

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) 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.**

Part E

Guidelines on General Procedural Matters

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Introduction

Part E contains guidelines for those procedural steps in respect of the examination of European patent applications and patents which without major variations may, insofar as the EPC permits, occur at a number of stages in the procedure. Attention is also drawn to Art. 125, which states: "In the absence of procedural provisions in this Convention, the EPO shall take into account the principles of procedural law generally recognised in the Contracting States".

With the exception of Chapter IX, Part E does not apply to international applications which the EPO processes under the Patent Cooperation Treaty (PCT), unless stated otherwise.

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 55, 58, 59, 64(1), 77(2), 95(2) or 108(2);
- (ii) if a party is to be invited to file observations on particular questions or to submit documents, evidence, etc., to clarify the issues involved;
- (iii) if, in the opinion of the Examining or Opposition Division, the patent cannot be granted or maintained in the text requested by the applicant or proprietor of the patent, but could possibly be granted or maintained in an amended text of more limited scope;
- (iv) if information necessary to the conduct of the proceedings has to be communicated to the parties, e.g. in accordance with Rule 14(2) and (3), 35(4), or 142(2) and (3);
- (v) for preparing oral proceedings, (see III, 5); or
- (vi) if a decision is to be based on grounds on which the parties have not yet had an opportunity to comment (see 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

Any decision, communication or notice from the EPO is to be signed by and to state the name of the employee responsible. Where these documents are produced by the employee responsible using a computer, a seal may replace the signature. Where the documents are produced automatically by a computer the employee's name may also be dispensed with. The same applies to pre-printed notices and communications.

Rule 113(1) and (2)

2. Notification

2.1 General remarks

Art. 119
Rule 125
Rule 126

The EPO as a matter of course notifies those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of the EPC, or of which notification has been ordered by the President of the EPO. Notifications may, where exceptional circumstances so require, be given through the intermediary of the central industrial property offices of the Contracting States. In proceedings before the EPO, any notification to be made must take the form 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 do not require such certification.

2.2 Method of notification

Rule 125(2) and (3)
Rule 127

Notification is to be by post, by delivery on the premises of the EPO, by public notice 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 are given in Rules 126 to 129. Notification through the central industrial property office of a Contracting State competent to deal with the addressee must be made in accordance with the provisions applicable to that office in national proceedings.

2.3 Notification by post

Rule 126

Notification is usually made by post. Decisions incurring a period for appeal or a petition for review, summonses and other documents as decided on by the President of the EPO must be notified by registered letter with advice of delivery. All other notifications by post must 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 is 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 is incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

Notification is deemed to have been effected even if acceptance of the letter has been refused.

The law of the state on the territory of which the notification is made applies to other matters concerning notification, e.g. the question whether delivery to a person other than the addressee constitutes an effective notification to the latter.

2.4 Notification to representatives

If a representative has been appointed, notifications must be addressed to him. If several such representatives have been appointed for a single interested party, notification to any one of them is sufficient. If several persons are joint applicants for or proprietors of a patent or have acted in common in filing notice of opposition or intervention and have not appointed a common representative, notification of one person, viz. the person referred to in Rule 151, will again be sufficient. If several interested parties have a common representative, notification of a single document to the common representative is sufficient.

*Rule 130***2.5 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 is deemed to have been notified on the date established by the EPO as the date of receipt. In cases where the EPO is not able to prove the actual date of notification, a letter for instance, sent by the 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.

Rule 125(4)

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. 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 will also be invited simultaneously to resubmit the said copy and – as an alternative to submitting replacement pages – to indicate on this copy, separately from the comments of the 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 EPO. 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 therefore does not include informal personal interviews or telephone conversations, such as occur in examination proceedings and limitation/revocation proceedings (see C-VI, 6). In view of Rule 81(2), 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 EPO and the opponent concerned.

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. *Art. 18(2)*
Art. 19(2)

2. Oral proceedings at the request of a party

If, in the course of proceedings, a party requests oral proceedings, the competent department must grant this request. 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(1)*

Nevertheless, oral proceedings will take place before the Receiving Section at the request of the applicant only where the Receiving Section considers this to be expedient or where it envisages refusing the European patent application. Where the Receiving Section does not consider it necessary to hold oral proceedings, it must inform the applicant accordingly (J 16/02). *Art. 116(2)*

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, Art. 101 or Art. 105b) 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. If the request is not expressly withdrawn, oral proceedings must be held.

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 last two 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 (or to limit a granted patent in limitation proceedings) on the basis of the documents filed during the oral proceedings.

Thus, as a rule, in examination, limitation or opposition proceedings there will be no justification for further oral proceedings, for example where one of the parties wishes to re-examine from a different viewpoint a subject already discussed in the course of the proceedings, either before or during the original oral proceedings. However, if the oral proceedings are not terminated with a decision and after the oral proceedings the subject of the proceedings changes, for example where fresh evidence is admitted into the proceedings after the original oral proceedings, then further oral proceedings will generally have to be held if requested (see T 194/96, 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 EPO to require discussion, it will in many cases be expedient to inform the party or parties in a notice and possibly also to invite one or more of the parties to submit written observations or to produce evidence, where appropriate. Parties may produce evidence in support of their arguments on their own initiative. Where, however, the evidence is such 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 is to 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.

6. Summons to oral proceedings

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 115(1)

Art. 119

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 amendments which meet the requirements of the EPC may be submitted (see also D-VI, 3.2).

Rule 116(1)

At least two months' notice of the summons must 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.

Rule 115(1)

In 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

A request for the postponement of oral proceedings is allowable only if the party concerned can advance serious reasons which justify the fixing of a new date (see T 1080/99, OJ 12/2002, 568, T 300/04, J 4/03 and T 178/03). The request to fix another date must be filed as soon as possible after the grounds preventing the party concerned from attending the oral proceedings have arisen. It must be accompanied by a sufficiently substantiated written statement indicating these reasons (see OJ EPO 1/2009, 68; see also T 178/03). A request to have oral proceedings held at an EPO site

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other than that indicated in the summons is not allowable (see T 1012/03).

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 are not public.

Art. 116(4)

Oral proceedings, including delivery of the decision (see III, 9), are public before the Opposition Divisions insofar 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.

If a party who has been duly summoned to oral proceedings does not appear as summoned, the oral proceedings may be conducted without him, since a party should not be able to delay issuance of a decision by failing to appear. *Rule 115(2)*

If, however, an allowable request for the postponement of oral proceedings has been filed (see III, 7), the proceedings should be postponed and a new date fixed. If the filing of the request was delayed due to the carelessness of the party concerned, the proceedings may, depending on the circumstances, still be postponed; if this happens in opposition proceedings, a decision on the apportionment of costs may have to be taken (see D-IX, 1.4). *Art. 104(1)*

If new facts or evidence are submitted during inter-partes oral proceedings which a party, although duly summoned, fails to attend, it must first be examined whether these submissions may be disregarded (Art. 114(2); see also III, 8.6 and VI, 2).

Following G 4/92 (OJ 3/1994, 149), if new facts are taken into consideration, then at the end of the oral proceedings a decision based on these facts cannot be taken against the absent party. Further, new evidence can only be used against the absent party if it has been previously notified and merely supports the previous assertions of the party who submits it. However, new arguments may be used at any time, insofar as they do not change the grounds on which the decision is based.

In other words, what the Enlarged Board of Appeal ruled out in G 4/92 was the possibility of taking decisions against the absent party on the basis of a surprising course of events at the oral proceedings, which changes the legal and factual framework of the case in an unforeseeable way (see T 414/94, not published in OJ).

An absent party cannot be considered taken by surprise if during oral proceedings the other side attempts to overcome objections raised before the oral proceedings. In particular, a submission during oral proceedings of a more restricted and/or formally amended set of claims with a view to overcoming the objections of the opponent is not

considered a "new fact" (see T 133/92 and T 202/92, neither published in OJ). Nor is it unexpected that amended claims are examined for formal admissibility and for compliance with Art. 123(2) and (3) (see T 341/92, OJ 6/1995, 373).

In the particular case of an absent opponent, if new prior art is submitted for the first time during oral proceedings which may be an obstacle to the maintenance of the opposed patent, this new prior art can be taken into consideration despite the opponent's absence because it is in the opponent's favour (see T 1049/93, not published in OJ).

8.4 Opening of the substantive part of the proceedings

Insofar 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 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 116.

If a party is represented by an authorised employee rather than a professional representative, the same considerations apply in respect of a person accompanying the authorised employee.

Parties are not to be considered as accompanying persons in the sense of G 4/95 (OJ 7/1996, 412) (see T 621/98, not published in OJ). They have the right to make submissions in oral proceedings by virtue of their status as party to the proceedings.

If written submissions are made during oral proceedings, it is the responsibility of the Division to make sure that the formal requirements such as readability, signature and dating of the submissions are met (see T 733/99).

8.6 Facts, evidence or amendments introduced at a late stage

With respect to facts and evidence not submitted in due time or arguments presented at a late stage in the proceedings in general, see VI, 2. Concerning facts and evidence not filed within the opposition period, see D-IV, 1.2.2.1(v).

Rule 116(1), being an implementation of Art. 114(2) as a further development on the existing jurisprudence regarding facts or evidence not filed in due time, makes it clear that the Examining or Opposition Division has a discretion to disregard new facts or evidence for the reason that they have not been filed before the date indicated in the summons under Rule 116, 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

Rule 116(1)

amendments (Art. 113(1)). A further example is where a new ground of opposition is introduced during oral proceedings: the opponent should always be granted the right to be heard, even where the arguments concern a late-filed ground of opposition and new arguments and evidence related to it (T 117/02).

Rule 116(2)

Rule 116(2) imposes the same obligations on the applicant or patent proprietor when submitting new documents which meet the requirements of the EPC (i.e. new amendments to the description, claims and drawings) as Rule 116(1) imposes on the parties in submitting new facts and evidence. Here the Division also has the discretion to disregard amendments because they are filed too late before the oral proceedings. 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)).

Analogously, the proprietor should always be given the opportunity to submit amendments intended to overcome objections raised by the Division which depart from a previously notified opinion (T 273/04).

Rule 116(1) and (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 amendments, 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 familiarise themselves in the time available with the new facts or evidence or the proposed amendments.

As regards **procedural expediency**: where the late-filed facts or evidence are relevant, but their introduction would cause a prolonged adjournment of the proceedings, the Division may decide 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 in opposition proceedings (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). Another would be the filing of requests subject to conditions to be met by the Division. It is the duty of any

party to proceedings to make its own case and to formulate its own requests (see T 446/00).

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 must, 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 Examining or Opposition Division indicates during the oral proceedings that it would be willing to grant or maintain a European patent provided that certain amendments are made which could not reasonably have been foreseen from the earlier procedure, the applicant or patent proprietor will be given a time limit of normally 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.

9. Delivery of the decision

Rule 111(1) and (2)

The delivery of the decision will follow a statement by the person conducting the proceedings announcing the operative part of the decision (see also 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." or

"The request for limitation of the patent is allowable." or

"The request for limitation of the patent is rejected."

Once a decision has been pronounced, submissions of the party or parties cannot be considered any longer and the decision stands, subject to the correction of errors in accordance with Rule 140. It may only be amended by appeal (see 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 must be notified to the parties without undue delay. The period for appeal will only begin to run from the date of notification of the written decision.

Generally speaking it will not be possible to give a decision granting a European patent or maintaining it in amended or limited form in oral proceedings since, in the case of the grant of a patent, the requirements laid down in Rule 71(3)-(7), and in the case of a patent being maintained in amended or limited form, the requirements of Rule 82(1) and (2) or Rule 95(3) must be fulfilled.

10. Minutes of oral proceedings

(As regards the minutes of taking of evidence, see IV, 1.7.)

10.1 Formal requirements

Minutes of oral proceedings must be drawn up.

Rule 124(1)

The person conducting the proceedings must ensure that during the whole proceedings an employee is available to keep minutes. If necessary, during oral proceedings different employees may carry out the task of minute-writing in sequence. In this case it must be made clear in the minutes which section was drawn up by which employee. The employees are normally members of the competent department, e.g. the Examining or Opposition Division. The minutes are normally taken down by hand by the member of the Division charged with this

task. Following the proceedings, the handwritten minutes are typed out.

Rule 124(3) and (4)

The minutes must be signed by the employee responsible for drawing them up and by the employee who conducted the oral proceedings. The parties must be provided with a copy of the minutes. Copies must be notified to them as soon as possible after the oral proceedings.

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 such apparatus into the hearing room (see Notice of the Vice-Presidents of the Directorates-General 2 and 3 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 124(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 patentability criteria.

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

Formal taking of evidence in accordance with Rule 117 will occur mainly in opposition proceedings and hardly ever before the Examining Division. The following Sections of this Chapter are therefore based primarily on opposition proceedings. However, they also apply *mutatis mutandis* to other proceedings and particularly to substantive examination.

Art. 117

Rule 117

1.2 Means of evidence

The party or parties may at any time during proceedings submit evidence in support of alleged facts (see III, 5, X, 1.2, D-IV, 5.3 and 5.4, and 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.

Art. 117(1)

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 which are admissible in proceedings before the EPO are (non-exhaustively) listed in Art. 117(1):

- production of documents;
- hearing the parties;
- hearing witnesses;

- sworn statements in writing;
- requests for information, for instance from a publisher concerning the date of publication of a book
- opinions by experts (see IV, 1.8.1); and
- inspection.

The most appropriate way of obtaining evidence in the individual case depends on the facts which have to be proven and on the availability of the evidence. To prove prior use in an opposition, the 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 being 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.

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 Rule 119(1), for the purposes of an inspection, such as in the form of a demonstration of a process or the investigation of an object, particularly in undertakings located far away.

*Art. 117(2)
Rules 118 to 120*

A member may also be commissioned to attend a court hearing pursuant to Rule 120(3), and put questions to the witnesses, parties and experts.

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 must make a decision to this end (order to take evidence), setting out the investigation which it intends to carry out, relevant facts to be proved 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 132(2) will be not less than two months and not more than four months, since the party concerned will normally know beforehand whom he wishes to be heard as a witness or expert.

Rule 117

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).

Art. 119

1.5 Summoning of parties, witnesses and experts

The parties, witnesses and experts to be heard must be invited to appear to give evidence on the date fixed. The summons must be notified. At least two months' notice of a summons issued to a party, witness or expert to give evidence must be given, unless they agree to a shorter period. The summons must contain:

*Art. 119
Rule 118(1) and (2)*

- Rule 118(2)(a)* (i) an extract from the order to take evidence, indicating in particular the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses and experts are to be heard;
- Rule 118(2)(b)* (ii) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke (see IV, 1.10); and
- Rule 118(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 EPO whether he is prepared to appear before it (see IV, 3.2.2 (iii) and (iv)).
- Rule 119(3)* Even if evidence is not taken in oral proceedings, all parties to the proceedings may attend an investigation. Parties not summoned should be informed thereof within the period laid down in Rule 118(2), together with a statement that they may attend.

1.6 Hearing of parties, witnesses and experts

1.6.1 General remarks

Where the Examining or Opposition Division holds hearings for the purpose of taking evidence (see 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 Rule 117 requires as a precondition a decision to take evidence (see IV, 1.4). This is different from hearing oral submissions by a person accompanying the representative during oral proceedings, which can be allowed at the discretion of the Division (see G 4/95, OJ 7/1996, 412 and III, 8.5).

1.6.2 Witnesses and experts not summoned

After opening the proceedings for the taking of evidence, the official in charge of the taking of evidence, i.e. in substantive examination and opposition proceedings the 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).

1.6.3 Guidance to persons heard

Before a party, witness or expert may be heard, he must be informed that the EPO may request the competent court in the country of residence of the person concerned to re-examine his evidence on oath or in an equally binding form.

Rule 119(2)

1.6.4 Separate hearings

Normally each witness must be heard separately, i.e. any other witnesses to be heard subsequently must not be present. This rule does not apply to experts and to the parties. Witnesses whose statements conflict may be confronted with one another, i.e. each heard in turn in the presence of the other. The same applies to experts.

1.6.5 Examination as to personal particulars

The hearing will begin by the 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 IV, 1.6.7).

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.

Rule 119(3)

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 may further not be directed to facts which require no further discussion, which are in no way relevant to the subject-matter

for which the taking of evidence has been ordered, or if they aim at establishing facts in respect of which no evidence has been offered. A decision to reject a question cannot be challenged. As regards the entitlement of other members of the Division to put questions, see III, 8.8.

1.7 Minutes of taking of evidence

Rule 124(1)

Minutes of the taking of evidence must 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 124(2)

The minutes will normally be taken down by a member of the competent department carrying out the taking of evidence. The most efficient way of noting testimony is by way of dictation on to a dictating machine, in the process of which the person hearing the evidence will summarise the testimony in small sections, taking into account any objections raised by the 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. It is not necessary to play back the minutes or to obtain approval of them if the testimony has been recorded verbatim and directly, using technical means.

Where the taking of evidence includes an inspection, the minutes must record, in addition to the essentials of the proceedings, the results of the inspection.

In addition, the taking of evidence as well as oral proceedings (see III, 10.1) may be recorded on sound recording apparatus.

1.8 Commissioning of experts

1.8.1 Decision on the form of the opinion

Rule 121(1)

If the competent department decides of its own motion to obtain an expert opinion (D-VI, 1, 6th paragraph), it will have to decide in what form it should be submitted by the expert whom it appoints. The opinion 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 opinion and provided that the parties agree to this arrangement. As a rule, in addition to submitting a written opinion and introducing it orally, the expert will also be heard (see IV, 1.6).

A copy of the opinion must be submitted to the parties. The copy will be produced by the EPO. *Rule 121(3)*

1.8.2 Objection to an expert

The parties may object to an expert. Therefore, before commissioning an expert to make an opinion, the competent department should inform the parties of the expert whom it intends to ask to draw up an opinion and of the subject-matter of the opinion. The communication to the parties 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 121(4)*

1.8.3 Terms of reference of the expert

The terms of reference of the expert must include: a precise description of his task, the period laid down for the submission of his opinion, the names of the parties to the proceedings and particulars of the rights which he may invoke under the provisions of Rule 122(2) to (4) (regarding travel and subsistence expenses and fees, see IV, 1.10). *Rule 121(2)(a)-(d)*

1.9 Costs arising from oral proceedings or taking of evidence

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 the EPO by the party who requested the evidence to be taken of a sum the amount of which is to be fixed by reference to an estimate of the costs. This procedure 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 88. Any shortfall between the deposit lodged and the amounts payable by the EPO under Rule 122(4), 2nd sentence, is fixed by the EPO 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 EPO itself. *Art. 104(1) and (2)*
Rule 122(1) and (2)

1.10 Entitlements of witnesses and experts

1.10.1 Expenses for travel and subsistence

Rule 122(2)

Witnesses and experts who are summoned by and appear before the EPO are entitled to appropriate reimbursement, by the EPO, of expenses for travel and subsistence (see 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.

1.10.2 Loss of earnings, fees

Rule 122(3)

Witnesses entitled to reimbursement of travel and subsistence expenses are also entitled to appropriate compensation, by the EPO, for loss of earnings, and experts to fees from the EPO for their work (see IV, 1.10.3). These payments must be made to the witnesses and experts after they have fulfilled their duties or tasks.

1.10.3 Details of the entitlements of witnesses and experts

Rule 122(4)

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 must be made by the EPO.

2. Conservation of evidence

2.1 Requirements

Rule 123(1)

On request, the EPO may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. This could for example be the case where an important witness is about to emigrate to a distant country or where perishable matter, e.g. a food-stuff, is adduced as involving a use made accessible to the public.

2.2 Request for the conservation of evidence

Rule 123(2)

The request for the conservation of evidence must contain:

Rule 123(2)(a)

(i) the name, address and nationality of the 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 41(2)(c);

Rule 123(2)(b)

(ii) sufficient identification of the European patent application or European patent in question;

- (iii) the designation of the facts in respect of which evidence is to be taken; *Rule 123(2)(c)*
- (iv) particulars of the way in which evidence is to be taken; and *Rule 123(2)(d)*
- (v) a statement establishing a prima facie case for fearing that it might subsequently become more difficult or impossible to take evidence. *Rule 123(2)(e)*

The request is not deemed to have been filed until the fee for conservation of evidence has been paid. *Rule 123(3)*

2.3 Competence

The decision on the request and any resulting taking of evidence are incumbent upon the department of the EPO required to take the decision liable to be affected by the facts to be established. *Rule 123(4)*

Responsibility for the decision and the taking of evidence will therefore normally rest with:

- (i) the Examining Division, from the date of filing until the date of the decision on the granting of the patent;
- (ii) the Opposition Division, from the latter date until expiry of the time allowed for filing notice of opposition and during opposition proceedings; and
- (iii) the Board of Appeal, from the date of a final decision by the Opposition Division until it becomes legally binding or while appeal proceedings are pending.

2.4 Decision on the request and the taking of evidence

The competent department must decide upon the request without delay. If it grants the request, it must also immediately make a decision on the taking of evidence. *Rule 123(1)*
Rule 117

The provisions with regard to the taking of evidence in proceedings before the EPO are applicable. *Rule 123(4)*

The date on which the measures are to be taken must therefore be communicated to the applicant for or proprietor of the patent and the other parties in sufficient time to allow them to attend. They may ask relevant questions. *Rule 123(1)*
Rule 118(2)
Rule 119(3)

3. Taking of evidence by courts or authorities of the Contracting States

3.1 Legal co-operation

Upon receipt of letters rogatory from the EPO, the courts or other competent authorities of Contracting States will undertake, on behalf *Art. 131(2)*

of the EPO and within the limits of their jurisdiction, any necessary enquiries.

3.2 Means of giving or taking evidence

3.2.1 Taking of evidence on oath or in equally binding form

Rule 120(3)

The principal case where evidence is taken by a competent court will be the hearing of parties, witnesses or experts. In such instances the competent department may request the competent court to take the evidence on oath or in an equally binding form.

3.2.2 Cases where evidence is taken by a competent court

Rule 120(3)

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;

Rule 120(2)

(ii) the competent department considers it advisable for the evidence of a party, witness or expert it has heard to be re-examined under oath or in an equally binding form (see IV, 3.2.1);

Rule 120(1)

(iii) there has been no reply to the summons by the expiry of a period fixed by the competent department in the summons (see IV, 1.5(iii)); or

Rule 120(1)

Rule 150(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 150(2)

The EPO must draw up letters rogatory in the language of the competent authority or must attach to such letters rogatory a translation into the language of that authority.

Rule 150(1)

Letters rogatory should be addressed to the central authority designated by the Contracting State.

3.4 Procedures before the competent authority

Rule 150(5)

The EPO must be informed of the time when, and the place where, the enquiry is to take place and must inform the parties, witnesses and experts concerned.

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 120(3)

Rule 150(6)

3.5 Costs of taking evidence

The execution of letters rogatory does not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the European Patent Organisation to reimburse any fees paid to experts and interpreters and the costs incurred as a result of the attendance of members of the competent department when evidence is taken.

Rule 150(7)

3.6 Taking of evidence by a person appointed by the competent authority

If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the competent department, appoint a suitable person to do so. When seeking the consent of the department concerned, the competent authority must indicate the approximate costs which would result from this procedure. If the competent department gives its consent, the European Patent Organisation must reimburse any costs incurred; without such consent, the Organisation is not liable for such costs.

Rule 150(8)

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, 6, 7 and 10, 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; and
- (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 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 possibly should not be evaluated on the same level as that of neutral witnesses. This applies above all where parties have been present when witnesses have been heard and have ascertained the attitude of the competent department. The considerations set out in 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 121 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

Any party to oral proceedings before the EPO may, in lieu of the language of the proceedings, use one of the other official languages of the EPO, on condition that such party either gives notice to the EPO at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings. In the former case, it is the responsibility of the EPO to provide for interpretation at its own expense.

Rule 4(1) and (5)

2. Language of a Contracting State or other language

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 interpreting into the language of the proceedings. However, if the parties and the EPO agree, any language may be used in oral proceedings without interpreting or prior notice.

Rule 4(1) and (4)

3. Exceptions from sections 1 and 2

Derogations from the provisions of Rule 4(1) are permitted, and these are at the discretion of the EPO. Clearly such permission must depend on the circumstances of the individual case. It may, for example, be envisaged that a party is 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 EPO is unable to provide for interpreting, it should postpone the oral proceedings if they occur at the examination stage. 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 EPO 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.

Rule 4(1)

4. Language used in the taking of evidence

When the evidence is being taken, a party, witness or expert who is unable to express himself adequately in English, French or German or in any other official language of the Contracting States is permitted to use another language. The EPO is responsible for interpreting into the language of the proceedings, assuming that this is necessary, if the evidence is taken at the request of the EPO itself. However, if the taking of evidence follows a request by a party to the proceedings, the use of a language other than English, French or German should be allowed only if that party provides for interpreting into the language

Rule 4(3)

of the proceedings or, at the discretion of the EPO, 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 4(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 EPO should provide for interpreting into the language of the proceedings at its own expense.

6. Language used in the minutes

Where the official language actually employed in oral proceedings is not the language of the proceedings as defined in Art. 14(3), if the Examining or Opposition Division 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 EPO will not provide translations of the minutes into the language of the proceedings as defined in Art. 14(3). This condition, as well as the declaration of agreement of the party or parties, 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.

Statements made in any other language must be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent made during oral proceedings must be entered in the minutes in the language of the proceedings. If the proceedings are conducted in a language other than English, French or German and no interpretation is effected, statements should be entered in the minutes in the language employed and the EPO 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, evidence or grounds not submitted in due time; observations by third parties

1. Examination by the EPO of its own motion

1.1 General remarks

In proceedings before it, the EPO examines the facts of its own motion; it is not restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought. This principle of examination by the EPO of its own motion must be complied with by the competent department during all proceedings pending before it. Thus, once proceedings have been initiated, e.g. once a valid request for examination has been filed or an admissible notice of opposition has been filed (although it may subsequently be withdrawn), if there is reason to believe, e.g. from personal knowledge or from observations presented by third parties, that there are facts and evidence not yet considered in the proceedings which in whole or in part prejudice the granting or maintenance of the European patent, such facts and evidence must be included in those examined by the EPO of its own motion pursuant to Art. 114(1). See D-V, 2, for the extent of substantive examination of the facts and evidence in opposition proceedings.

Art. 114(1)

1.2 Limits on the obligation to undertake examination

However, the obligation to undertake such examination 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 is not to be examined in opposition proceedings (G 1/91, see D-V, 2.2).

2. Facts, evidence or grounds for opposition not submitted in due time or arguments presented at a late stage

(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 116(1), refer primarily to III, 8.6.)

The EPO may disregard facts or evidence (e.g. publications) which are not submitted in due time by the parties concerned.

Art. 114(2)

This also applies to grounds for opposition not submitted in due time, together with supporting facts and evidence in opposition proceedings (see D-V, 2.2). Note in this respect that according to G 1/95 and G 7/95 (see OJ 11/1996, 615 and 626), Art. 100(a) does not constitute one single ground for opposition, but has to be considered a collection of individual grounds for opposition, i.e. individual legal bases for objection to the maintenance of a patent. This applies not only to distinctly different objections, such as subject-matter which is not patentable (Art. 52(2)) as compared to subject-matter which is not capable of industrial application (Art. 57), but also to an objection for lack of novelty as opposed to an objection for lack of inventive step.

New arguments based on facts, evidence and grounds constituting the legal and factual framework of the opposition cannot be disregarded.

In deciding whether to admit facts, evidence or grounds for opposition not filed in due time, their relevance to the decision, the state of the procedure and the reasons for belated submission are to be considered. If examination of late-filed grounds for opposition, late-filed facts or late-filed evidence reveals without any further investigation (i.e. **prima facie**) that they are relevant, i.e. that the basis of the envisaged decision would be changed, then the competent department has to take such grounds, facts or evidence into consideration no matter what stage the procedure has reached and whatever the reasons for belated submission. In that case, the principle of examination by the EPO of its own motion under Art. 114(1) takes precedence over the possibility of disregarding facts or evidence under Art. 114(2) (see T 156/84, OJ 10/1988, 372). Note, however, the limits on the obligation to undertake further examinations as set out in VI, 1.2. Otherwise, the department should inform the party concerned in the decision, with due regard to Art. 113(1) EPC (see T 281/00), that the facts, evidence and/or grounds for opposition were not submitted in due time and, since they are not relevant to the decision, will be disregarded pursuant to Art. 114(2). On the apportionment of any costs arising from the late filing of facts and evidence, see D-IX, 1.4.

The latest date up to which submissions can be considered at all is the date on which the decision is handed over to the EPO's internal postal service for transmittal to the parties (see G 12/91, 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

Following 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

Art. 115

Rule 114(1)

writing in English, French or German and must include a statement of the grounds on which they are based. That person may not be a party to the proceedings before the EPO.

Documentary evidence and, in particular, publications submitted in support of the arguments may be filed in any language. However, the EPO may request that a translation into one of its official languages be filed within a period to be specified; otherwise the evidence will be disregarded. Although the third party is sent acknowledgment of the receipt of his observations, the EPO does not inform him of any further action it takes in response to them. *Rule 3(3)*

The observations are communicated to the applicant or proprietor without delay and he may comment on them. If they call into question the patentability of the invention in whole or in part, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated, i.e. they must be admitted to 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 either are not disputed by the applicant or proprietor or are 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. *Rule 114(2)*

Chapter VII

Interruption and suspension of the proceedings

1. Interruption

1.1 Cases in which the proceedings may be interrupted

Proceedings before the EPO will be interrupted:

Rule 142(1)

- (i) in the event of the death or legal incapacity of the applicant for or proprietor of a European patent or of the person authorised by national law to act on his behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Art. 134, proceedings will be interrupted only on application by such representative; *Rule 142(1)(a)*
- (ii) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the EPO; or *Rule 142(1)(b)*
- (iii) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European patent or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the EPO. *Rule 142(1)(c)*

The parties will be informed of the interruption of the proceedings and the reasons for it.

1.2 Resumption of proceedings

When, in the cases referred to in VII, 1.1(i) and (ii), the EPO has been informed of the identity of the person authorised to continue the proceedings before the EPO, it will communicate to such person and to any interested third party that the proceedings are to be resumed as from a date to be fixed by the EPO. This date should be such that the person concerned has sufficient opportunity to become thoroughly familiar with the matter.

Rule 142(2)

In the case referred to in VII, 1.1(iii), the proceedings will be resumed when the EPO has been informed of the appointment of a new representative of the applicant or when the EPO has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, 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 will communicate to the applicant for or proprietor of the patent:

Rule 142(3)

- Rule 142(3)(a)* (i) where Art. 133(2) (mandatory appointment of a representative) is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified; or
- Rule 142(3)(b)* (ii) where Art. 133(2) is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

A copy of the communication will be forwarded to the other parties.

1.2.1 Resumption of time limits

Rule 142(4) 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 at the date of interruption of the proceedings, 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.

1.3. 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).

2. Stay of proceedings when entitlement proceedings are pending

Rule 14(1) If a third party provides proof to the EPO that he has opened proceedings against the applicant or proprietor for the purpose of seeking a judgment that he is entitled to the (grant of the) European patent, the EPO shall stay the proceedings unless the third party consents to the continuation of such proceedings. For further details see A-IV, 2.2 to 2.5 and D-VII, 5.1.

3. Stay of proceedings when a referral to the Enlarged Board of Appeal is pending

Where a referral to the Enlarged Board of Appeal is pending and the outcome of examination or opposition proceedings depends entirely on the decision of the Enlarged Board of Appeal, the proceedings will be stayed only upon request of at least one of the parties. Where the proceedings are not stayed, they will be decided according to existing practice (OJ EPO 10/2006, 538).

Chapter VIII

Time limits, loss of rights, further and accelerated processing and re-establishment of rights

1. Time limits and loss of rights resulting from failure to respond within a time limit

1.1 Determination of time limits

The EPC imposes time limits upon parties to proceedings.

Art. 120

Some of these are fixed by the articles of the EPC, e.g. Art. 87(1) (priority period), and Art. 99(1) (opposition). Others are fixed in the Implementing Regulations, e.g. in Rule 30(3) (payment of late-furnishing fee), Rule 38 (payment of filing and search fee), Rule 39(1) (payment of designation fees), Rule 58 (correction of deficiencies in application documents), Rule 70(1) (request for examination), Rule 71(3) (filing translations of the claims and payment of fees for grant and printing) and Rule 112(2) (applying for a decision after notification of loss of rights).

== Others take the form of a stipulated range, the precise period within this range being at the EPO's discretion.

In other cases, e.g. those dealt with in Rule 3(3) (filing translation of documentary evidence), or Rule 70(2) (invitation to the applicant to indicate whether he desires to proceed further with the European patent application), a period, but not its duration, is provided for in the EPC. The duration must be determined by the EPO in accordance with Rule 132 (see VIII, 1.2).

1.2 Duration of the time limits to be determined by the EPO on the basis of EPC provisions

The length of such periods 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 EPO it has been decided, as a general rule, to adopt a uniform practice with respect to time limits. This practice is at present as follows:

- (i) if deficiencies to be corrected are merely formal or merely of a minor character; if simple acts only are requested, e.g. under Rule 83 the subsequent filing of documents referred to by a party; or if observations are required on amendments which are merely of a minor character – two months;

- (ii) communications from an Examining or Opposition Division raising matters of substance – four months.

Rule 70(2)

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 if for example the subject-matter of the application or patent or the objections raised are exceptionally complicated. Where the applicant is invited to submit the indication provided for in Rule 70(2), a six-month time limit running from the publication of the search report is appropriate.

1.3 Time limits which may be freely determined

Time limits for operations in respect of which the setting of a time limit is not explicitly provided for in the EPC are not subject to the restrictions as to the duration of time limits laid down in Rule 132. They may be fixed by the EPO at its own discretion.

1.4 Calculation of time limits

Rule 131
Rule 126
Rule 134

Although Rule 131 allows other possibilities, any period fixed by the EPO will usually be specified in full months which will be calculated from the receipt of the communication by the person to whom it is addressed (see Rule 126(2)). Rule 131 gives precise details for the determination of the day of expiry of the period, whilst Rule 134 contains provisions covering certain contingencies, e.g. that the EPO 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 EPO and a Contracting State.

Rule 142

When proceedings have been interrupted because of the death of the applicant or proprietor or for any of the other reasons specified in Rule 142, time limits are subject to the provisions of Rule 142(4). The time limits for the payment of the examination fee and the renewal fees are suspended (see 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. 90(5)), any such time limits become determinable from the amended date of priority. This does not restore any loss of rights resulting from a time limit having already expired before the loss of priority date. Part A of the Guidelines deals with the procedure to be followed (see A-III, 6.9 to 6.11).

1.6 Extension of a time limit

Rule 132

Apart from the automatic extension of time limits under Rule 134 (see VIII, 1.4) and cases in respect of which the EPC specifies 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 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 4/1993, 229). No written confirmation is required for requests for extension of time limits filed by fax. 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 (see Notice of the Vice-President of the Directorate-General 2 of the EPO, OJ 5/1989, 180).

If the request for an extension 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).

If the request for extension of a time limit filed in good time has been rejected and the applicant considers this unjust, he can only overcome the ensuing loss of rights by requesting further processing under Art. 121(1) and Rule 135(1). 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).

Art. 106(2)

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 (Chronopost, Deutsche Post Express, DHL, Federal Express, LTA, TNT, SkyNet and 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 6/2003, 283). Rule 133 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 133, 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

Rule 133(1)

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 (updated 1 July 2009):

Albania, Andorra, Azerbaijan, Belarus, Bosnia and Herzegovina, Georgia, Moldova, Russian Federation, Serbia, Ukraine and 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) and Rule 55 the application will not be proceeded with; under Art. 90(5) the application will be refused or a right of priority lost; under Rule 5 a document may be deemed not to have been received. If the request for examination has not been filed in time, the application is deemed to be withdrawn (Art. 94(2)), and this sanction may also apply in those cases where the applicant fails to meet a time limit set by the EPO (e.g. the time limit for replying to an invitation to amend under Art. 94(3)).

If a particular time limit is not complied with and, in contrast to cases where mandatory legal sanctions are laid down (e.g. revocation of the European patent if the printing fee is not paid in due time (Rule 82(3)), no specific legal sanction is laid down in the EPC, submissions and requests from the parties made after expiry of the time limit but before a decision is handed over to the EPO's internal postal service for transmittal to the parties are to be regarded in the rest of the proceedings as if they had been received in time (see G 12/91, OJ 5/1994, 285); 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

1.9.1 Cases of loss of rights

Rule 112

If a party to the proceedings or a third party fails to comply with a time limit laid down in the EPC or fixed by the EPO, this will result in a loss of rights in certain cases specified in the EPC, without any decision concerning the refusal of the European patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence.

1.9.2 Noting and communication of loss of rights

Art. 119

Rule 112(1)

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).

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. *Rule 112(2)*

The competent department of the EPO will give such a decision only if it does not share the opinion of the person requesting it; otherwise it will inform the person requesting the decision and then continue with the proceedings. Since such decisions are subject to appeal, the reasons on which they are based must be stated. Only the person affected by the loss of rights noted will be party to the proceedings.

The request under Rule 112(2) for a review of the accuracy of the communication under Rule 112(1) exists in parallel to the legal remedies against the loss of rights. If the applicant fails to observe the time limit for requesting a decision under Rule 112(2), he may still apply for re-establishment of rights under Art. 122(1) and Rule 136(1) in respect of that time limit.

2. Further processing and re-establishment of rights

2.1 Request for further processing of the European patent application

If the European patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit vis-à-vis the European Patent Office, the application is allowed to proceed if the applicant makes a request for further processing of the application. Further processing must be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The omitted act must be completed within the period for making the request. The request is not deemed to have been filed until this fee has been paid. The department competent to decide on the omitted act also decides on the request for further processing. *Art. 121(1) and (2)*
Rule 135(1) and (3)

As a general rule, further processing is the legal remedy for failure to observe a time limit during proceedings before grant, even where the consequence is a partial loss of rights (e.g. loss of priority right). However, the possibility of requesting further processing is ruled out for the periods referred to in Art. 121(4) and Rules 6(1), 16(1)(a), 31(2), 36(1)(a) and (b), 40(3), 51(2) to (5), 52(2) and (3), 55, 56, 58, 59, 62a, 63, 64 and 112(2). *Rule 135(2)*

2.2 Re-establishment of rights

2.2.1 General remarks

An applicant for or proprietor of a European patent who, despite taking all due care required by the circumstances, was unable to *Art. 122(1)*

observe a time limit vis-à-vis the European Patent Office not specifically excluded by Art. 122(4) and Rule 136(3) may apply to have his rights re-established. According to Art. 122(4) and Rule 136(3), re-establishment of rights is ruled out in respect of all periods for which further processing is available and in respect of the period for requesting re-establishment of rights. Re-establishment applies to the time limit under Rule 135(1) for requesting further processing and also to the time limits which are excluded from further processing according to Art. 121(4) and Rule 135(2). This means that, where further processing applies to a time limit, re-establishment cannot be requested for failure to observe that time limit. However, if further processing is available, but the applicant fails to request it in time, re-establishment of rights according to Art. 122 is available for the time limit for requesting further processing. Moreover, re-establishment of rights is possible where an applicant fails to file his application within the priority period of Art. 87(1). The conditions governing this application are fully set out in Art. 122(1) to (6) and Rule 136(1) to (4). The provisions of Art. 122 and Rule 136 might be invoked if e.g. the applicant's working documents have been destroyed by fire and he has been obliged to prepare fresh ones; or if a specialist agency 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, J 31/89 and J 2/02, both not published in OJ).

Failure by an applicant to meet the time limit for filing the notice of appeal (Art. 108) cannot be remedied by further processing (Art. 121(4)); only re-establishment is available (Rule 136(3)).

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 G 1/86, OJ 10/1987, 447).

2.2.3 Relevant time limits

"Time limit" is 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. 122(1)

The following are examples of cases where re-establishment of rights may be possible in the event of failure to comply with a time limit. They concern the time limits for:

Rule 82(2) and (3)
Rule 88(3)
Art. 108
Art. 112a(4)
Art. 87(1)

- 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 in opposition proceedings;
- filing the request for a decision by the Opposition Division on the awarding of costs;
- appeals filed by applicants or patent proprietors (see XI, 6);
- filing a request for review by the Enlarged Board of Appeal; and
- claiming priority of an earlier first application according to Art. 87(1) (see A-III, 6.6).

2.2.4 Time limits not covered

Re-establishment of rights is expressly excluded as regards the time limit for requesting re-establishment of rights (see VIII, 2.2.1) and the time limits for which further processing is available (Art. 121). 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(4)
Rule 136(3)

2.2.5 Request for re-establishment of rights

The request for re-establishment of rights must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. As a general rule, the request is admissible within the year immediately following the expiry of the unobserved time limit. However, the time limit for requesting re-establishment of rights for the priority period or for filing a petition for review by the Enlarged Board of Appeal constitutes an exception to this general rule: in these cases, the request must be filed within two months of expiry of the relevant period laid down in Art. 87(1) and Art. 112a(4).

Rule 136(1)

The request must state the grounds on which it is based, and must set out the facts on which it relies. It is not deemed to be filed until

Rule 136(2)

after the fee for the re-establishment of rights has been paid in the amount laid down in the Rules relating to Fees under the EPC.

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

Rule 136(4)

The department competent to decide on the omitted act decides 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 faster search or examination can ask to have their applications processed under the programme for accelerated prosecution of European patent applications (PACE) (see the Notice from the EPO, Special edition No. 3, OJ EPO 2007, F.1).

4. Accelerated processing of oppositions

In cases where an infringement action in respect of a European patent is pending before a national court of a Contracting State, a party to the opposition proceedings may request accelerated processing. The request may be filed at any time. It must be filed in written reasoned form. In addition, the EPO will also accelerate the processing of the opposition if it is informed by the national court or competent authority of a Contracting State that infringement actions are pending (see the Notice from the President of the EPO dated 19 May 1998, OJ 7/1998, 361).

5. Accelerated processing before the Boards of Appeal

Parties with a legitimate interest may ask the Boards of Appeal to deal with their appeals rapidly. The Boards can speed up an appeal as far as the procedural regulations allow. Requests for accelerated

processing must be submitted to the competent Board either at the beginning of or during proceedings. They should contain reasons for the urgency together with relevant documents. This option is also available to the courts and competent authorities of the Contracting States (see the Notice from the Vice-President Directorate-General 3 dated 19 May 1998, OJ 7/1998, 362).

6. Renunciation of rights

6.1 Withdrawal of application or designation

The applicant may withdraw his application at any time up to the grant of the European patent (see also C-VI, 14.9), provided that no third party has proven to the EPO that he has initiated proceedings concerning entitlement to the application pursuant to Rule 15.

Rule 15



The same also applies to the withdrawal of a designation (see also A-III, 11.3.8). If all designations are withdrawn, the application is deemed to be withdrawn.

Art. 79(3)

Rules 39(2) and (3)

Withdrawal of the application in due time before the eighteen month publication has the advantage that the contents of the application do not become known to the public (see A-VI, 1.2). If, furthermore, no rights have been left outstanding and the application has not served as a basis for claiming a right of priority, a subsequent application for the same invention can be considered as the first application for the purposes of determining priority (see C-V, 1.4.1). If the examination fee has been paid, it will be refunded in full or in part (see A-VI, 2.5).

Art. 87(4)

6.2 Withdrawal of priority claim

The priority claim may also be withdrawn (see C-V, 3.5). If this is done before the technical preparations for publication of the application are completed, the publication will be deferred until 18 months after the date of filing of the European application (see A-VI, 1.1).

6.3 Statement of withdrawal

Any statement of withdrawal must be unqualified and unambiguous. It may, however, be conditional upon, e.g. avoidance of publication or refund of the examination fee.

6.4 Surrender of patent

A patent may not be surrendered in opposition proceedings by the proprietor filing a declaration of surrender with the EPO. Such a surrender must be declared before the competent authorities in the designated states in question (see D-VII, 6.1). Nevertheless, if a proprietor unambiguously declares to the EPO the surrender (or abandonment or renunciation) of the patent, this is deemed equivalent to a request that the patent be revoked (see also D-VIII, 1.2.5).

Rule 84(1)

Chapter IX

Applications under the Patent Cooperation Treaty (PCT)

1. General remarks

The EPO may act as a “designated Office” or an “elected Office” for an international application filed under the Patent Cooperation Treaty (PCT) designating “EP” (Euro-PCT application). Such application is thereby deemed to be a European application (Euro-PCT application) for the purposes of the EPC. However, in the case of Euro-PCT applications, the provisions of the PCT apply in addition to those of the EPC, and where there is conflict between them, e.g. in the case of certain time limits, the provisions of the PCT prevail. According to Art. 153(1)(a), the EPO acts as a designated Office for Contracting States to the EPC in respect of which the PCT has entered into force, which are designated in the international application and for which the applicant wishes to obtain a European patent. If the applicant has elected a designated State, the EPO is an elected Office (Art. 153(1)(b), for details see IX, 6.1).

Art. 153(1)(a) and (b)

Art. 153(2)

Art. 150(2)

In addition to being a designated Office, the EPO may act as a receiving Office under the PCT within the terms set out in Art. 151. Furthermore, it may also act as an International Searching Authority (ISA) or/and as an International Preliminary Examining Authority (IPEA) under the terms of Art. 152. There are thus the following possibilities for a European application filed under the provisions of the PCT:

Art. 151

Art. 152

- (i) the filing of the application and the international search take place at an office or offices other than the EPO (e.g. the Japan Patent Office). The EPO 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 files 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, a

designated Office or an elected Office. The EPO can, however, only act as an IPEA if the international search was carried out by the EPO, the Austrian, Spanish, Swedish or Finnish Patent Office or the Nordic Patent Institute.



In case (i), the European application will be accompanied by an international search report drawn up by another office. In cases (ii) and (iii), the international search report will be prepared by the Search Division of the EPO. In case (iv), 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

Art. 151

The EPO may act as a receiving Office when the conditions referred to in Art. 151 apply.

Rule 157(2)

Where the EPO acts as a receiving Office, the provisions of Rule 157(2) will apply to the international application and its related documents. The following documents must be filed with the EPO acting as receiving Office (Rule 157(2)): the request, the description, the claims, the abstract and the drawings, as well as 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). The President of the EPO may, however, decide that the international application and any related item be filed in more than one copy.

If an international application is filed by fax, the hard-copy application documents complying with the Rules and the Request (Form PCT/RO/101) should be forwarded simultaneously and the fax should state that such documents have been forwarded. Otherwise, the EPO will invite the applicant to supply such documents within a non-extendable period of one month (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3). To prevent duplication of files applicants are asked to indicate on the accompanying letter the fax date and to make it clear that the paper documents represent "confirmation of an application filed by fax".

Rule 157(1) and (3)

An international application for which the EPO is chosen by the applicant as the receiving Office must be filed directly with the EPO. An exception applies only where the applicant is obliged under the applicable national law of a Contracting State to file the international application concerned via a national authority (see Art. 75(2)). In that case, the national authority acts as intermediary ("filing office") of the EPO as receiving Office and is obliged to 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 international application and other documents relating to it may be filed electronically with the EPO as receiving Office.. Priority documents may be filed in electronic form only if they have been digitally signed by the issuing authority and the signature is accepted by the EPO (Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182).

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 work in accordance with the PCT Receiving Office Guidelines (see "PCT Resources" at www.wipo.int/pct/en/).

With regard to deadlines and procedural steps before the EPO as a receiving Office, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO - Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special Edition No. 3, OJ EPO 2007, C.1.

3. The EPO as an International Searching Authority (ISA)

3.1 General remarks

If the EPO acts as an International Searching Authority under the terms of Art. 152, it establishes the international search report in accordance with the PCT International Search and Preliminary Examination Guidelines and transmits it to the International Bureau (see Art. 16(1) and 18 PCT). The EPO also establishes a "written opinion of the International Searching Authority" (WO-ISA) (Rule 43bis PCT). The WO-ISA is transmitted to the IB together with the ISR. A copy of the ISR and, if applicable, the WO-ISA, is sent also to the applicant.

There is no possibility for a dialogue between the applicant and the EPO on the International Search Report (ISR) and the WO-ISA. However, in reaction to the ISR and WO-ISA, the applicant may file with the IB amended claims under Art. 19 PCT together with a brief statement explaining the amendments and indicating their likely effect on the description and drawings (see IX, 5.7). Further, the applicant may in response to the WO-ISA file "informal comments". Amendments under Art. 19 PCT and informal comments must be sent directly to the International Bureau.

A copy of the international search report, and if applicable, the WO-ISA 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, 5.7).

Art. 19(1) PCT

With regard to deadlines and procedural steps before the EPO as an International Searching Authority, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

3.2 Limitations

In accordance with the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (OJ 11/2007, 617), the EPO may limit its search work as an ISA. For information on the limitations of the competence of the EPO as ISA, see OJ 3/2009, 206 and B-VIII, 1.

4. The EPO as an International Preliminary Examining Authority (IPEA)

4.1 General remarks

Art. 152

The EPO may act as an International Preliminary Examining Authority under the terms of Art. 152.

When the EPO acts as an International Preliminary Examining Authority, the provisions of the PCT International Search and Preliminary Examination Guidelines will apply to the examination procedure.

*Art. 35 PCT
Rule 70 PCT*

An international preliminary examination report (IPER) 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).

With regard to deadlines and procedural steps before the EPO as an International Preliminary Examining Authority, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

Art. 33 PCT

The objective of the international preliminary examination according to Art. 33(1) PCT is 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 under the EPC (compare Art. 33(2), (3) and (4) PCT with Art. 54(1), 56 and 57 EPC).

Essential differences exist, however, between the procedures for international preliminary examination and the examination of European patent applications:

- (i) international preliminary examination does not lead to the grant of a patent or refusal of the application;
- (ii) for 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; and
- (iv) in accordance with the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (OJ 11/2007, 617), the EPO may limit its examination work as an IPEA. A limitation of the EPO's competence is applicable for applications relating to business methods filed by a US national or resident (OJ EPO 3/2009, 206). Further restrictions regarding the preliminary examination of applications relating to business methods follow from the application of Rule 67.1(iii) PCT and Rule 66.1(e) PCT.

4.2 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.

4a. Response to the WO-ISA, IPER or search opinion

Where the application is not subject to the preparation of a supplementary European search report (because the international search report and accompanying WO-ISA were prepared by the EPO - see B-II, 4.3), the applicant is sent an invitation according to Rule 161(1), inviting him to respond to the WO-ISA or, where applicable, the IPER prepared by the EPO in the international phase. Subject to certain exceptions, the applicant is required to reply within a period of one month (see C-VI, 3.5.1 for details).

Rule 161(1)

Rule 161(2)

Where the application is subject to the preparation of a supplementary European search report, the applicant will first be sent an invitation according to Rule 161(2) inviting him to amend the application within a period of one month. Thereafter, the supplementary European search report and accompanying search opinion will be prepared on the basis of the latest request filed by the applicant (see B-II, 4.3 and B-XII, 2). Subject to certain exceptions, the applicant is required by Rule 70a to respond to this search opinion (see B-XII, 9 and C-VI, 1.1.1 for details).

5. The EPO as a designated Office

5.1 General remarks

*Art. 153(1)(a)**Art. 4(1)(ii) PCT*

The EPO will act as a designated Office for those Contracting States to the EPC in respect of which the PCT has entered into force and which are designated in the international application, provided that the applicant informed the receiving Office in the international application that he wished to obtain a European patent for these States. The same applies if, in the international application, the applicant designated a Contracting State of which the national law provides that designation of that State has the effect of the application being for a European patent. The EPO is automatically designated in all international applications filed as of 1 January 2004 (Rule 4.9 PCT).

With regard to deadlines and procedural steps before the EPO as a designated Office, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide and amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

Rule 159(1)

In order to initiate the European phase before the EPO acting as a designated Office, the requirements for entry into the European phase according to Rule 159(1) must be complied with (see A-VII, 1.2 and 1.3), as must the requirements of Rule 161(1) (see IX, 4a). For entry into the European phase, applicants are strongly recommended to use Form 1200, downloadable from the EPO website. The use of Form 1200 is particularly important where the applicant files amendments in response to the WO-ISA or IPER prepared by the EPO (either in the international phase or on entry into the European phase) and in so doing wishes to avoid having to respond to the communication according to Rule 161(1) (see C-VI, 3.5.1).

5.2 Communication to the EPO as a designated Office

*Art. 20(1)(a) PCT**Rule 44bis.2 PCT*

A copy of the application together with the international search report or a declaration in accordance with Art. 17(2)(a) PCT is communicated by the International Bureau to the EPO as a designated Office in accordance with Art. 20(1)(a) PCT. Furthermore, the EPO does not require the applicant to furnish a copy of the international application (Rule 49.1(a-bis) PCT). The EPO as a

designated Office will then examine the application for compliance with the requirements of the EPC (see in particular A-VII).

The International Bureau shall communicate the International Preliminary Report on Patentability (Chapter I of the PCT) and any informal comments received from the applicant to the EPO as designated Office at 30 months from the priority date.

5.3 Publication of the translation of the international application

The international publication of a Euro-PCT application in an official language of the European Patent Office takes the place of publication of the European patent application and will be mentioned in the European Patent Bulletin. If the international publication of the Euro-PCT application is in another language, a translation into one of the official languages must be filed with the EPO within 31 months of the priority date (Art. 22(1) PCT and Rule 159(1)(a)). The EPO will publish the translation.

*Art. 153(3) and (4)
Rule 159*

If the translation is not supplied, the application is to be deemed withdrawn (Art. 24(1) PCT, Rule 160(1)). Furthermore, in this case, the application which has been published under the PCT is not considered as comprised in the state of the art in accordance with Art. 54(3) (see C-IV, 7.2). However, if the EPO finds that the application is deemed to be withdrawn because the translation was not filed in due time, it must first communicate this to the applicant (Rule 160(3)). Rule 112(2) applies *mutatis mutandis*. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation is supplied, a request for further processing under Art. 121 and Rule 135(1) is filed, and the fee for further processing is paid.

Rule 160(1)

5.4 Supplementary European search report

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 European search report, except where the Administrative Council has decided otherwise, as described in B-II, 4.3. For international applications filed as of 1 July 2005, this supplementary European search report is also accompanied by a search opinion under Rule 62(1). Where a supplementary European search report accompanied by a search opinion is drawn up on or after 1 April 2010, the applicant is required to respond to it (see B-XII, 9).

Art. 153(7)

Hence, the application will reach the Examining Division containing either one or two search reports, which must be taken into consideration during the examination along with any comments or amendments filed in response thereto.

5.5 Delaying of the procedure before the EPO

Art. 23 PCT
Rule 44bis.2 PCT

When acting as a designated Office, the EPO must not process or examine an international application before expiry of the period applicable under Art. 22 PCT (Art. 23(1) PCT). However, the EPO may, on the express request of the applicant, process or examine an international application at any time (Art. 23(2) PCT). The applicant may request the International Bureau to communicate a copy of the Written Opinion established by the International Searching Authority to the EPO as designated Office once a request under Art. 23(2) PCT is made.

5.6 Review by the EPO as a designated Office

Rule 159(2)

The EPO may decide, in accordance with Art. 25 PCT, to allow an international application deemed to be withdrawn, or not accorded a filing date, to proceed as a European application. 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 Art. 25(1)(a) PCT to the Examining Division. Where it is decided that the application can proceed as a European application, the search and examination is carried out as for other applications 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.

5.7 Examination and processing

Substantive examination of a Euro-PCT application is carried out as for any other European application, taking account of some specific provisions.

Art. 19(1) PCT

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, 9.4, and VI, 3.5.1, as well as B-XII, 9 for cases where a supplementary European search report is accompanied by a search opinion).

Art. 28 PCT
Rule 159(1)(b)
Rule 161

The examination must be conducted in accordance with Art. 28 PCT, which stipulates that the applicant must be given the opportunity to amend the claims, the description, and the drawings within a time limit prescribed pursuant to Rule 52.1(b) PCT (see also Rules 159(1)(b) and 161 and IX, 4a).

Rule 164(2)

If the Examining Division considers that the application documents which are to serve as basis for the European grant procedure do not meet the requirements of unity of invention, or if protection is sought for an invention not covered by the international search report (or, where a supplementary European search report has been established, by that report), it must invite the applicant to limit the

application to one invention covered by the international (or the supplementary European) search report.

- ⊞ If after receipt of the (supplementary) European search report the applicant files amended claims relating to an invention which differs from any of the originally claimed inventions and which does not combine with these inventions to form a single inventive concept, an objection under Rule 137(5) should be raised in the first communication pursuant to Art. 94(3) and Rule 71(2) (see also C-III, 7.11 and C-VI, 5.2(ii)). *Rule 137(5)*
- ⊞

5.8 Inspection of files

In its capacity as a designated Office, the EPO also allows access to its files pertaining to the international phase of applications, provided that international publication has taken place. The above applies mutatis mutandis to the communication of information from the files. *Art. 30(2) PCT*

6. The EPO as an elected Office

6.1 General remarks

The EPO will act as an elected Office if the applicant has filed a demand for international preliminary examination and has elected at least one Contracting State of the EPC which is designated in the international application and is bound by Chapter II PCT and for which a European patent is sought. The EPO will be automatically elected in all demands filed as of 1 January 2004. 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, 4). 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 and IX, 4.2). *Art. 153(1)(b)*

With regard to deadlines and procedural steps before the EPO as an elected Office, see the latest version of the Guide for applicants: "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT". For applications concerning nucleotide or amino acid sequences, see A-VII, 4.2 and Special edition No. 3, OJ EPO 2007, C.1.

6.2 Opening of the European 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). European substantive examination must normally not 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).

In order to initiate the European phase before the EPO acting as an elected Office, the requirements for entry into the European phase *Rule 159*

according to Rule 159 must be complied with (see A-VII, 1.2 and 1.3). For entry into the European phase, applicants are strongly recommended to use Form 1200, downloadable from the EPO website.



6.3 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 (see IX, 5.7). 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 PCT). The application will also be accompanied by a translation of the annexes, transmitted by the applicant, in the same language into which the international preliminary examination report was translated (Art. 36(3)(b) PCT).

Art. 41 and 42 PCT

The examination must be conducted in accordance with Art. 41 and 42 PCT, which stipulate that:

Rule 159(1)(b)
Rule 161

- (i) the applicant must be given the opportunity to amend the claims, the description, and the drawings within a time limit prescribed pursuant to Rule 78.1(b) or 78.2 PCT (see also Rules 159(1)(b) and 161); and
- (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.

6.3.1 Comparative test results

Where the EPO has established the IPER and refers therein to the submission of test reports, the applicant is taken to agree to the use of these reports as the basis for proceedings before the EPO when he uses the standard form for entry into the European phase before the EPO as elected Office, i.e. Form 1200. If the latter is not used or the IPER – referring to the test reports – was established by another International Preliminary Examination Authority, the applicant is invited to submit these reports for the European application.

6.3.2 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 European phase. New documents (claims,

description, drawings) submitted during the international preliminary examination and replacing the earlier filed documents will be attached to the international preliminary examination report. If the documents attached to the international preliminary examination report are in a language other than the language of the proceedings of the European application in the European phase, the applicant must be requested to file the documents in the language of the proceedings within a fixed period.

The applicant may also request that the examination be based on the documents in the international application as published or on amendments made on entry into the European phase. If the declarations of the applicant are unclear in this respect, the examiner will have to clarify the situation.

6.3.3 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, it is to be regarded as an opinion for purposes of examination, and generally the first communication will be based on the opinion expressed in the IPER and the applicant's response to it filed in accordance with Rule 161(1) (if applicable, see C-VI, 3.5.1). Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence (e.g. if further prior art documents are to be cited or if evidence is produced of unexpected effects), where the substantive patentability requirements under the PCT and the EPC are different, where the applicant provides convincing arguments, appropriate amendments or relevant counter-evidence in his response to the IPER according to Rule 161(1), or conversely where the applicant provides amendments in response to the IPER which introduce further deficiencies.

Examination reports drawn up by other International Preliminary Examining Authorities must be examined carefully. If the reasons put forward in the international preliminary examination report are sound, they must not be disregarded.

6.4 Inspection of files

In its capacity as elected Office the EPO allows access to its files (including the entire PCT Chapter II file) relating to the international phase of applications filed on or after 1 July 1998, provided international publication has taken place and, as far as the PCT Chapter II file is concerned, the IPER has been completed. The above applies mutatis mutandis to the communication of information from the files.

Rule 94.3 PCT

Chapter X

Decisions

1. Basis of decisions

1.1 General remarks

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.

Art. 113(1)

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 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 the proprietor of the patent in particular is given sufficient opportunity to defend himself and, similarly, if the oppositions are to be rejected or if, despite the claims of the opponents, the patent is to be maintained in amended form, the opponents in particular should be given the same opportunity.

1.2 Examples

The right to be heard is a right not just to present comments but also to have those comments duly considered. Amendments submitted by a party need to be considered, and the party must be given an opportunity to comment on the grounds and evidence brought forward by the Examining Division (see T 1123/04). A document should not be cited for the first time in a decision (see T 635/04) unless it has been introduced during oral proceedings. If a case is remitted from the Boards of Appeal for further prosecution, the Examining Division must check whether requests from examination proceedings prior to the appeal are still outstanding and must give the party an opportunity to comment (see T 1494/05). If the facts and grounds essential to a decision have been submitted by one party and if the party whose case is to be rejected has been afforded sufficient time to comment, the principle concerning the right to 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 prior art newly designated in the opposition

proceedings will be considered in conjunction with the prior art described in the introductory part of an independent claim. However, if new facts and grounds are introduced during the proceedings or if the facts and grounds on which the envisaged decision is to be based were not stated so unambiguously and clearly in the written submissions of the parties as to give a party occasion to comment, the party concerned must be given an opportunity to submit an opinion and to produce evidence before the decision is given.

2. Consideration of time limits

A decision may not be given until any time limit set has expired, unless all the parties affected by the time limit expressly agree that it need no longer be observed or have submitted their final opinions before it expires. The decision to grant a patent may be given once the applicant is deemed to have approved the text submitted to him under Rule 71(3) and has fulfilled all other formal requirements, even if the time limit set in the Rule 71(3) communication has not yet expired.

Moreover, as a rule, decisions 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.

3. Authoritative text of documents

Art. 113(2)

The EPO must decide upon the European patent application or the European patent only in the text submitted and agreed by the applicant or proprietor and last used as a basis for the proceedings. Consequently, for example, an amended version proposed by the Examining or Opposition Division (see C-VI, 14.1 and 14.2 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 or proprietor.

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 or proprietor within the meaning of Art. 113(2) (see T 234/86, OJ 3/1989, 79), and therefore must be dealt with in the order indicated or agreed to by the applicant or proprietor, up to and including the highest-ranking allowable request, if any.

When considering such requests it is essential that they are treated in the correct order. Thus, for instance, if the only allowable request is an auxiliary request, but is accompanied by a higher auxiliary request for oral proceedings (e.g. a request that oral proceedings be held if

the main request cannot be granted) then a communication under Rule 71(3) could not be issued on the basis of the allowable request, but instead oral proceedings in accordance with the higher request would have to be appointed, or a further communication under Rule 71(1) issued (see X, 5). If the order of the requests is not clear from the applicant's submissions, then it would be necessary to contact the applicant to clarify the situation before proceeding.

4. Written form of decisions

4.1 General remarks

Decisions are to be produced in writing. The same applies to decisions delivered at the end of oral proceedings (see III, 9). *Rule 111(1)*

No complete rules can be laid down about the form and content of decisions, which will depend on the requirements of each particular case.

The written decision will contain:

- the names of the parties to the proceedings (applicant, proprietor, opponents) and, if applicable, their representatives;
- the order, and, if necessary;
- the facts and submissions;
- the reasoning;
- the communication of the possibility of appeal (Rule 111(2)); and
- the signature(s) and the name(s) of the employee(s) responsible. *Rule 113(1)*

If the decision is produced by the employee responsible using a computer, the EPO seal may replace the signature. If it is produced automatically by a computer the employee's name may also be dispensed with (Rule 113(2)). 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 to grant, which is based on the documents that the applicant has approved (Rule 71(3)). The same applies when the patent is maintained in an amended form, because this is preceded by a final interlocutory decision pursuant to Art. 106(2) concerning the documents on which the maintenance of the patent is to be based (see D-VI, 7.2.2). In individual cases, consideration may also be given to the reasoning of those decisions which merely meet

the requests of the parties. If, for example, a number of reasons are invoked for a request for re-establishment, of which only one justifies re-establishment, a reasoned decision on re-establishment may be appropriate, in order to clarify the official action.

Even in those cases in which the decision contains no communication of the means of redress, an appeal can be filed if the decision is incorrect, e.g. if the grant was not made on the basis of the documents that the applicant had approved.

4.2 Order

The order may be, for example, as follows:

"The European patent application ... is hereby refused pursuant to Art. 97(2) EPC.";

"The opposition to the European patent ... is hereby rejected."; or

"The request for re-establishment of rights is hereby rejected".

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 clearly indicate what is the subject of the application and show on which documents (in particular 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 3(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" or "according to the state of the file", e.g. when all arguments have been sufficiently put forward in the proceedings and the applicant is interested in a speedy appealable decision. 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.

5. Reasoning of decisions

The reasoning must contain, in logical sequence, those arguments which justify the order. 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.

Art. 113(1)

Rule 111(2)

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 reasoning.

The need for complete and detailed reasoning is especially great when dealing with contentious points which are important for the decision; on the other hand, no unnecessary details or additional reasons should be given which are intended to provide further proof of what has already 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(2) 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 71(3) 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 71(3), maintain higher-ranking requests which are not allowable, a decision to refuse the application pursuant to Art. 97(2) 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. If the text of the requests maintained is not amended compared to that on file when the communication under Rule 71(3) was issued, then the requirement of Rule 71(4) for filing of translations and payment of fees does not apply. These matters are also dealt with in Legal Advice No. 15/05 (rev. 2), OJ 6/2005, 357.

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 EPC and, additionally, the reasons why the higher-ranking requests do not.

Insofar 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 all 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.

Rule 116
Rule 137(3)

If an Examining or Opposition Division has exercised its discretion under Rule 116 to refuse late-filed facts, evidence or requests, its decision must give the reasons for its refusal. A mere reference to the discretionary power given under Rule 116 is not sufficient. The same applies to the exercise of an Examining Division's discretion to refuse amendments under Rule 137(3) (see T 755/96, OJ 4/2000, 174).

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 on a number of separate reasons, in order to come as early as possible to a final decision in a case. Therefore an Examining or Opposition Division should deal with those questions which may be expected to become relevant at 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 – interlocutory decisions

Art. 106(2)

Interlocutory decisions may be given in principle. However, it should be borne in mind that pursuant to Art. 106(2), 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.

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 is bound by the ratio decidendi of the Board of Appeal, insofar as the facts, e.g. the subject-matter of the patent and the relevant state of the art, are the same.

Art. 111(2)

An Opposition Division is not bound by a decision of a Board of Appeal on appeal against a decision from an Examining Division (see T 167/93, 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.

8. Information as to means of redress

Decisions of the EPO which are open to appeal must be accompanied by a written communication of the possibility of appeal. The communication must also draw the attention of the parties to the

Rule 111(2)

provisions laid down in Art. 106 to 108 and Rules 97 and 98, the text of which must be attached. The parties may not invoke the omission of the communication.

9. Notification

Art. 119

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 139. For the latter, see A-V, 3 and C-VI, 5.4. 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 140

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 replacements 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

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. At this stage of the proceedings the department of first instance is still competent.

Art. 23(3)

Art. 109

Appeals shall lie from decisions of the Receiving Section, Examining Divisions, Opposition Divisions and the Legal Division.

Art. 106(1)

An appeal has suspensive effect. This means that decisions may not yet become final and their effects are suspended. As the decision may not then be enforced, the following do not take place: entry in the Register of European Patents, mention in the European Patent Bulletin and, where appropriate, publication of a new specification of the European patent.

2. Appeals after surrender or lapse of the patent

An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States.

Rule 98

3. Appeals against the apportionment of costs

The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. 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.

Rule 97(1)

4. Appeals against the decision of the Opposition Division on the fixing of costs

In accordance with Rule 97(2), the decision of the Opposition Division fixing the amount of costs of opposition proceedings may be appealed if the amount is in excess of the fee for appeal.

Rule 97(2)

Art. 13 RFees

5. Persons entitled to appeal and to be parties to appeal proceedings

Any party to proceedings adversely affected by a decision may appeal. Any other parties to the proceedings are parties to the appeal proceedings as of right.

Art. 107

6. Time limit and form of appeal

Notice of appeal must be filed with the EPO within two months of the date of notification of the decision appealed from. The notice is not deemed to have been filed until after the fee for appeal has been paid in the amount laid down in the Rules relating to Fees under the EPC.

Art. 108

Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed.

7. Interlocutory revision

7.1 General remarks

Art. 109(1)

If the department whose decision is contested considers the appeal to be admissible and well founded, it must rectify its decision. This does not apply where the appellant is opposed by another party to the proceedings.

The obligation or possibility of rectification may thus arise in connection with a decision by the Receiving Section, the Legal Division 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.

Art. 109(2)

After receipt of the statement of grounds, only three months are available for rectification of the decision by the department of the first instance. That department must therefore consider the appeal with the highest priority and start the examination on admissibility immediately, and if the appeal is considered admissible in the form in which it has been filed, the competent department will start its examination on allowability immediately.

The department concerned will rectify its decision if convinced in the light of the grounds of appeal that the appeal is admissible and well founded. This could arise, for example, because:

- (i) the department failed to take due account of some of the material available to it at the time the decision was made;
- (ii) the department did not receive material filed at the EPO in due time before the issue of the decision, owing to an office error; or
- (iii) the decision of the department concerned does not appear to be incorrect, but the applicant presents new information or evidence or files amendments to the application, which overcome the objections of the decision under appeal (see T 139/87, OJ 3/1990, 68).

Hence, in 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). The new objections may make it necessary to issue a further communication and/or to arrange for oral proceedings before a further decision is taken (see T 691/91 and T 919/95, neither published in OJ).

For the advantages of a decision covering more than one objection, see X, 5, last paragraph.

7.2 Remittal to the Board of Appeal

If the appeal is not allowed within three months after receipt of the statement of grounds, it must be remitted to the competent Board of Appeal without delay, and without comment as to its merit.

Art. 109(2)

7.3 Reimbursement of appeal fees

In the event of interlocutory revision, reimbursement of appeal fees will be ordered by the department whose decision has been impugned if such reimbursement is equitable by reason of a substantial procedural violation. This is particularly the case when essential facts or evidence were not taken into consideration in arriving at a decision, e.g. where a document filed at the EPO in good time by the party concerned is not placed in the file before a decision is reached or where the decision is based on facts or evidence on which the party concerned had no opportunity of presenting his comments.

Rule 103(1)(a)

Art. 109

If the decision is rectified by an interlocutory revision not because of any substantial procedural violation but e.g. because the party concerned submits amendments at the time of filing the appeal, there will be no reimbursement of appeal fees.

If the department whose decision is contested considers the requirements of Art. 109 for interlocutory revision to be fulfilled, but not the requirements of Rule 103(1)(a) for reimbursement of the appeal fee, it must rectify its decision and remit the request for reimbursement of the appeal fee to the board of appeal for a decision (see J 32/95, OJ 12/1999, 713).

The request for reimbursement of the appeal fee will be remitted to the board of appeal only if it was filed together with the appeal (see G 3/03 and T 21/02)

Where amendments have been filed (i.e. interlocutory revision must be carried out) but a substantial procedural violation has occurred, the appeal fee is to be reimbursed, even if this was not explicitly requested by the appellant (see G 3/03).

8. Rules of Procedure for the departments of second instance

Details of the procedure before the Boards of Appeal can be found in the Rules of Procedure of the Boards of Appeal (OJ 3/2003, 89). The Enlarged Board of Appeal has also adopted Rules of Procedure (OJ 5/2007, 303).

Chapter XII

Request from a national court for a technical opinion concerning a European patent

1. General

At the request of the competent national court trying an infringement or revocation action, the EPO is obliged, against payment of an appropriate fee, to give a technical opinion concerning the European patent which is the subject of the action. The Examining Divisions are responsible for the issue of such opinions. *Art. 25*

Only requests from a national court in a Contracting State will be accepted by the EPO. It is not, however, up to the EPO to check whether the requesting court is "competent" to deal with the action or not. The Examining Division, however, should check whether a European patent is the "subject of the action".

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.

The technical opinion is not a decision of the EPO. The parties to the national proceedings therefore have no right of appeal before the EPO against an unfavourable opinion.

2. Scope of the technical opinion

The Examining Division is obliged to give a "technical opinion" upon request. This means that the Division is bound to give an opinion only 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.

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 substantive 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).

A request from a national court is to be expected to be clearly and precisely formulated, so that the Examining Division will be in no doubt as to the questions on which the court wishes to have an opinion. Since the court is responsible for deciding the issues of law involved in the questions and since most questions include a mixture of legal and technical aspects, the court is expected where possible to separate clearly the legal aspects from the technical aspects upon which it seeks the opinion of the EPO.

3. Composition and duties of the Examining Division

3.1 Composition

The composition of the Examining Division to which the request is referred must be as defined in Art. 18(2). This means that the Division must include three technical examiners; normally a legally qualified examiner will also be included. The main responsibility for dealing with the request up to the time of formulating the opinion is entrusted to one technical examiner, hereinafter referred to as the "primary examiner".

In order to guarantee that the opinion given is not influenced by earlier proceedings within the EPO on the application/patent in question, examiners who have taken part in such earlier proceedings as members of an Examining or Opposition Division 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.

3.2 Duties

The primary examiner will act on behalf of the Examining Division and will normally be responsible for issuing communications to the court. The primary examiner 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

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).

Regarding documents to be used as evidence, the provisions of Rule 3(3) apply (see A-VIII, 3).

The court or the parties are responsible for providing any translations which may be required to satisfy the above conditions.

5. Procedure

It is envisaged that the procedure will normally involve the following stages.

5.1 Formalities check

The formalities officer will check whether the fee has been paid and whether there are any obvious deficiencies as to the language requirements. If there are any deficiencies in these respects, the formalities officer will write to the national court informing it that no substantive work on the opinion will begin until the deficiencies have been remedied. However, no time limit can be imposed on the court.

Art. 2, No. 20, RFees

If the file indicates that the court permits the parties to submit written arguments to the EPO and such arguments are not already on the file, the formalities officer will write via the court to the parties giving them a time limit (say two months) for submitting such arguments.

5.2 Preliminary examination

When the formal requirements have been met, and, where appropriate, the arguments of the parties are on file, the case will be referred to the directorate responsible for the technical field of the patent in order for the Examining Division to be established. Assuming that an Examining Division consisting entirely of new members can be formed or, where this is not possible, that the court maintains its request for a technical opinion (see XII, 3), the primary examiner will perform a preliminary examination to determine whether:

- (i) the questions put by the national court are such as the Examining Division is competent to answer, at least in part; and
- (ii) the papers filed are sufficiently complete and the necessary translations have also been filed.

If there are any deficiencies in these respects, the primary examiner will write to the national court accordingly.

5.3 Withdrawal of the request

If the request for a technical opinion is withdrawn before the Examining Division starts any substantive work on the opinion, 75% of the fee will be refunded.

Art. 10 RFees

5.4 Establishment and issue of the technical opinion

After any deficiencies as referred to in XII, 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 File inspection

The file of a request for a technical opinion is not a file within the meaning of Art. 128 and is not available for file inspection.

5.6 Appearance before the national court

If, after the opinion is issued, the national court asks the Examining Division to appear before it, the court should be informed that the EPO 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

A European patent application may be transferred for one or more of the designated contracting states. *Art. 71*

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. *Rule 22(1) and (2)*

Any kind of written evidence suitable to prove the transfer is admissible. A declaration signed by both parties is appropriate, but a declaration of transfer signed by the assignor would in any case be sufficient, as the assignee will in any case 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.

If the evidence presented is found to be unsatisfactory, the EPO informs the party requesting the transfer accordingly, and invites it to remedy the stated deficiencies.

If the request complies with the requirements of Rule 22(1), the transfer is registered with the date on which the request, the required evidence or the fee has been received by the EPO, whichever is the latest.

On the above date, the transfer becomes effective vis-à-vis the EPO, i.e. from that date the newly registered applicant is entitled to exercise the right to the European patent application in proceedings before the EPO (Art. 60(3)). If the transfer was for certain designated states only, Art. 118 applies. *Rule 22(3)*

The competent department for adverse decisions regarding entries in the Register of European Patents is the Legal Division. *Art. 20*

2. Transfer of the European patent

The above applies mutatis mutandis to the registration of a transfer of the European patent during the opposition period or during opposition proceedings. *Rule 85*

3. Licences and other rights

Art. 71
Art. 73
Rule 23(1)
Rule 24(a) and (b)

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 22(1) and (2) apply mutatis mutandis to the registration of the grant, establishment or transfer of such rights (see XIII, 1).

A licence will be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require. A licence will be recorded as a sub-licence where it is granted by a licensee whose licence is recorded in the Register of European Patents.

Rule 22(2)
Rule 23(2)

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 must be entered in the Register on production of supporting evidence (e.g. copy from the commercial register).