

## Notice from the European Patent Office dated 1 April 2010 concerning amendment of the Guidelines for Examination in the European Patent Office

1. By decision of the President of the EPO dated 19 November 2009, the Guidelines for Examination have been amended pursuant to Article 10(2) EPC. The amendments are being published in the form of a complete "April 2010" edition of the Guidelines. These have been revised following consultation with the Standing Advisory Committee before the EPO (SACEPO). The amended Guidelines will apply as from 1 April 2010.
2. The updated Guidelines for Examination are published in all three EPO languages on the EPO website ([www.epo.org/patents/law/legal-texts/guidelines.html](http://www.epo.org/patents/law/legal-texts/guidelines.html)) and are available for downloading free of charge. They will also be issued in paper form.
3. The English draft of these Guidelines was published on the EPO website in November 2009 in order to accommodate public interest in gaining the earliest possible access to information on the future amendments.
4. It should be noted that the "April 2010" edition of the Guidelines for Examination is the only valid official version, and supersedes the "April 2009" edition as from 1 April 2010.

### Amendments to the Guidelines for Examination in the European Patent Office

5. Since the last complete new edition in December 2007, the Guidelines have been updated in view of the fee changes (see notice dated 1 April 2009, OJ EPO 2009, 336). As part of this update, Parts A - D of the "April 2009" edition were published in electronic form. Part E was not affected by these amendments.
6. The current amendments bring the Guidelines for Examination into line with the new or amended Rules 36, 57, 62a, 63, 64, 69, 70a, 135, 137 and 161 EPC, which enter into force on 1 April 2010 (see Administrative Council decisions CA/D 2/09 and CA/D 3/09 of 25 March 2009 amending the Implementing Regulations to the EPC, OJ EPO 2009, 296, 299, and the notices from the Office dated 20 August 2009, OJ EPO 2009, 481, and 15 October 2009, OJ EPO 2009, 533).
7. It should be noted that the Guidelines have not been fully revised. In one instance, where the Guidelines are still to be revised, several passages do not completely reflect current examination practice. Furthermore, once the work as regards content had been concluded, recent publications or decisions that appeared subsequently could no longer be taken into account. Thus, the relevant notice dated 14 September 2009 (OJ EPO 2009, 486), applies, for example, with respect to the filing of a certified copy of an earlier application to which reference is made, notwithstanding the relevant sections A-II, 4.1.3.1 and A-IV, 1.3.1 of the Guidelines.
8. Amendments to the new or amended rules can be found, in particular, in the following passages:
  - (a) Rule 36 (Divisional applications): **A-III, 14; A-IV, 1 to 1.3.3; A-VIII, 1.3; C-III, 7.10, 7.11.1 and 7.11.4; C-VI, 1.1.4, 3.4, 5.2 and 9.1.3;**
  - (b) Rule 62a (Applications containing a plurality of independent claims): **B-III, 3.7, 3.10 and 3.11; B-IV, 2.1; B-VIII, 4 and 5; B-X, 3.1 and 8; B-XII, 7; C-III, 3.3; C-VI, 4.7, 5.2, 5.6 and 8.2;**
  - (c) Rule 63 (Incomplete search): **B-IV, 1.3; B-VIII, 3 and 5; C-II, 4.9; C-III, 4.1, 5 and 6.3; C-IV, 2.2 and 4.1; C-VI, 4.7, 5.2, 5.6 and 8.2;**

(d) Rule 64 (European search report where the invention lacks unity): **B-VII, 1.2;**

(e) Rule 69 (Information about publication): **A-VI, 2.1;**

(f) Rule 70a (Response to the extended European search report): **A-V, 2.1; A-VI, 2.1, 2.4, 2.5 and 3; B-XII, 1.2, 3.3, 3.9 and 9; C-III, 6.3, 7.10; C-IV, 2.2 and 4.1; C-VI, 1.1, 1.1.1, 3.2, 3.4 and 3.5; E-IX, 5.4 and 5.7;**

(g) Rule 135 (Further processing): **A-III, 14; A-IV, 1.1.1.5; E-VIII, 2.1;**

(h) Rule 137 (Amendment of the European patent application): **B-XII, 2, 2.2 and 9; C-VI, 2.1, 3.1 to 3.3, 3.5.1, 4.1, 4.7, 4.9, 5.2, 5.6, 5.7, 9.1.4 and 14.4;**

(i) Rule 161 (Amendment of the application after entry into the European phase): **A-VI, 2.4; A-VII, 7; C-III, 7.11; C-VI, 3.5.1 and 9.4; E-IX, 4a, 5.1 and 6.3.3.**

9. Amendments were made to chapter **C-IV, 11** concerning inventive step, in which the range of board of appeal decisions cited should be particularly noted.

10. Furthermore, the following sections of the Guidelines have been updated with regard to the following topics:

(a) Electronic filing of documents: **A-II, 1.3, 3.1; A-IV, 1.3.1; A-IX, 3.2; E-IX, 2;**

(b) Filing of priority documents: **A-II, 5.4.3; A-III, 6.7; A-VII, 3.5; C-V, 3.3;**

(c) Supplementary European search report: **A-XI, 9.3.1; B-II, 4.3;**

(d) Publications on the internet: **B-III, 2.5; B-IV, 2.3; C-IV, 6.2; D-V, 3.1.3;**

(e) Postponement of oral proceedings: **E-III, 7.**

11. A number of amendments were made in the light of decisions of the Enlarged Board of Appeal and the other boards of appeal: see **C-III, 3.3, 4.2, 4.12, 4.16, 4.20 and 7.1; C-IV, 2.3.5, 4.1, 4.4, 4.8.1 and 5.4; C-VI, 5.2, 5.3.2 and 9.1.4; D-I, 4; D-V, 6.2; E-III, 7, 8.5 and 8.6; E-VI, 2 and E-X, 1.2.**

# **Guidelines for Examination in the European Patent Office**

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# List of Contents

## General Part

Contents	a
1. Preliminary remarks	1
2. Explanatory notes	1
2.1 Overview	1
2.2 Abbreviations	2
3. General remarks	3
4. Work at the EPO	4
5. Survey of the processing of applications and patents at the EPO	4
6. Contracting States to the EPC	5
7. Extension to states not party to the EPC	6

## Part A – Guidelines for Formalities Examination

Contents	a
Chapter I Introduction	I-1
Chapter II Filing of applications and examination on filing	II-1
Chapter III Examination of formal requirements	III-1
Chapter IV Special provisions	IV-1
Chapter V Communicating the formalities report; amendment of application; correction of errors	V-1
Chapter VI Publication of application; request for examination and transmission of the dossier to Examining Division	VI-1
Chapter VII Applications under the Patent Cooperation Treaty (PCT) before the EPO acting as a designated or elected Office	VII-1
Chapter VIII Languages	VIII-1
Chapter IX Common provisions	IX-1
Chapter X Drawings	X-1
Chapter XI Fees	XI-1
Chapter XII Inspection of files; communication of information contained in files; consultation of the Register of European Patents; issuance of certified copies	XII-1

## Part B – Guidelines for Search

Contents	a
Chapter I Introduction	I-1
Chapter II General	II-1
Chapter III Characteristics of the search	III-1
Chapter IV Search procedure and strategy	IV-1
Chapter V Preclassification (routing) and official classification of European patent applications	V-1
Chapter VI The state of the art	VI-1
Chapter VII Unity of invention	VII-1
Chapter VIII Subject-matter to be excluded from the search	VIII-1
Chapter IX Search documentation	IX-1
Chapter X Search report	X-1

Chapter XI	The abstract	XI-1
– Annex	Checklist for considering the abstract (see XI, 5)	XI-3
Chapter XII	The search opinion	XII-1

### Part C – Guidelines for Substantive Examination

Contents		a
Chapter I	Introduction	I-1
Chapter II	Content of a European patent application (other than claims)	II-1
– Annex	Units recognised in international practice and complying with Rule 49(11) (see II, 4.16)	II-17
Chapter III	Claims	III-1
Chapter IV	Patentability	IV-1
– Annex	Examples relating to the requirement of inventive step – indicators (see IV, 11.13)	IV-43
Chapter V	Priority	V-1
Chapter VI	Examination procedure	VI-1

### Part D – Guidelines for Opposition and Limitation/Revocation Procedures

Contents		a
Chapter I	General remarks	I-1
Chapter II	The Opposition Division	II-1
Chapter III	Opposition	III-1
Chapter IV	Procedure up to substantive examination	IV-1
Chapter V	Substantive examination of opposition	V-1
Chapter VI	Procedure for the examination of the opposition	VI-1
Chapter VII	Details and special features of the proceedings	VII-1
Chapter VIII	Decisions of the Opposition Division	VIII-1
Chapter IX	Costs	IX-1
Chapter X	Limitation and revocation procedure	X-1

### Part E – Guidelines on General Procedural Matters

Contents		a
Introduction		1
Chapter I	Communications and notifications	I-1
Chapter II	Procedure for amendments to documents	II-1
Chapter III	Oral proceedings	III-1
Chapter IV	Taking and conservation of evidence	IV-1
Chapter V	Derogations from the language of the proceedings in oral proceedings	V-1
Chapter VI	Examination by the EPO of its own motion; facts, evidence or grounds not submitted in due time; observations by third parties	VI-1
Chapter VII	Interruption and suspension of the proceedings	VII-1
Chapter VIII	Time limits, loss of rights, further and accelerated processing and re-establishment of rights	VIII-1
Chapter IX	Applications under the Patent Cooperation Treaty (PCT)	IX-1
Chapter X	Decisions	X-1
Chapter XI	Appeals	XI-1
Chapter XII	Request from a national court for a technical opinion concerning a European patent	XII-1







# General Part



## Contents

1.	Preliminary remarks	1
2.	Explanatory notes	1
2.1	Overview	1
2.2	Abbreviations	2
3.	General remarks	3
4.	Work at the EPO	4
5.	Survey of the processing of applications and patents at the EPO	4
6.	Contracting States to the EPC	5
7.	Extension to states not party to the EPC	6



## **1. Preliminary remarks**

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

These Guidelines have been and will be updated at regular intervals to take account of developments in European patent law and practice. Amended or new text (as compared to the latest previous version only) is indicated by a vertical line in the right-hand margin. Mere deletions are indicated by two horizontal lines in the right-hand margin. 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. Any indication from readers drawing the attention to errors as well as suggestions for improvement are highly appreciated and may be sent by e-mail to: [patentlaw@epo.org](mailto:patentlaw@epo.org)

The Guidelines for Examination in the European Patent Office are also published by the EPO in an electronic, searchable form on the Internet via the EPO website:

<http://www.epo.org>

## **2. Explanatory notes**

### **2.1 Overview**

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

Part A: Guidelines for Formalities Examination;

Part B: Guidelines for Search;

Part C: Guidelines for Substantive Examination;

Part D: Guidelines for Opposition and Limitation/Revocation Procedures; and

Part E: Guidelines on General Procedural Matters.

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

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

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

Re April 2010 update:	OJ 4/2010;
Re April 2009 update:	OJ 5/2009, 336-337;
Re December 2007 update:	OJ 11/2007, 589 - OJ 11/2007, 592;
Re June 2005 update:	OJ 7/2005, 440 - 443;
Re December 2003 update:	OJ 12/2003, 582 - 585;
Re October 2001 update:	OJ 10/2001, 464 - 465;
Re February 2001 update:	OJ 2/2001, 115 - 116;
Re June 2000 update:	OJ 5/2000, 228 - 234;
Re July 1999 update:	OJ 7/1999, 510 - 522.

It will be noted that each Part of the Guidelines is 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). If the cross-reference is to another Part of the Guidelines it also includes the relevant 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 to articles and rules without further identification indicate the Articles or Rules 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 EPC itself.

It goes without saying that whenever "his" or "he" is used in relation to examiner, applicant, inventor, etc., this should be understood as "her or his" and "she or he", respectively.

## 2.2 Abbreviations

In the Guidelines, the following abbreviations are used:

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

References to the European Patent Convention (EPC) are references to the European Patent Convention as amended by the Act revising the EPC of 29 November 2000 and the



decision of the Administrative Council of 28 June adopting the new text of the European Patent Convention (OJ EPO Special editions No. 4/2001, pages 56 et seq; No. 1/2003, pages 3 et seq; No. 1/2007, pages 1 to 88) and the Implementing Regulations as adopted by decision of the Administrative Council of 7 December 2006 (OJ Special edition No. 1/2007, pages 89 et seq).

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

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

Decisions and opinions of the Enlarged Board of Appeal will only be referred to with their capital letter, their number and the number and page of the Official Journal they were published in, e.g. "G 2/88, OJ 4/1990, 93". Decisions of the Technical Boards of Appeal and the Legal Board of Appeal will be referred to in the same way, e.g., "T 152/82, OJ 7/1984, 301" and "J 4/91, OJ 8/1992, 402", where they have been published in the OJ, and "T 169/88, not published in OJ", if not. It is noted that all decisions and opinions of the Enlarged Board of Appeal and all decisions of the boards of appeal of the EPO are published on the Internet (<http://www.epo.org>) (see the Notice from the Vice-President Directorate-General 3 dated 3 July 2002, OJ 8-9/2002, 442).

The arrangements for deposit accounts and their annexes, including the arrangements for the automatic debiting procedure plus explanatory notes, are published from time to time as a Supplements to the Official Journal of the EPO.

### 3. General remarks

3.1 These Guidelines give instructions about 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 section 5).

The search and examination practice and procedure as regards PCT applications, as far as the international phase is concerned, are not the subject of these Guidelines, but are dealt with in the **PCT International Search and Preliminary Examination Guidelines**. Whenever considered appropriate, options given in the latter Guidelines and the way they are dealt with by the European Patent Office when acting as Receiving Office, International Searching Authority or International Preliminary Examining Authority are the subject of separate notices published in the Official Journal of the EPO and on the EPO website. It is important to note that Art. 150 EPC states that in case of conflict between the PCT and the EPC, the provisions of the PCT prevail.

These Guidelines are addressed primarily to EPO staff 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 EPO on the other.

3.2 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, as a general rule, parties can expect the EPO to act in accordance with the Guidelines until such time as they – or the relevant legal provisions – are amended. Notices concerning such amendments are published in the Official Journal of the EPO and on the EPO website.

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

3.3 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.

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

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

#### **4. Work at the EPO**

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

4.2 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 EPC. 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.

4.3 It is also important that the various departments of the EPO and various staff within the same department should not attempt to duplicate one another's efforts. For example, Examining Divisions should not attempt to check the formalities work performed by the Receiving Section or to duplicate the search work performed by the Search Division. One of the purposes of the Guidelines is to make clear where the demarcations of responsibility lie.

4.4 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 EPC imposes various time limits on the parties. Generally speaking there are no corresponding time limits imposed on the EPO, but the European patent system will be judged a success only if examiners and other employees also operate with reasonable expedition.

4.5 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.

## **5. Survey of the processing of applications and patents at the EPO**

5.1 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 is filed with the EPO or a competent national authority;
- (ii) the Receiving Section examines the application to determine if a date of filing can be accorded to the application;
- (iii) the formal examination of the application is undertaken by the Receiving Section;
- (iv) in parallel with the formal examination the Search Division draws up an EESR, a copy of which is forwarded to the applicant;
- (v) the application and the search report are published by the EPO either together or separately;
- (vi) on receipt of a request 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 examination and an examination of formalities necessary for grant by the Examining Division;
- (vii) provided the requirements of the EPC are met, a European patent is granted for the States designated;
- (viii) the specification of the European patent is published by the EPO;
- (ix) any person may give notice of opposition to the European patent granted; after examining the opposition, the Opposition Division decides whether to reject the opposition, maintain the patent in amended form, or to revoke the patent;
- (x) the patent proprietor may request limitation or revocation of the granted patent; the Examining Division will decide whether this request is to be granted
- (xi) if the European patent is amended, the EPO publishes a new specification of the European patent amended accordingly.

5.2 Any decision by an EPO first-instance department which adversely affects a party is 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.

## 6. Contracting States to the EPC

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

Austria	(1 May 1979)
Belgium	(7 October 1977)
Bulgaria	(1 July 2002)
Croatia	(1 January 2008)
Cyprus	(1 April 1998)
Czech Republic	(1 July 2002)
Denmark <sup>1</sup>	(1 January 1990)
Estonia	(1 July 2002)
Finland	(1 March 1996)
Former Yugoslav Republic of Macedonia	(1 January 2009)
France <sup>2</sup>	(7 October 1977)
Germany	(7 October 1977)
Greece	(1 October 1986)
Hungary	(1 January 2003)
Iceland	(1 November 2004)
Ireland	(1 August 1992)
Italy	(1 December 1978)
Latvia	(1 July 2005)
Liechtenstein	(1 April 1980)
Lithuania	(1 December 2004)
Luxembourg	(7 October 1977)
Malta	(1 March 2007)
Monaco	(1 December 1991)
Netherlands <sup>3</sup>	(7 October 1977)
Norway	(1 January 2008)
Poland	(1 March 2004)
Portugal	(1 January 1992)
Romania	(1 March 2003)
San Marino	(1 July 2009)
Slovak Republic	(1 July 2002)
Slovenia	(1 December 2002)
Spain	(1 October 1986)
Sweden	(1 May 1978)
Switzerland	(7 October 1977)
Turkey	(1 November 2000)
United Kingdom <sup>4</sup>	(7 October 1977)

(total: 36)

- \*: An up-to-date list of the Contracting States to the EPC is published each year in issue No. 4 of the Official Journal of the EPO.
- <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 4/2004, 79.

## 7. 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):

Albania	(1 February 1996)
Bosnia and Herzegovina	(1 December 2004)
Serbia	(1 November 2004)

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