is "absolutely necessary" to rely on reference to the description or drawings in appropriate cases (see T 150/82, OJ 7/1984, 309, 313). An example of an allowable exception would be that in which the invention involved some peculiar shape, illustrated in the drawings, but which could not be readily defined either in words or by a simple mathematical formula. Another special case is that in which the invention relates to chemical products some of whose features can be defined only by means of graphs or diagrams.

A further special case is where the invention is characterised by parameters. Provided that the conditions for defining the invention in this way are met (see III, 4.7a), then the definition of the invention should appear completely in the claim itself whenever this is reasonably practicable. In principle the method of measurement is necessary for the unambiguous definition of the parameter. The method of and means for measurement of the

parameter values need, however, not be in the claims when:

(i) the description of the method is so long that its inclusion would make the claim unclear through lack of conciseness or difficult to understand; in that case the claim should include a reference to the description, in accordance with Rule 29(6),

(ii) a person skilled in the art would know which method to employ, e.g. because there is only one method, or because a particular method is commonly used, or

(iii) all known methods yield the same result (within the limits of measurement accuracy).

However, in all other cases the method of and means for measurement should be included in the claims as the claims shall define the matter for which protection is sought (Art. 84).

Rule 29(7)

4.11 If the application contains drawings, and the comprehension of the claims would be improved by establishing the connection between the features mentioned in the claims and the corresponding reference signs in the drawings then appropriate reference signs should be placed in parentheses after the features mentioned in the claims. If there is a large number of different embodiments only the reference signs of the most important embodiments need be incorporated in the independent claim(s). Where claims are drafted in the two-part form set out in Rule 29(1) the reference signs should be inserted not only in the characterising part but also in the preamble of the claims. Reference signs should not however be seen as limiting the extent of the matter protected by the claims; their sole function is to make claims easier to understand. A comment to that effect in the description is acceptable (see T 237/84, OJ 7/1987, 309).

If text is added to reference signs in parentheses in the claims, lack of clarity can arise (Art. 84). Expressions such as "securing means (screw 13, nail 14)" or "valve assembly (valve seat 23, valve element 27, valve seat 28)" are not reference signs in the sense of Rule 29(7) but are special features, to which the last sentence of Rule 29 (7) is not applicable. Consequently it is unclear whether the features added to the reference signs are limiting or not. Accordingly, such bracketed features are generally not permissible. However, additional references to those figures where particular reference signs are to be found, such as "(13 - Figure 3; 14 - Figure 4)", are unobjectionable.

A lack of clarity can also arise with bracketed expressions that do not include reference signs, e.g. "(concrete)

moulded brick". In contrast, bracketed expressions with a generally accepted meaning are admissible, e.g. "(meth)acrylate" which is known as an abbreviation for "acrylate and methacrylate". The use of brackets in chemical or mathematical formulae is also unobjectionable.

4.12 Generally, the subject-matter of a claim is defined by means of positive features. However, the extent of a claim may be limited by means of a "disclaimer"; in other words, an element clearly defined by technical features may be expressly excluded from the protection claimed, for example in order to meet the requirement of novelty. A disclaimer may be used only when the claim's remaining subject-matter cannot be defined more clearly and concisely by means of positive features (see T 04/80, OJ 4/1982, 149). A specific prior art may be excluded by a disclaimer even in the absence of support for the excluded matter in the original documents (see T 433/86, not published in OJ). However, care should be taken that the wording of the disclaimer does not infringe Art. 123(2).

#### 4.13 "Comprising" vs. "consisting"

While in everyday language the word "comprise" may have both the meaning "include", "contain" or "comprehend" and "consist of", in drafting patent claims legal certainty normally requires it to be interpreted by the broader meaning "include", "contain" or "comprehend". On the other hand, if a claim for a chemical compound refers to it as "consisting of components A, B and C" by their proportions expressed in percentages, the presence of any additional component is excluded and therefore the percentages should add up to 100% (see T 759/91 and T 711/90, both not published in OJ).

### 5. Conciseness, number of claims

Art. 84  
Rule 29(5)

The requirement that the claims shall be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must be considered in relation to the nature of the invention the applicant seeks to protect. Undue repetition of wording, e.g. between one claim and another, should be avoided by the use of the dependent form. Regarding independent claims in the same category see III, 3.3. As for dependent claims, while there is no objection to a reasonable number of such claims directed to particular preferred features of the invention, the examiner should object to a multiplicity of claims of a trivial nature. What is or what is not a reasonable number of claims depends on the facts and circumstances of each particular case. Regard also has to be had to the interests of the relevant public. The presentation of the claims should not make it unduly burdensome to determine the matter for which protection is sought

(T 79/91, CLBA 1998, 169 and T 246/91, CLBA 1998, 170). Objection may also arise where there is a multiplicity of alternatives within a single claim, if this renders it unduly burdensome to determine the matter for which protection is sought.

### 6. Support in description

Art. 84

6.1 The claims must be supported by the description. This means that there must be a basis in the description for the subject-matter of every claim and that the scope of the claims must not be broader than is justified by the extent of the description and drawings and also the contribution to the art (T 409/91, OJ 9/1994, 653).

6.2 Most claims are generalisations from one or more particular examples. The extent of generalisation permissible is a matter which the examiner must judge in each particular case in the light of the relevant prior art. Thus an invention which opens up a whole new field is entitled to more generality in the claims than one which is concerned with advances in a known technology. A fair statement of claim is one which is not so broad that it goes beyond the invention nor yet so narrow as to deprive the applicant of a just reward for the disclosure of his invention. The applicant should be allowed to cover all obvious modifications, equivalents to and uses of that which he has described. In particular, if it is reasonable to predict that all the variants covered by the claims have the properties or uses the applicant ascribes to them in the description he should be allowed to draw his claims accordingly. After the date of filing, however, he should be allowed to do so only if this does not contravene Art. 123(2).

6.3 As a general rule, a claim should be regarded as supported by the description unless there are well-founded reasons for believing that the skilled man would be unable, on the basis of the information given in the application as filed, to extend the particular teaching of the description to the whole of the field claimed by using routine methods of experimentation or analysis. Support must however be of a technical character; vague statements or assertions having no technical content provide no basis.

The examiner should raise an objection of lack of support only if he has well-founded reasons. Once the examiner has set out a reasoned case that, for example, a broad claim is not supported over the whole of its breadth, the onus of demonstrating that the claim is fully supported lies with the applicant (see VI, 2.4). Where objection is raised, the reasons should, where possible, be supported specifically by a published document.

6.4 A claim in generic form, i.e. relating to a whole class, e.g. of materials or machines, may be acceptable even if



of broad scope, if there is fair support in the description and there is no reason to suppose that the invention cannot be worked through the whole of the field claimed. Where the information given appears insufficient to enable a man skilled in the art to extend the teaching of the description to parts of the field, claimed but not explicitly described, by using routine methods of experimentation or analysis, the examiner should raise a reasoned objection, and invite the applicant to establish, by suitable response, that the invention can in fact be readily applied on the basis of the information given over the whole field claimed or, failing this, to restrict the claim accordingly.

The question of support is illustrated by the following examples:

(i) A claim relates to a process for treating all kinds of "plant seedlings" by subjecting them to a controlled cold shock so as to produce specified results, whereas the description discloses the process applied to one kind of plant only. Since it is well-known that plants vary widely in their properties, there are well-founded reasons for believing that the process is not applicable to all plant seedlings. Unless the applicant can provide convincing evidence that the process is nevertheless generally applicable, he must restrict his claim to the particular kind of plant referred to in the description. A mere assertion that the process is applicable to all plant seedlings is not sufficient.

(ii) A claim relates to a specified method of treating "synthetic resin mouldings" to obtain certain changes in physical characteristics. All the examples described relate to thermoplastic resins and the method is such as to appear inappropriate to thermosetting resins. Unless the applicant can provide evidence that the method is nevertheless applicable to thermosetting resins, he must restrict his claim to thermoplastic resins.

(iii) A claim relates to improved fuel oil compositions which have a given desired property. The description provides support for one way of obtaining fuel oils having this property, which is by the presence of defined amounts of a certain additive. No other ways of obtaining fuel oils having the desired property are disclosed. The claim makes no mention of the additive. The claim is not supported over the whole of its breadth and objection arises.

It should be noted that, although an objection of lack of support is an objection under Art. 84, it can often, as in the above examples, also be considered as an objection of insufficient disclosure of the invention under Art. 83, the objection being that the disclosure is insufficient to enable the skilled person to carry out the "invention" over the whole of the broad field claimed (although sufficient in

respect of a narrow "invention"). Both requirements are designed to reflect the principle that the terms of a claim should be commensurate with, or be justified by, the invention. Whether the objection is raised as lack of support or as insufficiency is unimportant in examination proceedings; but it is important in opposition proceedings since there only the latter ground is available (see D-III, 5).

6.5 A claim may broadly define a feature in terms of its function, even where only one example of the feature has been given in the description, if the skilled reader would appreciate that other means could be used for the same function. For example, "terminal position detecting means" in a claim might be supported by a single example comprising a limit switch, it being obvious to the skilled person that e.g. a photoelectric cell or a strain gauge could be used instead. In general, however, if the entire contents of the application are such as to convey the impression that a function is to be carried out in a particular way, with no intimation that alternative means are envisaged, and a claim is formulated in such a way as to embrace other means, or all means, of performing the function, then objection arises. Furthermore, it may not be sufficient if the description merely states in vague terms that other means may be adopted, if it is not reasonably clear what they might be or how they might be used.

6.6 Where certain subject-matter is clearly disclosed in a claim of the application as filed, but is not mentioned anywhere in the description, it is permissible to amend the description so that it includes this subject-matter. Where the claim is dependent, it may suffice if it is mentioned in the description that the claim sets out a particular embodiment of the invention (see II, 4.5).

## **7. Unity of invention**

### **Independent claims**

Art. 82

7.1 The European application must "relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept". The second of these alternatives, i.e. the single-concept linked group, may give rise to a plurality of independent claims in the same category (as in the examples given in III, 3.3), but the more usual case is a plurality of independent claims in different categories.

The following Guidelines are consistent with and based on (in particular 7.2 to 7.3a and 7.4a) an agreement between the EPO, the Japanese Patent Office and the US Patent and Trademark Office, concluded in 1988 with a view to harmonising unity of invention practices in the three Offices.

Rule 30 of the Implementing Regulations to the Convention as amended by decision of the Administrative Council of 7.12.1990 shall apply to those European patent applications which are filed on or after 1.6.1991.

## Rule 30(1)

7.2 Rule 30(1) indicates how one determines whether or not the requirement of Art. 82 is fulfilled when more than one invention appears to be present. The link between the inventions required by Art. 82 must be a technical relationship which finds expression in the claims in terms of the same or corresponding special technical features. The expression "special technical features" means, in any one claim, the particular technical feature or features that define a contribution that the claimed invention considered as a whole makes over the prior art. Once the special technical features of each invention have been identified, one must determine whether or not there is a technical relationship between the inventions and, furthermore, whether or not this relationship involves these special technical features. Moreover, it is not necessary that the special technical features in each invention be the same. Rule 30(1) makes clear that the required relationship may be found between corresponding technical features. An example of this correspondence might be the following: In one claim the special technical feature which provides resilience might be a metal spring, whereas in another claim the special technical feature which provides resilience might be a block of rubber.

A plurality of independent claims in different categories may constitute a group of inventions so linked as to form a single general inventive concept. In particular, paragraph (1) of Rule 30 should be construed as permitting the inclusion of any one of the following combinations of claims of different categories in the same application:

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(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(ii) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(iii) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for an apparatus or means specifically designed for carrying out the said process.

However, while a single set of independent claims according to any one of the combinations (i), (ii) or (iii) above is always permissible, an examiner is not obliged to accept a plurality of such sets which could arise by additionally applying the provisions of Rule 29(2). The proliferation of claims arising out of a combined effect of this kind should be allowed only exceptionally.

7.3 It is essential that a single general inventive concept link the claims in the various categories. The presence in each claim of expressions such as "specially adapted" or "specifically designed" does not necessarily imply that a single general inventive concept is present.

The requirement that the process be specially adapted for the manufacture of the product is fulfilled if the claimed process inherently results in the claimed product. The expression "specially adapted" does not imply that the product could not also be manufactured by a different process. It also does not imply that a similar process of manufacture could not also be used for the manufacture of other products.

The requirement that the apparatus or means be specifically designed for carrying out the process is fulfilled if the apparatus or means is suitable for carrying out the process and if there is a technical relationship as defined in paragraph (1) of Rule 30 between the claimed apparatus or means and the claimed process. It is not sufficient for unity that the apparatus or means is merely capable of being used in carrying out the process. However, the expression "specifically designed" does not exclude that the apparatus or means could also be used for carrying out another process, or that the process could also be carried out using an alternative apparatus or means.

7.3a Unity of invention should be considered to be present in the context of intermediate and final products where:

(i) the intermediate and final products have the same essential structural element, i.e. their basic chemical structures are the same or, their chemical structures are technically closely interrelated, the intermediate incorporating an essential structural element into the final product, and

(ii) the intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

Unity of invention may also be present between intermediate and final products of which the structures are not known - for example, as between an intermediate having a known structure and a final product with unknown structure or as between an intermediate of unknown structure and a final product of unknown structure. In such cases, there should be sufficient evidence to lead one to conclude that the intermediate and final products are technically closely interrelated as, for example, when the intermediate contains the same essential element as the final product or incorporates an essential element into the final product.

Different intermediate products used in different processes for the preparation of the final product may be claimed provided that they have the same essential structural element. The intermediate and final products should not be separated, in the process leading from one to the other, by an intermediate which is not new. Where different intermediates for different structural parts of the final product are claimed, unity should not be regarded as being present between the intermediates. If the intermediate and final products are families of compounds, each intermediate compound should correspond to a compound claimed in the family of the final products. However, some of the final products may have no corresponding compound in the family of the intermediate products so that the two families need not be absolutely congruent.

The mere fact that, besides the ability to be used to produce final products, the intermediates also exhibit other possible effects or activities should not prejudice unity of invention.

Rule 30(2)

7.4 Alternative forms of an invention may be claimed either in a plurality of independent claims, as indicated in III, 7.1, or in a single claim (but see III, 3.7). In the latter case the presence of the two alternatives as independent forms may not be immediately apparent. In either case, however, the same criteria should be applied in deciding whether or not there is unity of invention, and lack of unity of invention may then also exist within a single claim.

7.4a Where a single claim defines (chemical or non-chemical) alternatives, i.e. a so-called "Markush grouping", unity of invention should be considered to be present when the alternatives are of a similar nature (see III, 3.7).

When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where:

- (i) all alternatives have a common property or activity,
- and
- (ii) a common structure is present, i.e. a significant structural element is shared by all of the alternatives, or all alternatives belong to a recognised class of chemical compounds in the art to which the invention pertains.

A "significant structural element is shared by all of the alternatives" where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together. The alternatives belong to a "recognised class of chemical compounds" if there is an expectation from the knowledge in the art that members of the class will behave in the same way in the context of the claimed invention, i.e. that each member could be substituted one for the other, with the expectation that the same intended result would be achieved. If it can be shown that at least one Markush alternative is not novel, unity of invention should be reconsidered.

7.5 Objection of lack of unity does not normally arise because a claim contains a number of individual features whether presenting a technical interrelationship (combination) or not (juxtaposition)

7.6 Lack of unity may be directly evident a priori, i.e. before considering the claims in relation to the prior art or may only become apparent a posteriori, i.e. after taking the prior art into consideration - e.g. a document within the state of the art as defined in Art. 54(2), shows that there is lack of novelty or inventive step in a main claim thus leaving two or more independent claims without a common inventive concept.

7.7 Although lack of unity may arise a posteriori as well as a priori, it should be remembered that lack of unity is not a ground of revocation in later proceedings. Therefore, although the objection should certainly be made and

amendment insisted upon in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. This is particularly so where the possible lack of unity does not necessitate a further search. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the search report. If the common matter of the independent claims is well-known, and the remaining subject-matter of each claim differs from that of the others without there being any unifying novel concept common to all, then clearly there is lack of unity. If, on the other hand, there is a common concept or principle which is novel and inventive then objection of lack of unity does not arise. For determining what is allowable between these two extremes, rigid rules cannot be given and each case should be considered on its merits, the benefit of any doubt being given to the applicant. For the particular case of claims for a known substance for a number of distinct medical uses, see IV, 4.2.

#### **Dependent claims**

7.8 No objection on account of lack of unity a priori is justified in respect of a dependent claim and the claim from which it depends, because the general concept they have in common is the subject-matter of the independent claim, which is also contained in the dependent claim. For example, suppose claim 1 claims a turbine rotor blade shaped in a specified manner, while claim 2 is for a "turbine rotor blade as claimed in claim 1 and produced from alloy Z". The common general concept linking the dependent with the independent claim is "turbine rotor blade shaped in a specified manner".

If, however, the independent claim appears to be not patentable, then the question whether there is still an inventive link between all the claims dependent on that claim needs to be carefully considered (see III, 7.7, non-unity "a posteriori"). It may be that the "special technical features" of one claim dependent on this non-patentable independent claim are not present in the same or corresponding form in an other claim dependent on that claim.

#### **Unity in relation to the search**

Rule 46(1)  
Rule 46(2)

7.9 In many and probably most instances lack of unity will have been noted and reported upon by the Search Division who will have drawn up a partial search report based on those parts of the application relating to the invention, or unified linked group of inventions, first mentioned in the claims. The Search Division may neither refuse the application for lack of unity, nor require limitation of the claims; but must inform the applicant that, if the search report is to be drawn up to cover those inventions present



other than the first mentioned, then appropriate fees must be paid within a stipulated period. The Examining Division will reconsider the question of unity of invention in respect of the claims as originally searched by the Search Division of the EPO and will notify the applicant of the outcome. Insofar as it finds that unity of invention is given, it will order refund of the relevant search fees, if a refund has been requested.

7.10 If the applicant has not availed himself of the opportunity to have the search results on the other inventions included in the search report he will be taken to have elected that the application should proceed on the basis of the invention which has been searched (see Opinion G 2/92, OJ 10/1993, 591). The examiner, if he agrees with the Search Division that the application contains more than one invention, should then require deletion of all of them, other than the invention which has been searched (see III, 7.12).

Rule 86(4)

7.10a For the situation where the applicant submits new claims directed to subject-matter which has not been searched as it was e.g. only contained in the description and the Search Division did not find it appropriate to extend the search to this subject-matter (see B-III, 3.6), reference is made to VI, 5.2 (ii).

7.11 If, however, the applicant has taken the opportunity to have other inventions searched then he may elect that the application shall proceed on the basis of any of these, the other being deleted if the examiner agrees with the Search Division's objection of lack of unity.

Rule 34(1)(c)  
Rule 25(1)

7.12 Whether or not the question of unity of invention has been raised by the Search Division, it must always be considered by the examiner. In doing so he should take into account the search report. If unity is found to be lacking, the applicant should be required to limit his claims in such a way as to avoid the objection. Excision or amendment of parts of the description may also be necessary (see II, 7.3). One or more divisional applications, covering matter removed to meet this objection, may be filed (see VI, 9).

Art. 157(3)(a)

7.13 For international applications entering the regional phase with an International Search Report established by the EPO, the Swedish, the Spanish or the Austrian Patent Office as International Searching Authority, no supplementary search is carried out.

(i) If during the International Search performed by one of said Offices an objection to lack of unity has been raised and the applicant has not taken the opportunity to have the other invention(s) searched by paying additional search fees for them, but has taken the opportunity to amend the

claims after receipt of the International Search Report so that they are limited to the invention searched and has indicated that examination is to be carried out on these amended claims, the examiner shall proceed on the basis of these claims.

Rule 104b(4)

(ii) If in the above case the applicant has not amended the claims so that they are limited to the invention searched and the examiner agrees with the objection of the International Searching Authority, he will invite the applicant to pay further search fees within the same time limit as in Rule 46(1) if he wishes the application to be examined on the basis of these inventions (as well).

If the applicant does not pay these further search fees, he will be taken to have elected that the application proceeds on the basis of the first claims, namely those upon which a search has been performed and he will have to delete the subject-matter related to the other inventions.

If the applicant pays the further search fees, he will, after receipt of the further search report, have to indicate on the basis of which invention the application should proceed and limit the application accordingly. In both cases he can file divisional applications for the inventions removed to meet the objection of non-unity.

(iii) If the applicant has not paid additional search fees and the examiner does not agree with the objection of the International Searching Authority, the Search Division will be requested to perform an additional search (see B-III, 4.2(iii)) and the examination will be carried out on all claims.

(iv) If the applicant has paid additional search fees during the international phase, 7.11 and 7.12 above apply likewise.

Art. 157(2)(a)

7.14 For international applications entering the regional phase with an International Search Report established by an International Searching Authority other than the above mentioned (see 7.13), a supplementary search is carried out by the Search Division of the EPO. If the applicant has paid additional search fees during the international phase, 7.11 and 7.12 above apply likewise. If the Search Division, during the supplementary search, notes a lack of unity (see B-VII, 2.4), 7.9-7.12 above apply.

7.15 For international applications entering the regional phase with an International Preliminary Examination Report, the examiner should carefully take into account the position taken in that IPER before deviating from it. This may be necessary where the claims have been changed or the interpretation of the rules regarding unity of invention was erroneous, see further 7.12 above.

- Rule 104b(4) 7.16 If the EPO has established an International Preliminary Examination Report on the application and the applicant wishes the application to proceed on the basis of claims which were not the subject of this International Preliminary Examination Report because these had not been searched by the International Searching Authority because of an objection to lack of unity, he will be invited to pay additional search fees for the inventions not searched and to additionally pay the difference between the full examination fee and the reduced examination fee as mentioned in Rule 104b(6). In that case the applicant, after receipt of the further search report, must also indicate on the basis of which invention the application should proceed.
- 7.17 For international applications, for which the EPO establishes an International Preliminary Examination Report, see PCT Preliminary Examination Guidelines Chapter III, 7 and Chapter VI, 5.5-5.9 (PCT Gazette S-07/98 of 29 October 1998). An allegation of lack of unity of invention may be contested by the applicant by paying the additional examination fees under protest. For the subsequent review by a review panel and, if applicable, by a Board of Appeal, see E-IX, 5.2.
- 8. Different texts of the claims and, if appropriate, different descriptions and drawings of the European patent application in respect of different Contracting States (see also D-VII, 4)**
- Rule 87 8.1 Different text in respect of state of the art according to Art. 54(3) and (4).
- If the EPO notes that in respect of one or more of the designated Contracting States the content of an earlier European patent application forms part of the state of the art pursuant to Art. 54(3) and (4), and if this prior art gives rise to different texts of the claims, different sets of claims for the Contracting States concerned shall be filed. Different descriptions and drawings will only be required if it is not possible to set out clearly in a common description which subject matter is to be protected in the different Contracting States, having regard to the appropriate prior art (see also IV, 6.3 and VI, 5.10-5.13).
- Art. 61(1)(b)  
Rule 15  
Rule 16(1)(2) 8.2 Different text where a partial transfer of right has taken place according to Rule 16(1) and (2) by virtue of a final decision pursuant to Art. 61
- If by a final decision pursuant to Art. 61 "it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, the original European patent application shall contain," where appropriate, "for the designated Contracting States in which the decision was

taken or recognised, claims, a description and drawings which are different from those for the other designated Contracting States" (see also VI, 5.14 and 9.7 to 9.12).

Art. 167(2)(a) 8.3 Different text where a reservation has been entered in accordance with Art. 167(2)(a)

Where a Contracting State has entered reservations in accordance with Art. 167(2)(a), patent applications and patents, by which protection is sought for chemical, pharmaceutical or food products as such, may include different sets of claims for that State and for the other designated States respectively. Such reservations have been made by Austria, Greece and Spain. The reservation for Austria ceased to be in force ten years after the entry into force of the EPC (7 October 1977), those for Greece and Spain ceased to have effect after 7 October 1992.

Rule 86(3) If different sets of claims have not already been presented in the European patent application as filed, they may be presented after the European search report has been received and before the reply to the first communication from the Examining Division, without the Examining Division's consent. Subsequently, however, they may only be presented with the Examining Division's consent. It is, however, in this case appropriate to allow different sets of claims, as any short delay caused by making the necessary amendments is of little weight compared to the importance to the applicant of obtaining a valid patent in such contracting states (see also VI, 4.9 and 4.10). In both cases, it is important to check that Art. 123(2) has not been contravened. If different sets of claims are filed only in opposition proceedings, it should also be checked that Art. 123(3) (extension of protection), has not been contravened.

The reservations under Art. 167(2) do not constitute requirements of the EPC under Art. 96(2) and therefore the Examining Division is not required to consider whether the claims meet such reservations (see Decision G 7/93, OJ 11/1994, 775). The filing of separate claims should be regarded simply as a possibility open to the applicant and may thus neither be suggested nor required.

Normally, a common description should be sufficient for all sets of claims.

8.4 Different text where national rights of earlier date exist

National rights of earlier date are not comprised in the state of the art (Art. 54) for the purposes of the EPO examination for patentability. Consequently a specific search for national rights of earlier date is not made, although any documents found are mentioned in the search report (see B-VI, 4.2). As a result, under

Art. 139(2), national rights of earlier date can be invoked, after the grant of the European patent, in national proceedings as a ground for revocation. Like the reservation under Art. 167(2)(a) (see III, 8.3), they represent exceptions to the uniformity of European substantive patent law. Where national rights exist, therefore, the applicant has a legitimate interest in submitting separate claims to ensure that the patent granted will not be partly revoked in some Contracting States. The filing of separate claims should, however, neither be required nor suggested.

If an applicant produces evidence in examination proceedings of the existence of pertinent national rights of earlier date in a particular designated State, it is appropriate to allow the submission of separate claims for the Contracting State in question (see VI, 4.9 and 4.10). The evidence must be in the form of a printed specification or, where applicable, a copy of the utility model or utility certificate or of the application for the latter (cf. Art. 140); this is necessary to prevent unjustified deviation from the unity of the European patent.

The effect of the national right of earlier date is determined by the relevant national provisions. The examiner does not have to decide whether the applicant has, by means of separate claims, limited the scope of his application to the extent required. That is the responsibility of the applicant.

The examiner must check that the separate claims do not contravene Art. 123(2) and that they meet the other requirements of the European Patent Convention.

In contrast to European rights of earlier date, national rights of earlier date are not comprised in the state of the art, so that there is no justification for a separate description.

However, at a suitable point in the preamble to the description, preferably in a separate paragraph following the information pursuant to Rule 27(1)(a), a reference to this situation must be made, for example along the following lines:

With reference to... (e.g. earlier application No... in...), the applicant has voluntarily limited the scope of the present application, and submitted separate claims for... (Contracting State).

#### 8.5 Calculation of claims fees

The claims fees are calculated in accordance with VI, 15.2.1.



**CHAPTER IV**

## PATENTABILITY

**1. General**

1.1 There are four basic requirements for patentability:

- Art. 52(1)
- (i) There must be an "invention".
  - (ii) The invention must be "susceptible of industrial application".
  - (iii) The invention must be "new".
  - (iv) The invention must involve an "inventive step".

These requirements will be dealt with in turn in IV, 2 and 3, 4, 5 to 8, and 9 respectively.

1.2 In addition to these four basic requirements, the examiner should be aware of the following two requirements that are implicitly contained in the Convention and the Regulations:

(i) The invention must be such that it can be carried out by a person skilled in the art (after proper instruction by the application); this follows from Art. 83. Instances where the invention fails to satisfy this requirement are given in II, 4.11.

(ii) The invention must be of "technical character" to the extent that it must relate to a **technical field** (Rule 27(1)(a)), must be concerned with a technical problem (Rule 27(1)(c)), and must have technical features in terms of which the matter for which protection is sought can be defined in the claim (Rule 29(1)) (see III, 2.1).

1.3 The Convention does not require explicitly or implicitly that an invention to be patentable must entail some technical progress or even any useful effect. Nevertheless, advantageous effects, if any, with respect to the state of the art should be stated in the description (Rule 27(1)(c)), and any such effects are often important in determining "inventive step" (see IV, 9).

**2. Inventions**

- Art. 52(2)
- 2.1 The Convention does **not** define what is meant by "invention", but Art. 52(2) contains a non-exhaustive list of things which shall not be regarded as inventions. It will be noted that the items on this list are all either abstract (e.g. discoveries, scientific theories, etc.) or non-technical (e.g. aesthetic creations or presentations of information). In contrast to this, an "invention" within the meaning of

Art. 52(1) must be of both a concrete and a technical character (see IV, 1.2(ii)). It may be in any field of technology.

Art. 52(3)

2.2 In considering whether the subject-matter of an application is an invention within the meaning of Art. 52(1), there are two general points the examiner must bear in mind. Firstly, any exclusion from patentability under Art. 52(2) applies only to the extent to which the application relates to the excluded subject-matter **as such**. Secondly, the examiner should disregard the form or kind of claim and concentrate on its content in order to identify whether the claimed subject-matter, considered as a whole, has a technical character. If it does not, there is no invention within the meaning of Art. 52(1).

It must also be borne in mind that the basic test of whether there is an invention within the meaning of Art. 52(1), is separate and distinct from the questions whether the subject-matter is susceptible of industrial application, is new and involves an inventive step.

2.3 The items on the list in Art. 52(2) will now be dealt with in turn, and further examples will be given in order better to clarify the distinction between what is patentable and what is not.

#### Discoveries

If a new property of a known material or article is found out, that is mere discovery and unpatentable because discovery as such has no technical effect and is therefore not an invention within the meaning of Art. 52(1). If however that property is put to practical use then this constitutes an invention which may be patentable. For example, the discovery that a particular known material is able to withstand mechanical shock would not be patentable, but a railway sleeper made from that material could well be patentable. To find a previously unrecognised substance occurring in nature is also mere discovery and therefore unpatentable. However, if a substance found in nature can be shown to produce a technical effect it may be patentable. An example of such a case is that of a substance occurring in nature which is found to have an antibiotic effect. In addition, if a micro-organism is discovered to exist in nature and to produce an antibiotic, the micro-organism itself may also be patentable as one aspect of the invention. Similarly, a gene which is discovered to exist in nature may be patentable if a technical effect is revealed, e.g. its use in making a certain polypeptide or in gene therapy.

For further specific issues concerning biotechnological inventions see IV, 2a, 3 and 4.6.



**Scientific theories**

These are a more generalised form of discoveries, and the same principle applies. For example, the physical theory of semiconductivity would not be patentable. However, new semiconductor devices and processes for manufacturing these may be patentable.

**Mathematical methods**

These are a particular example of the principle that purely abstract or intellectual methods are not patentable. For example, a shortcut method of division would not be patentable but a calculating machine constructed to operate accordingly may well be patentable. A mathematical method for designing electrical filters is not patentable; nevertheless filters designed according to this method would not be excluded from patentability by Art. 52(2) and (3).

**Aesthetic creations**

An aesthetic creation relates by definition to an article (e.g. a painting or sculpture) having aspects which are other than technical and the appreciation of which is essentially subjective. If, however, the article happens also to have technical features, it might be patentable, a tyre tread being an example of this. The aesthetic effect itself is not patentable, neither in a product nor in a process claim. For example a book claimed solely in terms of the aesthetic or artistic effect of its information content, of its layout or of its letterfont, would not be patentable, and neither would a painting defined by the aesthetic effect of its subject or by the arrangement of colours, or by the artistic (e.g. Impressionist) style. Nevertheless, if an aesthetic effect is obtained by a technical structure or other technical means, although the aesthetic effect itself is not patentable, the means of obtaining it may be. For example, a fabric may be provided with an attractive appearance by means of a layered structure not previously used for this purpose, in which case a fabric incorporating such structure might be patentable. Similarly, a book defined by a technical feature of the binding or pasting of the back may be patentable, even though it has an aesthetic effect too, similarly also a painting defined by the kind of cloth, or by the dyes or binders used. Also a process of producing an aesthetic creation may comprise a technical innovation and thus be patentable. For example, a diamond may have a particularly beautiful shape (not of itself patentable) produced by a new technical process. In this case, the process may be patentable. Similarly, a new printing technique for a book resulting in a particular layout with aesthetic effect may well be patentable, together with the book as a product of that process. Again a substance or composition defined by technical features serving to produce a special effect with

regard to scent or flavour, e.g. to maintain a scent or flavour for a prolonged period or to accentuate it, may well be patentable.

#### **Schemes, rules and methods for performing mental acts, playing games or doing business**

These are further examples of items of an abstract or intellectual character. In particular, a scheme for learning a language, a method of solving cross-word puzzles, a game (as an abstract entity defined by its rules) or a scheme for organising a commercial operation would not be patentable. However, if the claimed subject-matter specifies an apparatus or technical process for carrying out at least some part of the scheme, that scheme and the apparatus or process have to be examined as a whole. In particular, if the claim specifies computers, computer networks or other conventional programmable apparatus, or a program therefor, for carrying out at least some steps of a scheme, it is to be examined as a "computer-implemented invention" (see below).

#### **Programs for computers**

Programs for computers are a form of "computer-implemented invention", which expression is intended to cover claims which involve computers, computer networks or other conventional programmable apparatus whereby prima facie the novel features of the claimed invention are realised by means of a program or programs. Such claims may e.g. take the form of a method of operating said conventional apparatus, the apparatus set up to execute the method, or, following T 1173/97 (OJ 10/1999, 609), the program itself. In so far as the scheme for examination is concerned, no distinctions are made on the basis of the overall purpose of the invention, i.e. whether it is intended to fill a business niche, to provide some new entertainment, etc..

The basic patentability considerations here are in principle the same as for other subject-matter. While "programs for computers" are included among the items listed in Art. 52(2), if the claimed subject-matter has a technical character, it is not excluded from patentability by the provisions of Art. 52(2) and (3). However, a data-processing operation controlled by a computer program can equally, in theory, be implemented by means of special circuits, and the execution of a program always involves physical effects, e.g. electrical currents. According to T 1173/97 such normal physical effects are not in themselves sufficient to lend a computer program technical character. But if a computer program is capable of bringing about, when running on a computer, a further technical effect going beyond these normal physical effects, it is not excluded from patentability, irrespective of whether it is

claimed by itself or as a record on a carrier. This further technical effect may be known in the prior art. A further technical effect which lends technical character to a computer program may be found e.g. in the control of an industrial process or in processing data which represent physical entities or in the internal functioning of the computer itself or its interfaces under the influence of the program and could, for example, affect the efficiency or security of a process, the management of computer resources required or the rate of data transfer in a communication link. As a consequence, a computer program claimed by itself or as a record on a carrier or in the form of a signal may be considered as an invention within the meaning of Art. 52(1) if the program has the potential to bring about, when running on a computer, a further technical effect which goes beyond the normal physical interactions between the program and the computer. A patent may be granted on such a claim if all the requirements of the EPC are met, see in particular Art. 84, 83, 54 and 56, and 4.5 below. Such claims should not contain program listings (see II, 4.14a), but should define all the features which assure patentability of the process which the program is intended to carry out when it is run (see III, 4.4, last sentence).

Moreover, following T 769/92 (OJ 8/1995, 525), the requirement for technical character is satisfied if technical considerations are required to carry out the invention. Such technical considerations must be reflected in the claimed subject-matter.

When considering whether a claimed computer-implemented invention is patentable, the following is to be borne in mind. In the case of a method, specifying technical means for a purely non-technical purpose and/or for processing purely non-technical information does not necessarily confer technical character on any such individual step of use or on the method as a whole. On the other hand a computer system suitably programmed for use in a particular field, even if that is, for example, the field of business and economy, has the character of a concrete apparatus, in the sense of a physical entity or product, and thus is an invention within the meaning of Art. 52(1) (see T 931/95, OJ 10/2001, 441).

If a claimed invention does not have a prima facie technical character, it should be rejected under Art. 52(2) and (3). In the practice of examining computer-implemented inventions, however, it may be more appropriate for the examiner to proceed directly to the questions of novelty and inventive step, without considering beforehand the question of technical character. In assessing whether there is an inventive step, the examiner must establish an objective technical problem which has been overcome (see IV, 9.5). The solution of that problem constitutes the

invention's technical contribution to the art. The presence of such a technical contribution establishes that the claimed subject-matter has a technical character and therefore is indeed an invention within the meaning of Art. 52(1). If no such objective technical problem is found, the claimed subject-matter does not satisfy at least the requirement for an inventive step because there can be no technical contribution to the art, and the claim is to be rejected on this ground.

### **Presentations of information**

Any representation of information defined solely by the content of the information is not patentable. This applies whether the claim is directed to the presentation of the information per se (e.g. by acoustical signals, spoken words, visual displays, books defined by their subject, gramophone records defined by the musical piece recorded, traffic signs defined by the warning thereon) or to processes and apparatus for presenting information (e.g. indicators or recorders defined solely by the information indicated or recorded). If, however, the presentation of information has new technical features, there could be patentable subject-matter in the information carrier or in the process or apparatus for presenting the information. The arrangement or manner of representation, as distinguished from the information content, may well constitute a patentable technical feature. Examples in which such a technical feature may be present are: a telegraph apparatus or communication system using a particular code to represent the characters (e.g. pulse code modulation); a measuring instrument designed to produce a particular form of graph for representing the measured information; a gramophone record having a particular groove form to allow stereo recordings; a computer data structure (see T 1194/97, OJ 12/2000, 525) defined in terms which inherently comprise the technical features of the program which operates on said data structure (assuming the program itself, in the particular case, to be patentable); and a diapositive with a soundtrack arranged at the side of it.

### **2a. Biotechnological inventions**

- Rule 23b(2), (3) 2a.1 "Biotechnological inventions" are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used. "Biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.
- Rule 23c  
Rule 23b(1) In principle, biotechnological inventions are patentable under the EPC. For European patent applications and patents concerning biotechnological inventions, the relevant provisions of the Convention are to be applied

and interpreted in accordance with the provisions of Rules 23b-e. European Union Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions (OJ 2/1999, 101) is to be used as a supplementary means of interpretation. In particular the recitals (EU Dir. 98/44/EC, rec.) preceding the provisions of the Directive are also to be taken into account.

Rule 23c

2a.2 Biotechnological inventions are also patentable if they concern an item on the following non-exhaustive list:

Rule 23c(a)

(a) Biological material which is **isolated** from its natural environment or produced by means of a technical process even if it previously occurred in nature;

Hence, biological material may be considered patentable even if it already occurs in nature (see also 2.3 under "Discoveries").

Rule 23e(1)  
Rule 23e(2)

Although the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions (see 3.3b), an element isolated from the human body or otherwise produced by means of a technical process, which is susceptible of industrial application, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element. Such an element is not a priori excluded from patentability since it is, for example, the result of technical processes used to identify, purify and classify it and to produce it outside the human body, techniques which human beings alone are capable of putting into practice and which nature is incapable of accomplishing itself (EU Dir. 98/44/EC, rec. 21).

Rule 23e(3)

The examination of a patent application or a patent for gene sequences or partial sequences should be subject to the same criteria of patentability as in all other areas of technology (EU Dir. 98/44/EC, rec. 22). The industrial application of a sequence or partial sequence must be disclosed in the patent application as filed (see 4.6).

Rule 23c(b)

(b) Plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety;

Inventions which concern plants or animals are patentable provided that the application of the invention is not technically confined to a single plant or animal variety (EU Dir. 98/44/EC, rec. 29).

A claim wherein specific plant varieties are not individually claimed is not excluded from patentability under Article

53(b) EPC even though it may embrace plant varieties (see G 1/98, OJ 3/2000, 111, and IV, 3.4).

The subject-matter of a claim covering but not identifying plant varieties is not a claim to a variety or varieties (see G 1/98, OJ 3/2000, 111, reasons, 3.8). In the absence of the identification of a specific plant variety in a product claim, the subject-matter of the claimed invention is neither limited nor directed to a variety or varieties within the meaning of Article 53(b) (G 1/98, OJ 3/2000, 111, reasons, 3.1 and 3.10).

Rule 23c(c) (c) A microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety.

Rule 23b(6) "Microbiological process" means any process involving or performed upon or resulting in microbiological material.

### 3. Exceptions to patentability

Art. 53(a) 3.1 Any invention, the publication or exploitation of which would be contrary to "ordre public" or morality is specifically excluded from patentability. The purpose of this is to exclude from protection inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour (see also II, 7.1); obvious examples of subject-matter which should be excluded under this provision are letter-bombs and anti-personnel mines. In general, this provision is likely to be invoked only in rare and extreme cases. A fair test to apply is to consider whether it is probable that the public in general would regard the invention as so abhorrent that the grant of patent rights would be inconceivable. If it is clear that this is the case, objection should be raised under Art. 53(a); otherwise not. If difficult legal questions arise in this context, then refer to VI, 7.9.

Art. 53(a) 3.2 Exploitation is not to be deemed to be contrary to "ordre public" or morality merely because it is prohibited by law or regulation in some or all of the Contracting States. One reason for this is that a product could still be manufactured under a European patent for export to States in which its use is not prohibited.

3.3 In some cases refusal of a patent application may be unjustified. This may result when the invention has both an offensive and a non-offensive use: e.g. a process for breaking open locked safes, the use by a burglar being offensive but the use by a locksmith in the case of emergency inoffensive. In such a case no objection arises under Art. 53(a). Similarly, if a claimed invention defines a copying machine with features resulting in an improved precision of reproduction and an embodiment of this apparatus could comprise further features (not claimed but

apparent to the skilled person) the only purpose of which would be that it should also allow reproduction of security strips in banknotes strikingly similar to those in genuine banknotes, the claimed apparatus would cover an embodiment for producing counterfeit money which could be considered to fall under Art. 53(a). There is however no reason to consider the copying machine as claimed to be excluded since its improved properties could be used for many acceptable purposes (see G 1/98, OJ 3/2000, 111, reasons, 3.3.3). However, if the application contains an explicit reference to a use which is contrary to "ordre public" or morality, deletion of this reference should be required under the terms of Rule 34(1)(a).

3.3a The EPO has not been vested with the task of taking into account the economic effects of the grant of patents in specific areas of technology and of restricting the field of patentable subject-matter accordingly (see G 1/98, OJ 3/2000, 111, reasons, 3.9). The standard to apply for an exclusion under Art. 53(a) is whether the exploitation of the invention is contrary to "ordre public" or morality.

3.3b In the area of biotechnological inventions, the following list of exceptions to patentability under Art. 53(a) is laid down in Rule 23d. The list is illustrative and non-exhaustive and is to be seen as giving concrete form to the concept of "ordre public" and "morality" in this technical field.

Rule 23d	Under Article 53(a), European patents are not to be granted in respect of biotechnological inventions which concern:
Rule 23d(a)	(a) processes for cloning human beings;
	For the purpose of this exclusion a process for the cloning of human beings may be defined as any process, including techniques of embryo splitting, designed to create a human being with the same nuclear genetic information as another living or deceased human being (EU Dir. 98/44/EC, rec. 41).
Rule 23d(b)	(b) processes for modifying the germ line genetic identity of human beings;
Rule 23d(c)	(c) uses of human embryos for industrial or commercial purposes;
	The exclusion of the uses of human embryos for industrial or commercial purposes does not affect inventions for therapeutic or diagnostic purposes which are applied to the human embryo and are useful to it (EU Dir. 98/44/EC, rec. 42).
Rule 23d(d)	(d) processes for modifying the genetic identity of

	<p>animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.</p>	
	<p>The substantial medical benefit referred to above includes any benefit in terms of research, prevention, diagnosis or therapy (EU Dir. 98/44/EC, rec. 45).</p>	
Rule 23e(1)	<p>In addition, the human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions (see however IV, 2a.2). Such stages in the formation or development of the human body include germ cells (EU Dir. 98/44/EC, rec. 16).</p>	
	<p>Also excluded from patentability are processes to produce chimeras from germ cells or totipotent cells of humans and animals (EU Dir. 98/44/EC, rec. 38).</p>	
Art. 53(b)	<p>3.4 Excluded from patentability are also "plant or animal varieties or essentially biological processes for the production of plants or animals".</p>	
Rule 23b(4)	<p>3.4.1 The term "plant variety" is defined in Rule 23b(4).</p>	
Rule 23c(b)	<p>A patent is not to be granted if the claimed subject-matter is directed to a specific plant variety or specific plant varieties. However, if the invention concerns plants and animals and if the technical feasibility of the invention is not confined to a particular plant or animal variety, the invention is patentable (see 2a.2).</p>	
	<p>When a claim to a process for the production of a plant variety is examined, Art. 64(2) is not to be taken into consideration (see G 1/98, OJ 3/2000, 111). Hence, a process claim for the production of a plant variety (or plant varieties) is not <i>a priori</i> excluded from patentability merely because the resulting product constitutes or may constitute a plant variety.</p>	
Rule 23b(5)	<p>3.4.2 A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection. To take some examples, a method of crossing, inter-breeding, or selectively breeding, say, horses involving merely selecting for breeding and bringing together those animals having certain characteristics would be essentially biological and therefore unpatentable. On the other hand, a process of treating a plant or animal to improve its properties or yield or to promote or suppress its growth e.g. a method of pruning a tree, would not be essentially biological since although a biological process is involved, the essence of the invention is technical; the same could apply to a</p>	



method of treating a plant characterised by the application of a growth-stimulating substance or radiation. The treatment of soil by technical means to suppress or promote the growth of plants is also not excluded from patentability (see also 4.3).

Art. 53(b)  
Rule 23b(6)

3.5 As expressly stated in Art. 53(b), second half-sentence, the exclusion referred to in the first half-sentence does not apply to microbiological processes or the products thereof.

"Microbiological process" means any process involving or performed upon or resulting in microbiological material. Hence, the term "microbiological process" is to be interpreted as covering not only processes performed upon microbiological material or resulting in such, e.g. by genetic engineering, but also processes which as claimed include both microbiological and non-microbiological steps.

Rule 23c(c)

The product of a microbiological process may also be patentable per se (product claim). Propagation of the micro-organism itself is to be construed as a microbiological process for the purposes of Art. 53(b); consequently, the micro-organism can be protected per se as it is a product obtained by a microbiological process (see 2.3 under "Discoveries"). The term "micro-organism" includes bacteria and other generally unicellular organisms with dimensions beneath the limits of vision which can be propagated and manipulated in a laboratory (see T 356/93, OJ 8/1995, 545), including plasmids and viruses and unicellular fungi (including yeasts), algae, protozoa and, moreover, human, animal and plant cells.

On the other hand, product claims for plant or animal varieties cannot be allowed even if the variety is produced by means of a microbiological process (Rule 23c(c)). The exception to patentability in Art. 53(b), first half-sentence, applies to plant varieties irrespective of the way in which they are produced. Therefore, plant varieties containing genes introduced into an ancestral plant by recombinant gene technology are excluded from patentability (G 1/98, OJ 3/2000, 111).

Rule 28(3)

3.6 In the case of microbiological processes, particular regard should be had to the requirement of repeatability referred to in II, 4.11. As for biological material deposited under the terms of Rule 28, repeatability is assured by the possibility of taking samples (Rule 28(3)), and there is thus no need to indicate another process for the production of the biological material.

#### 4. Industrial application

Art. 57

4.1 "An invention shall be considered as susceptible of

industrial application if it can be made or used in any kind of industry, including agriculture". "Industry" should be understood in its broad sense as including any physical activity of "technical character" (see IV, 1.2), i.e. an activity which belongs to the useful or practical arts as distinct from the aesthetic arts; it does not necessarily imply the use of a machine or the manufacture of an article and could cover e.g. a process for dispersing fog, or a process for converting energy from one form to another. Thus, Art. 57 excludes from patentability very few "inventions" which are not already excluded by the list in Art. 52(2) (see IV, 2.1). One further class of "invention" which would be excluded, however, would be articles or processes alleged to operate in a manner clearly contrary to well-established physical laws, e.g. a perpetual motion machine. Objection could arise under Art. 57 only in so far as the claim specifies the intended function or purpose of the invention, but if, say, a perpetual motion machine is claimed merely as an article having a particular specified construction then objection should be made under Art. 83 (see II, 4.11).

Art. 52(4)  
Art. 54(5)

4.2 "Methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practised on the human or animal body shall not be regarded as inventions which are susceptible of industrial application. This provision shall not apply to products, in particular substances or compositions, for use in any of these methods." Patents may, however, be obtained for surgical, therapeutic or diagnostic instruments or apparatus for use in such methods. Also the manufacture of prostheses or artificial limbs, as well as taking measurements therefor on the human body, would be patentable, so that a method of manufacturing a prosthetic tooth which involves making a model of a patient's teeth in the mouth would not be excluded from patentability either, provided the prosthetic tooth is fabricated outside of the body. Patents may also be obtained for new products for use in these methods of treatment or diagnosis, particularly substances or compositions. However in the case of a known substance or composition, this may only be patented for use in these methods if the known substance or composition was not previously disclosed for use in surgery, therapy or diagnostic methods practised on the human or animal body ("first medical use"). The same substance or composition cannot subsequently be patented for any other use of that kind. A claim to a known substance or composition for the first use in surgical, therapeutic and/or diagnostic methods should be in a form such as: "substance or composition X" followed by the indication of the use, for instance "... for use as a medicament", "... as an antibacterial agent " or "... for curing disease Y". In contrast to what is stated in III, 4.8 these types of claims will be regarded as restricted to the substance or composition when presented or packaged for the use. Art. 54(5) provides for an exception from the general principle that product claims can only be obtained

for (absolutely) novel products. However this does not mean that product claims for the first medical use need not fulfil all other requirements of patentability, especially that of inventive step (see T 128/82, OJ 4/1984, 164). A claim in the form "Use of substance or composition X for the treatment of disease Y..." will be regarded as relating to a method for treatment explicitly excluded from patentability by Art. 52(4) and therefore will not be accepted.

If an application discloses for the first time a number of distinct surgical, therapeutic or diagnostic uses for a known substance or composition, normally in the one application independent claims each directed to the substance or composition for one of the various uses may be allowed; i.e. objection should not, as a general rule, be raised that there is lack of unity of invention.

A claim in the form "Use of a substance or composition X for the manufacture of a medicament for therapeutic application Z" is allowable for either a first or "subsequent" (second or further) such application, if this application is new and inventive (cf. Decision G 05/83, OJ 3/1985, 64). The same applies to claims in the form "Method for manufacturing a medicament intended for therapeutic application Z, characterised in that the substance X is used" or the substantive equivalents thereof (see T 958/94, OJ 6/1997, 241). In cases where an applicant simultaneously discloses more than one "subsequent" therapeutic use, claims of the above type directed to these different uses are allowable in the one application, but only if they form a single general inventive concept (Art. 82).

Art. 52(4)

4.3 It should be noted that Art. 52(4) excludes only methods of treatment by surgery or therapy and diagnostic methods. It follows that other methods of treatment of live human beings or animals (e.g. treatment of a sheep in order to promote growth, to improve the quality of mutton or to increase the yield of wool) or other methods of measuring or recording characteristics of the human or animal body are patentable provided that (as would probably be the case) such methods are of a technical, and not essentially biological character (see IV, 3.4) and provided that the methods are susceptible of industrial application. The latter proviso is particularly important in the case of human beings. For example an application with a claim for a method of contraception, which is to be applied in the private and personal sphere of a human being, is not susceptible of industrial application (see T 74/93, OJ 10/1995, 712). However, an application containing claims directed to the purely cosmetic treatment of a human by administration of a chemical product is considered as being susceptible of industrial application (see T 144/83, OJ 9/1986, 301). A cosmetic treatment involving surgery or therapy would not however be patentable (see below).

A treatment or diagnostic method, to be excluded, must actually be carried out on the living human or animal body. A treatment or diagnostic method practised on a dead human or animal body would therefore not be excluded from patentability by virtue of Art. 52(4). Treatment of body tissues or fluids after they have been removed from the human or animal body, or diagnostic methods applied thereon, are not excluded from patentability in so far as these tissues or fluids are not returned to the same body. Thus the treatment of blood for storage in a blood bank or diagnostic testing of blood samples is not excluded, whereas a treatment of blood by dialysis with the blood being returned to the same body would be excluded.

Regarding methods which are carried out on, or in relation to, the living human or animal body, it should be borne in mind that the intention of Art. 52(4) is only to free from restraint non-commercial and non-industrial medical and veterinary activities. Interpretation of the provision should avoid the exclusions from going beyond their proper limits (see Decision G 05/83, OJ 3/1985, 64).

However, in contrast to the subject-matter referred to in Art. 52(2) and (3) which is only excluded from patentability if claimed as such, a claim is not allowable under Art. 52(4) if it includes at least one feature defining a physical activity or action that constitutes a method step for treatment of the human or animal body by surgery or therapy or a diagnostic method step to be exercised on the human or animal body. In that case, whether or not the claim includes or consists of features directed to a technical operation performed on a technical object is legally irrelevant to the application of Art. 52(4) (see T 820/92, OJ 3/1995, 113 and T 82/93, OJ 5/1996, 274).

Taking the three exclusions in turn:

**Surgery** defines the nature of the treatment rather than its purpose. Thus, e.g. a method of treatment by surgery for cosmetic purposes or for embryo transfer is excluded, as well as surgical treatment for therapeutic purposes.

**Therapy** implies the curing of a disease or malfunction of the body and covers prophylactic treatment, e.g. immunisation against a certain disease (see T 19/86, OJ 1-2/1989, 24) or the removal of plaque (see T 290/86, OJ 8/1992, 414). A method for therapeutic purposes concerning the functioning of an apparatus associated with a living human or animal body is not excluded if no functional relationship exists between the steps related to the apparatus and the therapeutic effect of the apparatus on the body (see T 245/87, OJ 5/1989, 171).

**Diagnostic methods** likewise do not cover all methods related to diagnosis. Methods for obtaining information

(data, physical quantities) from the living human or animal body are not excluded by Art. 52(4), if the information obtained merely provides intermediate results which on their own do not enable a decision to be made on the treatment necessary. Generally such methods include X-ray investigations, NMR studies, and blood pressure measurements (see T 385/86, OJ 8/1988, 308).

4.4 Methods of testing generally should be regarded as inventions susceptible of industrial application and therefore patentable if the test is applicable to the improvement or control of a product, apparatus or process which is itself susceptible of industrial application. In particular, the utilisation of test animals for test purposes in industry, e.g. for testing industrial products (for example for ascertaining the absence of pyrogenetic or allergic effects) or phenomena (for example for determining water or air pollution) would be patentable.

4.5 It should be noted that "susceptibility of industrial application" is not a requirement that overrides the restriction of Art. 52(2), e.g. an administrative method of stock control is not patentable, having regard to Art. 52(2)(c), even though it could be applied to the store of spare parts of a factory. On the other hand, although an invention must be "susceptible of industrial application" and the description must indicate where this is not obvious the way in which the invention is so susceptible (see II, 4.12), the claims need not necessarily be restricted to the industrial application(s).

Rule 27(1)(f)  
Rule 23e(3)

4.6 In general it is required that the description of a European patent application should, where this is not self-evident, indicate the way in which the invention is capable of exploitation in industry. In relation to sequences and partial sequences of genes this general requirement is given specific form in that the industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application. A mere nucleic acid sequence without indication of a function is not a patentable invention (EU Dir. 98/44/EC, rec. 23). In cases where a sequence or partial sequence of a gene is used to produce a protein or a part of a protein, it is necessary to specify which protein or part of protein is produced and what function this protein or part of protein performs. Alternatively, when a nucleotide sequence is not used to produce a protein or part of a protein, the function to be indicated could e.g. be that the sequence exhibits a certain transcription promotor activity.

## 5. Novelty; state of the art

Art. 54(1)  
Art. 54(2)

5.1 An invention is "considered to be new if it does not form part of the state of the art". The "state of the art" is

defined as "everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application". The width of this definition should be noted. There are no restrictions whatever as to the geographical location where, or the language or manner in which the relevant information was made available to the public; also no age limit is stipulated for the documents or other sources of the information. There are however certain specific exclusions (see IV, 8). However, since the "state of the art" available to the examiner will mainly consist of the documents listed in the search report, this Section deals with the question of public availability only in relation to written description (either alone or in combination with an earlier oral description or use).

The principles to be applied in determining whether other kinds of prior art (which could be introduced into the proceedings e.g. by a third party under Art. 115) have been made available to the public are set out in D-V, 3.

5.2 A written description, i.e. a document, should be regarded as made available to the public if, at the relevant date, it was possible for members of the public to gain knowledge of the content of the document and there was no bar of confidentiality restricting the use or dissemination of such knowledge. For instance, German utility models ("Gebrauchsmuster") are already publicly available as of their date of entry in the Register of utility models ("Eintragungstag"), which precedes the date of announcement in the Patent Bulletin ("Bekanntmachung im Patentblatt"). The search report also cites documents in which doubts with regard to the fact of public availability and doubts concerning the precise date of publication of a document have not, or not fully, been removed (cf. B-VI, 7.1). If the applicant contests the public availability or assumed date of publication of the document the examiner should consider whether to investigate the matter further or ask the Search Division so to do. If the applicant shows sound reasons for doubting whether the document forms part of the "state of the art" in relation to his application and any further investigation does not produce evidence sufficient to remove that doubt the examiner should not pursue the matter further. The only other problem likely to arise for the examiner is where:

- (i) a document reproduces an oral description (e.g. a public lecture) or gives an account of a prior use (e.g. display at a public exhibition); and
- (ii) only the oral description or lecture was publicly available before the "date of filing" of the European application, the document itself being published on or after this date.

In such cases, the examiner should start with the assumption that the document gives a true account of the earlier lecture, display or other event and should therefore regard the earlier event as forming part of the "state of the art". If, however, the applicant gives sound reasons for contesting the truth of the account given in the document then again the examiner should not pursue the matter further.

Art. 89

5.3 It should be noted that "date of filing" in Art. 54(2) is to be interpreted as meaning the date of priority in appropriate cases (see Chapter V). It should be remembered also that different claims, or different alternatives claimed in one claim, may have different effective dates. The question of novelty must be considered against each claim (or part of a claim where a claim specifies a number of alternatives) and the state of the art in relation to one claim or one part of a claim may include matter which cannot be cited against another claim or part of a claim because the latter has an earlier effective date.

Of course if all the matter in the state of the art was made available to the public before the date of the earliest priority document, the examiner need not (and should not) concern himself with the allocation of priority dates.

#### **6. Conflict with other European applications**

Art. 54(3)(4)  
 Art. 56  
 Art. 89  
 Art. 85

6.1 The state of the art also comprises the content of other European applications filed earlier than, but published under Art. 93 on or after the date of filing of the application being examined, to the extent that the earlier and later applications designate the same State or States. Such earlier applications are part of the state of the art only when considering novelty and not when considering inventive step. Again, the "date of filing" is to be interpreted as meaning the date of priority in appropriate cases (see Chapter V). By the content of a European application is meant the whole disclosure, i.e. the description, drawings and claims, including:

- (i) any matter explicitly disclaimed (with the exception of disclaimers for unworkable embodiments),
- (ii) any matter for which an allowable reference (see II, 4.18, penultimate paragraph) to other documents is made or
- (iii) prior art insofar as explicitly described.

However, the "content" does not include any priority document (the purpose of such document being merely to determine to what extent the priority date is valid for the disclosure of the European application (see V, 1.2)) nor, in view of Art. 85, the abstract (see B-XI, 3).

It is important to note that it is the content of the earlier application as filed which is to be considered when applying Art. 54(3). In the case where an application is filed in a non-official language as permitted by Art. 14(2) (see A-VIII, 1.1), it may happen that matter is erroneously omitted from the translation in the language of the proceedings and not published under Art. 93 in that language. Even in this case, it is the content of the original text which is relevant for the purposes of Art. 54(3).

6.1a Whether a published European application can be a conflicting application under Art. 54(3) and (4) is determined firstly by its filing date and the date of its publication, which have to be before, respectively on or after the filing date of the application under examination. If the application claims priority, the priority date replaces the filing date (Art. 89) for that subject-matter in the application which corresponds to the priority application. If a priority claim was abandoned or otherwise lost with effect from a date prior to the publication, the filing date and not the priority date is relevant, irrespective of whether or not the priority claim might have conferred a valid priority right.

Further it is required that the conflicting application was still pending at its publication date (see J 5/81, OJ 4/1982, 155). If the application has been withdrawn or otherwise lost before the date of publication, but published because the preparations for publication have been completed, the publication has no effect under Art. 54(3), but only under Art. 54(2). Art. 54(3) must be interpreted as referring to the publication of a "valid" application, i.e. a European patent application in existence at its publication date.

Rule 23a

Finally, as the designation fees can be paid up to 6 months after the mention of the publication of the search report (Art. 79(2), extended where applicable by the grace period of Rule 85a), European applications are only comprised in the state of the art pursuant to Art. 54(3) for those Contracting States for which, at the expiry of the above mentioned period, the designation is definitive, i.e. the relevant designation fees have been paid.

Other changes taking effect after the date of publication (e.g. withdrawal of a designation or of the priority claim, or loss of the priority right for other reasons) do not affect the application of Art. 54(3) and (4).

Art. 158(1)(2)

6.2 The above principles also apply to PCT applications designating the Office, but with an important difference. Art. 158 makes clear that a PCT application is not included in the state of the art as from its priority date for the purposes of Art. 54(3), unless the PCT applicant has paid the required national fee and has supplied the PCT application to the EPO in English, French or German (this



implies that a translation is required where the PCT application was published in Japanese, Chinese, Spanish or Russian). The national fee comprises the national basic fee (equal to the filing fee), the designation fees and where applicable claims fees (Rule 104b(1)(b)).

## Rule 87

6.3 Where an application designates some States which are, and some which are not, designated in an earlier conflicting application, there are several possibilities of amendment open to the applicant. Firstly, he may simply withdraw the designations common to his own and the earlier application. Secondly, he may file claims for such common States which are different from the claims for the other designated States. Where different claims are filed, the examiner should consider whether the retention of the same description and drawings throughout creates confusion. In such a case, Rule 87 permits the examiner to require the filing of a different description and drawings; the applicant himself has no right to request such amendment (see also III, 8.1). Thirdly the applicant can limit his existing set of claims such that the conflicting application is no longer relevant.

If the search report on the conflicting application has been published, but the time limit for validly paying the designation fees has not yet expired, the applicant is informed that the examination cannot be concluded as long as the situation regarding the designations has not been clarified for the prior application, unless the applicant -irrespective of the confirmation of the designations by valid payment- limits his claims such that the conflicting application is no longer relevant for novelty. If the search report has not yet been published (the conflicting application having been published as an "A2" publication), the examiner will invite the competent Search Division to perform the search at the earliest convenience. In the meantime the examination rests.

For the rare case where the application is ready for grant before the search for conflicting applications can be performed (e.g. request for accelerated prosecution of an application filed without priority), see VI, 8.4.

6.4 The Convention does not deal explicitly with the case of copending European applications of the same effective date. However, it is an accepted principle in most patent systems that two patents shall not be granted to the same applicant for one invention. It is permissible to allow an applicant to proceed with two applications having the same description where the claims are quite distinct in scope and directed to different inventions. However, in the rare case in which there are two or more European applications from the same applicant definitively designating the same State or States, by confirming the designation through payment of the relevant designation fees,

and the claims of those applications have the same priority date and relate to the same invention (the claims conflicting in the manner explained in VI, 9.6), the applicant should be told that he must either amend one or more of the applications in such a manner that they no longer claim the same invention, or choose which one of those applications he wishes to proceed to grant. Should two applications of the same effective date be received from two different applicants each must be allowed to proceed as though the other did not exist.

#### **6a. Conflicts with national rights of earlier date**

Where a national right of an earlier date exists in a Contracting State designated in the application the applicant has the same possibilities of amendment as mentioned in 6.3 above, first paragraph, for conflicting European applications. The amendment of the application to take account of prior national rights should, however, neither be required nor suggested. (see also III, 8.4).

#### **7. Test for Novelty**

7.1 It should be noted that in considering novelty (as distinct from inventive step), it is not permissible to combine separate items of prior art together (see IV, 9.7). However, if a document (the "primary" document) refers explicitly to another document as providing more detailed information on certain features, the teaching of the latter may be regarded as incorporated into the document containing the reference (see T 153/85, OJ 1-2/1988, 1), if the document referred to was available to the public on the publication date of the document containing the reference. For conflicting applications, see 6.1 and II, 4.18.

The same principle applies to any matter explicitly disclaimed (except disclaimers which exclude unworkable embodiments) and to prior art insofar as explicitly described. It is further permissible to use a dictionary or similar document of reference in order to interpret a special term used in the primary document. The effective date for novelty purposes (see IV, 7.3) is always the date of the primary document.

7.2 A document takes away the novelty of any claimed subject-matter derivable directly and unambiguously from that document including any features implicit to a person skilled in the art in what is expressly mentioned in the document, e.g. a disclosure of the use of rubber in circumstances where clearly its elastic properties are used even if this is not explicitly stated takes away the novelty of the use of an elastic material. The limitation to subject-matter "derivable directly and unambiguously" from the document is important. Thus, when considering novelty, it is not correct to interpret the teaching of a document as embrac-

ing well-known equivalents which are not disclosed in the documents; this is a matter of obviousness.

7.3 In determining novelty a prior document should be read as it would have been read by a person skilled in the art on the effective date of the document. By "effective" date is meant the publication date in the case of a previously published document and the date of filing (or priority date, where appropriate) in the case of a document according to Art. 54(3).

However, it should be noted that a chemical compound, the name or formula of which was mentioned in a document, is not considered as known unless the information in the document, together, where appropriate, with knowledge generally available on the effective date of the document, enable it to be prepared and separated or, for instance in the case of a product of nature, only to be separated.

7.4 In considering novelty it should be borne in mind that a generic disclosure does not usually take away the novelty of any specific example falling within the terms of that disclosure, but that a specific disclosure does take away the novelty of a generic claim embracing that disclosure, e.g. a disclosure of copper takes away the novelty of metal as a generic concept, but not the novelty of any metal other than copper, and one of rivets takes away the novelty of fastening means as a generic concept, but not the novelty of any fastening other than rivets.

7.5 In the case of a prior document, the lack of novelty may be apparent from what is explicitly stated in the document itself. Alternatively, it may be implicit in the sense that, in carrying out the teaching of the prior document, the skilled person would inevitably arrive at a result falling within the terms of the claim. An objection of lack of novelty of this kind should be raised by the examiner only where there can be no reasonable doubt as to the practical effect of the prior teaching (for a second non-medical use, however, see IV, 7.6). Situations of this kind may also occur when the claims define the invention, or a feature thereof, by parameters (see III, 4.7a). It may happen that in the relevant prior art a different parameter, or no parameter at all, is mentioned. If the known and the claimed products are identical in all other respects (which is to be expected if, for example, the starting products and the manufacturing processes are identical), then in the first place an objection of lack of novelty arises. If the applicant is able to show, e.g. by appropriate comparison tests, that differences do exist with respect to the parameters, it is questionable whether the application discloses all the features essential to manufacture products having the parameters specified in the claims (Art. 83).

7.6 In determining novelty of the subject-matter of claims the examiner should have regard to the guidance given in III, 4.4-4.12. He should remember that, particularly for claims directed to a physical entity, non-distinctive characteristics of a particular intended use, should be disregarded (see III, 4.8). For example, a claim to a substance X for use as a catalyst would not be considered to be novel over the same substance known as a dye, unless the use referred to implies a particular form of the substance (e.g. the presence of certain additives) which distinguishes it from the known form of the substance. That is to say, characteristics not explicitly stated, but implied by the particular use, should be taken into account (see the example of a "mold for molten steel" in III, 4.8).

It should further be borne in mind that a claim to the use of a known compound for a particular purpose (second non-medical use), which is based on a technical effect, should be interpreted as including that technical effect as a functional technical feature, and is accordingly not open to objection under Art. 54(1), EPC provided that such technical feature has not previously been made available to the public (Decisions G 2/88, OJ 4/1990, 93, and G 6/88, OJ 4/1990, 114). For claims to a second or further medical use, see IV, 4.2.

### 8. Non-prejudicial disclosures

Art. 55(1) 8.1 There are two specified instances (and these are the only two) in which a prior disclosure of the invention shall not be taken into consideration as part of the state of the art, viz. where the disclosure was due to, or in consequence of:

Art. 55(1)(a) (i) an evident abuse in relation to the applicant or his legal predecessor - e.g. the invention was derived from the applicant and disclosed against his wish; or

Art. 55(1)(b) (ii) the display of the invention by the applicant or his legal predecessor at an officially recognised exhibition as defined in Art. 55(1)(b).

8.2 An essential condition, in both instances (i) and (ii), is that the disclosure in point must have taken place not earlier than six months preceding the filing of the application.

8.3 Regarding instance (i), the disclosure might be made in a published document or in any other way. As a particular instance, the disclosure might be made in a European application of earlier priority date. Thus, for example, a person B who has been told of A's invention in confidence, might himself apply for a patent for this invention. If so, the disclosure resulting from the publication of B's application will not prejudice A's rights provided that A has already

made an application, or applies within six months of such publication. In any event, having regard to Art. 61, B may not be entitled to proceed with his application (see VI, 9.7 to 9.9).

For "evident abuse" to be established, there must be, on the part of the person disclosing the invention, either actual intent to cause harm or actual or constructive knowledge that harm would or could ensue from this disclosure (see T 585/92, OJ 3/1996, 129).

Art. 55(2)  
Rule 23

8.4 In instance (ii), application must be made within six months of the disclosure of the invention at the exhibition if the display is not to prejudice the application. Furthermore the applicant must state, at the time of filing the application, that the invention has been so displayed, and must also file a supporting certificate within four months, giving the particulars required by Rule 23.

### 9. Inventive step

Art. 56

9.1 "An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art." Novelty and inventive step are different criteria. Novelty exists if there is any difference between the invention and the known art. The question - Is there inventive step? - only arises if there is novelty.

9.2 The "state of the art" for the purposes of considering inventive step is as defined in Art. 54(2) (see IV, 5); it does not include later published European applications referred to in Art. 54(3). As mentioned in IV, 5.3, "date of filing" in Art. 54(2), means date of priority where appropriate (see Chapter V).

9.3 Thus the question to consider, in relation to any claim defining the invention, is whether at the priority date of that claim, having regard to the art known at the time, it would have been obvious to the person skilled in the art to arrive at something falling within the terms of the claim. If so, the claim is bad for lack of inventive step. The term "obvious" means that which does not go beyond the normal progress of technology but merely follows plainly or logically from the prior art, i.e. something which does not involve the exercise of any skill or ability beyond that to be expected of the person skilled in the art. In considering inventive step, as distinct from novelty (see IV, 7.3), it is fair to construe any published document in the light of subsequent knowledge and to have regard to all the knowledge generally available to the person skilled in the art at the priority date of the claim.

9.3a The invention claimed must normally be considered as a whole. Thus it is not correct as a general rule, in the

case of a combination claim, to argue that the separate features of the combination taken by themselves are known or obvious and that "therefore" the whole subject-matter claimed is obvious. The only exception to this rule is where there is no functional relationship between the features of the combination i.e. where the claim is merely for a juxtaposition of features and not a true combination (see the example at 2.1 of the Annex to this Chapter).

9.4 While the claim should in each case be directed to technical features (and not, for example, merely to an idea), in order to assess whether an inventive step is present it is important for the examiner to bear in mind that there are various ways in which the skilled person may arrive at an invention. An invention may, for example, be based on the following:

(i) The formulation of an idea or of a problem to be solved (the solution being obvious once the problem is clearly stated).

**Example:** the problem of indicating to the driver of a motor vehicle at night the line of the road ahead by using the light from the vehicle itself. As soon as the problem is stated in this form the technical solution, viz. the provision of reflective markings along the road surface, appears simple and obvious. For another example see T 2/83, OJ 6/1984, 265.

(ii) The devising of a solution to a known problem.

**Example:** the problem of permanently marking farm animals such as cows without causing pain to the animals or damage to the hide has existed since farming began. The solution ("freeze-branding") consists in applying the discovery that the hide can be permanently depigmented by freezing.

(iii) The arrival at an insight into the cause of an observed phenomenon (the practical use of this phenomenon then being obvious).

**Example:** the agreeable flavour of butter is found to be caused by minute quantities of a particular compound. As soon as this insight has been arrived at, the technical application comprising adding this compound to margarine is immediately obvious.

Many inventions are of course based on a combination of the above possibilities - e.g. the arrival at an insight and the technical application of that insight may both involve the use of the inventive faculty.

9.5 In identifying the contribution any particular invention makes to the art in order to determine whether there is an inventive step, account should be taken first of what the applicant himself acknowledges in his description and claims to be known. Any such acknowledgement of known art should be regarded by the examiner as being correct unless the applicant states he has made a mistake (see VI, 8.5). However, the further prior art contained in the search report may put the invention in an entirely different perspective from that apparent from reading the applicant's specification by itself (and indeed this cited prior art may cause the applicant voluntarily to amend his claims to redefine his invention before his application comes up for examination). In order to reach a final conclusion as to whether the subject-matter of any claim includes an inventive step it is necessary to determine the difference between the subject-matter of that claim and the prior art and, in considering this matter, the examiner should not proceed solely from the point of view suggested by the form of claim (prior art plus characterising portion - see III, 2).

When assessing inventive step the examiner normally applies the **problem and solution approach**.

In the problem and solution approach there are three main stages:

1. determining the closest prior art,
2. establishing the technical problem to be solved, and
3. considering whether or not the claimed invention, starting from the closest prior art and the technical problem, would have been obvious to the skilled person.

The closest prior art is that combination of features derivable from one single reference that provides the best basis for considering the question of obviousness. The closest prior art may be, for example:

- (i) a known combination in the technical field concerned that discloses technical effects, purpose or intended use, most similar to the claimed invention or
- (ii) that combination which has the greatest number of technical features in common with the invention and capable of performing the function of the invention.

In the second stage one establishes in an objective way the **technical problem** to be solved. To do this, one studies the application (or the patent), the closest prior art, and the difference in terms of features (either structural or functional) between the invention and the closest prior art, and then formulates the technical problem. =

In this context the technical problem means the aim and task of modifying or adapting the closest prior art to provide the technical effects that the invention provides over the closest prior art.

The technical problem derived in this way may not be what the application presents as "the problem". The latter may require to be reformulated, since the objective technical problem is based on objectively established facts, in particular appearing in the prior art revealed in the course of the proceedings, which may be different from the prior art of which the applicant was actually aware at the time the application was filed.

The extent to which such reformulation of the technical problem is possible has to be assessed on the merits of each particular case. As a matter of principle any effect provided by the invention may be used as a basis for the reformulation of the technical problem, as long as said effect is derivable from the application as filed (see T 386/89, not published in OJ). It is also possible to rely on new effects submitted subsequently during the proceedings by the applicant, provided that the skilled person would recognise these effects as implied by or related to the technical problem initially suggested (see 9.10 below and T 184/82, OJ 6/1984, 261).

The expression technical problem should be interpreted broadly; it does not necessarily imply that the solution is a technical improvement over the prior art. Thus the problem could be simply to seek an alternative to a known device or process providing the same or similar effects or which is more cost-effective.

Sometimes the features of a claim provide more than one technical effect, so one can speak of the technical problem as having more than one part or aspect, each corresponding to one of the technical effects. In such cases, each part or aspect generally has to be considered in turn. =

In the third stage the question to be answered is whether there is any teaching in the prior art as a whole that **would** (not simply could, but would) prompt the skilled person, faced with the technical problem, to modify or adapt the closest prior art while taking account of that teaching, thus arriving at something falling within the terms of the claims, and thus achieving what the invention achieves (see IV, 9.3).

9.5a If an independent claim is new and non-obvious, there is no need to investigate the obviousness or non-obviousness of any claims dependent thereon, except in situations where the priority claim for the subject-matter of the dependent claim has to be checked because of



intermediate documents (see V, 2.6.3). Similarly, if a claim to a product is new and non-obvious there is no need to investigate the obviousness of any claims for a process which inevitably results in the manufacture of that product or any claims for a use of that product. In particular, analogy processes are patentable insofar as they provide a novel and inventive product (see T 119/82, OJ 5/1984, 217).

9.6 The person skilled in the art should be presumed to be an ordinary practitioner aware of what was common general knowledge in the art at the relevant date. He should also be presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have had at his disposal the normal means and capacity for routine work and experimentation. If the problem prompts the person skilled in the art to seek its solution in another technical field, the specialist in that field is the person qualified to solve the problem. The assessment of whether the solution involves an inventive step must therefore be based on that specialist's knowledge and ability (see T 32/81, OJ 6/1982, 225). There may be instances where it is more appropriate to think in terms of a group of persons, e.g. a research or production team, than a single person. This may apply e.g. in certain advanced technologies such as computers or telephone systems and in highly specialised processes such as the commercial production of integrated circuits or of complex chemical substances.

9.7 In considering whether there is inventive step (as distinct from novelty (see IV, 7)), it is permissible to combine together the disclosures of two or more documents or parts of documents, different parts of the same document or other pieces of prior art, but only where such combination would have been obvious to the person skilled in the art at the effective priority date of the claim under examination (see T 2/83, OJ 6/1984, 265). In determining whether it would be obvious to combine two or more distinct disclosures, the examiner should have regard to the following:

- (i) Whether the content of the documents is such as to make it likely or unlikely that the person skilled in the art, when concerned with the problem solved by the invention, would combine them - for example, if two disclosures considered as a whole could not in practice be readily combined because of inherent incompatibility in disclosed features essential to the invention, the combining of these disclosures should not normally be regarded as obvious.
- (ii) Whether the documents come from similar, neighbouring or remote technical fields.
- (iii) The combining of two or more parts of the same

document would be obvious if there is a reasonable basis for the skilled person to associate these parts with one another. It would normally be obvious to combine with a prior art document a well-known textbook or standard dictionary; this is only a special case of the general proposition that it is obvious to combine the teaching of one or more documents with the common general knowledge in the art. It would, generally speaking, also be obvious to combine two documents one of which contains a clear and unmistakable reference to the other (for references which are considered an integral part of the disclosure, see 6.1 and 7.1). In determining whether it is permissible to combine a document with an item of prior art made public in some other way, e.g. by use, similar considerations apply.

9.8 The annex to this chapter "Guidance for the assessment of inventive step" gives examples for guidance of circumstances where an invention should be regarded as obvious or where it involves an inventive step. It is to be stressed that these examples are only guides and that the applicable principle in each case is "was it obvious to a person skilled in the art?" Examiners should avoid attempts to fit a particular case into one of these examples where the latter is not clearly applicable. Also, the list is not exhaustive.

9.9 It should be remembered that an invention which at first sight appears obvious might in fact involve an inventive step. Once a new idea has been formulated it can often be shown theoretically how it might be arrived at, starting from something known, by a series of apparently easy steps. The examiner should be wary of ex post facto analysis of this kind. He should always bear in mind that the documents produced in the search have, of necessity, been obtained with foreknowledge of what matter constitutes the alleged invention. In all cases he should attempt to visualise the overall state of the art confronting the skilled man before the applicant's contribution and he should seek to make a "real life" assessment of this and other relevant factors. He should take into account all that is known concerning the background of the invention and give fair weight to relevant arguments or evidence submitted by the applicant. If, for example, an invention is shown to be of considerable technical value, and particularly if it provides a technical advantage which is new and surprising, and this can convincingly be related to one or more of the features included in the claim defining the invention, the examiner should be hesitant in pursuing an objection that such a claim lacks inventive step. The same applies where the invention solves a technical problem which workers in the art have been attempting to solve for a long time, or otherwise fulfils a long-felt need. Commercial success alone is not to be regarded as indicative of inventive step, but evidence of immediate commercial

success when coupled with evidence of a long-felt want is of relevance provided the examiner is satisfied that the success derives from the technical features of the invention and not from other influences (e.g. selling techniques or advertising).

9.10 The relevant arguments and evidence to be considered by the examiner for assessing inventive step may be taken either from the originally filed patent application, or be submitted by the applicant during the subsequent proceedings (see 9.5 above and VI, 5.7, 5.7a, 5.7c and 5.7d).

Care must be taken, however, whenever new effects in support of inventive step are referred to. Such new effects can only be taken into account if they are implied by or at least related to the technical problem initially suggested in the originally filed application (see also 9.5 above, T 386/89, not published in OJ and T 184/82, OJ 6/1984, 261).

Example of such a new effect:

The invention as filed relates to a pharmaceutical composition having a specific activity. At first sight, having regard to the relevant prior art, it would appear that there is a lack of inventive step. Subsequently the applicant submits new evidence which shows that the claimed composition exhibits an unexpected advantage in terms of low toxicity. In this case it is allowable to reformulate the technical problem by including the aspect of toxicity, since pharmaceutical activity and toxicity are related in the sense that the skilled person would always contemplate the two aspects together.

The reformulation of the technical problem may or may not give rise to an amendment, and subsequent insertion, of the statement of the technical problem in the description. Any such amendment is only allowable if it satisfies the conditions listed in VI, 5.7c. In the above example of a pharmaceutical composition, neither the reformulated problem nor the information on toxicity could be introduced into the description without infringing Art. 123(2).

**Guidance for the assessment of inventive step****1. Application of known measures?**

1.1 Inventions involving the application of known measures in an obvious way and in respect of which an inventive step is therefore to be ruled out:

(i) The teaching of a prior document is incomplete and at least one of the possible ways of "filling the gap" which would naturally or readily occur to the skilled person results in the invention.

**Example:** The invention relates to a building structure made from aluminium. A prior document discloses the same structure and says that it is of light-weight material but fails to mention the use of aluminium.

(ii) The invention differs from the known art merely in the use of well-known equivalents (mechanical, electrical or chemical).

**Example:** The invention relates to a pump which differs from a known pump solely in that its motive power is provided by a hydraulic motor instead of an electric motor.

(iii) The invention consists merely in a new use of a well-known material employing the known properties of that material.

**Example:** Washing composition containing as detergent a known compound having the known property of lowering the surface tension of water, this property being known to be an essential one for detergents.

(iv) The invention consists in the substitution in a known device of a recently developed material whose properties make it plainly suitable for that use ("analogous substitution").

**Example:** An electric cable comprises a polyethylene sheath bonded to a metallic shield by an adhesive. The invention lies in the use of a particularly newly developed adhesive known to be suitable for polymer-metal bonding.

(v) The invention consists merely in the use of a known technique in a closely analogous situation ("analogous use").

**Example:** The invention resides in the application of a pulse control technique to the electric motor driving the auxiliary mechanisms of an industrial truck, such as a fork-lift truck, the use of this technique to control the electric propulsion motor of the truck being already known.

1.2 Inventions involving the application of known measures in a non-obvious way and in respect of which an inventive step is therefore to be recognised:

(i) A known working method or means when used for a different purpose involves a new, surprising effect.

**Example:** It is known that high frequency power can be used in inductive butt welding. It should therefore be obvious that high-frequency power could also be used in conductive butt welding with similar effect; an inventive step would exist in this case, however, if high-frequency power were used for the continuous conductive butt welding of coiled strip but without removing scale (such scale removal being on the face of it necessary in order to avoid arcing between the welding contact and the strip). The unexpected additional effect is that scale removal is found to be unnecessary because at high frequency the current is supplied in a predominantly capacitive manner via the scale which forms a dielectric.

- (ii) A new use of a known device or material involves overcoming technical difficulties not resolvable by routine techniques.

**Example:** The invention relates to a device for supporting and controlling the rise and fall of gas holders, enabling the previously employed external guiding framework to be dispensed with. A similar device was known for supporting floating docks or pontoons but practical difficulties not encountered in the known applications needed to be overcome in applying the device to a gas holder.

## 2. Obvious combination of features?

### 2.1 Obvious and consequently non-inventive combination of features:

The invention consists merely in the juxtaposition or association of known devices or processes functioning in their normal way and not producing any non-obvious working inter-relationship.

**Example:** Machine for producing sausages consists of a known mincing machine and a known filling machine disposed side by side.

### 2.2 Not obvious and consequently inventive combination of features:

The combined features mutually support each other in their effects to such an extent that a new technical result is achieved. It is irrelevant whether each individual feature is fully or partly known by itself.

**Example:** A mixture of medicines consists of a painkiller (analgesic) and a tranquiliser (sedative). It was found that through the addition of the tranquiliser, which intrinsically appeared to have no pain-killing effect, the analgesic effect of the pain-killer was intensified in a way which could not have been predicted from the known properties of the active substances.

## 3. Obvious selection?

### 3.1 Obvious and consequently non-inventive selection among a number of known possibilities:

- (i) The invention consists merely in choosing from a number of equally likely alternatives.

**Example:** The invention relates to a known chemical process in which it is known to supply heat electrically to the reaction mixture. There are a

number of well-known alternative ways of so supplying the heat, and the invention resides merely in the choice of one alternative.

- (ii) The invention resides in the choice of particular dimensions, temperature ranges or other parameters from a limited range of possibilities, and it is clear that these parameters could be arrived at by routine trial and error or by the application of normal design procedures.

**Example:** The invention relates to a process for carrying out a known reaction and is characterised by a specified rate of flow of an inert gas. The prescribed rates are merely those which would necessarily be arrived at by the skilled practitioner.

- (iii) The invention can be arrived at merely by a simple extrapolation in a straightforward way from the known art.

**Example:** The invention is characterised by the use of a specified minimum content of a substance X in a preparation Y in order to improve its thermal stability, and this characterising feature can be derived merely by extrapolation on a straightline graph, obtainable from the known art, relating thermal stability to the content of substance X.

- (iv) The invention consists merely in selecting particular chemical compounds or compositions (including alloys) from a broad field.

**Example:** The prior art includes disclosure of a chemical compound characterised by a specified structure including a substituent group designated "R". This substituent "R" is defined so as to embrace entire ranges of broadly-defined radical groups such as all alkyl or aryl radicals either unsubstituted or substituted by halogen and/or hydroxy, although for practical reasons only a very small number of specific examples are given. The invention consists in the selection of a particular radical or particular group of radicals from amongst those referred to, as the substituent "R" (the selected radical or group of radicals not being specifically disclosed in the prior art document since the question would then be one of lack of novelty rather than obviousness). The resulting compounds

(a) are not described as having, nor shown to possess, any advantageous properties not possessed by the prior art examples; or

(b) are described as possessing advantageous properties compared with the compounds specifically referred to in the prior art but these properties are ones which the person skilled in the art would expect such compounds to possess, so that he is likely to be led to make this selection.

### 3.2 Not obvious and consequently inventive selection among a number of known possibilities:

- (i) The invention involves special selection in a process of particular operating conditions (e.g. temperature and pressure) within a known range, such selection producing unexpected effects in the operation of the process or the properties of the resulting product.

**Example:** In a process where substance A and substance B are transformed at high temperature into substance C, it was known that there is in general a constantly increased yield of substance C as the temperature increases in the range between 50 and 130 °C. It is now found that in the temperature range from 63 to 65 °C, which previously had not been explored, the yield of substance C was considerably higher than expected.

- (ii) The invention consists in selecting particular chemical compounds or compositions (including alloys) from a broad field, such compounds or compositions having unexpected advantages.

**Example:** In the example of a substituted chemical compound given at (iv) under 3.2 above, the invention again resides in the selection of the substituent radical "R" from the total field of possibilities defined in the prior disclosure. In this case, however, not only does the selection embrace a particular area of the possible field, and result in compounds that can be shown to possess advantageous properties (see IV, 9.10 and VI, 5.7a) but there are no indications which would lead the person skilled in the art to this particular selection rather than any other in order to achieve the advantageous properties.

#### 4. Overcoming a technical prejudice?

As a general rule, there is an inventive step if the prior art leads the person skilled in the art away from the procedure proposed by the invention. This applies in particular when the skilled person would not even consider carrying out experiments to determine whether these were alternatives to the known way of overcoming a real or imagined technical obstacle.

**Example:** Drinks containing carbon dioxide are, after being sterilised, bottled while hot in sterilised bottles. The general opinion is that immediately after withdrawal of the bottle from the filling device the bottled drink must be automatically shielded from the outside air so as to prevent the bottled drink from spurting out. A process involving the same steps but in which no precautions are taken to shield the drink from the outside air (because none are in fact necessary) would therefore be inventive.

**CHAPTER V**

## PRIORITY

**1. The right to priority**

1.1 A European application is accorded as its date of filing the date on which it satisfies the requirements of Art. 80, or, if filed under the PCT, the date on which it satisfies PCT Art. 11. This date remains unchanged except in the special circumstances of late-filed drawings provided for in Art. 91(6) and PCT Art. 14(2)

The date of filing may be the only effective date of the application. It will be of importance for fixing the expiry of certain time limits (e.g. the date by which the designation of the inventor must be filed under Art. 91(5)), for determining the state of the art relevant to the novelty or obviousness of the subject-matter of the application, and for determining, in accordance with Art. 60(2), which of two or more European applications from independent persons for the same invention is to proceed to grant.

Art. 89

1.2 However, in many cases, a European application will claim the right of priority of the date of filing of an earlier application. In such cases, it is the priority date (i.e. the date of filing of the earlier application) which becomes the effective date for the purposes mentioned in the preceding paragraph.

Art. 87(1)  
Art. 87(5)

1.3 For a valid claim to priority, the following conditions must be satisfied: the earlier application whose priority is claimed must have been made by the applicant of the European application or his predecessor in title; this prior application must have been the "first application" filed in respect of the same invention as the one to which the European application relates (see V, 1.4 and 1.4a); it must have been filed not more than 12 months before the filing date of the European application; and it must have been made in or for a Member State of the Paris Convention or in a State which has concluded an equivalent bilateral or multilateral agreement with the Office (see the list in the annex to A-III).

Art. 87(2)  
Art. 87(3)

The words "in or for" any Paris Union State mean that priority may be claimed of an earlier national application, European application or PCT application. If the earlier application was filed in or for an EPC Contracting State, this State may also be designated in the European application. The earlier application may be for a patent or for the registration of a utility model or for a utility certificate or for an inventor's certificate. So long as the contents of the application were sufficient to establish a filing date, it can be used to create a priority date, no matter what the



outcome of the application may later be; for example, it may subsequently be abandoned or refused.

1.4 Normally (except as explained in V, 1.4a) the filing date of the "first application" must be claimed as a priority, i.e. the application disclosing for the first time any or all of the subject-matter of the European application. If it is found that the application to which the priority claim is directed is in fact not the first application in the above sense, but some or all of the subject-matter was disclosed in a still earlier application originating from the same inventor, the priority claim is invalid as far as the subject-matter was already disclosed in the still earlier application.

To the extent the priority claim is invalid, the effective date of the European application is the date of its filing. The previously disclosed subject-matter of the European application is not novel, if the still earlier application referred to above was published prior to the effective date of the European application (Art. 54(2)) or if the still earlier application is also a European application which was published on or after the effective date of the European application in question (Art. 54(3)) as far as the designation fees for the same Contracting States have been validly paid (Art. 54(4) in conjunction with Rule 23a).

Art. 87(4)

1.4a A subsequent application for the same subject-matter and filed in or for the same State shall be considered as the first application for priority purposes if, at the date this subsequent application was filed, the first application had been withdrawn, abandoned or refused, without being open to public inspection and without leaving any rights outstanding, and had not served as a basis for claiming priority. The Office will not consider this question unless there is evidence of the existence of an earlier application as, for example, in the case of a United States continuation-in-part application. Where it is clear that an earlier application for the same subject-matter exists, and where the priority right is important because of intervening prior art (see V, 2.1), the applicant should be required to establish by evidence from an appropriate authority (normally a national patent office) that there were no rights outstanding in the earlier application in respect of the subject-matter of the application being examined.

Art. 88(2)

Art. 88(3)

1.5 "Multiple priorities may be claimed" - i.e. a European application may claim rights of priority based on more than one earlier application. The earlier application may have been filed in or for the same or different States, but in all cases the earliest application must have been filed not more than 12 months before the date of filing of the European application. An element of a European application will be accorded the priority date of the earliest priority application which discloses it. If, for instance, the European application describes and claims two embodiments

(A and B) of an invention, A being disclosed in a French application and B in a German application, both filed within the preceding 12 months, the priority dates of both the French and German applications may be claimed for the appropriate parts of the European application; embodiment A will have the French priority date, and embodiment B the German priority date, as effective dates. If embodiments A and B are claimed as alternatives in one claim, these alternatives will likewise have the different priority dates as effective dates. If, on the other hand, a European application is based on one earlier application disclosing a feature C and a second earlier application disclosing a feature D, neither disclosing the combination of C and D, a claim to that combination will be entitled only to the date of filing of the European application itself. In other words, it is not permitted to mosaic priority documents. An exception might arise where one priority document contains a reference to the other and explicitly states that features from the two documents can be combined in a particular manner.

## 2. Determining priority dates

2.1 As a general rule, the examiner should not make any investigation as to the validity of a right to priority. However, the priority right assumes importance if prior art has to be taken into account, which has been made available to the public within the meaning of Art. 54(2), on or after the priority date claimed and before the date of filing (e.g. an intermediate document, see IV, 5.3) or if the content of the European patent application is totally or partially identical with the content of another European application within the meaning of Art. 54(3), such other application claiming a priority date within that period and definitively designating one or more of the same States by confirming the designation through payment of the relevant designation fees (see IV, 6.1a). In such cases, (i.e. cases where the art in question would be relevant if of earlier date) the examiner must investigate whether the priority date(s) claimed may be accorded to the appropriate parts of the application he is examining and should inform the applicant of the outcome and whether, in consequence, the particular prior art under consideration, e.g. the intermediate document, or the other European application forms part of the state of the art within the meaning of Art. 54. Also, in the case of possible conflict with another European application under Art. 54(3), it may be necessary in addition to allocate priority dates to the appropriate parts of that other application and to communicate this to the applicant analogously.

Art. 88(4)

2.2 When the examiner needs to consider the question of priority date, he should bear in mind all the matters which are mentioned in V, 1.3 to 1.5 above. He should also remember that, to establish a priority date, it is not neces-

sary that the elements of the invention for which priority is claimed should be found among any claims in the previous application. It is sufficient that the documents of the previous application taken as a whole "specifically disclose" such elements. The description and any claims or drawings of the previous application should, therefore, be considered as a whole in deciding this question, except that account should not be taken of subject-matter found solely in that part of the description referring to prior art, or in an explicit disclaimer.

2.3 The requirement that the disclosure must be specific means that it is not sufficient if the elements in question are merely referred to in broad and general terms. A claim to a detailed embodiment of a certain feature would not be entitled to priority on the basis of a mere general reference to that feature in a priority document. Exact correspondence is not required, however. It is enough that, on a reasonable assessment, there is in substance a disclosure of all the elements of the claim.

2.4 The basic test to determine whether a claim is entitled to the date of a priority document is the same as the test of whether an amendment to an application satisfies the requirement of Art. 123(2) (see VI, 5.4). That is to say for the priority date to be allowed, the subject-matter of the claim must be derivable directly and unambiguously from the disclosure of the invention in the priority document, when account is taken of any features implicit to a person skilled in the art in what is expressly mentioned in the document. As an example of an implicit disclosure, a claim to apparatus including "releasable fastening means" would be entitled to the priority date of a disclosure of that apparatus in which the relevant fastening element was, say, a nut and bolt, or a spring catch or a toggle-operated latch, provided the general concept of "releasable" is implicit in the disclosure of such element.

2.5 If the tests set out in V, 2.2 to 2.4 are not satisfied in relation to a particular earlier application, then the effective date of the claim (or one of the embodiments claimed) will either be the filing date of the earliest application which does provide the required disclosure and of which the priority is validly claimed (see G 3/93, OJ 1-2/1995, 18) or, in the absence of such, will be the date of filing of the European application itself (or the new date of filing if the application has been re-dated under Art. 91(6)).

2.6 Some examples of determining priority dates

**Note:** the dates used are merely illustrative; they do not take account of the fact that the filing offices of the EPO are closed on weekends and certain public holidays.

2.6.1 Intermediate publication of the contents of the priority application:

P is the application from which priority is claimed by EP, D is the disclosure of the subject-matter of P.

1.1.90	1.5.90	1.6.90
filing	publication	filing
P	D	EP

D is state of the art under Art. 54(2) when the priority claim of P is not valid.

2.6.2 Intermediate publication of another European application:

P1 is the application from which priority is claimed by EP1, P2 the one from which EP2 claims priority. EP1 and EP2 are filed by different applicants.

1.2.89	1.1.90	1.2.90	1.8.90	1.1.91
filing	filing	filing	publication	filing
P1	P2	EP1	EP1	EP2
A + B	A + B	A + B	A + B	A + B

EP1 is state of the art under Art. 54(3) when the respective priority claims of P1 and P2 are valid. This does not change if the publication of EP1 takes place after the filing date of EP2.

The publication of EP1 is state of the art under Art. 54(2) if the priority claim of P2 is not valid.

2.6.3 Multiple priorities claimed for different inventions in the application with an intermediate publication of one of the inventions.

EP claims priority of P1 and P2, D is the disclosure of A+B.

1.1.90	1.2.90	1.3.90	1.6.90
filing	publication	filing	filing
P1	D	P2	EP
A + B	A + B	A + B + C	claim 1: A + B claim 2: A + B + C

Claim 1 has a valid priority of P1 for its subject-matter, thus publication D is not state of the art under Art. 54(2) against this claim. Claim 2 cannot benefit from the priority of P1, as it does not concern the same subject-matter. Thus publication D is state of the art under Art. 54(2) for this claim (see G 3/93, OJ 1-2/1995, 18). It is immaterial whether claim 2 is in the form of a dependent or an independent claim.

2.6.4 A situation in which it has to be checked whether the application from which priority is actually claimed is the "first application" in the sense of Art. 87(1):

P1 is the earliest application of the same applicant containing the invention. EP claims the priority of the later US-application P2, which is a "continuation-in-part" of P1. D is a public disclosure of A+B.

1.7.89	1.1.90	1.6.90	1.12.90
filing	filing	publication	filing
P1	P2 (cip)	D	EP
A + B	A + B	A + B	claim 1: A + B
	A + B + C		claim 2: A + B + C

The priority claim of P2 for claim 1 is not valid as P2 is not the "first application" for this subject-matter in the sense of Art. 87(1), but P1, which has "left rights outstanding" in that P2 is a "continuation-in-part" thereof. Therefore Art. 87(4) does not apply and this is not altered by an abandonment, withdrawal, refusal or non-publication of P1.

D is prior art pursuant to Art. 54(2) against claim 1, but not against claim 2, as the latter claim has the earlier priority of P2.

### 3. Claiming priority

Art. 88(1)  
Rule 38(1)

3.1 An applicant who wishes to claim priority must file a declaration of priority giving particulars of the previous filing, as specified in Rule 38(1), together with a certified copy of the previous application, and if necessary a translation of it into one of the official languages of the Office.

Rule 38(2)  
Rule 38(3)

3.2 The date and State of any filing from which priority is claimed must be stated at the time of filing the European application and the file number of the priority application must be indicated within 16 months of the priority date. The certified copy of the priority document must be filed also within 16 months of the priority date (see also A-III, 6.7 and A-VII, 3.5).

Rule 38(3)

In accordance with Rule 38(3), third sentence, and the decision of the President of the EPO dated 22 December 1998 (OJ 2/1999, 80), the EPO will include a copy of the previous application in the file of the European patent application without charging a fee, if the previous application is:

- (i) a European patent application,
- (ii) an international application filed with the EPO as receiving Office under the PCT,
- (iii) a Japanese patent or utility model application, or
- (iv) an international application filed with the Japanese Patent Office as receiving Office under the PCT.

No request is necessary to this end.

Art. 88(1)  
Rule 38(4)

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed within the time limit set by the EPO, but at the latest within the non-extendable time limit laid down in Rule 51(6). Alternatively a declaration that the European patent application is a complete translation of the previous application may be submitted within those same time limits. If this is not the case, or if the European application contains more or less text than is contained in the earlier application as filed, such a declaration cannot be accepted and a complete translation must be filed. A merely different arrangement of the various elements (i.e. the claims vs. the description) of the application does not affect the validity of such a declaration.

In the communication under Rule 51(6) the EPO will request the applicant to file the required translation or declaration. It will do so earlier only if the translation is required for the examination as to whether the priority claimed is effective (see V, 2.1).

3.3 If the required translation or declaration is not filed within the time limit, the right of priority is lost for the European patent application (see A-III, 6.10 and 6.11). However, for reasons of legal certainty the right of priority remains effective for determining the state of the art for the purposes of Art. 54(3) (see V, 2.1 and 3.4) in respect of any other European patent application. In that respect it is immaterial whether the translation or declaration has been filed, as changes taking effect after the date of publication do not affect the application of Art. 54(3).

3.4 An applicant may voluntarily abandon a claimed priority at any time. If he does so before the technical preparations for publication have been completed, then the priority date is not effective and the publication is deferred until 18 months after the filing date. If it is abandoned after the technical preparations for publication have been completed, then the application is still published 18 months after the priority date originally claimed (see A-VI, 1.1 and C-IV, 6.1a).

**CHAPTER VI****EXAMINATION PROCEDURE**

This chapter sets out the general procedure for examination, together with guidance on particular matters where necessary. It does not provide detailed instructions on matters of internal administration.

**1. The start of the examination**

Art. 94  
Rule 85b  
Art. 2, No. 7  
RFees  
Art. 94(3)  
Art. 122(5)

1.1 In order that examination of a European application can begin, the applicant is required to file a request for examination, which, however, is not deemed to be filed until after a written request has been made and the examination fee has been paid. The request for examination may be filed from the date on which the application is filed up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. If the request for examination has not been filed within the time limit it may still be validly filed within a period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within the period of grace a surcharge is paid. If the request for examination is not filed in due time, the application is deemed to be withdrawn. Re-establishment of rights in respect of the time limit for filing the request for examination pursuant to Art. 94(2) is not possible (see also 1.1.4).

Art. 96(1)  
Art. 96(3)  
Art. 121  
Art. 122  
Art. 10b RFees

1.1.1 If the applicant has filed a request for examination before the search report has been transmitted to him, the EPO will invite him to confirm, within the six-month period, that he desires to proceed further with his application. If the applicant fails to reply in due time to this invitation, the application will be deemed to be withdrawn. In this case, however, the means of redress provided for in Art. 121 (Further processing of the application) and in Art. 122 (Restitutio in integrum) will apply. The examination fee is refunded in full if the application is withdrawn or refused or is deemed to be withdrawn before the responsibility for the procedure passes to the Examining Division (see VI, 1.2).

Art. 96(1)  
Art. 18(1)  
Art. 10b RFees

1.1.2 Where the applicant files a request for examination before the search report is transmitted to him, he may also dispense with the need to comply with the invitation pursuant to Art. 96(1), and file a categorical request for examination whatever the result of the search may be, by which the procedure can also be accelerated (see Notice of the President of the EPO, OJ 7/1997, 340 and see E-VIII, 3). In this case, confirmation that he desires to proceed further with his application is deemed to be given when the search report is transmitted to him. It is also at this stage that responsibility for the procedure passes to the Examining Division. If the European patent application

is subsequently withdrawn before the substantive examination has begun, 75% of the examination fee will be refunded.

Art. 157(1)  
Art. 150(2)  
Art. 157(2)  
Art. 158(3)

1.1.3 If the application has proceeded via the PCT (Euro-PCT application), the above mentioned six-month period begins with the publication of the PCT search report or the declaration under Art. 17(2)(a), PCT. However, as is laid down in Art. 150(2) the time limit for requesting examination in a Euro-PCT case does not expire before the time prescribed in Art. 22 and Art. 39 PCT. The time limit will not be affected by whether a supplementary European search pursuant to Art. 157(2) needs to be made or whether the international application pursuant to Art. 158(3), is again published by the EPO.

1.1.4 An applicant who has failed to observe the time limit for filing a request for examination of a Euro-PCT application cannot have his rights re-established, (Decisions G 5/92 and 6/92, OJ 1-2/1994, 22 and 25, contrary to previous decisions of the Legal Board of Appeal).

Rule 25

1.1.5 It is to be noted that whenever the search report has been drawn up to cover several inventions lacking unity, the applicant is free to select the invention to be examined in the application under consideration. The others will be subject to objections of lack of unity, and may then be divided out according to Rule 25 (see III, 7.9 to 7.13).

Art. 18(1)

1.2 The Receiving Section remains responsible until the examination request has been filed, or if it was filed before transmission of the search report, until the applicant has replied, within the period set, to the invitation made under Art. 96(1) to the effect that he intends to continue with the application. When the Receiving Section ceases to be responsible, the dossier relating to the application is passed to the Directorate competent for the examination of the application.

1.3 The dossier will normally be allotted to an Examining Division responsible for the examination of applications in the technical field in which the particular application has been classified by the Search Division or PCT Searching Authority which carried out the search. There may be instances where it is appropriate to allot the application to an Examining Division comprising examiners who are not normally responsible for the indicated part of the IPC. There are a number of possible reasons for this: e.g. when the examination of an application may require very specialist technical knowledge; in order to make it possible, where appropriate, that an original and a divisional application are dealt with by the same Examining Division (this could sometimes be more efficient even when the two applications are classified in different technical fields); or when the classification of the published application does not corre-



spond to the subject-matter of the application in the form in which it reaches the substantive examiner (e.g. because the application has been amended after receipt of the search report).

Art. 18(2)

1.4 An Examining Division will normally consist of three technical examiners. However, within the Examining Division made responsible for the application, one member will, as a general rule, be entrusted to carry out all the work up to the point of a decision to grant a patent or refuse the application. This means that this examiner is entrusted to act on behalf of the Examining Division in all communications with the applicant up to that point, but he may confer informally with the other members of the Division at any time if a special point of doubt or difficulty arises (see VI, 7.1). Where reference is made in this Part of the Guidelines to the "examiner", this normally means the examiner entrusted with the work in this way, and it should be understood that this primary examiner is always acting in the name of the Examining Division.

Art. 79(2)  
Art. 91(1)(e)

1.5 The designation fees, according to Art. 79(2), can be validly paid up to the same time limit as the examination fee and therefore will be generally paid at the same time as the examination fee. Thus the examination whether and to what extent the designation fees have been validly paid will normally fall in the competence of the Examining Division, the Receiving Section no longer being competent (Art. 18(1)). The same applies to the examination as to whether extension fees have been paid, see A-III, 13.2. This task has been entrusted to the formalities officer by virtue of Rule 9(3), see point 1 of the Notice of the Vice-President of the Directorate-General for Examination and Opposition of 15.6.1984, OJ 7/1984, 317 as amended on 1.2.1989, OJ 5/1989, 178.

## 2. Examination procedure in general

Art. 94

2.1 The purpose of the examination is to ensure that the application and the invention to which it relates, meet the requirements set out in the relevant Articles of the Convention and Rules of the Implementing Regulations. The prime task of the Examining Division is to deal with the substantive requirements; the criteria by which an examiner shall judge whether they have been met, are dealt with in detail, in so far as appears necessary, in the other Chapters of this Part of the Guidelines. As for the formal requirements (see Part A), these are initially the responsibility of the Receiving Section. As soon as the application has passed to the Examining Division, that Division will have ultimate responsibility, but formal matters will normally be dealt with by a formalities officer. The examiner should not spend time checking the work done by the Receiving Section or this formalities officer, but if he believes a formalities report

is incorrect or incomplete he should refer the application to the formalities officer for further consideration.

Rule 51(1)

2.2 The examination is to be carried out in accordance with Art. 96(2) and (3), Art. 97, Rule 51(2) to (11) and Rule 52. The examiner's first step is to study the description, drawings (if any) and the claims of the application. In carrying out his task, the examiner will have in the dossier the documents making up the European application and a complete history of the proceedings up to the start of the examination. In particular, this dossier will include the request for grant; description, drawings (if any) and the claims as originally filed; any amendments proposed to date; the search report with the applicant's comments (if any), and copies of any cited documents; the formalities report from the Receiving Section and the priority documents together with any translations (see V, 3).

2.3 When the examiner has studied and understood the claims (including any amended claims), he should make a search for any additional conflicting European applications falling within the area defined by Art. 54(3) (see VI, 8.4).

Rule 51(3)  
Rule 84  
Art. 96(2)  
Rule 51(2)

2.4 Taking into account the documents (if any) cited in the search report and any further documents found as the result of the search referred to in VI, 2.3 above, and taking account also of any amendments that may have been proposed, or comments made, by the applicant, the examiner should identify any requirements of the Convention and Implementing Regulations which, in his opinion, the application does not satisfy. He will then write to the applicant giving reasons for any objections he raises and inviting the applicant within a specified period to file his observations or submit amendments. The filed application documents are not sent back to the applicant although a copy of the description and claims may be sent in appropriate cases (see E-II). When the applicant has replied, the examiner will then re-examine the application.

Art. 96(2)  
Art. 97  
Rule 68(2)  
Art. 113(1)  
Art. 109  
Art. 111(1)  
Art. 111(2)

2.5 The examiner should be guided at the re-examination stage by the over-riding principle that a final position (grant or refusal) should be reached in as few actions as possible, and he should control the procedure with this always in mind. The Convention provides that the process of communicating with the applicant described in VI, 2.4 shall be repeated "as often as necessary". Nevertheless, if it is clear that the applicant is not making any real effort to deal with the examiner's objections, either by amendments or by counter-arguments, then even at the first re-examination stage the examiner should bring the application before the other members of the Examining Division, who may decide to refuse the application. In any event, at some stage, the examiner will make a short written recommendation to the Division either that the

application should be refused or that a patent should be granted thereon. If the Division intends to refuse the application a written reasoned decision is necessary, and this will normally be prepared by the examiner entrusted with the examination of the application. In preparing the decision, the examiner must take care to abide by the general principles set out in Art. 113, i.e. the decision must be based on grounds or evidence on which the applicant has had the opportunity to comment. If the applicant appeals against the decision, and the Examining Division considers in the light of the applicant's statement, that the appeal is admissible and well-founded, it should rectify its decision accordingly within three months after receipt of the statement of grounds. Otherwise, the appeal will be considered by a Board of Appeal. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the Examining Division for further examination. In such a case, the further examination will normally be entrusted to the examiner who performed the original examination. The Examining Division is bound by the decision of the Board of Appeal.

Rule 51(4)  
Rule 51(6)  
Rule 36(1)  
Rule 51(10)

2.6 If the Examining Division considers that a European patent should be granted, it will first inform the applicant, by the communication under Rule 51(4) of the text in which it intends to grant the patent. In the subsequent communication under Rule 51(6), the applicant is requested to pay the appropriate fees and to file a translation of the claims, meeting the requirements of the Implementing Regulations, into the two official languages of the Office other than the language of the proceedings (see VI, 15.2 and 15.3). If any designated Contracting States require a translation pursuant to Art. 65(1), such States should be indicated. For details of the procedure, see VI, 15.

Art. 97(3)(5)

2.7 If the applicant has fulfilled the requirements set out in VI, 2.6, it is decided that a European patent be granted.

Rule 51(5)

2.8 If, on the other hand, the applicant does not communicate within the time limit given his approval of the text submitted, then the proceedings are continued as set out in VI, 15.1.1 to 15.1.4.

2.9 The stages of this procedure are considered in more detail in the following Sections.

### 3. The first stage of examination

Rule 86(2)  
Rule 51(1)

3.1 Following the receipt of the search report and prior to the examiner's first communication with the applicant, the latter may file comments on the search report and amendments to the description, claims or drawings. These amendments may be submitted to avoid possible objections of lack of novelty or lack of inventive step in view of the citations listed in the search report; or to meet any

objections notified by the Search Division under Rule 45 (i.e. that at least some claims do not permit of a meaningful search) or Rule 46 (i.e. that there is lack of unity of invention); or they may be suggested for some other reason, e.g. to remedy some obscurity which the applicant himself has noted in the original documents.

With a written request for accelerated examination the applicant can speed up the proceedings at the examination stage (see Notice of the President of the EPO, OJ 7/1997, 340 and E-VIII, 3).

Rule 86(2)

3.2 Such amendments are made by the applicant "of his own volition". This means that the applicant is not restricted to amendment necessary to remedy a defect in his application. It does not, however, mean that the applicant is free to amend in any way he chooses. Any amendment must satisfy the following conditions:

Art. 123(2)

(i) It must not add subject-matter to the content of the application as filed (see VI, 5.3 to 5.8b).

(ii) It must not itself cause the application as amended to be objectionable under the Convention, e.g. the amendment must not introduce obscurity.

If the amendments do not meet these conditions, the applicant should be told that the amended application cannot be allowed. Apart from the amendments referred to above, which are allowed under Rule 86(2), the applicant may correct obvious errors at any time (see VI, 5.9).

3.2a The question of unity of invention, if applicable, should be addressed as early as possible. If the applicant has paid additional search fees in response to an invitation of the Search Division under Rule 46 (1) and has requested a refund of these, the Examining Division will have to consider the matter (see also III, 7.9-7.12).

If the applicant has not responded to the above-mentioned invitation of the Search Division to pay a further search fee in respect of certain subject-matter, the Examining Division will review the case. If it considers that the objection of the Search Division was justified, the examination will proceed only for the invention which has been the subject of the search and the applicant will have to limit the application to that subject-matter by excising those parts which relate to the non-searched subject-matter (see Opinion G 2/92, OJ 10/1993, 591). The applicant may however file a divisional application for that subject-matter.

3.2b If the applicant has responded to the above-mentioned invitation to pay additional search fees, he will be invited at the beginning of the substantive examination to state on which invention the prosecution of the application

should be based and to limit the application accordingly by excising those parts belonging to the other inventions. For the latter the applicant may file divisional applications.

3.3 The examiner's first letter under Art. 96(2) should, as a general rule, cover all objections to the application (but see VI, 3.6). These objections may relate to formal matters (e.g. failure to comply with one or more of the requirements specified in Rule 26 to 29, 32, 34, 35 and 36), to substantive matters (e.g. the subject-matter of the application is not patentable), or to both.

3.4 For each objection the letter should indicate the part of the application which is deficient and the requirement of the Convention which is not met, either by referring to specific Articles or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent. For example, where prior art is cited and only part of a cited document is relevant, the particular passage relied upon should be identified. If the cited prior art is such as to demonstrate lack of novelty or inventive step in the independent claim or claims, and if consequently there is lack of unity between dependent claims, the applicant should be warned of this situation (see VI, 5.2(i)). Substantive matters should normally be set out first. The letter should be drafted in such a manner as to facilitate re-examination of the amended application and, in particular, to avoid the need for extensive re-reading (see VI, 4.2).

Rule 51(2)  
Art. 96(2)  
Art. 96(3)

3.5 The letter should include an invitation to the applicant to file his observations, to correct any deficiencies and, if necessary, to submit amendments to the description, claims and drawings. It must also state the period within which the applicant must reply. Failure to reply in due time will cause the application to be deemed withdrawn (see E-VIII, 1).

3.6 It is emphasised that the first sentence of VI, 3.3 only sets out the general rule. There may be cases in which the application is generally deficient. In these cases the examiner should not carry out a detailed examination, but should send a letter to the applicant informing him of this fact, mentioning the major deficiencies and saying that further examination is deferred until these have been removed by amendment; the letter should specify a period within which the deficiencies must be removed. There may be other cases in which, although a meaningful examination is possible, a fundamental objection arises, e.g. it is clear that certain claims lack novelty and that the statement of claim will have to be drastically recast, or there are substantial amendments which are not allowable for one of the reasons stated in VI, 3.2. In such cases it may be more appropriate to deal with this objection before making a detailed examination; if, e.g. the claims need re-casting,

it may be pointless to raise objections to the clarity of some dependent claims or to a passage in the description which may have to be amended or even deleted as a consequence. However, if there are other major objections these should be dealt with. Generally the examiner should at the first examination stage seek to make the maximum impact with the broad aim of bringing matters to a conclusion (grant or refusal, as the case may be), without any undue delay.

## Rule 27(1)(c)

3.7 When making the full examination, the examiner should concentrate on trying to understand what contribution the invention as defined in the claims adds to the known art. This should normally be sufficiently clear from the application as filed. If it is not, the applicant should be required to elucidate the matter (see II, 4.5); but the examiner should not raise an objection of this kind unless he is convinced it is necessary, since to do so might result in the applicant introducing additional subject-matter and thus offending against Art. 123(2) (see VI, 5.3 to 5.8b).

3.8 Although the examiner must bear in mind all the requirements of the Convention and Implementing Regulations, the requirements which are most likely to require attention in the majority of cases are sufficiency of disclosure (see II, 4); clarity, especially of the independent claims (see III, 4); novelty (see IV, 5); and inventive step (see IV, 9).

3.9 The examiner should not require or suggest amendments merely because he thinks they will improve the wording of the description or claims. A pedantic approach is undesirable; what is important is that the meaning of the description and claims should be clear. Also, while any serious inconsistencies between the claims and the description as filed should be objected to (see III, 4.3), if the claims appear to require substantial amendment the examiner should not require the applicant to amend the description as well, merely in order to bring it into conformity with the amended claims, since such consequential amendments are better left until the final form of at least the main claims has been settled.

3.10 It must be emphasised that it is not part of the duty of an examiner to require the applicant to amend the application in a particular way to meet an objection, since the drafting of the application is the applicant's responsibility and he should be free to amend in any way he chooses provided that the amendment removes the deficiency and otherwise satisfies the requirements of the Convention. However, it may sometimes be useful if the examiner suggests at least in general terms an acceptable form of amendment, but if he does so he should make it clear that the suggestion is merely for the assistance of the applicant and that other forms of amendment will be considered.

Rule 86(2)

3.11 Between receipt of the search report and receipt of the first communication from the examiner, the applicant may submit amendments at any time. These amendments may occasionally arrive after despatch of such communication. In such a case the examiner will have to repeat part of his examination to take them into account and, consequently, may have to issue a supplementary or amended report and specify a new period for reply.

#### **4. Further stages of examination**

##### **General procedure**

4.1 Following the examiner's first letter and the applicant's reply, the examiner must re-examine the application taking into account observations or amendments made by the applicant.

4.2 The examiner should apply the same standard of examination in relation to matters of substance at all stages in the processing of an application. However, after the first examination stage, he will not normally need to completely re-read the amended application if he has drafted his first letter in a comprehensive way (see VI, 3.4), but should concentrate on the amendments themselves and any related passages, and on the deficiencies noted in the letter.

4.3 In most cases, the applicant will have made a bona fide attempt to deal with the examiner's objections. In connection with a request for accelerated examination this will aid in bringing the case to an even quicker solution (See Notice of the President of the EPO, OJ 7/1997, 340 and E-VIII, 3). There are then two possibilities to consider. The first is that the examiner, having taken account of the observations of the applicant, considers that there is little prospect of progress towards grant and that the application should be refused. In such a case, the examiner should not refuse immediately but should warn the applicant, e.g. by a telephone conversation or by a short further written action, that the application will be refused unless he can produce further more convincing arguments or makes appropriate amendments within a specified time limit. The second and more usual possibility, however, is that the re-examination shows that there is good prospect of bringing the procedure to a positive conclusion in the form of a grant. In these latter cases, if there are still objections that require to be met, the examiner must consider whether they could best be resolved by a further written action, a telephone discussion or an interview. It should be noted that such discussions or interviews do not constitute oral proceedings (see E-III).

If this re-examination, however, shows that the applicant has not made any real effort to deal with these objections,

the examiner should consider recommending to the other members of the Examining Division that the application be refused immediately. However, this would be an exceptional case.

4.4 If the matters are such that the applicant is likely to require time to consider them, it will probably be preferable to deal with them by means of a written action. If, however, there seems to be confusion about points in dispute, e.g. if the applicant seems to have misunderstood the examiner's argument, or if the applicant's own argument is not clear, then it may expedite matters if the examiner proposes an interview. On the other hand, if the matters to be resolved are minor, or can quickly and easily be explained and dealt with, then they might be settled more expeditiously by telephone discussion. Discussion with the applicant or his authorised representative at an interview or by telephone is more fully considered in VI, 6.

The examiner, with the communication under Rule 51(4), should only propose such substantive amendments as he can reasonably expect the applicant to accept.

4.5 Similar considerations apply to later stages of re-examination except that, having regard to the principle stated in VI, 2.5, the greater the number of actions which have already taken place, the greater is the likelihood that the most appropriate action is to refer the application to the other members of the Examining Division for a final decision.

Art. 113(1) 4.5a Where the final decision is to refuse the application, care should be taken that the decision does not offend against Art. 113(1).

#### **Examination of amendments**

Rule 86(2) 4.6 Any amendment must satisfy the conditions listed in VI, 3.2. When it was effected must also be established. After receiving the European search report and before receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend the description, claims and drawings.

Rule 86(3)  
Rule 51(2) 4.7 After receipt of the first communication from the examiner, the applicant may "of his own volition, amend once the description, claims and drawings" provided that the amendment is filed at the same time as his reply. After replying to the first communication the applicant may amend only if the examiner consents to the amendments proposed. Giving the Examining Division this discretion is intended to ensure that the examination procedure is brought to a conclusion in as few actions as possible (see VI, 2.5). If an amendment is allowed, subsequent proceedings are based on the description, claims and drawings as



amended. Consent to an amendment does not necessarily imply that the application as amended is free from any objection under the Convention. Distinctions should be drawn between different types of amendments:

Art. 96(2)

Amendments remedying a deficiency in response to the preceding communication must always be allowed, provided they do not give rise to some new deficiency. Amendments limiting a claim already considered allowable should normally be allowed, as too should those improving the clarity of the description or claims in a manner clearly desirable.

A further factor is the amount of alteration to the application documents involved. Extensive reworking of the description or claims may be a proper response to highly relevant further prior art of which the applicant has only just become aware (e.g. either through further citation by the examiner or through knowledge obtained from another source). Regarding less extensive amendments, the examiner should adopt a reasonable approach, trying to balance fairness to the applicant against the need to avoid unnecessary delay and excessive and unjustified additional work for the EPO. Any subsequent request to withdraw an amendment is itself a request for further amendment; thus, if this subsequent request occurs after reply to the first communication from the examiner, it will be allowed only if the examiner consents. In exercising his discretion under Rule 86(3), the examiner should bear in mind the length of the proceedings to date and whether the applicant has already had sufficient opportunity for amendments. He should refuse in particular amendments reintroducing deficiencies previously pointed out to and removed by the applicant.

In deleting subject-matter from an application the applicant should avoid any statement which could be interpreted as abandonment of that subject-matter. Otherwise the subject-matter cannot be reinstated.

4.8 Any request by an applicant to replace the text of the application on whose basis a patent could be granted, with one that has been extensively revised should be refused, unless the applicant gives good reasons for proposing the changes only at this stage in the proceedings. This applies particularly in cases where the Examining Division has indicated that version of the claims proposed by the applicant is grantable and that the applicant has only to bring the description into line with that version.

Rule 51(4)  
Rule 86(3)

4.9 The communication under Rule 51(4) does not constitute an opportunity for the applicant to call into question the outcome of the earlier procedure (see VI, 15 for procedure upon grant). At this stage of the proceedings the substantive examination has already been completed

and the applicant has had the opportunity to amend the application and therefore normally only those amendments which do not appreciably delay the preparations for grant of the patent will be allowed under Rule 86(3). It is, however, appropriate to allow separate sets of claims for one or more designated states that have made a reservation under Art. 167(2) or for which prior national rights exist (see III, 8.3 and 8.4).

If the applicant approves without delay the text in which it is intended to grant the patent and does not request further amendments to the application, the procedure up to actual grant of the European patent can be shortened considerably, as the Rule 51 (6) communication can then be issued without waiting until expiry of the period set under Rule 51 (4) (see Notice of the President of the EPO, OJ 7/1997, 340 and E-VIII, 3 and VI, 15.1.1).

Rule 86(2)

If no other Examining Division communication has preceded that under Rule 51(4) the latter is a "first communication" within the meaning of Rule 86(3). This means that the applicant may amend the description, claims and drawings of his own volition (see VI, 3.2 for which amendments are allowable and which not).

Rule 89

4.10 After receipt of the applicant's approval to the text communicated to him pursuant to Rule 51(4), the communication under Rule 51(6) is sent out immediately, without waiting until expiry of the period under Rule 51(4). Amendments received after issue of the communication under Rule 51(6) will only exceptionally be allowed under the discretionary power of the Examining Division given by Rule 86(3). A clear example is where the applicant requests separate sets of claims for designated states that have made reservations under Art. 167(2), or for which prior national rights exist (see III, 8.3 and 8.4). Similarly it is appropriate to allow minor amendments which do not require re-opening of the substantive examination and which do not appreciably delay the issue of the decision to grant (see Decision G 7/93, OJ 11/1994, 775).

However, once the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant (see Decision G 12/91, OJ 5/1994, 285), the Examining Division is bound by it and can only amend it to the limited extent provided for in Rule 89 (cf. E-X, 10).

4.11 Paragraphs 4.9 and 4.10 above do not prevent the Examining Division from resuming the proceedings of its own motion where it becomes aware of circumstances which are such as to render non-patentable the subject-matter claimed. Such circumstances may be brought to the Examining Division's attention by the applicant or following observations by third parties under Art. 115 and can be considered up to the moment the decision is handed over

to the EPO's internal postal service. In the resumed proceedings, substantive amendments to resolve this problem are possible. Where this leads to a version which meets the requirements of the EPC, a second communication under Rule 51 (4) is issued, and 4.8 and 4.9 above apply again.

Rule 86(3)

4.12 If a request for amendment is to be refused under Rule 86(3), the applicant must first in compliance with Art. 113(1) be sent a communication giving the reasons for refusing the amendment. In the case of a situation as described in VI, 4.10 the applicant should be invited at the same time to request grant of the patent on the basis of the preceding acceptable version of the documents. If the applicant maintains his request for the amendment, the application must be refused under Art. 97(1) since, in these circumstances, there is no text of the application which has been agreed by the applicant and allowed by the Examining Division (Art. 113(2)).

## 5. Amendments

### Making the amendments

5.1 The general considerations relating to the technique of making amendments are set out in E-II.

### Allowability of amendments

5.2 The question of allowability of amendments is legally a question of whether the application as so amended is allowable. An amended application must of course satisfy all the requirements of the Convention including, in particular, inventive step and the other matters listed in VI, 3.8 (see also VI, 3.2). Also, however, especially when the claims have been substantially limited, the examiner should bear in mind that the following questions may require special consideration at the amendment stage:

(i) **Unity of invention:** Do the amended claims still satisfy the requirements of Art. 82? If the search report seems to reveal lack of novelty or inventive step in the concept common to all the claims, but the amended claims do not necessitate further search, the examiner should consider carefully whether objection to lack of unity is justified at this stage of the proceedings (see III, 7.7). If, however, the claims lack a common inventive concept and a further search is necessary, objection should be raised.

Rule 86(4)

(ii) **Changing to unsearched subject-matter:** If amended claims are directed to subject-matter which has not been searched (e.g. because it only appeared in the description and the Search Division did not find it appropriate to extend the search to this subject-matter, see B-III, 3.6) and which does not combine with the originally

claimed and searched invention or group of inventions to form a single general inventive concept, such amendments are not admissible. This applies particularly when this -unsearched- subject-matter alone is now claimed. Thus, if the original application did not originally disclose the subject-matter of the amended claim in a form which is unitary with the subject-matter of the original claims, an objection under Rule 86(4) should be raised. The applicant may continue to pursue such subject-matter only in the form of a divisional application, in accordance with Art. 76. If no such objection is raised the Examining Division should consider requesting an additional search (see VI, 8.5 and 8.8).

However, applicants should bear in mind that the examining procedure should be brought to a conclusion in as few actions as possible, thus the Examining Division may exercise its right to not allow further amendments under Rule 86(3) when further amendments are filed (see VI, 4.7).

(iii) **Agreement of description and claims:** If the claims have been amended, will the description require corresponding amendment to remove serious inconsistency between them? Is e.g. every embodiment of the invention described still within the scope of one or more claims? (see III, 4.3). Conversely are all of the amended claims supported by the description? (see III, 6). Also, if the categories of claims have been altered, will the title require corresponding amendment? It is important also to ensure that no amendment adds to the content of the application as filed and thus offends against Art. 123(2) as explained in the following paragraphs.

#### **Additional subject-matter**

Art. 123(2)

5.3 There is normally no objection to an applicant introducing, by amendment, further information regarding prior art which is relevant; indeed this may be required by the examiner (see II, 4.4 and 4.18). Nor will the straight-forward clarification of an obscurity, or the resolution of an inconsistency, be objected to. When, however, the applicant seeks to amend the description (other than references to the prior art), the drawings, or the claims in such a way that subject-matter which extends beyond the content of the application as filed is thereby introduced, the application as so amended cannot be allowed.

5.4 An amendment should be regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previ-

ously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art. At least where the amendment is by way of addition, the test corresponds to the test for novelty given in IV, 7.2 (see T 201/83, OJ 10/1984, 481).

Under Art. 123(2) it is impermissible to add to a European application matter present only in the priority document for that application (see T 260/85, OJ 4/1989, 105). For correction of errors see VI, 5.9.

5.5 For example, if an application related to a rubber composition comprising several ingredients and the applicant seeks to introduce the information that a further ingredient might be added, then this amendment should normally be objected to as offending against Art. 123(2). Likewise, in an application which described and claimed apparatus "mounted on resilient supports", without disclosing any particular kind of resilient support, objection should be raised if the applicant seeks to add the specific information that the supports are, or could be, e.g. helical springs (see, however, VI, 5.6).

5.6 If, however, the applicant can show convincingly that the subject-matter in question would, in the context of the invention, be so well-known to the person skilled in the art that its introduction could be regarded as an obvious clarification, the amendment may be permitted. For example, in the matter of the rubber composition referred to in VI, 5.5, if the applicant were able to show that the further ingredient which he sought to introduce was, say, a well-known additive normally used in rubber compositions of that kind as an aid to mixing and that its omission would generally be questioned, then its mention would be allowable on the grounds that it merely clarified the description and introduced nothing not already known to the skilled person; however, if the introduction of this additive brought about some special effects not originally disclosed, an amendment mentioning this should not be allowed. Similarly in the above-mentioned case of the resilient supports, if the applicant were able to demonstrate that the drawings, as interpreted by the skilled person, showed helical springs, or that the skilled person would only consider helical springs for the mounting in question, the specific mention of helical springs would be allowable.

5.6a Where a technical feature was clearly disclosed in the original application but its effect was not mentioned or not mentioned fully, yet it can be deduced without difficulty by a person skilled in the art from the application as filed, subsequent clarification of that effect in the description does not contravene Art. 123(2).

Art. 123(2)

5.7 Amendment by the introduction of further examples should always be looked at very carefully in the light of the

general considerations outlined in paragraphs 5.3 to 5.6a above. The same applies to the introduction of statements of new (i.e. previously not mentioned) effects of the invention such as new technical advantages: for example, if the invention as originally presented related to a process for cleaning woollen clothing consisting of treating the clothing with a particular fluid, the applicant should not be allowed to introduce later into the description a statement that the process also has the advantage of protecting the clothing against moth damage.

## Art. 123(2)

5.7a Under certain circumstances, however, later filed examples or new effects, even if not allowed into the application, may nevertheless be taken into account by the examiner as evidence in support of the patentability of the claimed invention. For instance, an additional example may be accepted as evidence that the invention can be readily applied, on the basis of the information given in the originally filed application, over the whole field claimed (see III, 6.4). Similarly a new effect (e.g. the one mentioned in VI, 5.7) may be considered as evidence in support of inventive step, provided that this new effect is implied by or at least related to an effect disclosed in the originally filed application (see IV, 9.10).

5.7b Any supplementary technical information submitted after the filing date of the application will be added to the part of the file which is open to public inspection, unless excluded from public inspection pursuant to Rule 93(d). From the date at which the information is added to the open part of the file, it forms part of the state of the art within the meaning of Art. 54(2). In order to notify the public of the existence of such information submitted after the application was filed and not included in the specification, an appropriate mention will be printed on the cover page of the patent specification.

5.7c Care must also be taken to ensure that any amendment to, or subsequent insertion of, a statement of the technical problem solved by the invention meets Art. 123(2). For example it may happen that following restriction of the claims to meet an objection of lack of inventive step, it is desired to revise the stated problem to emphasise an effect attainable by the thus restricted invention but not by the prior art. It must be remembered that such revision is only permissible if the effect emphasised is one deducible by a person skilled in the art without difficulty from the application as filed (see 5.6a and 5.7 above).

5.7d Features which are not disclosed in the description of the invention as originally filed but which are only described in a cross-referenced document which is identified in such description are prima facie not within "the content of the application as filed" for the purpose of Art. 123 (2).

It is only under particular conditions that such features can be introduced by way of amendment into the claims of an application.

Such an amendment would not contravene Art. 123(2) if the description of the invention as filed leaves no doubt to a skilled reader:

- (i) that protection is or may be sought for such features;
- (ii) that such features contribute to solving the technical problem underlying the invention;
- (iii) that such features at least implicitly clearly belong to the description of the invention contained in the application as filed (Art. 78(1)(b)), and thus to the content of the application as filed (Art. 123(2));
- (iv) that such features are precisely defined and identifiable within the disclosure of the reference document (see T 689/90, OJ 10/1993, 616).

5.8 Alteration or excision of the text, as well as the addition of further text, may introduce fresh subject-matter. For instance, suppose an invention related to a multi-layer laminated panel, and the description included several examples of different layered arrangements, one of these having an outer layer of polyethylene; amendment of this example either to alter the outer layer to polypropylene, or to omit this layer altogether would not normally be allowable. In each case the panel disclosed by the amendment example would be quite different from that originally disclosed and hence the amendment would introduce fresh subject-matter and therefore be unallowable.

5.8a The replacement or removal of a feature from a claim may not violate Art. 123(2) provided the skilled person would directly and unambiguously recognise that (1) the feature was not explained as essential in the disclosure, (2) it is not, as such, indispensable for the function of the invention in the light of the technical problem it serves to solve, and (3) the replacement or removal requires no real modification of other features to compensate for the change. In case of replacement by another feature: the replacing feature must of course find support in the original application documents, so as not to contravene Art. 123(2) (see T 331/87, OJ 1-2/1991, 22).

5.8b However, when the extent of a claim is limited by a disclaimer because of an overlap between the prior art and the claimed subject-matter, and the claim's remaining subject-matter cannot be defined more clearly and concisely by positive features, this specific prior art may be thus excluded, even if there is no basis for the excluded

subject-matter in the application as filed (see T 433/86, not published in OJ).

#### **Correction of errors**

Rule 88  
Art. 123(2)

5.9 Correction of errors is a special case involving an amendment, therefore the requirements of Art. 123(2) apply likewise.

Linguistic errors, errors of transcription and other mistakes in any document filed with the Office may be corrected at any time. However, where the mistake is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident (at least once attention is directed to the matter):

- (i) that an error has occurred; and
- (ii) what the correction should be.

Regarding (i), the incorrect information must be objectively recognisable for a skilled person using common general knowledge from the originally filed application documents (description, claims and drawings) taken by themselves.

Regarding (ii), the correction should be within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the originally filed application documents. Evidence of what was common general knowledge on the date of filing may be furnished in any suitable form.

The priority documents cannot be used for the purposes mentioned under (i) and (ii) above (see Opinion G 3/89 and Decision G 11/91, OJ 3/1993, 117 and 125 respectively).

The correction under Rule 88, second sentence, is of a strictly declaratory nature and establishes what a skilled person, using common general knowledge, would already derive on the date of filing from the parts of a European patent application, seen as a whole, relating to the disclosure (see the above mentioned Opinion G 3/89 and Decision G 11/91). Therefore, the complete replacement of the application documents (i.e. description, claims and drawings) by other documents is also not possible (see Decision G 2/95, OJ 10/1996, 555).

Such requests for correction can only be considered until the decision to grant a patent or to refuse the application has been handed over to the EPO's internal postal service, for transmittal to the applicant (in written proceedings), or has been pronounced in oral proceedings (see Decision G 12/91, OJ 5/1994, 285).



**Plural forms of amendment**

## Rule 87

5.10 A situation may arise in which, as a result of amendment, the application has two or more distinct sets of claims. This possibility is provided for when the "state of the art" includes the content of a European application (or more than one European application) coming within the terms of Art. 54(3), and some of the Contracting States designated in the application under examination are also designated definitively in that other or those other European application(s) by confirming the designation through payment of the relevant designation fees (see IV, 6.1a, 6.3 and III, 8.1).

5.11 In examining the sets of claims referred to above, it will generally be found expedient to deal with each one quite separately, especially where the difference between them is substantial. The letter to the applicant will thus be divided into two or more parts, and the aim will be to have each set of claims, together with the description and drawings, brought into a state where it is in order to proceed to grant.

5.12 As indicated in IV, 6.3, if the examiner considers that the description and drawings are so inconsistent with either set of claims as to create confusion, he should require the applicant to amend the description and drawings to remedy this.

If the applicant voluntarily proposes such amendment the examiner should allow it only if he considers it necessary.

5.13 Hence this type of application will, after amendment, either consist of two or more distinct sets of claims each supported by the same description and drawings, or two or more sets of claims each supported by different description and drawings.

## Rule 16(2)

5.14 A similar situation may arise where a final decision on entitlement to the grant of a European patent applies to only some of the States designated in the application (see VI, 9.11).

**6. Discussion with the applicant**

6.1 In this section the term "applicant" is intended to mean "representative" where he has appointed one. Where the applicant has appointed a representative, the communication should be with that representative.

6.1a The circumstances in which it may be appropriate for the examiner to communicate with the applicant by telephone or propose an interview rather than send a further written action are considered in VI, 4.4. If the applicant requests an interview the request should be

granted unless the examiner believes that no useful purpose would be served by such a discussion.

6.2 When an interview is arranged, whether by telephone or in writing, and whether by examiner or applicant, the matters for discussion should be stated. If the arrangement is made by telephone, the examiner should record the particulars and briefly indicate, on the file, the matters to be discussed.

6.3 The interview will normally be conducted solely by the examiner dealing with the application. It is not a formal procedure (for formal oral proceedings before the Examining Division, see E-III), and the recording of the interview depends upon the nature of the matters under discussion. Where the interview is concerned with the clarification of obscurities, the resolution of uncertainties, or putting the application in order by clearing up a number of minor points it will usually be sufficient if the examiner makes a note on the file of the matters discussed and the conclusions reached, or amendments agreed. If, however, the interview is concerned with resolving weightier matters, such as questions of novelty, inventive step, or whether the amendment introduces fresh subject-matter, then a fuller note of the matters discussed should be made in the file. It should always be made clear to the applicant that any agreement reached must ultimately be subject to the views of the other members of the Division.

6.4 If a fresh objection of substance is raised at an interview and no amendment to meet it is agreed at the time, the objection must be confirmed by a letter giving the applicant a fresh period within which he may reply if he so wishes. Otherwise time limits may not be altered as a result of an interview.

6.5 When the telephone is used to settle outstanding matters, the normal procedure should be for the examiner to telephone the applicant stating the number of the application he wishes to discuss and requesting the applicant to telephone back at a specified time. A note must be made on the file, giving particulars and identifying the matters discussed and any agreements reached. Any matters on which agreement was not reached should also be noted and the arguments adduced by the applicant should be summarised.

6.6 The records of interviews or telephone conversations should always indicate whether the next action is due to come from the applicant or the examiner.

## **7. Work within the Examining Division**

7.1 As stated in VI, 1.4, the examiner may seek the advice of other members of his Division, if necessary, at any

stage in the examination. However, a point will be reached when it becomes appropriate for the examiner to refer the case formally to the other members of the Examining Division. This will arise if he considers it is in order to proceed to grant; or, at the other extreme, if there seems no possibility of amendment which would overcome his objections, or if the applicant has made no serious attempt to meet these objections and it therefore appears that the application must be refused. Between these extremes there are other circumstances in which reference to the Examining Division is appropriate, e.g. oral proceedings may be suggested by the examiner or requested by the applicant because an impasse has been reached. In considering whether to refer the application to the Division, the examiner should be guided by the principle stated in VI, 2.5.

7.2 If the examiner considers that the application satisfies the requirements of the Convention and is thus in order to proceed to grant he should make a brief written report. As a general rule, it will be appropriate in this report for the examiner to give the reasons why, in his opinion, the subject-matter as claimed in the application is not obvious having regard to the state of the art. He should normally comment on the document reflecting the nearest prior art and the features of the claimed invention which make it patentable, although there may be exceptional circumstances where this is not necessary, e.g. where patentability is based on a surprising effect. He should also indicate how any apparently obscure but important points have ultimately been clarified, and if there are any borderline questions which the examiner has resolved in favour of the applicant, he should draw attention specifically to these.

7.3 When referring to the Division an application which is not in order for grant of a patent, the examiner should make a written report which sets out the points at issue, summarises the case history to the extent necessary to enable the other members to obtain a quick grasp of the essential facts, and recommends the action to be taken, e.g. refusal, or grant conditional upon certain further amendments. As the other members will require to study the case themselves, there is no need for a detailed exposition. It will be useful however to draw attention to any unusual features or to points not readily apparent from the documents themselves. If the report recommends refusal and the issue seems clear cut, the examiner may include with his report a draft reasoned decision for issue by the Examining Division (see VI, 2.5); if the issue is not clear cut, the drafting of the reasoned decision should be deferred until the Division has discussed the case.

Art. 18(2)

7.4 When an application is referred to the other members of the Division, they will first consider the case individually and each will indicate his opinion on the course of action

to be taken. If there is complete agreement with the recommendation of the primary examiner, no meeting of the Division will be necessary; when further action is needed the primary examiner will be entrusted with the work. If, however, there is not complete agreement immediately with the primary examiner, or at least one member of the Division wishes to discuss the case, a meeting of the Division will be arranged. At such a meeting, the Division should try to reach a unanimous opinion by discussion, but where this seems unlikely, the difference of opinion must be resolved by voting. When the Division is enlarged to four members (see VI, 7.9), the Chairman has a casting vote should this be necessary.

7.5 The other members of the Division should bear in mind that their function generally is not to make a complete re-examination of the application. If, following a discussion, the conclusions of the examiner entrusted with the examination are generally considered to be reasonable, the other members should accept them.

7.6 If, in the opinion of the Examining Division, the possibility exists of amending the application to bring it into a form which meets the requirements of the Convention, then the primary examiner should be entrusted with the task of communicating to the applicant that the Examining Division is of the opinion that the application should be refused on certain grounds unless satisfactory amendments are submitted within a stated period. If, within the time limit, satisfactory amendments are made, the examiner will then report back to the Examining Division recommending that the application should proceed to grant. If not, he should report back recommending refusal.

Rule 86(2)

7.7 If, on the other hand, the Division is satisfied that the applicant has had sufficient opportunity to amend and that all the requirements are still not met, it should issue a decision to refuse the application; this decision will normally be drafted by the primary examiner.

Art. 113(1)

Rule 68(2)

Rule 68(1)

The grounds of refusal must be stated and full reasons must be given; refusal may be based only on grounds on which the applicant has had an opportunity to put forward comments. In addition, the applicant's attention must be directed to the provisions for appeal laid down in Art. 106 to 108. If oral proceedings take place (see E-III), the decision may be given orally but must subsequently be notified in writing, the time for appeal then running from the date of such notification.

7.8 Any decision is issued by the Examining Division as a whole and not by an individual examiner. All members, therefore, sign the decision irrespective of whether or not it was a unanimous one.

Art. 18(2) 7.9 "If the Examining Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner."

The participation or consultation of a legally qualified examiner will be required if a difficult legal question arises which has not yet been solved by the Guidelines or by jurisprudence. If the Examining Division has been enlarged by the addition of a legally qualified examiner, it consists of four members. In this case in the event of parity of votes, the vote of the Chairman will be decisive. As a rule, this enlargement of the Examining Division will be required in cases where evidence has to be taken according to Rule 72. The addition of a legally qualified examiner is to be considered also in the case of oral proceedings. Depending on the nature of the problem, as an alternative to the enlargement of the Examining Division consultation of a legally qualified examiner in the Directorate Patent Law may take place. For instance, doubts may arise whether an application concerns an invention within the meaning of Art. 52(2) or whether the claimed invention is excluded from patentability by virtue of Art. 53. Consultation of a legally qualified examiner may also be appropriate in cases where legal considerations are predominant in respect to a decision as in proceedings following a request for restitutio in integrum according to Art. 122. The formalities officer may also consult the Directorate Patent Law in cases within the scope of the duties transferred to him according to Rule 9(3).

## 8. Searching and the search report

### The search report

Rule 44 8.1 The search report prepared by the Search Division will  
Rule 46 normally be in the form prescribed by Rule 44. In cases where the application lacks unity, the search report will relate to one or more than one invention (see B-VII, 1.1 and 1.2).

Rule 45 In the exceptional cases provided for in Rule 45 and  
PCT Art. 17(2) PCT Art. 17(2)(a) and (b) only a partial search report or a declaration that a complete search is not possible will be available.

8.2 Assuming that a search has been made and documents cited, there are two special problems which may arise occasionally in respect of such documents. The first is the date of publication of the material in the document; this is dealt with in IV, 5.2. The other problem concerns documents in a non-official language (i.e. a language other than English, French or German).

8.3 The search examiner will cite a document in a non-official language only if he knows or has strong

evidence leading him to suspect (e.g. from drawings, from an abstract, or a corresponding patent in an official language, or from a translation produced by himself or some other person familiar with the language of the document) that the document is relevant. The examiner, in his first action, may cite the document on the basis of similar evidence; an abstract or corresponding document in an official language, if supplied by the search examiner, will also be cited. If, however, the applicant disputes the relevance of the document and gives specific reasons, the examiner should consider whether, in the light of these reasons and of the other prior art available to him, he is justified in pursuing the matter. If so, he should obtain a translation of the document (or merely the relevant part of it if that can be easily identified). If he remains of the view that the document is relevant, he should send a copy of the translation to the applicant with the next official communication.

#### **Search for conflicting European applications**

8.4 As stated in VI, 2.3, the examiner will need to make a "topping-up" search for conflicting European applications falling within the area defined by Art. 54(3). This is because as a general rule the search files in the Search Division will not be complete in respect of such material at the time the main search is made. Since priority dates claimed (if any) may not be accorded to all or part of the application but may be accorded to the appropriate part of a conflicting application (see V, 2.1), this search should be extended so as to cover all published European applications filed up to one year after the filing of the application under consideration. If the examiner is unable to complete this "topping-up" search at the first examination stage he should ensure that such search is completed before the application is reported to be in order for the grant of a patent. In the rare case in which (e.g. due to a request for accelerated prosecution ("PACE", see Notice of the President of the EPO, OJ 7/1997, 340) of an application not claiming priority) the application is found to be in order before this search can be completed, the grant of a patent should not be substantially delayed for this reason unless:

- (i) the examiner has knowledge of a European application which may have to be cited when the designation of contracting states has become final after publication, or
- (ii) the examiner has knowledge of a PCT-application which will have to be cited when all the conditions pursuant to Art. 158(2) have been fulfilled (see also IV, 6.2 and 6.3), or
- (iii) the applicant requests that, for this reason, the grant be delayed.

If none of the above conditions apply, the applicant is notified that the proceedings for grant will continue without, however, a complete search for conflicting applications pursuant to Art. 54(3).

#### **Other additional searches during examination**

8.5 An additional search will sometimes be required either at the first stage of amendment or subsequently. This may arise for a number of reasons. First, an additional search may be necessary where a declaration or a partial search, taking the place of the search report under Rule 45, or a declaration under PCT Art. 17(2), has been issued by the Search Division, and subsequently the deficiencies which rendered a meaningful search impossible have been corrected by amendment, or successfully refuted by the applicant. Secondly, an additional search may be necessary where the Search Division has not searched a particular part of the application because of objection of lack of unity of invention, and the substantive examiner disagrees with the objection. Thirdly, an additional search may be necessary where the claims have been so amended that their scope is no longer covered by the original search. Exceptionally, an additional search may be required if the applicant resiles from an acknowledgement of prior art (see IV, 9.5), or if the examiner believes that material relevant to obviousness might be found in technical fields not taken into account during the search.

8.6 The Search Division will have in the search files a copy of the published application and of the search report. If therefore the examiner believes that, for whatever reason, an additional search may be required, it will often be appropriate for him to consult the search examiner informally by telephone. If, after prior consultation with the search examiner where appropriate, it appears necessary for a systematic additional search to be done, the examiner should write a brief report to the Search Division stating the reason for the additional search and indicating any points which will help the search examiner to assess the search need without having to study the description again; he should also send such documents (e.g. amended claims) as are relevant to the additional search. It will not normally be necessary to return the whole dossier.

8.7 If, e.g. because of a badly drafted set of claims, the previous search was incomplete to an extent such that the search now to be made is the first effective one, then the examiner should indicate which claim, or claims, in his opinion, define the scope of the invention for which search is now required, and whether a particular interpretation is to be placed upon any wording in these claims. If it seems probable that the scope of the search resulting from the selected claims will, even at that stage, be very broad, the

examiner should, if possible, indicate how in his opinion it might be narrowed without impairing unduly the effectiveness of the resultant search. He should also indicate any elements of the selected claims which he considers to be either of little substance, or of special importance.

8.8 If a complete search has been made but an additional search in the same technical field is required due to amendment of the claims, it will usually be sufficient if the examiner indicates the claim, or claims, defining the invention as in VI, 8.7, and the ways in which these claims are different in scope from the original search.

8.9 Although in principle all search work (other than for Art. 54(3) material) should be done by the Search Division, the examiner is not barred from looking for a relevant document whose existence he knows of or has reason to suspect, if he can retrieve that document in a short time from material available to him in Munich.

Art. 157(1)  
Art. 157(2)(a)  
Art. 157(3)(a)

8.10 When the application has been filed under the PCT, the search report will be the international search report made under the PCT but this will be accompanied by a supplementary European search report unless the Administrative Council decides that a supplementary report is to be dispensed with. Both of these reports will have to be considered by the examiner when deciding whether any additional search is required.

8.11 A copy of any document cited by the examiner but not mentioned in the search report, for example one found in a search under VI, 8.4 or VI, 8.5, should be sent to the applicant, and a further copy placed in the dossier so as to be available to the public.

## 9. Special applications

### Divisional applications (see also A-IV, 1)

Art. 76(1)

9.1 Subsequent to the filing of a European application, a divisional application may be filed. The divisional application is accorded the same filing date as the parent application, and has the benefit of any right of priority of the parent application in respect of the subject-matter contained in the divisional application. A European application may give rise to more than one divisional application. A divisional application may itself give rise to one or more divisional applications.

Art. 82

9.2 The applicant may file a divisional application of his own volition (voluntary division). The most common reason, however, for filing a divisional application is to meet an objection under Art. 82 of lack of unity of invention (mandatory division). If the examiner objects to lack of unity, the applicant is allowed a period (see VI, 11 and



E-VIII, 1) in which to limit his application to a single invention. The limitation of the parent application has to be clear and unconditional. The communication inviting the applicant to limit the application due to lack of unity should therefore include a reference to the fact that if the applica-

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tion is not limited within the set time limit the application may be refused.

## Rule 25(1)

9.3 Divisional applications may be filed "up to approval of the text, in accordance with Rule 51(4), in which the European patent is to be granted." This means that the mere deletion of subject-matter in an application is not prejudicial to the later filing of a divisional application up to the approval mentioned above. When deleting subject-matter the applicant should, however, avoid any statements which could be interpreted as abandonment (see also VI, 4.7).

Divisional applications cannot be filed after approval of the text proposed for grant according to Rule 51(4). The only exception is the situation where the Examining Division resumes the examination of its own motion after approval of the applicant (see VI, 15.1.5), resulting in an amended version proposed for grant, in which case the final approval of the applicant needs to be obtained with another communication under Rule 51(4).

A withdrawal of an approval cannot again create the possibility of filing a divisional application (see Opinion G 10/92, OJ 9/1994, 633 and J 29/96, OJ 12/1998, 581).

9.4 The substantive examination of a divisional application should in principle be carried out as for any other application but the following special points need to be considered. The claims of a divisional application need not be limited to subject-matter already claimed in claims of the parent application; however the subject-matter may not extend beyond the content of the parent application as filed. If a divisional application contains subject-matter additional to that contained in the parent application as filed and the applicant is unwilling to remedy this defect by removal of that additional subject-matter, the divisional application must be refused. It cannot be converted into an independent application taking its own filing date. Moreover a further divisional application for this additional subject-matter will also be refused.

If the divisional application's subject-matter is restricted to only a part of the subject-matter as claimed in the parent application, this subject-matter must be directly and unambiguously derivable as such a separate entity, which could be used outside the context of the invention of the parent application (see T 545/92, not published in OJ).

9.5 The description and drawings of the parent application and the or each divisional application should in principle be confined to matter which is relevant to the invention claimed in that application. However, amendment of the description should be required only where it is absolutely necessary. Thus the repetition in a divisional application of

matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application. As for the matter of cross-references there is no need for the examiner to check in the description since, under present practice, cross-references are always made between the parent and divisional applications. These appear on the front page of the respective application and patent published after receipt of the divisional application.

9.6 The parent and divisional applications may not claim the same subject-matter (see IV, 6.4). This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable. As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B.

#### **Applications resulting from a decision under Art. 61**

9.7 In certain circumstances, before a patent has been granted on a particular application, it may be adjudged as a result of a final decision of a national court that a person other than the applicant is entitled to the grant of a patent thereon. In this event this third party may either:

- |               |                                                                                  |
|---------------|----------------------------------------------------------------------------------|
| Art. 61(1)(a) | (i) prosecute the application as his own application in place of the applicant,  |
| Art. 61(1)(b) | (ii) file a new European patent application in respect of the same invention, or |
| Art. 61(1)(c) | (iii) request that the application be refused.                                   |

(See also IV, 8.3).

9.8 If the third party adopts the first of these alternatives he becomes the applicant in place of the former applicant and the prosecution of the application is continued from the position at which it was interrupted.

- |                             |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                     |
|-----------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Art. 61(1)(2)<br>Rule 15(1) | 9.9 If however the third party files a new application under Art. 61(1)(b), the provisions of Art. 76(1), apply to this new application <i>mutatis mutandis</i> . This means that the new application is treated as though it were a divisional application i.e. it takes the date of filing and the benefit of any priority right of the original application. The examiner must therefore ensure that the subject-matter content of the new application does not extend beyond the content of the |
|-----------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

original application as filed. The original application is deemed to be withdrawn on the date of filing of the new application for the designated States concerned.

9.9a In cases where the original application has been withdrawn or refused or was deemed to be withdrawn and is thus no longer pending, Art. 61(1)(b) is applicable, thus allowing the third party to still file a new European patent application in respect of the same invention (see Decision G 3/92, OJ 9/1994, 607).

Rule 16(1)

9.10 "If, by a final decision, it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application" then the foregoing considerations apply only to "such part". In such a case, option (i) mentioned in VI, 9.7 is not open to the third party and, regarding option (ii), the new application must be confined to that part of the original subject-matter to which he has become entitled; similarly the original application must, for the designated States concerned, be confined to the subject-matter to which the original applicant remains entitled. The new application and the amended original application will stand in a relationship to each other similar to that appertaining between two divisional applications, and they will each stand in a relationship to the original application similar to that in which divisional applications stand in relation to the application from which they are divided. The guidance set out in VI, 9.4, 9.5 and 9.6 is therefore applicable to this situation.

Rule 16(2)

9.11 Where the final decision on entitlement applies to some only of the designated States, the original application may contain different claims, description and drawings for those States compared with the others (see VI, 5.14 and III, 8.2).

9.12 If the sole result of the application of Art. 61(1) is to divide the right to the grant between the original applicant and the third party so that each may apply for the entire subject-matter for different designated States, each application should be examined in the normal way without regard to the other, with the proviso that the subject-matter of each application must not extend beyond that of the original application.

**9a. Applications where a reservation has been entered in accordance with Art. 167(2)(a).**

(see III, 8.3).

**10. International applications (Euro-PCT applications)**

Art. 157

The general considerations relating to PCT applications are set out in E-IX. The examination of European applica-

tions made under the provisions of the PCT should be carried out in exactly the same way as for other European applications. Where, however, the search is performed by an International Searching Authority other than the EPO, the examiner may have to consider two search reports, the international search report and a supplementary search report prepared by the EPO.

Where the EPO is an elected Office, the international search report and the documents attached to it must be considered in accordance with E-IX, 6.4.

### **11. Time limits for response to communications from the examiner**

11.1 The general considerations relating to time limits are set out in E-VIII. The time limit for response to a letter from the examiner should in general be between two and four months in accordance with Rule 84. The period to be allowed will be determined by the examiner taking all the factors relevant to the particular application into account. These include the language normally used by the applicant or his representative; the number and nature of the objections raised; the length and technical complexity of the application; the proximity of the Office to the applicant or, if he has one, his representative; and the distance separating applicant and representative.

11.2 In certain special circumstances the examiner may allow up to six months for the time limit. The six-month period may be appropriate, for instance, if the applicant resides a long way from his representative and the language of the proceedings is not one to which the applicant is accustomed; or if the subject-matter of the application or the objections raised are exceptionally complicated.

### **12. Examination of observations by third parties**

The general considerations relating to observations from third parties are set out in E-VI, 3. In the context of substantive examination, such observations are not taken into account unless a request for examination has been filed.

### **13. Oral proceedings**

The general considerations relating to oral proceedings are set out in E-III.

### **14. Taking of evidence**

14.1 The general considerations relating to the taking of evidence are set out in E-IV. This Section deals only with the kind of evidence most likely to arise in pre-grant proceedings, viz. written evidence.

14.2 An Examining Division would not, as a general rule, require evidence to be produced. The primary function of the examiner in proceedings before grant is to point to the applicant any ways in which the application does not meet the requirements of the Convention. If the applicant does not accept the view of the examiner, then it is for the applicant to decide whether he wishes to produce evidence in support of his case and, if so, what form that evidence should take. The Examining Division should afford the applicant a reasonable opportunity of producing any evidence which is likely to be relevant. However, this opportunity would not be given where the Examining Division is convinced that no useful purpose would be served by it, or that undue delay would result.

14.3 Written evidence could include the supply of information, or the production of a document or of a sworn statement. To take some examples:

To rebut an allegation by the examiner of lack of inventive step, the applicant might, in support of his case, supply information as to the technical advantages of the invention. Again he might produce a sworn statement, either from himself or from an independent witness, purporting to show that workers in the art have been trying for a long time unsuccessfully to solve the problem with which the invention is concerned, or that the invention is a completely new departure in the relevant art.

### **15. Grant and publication of patent**

Art. 97(2)(a) 15.1 Once the Examining Division has decided that a patent can be granted it must inform the applicant of the text on whose basis it intends to do so. This text may include amendments made by the Examining Division on its own initiative which it can reasonably expect the applicant to accept.

Rule 51(4) This text is communicated to the applicant as required by Rule 51(4), and he is requested to approve it within a specified period (currently four months), which may be extended once by two months upon request (for which no reasons need be given). Not until the communication under Rule 51(6) is issued does the period for filing the translation begin.

An annex to the communication under Rule 51(4) states which Contracting States have been designated, the title of the invention in the three EPO official languages, the international patent classification and the registered name of the applicant.

Art. 97(1)  
Rule 51(5) 15.1.1 If the applicant fails to indicate within the period stipulated under Rule 51(4) that he approves the text communicated to him, the application is refused. The

same applies if within that period he expressly states that he does not approve the text but fails to suggest any amendments, since no text on the basis of which the patent can be granted then exists (Art. 97(1)).

15.1.2 If within the period set the applicant requests amendments to which the Examining Division gives its consent under Rule 86(3) without issuing a further communication, no new communication under Rule 51(4) is issued either. The patent is then granted on the basis of the text as amended, and the Rule 51(6) communication issued confirming grant on the basis of that text, without waiting until the expiry of the period set under Rule 51(4) (see the Notice of the EPO, OJ 1-2/1989, 43).

15.1.3 If the Examining Division does not consent to the amendments proposed (cf. VI, 4.6 et seq.) it informs the applicant of this fact, stating its reasons and requesting his comments within a specified period. If the applicant fails to reply within that time the application is deemed to be withdrawn (Art. 96(3)). If the Examining Division sees no reason to change its opinion on the basis of comments received the application is refused (Art. 97(1)). If the applicant withdraws the proposed amendments the communication under Rule 51(6) is issued.

15.1.4 If the Examining Division considers the amendments proposed to be allowable in substance under Rule 86(3) but still has objections to the text in its amended form, it requests the applicant to rectify the remaining deficiencies and to communicate his approval of the amended text (Art. 113(2)). Once he has done so a communication under Rule 51(6) is issued. This communication shall indicate the amendments to the text communicated under Rule 51(4) so as to establish the text in which the patent is to be granted.

15.1.5 A new Rule 51(4) communication is sent out if, exceptionally, the Examining Division resumes examination of its own motion after the period under Rule 51(4) has expired but before the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant (cf. VI, 4.11) and resumed examination results in a text on whose basis the patent can be granted.

Art. 97(2)(5)  
Rule 51(6)  
Art. 97(2)(c)

15.2 Only when the applicant has approved the text or the Examining Division has agreed to allow further amendments does the Examining Division set the applicant a non-extendable period of (currently) three months within which to pay the fees for grant and printing and any claims fees due (see next paragraph) and to file a translation of the claims intended to serve as the basis for grant, in the two EPO official languages which were not the language of the proceedings.



- Art. 88(1)  
Rule 38(4) In that communication the applicant is also requested to file within the above mentioned time limit either the translation of the application of which priority is claimed or the declaration as provided for in Rule 38(4), if he has not yet done so.
- Rule 51(7)  
Rule 31(1) 15.2.1 If the text of the European patent application serving as the basis for grant contains more than ten claims, the Examining Division requests the applicant to pay, within the period under Rule 51(6), claims fees in respect of each claim over and above that number unless he has already done so under Rule 31(1). Where there is more than one set of claims, fees are incurred under Rule 31 or Rule 51(7) only for the set with the greatest number of claims.
- If the application contains different sets of claims for particular Contracting States, a translation of all the sets of claims must be filed. It is not up to the examiner to check that the translation filed is correct.
- Art. 97(3)(5)  
Rule 51(8) If the applicant fails either to pay all the above-mentioned fees or to file the translation in due time, the application is deemed to be withdrawn.
- Art. 97(2)(c)  
Rule 51(9) 15.2.2 Before a patent can be granted, the applicant must also have paid any renewal and additional fees due. If a renewal fee is already due before notification of the Rule 51(4) communication or becomes so after notification of Rule 51(6) communication but before the expected date of publication of the mention of the grant of the European patent, this is drawn to the applicant's attention. Mention of grant is published only once the renewal fee has been paid. If the renewal and any additional fee are not paid in time the application is deemed to be withdrawn.
- Rule 51(8a) 15.2.3 In the rare case that examination could be accelerated to such an extent that the communication under Rule 51(6) is issued before the designation fees become due, the mention of grant of the patent will not be published until the designation fees have been paid and the designation of states for which no designation fees have been paid has been withdrawn. The applicant is informed accordingly.
- Art. 65(1)  
Rule 51(10) 15.3 The communication under Rule 51(6) also tells the applicant which designated States, if any, require translations of any patent not in one of their official languages.
- Art. 121 15.4 If the applicant overruns the time limits set under Rule 51(4) and (6) he may request further processing under Art. 121.
- Art. 97(4)-(6) 15.5 If the requirements set out in VI, 15.2 above are fulfilled, it is decided that a European patent be granted.

This decision, however, does not take effect until the date on which the grant is mentioned in the European Patent Bulletin. This does not normally occur until at least five months after despatch of the Rule 51(6) communication, except where the applicant has requested that mention of grant of the European patent be published before the expiry of that time limit, pursuant to Art. 97(6). Such a request takes effect, and results in the five-month period ceasing to apply, only if the applicant:

- has given his approval to the text submitted to him with the Rule 51(4) communication,
- has filed the translations of the claims in the two other official languages,
- has paid the fees for granting, for printing and for any additional claims, and
- has filed the translation of the priority document or the declaration under Rule 38(4), if applicable.

In any case the mention of the grant will not be published as long as there are renewal and/or additional fees outstanding (Rule 51(9)).

The decision to grant contains the date of the mention of the grant of the European patent and is sent to the applicant when the technical preparations for printing the patent specification have been completed.

Art. 98  
Rule 49(2)  
Rule 53  
Art. 14(7)

At the same time as mention of the grant is published in the Bulletin, the EPO publishes the patent specification containing the description, claims (in the three official languages) and any drawings. The front page of the published specification shows inter alia the Contracting States which are still designated at the time of grant.

Rule 53

15.5a The specification of the European patent is not published if the application is withdrawn before the termination of the technical preparations for publication. If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed. The Office will however try (in accordance with the principles of J 05/81, OJ 4/1982, 155 et seq.) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily. The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80, OJ 5/1981, 141 et seq.). The applicant is bound by an effective declaration of withdrawal (see Legal Advice No. 8/80, OJ 1/1981, 6).

15.6 As soon as the European patent specification has been published, the Office issues the proprietor with a certificate of his entitlement to the European patent. The patent specification is attached to the certificate and the whole despatched to the patent proprietor without delay.

15.7 If no notice of opposition is recorded in the dossier of the European patent within nine months of publication of the mention of grant, the patent proprietor is informed and an appropriate entry published in the European Patent Bulletin. If subsequently it emerges that an opposition was filed in time, the proprietor is again informed and a correction published in the Bulletin.



**PART D**  
**GUIDELINES FOR OPPOSITION PROCEDURE**



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**CHAPTER I**

## GENERAL REMARKS

**1. The meaning of opposition**

The public may oppose the granted European patent on the basis of one or more of the grounds mentioned in Art. 100. The grounds on which the opposition is based may arise for example from circumstances of which the EPO was not aware when the patent was granted (e.g. prior use or a publication which was not contained or not found among the material available to the Patent Office). Opposition is therefore a means by which any person may obtain the limitation or revocation of a wrongly granted patent.

**2. Opposition after surrender or lapse**

Art. 99(3) "An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States." This is relevant in that in such cases the rights acquired with the patent remain in existence during the period up to surrender or lapse and claims arising from such rights may subsist after that date.

**3. Territorial effect of the opposition**

Art. 99(2) "The opposition shall apply to the European patent in all the Contracting States in which that patent has effect." Thus the opposition should formally be in respect of all the designated States. If an opposition is filed in respect of only some of the designated States it will be treated as if it were in respect of all the designated States.

Nevertheless the effect of an opposition may differ as between Contracting States. This may arise where the patent contains different claims for different Contracting States in accordance with Rule 16(2), or Rule 87, or where the claims must take account of different art under the provisions of Art. 54(3). Thus the patent may be differently amended in respect of different Contracting States and may be revoked in respect of one or more Contracting States and not in respect of others.

**4. Entitlement to oppose**

Art. 99(1) "Any person" may give notice of opposition without specifying any particular interest. "Any person" is to be construed in line with Art. 58 as meaning any natural person (private individual, selfemployed persons, etc.), any legal person or any body assimilated to a legal person under the law governing it. "Any person" does not include the proprietor of the patent (as was decided in Decision G 9/93 (OJ 12/1994, 891), reversing Decision G 01/84

(OJ 10/1985, 299)). Oppositions filed by patent proprietors before publication of this Decision will remain unaffected by Decision G 9/93.

Notice of opposition may also be filed jointly by more than one of the persons mentioned above.

Oppositions are not assignable but may be inherited or succeeded to as part of an overall succession in law, e.g. in the event of the merger of legal persons. Acquiring companies may also take over oppositions filed by acquired companies.

#### **5. Intervention of the assumed infringer**

Art. 105(1)  
Art. 105(2)

Under certain conditions (see VII, 7) "any third party who proves that proceedings for infringement of the opposed patent have been instituted against him" or "that the proprietor of the patent has requested that he cease alleged infringement of the patent and that he has instituted proceedings for a court ruling that he is not infringing the patent" "may, after the opposition period has expired, intervene in the opposition proceedings". Once the notice of intervention has been filed in good time and in due form, the intervention is to be "treated as an opposition" (see IV, 5.6).

#### **6. Parties to opposition proceedings**

Art. 99(4)  
Art. 105(2)  
Art. 115(1)

The proprietor of the patent and the opponent and, where applicable, the intervener will be parties to the opposition proceedings. However, an opponent who has withdrawn notice of opposition or whose opposition has been rejected as inadmissible will remain a party to the proceedings only until the date of such withdrawal or the date on which the decision on rejection has become final. The same will apply in the case of interveners. Third parties who have presented observations concerning the patentability of the invention in respect of which an application has been filed are not parties to opposition proceedings (see E-VI, 3).

Art. 118

"Where the proprietors of a European patent are not the same in respect of different designated Contracting States, they shall be regarded as joint proprietors for the purposes of opposition proceedings" (see VII, 3.1 concerning the unity of the European patent).

Art. 99(5)  
Art. 61(1)(a)

"Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State". In this event, "by derogation from Art. 118, the previous proprietor and the person making the request shall not be deemed to be joint proprietors unless both so request." The aim of this

provision is to afford the new proprietor the opportunity of defending himself against the opposition as he sees fit (see VII, 3.2, as regards the conduct of the opposition proceedings in such cases).

Art. 20(1)

The Legal Division is responsible for decisions in respect of entries in the Register of European Patents (see Information of the EPO, OJ 9/1990, 404).

### **7. Representation**

As regards the requirements relating to representation of opponents and patent proprietors, reference is made to A-IX, 1. Deficiencies in the representation of an opponent at filing the opposition and their remedy are treated in IV, 1.2.1 (ii) and 1.2.2.2 (iv).

### **8. Information to the public**

As soon as an opposition has been received, the date of filing of the opposition is entered in the Register of European Patents and published in the European Patent Bulletin. The same applies to the date on which opposition proceedings are concluded and to the outcome of the proceedings.

**CHAPTER II**

## THE OPPOSITION DIVISION

Rule 12(1)

**1. Administrative structure**

Each Opposition Division is part of a Directorate of the EPO comprising several Examining and Opposition Divisions.

Art. 19(2)

**2. Composition**

## 2.1 Technically qualified examiners

"An Opposition Division shall consist of three technical examiners, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates."

## 2.2 Legally qualified examiners

"If the Opposition Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner who shall not have taken part in the proceedings for grant."

The principles established for inclusion of a legally qualified member and for consultation of the Legal Division by the Examining Division apply correspondingly for the Opposition Division (see C-VI, 7.9). In addition to this, difficult legal questions may occur during the examination as to whether an opposition is to be rejected as inadmissible. Consultation of a legally qualified member should also be envisaged in cases where it is questionable whether or not a disclosure by means other than a document was made available to the public.

## 2.3 Chairman

The Chairman must be a technically qualified examiner who must not have taken part in the grant proceedings.

Rule 9(1)

**3. Allocation of duties and appointment of members of the Opposition Division**

C-VI, 1.3 applies mutatis mutandis.

**4. Tasks of the Opposition Divisions**

Art. 19(1)

## 4.1 Examination of oppositions

The respective Opposition Divisions "shall be responsible for the examination of oppositions against European patents".



The examination of newly submitted documents for compliance with physical requirements will essentially be the task of the competent formalities officers (see II, 7, A-I, 2, A-III, 3.2 and C-VI, 2.1).

Art. 104(2)  
Rule 63(3)(4)

4.2 Decision concerning the awarding of costs by the registry (i.e. the formalities officer)

The Opposition Division will decide on requests to have the costs fixed by the registry reviewed (see IX, 2.1).

Art. 122(4)  
Rule 69(2)

4.3 Ancillary proceedings

It will be incumbent upon the Opposition Division to conduct ancillary proceedings arising in the course of opposition proceedings, such as the processing of applications for restitutio in integrum in respect of a time limit which was not observed vis-à-vis the EPO during the opposition proceedings or of requests for a decision concerning a finding arrived at by the formalities officer that a right has been lost. Additional tasks may be entrusted to the Opposition Divisions by the President of the EPO in accordance with Rule 9(2).

Art. 19(2)  
Art. 117(2)

#### **5. Allocation of tasks to members**

An Opposition Division will normally entrust one of its members with the examination of the opposition, but not with the conduct of oral proceedings, up to the time of the final decision on the opposition (see also IV, 2). If need be, he may also be entrusted with the examination of the evidence adduced (see E-IV, 1.3). Normally the examiner who dealt with the corresponding application in the proceedings for grant will be appointed and he will be referred to as the primary examiner.

#### **6. Duties and powers of members**

The primary examiner will conduct the examination of the opposition. In this work he will issue communications to the parties without consulting the other members. However if the primary examiner believes that the other members may have reservations concerning the procedure which he intends to follow, he must submit the communication to the Opposition Division before despatch. If he considers that the matter is ready for a decision or that oral proceedings should be arranged, possibly in conjunction with the taking of evidence (see E-III, 1 to 4 and E-IV, 1.6.1), he must submit an opinion in writing to the Opposition Division.

In the light of this opinion, the other members of the Opposition Division will give their own opinions in writing, which may simply be a short confirmation of agreement.

If there are differences of opinion, the Chairman must fix a date for a meeting at which the primary examiner will report on the matter. The Chairman will preside at the meeting and, following a discussion, will take a vote on the decision or the further course of the procedure.

Art. 19(2)

Voting will be on the basis of a simple majority. "In the event of parity of votes, the vote of the Chairman of the Division shall be decisive."

Any further measures necessary will as a rule be entrusted to the primary examiner. If no further measures are necessary, the primary examiner will draft a decision on the opposition and will distribute the draft to the other members of the Opposition Division for examination and signature. If any changes are proposed by a member and there are differences of opinion on such changes, the Chairman must arrange a meeting.

Where reference is made hereinafter to the Opposition Division, this should be taken to mean the primary examiner where such a member has been appointed and in so far as he is entitled to act alone under the Convention and the Implementing Regulations thereto.

Rule 9(3)

#### **7. Allocation of Individual duties**

"The President of the EPO may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the Examining Divisions or to the Opposition Divisions and involving no technical or legal difficulties." In so far as such duties affect the public, their allocation will be notified in the Official Journal of the EPO (see OJ 7/1984, 319 and OJ 5/1989, 179).

The formalities officers entrusted with these duties make up the registry of the Opposition Divisions.

**CHAPTER III**

## OPPOSITION

**1. Time allowed for filing notice of opposition**

Art. 99(1) "Within nine months from the publication of the mention of the grant of the European patent", notice of opposition has to be given to the EPO in Munich, The Hague or Berlin.

For expiry of the time limit see E-VIII, 1.4. Restitutio in integrum in respect of unobserved time limits for opposition is not possible in the case of an opponent (see however E-VIII, 2.2.2).

**2. Opposition fees**

Payment of the opposition fee

Art 99(1) The amount of the opposition fee specified in the Rules relating to Fees under the European Patent Convention must be paid before expiry of the time limit for opposition.

As regards the legal consequences and the procedure where the fee is not paid in good time, see IV, 1.2.1 (i) and 1.4.1.

For reduction of the opposition fee, see A-XI, 9.2.4.

**3. Submission in writing**

Art. 99(1)  
Rule 61a  
Rule 36(2) 3.1 Form of the opposition

Rule 35(4) The notice of opposition must be filed in writing and should be "typewritten or printed", with "a margin of about 2.5 cm on the left hand side of each page". It would be appropriate if the notice of opposition also satisfied the requirements laid down in Rule 35(4).

Rule 36(4) "Such documents as must be communicated to other" parties concerned "must be filed in a sufficient number of copies. If the party concerned does not comply with this obligation in spite of a request" to do so, "the missing copies will be provided at the expense of the party concerned."

Rule 36(5) 3.2 Notices of opposition filed by telegram, telex or facsimile

Notice of opposition may also be filed by telegram, telex or facsimile. At the invitation of the EPO, written confirmation reproducing the contents of the telegram, telex or facsimile and complying with the requirements of the Implementing

Regulations - in particular properly signed - must be supplied. If the opponent fails to comply with this invitation in due time, the telegram, telex or facsimile shall be deemed not to have been received (see A-IX, 2.5). The opposition fee must in any case be paid within the opposition period.

Rule 36(3)(5)

### 3.3 Signature of the notice of opposition

The notice of opposition must be signed by the person responsible, i.e. by the opponent or, where appropriate, by his representative (see also IV, 1.2.1(ii) and A-IX, 1).

Initials or other abbreviated forms will not be accepted as a signature.

The name of the person filing the notice of opposition will be accepted by way of signature on telegrams and telexes, as will the reproduction of their signature on facsimiles.

If the signature is omitted, the formalities officer must request the party, or where appropriate his representative, to affix his signature within a time limit to be laid down by the formalities officer. "If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been received" (see IV, 1.2.1 (ii) and 1.4.1).

### 4. Derogations from language requirements

Derogations from language requirements for written opposition proceedings are dealt with in A-VIII, 2 and for oral opposition proceedings in E-V.

Art. 99(1)

### 5. Grounds for opposition

A written reasoned statement of the grounds for opposition must be filed within the opposition period.

Art. 100

Opposition may only be filed on the ground that:

Art. 100(a)

(i) the subject-matter of the European patent is not patentable within the terms of Art. 52 to 57, because it

- is not new (Art. 52(1), 54, 55),
- does not involve an inventive step (Art. 52(1), 56),
- is not susceptible of industrial application (Art. 52(1), 57),
- is not regarded as an invention under Art. 52(2) to (4) or

- is not patentable under Art. 53.

Art. 100(b) (ii) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art (Art. 83);

Art. 100(c) (iii) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Art. 61 (new application in respect of the invention by the person adjudged in a final decision to be entitled to the grant of a European patent), beyond the content of the earlier application as filed (Art. 123(2)).

(See also V, 3 to 5 and C-IV).

Note that each single condition mentioned above forms an individual legal basis for objection to the maintenance of the patent. Consequently, each such condition is to be regarded as a separate ground of opposition (see Decisions G 1/95 and G 7/95, OJ 11/1996, 615 and 626).

The following allegations, for example, do not constitute grounds for opposition: that national rights of earlier date exist which put the patentability of the invention in question (see however IV, 5.3 and VII, 4.5), that the proprietor of the patent is not entitled to the European patent, that the subject-matter of the patent lacks unity, that the claims are not supported by the description (unless it is also argued that the claims are so broadly worded that the description in the specification does not sufficiently disclose the subject-matter within the meaning of Art. 100(b)), that the form and content of the description or drawings of the patent do not comply with the provisions as to formal requirements as set forth in Rules 27 and 32 of the Implementing Regulations, or that the designation of the inventor is incorrect. Nor does the simple allegation that priority has been wrongly claimed constitute a ground for opposition. However, the matter of priority must be subjected to a substantial examination in the course of opposition proceedings if state of the art is invoked in connection with a ground for opposition under Art. 100(a) in relation to which the priority date is of decisive importance (see C-IV, 5 and 6 and C-V, 2).

## 6. Content of the notice of opposition

The notice of opposition shall contain:

Rule 55(a) (i) the name and address of the opponent and the State in which his residence or principal place of business is located. Names of natural persons must be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of

legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, must be indicated by their official designations. Addresses must be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They should in any case comprise all the relevant administrative units including the house number, if any. It is recommended that the telegraphic and telex address and the telephone and facsimile number be indicated (see IV, 1.2.2.2(i) and IV, 1.4.2);

- Rule 55(b) (ii) the number of the European patent against which opposition is filed, and the name of the proprietor and title of the invention (see IV, 1.2.2.2(ii) and IV, 1.4.2);
- Rule 55(c) (iii) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds (see IV, 1.2.2.1(iii), (iv), (v) and IV, 1.4.2). However, in order to streamline opposition procedure it is recommended that the evidence itself be submitted as soon as possible (see IV, 1.2.2.1(v), last paragraph).
- Rule 55(d) (iv) if the opponent has appointed a representative, his name and the address of his place of business in accordance with the provisions of sub-paragraph (i) as set out supra (see IV, 1.2.2.2(iii) and IV, 1.4.2).

IV, 1 sets out further details and explains the manner in which the opposition will be dealt with where one of these requirements is not fulfilled.

**CHAPTER IV**

## PROCEDURE UP TO SUBSTANTIVE EXAMINATION

**1. Examination for deficiencies in the notice of opposition and communications from the formalities officer arising from this examination**

## 1.1 Forwarding of the notice of opposition to the formalities officer

The notice of opposition must be forwarded directly to the formalities officer, who then places it in the files of the European patent concerned in accordance with the relevant administrative instructions and communicates it without delay to the proprietor for information. If a notice of opposition is received prior to the publication of the mention of the grant of the European patent, the formalities officer informs the opponent that for that reason his document cannot be treated as an opposition. This document becomes part of the files and, as such, is also available for inspection under Art. 128(4), and is brought to the attention of the applicant for or the proprietor of the patent as an observation by a third party in accordance with Art. 115 (for details, see E-VI, 3). If an opposition fee has been paid, it will in this case be refunded.

Examinations, observations, communications and, where appropriate, invitations to the parties will be the responsibility of the formalities officer who has been entrusted with this task of the Opposition Division (see II, 7).

## 1.2 Examination for deficiencies in the notice of opposition

After the notice of opposition has been given, the formalities officer examines whether any deficiencies exist.

## 1.2.1 Deficiencies which, if not remedied, lead to the opposition being deemed not to have been filed

Art. 8 RFees  
Art. 9(1) RFees

(i) The opposition fee or a sufficient amount of the fee has not been paid in the course of the opposition period (Art. 99(1)).

However, if the opposition fee, apart from a small amount (e.g. deducted as bank charges) has been paid within the opposition period, the formalities officer examines whether the amount lacking can be overlooked where this is justified. If the formalities officer concludes that the amount lacking can be overlooked, the opposition fee is deemed to have been paid and there is no deficiency, as meant here.

(ii) The document giving notice of opposition is not signed and is not rectified within the period set by the

formalities officer, which is fixed at two months as a rule (see E-VIII, 1.2) (Rule 36(3)). In the case of Art. 133(2), (see also 1.2.2.2(iv)) a professional representative has been appointed within the prescribed time limit but the notice of opposition has not been signed by the representative and he has failed to remedy such deficiency either by signing it or by approving it in writing.

(iii) Where a notice of opposition is filed by telegram, telex or facsimile and written confirmation reproducing the contents of the telegram, telex or facsimile, if requested by Formalities, is not supplied in due time (Rule 36(5) and Decision of the President of the EPO, OJ 6/1992, 299).

(iv) Where a notice of opposition is filed by the representative or employee of an opponent, and the authorisation, if any is required (see IX, 1.5 and the Decision of the President of the EPO in OJ 9/1991, 489), is not supplied in due time (Rule 101(1),(4)).

(v) The Opposition is submitted within the opposition period but not in an official language of the EPO, as specified in Rule 1(1), or if Art. 14(4) applies to the opponent, the translation of the elements referred to in Rule 55(c) is not submitted within the opposition period (see also A-VIII, 2.1, Decision G 6/91, OJ 9/1992, 491 and T 193/87, OJ 4/1994, 207). This period shall be extended where the one-month period as required under Rule 6(2) expires later.

This deficiency is present if the opposition is not filed in English, French or German or if, for example, an opponent from Belgium files his opposition in time in Dutch but fails to file the translation of the essential elements into English, French or German within the above-mentioned time limits.

1.2.2 Deficiencies which, if not remedied, lead to the opposition being rejected as inadmissible

Only such oppositions as are deemed to have been filed will be examined for deficiencies under Rule 56(1) and (2). For oppositions which, upon submission, are deemed not to have been filed because of deficiencies as described in IV, 1.2.1, see further procedure as described in IV, 1.4.1.

If the formalities officer is not sure whether the opposition in question contains a deficiency under Rule 55(c) he will submit the file to the Opposition Division for checking. He will do this in particular if the opposition alleges non-patentability under Art. 52, 54 and 56 and the relevant state of the art has been made available to the public by means other than by written description, or if taking of evidence has been requested in accordance with Rule 72.



In this connection the Opposition Division will also examine the extent to which it is necessary for the formalities officer to request the opponent to submit evidence (see IV, 1.2.2.1(v)).

#### 1.2.2.1 Deficiencies under Rule 56(1)

The following deficiencies fall into this category:

(i) The notice of opposition is not filed in writing with the EPO in Munich or its branch at The Hague or its sub-office in Berlin within the nine-month opposition period, calculated from the date of publication of the mention of the grant of the European patent in the European Patent Bulletin (Art. 99(1)).

Accordingly, the opposition is deficient if, for example, notice of opposition is submitted to the EPO belatedly, i.e. after expiry of the nine-month period, or where the opposition is notified within the opposition period but only verbally in a telephone call officially noted in the files. This category of deficiency also includes oppositions which, notwithstanding Art. 99(1), are filed with the central industrial property office of a Contracting State or an authority thereunder and not forwarded by these offices either at all or in time for them to be received by the EPO before the expiry of the opposition period. There is no legal obligation upon these offices or authorities to forward oppositions to the EPO.

(ii) The notice of opposition does not provide sufficient identification of the European patent against which opposition is filed.

Such a deficiency exists if the EPO is unable to identify the relevant patent on the basis of the particulars in the notice of opposition; for example, if only the proprietor of the contested patent and perhaps the title of the invention for which the patent was granted are mentioned in the notice of opposition. Such particulars alone are not an adequate description of the contested European patent, unless the proprietor of the patent who alone is named possesses only one patent or possesses several patents, the subject-matter of only one of which fits the title of the invention given in the notice of opposition, being clearly distinct from the subject-matter of the other patents which this proprietor holds. A mere indication of the number of the contested European patent in the notice of opposition constitutes sufficient identification of the patent concerned, provided that no conflicting information is given, e.g. an inconsistent name for the proprietor, and the conflict cannot be resolved from the information given.

Rule 55(c)

(iii) The notice of opposition contains no statement of the extent to which the European patent is opposed.

Such a deficiency is present if it is not clear from the requisite statement whether the opposition is directed against the entire subject-matter of the patent or only a part thereof, i.e. whether it is directed against all the claims or only against one or a part of one claim, such as an alternative or embodiment.

Rule 55(c)

(iv) The notice of opposition contains no statement of the grounds on which the opposition is based.

A notice of opposition contains such a deficiency if it does not mention at least one of the grounds for opposition referred to in Art. 100 (see III, 5). If non-patentability is given as a ground for opposition, the statement of grounds must at least implicitly indicate which conditions for patentability (Art. 52 to 57) are considered not to have been fulfilled.

Art. 99(1)  
Rule 55(c)

(v) The notice of opposition does not indicate the facts, evidence and arguments presented in support of the opposition.

An opposition is adequately substantiated only if in respect of at least one of his grounds for opposition the opponent adduces facts, evidence and arguments establishing a possible obstacle to patentability under the EPC. He must indicate the technical context and the conclusions he has drawn from it. The content of the statement of grounds must be such as to enable the patent proprietor and the Opposition Division to examine the alleged ground for revocation without recourse to independent enquiries. Unsubstantiated assertions do not meet this requirement. Nor as a rule is mere reference to patent documents enough; unless the document is very short the opponent must indicate on which parts his opposition is based. Where there are allegations that use or oral description are comprised in the state of the art, the Opposition Division must be supplied with an indication of the facts, evidence and arguments necessary for determination of the matters set out under V, 3.1.2 and 3.2.3. See also in this respect T 328/87, OJ 12/1992, 701.

If, where there are multiple grounds for opposition, the facts, evidence and arguments for one ground are sufficiently indicated, the opposition is admissible, even if the facts, evidence and arguments in support of the other grounds for opposition are submitted belatedly. Such belated facts, evidence and arguments are in that event dealt with in accordance with E-VI, 2.

It is immaterial, as far as the question of admissibility of an opposition is concerned, whether and to what extent the facts, evidence and arguments submitted in due time actually warrant revocation of the contested European patent or its maintenance in amended form. On the one

hand, an unconvincing ground of opposition may have been clearly presented and argued (making the opposition admissible), whereas conversely a deficient submission may have been rejected as inadmissible even though, if properly drafted, it could have succeeded (see also T 222/85, OJ 4/1988, 128).

Rule 55(c) An indication of at least one ground of opposition and of the facts, evidence and arguments on which it is based fulfills the prerequisites for admissibility of the opposition in this respect. The evidence itself can also be produced after the expiry of the opposition period. Because of the long opposition period (9 months) it is however recommended, in order to expedite the opposition proceedings, that written evidence indicated in the notice of opposition be submitted in two copies as soon as possible and best of all with the notice of opposition.

Rule 59 Otherwise if his opposition is admissible the opponent will be invited to supply such evidence as soon as possible and as a rule within two months. If the documents thus requested are neither enclosed nor filed within the time limit set the Opposition Division may decide not to take into account any arguments based on them. (As regards evidence not submitted in due time see E-VI, 2 and E-III, 8.6).

Art. 99(1)  
Rule 55(a) (vi) The opposition does not indicate beyond any doubt the identity of the person filing the opposition (Art. 99(1), Rule 55(a).

#### 1.2.2.2 Deficiencies under Rule 56(2)

The following deficiencies fall within this category:

Rule 55(a) (i) The notice of opposition does not state the name and address of the opponent and the State in which his residence or principal place of business is located in the prescribed manner (see III, 6(i)).

Rule 55 (b) (ii) The number of the European patent against which the opposition is filed, or the name of the proprietor of the patent or the title of the invention is not indicated.

Each of the particulars listed in (ii) above must be supplied within the time limit set by the formalities officer (see IV, 1.3.2), even if the contested European patent may be identified by means of one of these or other particulars within the opposition period (see IV, 1.2.2.1(ii)). If the name of the proprietor of the patent as indicated by the opponent is not the same as that recorded in the Register, the formalities officer will inform the opponent of the proprietor's correct name.

- Rule 55(d) (iii) Where the opponent has appointed a representative, the name or the address of the place of business of such representative is not indicated in the notice of opposition in the prescribed manner (see III, 6(iv)).
- (iv) The opponent has neither his residence nor his principal place of business in one of the Contracting States (Art. 133(2)) and has not communicated the appointment of a professional representative (Art. 134). In the communication requesting him to remedy such deficiency the opponent must also be asked to arrange for the signature or approval of the notice of opposition by the representative to be appointed.
- Rule 61a (v) The notice of opposition fails to satisfy further formal requirements other than those mentioned in Rule 56(1). For instance, it may fail to comply with the provisions of Rule 36(2) without due justification.
- Art. 14(4)(5)  
Rule 1(1)  
Rule 6(2)  
Rule 36(3)(5)  
Rule 56(1)(2)  
Rule 101(1)
- 1.3 Issue of communications by the formalities officer as a result of examination for deficiencies
- If, in the course of his examination as described in IV, 1.2, the formalities officer notes deficiencies which may still be remedied, and if there are no deficiencies which may no longer be remedied (in the case of deficiencies which may no longer be remedied see IV, 1.4), he will issue the communications described in IV, 1.3.1 and/or 1.3.2 to the opponent, if possible in a single communication.
- 1.3.1 Communication in the event of deficiencies as described in IV, 1.2.1, which, if not remedied, will lead to the opposition being deemed not to have been filed
- The communication will indicate the deficiencies noted in accordance with IV, 1.2.1 and will state that the opposition will be deemed not to have been filed unless the deficiency or deficiencies are remedied within the time limits indicated in IV, 1.2.1.
- 1.3.2 Communication in the event of deficiencies as described in IV, 1.2.2, which, if not remedied, will lead to rejection of the opposition as inadmissible
- The communication will indicate the deficiencies noted in accordance with IV, 1.2.2.1 or IV, 1.2.2.2 and will state that the opposition will be rejected as inadmissible unless the deficiencies as described in IV, 1.2.2.1 are remedied within the opposition period and unless the deficiencies as described in IV, 1.2.2.2 are remedied within the period stipulated by the formalities officer.

### 1.3.3 Extent of the formalities officer's obligation to issue the above communications

Although the formalities officer is not obliged to do so, he should notify the opponent of deficiencies as described in IV, 1.2.1(i), (iii) and (iv) and IV, 1.2.2.1 in good time before the expiry of the time-limits within which it is still possible to remedy the deficiencies. However, the opponent can seek no legal remedy against failure to issue these communications, which should be regarded merely as a service afforded the opponent by the EPO so as largely to obviate any adverse legal consequences. Deficiencies as described in IV, 1.2.1(ii) and 1.2.2.2 must in any event be officially notified to the opponent, since this is a statutory requirement. Should this communication inadvertently be omitted notwithstanding deficiencies of this type in the notice of opposition, the opponent may submit the missing particulars on his own initiative at any time, even after the expiry of the opposition period without suffering adverse legal consequences.

### 1.4 Subsequent procedure in the event of deficiencies which may no longer be remedied

#### Rule 69(1)

1.4.1 Deficiencies which may no longer be remedied, as a result of which the opposition is deemed not to have been filed.

If the formalities officer establishes that the deficiencies referred to in IV, 1.2.1 have not been remedied within the time limits laid down in the Convention or by the Patent Office, he will inform the opponent in accordance with Art. 119 that the notice of opposition is deemed not to have been filed and that a decision may be applied for under the terms of Rule 69(2), (see E-VIII, 1.9.3). If no such application is made within the prescribed period of two months after notification of this communication, and if there is no other valid opposition pending, the proceedings are closed and the parties informed accordingly. Any opposition fees which have been paid are refunded. The file is returned to the patent registry.

Documents submitted with a notice of opposition which is deemed not to have been filed will form part of the file and will thus be available for inspection in accordance with Art. 128(4). They will be regarded as observations by third parties under Art. 115 (see in this connection V, 2 and E-VI, 3). If a further admissible opposition is pending, the proceedings are continued in respect of it.

1.4.2 Deficiencies which may no longer be remedied in accordance with Rule 56(1) and (2), resulting in the opposition being rejected as inadmissible.

If there are no deficiencies of the type referred to in IV,

1.4.1, but a notice of opposition which is deemed to have been filed reveals deficiencies under the terms of Rule 56(1) (see IV, 1.2.2.1), which may no longer be remedied and which have not been communicated to the opponent in accordance with IV, 1.3.2 (because the opposition period has already expired), the formalities officer must, by virtue of Art. 113(1), notify the opponent of these deficiencies, allowing him time in which to submit comments (normally two months), and point out to him that the notice of opposition is likely to be rejected as inadmissible.

If the opponent does not refute the opinion expressed by the formalities officer on the existence of deficiencies which may no longer be corrected or has failed to remedy in good time deficiencies which may be corrected (Rule 56(2)) and which were communicated to him pursuant to IV, 1.3.2, the formalities officer will reject the notice of opposition as inadmissible, except in the case mentioned in IV, 1.2.2.1 (v) (for which the Opposition Division is competent to decide, see the Notice of the Vice-President of the Directorate-General for Examination and Opposition of the EPO concerning the entrustment to formalities officers of the execution of individual duties falling to the Opposition Divisions of the EPO, dated 15 June 1984, OJ 7/1984, 319 as amended by the Notice dated 1 February 1989, OJ 5/1989, 179). As regards the form of the decision, see E-X, 4 and 5.

In all other cases the formalities officer will submit the opposition documents to the Directorate responsible for the European patent in suit (for designation of an Opposition Division, see IV, 2).

The decision declaring the opposition inadmissible under Rule 56(1) or 56(2) can be taken without the participation of the proprietor of the patent in accordance with Rule 56(3). However, for reasons of procedural economy, the substantive examination is in fact initiated if at least one further admissible opposition is pending. The proprietor of the patent may also comment on the admissibility of the former opposition in the course of that examination.

When the decision declaring the opposition inadmissible has become final the opponent concerned is no longer a party to the proceedings.

1.5 Communications and decisions in the course of the examination as to whether the opposition is deemed to have been filed and is admissible are also notified to the proprietor of the patent. If he files observations on his own initiative concerning such a communication, they may be taken into account in the decision.

1.6 For the subsequent procedure in the event of one or more oppositions with no deficiencies see IV, 5.2.

## 2. Activity of the Opposition Division

Art. 19(2)

The formalities officer submits the files to the competent Directorate on expiry of the periods specified in 5.2, 5.3 and 5.5 and in the remaining (see IV, 1.4.2) cases immediately.

The Director responsible will then designate the three technical members of the competent Opposition Division. The Opposition Division will decide whether one of its members - and if so, which - is to be entrusted with the examination of the opposition up to the taking of a decision (see II, 5). The technical members of the Division should not be designated if the opposition is rejected as inadmissible by the formalities officer and no further admissible opposition has been filed (see IV, 1.4.2).

## 3. Rejection of the opposition as inadmissible by the Opposition Division, the proprietor of the patent not being a party

(for rejection of the opposition as inadmissible at a later stage, the proprietor of the patent being a party, see IV, 5.1).

In cases of insufficient substantiation, where the formalities officer is not competent to decide on the inadmissibility (see IV, 1.2.2.1 (v)), the Opposition Division will either:

- (i) issue the decision rejecting the opposition as inadmissible (when the formalities officer has already informed the opponent of this deficiency pursuant to IV, 1.3.2),
- (ii) consider the opposition admissible and continue with examination of the opposition (see V),
- (iii) or communicate its findings to the opponent in question and at the same time request him to submit observations.

If the opponent does not refute the opinion expressed by the Opposition Division on the existence of these deficiencies which may no longer be corrected, the Opposition Division will reject the notice of opposition as inadmissible. As regards the form of the decision, see E-X, 4 and 5.

The decision will be communicated to the other parties. An inadmissible opposition or documents produced in support of an inadmissible opposition will be placed in the files and will therefore be available for inspection in accordance with Art. 128(4). As regards the possibility of taking them into

consideration as observations by third parties, see V, 2 and E-VI, 3. If there are further admissible oppositions, for reasons of procedural economy this decision to reject the opposition as inadmissible will normally be taken at the end of the procedure together with the decision on the admissible oppositions.

For the possibility of appeal by the opponent and other possible means of redress, see E-XI, 1 and 7.

#### **4. Termination of opposition proceedings in the event of inadmissible opposition**

Under the terms of Art. 101(1), and Rule 57(1), the examination as to whether the European patent can be maintained can only be performed if at least one admissible opposition has been filed. This means that the Opposition Division has to refrain from commenting on the substantive merits of the opposition when expressing an opinion on the inadmissibility of that opposition, if there is no further admissible opposition (see T 925/91, OJ 7/1995, 469). Opposition proceedings are terminated once all notices of opposition filed against a European patent have been rejected as inadmissible and the last decision in this respect has become final. This will be communicated to the parties.

#### **5. Preparation of substantive examination**

5.1 Since the admissibility of an opposition is always open to question by the proprietor no separate communication that the opposition is admissible will be sent to the opponent or the proprietor of the patent. Where deficiencies on the basis of which the notice of opposition is likely to be regarded as inadmissible, but of which the opponent has not been informed by the formalities officer, come to the attention of the Opposition Division in the opposition documents submitted to it or because the proprietor has raised the issue at any stage of the proceedings, it will inform the parties about its reservations in a communication and at the same time request the opponent in question to submit observations. If deficiencies within the meaning of Rule 56(2) are involved, it is sufficient to specify a period for the opponent to remedy such deficiencies.

If the opponent does not refute the opinion expressed by the Opposition Division on the existence of these deficiencies which may no longer be corrected or fails to remedy in good time deficiencies which may be corrected, the Opposition Division will reject the notice of opposition as inadmissible. As regards the form of the decision, see E-X, 4 and 5. For the procedure that follows, see the last two paragraphs of IV, 3.



5.2 Invitation to the proprietor of the patent to submit comments and communication of opposition to the other parties concerned by the formalities officer

Rule 57(1)(2)

If the formalities officer considers that no further ex-officio objection to the admissibility of the or each opposition remains, he will invite the proprietor of the patent, immediately after expiry of the opposition period or the period laid down by the formalities officer for the remedying of the deficiencies in accordance with Rule 56(2) (see 1.2.2.2), or for the presentation of evidence (see 1.2.2.1(v)), "to file his observations" concerning the oppositions communicated earlier "and to file amendments, where appropriate, to the description, claims and drawings within a period to be fixed by him" (normally four months). This also applies to oppositions where a decision to the effect that they are deemed not to have been filed or are inadmissible has not yet been taken or has not yet become final.

"If several notices of opposition have been filed", the formalities officer will "communicate them to the other opponents at the same time as the communication" provided for in the previous paragraph. This will not be combined with an invitation to file observations or the setting of a time limit.

5.3 Filing of amended documents in reply to the notice of opposition

Rule 57a

Any amendments made in opposition proceedings must be occasioned by the grounds for opposition specified in Art. 100. That is to say, amendments can be allowed only if they are required in order to meet a ground for opposition. It is not necessary, however, that the ground for opposition in question was actually invoked by the opponent. For example, in opposition proceedings admissibly opened on grounds of non-patentability, the patent proprietor can also submit amendments to remove added subject-matter. Opposition proceedings cannot be used merely to tidy up and improve the disclosure in the patent specification (see T 127/85, OJ 7/1989, 271). Apart from the above, amendments occasioned by national rights of earlier date are admissible pursuant to Rule 87 (see also C-IV, 6a with the exception of withdrawing the designation and the reference in VII, 4.5 to C-III, 8.4).

If the proprietor proposes amendments to the patent in reply to the grounds of opposition and the Opposition Division intends to maintain the patent in amended form, pursuant to those grounds, other amendments, not related to the grounds of opposition (e.g. corrections, clarifications), may be allowed provided that the thus amended patent still fulfils the requirements of the Convention. Such amendments, however, should not be proposed by the Opposition Division and they can only be taken into

consideration up to the pronouncement of the decision (in oral proceedings) or until the date the decision is handed over to the EPO's internal postal service for transmittal to the parties (in written proceedings) (see Decision G 12/91, OJ 5/1994, 285).

The amended documents should, provided that it is not irrelevant at the stage reached in the procedure, be as complete as possible and drawn up in such a way as to allow the European patent, where appropriate, to be maintained without further delay in the amended version.

These considerations apply also to documents of second preference in which the proprietor proposes amendments for consideration by the Opposition Division only if the Division is unable to grant his main request, for example that the opposition is rejected. In both cases, however, it will be more convenient in certain circumstances to determine first the form of the claims, leaving purely consequential amendments in the description to be dealt with later.

Care must be taken to ensure that any amendments do not offend against Art. 123(2) and (3) (see V, 5 and 6). The proprietor of the patent should, where this is not obvious, indicate the points in the original application documents or claims of the granted patent from which the amendments may be derived (Art. 100(c) and Art. 123(2)). In addition, he should file observations as regards the patentability of the subject-matter of the patent as amended (with reference to Art. 100(a) and 100(b)), taking into account the state of the art and objections raised in the opposition notice together, where appropriate, with the evidence presented in support. It must also be checked that the patent, by the amendments **themselves**, does not contravene the requirements of the Convention (with the exception of Art. 82, see V,2). For the form of amended documents see E-II.

Rule 57(3)

5.4 Communication of observations from one of the parties to the other parties

The formalities officer will, at any stage in the procedure, immediately communicate the observations of any of the parties to the other parties for information.

If the proprietor of the patent files amended documents with his observations, where applicable as part of an alternative request, the formalities officer will invite the other parties to submit observations within a period to be fixed by him (normally four months).

If the Opposition Division considers that observations are called for in the course of the further procedure, a separate invitation is issued and a period is fixed (normally four

months), with or without a communication stating the grounds.

#### 5.5 Decision concerning the admissibility of an opposition, the proprietor of the patent being a party

If the proprietor of the patent, when replying to the notice of opposition, contends that the opposition is inadmissible pursuant to Rule 56(1) and (2), because of deficiencies which are to be specified, the opponent concerned must be given the opportunity to submit his comments within a period fixed by the formalities officer (two months).

If the Opposition Division concludes that the opposition is inadmissible it must as a rule first take a reasoned decision, against which an appeal shall lie. If, on the other hand, on the basis of another - admissible - opposition, an immediate decision can be taken on the rejection of the opposition or oppositions or on the revocation of the patent, the decision on admissibility is to be taken together with this final decision.

If, despite the observations of the proprietor of the patent, the Opposition Division concludes that the opposition is admissible, the decision on admissibility is normally to be taken together with the final decision, especially where at least one other admissible opposition exists. If there are only oppositions where the admissibility is doubtful, a reasoned intermediate decision should be issued, against which an appeal shall lie, provided that this will not unduly delay the proceedings.

An opponent whose opposition has been finally rejected as inadmissible is no longer a party to the subsequent proceedings once this decision becomes final.

#### Rule 57(4)

#### 5.6 Examination of the admissibility of an intervention and preparations in the event of an intervention

When examining whether an intervention is admissible, the formalities officer and the Opposition Division should proceed as for the examination as to admissibility of an opposition (see IV, 1, 3 and 5.5) but on the basis of the requirements for intervention under Art. 105.

#### Rule 61a

Rule 36(4) will apply in respect of the documents to be sent, in accordance with IV, 5.2 and 5.4, to the parties including, where appropriate, a third party who has validly intervened (see also III, 3.1). Paragraphs IV, 5.1 and 5.4 may however be disregarded in the case of an application for intervention in opposition proceedings.

Accordingly, particularly in the case of proceedings which are at an advanced stage, the formalities officer will inform third parties who have intervened of the progress of the

proceedings and request them to indicate within one month whether they will also require the documents received from the parties in accordance with Rule 57(1), (2) and (3), together with the communications from the Opposition Division and the observations of the parties under Rule 58(1), for the preceding period. If this is the case, the formalities officer should also provide the documents filed in accordance with Rule 36(4), for the preceding period and send them with the relevant communications from the Opposition Division or the formalities officer to the intervening third party.

**CHAPTER V**

## SUBSTANTIVE EXAMINATION OF OPPOSITION

Art. 101(1)

**1. Beginning of the examination of the opposition**

Art. 101(1)

Once the preparations for the examination of the opposition have been completed pursuant to Rule 57, "the Opposition Division shall examine whether the grounds for opposition (see III, 5) laid down in Art. 100 prejudice the maintenance of the European patent". The examination may also begin if a single admissible opposition has been withdrawn in the interim (see VII, 6.3). If the opponent has died or is legally incapacitated, the examination may begin even without the participation of the heirs or legal representatives (see VII, 6.2).

Art. 114

**2. Extent of the examination**

## 2.1 Extent to which the patent is opposed

In the unusual case where an opposition is limited to only a certain part of the patent, the Opposition Division has to limit its examination to the part opposed (see Decision G 9/91, OJ 7/1993, 408).

## 2.2 Examination of the grounds for opposition

As a general rule the Opposition Division will confine its examination to those grounds for opposition brought forward by the opponent. If, for example, the opposition is filed only on the grounds that the subject-matter of the European patent is not adequately disclosed or that it extends beyond the content of the patent application as filed, the Opposition Division will examine the patentability of the subject-matter of the European patent pursuant to Art. 52 to 57 only if facts have come to its notice which, **prima facie**, wholly or partially prejudice the maintenance of the patent (see Opinion G 10/91, OJ 7/1993, 420).

If, therefore, once the proceedings for examining the opposition(s) have been initiated, because an admissible opposition has been filed (although it may have been withdrawn in the interim), there is reason to believe that other grounds exist which, *prima facie*, in whole or in part prejudice the maintenance of the European patent, these grounds should generally be examined by the Opposition Division of its own motion pursuant to Art. 114(1). Such other grounds may result from facts emerging from the search report or the examination procedure, the examiner's personal knowledge or observations presented by third parties pursuant to Art. 115 (see also E-VI, 3). Such grounds may also have been put forward in an opposition which has been withdrawn, in another opposition which has been rejected as inadmissible, or in another opposi-

tion deemed not to have been filed. They may also be any grounds submitted belatedly (see E-VI, 1.1 and 2). In carrying out such examination the Opposition Division should however take the interests of procedural expediency into account (see E-VI, 1.2). If the decision is to be based on grounds to be taken into account pursuant to Art. 114(1), the parties must be given the opportunity to comment (see E-X, 1).

Pursuant to Art. 100, the absence of unity of invention is not a ground for opposition (see III, 5).

Art. 82

Since unity of invention under Art. 82 is only required for the European patent application, the unity of the subject-matter of the European patent may not be examined by the Opposition Division, even of its own motion. In particular, where the facts, evidence and arguments which come to light in the opposition proceedings lead to the maintenance of the European patent in amended form, there should be no further examination as to whether the remaining subject-matter of the patent contains a single invention or more than one. Any lack of unity must be accepted (see Decision G 1/91, OJ 6/1992, 253).

The grounds for opposition laid down in Art. 100 are examined in greater detail below.

Art. 100(a)

### **3. Non-patentability pursuant to Art. 52 to 57**

The same substantive requirements apply in the opposition procedure regarding patentability pursuant to Art. 52 to 57 as in the examination procedure. Part C, Chapter IV should therefore also be applied in opposition proceedings. However, it will be more common in opposition proceedings than in examination procedure for the examination as to patentability to be based on the state of the art as made available to the public not by written description but "by means of an oral description, by use, or in any other way" (see Art. 54(2)). The above-mentioned ways in which the state of the art may be made available to the public will accordingly be considered in more detail below.

Art. 54(2)

3.1 State of the art made available to the public "by use or in any other way"

3.1.1 Types of use and instances of state of the art made available in any other way

Use may be constituted by producing, offering, marketing or otherwise exploiting a product, or by offering or marketing a process or its application or by applying the process. Marketing may be effected, for example, by sale or exchange.

The state of the art may also be made available to the public in other ways, as for example by demonstrating an object or process in specialist training courses or on television.

Availability to the public in any other way also includes all possibilities which technological progress may subsequently offer of making available the aspect of the state of the art concerned.

### 3.1.2 Matters to be determined by the Opposition Division as regards use

When dealing with an allegation that an object or process has been used in such a way that it is comprised in the state of the art, the Opposition Division will have to determine the following details:

(i) the date on which the alleged use occurred, i.e. whether there was any instance of use before the relevant date (prior use),

(ii) what has been used, in order to determine the degree of similarity between the object used and the subject-matter of the European patent,

(iii) all the circumstances relating to the use, in order to determine whether and to what extent it was made available to the public, as for example the place of use and the form of use. These factors are important in that, for example, the details of a demonstration of a manufacturing process in a factory or of the delivery and sale of a product may well provide information as regards the possibility of the subject-matter having become available to the public.

On the basis of the submissions and the evidence already submitted, e.g. documents confirming sale, or affidavits related to the prior use, the Opposition Division will first establish the relevance of the alleged prior use. If on the basis of this assessment it is of the opinion that the prior use is sufficiently substantiated and relevant, it may decide on the opposition using the submissions and the evidence, if the patentee does not contest the prior use. If the patentee does contest it or certain circumstances of it, the Division will need to take further evidence, if offered (e.g. hearing witnesses or performing an inspection) for those facts which are relevant to the case and which cannot yet be considered proven on the basis of the evidence already submitted. Evidence is always taken under participation of the parties, normally in oral proceedings. For details concerning means of evidence see E-IV, 1.2.

### 3.1.3 Ways in which subject-matter may be made available

#### 3.1.3.1 General principles

Subject-matter should be regarded as made available to the public by use or in any other way if, at the relevant date, it was possible for members of the public to gain knowledge of the subject-matter and there was no bar of confidentiality restricting the use or dissemination of such knowledge (see also C-IV, 5.2 with reference to written descriptions). This may, for example, arise if an object is unconditionally sold to a member of the public, since the buyer thereby acquires unlimited possession of any knowledge which may be obtained from the object. Even where in such cases the specific features of the object may not be ascertained from an external examination, but only by further analysis, those features are nevertheless to be considered as having been made available to the public. This is irrespective of whether or not particular reasons can be identified for analysing the composition or internal structure of the object. These specific features only relate to the intrinsic features. Extrinsic characteristics, which are only revealed when the product is exposed to interaction with specifically chosen outside conditions, e.g. reactants or the like, in order to provide a particular effect or result or to discover potential results or capabilities, therefore point beyond the product per se as they are dependent on deliberate choices being made. Typical examples are the application as a pharmaceutical product of a known substance or composition (cf. Art. 54(5)) and the use of a known compound for a particular purpose, based on a new technical effect (cf. Decision G 2/88, OJ 4/1993, 93). Thus, such characteristics cannot be considered as already having been made available to the public (see Opinion G 1/92, OJ 5/1993, 277).

If, on the other hand, an object could be seen in a given place (a factory, for example) to which members of the public not bound to secrecy, including persons with sufficient technical knowledge to ascertain the specific features of the object, had access, all knowledge which an expert was able to gain from a purely external examination is to be regarded as having been made available to the public. In such cases, however, all concealed features which could be ascertained only by dismantling or destroying the object will not be deemed to have been made available to the public.

#### 3.1.3.2 Agreement on secrecy

The basic principle to be adopted is that subject-matter has not been made available to the public by use or in any other way if there is an express or tacit agreement on secrecy which has not been broken (reference should be made to the particular case of a non-prejudicial disclosure



arising from an evident abuse in relation to the applicant, in accordance with Art. 55(1) (a)), or if the circumstances of the case are such that such secrecy derives from a relationship of good faith or trust. Good faith or trust are factors which may occur in contractual or commercial relationships.

#### 3.1.3.3 Use on non-public property

As a general rule, use on non-public property, for example in factories and barracks, is not considered as use made available to the public, because company employees and soldiers are usually bound to secrecy, save in cases where the objects or processes used are exhibited, explained or shown to the public in such places, or where specialists not bound to secrecy are able to recognise their essential features from the outside. Clearly the above-mentioned "non-public property" does **not** refer to the premises of a third party to whom the object in question was unconditionally sold or the place where the public could see the object in question or ascertain features of it (see the examples in 3.1.3.1 above).

#### 3.1.3.4 Example of the accessibility of objects used

A press for producing light building (hard fibre) boards was installed in a factory shed. Although the door bore the notice "Unauthorised persons not admitted", customers (in particular dealers in building materials and clients who were interested in purchasing light building boards), were given the opportunity of seeing the press although no form of demonstration or explanation was given. An obligation to secrecy was not imposed as, according to witnesses, the company did not consider such visitors as a possible source of competition. These visitors were not genuine specialists, i.e. they did not manufacture such boards or presses, but were not entirely laymen either. In view of the simple construction of the press, the essential features of the invention concerned were bound to be evident to anyone observing it. There was therefore a possibility that these customers, and in particular the dealers in building materials, would recognise these essential features of the press and, as they were not bound to secrecy, they would be free to communicate this information to others.

#### 3.1.3.5 Example of the inaccessibility of a process

The subject of the patent concerns a process for the manufacture of a product. As proof that this process had been made available to the public by use, a similar already known product was asserted to have been produced by the process claimed. However, it could not be clearly ascertained, even after an exhaustive examination, by which process it had been produced.

Art. 54(2)

3.2 State of the art made available by means of oral description

3.2.1 Cases of oral description

The state of the art is made available to the public by oral description when facts are unconditionally brought to the knowledge of members of the public in the course of a conversation, a lecture, or by means of radio, television or sound reproduction equipment (tapes and records).

3.2.2 Non-prejudicial oral description

Art. 55(1)(a)

The state of the art will not be affected by oral descriptions made by and to persons who were bound to, and preserved, secrecy, nor by an oral disclosure which was made no earlier than six months before the filing of the European patent application and which derives directly or indirectly from an evident abuse in relation to the applicant or his legal predecessor. In determining whether evident abuse has occurred, note C-IV, 8.3.

3.2.3 Matters to be determined by the Opposition Division in cases of oral description

Once again, in such cases the following details will have to be determined:

- (i) when the oral description took place,
- (ii) what was described orally,
- (iii) whether the oral description was made available to the public; this will also depend on the type of oral description (conversation, lecture) and on the place at which the description was given (public meeting, factory hall; see also V, 3.1.2 (iii)).

3.3 State of the art made available to the public in writing or by any other means

For this state of the art corresponding details to those defined in 3.2.3 have to be determined, if they are not clear from the written or otherwise made available disclosure itself or if they are contested by a party.

If a piece of information is made available by means of a written description and use or by means of a written and oral description, but only the use and the oral description are made available before the relevant date, then in accordance with C-IV, 5.2, the subsequently published written description may be deemed to give a true account of that oral description or use, unless the proprietor of the patent can give good reason why this should not be the case. In this case the opponent must adduce proof to the

contrary in respect of the reasons given by the proprietor of the patent.

Art. 100(b)

#### **4. Insufficient disclosure of the invention**

##### 4.1 Required form of disclosure

The determination whether the disclosure of an invention in a European patent application is sufficient is dealt with in C-II.

The principles set out there will also apply *mutatis mutandis* to the opposition procedure. The overriding consideration in this context is in the first place the disclosed content of the European patent specification, that is to say what a person skilled in the art is able to infer from the patent claims, description and the drawings, if any, without reflection as to inventivity. Pursuant to Art. 100(b), the patent has to disclose the invention in a manner sufficiently clear and complete for it to be carried out by persons skilled in the art. If the patent specification does not disclose the invention sufficiently clearly to enable it to be carried out in accordance with Art. 100(b), this may be remedied, provided the original documents contained a sufficient disclosure, but subject to the condition that, as required under Art. 123(2), the subject-matter of the European patent does not extend beyond the content of the application as filed and, as required under Art. 123(3), the protection conferred is not extended.

Rule 28(1)(2)

##### 4.2 Disclosure of inventions relating to micro-organisms

The relevant details in this connection will be found in C-II, 6.

##### 4.3 Burden of proof as regards the possibility of performing and repeating the invention

If the Opposition Division has serious doubts as regards the possibility of performing the invention and repeating it as described, the burden of proof as regards this possibility, or at least a demonstration that success is credible, rests with the proprietor of the patent. This may be the case where, for example, experiments carried out by the opponent suggest that the subject-matter of the patent does not achieve the desired technical result. As regards the possibility of performing and repeating the invention, see also C-II, 4.11.

##### 4.4 Cases of partially insufficient disclosure

###### 4.4.1 Only variants of the invention are incapable of being performed

The fact that only variants of the invention e.g. one of a

number of embodiments of the invention are not capable of being performed should not immediately give rise to the conclusion that the subject-matter of the invention as a whole is incapable of being performed, i.e. is incapable of resolving the problem involved and therefore of achieving the desired technical result.

Those parts of the description relating to the variants of the invention which are incapable of being performed and the relevant claims must however then be deleted at the request of the Opposition Division if the deficiency is not remedied. The patent specification must then be so worded that the remaining claims are supported by the description and do not relate to embodiments which have proved to be incapable of being performed.

Any failure to rectify these deficiencies without good reason will result in the patent being revoked.

#### 4.4.2 Absence of obvious details

For the purposes of sufficient disclosure the patent does not need to describe all the details of the operations to be carried out by the person skilled in the art on the basis of the instructions given, if these details are obvious and clear from the definition of the class of the claims or on the basis of general expert knowledge (see also C-II, 4.9 and C-III, 4.4).

#### 4.4.3 Difficulties in performing the invention

An invention should not be immediately regarded as incapable of being performed on account of a reasonable degree of difficulty experienced in its performance ("teething troubles", for example).

1st Example: The difficulties which could, for example, arise from the fact that an artificial hip-joint could be fitted to the human body only by a surgeon of great experience and above-average ability would not prevent manufacturers of orthopaedic devices from deriving complete information from the patent with the result that they could reproduce the invention with a view to making an artificial hip-joint.

2nd Example: A switchable semi-conductor which, according to the invention, is used for switching electrical circuits on and off without using contacts, thereby making for smoother operation, suffers from teething troubles in that a residual current continues to flow in the circuit when switched off. However this residual current adversely affects the use of the electrical switch in certain fields only, and can otherwise be reduced to negligible proportions by routine further development of the semi-conductor.

Art. 100(c)

**5. Subject-matter of the European patent extending beyond the original disclosure**

## 5.1 Basis of this ground for opposition

This ground for opposition under Art. 100(c), refers back to Art. 123(2), which stipulates that the subject-matter of a European patent may not extend beyond the content of the application as filed. If the patent was granted on a European divisional application (Art. 76(1)) or on a new European patent application by the person entitled thereto (Art. 61), the subject-matter may not extend beyond the content of the earlier application as filed. In the case of a patent granted on an application filed in accordance with Art. 14(2), the original text shall, as provided for in Art. 70(2), constitute the basis for determining whether the subject-matter of the European patent extends beyond the content of the application as filed. However, unless, for example, the opponent adduces proof to the contrary the Opposition Division may, under Rule 7, assume that the translation referred to in Art. 14(2), is in conformity with the original text of the application.

## 5.2 Distinction between admissible and inadmissible amendments

The distinction between admissible amendments to the content of the earlier application and those which are at variance with Art. 123(2) has already been set forth in C-VI, 5 (more specifically C-VI, 5.3 to 5.8b) and C-VI, 9 (more specifically C-VI, 9.1, 9.4, 9.5 and 9.10). These Guidelines should be applied *mutatis mutandis* in the course of opposition proceedings in cases where the subject-matter of the European patent as granted or as amended during the opposition proceedings extends beyond the content of the application as filed.

Art. 123(3)

**6. Inadmissible extension of protection**

## 6.1 General remarks

Art. 69(2)

"The European patent as granted or as amended in opposition proceedings shall determine retroactively the protection conferred by the European patent application, in so far as such protection is not thereby extended."

The opposition proceedings will frequently give rise to amendments to the claims, following from grounds for opposition raised under Art. 100. Reasoned requests filed independently by the proprietor of the patent for an amendment to the claims, e.g. for limitation of the patent in view of an aspect of the state of the art which has come to his knowledge, may also result in amendments to the claims after examination by the Opposition Division.

Art. 123(3) In such cases "the claims of the European patent may not be amended in such a way as to extend the protection conferred" by the patent.

Art. 69(1) "The extent of protection conferred by a European patent shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims."

The Protocol on the Interpretation of Art. 69, which is, pursuant to Art. 164(1), an integral part of the Convention, specifies how Art. 69 is to be interpreted. =====

Since, pursuant to Art. 69(1), amendments to the description and drawings will also influence the interpretation of the claims, and may therefore extend the protection conferred, any such amendments extending protection in this way are inadmissible (see also Decision G 1/93, OJ 8/1994, 541).

#### 6.2 Examination of amendments to the claims

In view of the above considerations, all amendments made to claims and any connected amendments to the description and drawings in the course of opposition proceedings, such as a change in the technical features of the invention, must be examined to determine whether such amendments could result in the extension of the subject-matter beyond the content of the application as originally filed (Art. 123(2)) or in the extension of the protection conferred (Art. 123(3)).

A possible conflict between the requirements of Art. 123 (2) and 123 (3) may occur where in the procedure before grant a feature was added to the application, which is considered inadmissible under Art. 123(2) in opposition proceedings. In that case Art. 123 (2) would require deletion of such a feature whereas Art. 123 (3) would not allow deletion, as this would extend the protection conferred by the patent as granted. In such a case the patent will have to be revoked under Art. 100 (c). However, where this feature can be **replaced** by a feature for which there is a basis in the application as filed **and** which does not extend the protection conferred by the patent as granted, maintenance in this amended form can be allowed. If the added feature, **without providing a technical contribution to the subject-matter of the claimed invention**, merely limits the protection conferred by the patent as granted by excluding protection for part of the subject-matter of the claimed invention as covered by the application as filed, this feature may be maintained (see Decision G 1/93, OJ 8/1994, 541).

Other requirements of the EPC may also interact with Art. 123(3) after grant. For instance, if a patent as granted

only contains claims that in fact define a "method for treatment of the human or animal body by therapy or surgery practised on the human or animal body" or contain such a method step, and such a patent is opposed under Art. 52(4), then Art. 52(4) and 123(3) may operate in combination so that the patent must inevitably be revoked, in that:

- the patent cannot be maintained as granted because its claims define subject-matter which is unpatentable under Art. 52(4);
- the patent cannot be maintained in amended form because amendment of the claims as granted by deletion of such "method features" would be contrary to Art. 123(3) (see T 82/93, OJ 5/1996, 274).

### 6.3 Change of category of claim.

Rule 57a  
Art. 123(3)

An amendment can be in the form of a change in the category of a claim, possibly combined with a change in the technical features of the invention. Firstly it must be clear that this amendment is necessitated by grounds of opposition (see IV, 5.3). If that is not the case a change of category should be refused.

Even if this condition is fulfilled, the opposition division should exercise great caution in allowing a change of claim category, because the protection as conferred by the claims may be extended (Art. 123(3)). The change of category requested could involve a change from:

(i) "Product" to "use"

If a patent is so amended that a claim to a product (a physical entity) is replaced by a claim to the use of this product, the degree of protection is not extended, provided that the use claim in reality defines the use of a particular physical entity to achieve an effect and does not define such a use to produce a product (Decision G 2/88, OJ 4/1990, 93).

(ii) "Product" to "method"

If a patent is so amended that a claim to a product is replaced by a claim to a method for producing the product, this change of category is allowable, provided that the method now claimed only results in the product previously claimed. As it is a fundamental principle of European patent law that the protection conferred by a product claim covers all methods for production of the product, the limitation to one of these methods cannot extend the protection conferred originally (see T 5/90 and T 54/90, both not published in OJ).

(iii) "Method" to "product"

If a patent is so amended that a claim to a method of operating a device is replaced by a claim directed to the device itself, this change of category is allowable, provided that the original claim contains the claimed features of the device exhaustively, whether in structural or functional terms (see T 378/86, OJ 10/1988, 386 and T 426/89, OJ 4/1992, 174). If, however, the device as now claimed is for its features no longer dependent on the circumstances of its operation whereas it depended thereon under the terms of the prior method claim, then such a change of category should not be allowed (T 82/93, OJ 5/1996, 274).

By contrast, the change in claim category from a method in which an apparatus is used, to the apparatus itself, is not allowable (T 86/90, not published in OJ).

(iv) "Method" to "use"

Not allowable either is the change from a process for the preparation of a product to the use of the product for another purpose than previously described (T 98/85 and T 194/85, both not published in OJ). The change in a claim from a method, in which a certain product is used, to a claim to the use of that product in performing that same method is, on the other hand, allowable (see T 332/94, not published in OJ).



**CHAPTER VI****PROCEDURE FOR THE EXAMINATION OF THE OPPOSITION**

(oral proceedings: see E-III; taking and conservation of evidence: see E-IV)

**1. General remarks**

The Opposition Division will first of all endeavour to reach a decision in written proceedings. Taking account of the investigations usually conducted beforehand by a primary examiner (see II, 5 and 6), the Opposition Division will base itself on the written submissions of the parties and, where appropriate, on other written evidence obtained, in particular, through the production of documents, requests for information and sworn statements in writing.

The evidence should be submitted as soon as possible (see IV, 1.2.2).

However, if the Opposition Division considers it expedient, or if any party requests oral proceedings, oral proceedings in accordance with Art. 116(1), will be held before the Opposition Division after suitable preparation. In the oral proceedings the parties may state their cases and put forward and argue submissions in order to clarify outstanding questions. Members of the Opposition Division may put questions to the parties.

**Rule 72(1)**

In special, less common, cases it will occasionally prove necessary in opposition proceedings for oral evidence to be taken by the Opposition Division as part of oral proceedings or for the conservation of evidence, or by a primary examiner outside the oral proceedings. The Opposition Division is not obliged to take oral evidence if it does not consider it necessary, even if a party has so requested. Oral evidence may be taken, where appropriate under oath, before the competent court in the country of residence of the person to be heard. A member of the Opposition Division may, at the request of the Opposition Division, attend such court hearings (see E-IV, 1.3).

The principal means of taking oral evidence will be the hearing of witnesses and parties (see E-IV, 1.6).

Only in exceptional cases will evidence be obtained at the initiative of the Opposition Division by means of oral and/or written reports by experts (see E-IV, 1.8.1) or by carrying out an inspection (see E-IV, 1.2, last paragraph). In view of the specialised knowledge of the members of the Opposition Division - and of the costs involved - such means should be used only as a last resort.

- Art. 113(2) **2. Adherence to the text of the European patent submitted or approved by the proprietor**
- 2.1 If, after the notice of opposition has been communicated to him, the proprietor of the patent submits amendments to the description, claims or drawings (see IV, 5.3), the Opposition Division must take as a basis for its examination the text of the European patent submitted by the proprietor. This principle, that the Opposition Division must concern itself solely with the text most recently "submitted or agreed by the proprietor", also applies for the rest of the opposition procedure. (As regards the possibility of amending texts, see V, 6.1, second paragraph.)
- 2.2 If the proprietor states that he no longer approves the text in which the patent was granted and does not submit an amended text, the patent must be revoked. This also applies when the proprietor requests that the patent be revoked (Legal Advice No. 11/82, OJ 2/1982, 57).
- Art. 101(2) **3. Invitation to file observations**
- 3.1 Examiners' communications
- "In the examination of the opposition, the Opposition Division shall invite the parties, as often as is necessary", to elucidate the substance of the case, "to file observations, within a period to be fixed by the Opposition Division, on communications from another party or issued by itself" (see E-I, 1) and, where appropriate, to adduce evidence in respect of matters under dispute. As regards the length of the period see E-VIII, 1.2, as regards the extension of a period see E-VIII, 1.6 and as regards late submission of observations see E-VIII, 1.7 and 1.8 as well as Art. 114(2).
- Rule 58(1) "Communications" from the Opposition Division "and all replies there to shall be communicated to all parties".
- 3.2 Summons to oral proceedings
- Art. 116(1) If oral proceedings have to be arranged, the parties are  
Rule 71(1) summoned to them as quickly as possible at reasonable notice (see E-III, 6).
- Rule 71a(1) Together with the summons the Opposition Division will draw attention to and explain in an annexed note the points which in its opinion need to be discussed for the purposes of the decision to be taken; where this has already been done sufficiently in a prior communication it is appropriate to refer to that communication. Normally, the annex will also contain the provisional and non-binding opinion of the Opposition Division on the positions adopted by the parties and in particular on amendments filed by the proprietor of the patent. At the same time a date will be fixed up to which written submissions may be made or

amendments meeting the requirements of the EPC may be filed. Normally this date will be one month before the date of the oral proceedings. However, an earlier date may be advisable if it is anticipated that a party will reasonably need more time, for example to consider the results of comparative tests filed by the other party. With respect to this date Rule 84 does not apply, i.e. this time limit cannot be extended on request of the parties.

#### **4. Communications from the Opposition Division to the proprietor of the patent**

Rule 58(3)

4.1 Communications from the Opposition Division: reasoned statement

"Where necessary, any communication to the proprietor of the European patent shall contain a reasoned statement." This will apply, too, for any communication to other parties which is communicated to the proprietor of the patent only for information. A reasoned statement will usually not be required if the communication concerns only matters relating to form or if it contains no more than self-explanatory proposals. "Where appropriate, all the grounds against the maintenance of the European patent" are to be given in the communication.

Rule 58(2)

4.2 Invitation to file amended documents

If the Opposition Division considers that the European patent cannot be maintained in an unamended form, but that a more limited text might be acceptable, it must inform the proprietor of the patent accordingly, stating the grounds, and in appropriate cases invite him "to file, where necessary, the description, claims and drawings in amended form." As regards the time limit here, see E-VIII, 1.2. Where necessary, the description adjusted in line with the new claims should also deal with the state of the art as set out in the opposition proceedings, the technical purpose and the advantages of the invention as it will then stand. The Opposition Division may itself make proposals for amendments to the documents and in this case it should point out to the proprietor of the patent that they are no more than proposals, which he is free to accept on his own responsibility and as he sees fit, but that the patent may be revoked if it remains in a form that is open to objection on the grounds set forth.

Proposals for amendment filed at a late stage in the proceedings may be disregarded (see T 406/86, OJ 7/1989, 302).

For amended documents, see E-II.

### 5. Additional search

In exceptional cases the Opposition Division, like the Examining Division, may, on its own initiative, cite new material relating to the state of the art and take it into account in its subsequent decision (see C-VI, 8.9). In the normal course of events however, since the grant of the patent will have been preceded by a search into the subject-matter of the application by the Search Division, the Examining Division and, generally, by the opponents, no additional search will be made. Only in exceptional cases should an additional search by the Search Division be set in train. Such a case might arise, for example, if in the opposition the main subject covered by the patent shifts to elements of a dependent claim which were originally of subsidiary importance, to elements which were previously not set out in the claims, but only in the description, to individual features of a combination, or to subcombinations, and there are grounds for believing that the original search did not extend to such elements or features and if no relevant document can be found quickly in the circumstances set out in C-VI, 8.9.

### 6. Examination of the opposition during oral proceedings

For details regarding the examination shortly before and during oral proceedings and the conduct thereof, see E-III, 8.

### 7. Preparation of the decision

#### 7.1 General remarks

Art. 116(1)  
Rule 72(1)

If the Opposition Division does not consider it expedient to arrange for oral proceedings of its own motion (see E-III, 4) or for the taking of evidence even where the latter is requested (see E-IV), and if no admissible request for oral proceedings has been received from a party (see E-III, 2), the decision must be reached on the basis of written proceedings. In this case there is no obligation to arrange for oral proceedings before a decision is reached.

If the case is decided on the basis of written proceedings, submissions filed after the decision has been handed over to the EPO internal postal service for remittal to the parties can no longer be considered, as from that moment the Division cannot amend the decision (see Decision G 12/91, OJ 5/1994, 285) except to the limited extent provided for in Rule 89 (cf. E-X, 10).

The decision, whether or not preceded by oral proceedings or the taking of evidence, may be to revoke the patent (see VIII, 1.2), to reject the opposition (see VIII, 1.3) or to maintain the patent as amended (see VIII, 1.4).

## 7.2 Preparation of decision maintaining a European patent in amended form

### 7.2.1 Procedural requirements

Art. 113

A decision may be delivered only when the patent proprietor has approved the text in which the Opposition Division proposes to maintain the patent and the opponent has had sufficient opportunity to comment on the proposed new text.

Both prerequisites can be fulfilled during oral proceedings. In written proceedings, the necessary opportunity to comment on the new text proposed by the Opposition Division can also be given to the opponent when a communication is issued to the parties. Once these requirements have been met, a separate communication under Rule 58(4) is neither necessary nor appropriate (see Decision G 1/88, OJ 6/1989, 189).

If the patent can be maintained in the amended form, the Opposition Division should immediately try to obtain the patent proprietor's approval of the text in which the patent can be maintained and give the opponent an opportunity to comment thereon. An interlocutory decision can then be delivered straight away.

If these requirements have still not been met and no oral proceedings are being held, a communication under Art. 101(2) must be issued. This also applies when it has been established in principle that the patent can be maintained in a particular form but a complete text expressly approved by the patent proprietor is not yet available.

The patent proprietor's approval of an amended version of the patent need not be given in a separate, express declaration; it may also be apparent from the circumstances, in particular from the fact that he has filed or requested the amended version. This applies equally to versions which have been filed as a subsidiary request. (For the wording of documents in oral proceedings, see E-III, 8.9 and 9.)

Rule 58(4)

The patent proprietor's approval can also be obtained through a communication under Rule 58(4) in which the Opposition Division informs the parties that it "intends to maintain the patent as amended" and invites them to "state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent". If the patent proprietor fails to file objections to the text thus notified, he is considered to approve of it.

Generally speaking, this communication is useful only if the Opposition Division considers that the complete document expressly approved by the patent proprietor, on which the opponent has been able to comment, still requires amendments. However, these must not go beyond such editorial changes to the wording as appear absolutely necessary by comparison with the text most recently submitted or approved by the patent proprietor. The Opposition Division should draw attention to such amendments and state why they are required if they are not self-explanatory.

If within the period specified in the communication, or in a communication under Rule 58(4), the patent proprietor objects to the text in which the patent is to be maintained, the proceedings are continued. The European patent can be revoked in the subsequent proceedings if the patent proprietor objects to the text and fails to submit new, properly amended documents despite having been requested to do so.

If an opponent objects to the text communicated to him, in which it is intended to maintain the patent, the Opposition Division will continue examining the opposition if it considers that the Convention prejudices the maintenance of the patent in the text initially envisaged.

#### 7.2.2 Decision on the documents on the basis of which the patent is to be maintained

If the Opposition Division considers that the patent can be maintained on the basis of the text submitted or approved by the patent proprietor, and the opponent has had sufficient opportunity to comment on this text - either in writing or during oral proceedings - as well as on the reasons decisive to the patent's maintenance, the Opposition Division will issue an interlocutory decision to the effect that the patent and the invention to which it relates meet the requirements of the EPC following the amendments made by the patent proprietor during the opposition proceedings. If the patent can only be maintained on the basis of an auxiliary request, the decision has to contain a reasoned statement why the version of the main request (and any preceding auxiliary request) does not meet the requirements of the Convention (see T 234/86, OJ 3/1989, 79).

A separate appeal under Art. 106(3) EPC is allowed against this decision, which must be reasoned having regard to the grounds for opposition maintained by the opponent or taken up by the Opposition Division. The decision is delivered in all cases where a European patent is maintained in amended form, even if the opponent has approved of the text communicated by the Opposition Division or has not commented on it. If this decision is not

contested, the ruling enshrined in it becomes final and as a result the documents can no longer be amended.

This interlocutory decision is intended to save the patent proprietor unnecessary translation costs arising from an amendment to the text in appeal proceedings.

### 7.2.3 Request for printing fee and translations

Art. 102(3)(b)  
Art. 102(5)  
Rule 58(5)

Once the interlocutory decision becomes final or the amended texts in which the patent is to be maintained have been drawn up in opposition appeal proceedings, the formalities officer requests "the proprietor of the patent to pay, within three months, the fee for the printing of a new specification of the European patent and to file a translation of any amended claims in the two official languages of the EPO other than the language of the proceedings."

If the European patent in the amended form contains different claims for different Contracting States, a translation of all sets of claims - in the text communicated to the proprietor of the patent - into all official languages different from the language of the proceedings must be filed.

Rule 58(7)

"The communication under the foregoing paragraph shall indicate the designated Contracting States which require a translation pursuant to Art. 65(1)."

Art. 102(4)(5)  
Rule 58(6)

If the request under the first paragraph above is not complied with "in due time", the acts may still be validly performed within two months of notification of a communication pointing out the failure to observe the time limit, provided that within this two-month period a surcharge equal to twice the fee for printing a new specification of the European patent is paid. If one of the acts is not performed within the period of grace, the formalities officer will issue a decision for revocation of the patent in accordance with Art. 102(4).

**CHAPTER VII****DETAILS AND SPECIAL FEATURES OF THE PROCEEDINGS****1. Sequence of proceedings****1.1 Basic principle**

The examination of the admissibility of the opposition and preparation of the examination of the opposition should be commenced immediately after the notice of opposition has been received by the formalities officer or the Opposition Division (see IV, 1 and 3 and V, 1 and 2).

If during the rest of the proceedings, the Opposition Division, on account of the amount of work in hand, is unable to process immediately all the oppositions submitted, the reference date for the sequence of tasks will, in principle, be the date on which the last observations, in respect of which a time limit had been laid down, were submitted by any of the parties, but may not be later than the date on which the time limit expired. Documents received unsolicited or not subject to a previously stipulated official time limit, in connection with official communications setting a time limit, will not affect the sequence of tasks unless they require a further early notification setting a time limit to be made.

**1.2 Exceptions**

Notwithstanding VII, 1.1 above, oppositions are to be given priority:

- (i) if the earlier examination proceedings were of considerably longer duration than usual,
- (ii) if the opposition proceedings have already extended over a considerably longer period than usual,
- (iii) if a party to the proceedings has submitted a detailed and reasoned request for the proceedings to be speeded up and has given special grounds for his request which, after careful consideration of the interests of all parties, justifies a departure from the timetable of the sequence of tasks,
- (iv) if other matters to be dealt with, e.g., divisional applications, hinge upon the final decision concerning the opposition,
- (v) if the next procedural step can be dealt with relatively quickly.



Rule 59

**2. Request for documents**

"Documents referred to by a party to opposition proceedings shall be filed together with the notice of opposition or the written submissions in two copies. If such documents are neither enclosed nor filed in due time upon invitation by the formalities officer, the Opposition Division may decide not to take into account any arguments based on them."

In implementing this provision the desired aim of speeding up the procedure should be borne in mind as much as the common interest in taking into account obviously relevant submissions.

**3. Unity of the European patent**

Art. 118

**3.1 Basic principle**

If the proprietors of the patent are not the same for different designated Contracting States, the unity of the European patent in opposition proceedings will not be affected, since such persons are to be regarded as joint proprietors (see I, 6, second and third paragraphs).

In particular the text of the European patent will be uniform for all designated Contracting States unless otherwise provided for in the European Patent Convention (see VII, 3.2 and 4).

**3.2 Factors affecting the unity of the European patent**

The unity of the European patent in opposition proceedings will be affected if the previous proprietor of the patent and the person replacing him pursuant to Art. 99(5) in respect of a particular Contracting State are not deemed to be joint proprietors (see I, 6). In this event, the opposition proceedings involving the different proprietors must be conducted separately. Since different requests may be submitted by the two proprietors (e.g. as regards amendments to the claims), the two sets of opposition proceedings may lead to different conclusions, e.g. as regards the text of the European patent or the scope of the protection.

**4. Texts of the European patent which are different for different Contracting States**

Rule 16(3)

**4.1 Different texts where the entitled person takes part in the proceedings**

"Where a third party has, in accordance with Art. 99(5), replaced the previous proprietor for one or some of the designated Contracting States" (see I, 6; third paragraph), "the patent as maintained in opposition proceedings may contain for these States claims, a description and drawings

which are different from those for the other designated Contracting States" without, of course, going beyond the original disclosure.

Rule 87 4.2 Different text where the state of the art is different pursuant to Art. 54(3) and (4)

C-III, 8.1 applies by analogy.

Art. 61 4.3 Different text where a partial transfer of right by virtue  
Rule 16(1)(2) of a final decision pursuant to Art. 61 and Rule 16(1) and (2) has taken place.

C-III, 8.2 applies by analogy.

Art. 167(2)(a) 4.4 Different text where a reservation has been entered in accordance with Art. 167(2).

C-III, 8.3 applies by analogy.

4.5 Different text where national rights of earlier date exist.

C-III, 8.4 applies by analogy.

#### **5. Procedure where the proprietor is not entitled**

Rule 13(4) 5.1 Suspension of proceedings

"If a third party provides proof", e.g. a certificate from the court concerned, "to the EPO during opposition proceedings or during the opposition period that he has opened proceedings against the proprietor of the European patent for the purpose of seeking a judgment that he is entitled to the European patent, the Opposition Division shall stay the opposition proceedings unless the third party consents to the continuation of such proceedings. Such consent must be communicated in writing to the EPO; it shall be irrevocable. However, the suspension of the proceedings may not be ordered until the Opposition Division has deemed the opposition admissible." The parties are to be informed of the order suspending the proceedings.

5.2 Continuation of proceedings

Rule 13(3)(4) "When giving a decision on the suspension of proceedings or thereafter the Opposition Division may set a date on which it intends to continue the proceedings pending before it regardless of the stage reached in the proceedings opened" against the proprietor of the patent, as referred to in VII, 5.1. "The date is to be communicated to the third party, the proprietor of the patent and any other party. If no proof has been provided by that date that a decision which has become final has been given, the Opposition Division may continue proceedings."

If a date is set for the resumption of proceedings, it should be chosen, with due consideration for the interests of the third party who only becomes a party to the proceedings after a judgment has been given in his favour, on the basis of the probable duration of the court proceedings so as to enable them to be concluded within that period of time. If, by the date set, the court has not given a judgment, the opposition proceedings must at all events be further stayed if the judgment is expected in the near future. However, the opposition proceedings should be resumed if it is evident that delaying tactics are being employed by the third party or if the proceedings in the court of first instance have concluded with a judgment in favour of the proprietor of the patent and the legal procedure is extended by the filing of an appeal. Opposition proceedings might also be resumed in the absence of a judgment if the patent can be maintained unamended.

Rule 13(2)(4) "Where proof is provided to the Opposition Division that a decision which has become final has been given in the proceedings" concerning the entitlement to the European patent, the Opposition Division must "communicate to the proprietor and any other party that the opposition proceedings shall be resumed as from the date stated in the communication." "If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the opposition proceedings."

Rule 13(5) 5.3 Interruption of time limits

"The time limits in force at the date of suspension other than time limits for payment of renewal fees shall be interrupted by such suspension. The time which has not yet elapsed shall begin to run as from the date on which proceedings are resumed; however, the time still to run after the resumption of the proceedings shall not be less than two months."

Example: the three-month time limit under Rule 58(5), begins on 3 January 1974; proceedings are suspended on 23 January 1974 and resumed on 1 October 1974. Of the first month (ending 2 February 1974) there are still 11 days left (23 January - 2 February). The total time which has not elapsed then amounts to 11 days and 2 months. The time limit ends on 11 December 1974.

Art. 20 5.4 Department responsible

The Legal Division is responsible for questions concerning the suspension and resumption of proceedings (see Information of the EPO, OJ 9/1990, 404).

**6. Continuation of the opposition proceedings in the cases covered by Rule 60**

Rule 60(1)

6.1 Continuation in the case of surrender or lapse of the patent

"If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent filed within two months" after the date on which the Opposition Division informed the opponent of the surrender or lapse. Evidence of the lapse must generally be provided by submitting extracts from the Patent Registers of the designated Contracting States.

If, in the case of a request for continuation of the proceedings, the proprietor of the patent has renounced before the competent authorities in the designated states all rights conferred by the patent with ab initio and universal effect, or if no request for continuation has been received within the time limit, the opposition proceedings will be closed. The decision to close the proceedings will be communicated to the parties.

If instead the proprietor of the patent declares to the EPO that he surrenders/abandons/renounces the patent, the EPO will interpret this as a request for revocation of the patent. For details of the procedure to be followed, see VIII, 1.2.5.

Rule 60(2)

6.2 Continuation on the death or legal incapacity of the opponent

"In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the Opposition Division of its own motion, even without the participation of the heirs or legal representatives", for example if the legal proceedings in connection with the will or the appointment of a new legal representative would inordinately prolong the opposition proceedings. This provision will apply not only where merely one opposition has been filed: it will also apply in cases where not all those who have filed opposition are deceased or legally incapacitated.

The Opposition Division should continue the proceedings if, for instance, the proprietor of the patent has submitted amendments to the patent in response to the notice of opposition (see T 560/90, not published in OJ). The Opposition Division should also continue the proceedings if it considers that the stage reached in the opposition proceedings is such that they are likely to result in a limitation or revocation of the European patent without further assistance from the opponent(s) concerned and

without the Opposition Division itself having to undertake extensive investigations (see T 197/88, OJ 10/1989, 412).

The proprietor of the patent and any other parties are to be informed that the proceedings will be continued. Otherwise the proceedings are closed and the decision to close the proceedings is communicated to the parties.

Rule 60(2)

6.3 Continuation after the opposition has been withdrawn

The opposition proceedings can be continued even if the opposition or all of them have been withdrawn. The principles set forth in VII, 6.2 apply mutatis mutandis in deciding whether the proceedings are continued or closed.

Art. 105

### **7. Intervention of the assumed infringer**

The assumed infringer of a patent (see I, 5) may file notice of intervention in the opposition proceedings within three months of the date on which infringement proceedings were instituted against him or on which he instituted proceedings for a court ruling that he is not infringing the patent. "Notice of intervention shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid" to the amount prescribed in the Rules relating to Fees under the European Patent Convention.

Intervention is permissible as long as opposition or appeal proceedings are pending. A third party can only become a party to the proceedings if a party to the proceedings in which the decision was given files an appeal pursuant to Art. 107; otherwise the decision of the Opposition Division will become final on expiry of the appeal period (see Decisions G 4/91, OJ 6/1993, 339 and G 1/94, OJ 11/1994, 787).

Art. 103

### **8. Publication of a new specification of the patent**

If a European patent is maintained in an amended form, "the EPO shall, at the same time as it publishes the mention of the opposition decision, publish a new specification of the European patent containing the description, the claims and any drawings, in the amended form".

Rule 62a

Rule 54 shall apply mutatis mutandis to the new specification of the European patent.

**CHAPTER VIII**

## DECISIONS OF THE OPPOSITION DIVISION

General remarks on decisions appear in E-X.

**1. Final decisions on an admissible opposition**

## 1.1 General remarks

The Opposition Division has to take a final decision on the opposition, by revoking the European patent or rejecting the opposition or ruling that the European patent is to be maintained as amended. If the only admissible opposition or all the admissible oppositions are withdrawn and the Opposition Division takes the view that as the case stands there is no reason for the Office to continue the proceedings of its own motion, the proceedings are closed by means of a formal decision (Rule 60(2), second sentence).

Art. 102(1)

## 1.2 Revocation of the European patent

## 1.2.1 Revocation on substantive grounds

"If the Opposition Division is of the opinion that the grounds for opposition mentioned in Art. 100 prejudice the maintenance of the European patent, it shall revoke the patent." For revocation because the proprietor of the patent has not given his agreement see VI, 2.2., 4.2 and 7.2.2.

Art. 102(4)(5)

## 1.2.2 Revocation for failure to pay the printing fee or to file a translation

If the proprietor of the patent fails in due time to pay the fee for the printing of a new specification of the European patent, or to file a translation of the amended claims in the two official languages of the EPO other than the language of the proceedings (see VI, 7.2.3), then the European patent will be revoked.

Rule 90(3)(a)

## 1.2.3 Revocation for failure to notify the appointment of a new representative

If opposition proceedings are interrupted according to Rule 90(1)(c) and the patent proprietor who is not resident in one of the Contracting States, does not forward a notification of the appointment of a new representative within the two-month period laid down in Rule 90(3)(a) (see E-VII, 2 (i)), then the European patent will be revoked.

## 1.2.4 Revocation in the event of requirements not being met until after expiry of time limits

In the cases referred to in VIII, 1.2.2 and 1.2.3, the Euro-

pean patent will be revoked even if the omitted acts have been completed during the period between expiry of the time limit and the taking of a final decision, unless an application for restitutio in integrum has been filed, in which case a decision must first be given on the application.

1.2.5 Revocation of the patent in the event that the proprietor no longer wishes the patent to be maintained as granted

If the proprietor states that he no longer approves the text in which the patent was granted and does not submit an amended text, the patent must be revoked. This also applies when the proprietor requests the patent to be revoked.

If a proprietor unambiguously declares to the EPO the surrender (or abandonment or renunciation) of the patent, this is interpreted as equivalent to a request that the patent be revoked (see T 237/86, OJ 7/1988, 261). If the request of the proprietor is not unambiguous he is given the opportunity to request that the patent be revoked or to declare that he no longer approves of the patent being maintained as granted. This results in the patent being revoked (see Legal Advice 11/82, OJ 2/1982, 57).

Art. 102(2)

1.3 Rejection of the opposition

"If the Opposition Division is of the opinion that the grounds for opposition mentioned in Art. 100 do not prejudice the maintenance of the European patent unamended, it shall reject the opposition."

1.4 Maintenance of the European patent as amended

Art. 102(3)  
Rule 58(4)(5)

1.4.1 Taking of a final decision

"If the Opposition Division is of the opinion that, taking into consideration the amendments made by the proprietor of the patent during the opposition proceedings, the patent and the invention to which it relates meet the requirements of this Convention," the decision to maintain the European patent as amended shall be issued.

The procedure specified in VI, 7.2.1 to 7.2.3 will precede the decision.

Rule 58(7)

1.4.2 Statement in the decision of the amended form of the European patent

"The decision shall state which text of the European patent forms the basis for the maintenance thereof."

**2. Other decisions**

2.1 Decision on the inadmissibility of an opposition or intervention

See IV, 3, and IV, 5.5, with reference to the notice of opposition and IV, 5.6, and VII, 7, for the intervention of an assumed infringer.

2.2 Decisions which do not terminate proceedings

Such decisions are dealt with in E-X, 6.

See VI, 7.2.2, with reference to the maintenance of a patent with amended documents.

Rule 69(2)

2.3 Decision on a notified loss of rights at the request of the person concerned

This decision is dealt with in E-VIII, 1.9.3.

2.4 Decision on restitutio in integrum

This decision is dealt with in E-VIII, 2.2.7.

2.5 Decision on closure of the opposition proceedings

This decision is dealt with in VII, 6 and VIII, 1.1.



**CHAPTER IX**

## COSTS

Art. 104(1)

**1. Charging of costs**

## 1.1 General principle

"Each party to the proceedings shall meet the costs he has incurred". However, where costs have been "incurred during the taking of evidence or in oral proceedings", an Opposition Division may, "for reasons of equity, order a different apportionment" of such costs.

The phrase "taking of evidence" refers generally to the receiving of evidence by an Opposition Division, whatever the form of such evidence. It includes e.g. the production of documents and sworn statements in writing as well as hearing witnesses (see T 117/86, OJ 10/1989, 401).

Rule 63(1)

## 1.2 Decisions on the apportionment of costs

"Apportionment of costs shall be dealt with in the decision on the opposition". This apportionment will form part of the main decision and will be incorporated in the operative part of the decision.

The decision will deal only with the obligation on the party or parties concerned to bear costs. The actual amounts to be paid by one party to another shall be dealt with in the decision on the awarding of costs (see IX, 2).

A statement that the parties will bear their own costs may be incorporated in the grounds for the decision on the opposition and should be included in cases where one of the parties to the proceedings has submitted a request for a decision on the awarding of costs which the Opposition Division does not regard as justified.

A decision to award costs may be made by the Opposition Division of its own motion, even if no application for the awarding of costs has been made.

In the absence of an express decision on the awarding of costs each of the parties concerned shall bear his own costs.

Rule 63(1)

## 1.3 Costs to be taken into consideration

Apportionment of costs may relate only to those expenses "necessary to assure proper protection of the rights involved".

Examples of such expenses are:

- (i) expenditure incurred in respect of witnesses and experts, together with other costs arising in connection with the taking of evidence;
- (ii) remuneration of the representatives of the parties in respect of oral proceedings or the taking of evidence;
- (iii) expenditure incurred directly by the parties, i.e. their travel expenses in coming to oral proceedings or the taking of evidence.

Costs incurred in respect of superfluous or irrelevant evidence, etc. cannot be covered by a decision on costs.

#### 1.4 Principle of equity

Reasons of equity will require a decision on the apportionment of costs when the costs arise in whole or in part as a result of the conduct of one party which is not in keeping with the care required to assure proper protection of the rights involved, in other words when the costs are culpably incurred as a result of irresponsible or even malicious actions. Each party may of course defend his rights or interests (e.g. the proprietor his patent) by any legally admissible means within the framework of the opposition proceedings; he may, for example, request oral proceedings or the taking of evidence. ==

Accordingly, costs incurred as a result of default or of inappropriate legal means used by either party may be charged to the party responsible, even if he has been successful in the opposition proceedings.

The following are examples where the principle of equity may be applied:

The costs incurred by the opponent in preparing oral proceedings which have been appointed may be charged to the proprietor of the patent if he surrenders the patent just before the date appointed for the oral proceedings, although it was clear when the proceedings were being arranged, from a document put forward by the opponent that the proprietor of the patent had no case and he alone therefore was liable for his irresponsible conduct.

If an aspect of the state of the art is adduced as an argument at a late stage and it can be shown, or it is evident, that the party concerned knew of it earlier, e.g. in that he had made prior use of it, the additional costs of further oral proceedings unnecessarily incurred by the other parties may be charged to the party which caused them by submitting his argument at so late a stage.

If relevant facts or evidence are submitted by a party only at a late stage of the proceedings without any good reason and if, as a consequence, unnecessary costs are incurred by another party then the Opposition Division may decide on the apportionment of costs.

---

## 2. Procedure for the fixing of costs

### 2.1 Fixing of costs by the registry

- Art. 104(2)  
Rule 63(2) At the request of at least one party, "the registry of the Opposition Division" or the registry designated by the President of the EPO in accordance with Rule 9(4), "shall fix the amount of the costs to be paid under a decision apportioning them". "The request shall only be admissible if the decision" apportioning the costs "has become final".
- Rule 63(2) "A bill of costs, with supporting evidence" in respect of each amount involved, "shall be attached to the request". "Costs may be fixed once their credibility is established."
- Art. 119 The parties will be notified of the costs as fixed by the registry.

### 2.2 Appeal against the fixing of costs by the registry

- Art. 104(2) "The fixing of the costs by the registry may be reviewed by a decision of the Opposition Division."
- Rule 63(3) "The request, stating the reasons on which it is based, must be filed in writing to the EPO within one month after the date of notification of the awarding of costs" by the registry. "It shall not be deemed to be filed until the fee for the awarding of costs has been paid" at the rate prescribed in the Rules relating to Fees under the European Patent Convention.
- Rule 63(4) "The Opposition Division shall take a decision on the request without oral proceedings."

## 3. Enforcement of the fixing of costs

- Art. 104(3) "Any final decision of the EPO fixing the amount of costs shall be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in the territory of which enforcement is to be carried out. Verification of such decision shall be limited to its authenticity".

"Decision" as referred to above also covers the final fixing of costs by the registry of the Opposition Division.



**PART E**

**GUIDELINES ON GENERAL PROCEDURAL MATTERS**



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**INTRODUCTION**

This Part contains guidelines for those procedural steps in respect of the examination of European patent applications and patents which without major variations may, in so far as the Convention and the Implementing Regulations permit, occur at a number of stages in the procedure. Attention is also drawn to Art. 125, which states: "In the absence of procedural provisions in this Convention, the EPO shall take into account the principles of procedural law generally recognised in the Contracting States".

These guidelines also apply to any international applications which the EPO may process under the Patent Cooperation Treaty (PCT).

**CHAPTER I**

## COMMUNICATIONS AND NOTIFICATIONS

**1. Communications**

## 1.1 General remarks

Communications should be sent, inter alia,

(i) if a party has to be informed of deficiencies, together, where appropriate, with a request to remedy those deficiencies, e.g. in accordance with Rule 39, Rule 41(1) and (3), Rule 46(1), or Rule 56(2),

(ii) if a party is to be invited to file observations on particular questions or to submit documents, evidence, etc., to clarify the issues involved,

(iii) if, in the opinion of the Examining or Opposition Division, the patent cannot be granted or maintained in the text requested by the applicant or proprietor of the patent, but could possibly be granted or maintained in an amended text of more limited scope,

(iv) if information necessary to the conduct of the proceedings has to be communicated to the parties, e.g. in accordance with Rule 13(2) and (4), Rule 24(4), or Rule 90(2) and (3),

(v) for preparing oral proceedings, (see III, 5),

(vi) if the decision is to be based on grounds on which the parties have not yet had an opportunity to comment (see X, 1).

## 1.2 Number of communications

Since each communication issued may entail prolonging the proceedings, the proceedings should be conducted in such a way as to manage with as few communications as possible. If a communication has to be issued, it should cover all the points which are necessary, or likely to be of importance, for the particular stage of the proceedings, e.g. the preparation of oral proceedings or of a decision.

## 1.3 Form of decisions, communications and notices

## Rule 70

"Any decision, communication or notice from the EPO is to be signed by and to state the name of the employee responsible. Where these documents are produced by the employee responsible using a computer, a seal may replace the signature. Where the documents are produced automatically by a computer the employee's name may

also be dispensed with. The same applies for pre-printed notices and communications."

## 2. Notification

### 2.1 General remarks

Art. 119  
Rule 77(1)

"The EPO shall, as a matter of course, notify those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of the Convention, or of which notification has been ordered by the President of the EPO. Notifications may, where exceptional circumstances so require, be given through the intermediary of the central industrial property offices of the Contracting States. In proceedings before the EPO, any notification to be made shall take the form either of the original document, a copy thereof certified by, or bearing the seal of the EPO or a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification."

### 2.2 Method of notification

Rule 77(2)  
Rule 77(3)

Notification is to be "by post", "by delivery on the premises of the EPO", "by public notification" or "by such technical means of communication as determined by the President of the EPO and under the conditions laid down by him governing their use". Further details concerning notifications will be found in Rules 78 to 80. "Notification through the central industrial property office of a Contracting State" competent to deal with the addressee "shall be made in accordance with the provisions applicable to the said office in national proceedings."

### 2.3 Notification by post

Rule 78

Notification is usually made by post. "Decisions incurring a time limit for appeal, summonses and other documents as decided on by the President of the EPO shall be notified by registered letter with advice of delivery. All other notifications by post shall be by registered letter." The President of the EPO has, so far, not named any other documents to be notified by registered letter with advice of delivery.

The letter "shall be deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be."

Notification "shall be deemed to have been effected even if acceptance of the letter has been refused."

The law of the state on the territory of which the notification is made shall apply to other matters concerning notification, e.g. the question whether delivery to an other person than the addressee constitutes an effective notification to the latter.

Rule 81

#### 2.4 Notification to representatives

"If a representative has been appointed, notifications shall be addressed to him." "If several such representatives have been appointed for a single interested party, notification to any one of them shall be sufficient." If several persons are joint applicants for or proprietors of a patent or have acted in common in filing notice of opposition or intervention and have not appointed a common representative, notification of one person, viz. the person referred to in Rule 100, will again be sufficient. "If several interested parties have a common representative, notification of a single document to the common representative shall be sufficient."

Rule 82

#### 2.5 Irregularities in the notification

"Where a document has reached the addressee, if the EPO is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the EPO as the date of receipt." In cases where the EPO is not able to prove the actual date of notification, for instance a letter sent by the addressee himself, which indicates the date of receipt, is accepted as proof. If it is evident from a reply from the addressee that he has received the document, although he does not mention the date of its notification, the date on which that reply was written is to be regarded as the date of notification.



**CHAPTER II**

## PROCEDURE FOR AMENDMENTS TO DOCUMENTS

**1. Amendment by submitting missing documents or by filing replacement pages**

The content of a European patent application or patent may be amended within the limits laid down in Art. 123(2) and (3). (For the conditions governing amendments, see also A-V, 2, C-VI, 5 and D-V, 6). This will normally be done by submitting missing documents or by filing replacement pages. Replacement pages for the request for grant, description, claims, drawings and abstract are to be filed in triplicate. Where replacement pages are filed the applicant or patent proprietor should, in the interests of procedural efficiency, identify clearly all amendments made, and indicate on which passages of the original application these amendments are based.

**2. Amendments using copies**

Amendments, particularly to the description or claims, may be made by using copies in accordance with the following procedure:

If he deems it expedient, the examiner or formalities officer may, on a copy of one or more pages of the documents to be amended, put forward suggestions as to how amendments should be made in such a way as to take account of the objections raised. The annotated copies (not the working documents which are to remain in the dossier) will then be forwarded to the applicant or, in opposition proceedings, to the proprietor of the patent and the other parties, in the communication setting out the objections. In this communication, the applicant or proprietor will not only be informed of the deficiencies recorded and invited to adopt a position or submit amendments within a fixed time limit, but shall also be invited simultaneously to resubmit the said copy and - as an alternative to submitting replacement pages - to indicate on this copy, separately from the comments of the examiner (preferably typewritten and in such a way as to be well legible after photocopying), any amendments to be made to the pages concerned. Opponents may also be invited to submit their comments in the same way.

The parties may also submit copies of one or more amended pages on their own initiative. The filing of completely retyped documents should normally be objected to, for reasons of procedural economy, as these documents will have to be checked for correspondence with the original documents (see T 113/92, not published in OJ). Only where the amendments are so extensive as to affect the legibility of the copies, replacement pages

must be filed. In this case such pages may also be requested by the examiner on his own initiative.

### **3. Amendments made by the EPO at the request of a party and amendments made by a party at the EPO**

Where necessary, deficient documents may also be amended at the request of a party by the competent department of the EPO. This will be the procedure for minor amendments, e.g. where it is necessary to insert details which were omitted in the request for grant, and the number of amendments involved is not excessively large, or where whole pages or paragraphs are to be deleted. The party concerned should submit a list summarising the amendments to be undertaken by the Office. This procedure is also to be followed for minor amendments to drawings, e.g. for amending a reference number or deleting one or more whole figures (as regards the removal of references following an amendment to the description, see C-II, 4.8). In the case of complicated amendments to drawings, where it is not immediately clear how the changes are to be made, the party concerned, who as a rule is the applicant or proprietor, must submit replacement pages. A party may also make amendments himself at the EPO, for example when he attends to sign documents.

**CHAPTER III**

## ORAL PROCEEDINGS

**1. General**

By "oral proceedings" is meant formal proceedings within the meaning of Art. 116. The term does not therefore include informal personal interviews or telephone conversations, such as occur in examination proceedings (see C-VI, 6). In view of Rule 58(1), such informal personal interviews or telephone conversations are not allowed in opposition proceedings, in which more than one party is involved, unless the interview or telephone conversation concerns matters which do not affect the interests of other parties. An example is proceedings for examining the admissibility of opposition, provided this involves only the Office and the opponent concerned.

Art. 18(2)  
Art. 19(2)

Oral proceedings will take place before the competent body, e.g. within the Receiving Section before the competent formalities officer and during the examination and opposition procedure before the whole Division.

**2. Oral proceedings at the request of a party**

Art. 116(1)

If, in the course of proceedings, a party requests oral proceedings, the competent department must grant this request. The EPO will not inform the party concerned of this right but will expect him - if he does not obtain satisfaction from the competent department - to request oral proceedings (if he so wishes) before a decision is reached.

Art. 116(2)

"Nevertheless, oral proceedings shall take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application."

The competent department will decide on the most appropriate date for the oral proceedings, which should only be held after the issues to be determined are sufficiently clear (see III, 5). If the competent department considers that a decision on the matter may be reached on the basis of the written evidence obtained and intends to take a decision (e.g. in accordance with Art. 97 or Art. 102) which fully concurs with the case put forward by the party or parties which requested the oral proceedings, the party or parties concerned should be informed accordingly and asked whether the request or requests for oral proceedings will be maintained even though the decision concurs with the case put forward; this will not apply if the party concerned has indicated that the request for oral proceedings has been made solely as a precaution to cover the

eventuality of the case put forward by him not being accepted.

### 3. Request for further oral proceedings

Art. 116(1)

"The EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same."

Oral proceedings, particularly in opposition, are held to give the opportunity to finally discuss all matters raised and are normally terminated with a decision announced orally. The Division is bound by that decision, once announced, and it cannot reopen the proceedings to allow further submissions to be filed or to take into account new facts (see the two last paragraphs of VI, 2). Only if the Division, in the oral proceedings, has not announced a decision, but has decided to continue the proceedings in writing, can further submissions be examined. Such may be the case e.g. when the Examining Division indicates that it intends to grant a patent on the basis of the documents filed during the oral proceedings.

Thus, as a rule, in examination or opposition proceedings there will be no justification for further oral proceedings, for example where one of the parties wishes to re-examine from a different viewpoint a subject already discussed in the course of the proceedings, either before or during the original oral proceedings. However, if the oral proceedings are not terminated with a decision and after the oral proceedings the subject of the proceedings changes, for example where fresh evidence is admitted into the proceedings after the original oral proceedings, then a further oral proceedings will generally have to be held if requested (see T 194/96, not published in OJ).

### 4. Oral proceedings at the instance of the EPO

Art. 116(1)

The competent department of the EPO may arrange for oral proceedings to take place without a request from a party if it considers this to be expedient.

Oral proceedings will normally only be expedient if after an attempt at written clarification there are still questions or doubts which have a crucial bearing on the decision to be reached and which may be more efficiently or surely settled by oral discussion with the party or parties or if it is necessary to take evidence as part of oral proceedings (see IV, 1.3 and 1.6.1). The competent department should also bear in mind the need for economy in such procedures, since oral proceedings give rise to costs for both the EPO and the party or parties.

### 5. Preparation of oral proceedings

The purpose of oral proceedings should be to settle as far as possible all outstanding questions relevant to the decision. To this end proceedings should be carefully prepared after examination of all the written matter submitted and with this in mind the most appropriate date for conducting oral proceedings chosen.

Insofar as certain questions relevant to the decision are considered by the Office to require discussion, it will in many cases be expedient to inform the party or parties in a notice and possibly also to invite one or more of the parties to submit written observations or to produce evidence, where appropriate. Parties may produce evidence in support of their arguments on their own initiative. Where however the evidence is such as should have been put forward at an earlier stage, e.g. in opposition proceedings pursuant to D-IV, 1.2.2.1(v) and 5.4, it is for the competent body to consider whether the evidence not filed in due time shall be admitted (see VI, 2). Any observations should be received in time for them to be communicated to the other parties at the latest one month before the oral proceedings. The time limit for submission of observations should be fixed accordingly, particularly where the invitation to file observations is issued at the same time as the summons to oral proceedings.

If, exceptionally, a party wishes a document to be taken into consideration during oral proceedings which has not previously been introduced in the proceedings, the required number of copies of this document must also be submitted within the same time limit before the oral proceedings.

In proceedings with only one party, i.e. in proceedings before the Receiving Section or the Examining Division, there must be at least one copy for the competent department and in opposition proceedings at least one copy for the Opposition Division and the other parties.

As regards the late introduction of documents in oral proceedings, see III, 8.6.

### 6. Summons to oral proceedings

Rule 71  
Art. 119

All parties must be duly summoned to oral proceedings by notification. The summons must state the subject and the date and time of the oral proceedings. —

Rule 71a(1)

The summons will also be accompanied by a note drawing attention to the points which need to be discussed, will normally contain the provisional and non-binding opinion of the Division and will also fix a date up to which written submissions may be filed or documents which meet the

requirements of the EPC may be submitted (see also D-VI, 3.2).

Rule 71

"At least two months' notice of the summons shall be given unless the parties agree to a shorter period." The summons must state that if a party duly summoned does not appear as summoned, the proceedings may continue without him.

Opposition proceedings as a rule, even oral proceedings requested on the basis of totally different grounds for opposition, should be conducted as a single set of proceedings.

### **7. Requests for the postponement of oral proceedings**

Requests for the postponement of oral proceedings must, for planning reasons, be received in good time before the arranged date. It will be possible to grant such requests only in justified cases, i.e. where refusal to do so would damage the party requesting the postponement and where the need for postponement does not arise from failure by that party to make provision for reasonably foreseeable circumstances (see also III, 8.3, fourth paragraph). Where appropriate, the consent of the other parties should be sought. If the competent body decides to postpone oral proceedings for official reasons, the parties should be notified as early as possible.

### **8. Conduct of oral proceedings**

#### 8.1 Admission of the public to proceedings

Art. 116(3)

"Oral proceedings before the Receiving Section, the Examining Divisions and the Legal Division shall not be public."

Art. 116(4)

"Oral proceedings, including delivery of the decision (see III, 9), shall be public before the Opposition Divisions in so far as the Opposition Division does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings." This could, for example, be the case if one of the parties wishes to give information about sales figures or other commercial secrets in support of his case. Generally, the public will only be excluded whilst such information is being given.

#### 8.2 Conduct of oral proceedings

Before the Receiving Section oral proceedings will be conducted by the formalities officer and before the Examining or Opposition Divisions by the Chairman of the Division concerned.

The responsibilities of the person conducting the proceedings will include keeping order and conducting the proceedings as regards their formal and substantive aspects.

The person conducting the proceedings must in particular ensure that, where necessary, a list is prepared of all disputed or unclear points relevant to the decision to be reached, that these are discussed and that the party or parties have the opportunity of commenting on them.

On the other hand, the oral proceedings are to be conducted strictly and efficiently, so that the submissions of the party or parties and the discussions are not unnecessarily digressive and do not deal with points which are of no relevance to the decision to be reached. Repetition should be avoided as far as possible. In particular written material submitted at the appropriate time to the competent department and to the party or parties which has already been the subject of proceedings need not be read out in extenso. A simple reference to such written material may suffice.

### 8.3 Opening of oral proceedings: non-appearance of a party

The person conducting the proceedings will have the particulars of the persons taking part taken and their authorisations checked, where necessary, before the start of the oral proceedings. Parties and their representatives must identify themselves unless they are known to the person conducting the proceedings or any of the members of the Examining or Opposition Division. If parties do not appear or are not represented, a check will be made that they were duly summoned. The oral proceedings are then opened.

The person conducting the proceedings will introduce the parties present. He will have the particulars of the persons taking part in the proceedings recorded and will establish in what capacity they are present. Details of these steps and any consequences thereof will be recorded in the minutes (see III, 10).

If an absent party was not duly summoned, this is noted in the minutes and the oral proceedings are closed. A new date must be fixed for further oral proceedings.

#### Rule 71(2)

If a party who has been duly summoned to oral proceedings does not appear as summoned, the oral proceedings may be conducted without him as a party should not be able to delay issuance of a decision by failing to appear.

If, however, an adequately justified application for postponement has been received from a party who has failed to appear, in which it is convincingly argued, or is

self-evident, that it was not possible to submit the application sufficiently early for the oral proceedings to be postponed in good time, the proceedings should be postponed and a new date fixed. If the delay in submitting the application is ascribable to the carelessness of the party concerned, the proceedings may, depending on the circumstances, still be postponed; if this happens in opposition proceedings, a decision on costs may have to be taken (see D-IX, 1.4).

If new facts or evidence are submitted during inter partes oral proceedings which a party, although duly summoned, fails to attend, it shall first be examined whether these submissions may be disregarded (Art. 114(2); see also 8.6 and VI, 2).

If new facts are taken into consideration, then at the end of the oral proceedings a decision based on these facts cannot be taken against the absent party.

New evidence can only be used against the absent party if it has been previously notified and merely supports the previous assertions of the party who submits it.

New arguments may be used anytime, insofar as they do not change the grounds on which the decision is based (see Opinion G 4/92, OJ 3/1994, 149).

An absent party cannot be considered taken by surprise if during oral proceedings the other side attempts to overcome objections raised before the oral proceedings. In particular, a submission during oral proceedings of a more restricted and/or formally amended set of claims with a view to overcome the objections of the opponent is not considered a "new fact" (see T 133/92 and T 202/92, both not published in OJ). Neither is it unexpected that amended claims are examined for formal admissibility and for compliance with Art. 123(2) and (3) (see T 341/92, OJ 6/1995, 373).

#### 8.4 Opening of the substantive part of the proceedings

In so far as necessary, the person conducting the proceedings will outline the stage reached in the proceedings and will indicate the most important matters in dispute according to the file. In examination or opposition proceedings this may also be done by the primary examiner.

#### 8.5 Submissions by the parties

After the introduction referred to above, the party or parties will be allowed the floor in order to put their cases and to make applications on procedural matters and state the grounds thereof. In the normal course of events each party



should have only one opportunity of making a comprehensive statement.

In opposition proceedings the opponents will generally speak first and the patent proprietor afterwards. Where there are a number of opponents, it may be expedient to grant the patent proprietor an opportunity of replying directly after the statement of each individual opponent. The opponents and the patent proprietor should be given the opportunity of making a final reply.

The submissions of the party or parties may be prepared in writing, although they should as far as possible be made extemporaneously. Passages from documents already introduced into the proceedings which are referred to again should only be read out where their precise wording is relevant.

Submissions by a person who is not qualified under Art. 133 and Art. 134 to represent parties to proceedings before the EPO may be admitted at oral proceedings when this person accompanies a professional representative representing that party. Such submissions, however, cannot be made as a matter of right, but only with the permission and at the discretion of the Examining or Opposition Division. In opposition proceedings the Division should consider in exercising its discretion whether (see Decision G 4/95, OJ 7/1996, 412):

- (i) the party on behalf of which the person is to speak has filed a request to this effect;
- (ii) the party making the request has indicated the name of the person, the subject-matter of the submission and the person's qualification to speak on this matter;
- (iii) the request has been filed sufficiently in advance of the oral proceedings;
- (iv) in the case of a late filed request, either there are exceptional circumstances justifying the admission of the submission or all the other parties agree to the making of the submission; and
- (v) the submissions are made under the continuing responsibility and control of the professional representative.

If neither of the alternative conditions mentioned under (iv) are met, a late filed request should be refused. The time limit to be applied when deciding whether a request was late filed is that fixed in the summons under Rule 71a.

If a party is represented by an authorised employee rather than a professional representative the same consider-

ations apply in respect of a person accompanying the authorised employee.

#### 8.6 Facts, evidence or amendments introduced late

With respect to facts and evidence submitted late in the proceedings in general, see E-VI, 2.

Rule 71a(1) Rule 71a(1), being an implementation of Art. 114(2) as a further development on the existing jurisprudence regarding facts or evidence not filed in due time, makes clear that the Division has a discretion to disregard new facts or evidence for the reason that they have not been filed before the date indicated in the summons under Rule 71a, unless they have to be admitted because the subject of the proceedings has changed. An example of such a change would be where, in timely response to the points raised in the note annexed to the summons, the proprietor files amendments which have the result that a new document becomes relevant; in such a case the opponent should be allowed to present this document and must be given a chance to comment on the amendments (Art. 113(1)).

Rule 71a(2) Rule 71a(2) imposes the same obligations on the applicant or patent proprietor when submitting new documents which meet the requirements of the Convention (i.e. new amendments to the description, claims and drawings) as Rule 71a(1) imposes on the parties in submitting new facts and evidence. Here the Division also has the discretion to disregard amendments because they are filed too late before the oral proceedings. However, where the opponent files, before the indicated date, pertinent new material, the patent proprietor must be given a chance to present his comments and submit amendments (Art. 113(1)).

Rule 71a(1)(2) In exercising this discretion, the Division will in the first place have to consider the relevance of the late filed facts or evidence (see VI, 2) or the allowability of the late filed amendment, on a **prima facie** basis. If these facts or evidence are not relevant or if these amendments are clearly not allowable, they will not be admitted. Before admitting these submissions, the Division will next consider **procedural expediency**, the **possibility of abuse of the procedure** (e.g. one of the parties is obviously protracting the proceedings) and the question whether the parties **can reasonably be expected** to familiarize themselves in the time available with the new facts or evidence or the proposed amendments.

As regards **procedural expediency**: where the late filed facts or evidence are relevant, but their introduction would cause a prolonged adjournment of the proceedings, the Division may decide to not admit these facts or evidence in the proceedings. An example would be where the witness lives abroad and still has to be found or lengthy

tests are still necessary. The Division may, however, also postpone the proceedings and in doing so may have to consider the apportionment of costs (Art. 104).

An example of possible **abuse of the proceedings** would be a proliferation of auxiliary requests, introduced at short notice by the patent proprietor, which are not a reaction to the course of the proceedings. Another example would be an opponent who files an assertion of public prior use, based on activities of the opponent himself, late in the absence of good reasons for the delay (see T 534/89, OJ 7/1994, 464).

In opposition proceedings the parties should be heard on such matters. If the Opposition Division approves the introduction of new facts or evidence and if the other parties have not had sufficient time to study them, it should, where easily comprehensible subject-matter is involved, grant the parties an opportunity of familiarising themselves with it, possibly by briefly interrupting the oral proceedings. If this is not feasible, the other parties must, upon request, be given the opportunity to comment in the proceedings subsequent to the oral proceedings, where appropriate in a further set of oral proceedings. Where possible, however, oral proceedings should not be adjourned. Where possible, legal commentaries, decisions (of a Board of Appeal, for example) and reports on legal decisions which are to be referred to in oral proceedings should be notified to the Opposition Division and the other parties in good time before the proceedings. They may, however, be quoted or submitted for the first time in the oral proceedings themselves if the Opposition Division agrees after consulting the parties.

As regards the costs which may be incurred for late submissions, see D-IX, 1.4.

#### 8.7 Discussion of the facts and of the legal position

A discussion will be conducted with the party or parties concerning those technical or legal questions which are relevant to the decision and which, after the parties have made their submissions, do not appear to have been sufficiently clarified or discussed or are seemingly contradictory. Where necessary, it should be ensured that the party or parties file requests which are to the point and that the applicant or proprietor formulates the claims appropriately.

If the Examining or Opposition Division finds that some patentable subject-matter results from a limitation or an amendment of the claims, it should inform the applicant or proprietor of the fact and allow him an opportunity to submit amended claims based thereon.

If the competent department intends to depart from a previous legal assessment of the situation with which the parties are acquainted or from a prevailing legal opinion, or if facts or evidence already introduced into the proceedings are seen in a different light - e.g. during the deliberations of the Examining or Opposition Division (see III, 8.9) - so that the case takes a significant turn, the parties should be informed thereof.

#### 8.8 Right of the other members of the Examining or Opposition Division to put questions

The Chairman must allow any member of the Examining or Opposition Division who so requests to put questions. He may determine at which point in the proceedings such questions may be put.

In oral proceedings questions may be put to the parties in connection with their statements or the discussion of the facts or of the legal position. When evidence is taken as part of oral proceedings questions may also be put to the witnesses, parties and experts called. As regards the right of the parties to put questions, see IV, 1.6.7.

#### 8.9 Closure of oral proceedings

If the competent department considers that the matter has been sufficiently thoroughly discussed, it must decide on the subsequent procedure to be followed. Where the department consists of a number of members - as in the case of the Examining and Opposition Divisions - they shall, if necessary, deliberate on the matter in the absence of the parties. If new aspects emerge during the discussion and require further questions to be put to the parties, the proceedings may be restarted. The person conducting the proceedings may thereafter give the decision of the department. Otherwise he should inform the party or parties of the subsequent procedure and then close the oral proceedings.

While the department is bound by the decision it issues on substantive matters (see III, 9), it is free, as a result of further reflection, to inform the parties that it intends to depart from the procedure which it has announced.

The subsequent procedure may, for example, consist in the department issuing a further communication, imposing certain requirements on one of the parties, or informing the parties that it intends to grant or maintain the patent in an amended form. As regards the delivery of a decision in the last case, see III, 9.

If the patent is to be granted or maintained in an amended form it should be the aim to reach an agreement upon the final text in the oral proceedings. If, however, the Examin-

ing or Opposition Division indicates during the oral proceedings that it would be willing to grant or maintain a European patent provided that certain amendments are made which could not reasonably have been foreseen from the earlier procedure, the applicant or patent proprietor will be given a time limit of normally 2 to 4 months in which to submit such amendments. If the applicant or patent proprietor fails to do so, the application will be refused or the patent will be revoked.

Rule 68(1)(2)

### **9. Delivery of the decision**

The delivery of the decision will follow a statement by the person conducting the proceedings announcing the operative part of the decision (see also III, 8.9 and X, 4).

The operative part may, for example, read as follows:

"The patent application ... is refused." or

"The opposition to the patent ... is rejected." or

"The patent ... is revoked." or

"Taking account of the amendments made by the proprietor in the opposition proceedings, the patent and the invention to which it relates satisfy the requirements of the Convention."

Once a decision has been pronounced, submissions of the party or parties cannot be considered any longer and the decision stands, subject to the correction of errors in accordance with Rule 89. It may only be amended by appeal (see XI, 1, 7 and 8).

No pronouncement need be made at this point as to the reasons for the decision or the possibility of appeal. However the Examining or Opposition Division may give a short explanation of the reasons for the decision.

"Subsequently the decision in writing" containing the reasoning and information as to right of appeal "shall be notified to the parties" without undue delay. The period for appeal will only begin to run from the date of notification of the written decision.

Generally speaking it will not be possible to give a decision granting a European patent or maintaining it in amended form in oral proceedings since, in the case of the grant of a patent, the requirements laid down in Art. 97(2) and (5), and in the case of a patent being maintained in amended form, the requirements of Art. 102(3) and (5) must be fulfilled.

**10. Minutes of oral proceedings**

(As regards the minutes of taking of evidence, see IV, 1.7).

Rule 76(1)

**10.1 Formal requirements**

"Minutes of oral proceedings shall be drawn up."

The person conducting the proceedings must ensure that during the whole proceedings an employee is available to keep minutes. If necessary, during oral proceedings different employees may carry out the task of minute-writing in sequence. In this case it must be made clear in the minutes which section was drawn up by which employee. The employees are normally members of the competent department, e.g. the Examining or Opposition Division. The minutes are either taken down by hand by the member charged with the minute-taking or are dictated on to a dictating machine. If the minutes or parts of the minutes are dictated or read out, any objections to them must be raised immediately and recorded in the minutes. Following the proceedings the dictation or handwritten minutes are typed out.

Rule 76(3)  
Rule 76(4)

The minutes shall be authenticated either by the signatures of the employee who drew them up and of the employee who conducted the oral proceedings or taking of evidence, or by any other appropriate means. "The parties shall be provided with a copy of the minutes." Copies must be notified to them as soon as possible after the oral proceedings.

Provided the parties have been informed, oral proceedings may be recorded on sound recording apparatus. However, no person other than an EPO employee is allowed to introduce any kind of such apparatus into the hearing room (see Notice of the Vice-Presidents of the Directorates-General for Examination/Opposition and for Appeals, dated 25 February 1986 concerning sound recording devices in oral proceedings before the EPO, OJ 2/1986, 63). The recording should be kept until the end of any possible proceedings. Copies of the recording will not be provided to the parties.

The minutes must first include the date of the proceedings, the names of the members of the department, e.g. the Opposition Division, present and the name or names of the minute-writer or writers. Minutes must also include the details referred to in III, 8.3.

**10.2 Subject-matter of minutes**

Rule 76(1)

Minutes must contain "the essentials of the oral proceedings" and "the relevant statements made by the parties".

Relevant statements are, for example, new or amended procedural submissions or the withdrawal thereof, the fresh submission or amendment or withdrawal of application documents, such as claims, description and drawings, and statements of surrender.

The essentials of the oral proceedings include new statements by the party or parties and by the member or members of the department concerning the subject-matter of the proceedings. In examination and opposition proceedings the essentials are principally new statements arguing the presence or lack of novelty, inventive step and other criteria of patentability.

If in the course of the procedure prior to oral proceedings the department has delivered an opinion - e.g. on patentability - and changes this opinion in response to arguments put forward by the parties, e.g. following the deliberations of the Examining or Opposition Division, this must be mentioned in the minutes, with a statement of the reasons for doing so. The minutes should also contain procedural information, such as how the proceedings are to be continued after closure of the oral proceedings.

If a decision is given, the wording of the operative part must be reproduced in the minutes.

If the exact wording of a statement or submission is not of importance, only a concise summary of the essentials should appear in the minutes.

The minutes with the result reached during the proceedings are communicated to the parties as soon as possible.

**CHAPTER IV**

## TAKING AND CONSERVATION OF EVIDENCE

**1. Taking of evidence by the departments of the EPO**

## 1.1 General remarks

Art. 117  
Rule 72

Formal taking of evidence in accordance with Rule 72(1) will occur mainly in opposition proceedings and hardly ever before the Examining Division. The following Sections of this Chapter are therefore based primarily on opposition proceedings. However, they also apply *mutatis mutandis* to other proceedings and particularly to substantive examination.

Art. 117(1)

## 1.2 Means of evidence

The party or parties may at any time during proceedings submit evidence in support of alleged facts (see III, 5, X, 1.2, D-IV, 5.3 and 5.4, D-VI, 3). This should be done at the earliest opportunity. When such evidence is such as should have been put forward at an earlier stage it is for the competent department to consider whether it is expedient (see VI, 2) to allow the new evidence to be introduced.

It would generally be desirable for a party to produce evidence in respect of all the facts alleged in support of his case, in order, for example, to show whether a particular technique was generally known to industry or whether there was any prejudice against a particular technique.

Facts adduced by a party will, however, normally be deemed true, even without supporting evidence, if it is clear that no doubts exist concerning them, if they do not contradict one another or if no objection is raised. In such cases the facts need not be supported by evidence.

There will however be occasions, particularly in opposition proceedings, in which the arguments of the party or parties must be supported by evidence. This will for example be the case where reference is made to prior art, for instance in the form of an oral description, a use or perhaps a company publication and there is some doubt as to whether, and if so when, such prior art was made available to the public.

The means of evidence are (non-exhaustively) listed in Art. 117:

- production of documents
- hearing the parties
- hearing witnesses
- sworn statements in writing



- requests for information, for instance from a publisher concerning the date of publication of a book
- opinions by experts (see IV, 1.8.1)
- inspection.

The most appropriate way of obtaining evidence in the individual case depends on the facts which have to be proven and on the availability of the evidence. To prove prior use in an opposition the opponent usually offers as evidence the production of documents, the hearing of witnesses or parties, or he presents sworn statements in writing. It is at the Opposition Division's discretion to evaluate this evidence, there are no fixed rules as to how any category of evidence should be judged (for the evaluation of evidence, see IV, 4).

If the documents produced (e.g. patent documents) leave no doubt as to their contents and date of availability to the public and are more relevant for the patent in suit than other evidence offered, reasons of procedural efficiency may lead the Opposition Division to not pursue the other evidence at first.

If the testimony of a witness is offered, the Opposition Division may decide to hear this person in order to verify the facts for which this witness is brought forward, e.g. the prior use of the claimed product in an undertaking or the existence of an obligation to secrecy. For adequate substantiation the notice of opposition should make clear these facts, as witnesses are meant to serve for corroboration of facts brought forward, not for supplying these facts in place of the opponent. The above applies likewise to hearing the parties (see also IV, 1.6)

Whether a written statement ("affidavit") is made under oath or not is only one of the criteria applied by the Opposition Division in its evaluation of the evidence adduced. Apart from its relevance for the case, other criteria are the relationship between the person making the statement and the parties to the proceedings, the personal interest of that person, the context in which the statement was made, etc. Such a statement does not go beyond its literal content and does not allow the Opposition Division to assess the associated or background factors. If the alleged facts are contested by the other party, the Opposition Division does not generally base its decision on such a statement, but summons the person making the statement as a witness, if so offered by the party. The ensuing hearing of the witness allows the Opposition Division and the parties to put questions to the witness and thus enables the Opposition Division to establish the facts on the basis of that person's testimony. If that person is not offered as a witness the Opposition Division will not pursue this evidence further.

Inspection will enable direct observations to be made and direct impressions to be formed of the object or process concerned. It may, for example, involve the demonstration of a product or process requested by the applicant or proprietor of the patent to substantiate the method of operation of the subject-matter of the patent where this is disputed by the Examining or Opposition Division.

Art. 117(2)

### 1.3 Taking of evidence in substantive examination and opposition proceedings

The department responsible for the taking of evidence in the form of a hearing of witnesses, parties and experts will, in substantive examination and opposition proceedings, be the Division before which the taking of evidence as part of oral proceedings would normally take place. However "the Division may commission one of its members to examine the evidence adduced." Generally he will be the primary examiner under Art. 18(2) or Art. 19(2). A member may, for example, be commissioned pursuant to Art. 117(2), for the purposes of an inspection, such as in the form of a demonstration of a process or the investigation of an object, particularly in undertakings located far away.

A member may also be commissioned to attend a court hearing pursuant to Art. 117(6), and put questions to the witnesses, parties and experts.

Rule 72(1)

### 1.4 Order to take evidence

"Where the competent department of the EPO considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it shall make a decision to this end (order to take evidence), setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation." If oral evidence of witnesses and experts is requested by a party but the witnesses and experts are not simultaneously named, the party is requested, either prior to the issue of the order to take evidence or in the order itself, to make known within a specified time limit the names and addresses of the witnesses and experts whom it wishes to be heard. The time limit to be computed in accordance with Rule 84 will normally be two months, since the party concerned will normally know beforehand whom he wishes to be heard as a witness or expert.

Art. 119

The order to take evidence must be notified to the parties. It may be appealed only together with the final decision, unless it allows separate appeal (see X, 6).

### 1.5 Summoning of parties, witnesses and experts

Art. 117(3)(a)  
Art. 119

The parties, witnesses and experts to be heard must be invited to appear to give evidence on the date fixed. The

- Rule 72(2) summons must be notified. At least two months' notice of a summons issued to a party, witness or expert to give evidence shall be given unless they agree to a shorter period. The summons shall contain:
- Rule 72(2)(a) (i) an extract from the order to take evidence, indicating in particular the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses and experts are to be heard;
- Rule 72(2)(b) (ii) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke (see IV, 1.10);
- Rule 72(2)(c) (iii) an indication that the party, witness or expert may request to be heard by the competent court of his country of residence and a requirement that he informs the EPO within a time limit to be fixed by the Office whether he is prepared to appear before it (see IV, 3.2.2 (iii) and (iv)).
- Rule 72(4) Even if evidence is not taken in oral proceedings, all parties to the proceedings "may attend an investigation". Parties not summoned should be informed thereof within the period laid down in Rule 72(2), together with a statement that they may attend.

#### 1.6 Hearing of parties, witnesses and experts

##### 1.6.1 General remarks

Where the Examining or Opposition Division holds hearings for the purpose of taking evidence (see IV 1.3) and if the case in question is expected to give rise to particular legal issues, it is advisable that the Division should be enlarged by the addition of a legally qualified examiner, if this is not already the case (see D-II, 2.2).

Where a hearing is held in connection with oral proceedings, the considerations set out in III, 8.2, 8.3, 8.8 and 8.9 are directly applicable, and where this is not the case they apply *mutatis mutandis*.

The hearing of an "expert" in the sense of Art. 117(3) requires as a precondition a decision to take evidence (see IV, 1.4). This is something different from hearing oral submissions by a person accompanying the representative during oral proceedings, which can be allowed under the discretion of the Division (see Decision G 4/95, OJ 7/1996, 412) (see III, 8.5).

- Rule 74(2) 1.6.2 Witnesses and experts not summoned

After opening the proceedings for the taking of evidence the official in charge of the taking of evidence, i.e. in substantive examination and opposition proceedings the

Chairman of the Division concerned or the member commissioned for the taking of evidence, will determine whether any party requests that any other person present but not summoned should be heard. If a party makes such a request he should briefly state why and to what purpose the person concerned should give testimony. The department in question will then decide on whether or not to grant the request (for the admission of facts or evidence not filed in due time see VI, 2).

## Rule 72(3)

## 1.6.3 Guidance to persons heard

"Before a party, witness or expert may be heard, he shall be informed that the EPO may request the competent court in the country of residence of the person concerned to reexamine his evidence on oath or in an equally binding form."

## 1.6.4 Separate hearings

Normally each witness must be heard separately, i.e. any other witnesses to be heard subsequently must not be present. This rule does not apply to experts and to the parties. Witnesses whose statements conflict may be confronted with one another i.e. each heard in turn in the presence of the other. The same applies to experts.

## 1.6.5 Examination as to personal particulars

The hearing will begin by the person giving evidence being asked his given names, family name, age, occupation and address. Witnesses and experts must also be asked whether they are related by blood or marriage with any of the parties and whether they have a material interest in a particular party being successful in the proceedings.

## 1.6.6 Examination as to res gestae

The examination as to personal particulars will be followed by the examination as to res gestae. The person testifying should be instructed to give a full and logical account of what he knows concerning the subject-matter of the hearing. Further questions may have to be put to clarify and supplement statements and to establish on what the knowledge of the person testifying is based. Such questions may be put by the member commissioned for the taking of evidence, where applicable, the Chairman or any other member of the department concerned. As regards the entitlement of other members of the Division to put questions, see III, 8.8. When formulating questions the same considerations apply as for the parties (see 1.6.7).

## Rule 72(4)

## 1.6.7 Entitlement of parties to put questions at hearings

"The parties may put relevant questions to the testifying

parties, witnesses and experts" including, e.g. in opposition proceedings, witnesses and experts testifying on behalf of other parties. The official in charge of the taking of evidence will determine at what point in the proceedings such questions may be put.

Any doubts on the part of the competent department, e.g. the Opposition Division, or a party as to the admissibility of a question must be settled by the competent department. "Leading questions", i.e. questions which already contain the statement which one would like to hear from the witness, practically only requiring him to answer by "yes" or "no", should be avoided, because they do not allow to properly establish the witness' own recollection of the facts. Questions shall further not be directed to facts which require no further discussion, which are in no way relevant to the subject-matter for which the taking of evidence has been ordered, or if they aim at establishing facts in respect of which no evidence has been offered. A decision to reject a question cannot be challenged. As regards the entitlement of other members of the Division to put questions, see III, 8.8.

Rule 76

1.7 Minutes of taking of evidence

"Minutes of the taking of evidence shall be drawn up" as described in III, 10, subject to the following qualifications:

The minutes of the taking of evidence must, in addition to the essentials of the taking of evidence, also record as comprehensively as possible (almost verbatim as far as the essential points are concerned) the testimony of the parties, witnesses or experts.

Rule 76(2)

The minutes will normally be taken down by a member of the competent department carrying out the taking of evidence. The most efficient way of noting testimony is by way of dictation on to a dictating machine, in the process of which the person hearing the evidence will summarise the testimony in small sections, taking into account any objections raised by the person being heard, and dictate it in this form on to a dictating machine. If the dictated passage does not correspond in full to his testimony, the person being heard should raise any objections immediately. This should be pointed out to him at the beginning of his testimony. At the end of his testimony, he will be asked to approve the dictated minutes, which he will have listened to as they were dictated. His approval or any objections should be included in the dictated text. The dictated minutes are typed out and the parties are provided with a copy as soon as possible.

Where the taking of evidence includes an inspection, the minutes must record, in addition to the essentials of the proceedings, the results of the inspection.

In addition the taking of evidence as well as oral proceedings (see III, 10.1) may be recorded on sound recording apparatus.

Rule 73(1)

1.8 Commissioning of experts

1.8.1 Decision on the form of the report

If the competent department decides of its own motion to obtain an expert report (D-VI, 1, 6th paragraph) it will have to decide in what form it should be submitted by the expert whom it appoints. The report should be drawn up in written form only in cases where the competent department considers that this form is adequate in view of the content of the report and provided that the parties agree to this arrangement. As a rule, in addition to submitting a written report and introducing it orally, the expert will also be heard (see IV, 1.6).

Rule 73(3)

"A copy of the report shall be submitted to the parties." The copy will be produced by the EPO.

Rule 73(4)

1.8.2 Objection to an expert

The parties may object to an expert. Therefore, before commissioning an expert to make a report, the competent department should inform the parties of the expert whom it intends to ask to draw up a report and of the subject-matter of the report. The communication to the parties should state a time limit within which objections to the expert may be made. If the parties do object to an expert, the competent department will decide on the objection.

Rule 73(2)

1.8.3 Terms of reference of the expert

"The terms of reference of the expert shall include: a precise description of his task, the time limit laid down for the submission of his report, the names of the parties to the proceedings and particulars of the rights which he may invoke under the provisions of Rule 74(2) to (4)" (Regarding travel and subsistence expenses and his fees, see IV, 1.10).

1.9 Costs arising from oral proceedings or taking of evidence

Art. 104(1)

Rule 74(1)

Art. 104(2)

As a rule, each party to proceedings before the EPO meets the costs he has incurred. This principle notwithstanding, the competent body in the opposition proceedings may for reasons of equity (cf. D-IX, 1.4) decide to apportion in some other way the costs arising for the parties in respect of oral proceedings or taking of evidence (cf. D-IX, 1) and the costs arising for the EPO in respect of witnesses and experts (cf. IV, 1.10). The competent body may make the taking of evidence "conditional upon

deposit with it" (the EPO) "by the party who requested the evidence to be taken, of a sum the amount of which shall be fixed by reference to an estimate of the costs." This procedure should be applied where at the request of a party to grant or opposition proceedings evidence is to be taken by hearing witnesses or seeking an expert opinion, unless no costs will arise because the witness or expert has waived his right to indemnification. If the party requesting evidence to be taken does not comply with the requirement of making such a deposit the evidence need not be taken. In opposition proceedings the party requesting the evidence bears the costs of indemnifying witnesses or experts, unless for reasons of equity in individual cases other arrangements are made for the apportionment of costs under Art. 104(1) in conjunction with Rule 63. Any shortfall between the deposit lodged and the amounts payable by the Office under Rule 74(4), 2nd sentence, is fixed by the Office of its own motion. Any unused amount of the deposit lodged is refunded. The Office's internal costs arising through oral proceedings or taking of evidence, e.g. any associated staff travel and subsistence costs, are to be met by the Office itself.

## Rule 74(2)

## 1.10 Entitlements of witnesses and experts

## 1.10.1 Expenses for travel and subsistence

"Witnesses and experts who are summoned by and appear before the EPO shall be entitled to appropriate reimbursement", by the EPO, "of expenses for travel and subsistence" (see IV, 1.10.3). This applies even if the witnesses or experts are not heard, e.g. where evidence is to be produced concerning an alleged prior use and shortly before the taking of evidence such prior use is substantiated by a document already published. Witnesses and experts may be granted an advance on their expenses for travel and subsistence. Witnesses and experts who appear before the EPO without being summoned by it but are heard as witnesses or experts will also be entitled to appropriate reimbursement of expenses for travel and subsistence.

## Rule 74(3)

## 1.10.2 Loss of earnings, fees

"Witnesses entitled to reimbursement" of travel and subsistence expenses "shall also be entitled to appropriate compensation", by the EPO, "for loss of earnings, and experts to fees" from the EPO "for their work" (see IV, 1.10.3). "These payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks."

## Rule 74(4)

## 1.10.3 Details of the entitlements of witnesses and experts

"The Administrative Council" of the European Patent Organisation has laid "down the details" governing the

entitlements of witnesses and experts set out under IV, 1.10.1 and 1.10.2, see document CA/D 5/77 (published in OJ 3/1983, 100) "Payment of amounts due shall be made by the EPO."

## 2. Conservation of evidence

- Rule 75(1) 2.1 Requirements
- "On request, the EPO may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence." This could for example be the case where an important witness is about to emigrate to a distant country or where perishable matter, e.g. a food-stuff, is adduced as involving a use made accessible to the public.
- Rule 75(2) 2.2 Request for the conservation of evidence
- The request for the conservation of evidence must contain:
- Rule 75(2)(a) (i) the name and address of the person filing the request and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 26(2) (c);
- Rule 75(2)(b) (ii) sufficient identification of the European patent application or European patent in question;
- Rule 75(2)(c) (iii) the designation of the facts in respect of which evidence is to be taken;
- Rule 75(2)(d) (iv) particulars of the way in which evidence is to be taken;
- Rule 75(2)(e) (v) a statement establishing a prima facie case for fearing that it might subsequently become more difficult or impossible to take evidence.
- Rule 75(3) "The request shall not be deemed to have been filed until the fee for conservation of evidence has been paid."
- 2.3 Competence
- Rule 75(4) "The decision on the request and any resulting taking of evidence shall be incumbent upon the department of the EPO required to take the decision liable to be affected by the facts to be established."
- Responsibility for the decision and the taking of evidence will therefore normally rest with:



(i) the Examining Division, from the date of filing until the date of the decision on the granting of the patent;

(ii) the Opposition Division, from the latter date until expiry of the time allowed for filing notice of opposition and during opposition proceedings, and

(iii) the Board of Appeal, from the date of a final decision by the Opposition Division until it becomes legally binding or while appeal proceedings are pending.

#### 2.4 Decision on the request and the taking of evidence

Rule 75(1)  
Rule 72(1) The competent department must decide upon the request without delay. If it grants the request it must also immediately make a decision on the taking of evidence.

Rule 75(4) "The provisions with regard to the taking of evidence in proceedings before the EPO shall be applicable."

Rule 75(1)  
Rule 72(2)(4) "The date on which the measures are to be taken" must therefore "be communicated to the applicant for or proprietor of the patent" and the other parties "in sufficient time to allow them to attend. They may ask relevant questions."

### **3. Taking of evidence by courts or authorities of the Contracting States**

#### 3.1 Legal co-operation

Art. 131(2) "Upon receipt of letters rogatory from the EPO, the courts or other competent authorities of Contracting States shall undertake, on behalf of that Office and within the limits of their jurisdiction, any necessary enquiries."

#### 3.2 Means of giving or taking evidence

Art. 117(6) 3.2.1 Taking of evidence on oath or in equally binding form

The principle case where evidence is taken by a competent court will be the hearing of parties, witnesses or experts. In such instances the competent department "may request the competent court to take the evidence on oath or in an equally binding form".

#### 3.2.2 Cases where evidence is taken in this manner

Art. 117(6) The competent department will, if necessary, request a competent court to take evidence, where appropriate under oath, where:

(i) the taking of evidence by that department would entail disproportionately high travelling costs or the taking of evidence by the competent court appears to be appropriate on other grounds,

- Art. 117(5) (ii) the competent department considers it advisable for the evidence of a party, witness or expert it has heard to be re-examined under oath or in an equally binding form (see IV, 3.2.1),
- Art. 117(4) (iii) there has been no reply to the summons by the expiry of a period fixed by the competent department in the summons (see IV, 1.5 (iii)), or
- Art. 117(4)  
Rule 99(3) (iv) a party, witness or expert who has been summoned before that department requests the latter in accordance with IV, 1.5 (iii), to allow his evidence to be heard by a competent court in his country of residence. If the party, witness or expert simply refuses to be heard by the responsible Division, he should be notified that the competent national court will have the relevant national legal possibilities to oblige him to appear and to testify.
- 3.3 Letters rogatory
- Rule 99(2) "The EPO shall draw up letters rogatory in the language of the competent authority or shall attach to such letters rogatory a translation into the language of that authority".
- Rule 99(1) Letters rogatory should be addressed to the central authority designated by the Contracting State.
- 3.4 Procedures before the competent authority
- Rule 99(5) "The EPO shall be informed of the time when, and the place where, the enquiry is to take place and shall inform the parties, witnesses and experts concerned."
- Art. 117(6)  
Rule 99(6) "If so requested by the EPO, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority." Whether the parties may put questions or not will depend on the laws of the Contracting States concerned.
- Rule 99(7) 3.5 Costs of taking evidence
- "The execution of letters rogatory shall not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the European Patent Organisation to reimburse any fees paid to experts and interpreters and the costs incurred" as a result of the attendance of members of the competent department when evidence is taken.
- Rule 99(8) 3.6 Taking of evidence by parties
- "If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may,

with the consent of the competent department, appoint a suitable person to do so. When seeking the consent of the department concerned, the competent authority shall indicate the approximate costs which would result from this procedure. If the competent department gives its consent, the European Patent Organisation shall reimburse any costs incurred; without such consent, the Organisation shall not be liable for such costs."

#### **4. Evaluation of evidence**

##### **4.1 General remarks**

The competent department must examine whether the conclusions drawn by the parties from the evidence and facts are correct and give grounds for the conclusions it itself freely arrives at on the basis of the situation as a whole.

The state of the art to be taken into consideration in individual cases for the purposes of Art. 54 is that laid down in C-IV, 5, 6 and 8, and D-V, 3.1 and 3.2.

The competent department is not obliged to take into consideration any facts or evidence not presented by the parties in due time, except within the limits specified in VI, 2.

##### **4.2 Evaluation of the testimony of a witness**

After the witnesses have been heard, the party or parties must be given an opportunity of making observations. The observations may be made either in oral proceedings following the taking of evidence or exceptionally in writing after transmission of the minutes of the taking of evidence. The decision on this matter will rest with the competent department. The parties may file requests accordingly.

Only when this has been done should the competent department proceed to evaluate the evidence. Where a witness's testimony which is crucial to the decision has been challenged by a party but the department regards it as credible, or where a witness's oral or written testimony is disregarded in its decision as being not credible, the department concerned must state the grounds for its view in its decision.

In evaluating a witness's oral or written testimony, special attention should be paid to the following:

- (i) What is important is what a witness can relate concerning the points at issue on the basis of his own knowledge or views, and whether he has practical experience in the field in question. Second-hand assertions based on something heard from third parties are for the

most part worthless on their own. It is also important from the point of view of the evaluation whether the witness was involved in the event himself or only knows of it as an observer or listener.

(ii) In the event of long intervals of time (several years) between the event in question and the testimony, it should be borne in mind that most people's power of recall is limited without the support of documentary evidence.

(iii) Where testimony appears to conflict the texts of the statements concerned should be closely compared with one another. Apparent contradiction in the testimony of witnesses may sometimes be resolved in this way. For example, a close examination of apparently contradictory statements by witnesses as to whether a substance X was commonly used for a particular purpose may show that there is in fact no contradiction at all, in that while one witness was saying specifically that substance X was not used for that particular purpose, the other witness was saying no more than that substances like X or that a certain class of substances to which X belonged, were commonly used for this particular purpose without intending to make any statement regarding substance X itself.

#### 4.3 Evaluation of the testimony of parties

Oral or written evidence given by parties or their refusal to give evidence should be evaluated in the light of their special interest in the matter. Because of their special interest, the testimony of parties should possibly not be evaluated on the same level as that of neutral witnesses. This applies above all where parties have been present when witnesses have been heard and have ascertained the attitude of the competent department. The considerations set out in IV, 4.2 (Evaluation of the testimony of a witness) apply *mutatis mutandis*.

#### 4.4 Evaluation of an expert opinion

The competent department must examine whether the grounds on which an expert opinion is based are convincing. Notwithstanding its discretion in the evaluation of evidence, it may not disregard an expert opinion in the absence of grounds based on adequate specialist knowledge of its own or of another expert, irrespective of whether the latter expert is an independent expert commissioned under Rule 73 or an expert who testifies at the request of one of the parties.

#### 4.5 Evaluation of an inspection

In the case of a demonstration a specific test programme under specific conditions should be agreed in advance. During the demonstration itself care must be taken to

ensure that the characteristics or conditions of operation claimed for the invention are complied with. Where an invention is compared under test with an item forming part of the state of the art, as far as possible the same or comparable test conditions must be applied to both.

**CHAPTER V****DEROGATIONS FROM THE LANGUAGE OF THE PROCEEDINGS IN ORAL PROCEEDINGS****1. Use of an official language**

Rule 2(1)  
Rule 2(5)

"Any party to oral proceedings before the EPO may, in lieu of the language of the proceedings, use one of the other official languages of the EPO, on condition either that such party gives notice to the EPO at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings." In the former case, it is the responsibility of the Office to provide for interpretation at its own expense.

**2. Language of a Contracting State or other language**

Rule 2(1)  
Rule 2(4)

"Any party may likewise use one of the official languages of the Contracting States", other than English, French or German "on condition that he makes provision for interpretation into the language of the proceedings." However, "if the parties and the EPO agree, any language may be used in oral proceedings" without interpretation or prior notice.

**3. Exceptions from points 1 and 2**

Rule 2(1)

Derogations are permitted from the provisions of Rule 2(1), and these are at the discretion of the EPO. Clearly such permission must depend on the circumstances of the individual case. It can for example be envisaged that a party might be unable to give one month's notice through no fault of his own, and, although he has made arrangements for an interpreter, the latter is unable (e.g. through illness) to attend. If, in such circumstances, the Office is unable to provide for interpretation, it should, if the oral proceedings occur at the examination stage, postpone them. However, in opposition proceedings, the oral proceedings should continue if the parties agree and the employees of the EPO involved in the proceedings can cope with the language. In other cases, the Office should postpone the oral proceedings and any costs incurred by the innocent party as a result of the postponement should be a matter for apportionment under Art. 104.

**4. Language used in the taking of evidence**

Rule 2(3)

When the evidence is being taken, a party, witness or expert who is unable to express himself adequately in English, French or German or in any other official language of the Contracting States, is permitted to use another language. The Office is responsible for interpretation into the language of the proceedings, assuming that this is necessary, if the evidence is taken at the request of

the Office itself. But, if the taking of evidence follows a request by a party to the proceedings, the use of a language other than English, French or German should be allowed only if that party provides for interpretation into the language of the proceedings or, at the discretion of the Office, into any one of English, French or German. This discretion should be exercised in opposition proceedings only if the other parties agree.

#### **5. Language used by employees of the EPO**

Rule 2(2)

Employees of the EPO may use any one of English, French or German in the course of all oral proceedings. If, prior to the commencement of oral proceedings, an employee is aware that he may need to use a language other than the language of the proceedings, he should ensure that the parties involved are informed of his intention. However, employees should not depart from the language of the proceedings without good reason, and unless the parties involved are competent in the language used and express no objection, the Office should provide for interpretation into the language of the proceedings at its own expense.

#### **6. Language used in the minutes**

Where the official language actually employed in an oral proceedings is not the language of the proceedings as defined in Art. 14(3), if the Examining or Opposition Division considers it appropriate and subject to explicit agreement of all parties concerned, the minutes may be recorded in the language actually employed in the oral proceedings.

Prior to the agreement of the parties, their attention should be drawn to the fact that the Office will not provide translations of the minutes into the language of the proceedings as defined in Art. 14(3). This condition, as well as the declaration of agreement of the party or parties, should be recorded in the minutes.

Statements made in English, French or German, are entered in the minutes of the proceedings in the language employed.

Rule 2(6)

"Statements made in any other language shall be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent" made during oral proceedings "shall be entered in the minutes in the language of the proceedings." If the proceedings are conducted in a language other than English, French or German and no interpretation is effected then statements should be entered in the minutes in the language em-

ployed and the Office should subsequently provide in the minutes a translation into the language of the proceedings.



**CHAPTER VI**

EXAMINATION BY THE EPO OF ITS OWN MOTION;  
FACTS OR EVIDENCE NOT SUBMITTED IN DUE TIME;  
OBSERVATIONS BY THIRD PARTIES

**1. Examination by the EPO of its own motion**

## 1.1 General remarks

Art. 114(1)

"In proceedings before it, the EPO shall examine the facts of its own motion; it shall not be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought." This principle of examination by the EPO of its own motion must be complied with by the competent department during all proceedings pending before it. If, therefore, once proceedings have been initiated, e.g. once a valid request for examination has been filed or an admissible notice of opposition has been filed (although it may subsequently be withdrawn) there is reason to believe, e.g. from personal knowledge or from observations presented by third parties, that there are facts and evidence not already considered in the proceedings which in whole or in part prejudice the granting or maintenance of the European patent, such facts and evidence must be included in those examined by the EPO of its own motion pursuant to Art. 114(1). See D-V, 2 for the extent of the substantive examination of the facts and evidence in opposition proceedings.

## 1.2 Limits on the obligation to undertake examination

However, the obligation to undertake such examination should be kept within limits in the interests of procedural expediency. For example, in opposition proceedings, an offer to prove that an alleged public prior use took place should not be taken up if the opponent making such an allegation has ceased to participate in the proceedings and the necessary evidence cannot be easily obtained at a reasonable cost.

The unity of the subject-matter of the European patent may not be examined in opposition proceedings (see D-V, 2.2, penultimate paragraph).

**2. Facts or evidence not submitted in due time**

(for the situation where submissions of the parties are filed late in respect of the date indicated in the note to the summons to oral proceedings, pursuant to Rule 71a(1), primarily E-III, 8.6 applies).

Art. 114(2)

"The EPO may disregard facts or evidence" (e.g. publications) "which are not submitted in due time by the parties concerned." This also applies to grounds for opposition not

submitted in due time, together with supporting facts and evidence in opposition proceedings. According to Decisions G 1/95 and G 7/95 (see OJ 11/1996, 615 and 626), Art. 100(a) does not constitute one single ground of opposition, but has to be considered a collection of individual grounds of opposition, i.e. individual legal bases for objection to the maintenance of a patent. This applies not only to distinctly different objections as e.g. subject-matter which is not patentable (Art. 52(2)) as compared to subject-matter which is not capable of industrial application (Art. 57), but also to an objection for lack of novelty as opposed to an objection for lack of inventive step.

In deciding whether to admit the facts or evidence not filed in due time their relevance to the decision, the state of the procedure and the reasons for the belated presentation are to be considered. If examination of the late-filed ground of opposition, the late filed facts or evidence reveals without any further investigation (i.e. prima facie) that they are relevant, i.e. that the basis of the envisaged decision would be changed, then the competent department has to take such ground, facts or evidence into consideration no matter what stage the procedure has reached and whatever the reasons for the belated presentation. In that case the principle of examination by the EPO of its own motion under Art. 114(1) takes precedence over the possibility of disregarding facts or evidence under Art. 114(2) (see T 156/84, OJ 10/1988, 372). Note, however, the limits on the obligation to undertake further examinations in VI, 1.2. Otherwise it should inform the party concerned, at the latest in the decision that the facts and evidence were not submitted in due time and, since they are not relevant to the decision, will be disregarded pursuant to Art. 114(2). On the apportionment of costs possibly resulting from the late filing of facts and evidence see D-IX, 1.4.

The latest date up to which submissions can at all be considered is the date on which the decision is handed over to the EPO's internal postal service for transmittal to the parties (see Decision G 12/91, OJ 5/1994, 285).

The above applies in written proceedings; in oral proceedings submissions can only be considered up to the pronouncement of the decision (see III, 9).

### **3. Observations by third parties and examination thereof**

Art. 115(1)

"Following the publication of the European patent application" under Art. 93, "any person may present observations concerning the patentability of the invention. Such observations must be filed in writing and must include a statement of the grounds on which they are based. That person shall not be a party to the proceedings before the EPO." The statement of grounds must be presented in German,

English or French language. Although receipt of the observations is acknowledged to the third party, the EPO does not inform him of the further action taken by the Office in response to his observations.

Art. 115(2)

The observations are communicated to the applicant or proprietor without delay and he may comment on them. If, in whole or in part, they call into question the patentability of the invention, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated, i.e. they must be introduced into the proceedings. If the observations relate to alleged prior art available other than from a document, e.g. from use, this should be taken into account only if the alleged facts are either not disputed by the applicant or proprietor or established beyond reasonable doubt. Observations by third parties received after the conclusion of proceedings will not be taken into account and will simply be added to the file. ==

**CHAPTER VII**

## INTERRUPTION OF THE PROCEEDINGS

Rule 90(1) **1. Cases in which the proceedings may be interrupted**

Proceedings before the EPO shall be interrupted:

Rule 90(1)(a) (i) in the event of the death or legal incapacity of the applicant for or proprietor of a European patent or of the person authorised by national law to act on his behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Art. 134, proceedings shall be interrupted only on application by such representative;

Rule 90(1)(b) (ii) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO;

Rule 90(1)(c) (iii) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European patent or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the EPO.

The parties will be informed of the interruption of the proceedings and the reasons therefor.

**2. Resumption of proceedings**

Rule 90(2) When, in the cases referred to in VII, 1 (i) and (ii), the EPO has been informed of the identity of the person authorised to continue the proceedings before the EPO, the EPO shall communicate to such person and to any interested third party that the proceedings shall be resumed as from a date to be fixed by the EPO. The time at which the date is set should be such that the person concerned has sufficient opportunity to become thoroughly familiar with the matter.

Rule 90(3) In the case referred to in VII, 1(iii), the proceedings shall be resumed when the EPO has been informed of the appointment of a new representative of the applicant or when the EPO has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the EPO has not been informed of the appointment of a new representative it shall communicate to the applicant for or proprietor of the patent:

Rule 90(3)(a) (i) where Art. 133(2) (mandatory appointment of a representative), is applicable, that the European patent

application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified, or

Rule 90(3)(b)

(ii) where Art. 133(2) is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

A copy of the communication will be forwarded to the other parties.

Rule 90(4)

2.1 Resumption of time limits

"The time limits, other than the time limit for making a request for examination and the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the patent at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed. If such date is less than two months before the end of the period within which the request for examination must be filed, such a request may be filed up to the end of two months after such date."

### 3. Department responsible

Art. 20

The Legal Division is responsible for questions concerning the interruption or resumption of proceedings (see Information from the EPO, OJ 9/1990, 404).

**CHAPTER VIII**

## TIME LIMITS, LOSS OF RIGHTS, FURTHER PROCESSING AND RE-ESTABLISHMENT OF RIGHTS

**1. Time limits and loss of rights resulting from failure to respond within a time limit**

## 1.1 Determination of time limits

Art. 120

The Convention and the Implementing Regulations impose time limits upon parties to proceedings.

Some of these are fixed by the Convention e.g. in Art. 78(2) (payment of filing and search fees), Art. 91(5) (designation of the inventor), Art. 94(2) (request for examination) and Art. 99(1) (opposition). Others are fixed in the Implementing Regulations, e.g. in Rule 36(5) (document reproducing contents of telegram or telex), and Rule 69(2) (applying for a decision after notification of loss of rights).

Others take the form of a stipulated range, e.g. 2 to 6 weeks as in Rule 46(1) (payment of further search fees), the precise period within this range being at the Office's discretion.

In other cases, e.g. those dealt with in Rule 41(1) (rectification of deficiencies in the form of the application documents) and Art. 96(1) (invitation to the applicant to indicate whether he desires to proceed further with the European patent application), a time limit, but not its duration, is laid down in the Convention or in the Implementing Regulations. The duration must be determined by the Patent Office in accordance with Rule 84 (see VIII, 1.2).

## 1.2 Duration of the time limits to be determined by the Patent Office on the basis of provisions of the Convention or the Implementing Regulations

The length of the time limits should be based, in principle, on the amount of work which is likely to be required to perform the operation in question. However in order to facilitate the work of parties and the Office it has been decided, as a general rule, to adopt a uniform practice with respect to time limits. This practice is at present as follows.

(i) If deficiencies to be corrected are merely formal or merely of a minor character; if simple acts only are requested, e.g. under Rule 59 the subsequent filing of documents referred to by a party; or if observations are required on amendments which are merely of a minor character - two months.

(ii) Communications from an Examining or Opposition Division raising matters of substance - four months.

Art. 96(1)

A longer time limit of up to six months should be set only in the exceptional cases where it is clear that in the circumstances a four-month time limit cannot be adhered to. Each case must be judged on its individual merits and it is difficult to give general guidance but a six-month time limit might be justified e.g. if the subject-matter of the application or patent or the objections raised are exceptionally complicated. Where the applicant is invited to submit the statement provided for in Art. 96(1), a six-month time limit running from the publication of the search report is appropriate.

Rule 1(3)

Some Rules stipulate a minimum time limit, e.g. Rule 1(3) (translation of a document to be used in evidence) "not less than one month". Where this is so, the stipulated minimum period takes the place of the minimum period of two months referred to in Rule 84.

#### 1.3 Time limits which may be freely determined

Time limits for operations in respect of which the setting of a time limit is not explicitly provided for in the Convention or the Implementing Regulations are not subject to the restrictions as to the duration of time limits laid down in Rule 84. They may be fixed by the Patent Office at its own discretion. For example, if a party is requested to forward copies of his document where this was not submitted in the required number of copies (Rule 36(4)), a time limit of two to four weeks would be appropriate.

#### 1.4 Calculation of time limits

Rule 83  
Rule 78  
Rule 85

Although Rule 83 allows other possibilities, any period fixed by the Office will usually be specified in full months which will be calculated from the receipt of the communication by the person to whom it is addressed (see Rule 78(2)). Rule 83 gives precise details for the determination of the day of expiry of the period, whilst Rule 85 contains provisions covering certain contingencies, e.g. that the Office is not open on the day on which a time limit expires, or that there is a general disruption in the postal facilities between the Office and a Contracting State.

Rule 90

When proceedings have been interrupted because of the death of the applicant or proprietor or for any of the other reasons specified in Rule 90, time limits are subject to the provisions of Rule 90(4). The time limits for the payment of the examination fee and the renewal fees are suspended (see J 07/83, OJ 5/1984, 211).

## 1.5 Effect of change in priority date

- Art. 88(2) Certain time limits run from the date of priority, or in the case of multiple priorities, from the earliest date of priority. Where this date no longer applies (e.g. the right of priority is lost in accordance with the provisions of Art. 91(3)), any such time limits become determinable from the amended date of priority. This does not restore any loss of right resulting from a time limit having already expired before the loss of priority date. The Formalities Guidelines deal with the procedure to be followed (see A-III, 6.11).

## 1.6 Extension of a time limit

- Rule 84 Apart from the automatic extension of time limits under Rule 85 (see VIII, 1.4) and cases in respect of which the Convention or the Implementing Regulations specify a fixed period which may not be extended, the duration of time limits may be extended, but the applicant must request this extension in writing, before the expiry of the period that has been set. The extended period is to be calculated from the start of the original period (see Legal Advice No. 5/93 rev., Point III, OJ 4/1994, 229). No written confirmation is required for requests for extension of time limits filed by telegram, telex or facsimile. For any communication raising a matter of substance, a request for extension, even if filed without reasons, should normally be allowed if the total period set does not thereby exceed six months. A short time limit for correcting a mere formal or minor deficiency should be extended under the same circumstances by two months. However, a request for a longer extension, especially if the total period set exceeds six months, should be allowed only exceptionally, when the reasons given are sufficient to show convincingly that a reply in the period previously laid down will not be possible. Such exceptional circumstances might be e.g. the fact that a representative or client is so seriously ill that he cannot deal with the case in time; or the need to perform extensive biological experiments or tests. On the other hand foreseeable or avoidable circumstances (e.g. leave, pressure of other work) should not be accepted as a sufficiently exceptional circumstance (cf. notice of the Vice-President of the Directorate-General for Examination/Opposition of the EPO, OJ 5/1989, 180).

If the request for an extension of time is granted, the party should be informed of the new time limit. Otherwise, he should be told that the relevant sanction has taken effect or will take effect (see VIII, 1.9.2).

- Art. 106(3) If the request for extension of a time limit filed in good time has been rejected and the applicant considers this unjust, the ensuing loss of rights can only be overcome by a request for further processing under Art. 121. At the same time, he may request reimbursement of the fee for further



processing. A decision rejecting the request for reimbursement is open to appeal, either together with the final decision or separately, as the case may be (see J 37/89, OJ 4/1993, 201).

#### 1.7 Late receipt of documents

The fiction that a time limit has been observed is created provided a document received late was posted or delivered to one of the delivery services recognised by the President of the EPO (DHL, Express Post, Federal Express, TNT, UPS) at least five days before expiry of the time limit and was received no later than three months after expiry of the time limit (see Decision of the President of the EPO, OJ 1/1999, 45, and OJ 5/1999). Rule 84a applies to all time limits to be observed vis-à-vis the Office and/or the national authorities, including the priority period laid down in Art. 87(1). The document must have been sent as a registered letter or in a form of consignment corresponding to registration and, if posted outside Europe, by airmail. Within the meaning of Rule 84a a document is deemed to have been posted or delivered to a delivery service within Europe if it was despatched in one of the states belonging to the European Conference of Postal and Telecommunications Administrations (CEPT) (in addition to the EPC Contracting States these are the states listed below) or in a state which is generally understood to be part of Europe. At the request of the EPO, confirmation of registration by the post office or of receipt by the delivery service must be provided as evidence that the document was posted in due time. Despite this legal fiction that the time limit has been observed, the filing date of the document remains the day on which it was actually received.

The following non-Contracting States belong to the CEPT:

Albania, Andorra, Bosnia and Herzegovina, Bulgaria, Croatia, Czech Republic, Estonia, Hungary, Iceland, Latvia, Lithuania, Malta, Moldova, Norway, Poland, Romania, Russian Federation, San Marino, Slovakia, Slovenia, The former Yugoslav Republic of Macedonia, Turkey, Ukraine and the Vatican.

#### 1.8 Failure to respond within a time limit

If a party has not acted within a time limit, various sanctions may be applied depending on the circumstances. For instance, under Art. 90(2), the application will not be proceeded with; under Art. 91(3) the application may be refused or a right of priority lost; under Rule 5 a document may be deemed not to have been received. If the request for examination has not been filed in time the application is deemed to be withdrawn (Art. 94(3)) and this sanction may also apply in those cases where the applicant fails to

meet a time limit set by the Office (e.g. the time limit for replying to an invitation to amend under Art. 96(2)).

If a particular time limit is not complied with and, in contrast to cases where mandatory legal sanctions are laid down (e.g. revocation of the European patent if the printing fee is not paid in due time (Art. 102(4)), no specific legal sanction is laid down in the Convention or the Implementing Regulations, submissions and requests from the parties made after the expiry of the time limit but before a decision is handed over to the EPO's internal postal service for transmittal to the parties (see Decision G 12/91, OJ 5/1994, 285), are to be regarded in the rest of the proceedings as if they had been received in time; any facts or evidence are, however, to be treated as not filed in due time (Art. 114(2), see also VI, 2).

#### 1.9 Loss of rights

##### Rule 69

##### 1.9.1 Cases of loss of rights

If a party to the proceedings or a third party fails to comply with a time limit laid down in the Convention or fixed by the Patent Office this will result in a loss of rights in certain cases specified in the Convention, "without any decision concerning the refusal of the European patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence".

##### Art. 119 Rule 69(1)

##### 1.9.2 Noting and communication of loss of rights

If there has been a loss of any right as described in VIII, 1.9.1, a formalities officer will note such loss of rights and "communicate this to the person concerned". The communication will be notified to the person concerned as a matter of course (see also D-IV, 1.4.1).

##### Rule 69(2)

##### 1.9.3 Decision on loss of rights

"If the person concerned considers that the finding of the EPO is inaccurate, he may, within two months after notification of the communication, apply for a decision on the matter by the EPO."

The competent department of the Patent Office will give such a decision "only if it does not share the opinion of the person requesting it; otherwise it shall inform the person requesting the decision" and then continue with the proceedings. Since such decisions are subject to appeal the reasons on which they are based must be stated. Only the person affected by the loss of rights noted will be party to the proceedings.

## 2. Further processing and re-establishment of rights

### 2.1 Request for further processing of the European patent application

Art. 121(1)  
Art. 121(2)  
Art. 121(3)

"If the European patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit set by the EPO" (as distinct from those fixed by the Convention or in the Implementing Regulations), the application is allowed to proceed if the applicant makes a written request for further processing of the application. This request must, however, be filed within two months of the notification of refusal or notice that the application is deemed to be withdrawn; and the omitted act must be completed and a fee for further processing must be paid within this period. "The request shall not be deemed to have been filed until this fee has been paid. The department competent to decide on the omitted act shall decide on the request" for further processing.

### 2.2 Re-establishment of rights

#### 2.2.1 General remarks

Art. 122

"The applicant for or proprietor of a European patent who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit" not specifically excluded by Art. 122(5) may apply to have his rights re-established. The conditions governing such application are fully set out in Art. 122(1) to (6). The provisions of this Article might be invoked if e.g. the applicant's working documents had been destroyed by fire and he had been obliged to prepare fresh ones; or if a specialist agency had sent him the wrong set of drawings relating to a priority document, and the error was not immediately apparent. In all instances it is necessary for the applicant or proprietor or representative, as the case may be, to supply evidence that he had exercised all due care required by the circumstances and that the delay was caused by unforeseeable factors. Errors of law, however, do not constitute grounds for re-establishment (see e.g. D 6/82, OJ 8/1983, 337).

#### 2.2.2 Extension of re-establishment of rights to opponents

Re-establishment of opponents in respect of the time limit for filing the appeal itself is excluded under Art. 122(1)(see T 210/89, OJ 8/1991, 433). However, an opponent who has filed an appeal can request re-establishment of rights in respect of the time limit for submitting the grounds for appeal (see Decision G 1/86, OJ 10/1987, 447).

Art. 122(1)

## 2.2.3 Relevant time limits

"Time limit" shall be taken to mean a specific period of time within which an act vis-à-vis the EPO has to be completed. A time limit is therefore not a date, i.e. an appointed day. Accordingly, no provision may be made for re-establishment of rights in the event of failure to be present on the date appointed for oral proceedings.

Art. 102(3)-(5)  
Rule 58(6)  
Rule 90(3)(a)  
Rule 63(3)

The following are examples of cases where re-establishment of rights is possible in the event of failure to comply with a time limit. They concern the time limits for:

- the payment of the fee for the printing of the new specification of the European patent,
- the filing of the translation of any amended claims,
- informing the Office of the appointment of a new representative,
- filing the request for a decision by the Opposition Division on the awarding of costs by the registry and for appeals filed by applicants or patent proprietors (see XI, 6).

## 2.2.4 Time limits not covered

Art. 122(1)(5)

Re-establishment of rights is expressly excluded as regards the time limits for the application for *restitutio in integrum* (see VIII, 2.2.5) and the time limits laid down in Art. 61(3), Art. 76(3), Art. 78(2), Art. 79(2), Art. 87(1), and Art. 94(2). The time limits for the payment of the filing fee, search fee, designation fee and examination fee in respect of a Euro-PCT application under Art. 150(2), as well as the periods of grace under Rule 85a and Rule 85b are excluded from re-establishment of rights (see Decisions G 3/91, OJ 1-2/1993, 8; G 5/92 and 6/92, OJ 1-2/1994, 22 and 25; as well as J 18/82, OJ 11/1983, 441). However, Euro-PCT applicants may be re-established in the time limit for paying the above mentioned fees in all cases where re-establishment was applied for before Decision G 3/91 (see above) was made available to the public, (see Decision G 5/93, OJ 7/1994, 447)). Furthermore, re-establishment of rights will not be permitted in cases of failure to comply with time limits which do not have the "direct consequence of causing the refusal of the European patent application, or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress". For example, there can be no re-establishment of rights as regards the time limits for submission by the patent proprietor in opposition proceedings of his observations on the written statements of the other parties to the proceedings or on communications from the Opposition Division.

Art. 122(2)(3)

## 2.2.5 Applications for re-establishment of rights

"The application" for the re-establishment of rights "must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit."

"The application must state the grounds on which it is based, and must set out the facts on which it relies. It shall not be deemed to be filed until after the fee for the re-establishment of rights has been paid" to the amount laid down in the Rules relating to Fees under the European Patent Convention.

## 2.2.6 Special considerations in proceedings with more than one party

If, for instance, in opposition proceedings, the proprietor of the patent files an application for re-establishment of rights, the opponents and any third parties, although not involved in the procedure for the re-establishment of rights must be informed of the application for re-establishment of rights and the subsequent decision, if this involves the re-establishment of rights as regards a time limit connected with the opposition procedure.

## 2.2.7 Decision on re-establishment of rights

Art. 122(4)

"The department competent to decide on the omitted act shall decide upon the application" for re-establishment of rights. The grounds for the decision need only be stated if the application is disallowed. This also applies in opposition proceedings since the opponents are not involved in the procedure for re-establishment of rights.

The department which took the contested decision will have to consider re-establishment of rights in respect of an unobserved time limit for appeal when the conditions for granting interlocutory revision are fulfilled (see XI, 7). It can, however, only decide to allow re-establishment if it can do so within the three-month time limit of Art. 109(2) and the conditions for re-establishment (see VIII, 2.2.1 to 2.2.5) are fulfilled. In all other cases, the appeal, together with the application for the re-establishment of rights, must be submitted to the competent Board of Appeal.

**3. Accelerated prosecution of European patent applications**

Applicants requiring a more rapid search or examination can request accelerated prosecution of their applications (see Notice of the President of the EPO, OJ 7/1997, 340).

**CHAPTER IX**

## APPLICATIONS UNDER THE PATENT COOPERATION TREATY

**1. General remarks**

Art. 153  
Art. 156  
Art. 150(3)  
Art. 153(1)

The EPO may be a "designated Office" and an "elected Office" for an international application made under the Patent Cooperation Treaty (PCT). That application is thereby deemed to be a European application (Euro-PCT application) for the purposes of the Convention; the third digit of the application number assigned is a "9". However, in the case of Euro-PCT applications the provisions of the PCT apply in addition to those of the Convention, and where there is conflict between them, e.g. in the case of certain time limits, the provisions of the PCT prevail. The EPO acts as a designated Office for Contracting States to the European Patent Convention in respect of which the PCT has entered into force and which are designated in the international application when the provisions of Art. 153(1), apply. The EPO is an elected Office when the conditions referred to in Art. 156 apply (for details see IX, 6.1).

Art. 151  
Art. 154  
Art. 155

In addition to being a designated Office, the EPO may act as a receiving Office and also as an International Searching Authority under the PCT within the terms set out in Art. 151 and 154 of the Convention. Furthermore the EPO may act as an International Preliminary Examining Authority under the terms of Art. 155. There are thus the following possibilities for a European application made under the provisions of the PCT:

(i) the filing of the application and the international search take place at an office or offices other than the EPO (e.g. the Japanese Patent Office). The EPO acts as a designated Office.

(ii) the application is filed at another office (e.g. the United Kingdom Patent Office) but the EPO performs the international search. The EPO acts as international Searching Authority and as a designated Office.

(iii) the application is filed at the EPO which also performs the international search. The EPO acts as receiving Office, International Searching Authority and designated Office.

(iv) in addition to the cases mentioned under (i)-(iii) the applicant makes a demand for international preliminary examination and elects the EPO from among the designated Offices. The EPO is the "elected Office".

(v) the EPO is the International Preliminary Examining Authority. It may carry out this function without being the receiving Office, the International Searching Authority, a designated Office or an elected Office.

In the first case the European application will be accompanied by an international search report drawn up by another office. In the second and third case the international search report will be prepared by the Search Division of the EPO. In the fourth case the international search report and the international preliminary examination report may be drawn up by the EPO or by another International Searching Authority and International Preliminary Examining Authority.

## 2. The EPO as a receiving Office

The EPO may act as a receiving Office when the conditions referred to in Art. 151 apply.

Rule 104(1)(2)

Where the EPO acts as a receiving Office, the provisions of Rule 104 (1) and (2) will apply for the international application and its related documents. The following documents must be filed in triplicate with the EPO acting as receiving Office (Rule 104(1)): the request, the description, the claims, the abstract, the drawings. Under current practice, the other documents referred to in Rule 3.3(a)(ii) PCT, and listed on the right-hand side of Box VIII of the PCT request form (PCT/RO/101) need only be filed singly with the EPO. The President of the EPO may, however, decide that the international application and any related item be filed in fewer than three copies.

Rule 104(3)

If an international application is filed with an authority of a Contracting State for transmittal to the EPO as the receiving Office, the Contracting State must ensure that the application reaches the EPO not later than two weeks before the end of the thirteenth month after filing or, if priority is claimed, after the date of priority.

The initial processing and formal examination of international applications are carried out by the receiving Office and the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with the provisions of the PCT. When the EPO is acting as a receiving Office, EPO employees will not work to these Guidelines but to the PCT Guidelines.

## 3. The EPO as an International Searching Authority

3.1 If the EPO acts as an International Searching Authority under the terms of Art. 154, it establishes the international search report in accordance with the PCT Search Guidelines (see PCT-Gazette S-06/1998 of 8 October 1998) and

transmits it to the International Bureau (see Art. 16(1) and 18 of the PCT).

A copy of the international search report is also sent to the applicant who may, as a result, file with the International Bureau amended claims, and may also file a brief statement explaining the amendments and indicating their likely effect on the description and drawings (see IX, 4.7).

### 3.2 Review of the objection to lack of unity under Rule 40.2 (c)-(e) PCT

The allegation of lack of unity can be contested by the applicant by paying the additional search fees under protest. A review panel will review the justification of the invitation to pay additional fees. If the review panel considers the protest entirely justified, the additional search fees are refunded and the search is carried out on all inventions.

If the review panel considers the protest unjustified, it informs the applicant of its reasons and invites him to pay a protest fee within a time limit of one month if the question of unity is to be referred to the Board of Appeal.

If the review panel considers the protest justified only in part, the corresponding search fees are refunded, the applicant is informed of the reasons and is invited to pay a protest fee (see above) if he wishes the question referred to the Board of Appeal, to the extent it was not allowed.

If the protest fee is not paid in due time, the protest is considered withdrawn. If the protest fee is paid in due time, the Board of Appeal will examine the question and may find that:

- the protest was entirely justified, in which case the additional search fees and the protest fee are refunded,
- the protest was justified only in part, in which case the corresponding search fees are refunded,
- the protest was unjustified, (see Decision of the President of the EPO, OJ 9/1992, 547).

## 4. The EPO as a designated Office

4.1 With regard to deadlines and procedural steps before the EPO as a designated Office, see Information for PCT applicants in Supplement No. 1 to OJ 12/1992 and OJ 1-2/1994, 131. For applications concerning nucleotide and amino acid sequences, see A-VII, 4.2 and Supplement No. 2 to OJ 11/1998.



#### 4.2 Communication to the EPO as a designated Office

A copy of the application together with the international search report or a declaration in accordance with Art. 17(2)(a) of the PCT is communicated, by the International Bureau in accordance with Art. 20(1)(a) of the PCT to the EPO as a designated Office. Furthermore, the EPO does not require the furnishing by the applicant of a copy of the international application (Rule 49.1 a bis) PCT). The designated Offices then deal with it in accordance with their respective patent laws (e.g. the EPO will examine the application for compliance with the requirements of the Convention, see particularly A-VII).

#### 4.3 Publication of the translation of the international application

Art. 158(1)  
Art. 158(2)

Publication of the application by the International Bureau takes the place of publication by the EPO, with the proviso that, if the language of the application is not one of the official languages of the EPO, then within 21 months of the priority date, the EPO must, according to PCT Art. 22(1) and Rule 104b(1)(a) EPC, be supplied by the applicant with a translation in one of those languages, which it must publish. Even if the International Searching Authority has made a declaration that no international search report will be established, the applicant must provide the EPO with a translation within 21 months from the priority date. If the translated application, together with the appropriate fee, is not supplied, the application is to be deemed withdrawn (Art. 24(1) PCT). Also, in this case, the application which has been published under the PCT is not considered as comprised in the state of the art in accordance with Art. 54(3) (see C-IV, 6).

#### 4.4 Supplementary European search report

Art. 157(2)(b)  
Art. 157(2)(a)

When the application, in one of the official languages of the EPO, and the international search report have been communicated to the EPO, and the fees have been paid, the Search Division will prepare a supplementary search report, except where the Administrative Council has decided otherwise. Hence the application will reach the Examining Division containing either one or two search reports, which must be taken into consideration during the examination.

#### 4.5 Delaying of the procedure before the EPO

When acting as a designated Office, the EPO must not process or examine an international application prior to the expiry of the period applicable under PCT Art. 22 (PCT Art. 23(1)). However, the EPO may, on the express request of the applicant, process or examine an international application at any time (PCT Art. 23(2)).

#### 4.6 Review by the EPO as a designated Office

Art. 153(2)

The EPO may decide, in accordance with PCT Art. 25, to allow an international application deemed to be withdrawn, or not accorded a filing date, to proceed as a European application. The Examining Division is competent to take decisions in relation to these applications and the Receiving Section transfers copies of any documents received from the International Bureau under the circumstances of PCT Art. 25 (1)(a) to the Examining Division. Where it is decided that the application can proceed as a European application then the examination is carried out as for other applications although the application may be accorded the date it was originally filed with the PCT receiving Office and may claim the priority date, if any, of the international application.

#### 4.7 Examination and processing

If amended claims were filed (see IX, 3.1) on an international application before its transmission to the EPO these should be considered together with any accompanying explanatory statement, in the same way as for other amendments filed prior to the examiner's first communication with the applicant (see C-VI, 3).

In all other respects the substantive examination should be carried out as for any other European application.

#### 4.8 Inspection of files

The EPO as designated Office allows inspection of files relating to international applications after international publication by the International Bureau, even if these have not entered into the regional phase before the EPO, see IX, 4.1. The same applies *mutatis mutandis* to the communication of information from the files.

### **5. The EPO as an International Preliminary Examining Authority**

Art. 155(1)(2)

5.1 The EPO may act as an International Preliminary Examining Authority under the terms of Art. 155.

When the EPO acts as an International Preliminary Examining Authority, the provisions of the PCT Guidelines for International Preliminary Examination (see PCT-Gazette S-07/1998 of 29 October 1998) will apply for the examination procedure. The international preliminary examination is carried out by a single examiner.

The international preliminary examination has for its objective according to Art. 33(1) PCT to formulate a preliminary and non-binding opinion on the questions whether the claimed invention appears to be novel, to

involve an inventive step, and to be industrially applicable. With respect to these three criteria substantially the same requirements apply as according to the European Patent Convention (compare Art. 33(2), (3) and (4) PCT with Art. 54(1), 56 and 57 EPC).

Essential differences exist, however, between the procedures of the international preliminary examination and the examination of European patent applications:

- (i) The international preliminary examination does not lead up to the grant of a patent or refusal of the application.
- (ii) For the international preliminary examination the time limits set in Rule 69 PCT are to be met.
- (iii) The procedure followed in cases of lack of unity of invention.

In nearly all cases the examiner will issue a first written opinion according to Rule 66.2 PCT, to which the applicant may submit a formal response (Rule 66.3 PCT) directly to the International Preliminary Examining Authority. Also informal communications with the applicant (telephone call or personal interview) are possible according to Rule 66.6 PCT. In any case the international preliminary examination report (Art. 35 PCT) will be established within the prescribed time limit and in the form prescribed in Rule 70 PCT. One copy each of the international preliminary examination report and its annexes, if any, will be transmitted, on the same day, to the International Bureau and to the applicant (Rule 71.1 PCT).

#### 5.2 Review of the objection to lack of unity under Rule 68.3 (c)-(e) PCT

The allegation of lack of unity can be contested by the applicant by paying the additional examination fees under protest. A review panel will review the justification of the invitation to pay additional fees. If the review panel considers the protest entirely justified, the additional examination fees are refunded and the examination is carried out on all inventions.

If the review panel considers the protest unjustified, it informs the applicant of its reasons and invites him to pay a protest fee within a time limit of one month if the question of unity is to be referred to the Board of Appeal.

If the review panel considers the protest justified only in part, the corresponding examination fees are refunded, the applicant is informed of the reasons and is invited to pay a protest fee (see above) if he wishes the question re-

ferred to the Board of Appeal, to the extent it was not allowed.

If the protest fee is not paid in due time, the protest is considered withdrawn. If the protest fee is paid in due time, the Board of Appeal will examine the question and may find that:

- the protest was entirely justified, in which case the additional examination fees and the protest fee are refunded,
- the protest was justified only in part, in which case the corresponding examination fees are refunded,
- the protest was unjustified, (see Decision of the President of the EPO, OJ 9/1992, 547).

Where additional search fees have been paid under protest (see IX, 3.2) in response to an invitation of the EPO as International Searching Authority, the question will usually have been treated by the review panel. If after review a protest fee has been paid and the matter has already been treated by the Board of Appeal and the Board has decided on the substantive issue, the substantive examiner should generally follow the Decision of the Board of Appeal, insofar the facts are the same. If the Decision of the Board of Appeal is not yet available or only relates to formal issues, the examiner should generally follow the opinion of the review panel (when the facts are still the same) and ask, when applicable, for additional examination fees. A refund of these can be given, when the review panel in examination considers the protest (partly) justified (see above). If in the meantime the Decision of the Board of Appeal becomes available and is in favour of the applicant on the substantive issue, the review panel should take this into consideration.

### 5.3 Documents forming the basis for the International Preliminary Examination Report (IPER)

Comparative tests not forming part of the international application as filed, but having been submitted as further evidence in the course of the International Preliminary Examination, are considered confidential information and are therefore not published. These tests should neither be annexed to nor, except with the prior consent of the applicant, extensively referred to in the IPER. The examiner should make a clear reference in the IPER to the fact that comparative test results had been submitted during the International Preliminary Examination, without giving details of those results, to put the elected Offices on notice with respect to those results.

## 6. The EPO as an elected Office

6.1 With regard to deadlines and procedural steps before the EPO as an elected Office, see Information for PCT applicants in Supplement No. 1 to OJ 12/1992 and OJ 1-2/1994, 133. For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Supplement No. 2 to OJ 11/1998.

### 6.1a General remarks

Art. 156

The EPO will act as an elected Office if the applicant has made a demand for international preliminary examination and has elected at least one Contracting State of the European Patent Convention which is designated in the international application, bound by Chapter II PCT and for which a European patent is sought. An international preliminary examination report will be drawn up on the basis of the demand by an International Preliminary Examining Authority (e.g. the EPO in accordance with IX, 5). Election of the EPO means that the applicant intends to use the results of the international preliminary examination report in proceedings before the EPO (see Art. 31(4)(a) PCT).

### 6.2 Opening of the regional phase and of substantive examination

The EPO will be notified of its election by the International Bureau (WIPO) (Art. 31(7), Rule 61.2(a) PCT). If such a notification is in the file and an EPC Contracting State has been elected before expiry of the 19th month from the earliest priority date, the European substantive examination must not normally begin before expiry of the 31st month from the earliest priority date (Art. 40(1) PCT). The only circumstance in which examination may begin earlier is if the applicant has expressly so requested (Art. 40(2) PCT).

### 6.3 The international preliminary examination report (IPER)

The international preliminary examination report constitutes a preliminary, non-binding opinion on whether the claimed invention appears to be novel, to involve an inventive step and to be industrially applicable (Art. 33(1) PCT). The opinion is formulated on the basis of the documents referred to in the report. These documents may be the following, in particular:

- (i) the text of the application as filed with the receiving Office or, if appropriate, the published translation thereof (Art. 21 PCT);
- (ii) the text of the application as filed with the receiving Office, taking into consideration any amendments made

pursuant to Art. 19 PCT to the claims or, if appropriate, the published translation thereof (Art. 21 PCT);

(iii) the text of the application referred to in (i) or (ii), taking into consideration the documents (description, claims and drawings; see Art. 34(2)(b) and (3)(b) and Rules 66 and 68.2 PCT) attached in annex to the international preliminary examination report.

#### 6.4 Substantive examination of a Euro-PCT application accompanied by an international preliminary examination report (IPER)

The substantive examination is conducted in the same way as with European applications for which the EPO is a designated Office (see IX, 4). Where the EPO was the International Preliminary Examining Authority, the international preliminary examination will normally have been carried out by the examiner responsible for examining the related Euro-PCT application.

Art. 14(1)

The application to be examined will be accompanied by an international preliminary examination report drawn up in one of the official languages of the EPO. New documents in the original language may be attached in annex to the report (Art. 36(3)(a) PCT and Rule 70.16). The application will also be accompanied by a translation of the annexes, transmitted by the applicant, in the same language into which the international preliminary examination report was translated (Art. 36(3)(b) PCT).

The examination must be conducted in accordance with Art. 41 and 42 PCT, which stipulate that:

(i) the applicant must be given the opportunity to amend the claims, the description, and the drawings within a time limit prescribed pursuant to Rule 78.1(b) or 78.2 PCT, and

(ii) the EPO cannot require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same application in any other elected Office.

##### 6.4.1 Comparative test results

Where the EPO has established the IPER and therein refers to the submission of test reports (see IX, 5.4), the applicant is taken to agree to the use of these reports as the basis of proceedings before the EPO when he uses the standard form for entry into the regional phase before the EPO as elected Office. If the latter is not used or the IPER -referring to the test reports - was established by another International Preliminary Examination Authority,

the applicant is invited to submit these reports for the European application.

#### 6.4.2 Documents forming the basis for substantive examination

Normally, the documents which are indicated in the international preliminary examination report as forming the basis for that report will also form the basis for the substantive examination in the EPO as an elected Office in the regional phase. New documents (claims, description, drawings) submitted during the international preliminary examination and replacing the earlier filed documents will be attached to the international preliminary examination report. If the documents attached to the international preliminary examination report are in a language other than the language of the proceedings of the European application in the regional phase, the applicant must be requested to file the documents in the language of the proceedings within a fixed period.

The applicant may also request that the examination be based on the documents in the international application as published or on amendments made on entry into the regional phase. If the declarations of the applicant are unclear in this respect, the examiner will have to clarify the situation.

#### 6.4.3 Consideration of the contents of the international preliminary examination report during substantive examination

If the international preliminary examination report has been drawn up by the EPO, that report is to be regarded as an opinion for purposes of examination and generally the first communication will only refer to the opinion expressed in the IPER. Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence (e.g. if further documents have been cited, as might happen in a supplementary European search report, or if evidence is produced of unexpected effects) or where the substantive patentability requirements under the PCT and EPC are different.

Examination reports drawn up by other International Preliminary Examining Authorities must be examined carefully. If the reasons put forward in the international preliminary examination report are sound, they must not be disregarded.

#### 6.5 Inspection of files

##### Rule 94.2 PCT

Files held by the EPO in its capacity as International Preliminary Examination Authority are accessible to the applicant or any person authorised by him and, once the

international preliminary examination report has been drawn up, to the elected offices.

Rule 94.3 PCT

In its capacity as elected office the EPO also allows access to its files pertaining to the international phase of applications filed on or after 1 July 1998, provided that international publication has taken place and that at least one of the acts listed in Rule 104b(1) EPC for entry into the regional phase has been performed. The above applies *mutatis mutandis* to the communication of information from the files.



**CHAPTER X**

## DECISIONS

**1. Basis of decisions**

## 1.1 General remarks

Art. 113(1)

"The decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments."

This provision is intended to ensure that no party can be taken by surprise by grounds for a decision against his application on which he did not have an opportunity to present his comments.

In the substantive examination the applicant must have an opportunity of presenting his comments on all the grounds invoked against his application.

In opposition proceedings, if the patent is to be revoked it should be ensured that especially the proprietor of the patent was given sufficient opportunity to defend himself and similarly, if the oppositions are to be rejected or if, despite the claims of the opponents, the patent is to be maintained in amended form, especially the opponents should be given the same opportunity.

## 1.2 Examples

If the facts and grounds essential to a decision have been submitted by one party and if the party whose case is to be rejected has been afforded sufficient time to comment, the principle concerning the right to a hearing set out in Art. 113(1), will have been respected. If the decision in opposition proceedings is to be based on grounds which were raised in the examination proceedings, but not in the notice of opposition, the observations by the parties or the communications of the Opposition Division, these must be introduced (i.e. raised for discussion) by the Opposition Division in the opposition proceedings before the decision is given so as to afford the parties an opportunity to comment. If the opposition is based on lack of inventive step, the proprietor of the patent must expect that the state of the art newly designated in the opposition proceedings will be considered in conjunction with the state of the art described in the introductory part of an independent claim. However, if new facts and grounds are introduced during the proceedings or if the facts and grounds on which the envisaged decision is to be based were not stated so unambiguously and clearly in the written submissions of the parties as to give a party occasion to comment, the party concerned must be given an opportunity to submit an

opinion and to produce evidence before the decision is given.

## 2. Consideration of time limits

A decision may not be given until any time limit set has expired unless all the parties affected by the time limit expressly agree that it need no longer be observed or have submitted their final opinions before it expires.

Moreover, as a rule, decisions should not be given until an internal EPO time limit (e.g. 20 days) following upon the official time limit (but from which the parties may derive no rights) has expired so as to ensure that documents received at the end of the period officially allowed have actually been entered in the files when the decision is being taken and can be taken into account in the decision.

With reference to submissions and applications received after expiry of a time limit see VIII, 1.8.

Art 113(2)

## 3. Decisive text of documents

"The EPO shall decide upon the European patent application or the European patent only in the text submitted" and "agreed by the applicant for or proprietor of the patent" and last used as a basis for the proceedings. Consequently, for example, an amended version proposed by the Examining or Opposition Division (see C-VI, 15.1 and D-VI, 4.2 and 7.2) may only be adopted as a basis for the decision if it has been approved by the applicant for or the proprietor of the patent.

In the case of one or more subsidiary request(s) (sometimes referred to as "auxiliary requests") directed to alternative texts for grant or maintenance of a patent, every such request qualifies as a text submitted or agreed by the applicant for or proprietor of the patent within the meaning of Art. 113(2) (see T 234/86, not published in OJ), and therefore must be dealt with in the order indicated or agreed to by the applicant or proprietor, up to and including the highest-ranking allowable request, if any.

Rule 68(1)

## 4. Written form of decisions

### 4.1 General remarks

Decisions are to be produced in writing. The same applies in the case of decisions delivered at the end of oral proceedings (see III, 9).

No complete rules can be laid down about the form and content of decisions, which will depend on the requirements of each particular case.

The written decision will contain:

- the names of the parties to the proceedings (applicant, patent proprietor, opponents) and, if applicable, their representatives,
  - the tenor, and, if necessary,
  - the facts and the submissions,
  - the reasoning and
  - the communication of the possibility of appeal (Rule 68(2)),
- Rule 70(1)
- the signature(s) and the name(s) of the employee(s) responsible.

If the decision is produced by the employee responsible using a computer, the seal of the EPO may replace the signature. If it is produced automatically by a computer the employee's name may also be dispensed with (Rule 70(2)). The file copy contains the names and the actual signature(s) of the employee(s) responsible.

The presentation of the facts and the submissions, the reasoning and the communication of the means of redress are generally omitted when a decision merely meets the requests of all the parties concerned; this applies in particular to the decision on the grant which is based on the documents which the applicant has approved (Art. 97(2) (a)). The same applies when the patent is maintained in an amended form because this is preceded by a final interlocutory decision pursuant to Art. 106(3) concerning the documents on which the maintenance of the patent is to be based (see D-VI, 7.2.2). In individual cases consideration may also be given to the reasoning of those decisions which merely meet the requests of the parties. If, for example, a number of reasons are invoked for a request for re-establishment, of which only one justifies the re-establishment, a reasoned decision on re-establishment may be appropriate, in order to clarify the official action.

Even in those cases in which the decision contains no communication of the means of redress, an appeal can be filed if the decision is incorrect, e.g. if the grant was not made on the basis of the documents which the applicant had approved.

4.2 The tenor may be, for example, as follows:

"The European patent application ... is hereby refused according to Art. 97(1) EPC.

"The opposition to the European patent ... is hereby rejected."

"The request for restitutio in integrum is hereby rejected."

#### 4.3 Facts and submissions

Facts and submissions have to be given insofar as they are significant for the decision.

Under facts a brief description of the case and a summary of the main reasons on which the decision is based and of the most important replies of the parties should be given. These points, however, are to be covered in detail in the subsequent reasoning. Facts and submissions which are irrelevant to the decision, e.g. requests for amendment which are not maintained, are to be omitted.

The facts and submissions must make clear what is the subject of the application and show on which documents (particularly on which claims) the decision is based. The text of the independent claim(s) and other especially important claims or passages of the description on which the decision is based, must be cited verbatim in the language of the proceedings (Rule 1(2)). As regards the dependent claims, it may be sufficient to refer to the file content.

#### 4.4 Decision on the file as it stands

Applicants may request a decision "on the file as it stands", e.g. when all arguments have been sufficiently put forward in the proceedings and the applicant is interested in a speedy appealable decision. In such a case the decision will be of a standard form, simply referring to the previous communication(s) for its grounds and to the request of the applicant for such a decision.

Art. 113(1)  
Rule 68(2)

### 5. Reasoning of decisions

The reasoning must contain, in logical sequence, those arguments which justify the tenor. It should be complete and independently comprehensible, i.e. generally without references. If, however, a question has already been raised in detail in a particular communication contained in the file, the reasoning of the decision may be summarised accordingly and reference may be made to the relevant communication for the details.

The conclusions drawn from the facts and evidence, e.g. publications, must be made clear. The parts of a publication which are important for the decision must be cited in such a way that those conclusions can be checked without difficulty. It is not sufficient, for example, merely to assert that the cited publications show that the subject of a claim

is known or obvious, or, conversely, do not cast doubt on its patentability; instead, reference should be made to each particular passage in the publications to show why this is the case.

It is particularly important that special attention should be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked. Documents which cover the same facts or arguments may be treated in summary form, in order to avoid unnecessarily long reasonings.

The need for complete and detailed reasoning is especially great when dealing with contentious points which are important for the decision; on the other hand, no unnecessary details or additional reasons should be given which are intended to provide further proof of what already has been proven.

If during **examination proceedings** a main and subsidiary requests have been filed (see X, 3) and none of these is allowable, the reasons for the decision to refuse the application pursuant to Art. 97(1) must not be limited to the main request, but must also comprise the reasons for the non-allowability of each subsidiary request. If one of the requests is allowable the communication pursuant to Rule 51(4) is to be issued on the basis of the (first) allowable request and must be accompanied by an explanation of the reasons why the higher-ranking requests are not allowable. Should the applicant, in response to the communication pursuant to Rule 51(4), maintain higher-ranking requests which are not allowable, a decision to refuse the application pursuant to Art. 97(1) will be issued; the reasons must set out the grounds for the non-allowability of each request which ranks higher than the allowable request. In respect of the allowable request the decision to refuse must mention that the applicant has failed to give his approval to it (Rule 51(5)). these matters are also dealt with in Legal Advice no. 15/98 rev, OJ 3/1998, 113.

Similarly, if in **opposition proceedings** the proprietor has submitted in addition to his main request one or more subsidiary requests, none of which is allowable, the patent must be revoked and the decision must set out, in respect of each request submitted and maintained by the proprietor, the reasons for not allowing it. Where one of the proprietor's requests directed to the maintenance of the patent in amended form is allowable, an interlocutory decision is to be issued on the basis of the (first) allowable request; it has to set out the reasons why this request meets the requirements of the Convention and, additionally, the reasons why the higher-ranking requests do not.

In so far as a decision includes the rejection of any of the

multiple requests, such decision may not be taken until the applicant or proprietor has been informed, with respect to each of these requests, of the reasons for not allowing them, so that the applicant or proprietor is not deprived of the opportunity to present comments (Art. 113(1)-right to be heard). Similarly, an opportunity to comment must be granted to the opponent(s) with respect to a subsidiary request before it is held allowable by an interlocutory decision (see D-VI, 7.2).

Practical considerations will determine at which point in the decision the subsidiary request is dealt with. The main emphasis should be laid on dealing with the independent claims, whereas the reasoning as regards dependent claims does not need to be so detailed, unless special importance is attached to them in any particular case.

There is no strict rule that a decision has to deal with all the points which are or may become contentious between the deciding authority and the parties concerned. For reasons of economy it is, however, appropriate to base a rejection, in order to come as early as possible to a final decision in a case, on a number of separate reasons. Therefore an Examining or Opposition Division should deal with those questions which may be expected to become relevant in second instance insofar as this is possible without substantial additional effort, so that, in the event of a successful appeal, the matter does not have to be remitted to the deciding authority by the Board of Appeal.

#### **6. Decisions which do not terminate proceedings**

Art. 106(3)

Such decisions (interlocutory decisions) may be given in principle. However, it should be borne in mind that pursuant to Art. 106(3), "a decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal".

The competent department should use its discretion as to the need for an interlocutory decision (see, however, D-VI, 7.2.2 with respect to the interlocutory decision for maintenance of a patent in amended form in opposition proceedings). To avoid fragmentation of the proceedings, such decisions should be the exception rather than the rule and should be given only if the duration or cost of the proceedings as a whole is thereby reduced. The interests of the parties should also be borne in mind as appropriate. In the normal course, an interlocutory decision should be contemplated only for the purpose of ruling that separate appeal may be made, as only in this way can a decision be obtained on a preliminary point before the final decision terminating the proceedings is reached. (The proceedings must be suspended until the decision has become final.)

It is especially important to allow separate appeal where the continuation of the proceedings depends on a preliminary ruling on a fundamental point of law, e.g. where different Boards of Appeal have given different rulings or conflicting decisions have been given by different Examining or Opposition Divisions and no decision on appeal has been given in the matter. Interlocutory decisions must state the reasons on which they are taken; if it is decided not to allow separate appeal, the reasons for this ruling may be given only in the final decision.

Art. 111(2)

**7. Binding nature of decisions on appeals relating to the same case**

If a department has to give a decision in a case which has already been remitted by the Board of Appeal for further prosecution to that department it "shall be bound by the ratio decidendi of the Board of Appeal, in so far as the facts," e.g. the subject-matter of the patent and the relevant state of the art, "are the same".

An Opposition Division is not bound by a decision of a Board of Appeal on appeal against a decision from an Examining Division (see T 167/93, OJ 6/1997, 229). The exclusive phrasing of the last sentence of Art. 111(2), only mentioning the Examining Division being bound by the decision on appeal against a decision of the Receiving Section, makes this clear. Opposition proceedings are entirely separate from the examination proceedings and the Opposition Division is entitled to examine the facts, evidence and arguments anew, particularly since another party (the opponent) is now involved. It should, however, take due notice of the assessment of these facts, evidence and arguments as contained in the reasons of the decision of the Board of Appeal.

Rule 68(2)

**8. Information as to means of redress**

"Decisions of the EPO which are open to appeal shall be accompanied by a written communication of the possibility of appeal. The communication shall also draw the attention of the parties to the provisions laid down in Art. 106 to 108, the text of which shall be attached. The parties may not invoke the omission of the communication."

Art. 119

**9. Notification**

Decisions must be notified as a matter of course (see I, 2).

**10. Correction of errors in decisions**

Correction of errors in decisions must be clearly distinguished from correction of errors in documents filed by the applicant (or patentee), pursuant to Rule 88. For the latter, see A-III, 6.5 and C-VI, 5.9. Correction of errors made by

the applicant (or patentee) in application (or patent-) documents cannot be arrived at in a roundabout manner through correction of the decision to grant (or maintain in amended form).

## Rule 89

Correction of a decision is admissible only if the text of the decision is manifestly other than intended by the department concerned. Thus only "linguistic errors, errors of transcription and obvious mistakes" in decisions can be corrected.

The documents approved by the applicant for grant or approved by the patentee for maintenance in amended form are part of the decision to grant (see T 850/95, OJ 4/1997, 152) or to maintain in amended form, respectively. If a decision relates to wrong or incomplete documents, e.g. in the case of omission from a granted patent of claims, description parts or drawings which had already been filed as replacement and whose admissibility was never at issue during earlier proceedings, a correction of the text of the description or claims or of the drawings should be allowed.

However, this does not relieve the applicant or patentee from the duty to properly check the documents as proposed for grant or for maintenance in amended form, respectively.

Corrections of decisions are to be made by a decision at the reasoned request of one of the parties or by the EPO of its own motion. If the request for correction is refused, this decision must be reasoned (see T 850/95, OJ 4/1997, 152). These reasons must previously have been communicated to the requester (Art. 113(1)).



**CHAPTER XI**

## APPEALS

**1. Suspensive effect**

Art. 23(3)  
Art. 109

The Boards of Appeal are not bound by any instructions. Therefore this chapter deals in detail only with those questions which are relevant for interlocutory revision. In this stage of proceedings the department of first instance is still competent.

Art. 106(1)

"An appeal shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division."

The appeal "shall have suspensive effect". This means that decisions may not yet become final and their effects are suspended. As the decision may not then be enforced, the following do not take place: entry in the Register of European Patents, mention in the European Patent Bulletin and, where appropriate, publication of a new specification of the European patent.

Art. 106(2)

**2. Appeals after surrender or lapse of the patent**

"An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States."

Art. 106(4)

**3. Appeals against the apportionment of costs**

"The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal." A party to the proceedings who feels that he has been adversely affected by the apportionment of costs may therefore only file an appeal against the decision on costs if he also lodges an appeal against the decision on the opposition on other admissible grounds.

Art. 106(5)

**4. Appeals against the decision of the Opposition Division on the fixing of costs**

Art. 11 RFees

In accordance with Art. 106(5) the decision of the Opposition Division fixing the amount of costs of opposition proceedings may be appealed if the amount is in excess of the fee for appeal.

Art. 107

**5. Persons entitled to appeal and to be parties to appeal proceedings**

"Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings shall be parties to the appeal proceedings as of right."

Art. 108

**6. Time limit and form of appeal**

"Notice of appeal must be filed in writing at the EPO within two months of the date of notification of the decision appealed from. The notice shall not be deemed to have been filed until after the fee for appeal has been paid" to the amount laid down in the Rules relating to Fees under the European Patent Convention. "Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed."

Art. 109

**7. Interlocutory revision**

"If the department whose decision is contested considers the appeal to be admissible and well founded, it shall rectify its decision. This shall not apply where the appellant is opposed by another party to the proceedings."

The obligation or possibility of rectification will thus arise in connection with a decision by the Receiving Section, Legal Division or an Examining Division. In opposition proceedings, it only arises in the special case that all the notices of opposition have been withdrawn and the proprietor of the patent files an appeal.

The department concerned will rectify its decision if convinced in the light of the grounds of appeal that the appeal is admissible and well founded.

This could arise, for example, because:

- (i) the department failed to take duly into account some of the material available to it at the time the decision was made; or
- (ii) the department did not receive material filed in the Office in due time before the issue of the decision, owing to an Office error.

Interlocutory revision also arises where the decision of the department concerned does not appear to be incorrect, but the applicant presents new information or evidence or files amendments to the application, which overcome the objections of the decision under appeal (see T 139/87, OJ 3/1990, 68). In the case of newly submitted amendments which meet the substantive objections dealt with in the decision under appeal, the decision must be rectified. This could be the case, for example, if the amendments were ones which were actually suggested by the Examining Division in the course of the proceedings, but which the applicant was previously unwilling to make. If the amendments meet the objections contained in the decision under appeal, but raise new ones not yet discussed, interlocutory revision must also be allowed as the applicant has the right to two instances (see T 219/93, not published in OJ).

For the advantages of the decision covering more than one objection, see X, 5, last paragraph.

Rule 67

**8. Reimbursement of appeal fees**

In the event of interlocutory revision, the reimbursement of appeal fees will be ordered by the department whose decision has been impugned, "if such reimbursement is equitable by reason of a substantial procedural violation". This is particularly the case when in arriving at a decision essential facts or evidence were not taken into consideration e.g. where a document filed at the EPO in good time by the party concerned is not placed in the file before a decision is reached or where the decision is based on facts or evidence on which the party concerned had no opportunity of presenting his comments.

If the decision is rectified by an interlocutory revision not because of any substantial procedural violation but e.g. because the party concerned submits amendments at the time of filing the appeal, there will be no reimbursement of appeal fees.

Art. 109(2)

**9. Remittal to the Board of Appeal**

"If the appeal is not allowed within three months after receipt of the statement of grounds, it shall be remitted to the competent Board of Appeal without delay, and without comment as to its merit."

Three months are available for the rectification of the decision by the department of the first instance. Furthermore, when the appeal is not allowed by this department, it is to be remitted without comment to the competent Board of Appeal. It is therefore necessary that the department of the first instance consider the appeal with the highest priority and start immediately the examination on admissibility and in case the appeal is considered admissible in the form in which it has been filed the competent department will start its examination on allowability immediately. It will only rectify its decision if this is possible without further contacts with the party involved.

In all other cases the appeal will be remitted to the competent Board of Appeal.

**10. Rules of Procedure for the departments of the second instance**

Details of the proceedings before the Boards of Appeal will be found in the Rules of Procedure of the Boards of Appeal (OJ 1/1983, 7 as amended 10 October 1988, OJ 9/1989, 361; see also Guidance for appellants and their representatives, OJ 6/1981, 176). The Enlarged Board of Appeal has also adopted Rules of Procedure

(OJ 1/1983, 3 as amended in OJ 9/1989, 362 and in OJ 7/1994, 443).

**CHAPTER XII****THE REQUEST FROM A NATIONAL COURT FOR A TECHNICAL OPINION CONCERNING A EUROPEAN PATENT****1. General**

Art. 25

1.1 "At the request of the competent national court trying an infringement or revocation action, the EPO shall be obliged, against payment of an appropriate fee, to give a technical opinion concerning the European patent which is the subject of the action. The Examining Divisions shall be responsible for the issue of such opinions."

Only requests from a national court in a Contracting State will be accepted by the EPO. It is not however up to the EPO to check whether the requesting court is "competent" to deal with the action or not. The Examining Division, however, should check whether a European patent is the "subject of the action".

1.2 The Examining Division responsible for the technical opinion should give the parties an opportunity to submit arguments in writing if the court so permits. However, the parties have no right to be heard before the EPO. Nevertheless, where the Examining Division considers it necessary, it may invite the parties, via the court and provided that the court so permits, either to be heard before the Examining Division or to submit supplementary observations on specific points identified by the Examining Division. If the parties are heard, such a hearing is not considered to constitute oral proceedings within the meaning of Art. 116.

1.3 The technical opinion is not a "decision" of the EPO. The parties to the national proceedings therefore have no right of appeal before the EPO against an "unfavourable" opinion.

**2. Scope of the technical opinion**

2.1 The Examining Division is obliged to give a "technical opinion" upon request. This means that the Division is bound to give an opinion only insofar as the questions put are of a technical character. However, the Examining Division should not be too restrictive in this regard but should attempt to assist the national court as much as is reasonably possible, while remembering that the actual decision on infringement or revocation is exclusively a matter for the national court.

2.2 Generally speaking, the Examining Division should attempt to give a technical opinion on any question which is similar to those normally dealt with in European substan-

tive examination work, even when the question has a legal, as well as a technical, aspect. On the other hand, the Examining Division should decline to make any specific statement on whether a patent is valid or on whether it is infringed. It should also not give any opinion on the extent of protection (Art. 69 and the accompanying Protocol).

2.3 It is to be expected that a request from a national court will be clearly and precisely formulated, so that the Examining Division will be in no doubt as to the questions on which the court wishes to have an opinion. Since the court is responsible for deciding the issues of law involved in the questions and since most questions include a mixture of legal and technical aspects, the court is expected where possible to separate clearly the legal aspects from the technical aspects upon which it seeks the opinion of the EPO.

### **3. Composition and duties of the Examining Division**

3.1 The composition of the Examining Division to which the request is referred shall be as defined in Art. 18 (2). This means that the Division shall include three technical examiners; normally a legally qualified examiner shall also be included. The main responsibility for dealing with the request up to the time of formulating the opinion shall be entrusted to one technical examiner, hereinafter referred to as the "primary examiner".

3.2 In order to guarantee that the opinion given is not influenced by earlier proceedings within the EPO on the application/patent in question, examiners who have taken part in such earlier proceedings as members of an Examining or Opposition Division should be excluded from the Examining Division set up under Art. 25. Where this is not practicable, the national court and the parties should be informed of the proposed members of the Examining Division under Art. 25 and of which among these members participated in European examination or opposition proceedings on the case. The court should be asked to state whether, in the circumstances, the request for a technical opinion is maintained.

3.3 The primary examiner will act on behalf of the Examining Division and he will normally be responsible for issuing communications to the court. The primary examiner should also draft the written opinion and should circulate the draft to the other members of the Examining Division for consideration. If any changes are proposed in the draft and there are differences of view on such changes, the Chairman should arrange a meeting to resolve the matter. The final opinion should be signed by all members of the Division.

#### 4. Language to be used

4.1 In principle the language to be used should be the language of the proceedings of the European patent; however, if the court so requests, another official language of the EPO may be used. At least the request itself, any submissions from the parties, and any amendments to the patent should be in that language or translated into that language. The opinion should also be produced in that language. However, where appropriate, the Examining Division should pay regard to the provisions of Art. 70(2) to (4).

4.2 Regarding documents to be used as evidence, the provisions of Rule 1(3) shall apply (see A-VIII, 2.2).

4.3 The court or the parties shall be responsible for providing any translations which may be required to satisfy the above conditions.

#### 5. Procedure

It is envisaged that the procedure would normally involve the following stages.

##### 5.1 Formalities check

Art.2, No.20  
RFees

The formalities officer will check whether the fee has been paid and whether there are any obvious deficiencies as to the language requirements. If there are any deficiencies in these respects, the formalities officer will write to the national court informing it that no substantive work on the opinion will begin until the deficiencies have been remedied. However no time limit can be imposed on the court.

If the file indicates that the court permits the parties to submit written arguments to the EPO and such arguments are not already on the file, the formalities officer will write via the court to the parties giving them a time limit (say 2 months) for submitting such arguments.

##### 5.2 Preliminary examination

When the formal requirements have been met, and, where appropriate, the arguments of the parties are on file, the case will be referred to the Directorate responsible for the technical field to the patent in order that the Examining Division may be established. Assuming that an Examining Division consisting entirely of new members can be formed or, where this is not possible, that the court maintains its request for a technical opinion (see XII, 3.2), the primary examiner will make a preliminary examination to determine whether:

(i) The questions put by the national court are such as the Examining Division is competent to answer, at least in part.

(ii) The papers filed are sufficiently complete and the necessary translations have also been filed.

If there are any deficiencies in these respects, the primary examiner will write to the national court accordingly.

#### 5.3 Withdrawal of the request

#### Art. 10a RFees

If the request for a technical opinion is withdrawn before the Examining Division starts any substantive work on the opinion, 75% of the fee will be refunded.

#### 5.4 Establishment and issue of the technical opinion

After any deficiencies as referred to in 5.1 or 5.2 above have been met, the Examining Division should establish the technical opinion as soon as possible.

The opinion should be sent to the national court. Any papers received from the court which belong to the national proceedings should be sent back with the opinion.

#### 5.5 Appearance before the national court

If after the opinion is issued the national court asks the Examining Division to appear before it, the court should be informed that the Office is willing to send one member of the Division provided that his costs are paid and on the understanding that this member will be required only to answer questions on the technical opinion given, and will not be required to give an opinion on additional matters unless notice in writing of these additional matters is given to the Examining Division at least one month before the appearance before the court.



**CHAPTER XIII**

REGISTERING TRANSFERS, LICENCES, OTHER RIGHTS, ETC.

**1. Transfer of the European patent application**

Art. 71 A European patent application may be transferred for one or more of the designated contracting states.

Rule 20(1)(2) 1.1 Without prejudice to Art. 72, the transfer of a European patent application is recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the EPO that such transfer has taken place. The request is deemed not to have been filed until such time as the prescribed administrative fee has been paid.

1.2 Any kind of written evidence suitable to prove the transfer is admissible. A declaration signed by both parties is sufficient, but also a declaration of transfer signed by the assignor will do, as the assignee will anyway be notified by the EPO of the entry in the Register. Formal documentary proof (originals or certified copies) such as the instrument of transfer or official documents verifying the transfer or extracts thereof, are equally appropriate.

1.3 In case the evidence presented is found to be unsatisfactory, the EPO informs the party requesting the transfer accordingly, and invites it to remedy the stated deficiencies.

1.4 If the request complies with the requirements of Rule 20(1), the transfer is registered with the date on which the request, the required evidence or the fee has been received by the EPO, whichever is the latest.

Rule 20(3) 1.5 On the above date, the transfer becomes effective vis-à-vis the EPO, i.e. from that date the newly registered applicant is entitled to exercise the right to the European patent application in proceedings before the EPO (Art. 60(3)). In case the transfer was for certain designated states only, Art. 118 applies.

Art. 20 1.6 The competent department for adverse decisions regarding the entry of the person concerned in the Register of European Patents is the Legal Division.

**2. Transfer of the European patent**

Rule 61 The above applies mutatis mutandis to the registration of a transfer of the European patent during the opposition period or during opposition proceedings.

**3. Licences and other rights**

Art. 71  
Art. 73  
Rule 21  
Rule 22

3.1 A European patent application may give rise to rights in rem, may be licensed and may be the subject of legal means of execution. Rule 20(1) and (2) apply mutatis mutandis to the registration of the grant, establishment or transfer of such rights (see 1.1 to 1.4 and 1.6).

3.2 A licence shall be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require. A licence shall be recorded as a sub-licence where it is granted by a licensee whose licence is recorded in the Register of European Patents.

Rule 21(2)

3.3 Upon request and subject to the payment of the prescribed administrative fee, registered licences and other rights are cancelled on production of documents satisfying the EPO that the right has lapsed, or of a declaration of the proprietor of the right that he consents to the cancellation.

**4. Change of name**

Changes in the name of the applicant for or proprietor of a European patent shall be entered in the Register on production of supporting evidence (e.g. copy from the commercial register).