Europäisches Patentamt
European Patent Office
Office européen des brevets

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 A

Guidelines for Formalities Examination

Contents

Chapter III – Examination of formal requirements III-1

Chapter I

Introduction

1. Overview

This Part A of the Guidelines deals with the following:

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

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

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

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

(v) fee questions (Chapter XI);

(vi) inspection of files, communication of information contained in files, consultation of the Register of European Patents and issuance of certified copies (Chapter XII).

2. Responsibility for formalities examination

Rule 10
Rule 11(3)

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

3. Purpose of Part A

The formalities staff should note that this Part A of the Guidelines is intended to provide them with the knowledge and background which it is felt will assist them in carrying out their functions in a uniform and expeditious manner. It does not, however, provide authority for ignoring the provisions of the EPC and in that regard specific attention is directed to paragraph 3.2 of the General Part of the Guidelines.

4. Other Parts relating to formalities

It is not the intention that the formalities staff should concern themselves with only this Part A of the Guidelines. It is expected that

they will have to refer frequently to the other Parts and in particular Part E.

Chapter II

Filing of applications and examination on filing

1. Where and how applications may be filed

1.1 Filing of applications by delivery by hand or by post

European patent applications may be filed in writing, by delivery by hand, by post or by technical means of communication (see II, 1.2 and 1.3) at the EPO's filing offices in Munich, The Hague or Berlin. The EPO's sub-office in Vienna is not a filing office.

Art. 75(1)
Rule 35(1)
Rule 2(1)

The opening hours of the filing offices of the EPO were published in the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.2. Dates on which at least one of the filing offices of the EPO is not open to receive documents are likewise announced at regular intervals in the Official Journal of the EPO (see also E-VIII, 1.4).

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

European patent applications (with the exception of divisional applications, see IV, 1.3.1, and applications according to Art. 61(1)(b), see IV, 2.7) may also be filed at the central industrial property office or other competent authority of a Contracting State if the national law of that State so allows (see II, 1.7).

1.2 Filing of applications by fax

Applications may also be filed by fax with the filing offices of the EPO or with the competent national authorities of those Contracting States which so permit, namely – at present – Austria (AT), Belgium (BE), Bulgaria (BG), Czech Republic (CZ), Denmark (DK), Finland (FI), France (FR), Germany (DE), Greece (GR), Iceland (IS), Ireland (IE), Liechtenstein (LI), Luxembourg (LU), Monaco (MC), Poland (PL), Portugal (PT), Slovakia (SK), Slovenia (SI), Spain (ES), Sweden (SE), Switzerland (CH) and United Kingdom (GB). For further details, see the latest version of the brochure "National Law relating to the EPC".

Where a document transmitted using such technical means is illegible or incomplete, the document is to be treated as not having been received to the extent that it is illegible or that the attempted transmission failed and the sender must be notified as soon as possible (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3).

Art. 90(5)

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

1.3 Filing of applications in electronic form

European patent applications and international (PCT) applications may be filed with the EPO in electronic form either **online** or on **electronic data carriers** (see the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182). At present, the data carriers permitted are CD-R as per ISO 9660 and DVD-R or DVD+R (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.5). Documents making up a European or an international patent application in electronic form must be prepared using either the epoline® Online Filing software or the PaTrAS software, both of which include the Request for Grant Form, unless the use of other software is permitted (see Art. 5 of the Decision of the President dated 26 February 2009, OJ EPO 3/2009, 182, Art. 2 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.5, and the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.6).

Other documents may also be filed electronically in grant, opposition, limitation, revocation and appeal proceedings (see the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182).

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

1.4 Filing of applications by other means

As of 1 January 2003 European patent applications may no longer be filed with the EPO on **diskette** accompanied by a paper version prepared by means of the **EP-EASY** software (see the Notice from the EPO dated 1 October 2002, OJ 10/2002, 515). This applies also to the filing of European patent applications with the filing offices of Belgium (BE), Finland (FI), France (FR), Sweden (SE), Switzerland (CH) and the United Kingdom (GB).

The filing of European patent applications by other means such as **e-mail** is at present not allowed (see also the Notice dated 12 September 2000, OJ 10/2000, 458).

1.5 Subsequent filing of documents

For the subsequent filing of documents, see IX, 2.5 and II, 1.3, second paragraph.

1.6 Debit orders for deposit accounts held with the EPO

European patent applications and international (PCT) applications may be accompanied by a debit order for the fees due. To avoid the risk of payment being debited twice where a debit order is sent by fax, the original should not be filed subsequently (see points 6.2, 6.9 and 6.10 of the Arrangements for deposit accounts, Supplement No. 1 to OJ 3/2009). For the abolition of payments by cheque, see A-XI, 2.

Points 6.2, 6.9 and 6.10 ADA

1.7 Forwarding of applications

The central industrial property office of a Contracting State is obliged to forward to the EPO, in the shortest time compatible with national law concerning the secrecy of inventions, applications filed (see II, 3.2) with that office or with other competent authorities in that State (for debit order enclosures, see II, 1.6).

Art. 77(1)
Rule 37(1)

A time limit of six weeks after filing is specified for the onward transmission to the EPO of applications the subject-matter of which is obviously not liable to secrecy, this time limit being extended to four months or, where priority has been claimed, to fourteen months after the date of priority, for applications which require further examination as to their liability to secrecy. It should be noted, however, that an application received outside the specified time limits, either six weeks or four months, must be processed provided the application is received in Munich, The Hague or Berlin before the end of the fourteenth month after filing or, where appropriate, after the date of priority. Applications received outside this last mentioned time limit are deemed to be withdrawn. Re-establishment of rights and further processing in respect of the period under Rule 37(2) are not possible, since the loss of rights does not result from a failure of the applicant to observe a time limit (see J 3/80, OJ 4/1980, 92), but a request for conversion under Art. 135(1)(a) may be filed (see IV, 6).

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

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

Rule 134(2)

1.8 Application numbering systems

1.8.1 Applications filed before 1 January 2002

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

The application number consists of nine digits. The first two digits (from left to right) of the application number indicate the filing year. The last

(ninth) digit is a check digit. The third digit or third and fourth digits of the application number indicate(s) the place of filing.

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

International applications filed under the Patent Cooperation Treaty (PCT), and designating "EP" (Euro-PCT applications) receive the digit "9" as the third digit or the digits "27" as the third and fourth digits.

1.8.2 Applications filed on or after 1 January 2002

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

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

The above also applies to international applications designating "EP" (Euro-PCT applications), albeit that for these applications a dedicated range for the above-mentioned six-digit number within the application number is used, which does not reflect the place of filing.

A list of the number ranges currently in use, along with, where appropriate, the corresponding places of filing, is published in OJ 10/2001, 465.

2. Persons entitled to file an application

Art. 58

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

Art. 60(3)

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

Art. 59
Art. 118

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

If it is adjudged that a person other than the applicant is entitled to the grant of a European patent that person has the option of prosecuting the application as his own application in place of the applicant (see IV, 2). *Art. 61(1)*

3. Procedure on filing

3.1 Receipt; confirmation

The authority with which the application is filed – either the EPO (Munich, The Hague or Berlin) or the competent national authority – must mark the documents making up the application with the date of receipt and issue a receipt to the applicant (for the date of receipt of applications received by fax see Art. 5 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3). The receipt must be issued without delay and include at least the application number, the nature and number of the documents and the date of their receipt. The receipt should also include the applicant's or representative's file reference number or any other information which would be helpful in identifying the applicant. The receipt of European patent applications filed online will be acknowledged electronically during the submission session. Where it becomes apparent that such acknowledgment was not successfully transmitted, the authority with which the application is filed will promptly transmit the acknowledgment by other means where the necessary indications furnished to it so permit (see Art. 10 of the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182). On request, the EPO also provides confirmation by fax of the receipt of documents filed with it (see Art. 8 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3). To ensure despatch of the receipt immediately after the documents are received: *Rule 35(2)*

– the request for the issue of a receipt by fax must be transmitted at the same time as the documents filed;

– the postal or fax address to which the receipt is to be sent must be stated; and

– evidence of the payment of the prescribed administrative fee or a debit order must be enclosed.

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

3.2 Filing with a competent national authority

If the application is filed with a competent national authority, that authority must without delay inform the EPO of receipt of the documents making up the application and indicate the nature and date of receipt of the documents, the application number and any priority date claimed. It is recommended that the competent national authority should indicate as well the applicant's or representative's reference number where such has been indicated. In practice, the *Rule 35(3)*

above-mentioned information is provided to the EPO by the forwarding of the application itself, unless national security checks by the national office delay the forwarding of the application, in which case a separate notice is sent by that office to the EPO.

Rule 35(4) When the EPO has received an application which has been forwarded by the central industrial property office of a Contracting State, it notifies the applicant, indicating the date of receipt at the EPO (see OJ 7/1990, 306). Once this communication has been received, all further documents relating to the application must be sent directly to the EPO.

Art. 77(3)
Rule 37(2)
Rule 112(1) Where an application is not received at the EPO from the central industrial property office of a Contracting State before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority and is consequently deemed to be withdrawn (see II, 1.7), the applicant must be notified accordingly; all fees must be refunded, including any surcharges paid and any fees paid in advance of their due date.

4. Examination on filing

4.1 Minimum requirements for according a date of filing

Art. 90(1)
Rule 10(1) The EPO examines applications to determine whether they meet the minimum requirements for according a date of filing (since this occurs before the Examining Division assumes responsibility, this check is carried out by the Receiving Section). These requirements are satisfied where the documents filed contain:

Rule 40(1)(a) (i) an indication that a European patent is sought;

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

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

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

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

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

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

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

4.1.1 Indication that a European patent is sought

Use of the prescribed Request for Grant form or the *epoline*® Online Filing software best provides "the indication that a patent is sought" as referred to in II, 4.1(i) (see also III, 4).

4.1.2 Information concerning the applicant

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

(i) identifies the applicant or

(ii) allows the applicant to be contacted.

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

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

(b) a fax number

(c) a PO box number.

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

In deciding whether or not the above information concerning the applicant satisfies the above requirements, the EPO will take into account all data contained in the documents filed (cf. J 25/86, OJ 11/1987, 475). Objection should not be raised at this stage with regard to the status of the applicant or his entitlement to apply, or where, in the case of joint applicants, there is doubt as to the Contracting States designated by the individual applicants.

4.1.3 Description

The contents of the description do not require close scrutiny – it is sufficient to identify a document (or documents) which appear(s) to

include a description. If instead of filing a description, the applicant has filed a reference to a previously filed application, see II, 4.1.3.1.

4.1.3.1 Reference to a previously filed application

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

Rule 40(2) *Details required on the date of filing*

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

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

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

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

Rule 40(3) *Copy of the previously filed application*

The applicant must supply a certified copy of the previously filed application within two months of the filing date (Rule 40(3)). However, according to Rule 40(3), last sentence, this requirement is dispensed with where the previously filed application is already available to the EPO under the conditions specified by the President. According to the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236, a certified copy does not need to be filed where the previously filed application is one of the following:

(a) a European application

(b) an international application filed with the EPO as receiving Office

(c) a Japanese patent or utility model application

(d) a Korean patent or utility model application

(e) a US patent application or provisional patent application subject to the document exchange agreement with the USPTO (see III, 6.7).

If the previously filed application is any of the above, then a copy will be automatically included in the file by the EPO.

Translation of the previously filed application *Rule 40(3)*

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

Note that where the previously filed application is in a language according to Art. 14(4) (an official language of a Contracting State to the EPC), the application may qualify for a reduction of the filing fee, provided that the applicant is entitled according to Rule 6(3) (see XI, 9.2.1 and 9.2.2). The reduction applies even in cases where the description is filed by reference to a previously filed application according to Rule 40(1)(c), where the previously filed application is in a language specified in Art 14(4) but the claims are filed after the date of the filing in accordance with Rule 57(c) and Rule 58 and in an official language of the EPO. This is because the essential element for establishing a filing date (the provision of a description, cf. Rule 40(1)(c)) has been provided in a language giving rise to the entitlement to the reduction (see G 6/91, OJ 9/1992, 491 mutatis mutandis).

The claims

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

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

4.1.4 Deficiencies

If the EPO (Receiving Section) notes either of the following deficiencies: *Art. 90(1) and (2) Rule 55*

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

Rule 40(1)(c) - no description or reference to an earlier application,

either of which prevents the application being accorded a date of filing, it communicates this to the applicant and invites him to remedy it within a non-extendable period of two months of notification of the communication. If the applicant does not remedy the deficiency in due time he is informed that the application will not be dealt with as a European application. Any fees which have been paid are refunded.

In the event that the information concerning the applicant is missing or does not enable the EPO to contact him (a deficiency according to Rule 40(1)(b)), no such communication is sent. However, if the applicant corrects this deficiency of his own motion within two months of the date of receipt of the original documents, then the date of filing is the date on which all requirements of Rule 40 are met. If the requirements of Rule 40 are not met at the end of this period, the application will not be dealt with as a European application and the applicant will have to re-file all documents relating to the purported European application.

Filing by reference to a previous application

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

(i) the filing date of the previous application

(ii) its file number

(iii) the office where it was filed

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

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

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

4.1.5 Date of filing

The date of filing accorded to the application is the date the application meets the requirements of II, 4.1 and is either:

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

(ii) the date, not later than the two-month period referred to in II, 4.1.4, on which the applicant rectifies any deficiencies. In the latter case, the applicant is informed of the date of filing accorded to his application.

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

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

5. Late filing of drawings or parts of the description

5.1 Late filing of drawings or parts of the description - on invitation

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

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

5.2 Late filing of drawings or parts of the description - without invitation

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

Rule 56(2)
Rule 56(4)(a)

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

5.3 The filing date changes

Rule 56(2)

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

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

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

Rule 56(3)

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

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

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

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

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

Rule 56(3)(a)

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

Rule 56(3)(b)

(vi) where the priority document is not in an official language of the EPO, the applicant files a translation into one of these languages within the applicable time limit*, unless such a translation is already available to the EPO under Rule 53(3) (see II, 5.4.4)

Rule 56(3)(c)

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

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

Where criterion (i) is not satisfied, the late-filing of those parts is deemed not to have been made and all references thereto in the application are deemed to be deleted under Rule 56(4)(a) (see II, 5.1

and 5.2). In this case the filing date does not change, but the late filed parts are not introduced into the application either.

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

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

5.4.1 Late-filed missing parts and the priority claim

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

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

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

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

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

Alternatively, the applicant may file submission (i) earlier (again, provided that it is filed within the time limit according to Rule 52(2)) and then subsequently file submission (ii) (again, provided that it complies with the applicable time limit). However, it is not possible to file request (ii) before request (i), because in this case request (ii) would be filed at a time when there is no priority claim, and it would not meet the requirements of Rule 56(3).

5.4.2 The missing parts are completely contained in the claimed priority

In cases where no translation of the priority is required and the application and priority are in the same official language, the

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

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

5.4.3 Copy of the claimed priority

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

Where a copy of the claimed priority is already available to the EPO under Rule 53(2) in accordance with the conditions laid down by the President, the applicant does not need to file it at all. Currently, this applies where the claimed priority is one of the following (see the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236):

(a) a European application

(b) an International application filed with the EPO as receiving Office

(c) a Japanese patent or utility model application

(d) a Korean patent or utility model application

(e) a US patent application or provisional patent application subject to the document exchange agreement with the USPTO (see III, 6.7).

5.4.4 Translation of the priority

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

In cases where the claimed priority is in an official language of the EPO and the European application is in a different official language of the EPO, there is no requirement for the applicant to file a translation of the priority according to Rule 56(3)(b). However, since the language of the priority and of the European application differ, the requirement that the newly introduced drawings (if they contain annotations) or parts of the description are "completely contained" in the priority (Rule 56(3)) is not

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

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

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

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

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

Rule 56(2) and (4)

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

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

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

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

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

Chapter III

Examination of formal requirements

1. General

1.1 Formal requirements

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

(i) representation;

(ii) physical requirements of the application;

(iii) abstract;

(iv) request for grant;

(v) claim to priority;

(vi) designation of inventor;

(vii) translations, where required;

(viii) the presence of at least one claim;

(ix) filing and search fees

1.2 Further checks

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

(i) carry out a preliminary check of the description and claims in order to ensure that the title of the invention, which will appear in the published application, is in general accord with the requirements of Rule 41(2)(b) *Rule 45(1) and (2)* *Rule 25* *Art. 55(1)(b)* *Rule 31* *Rule 30*

(ii) check whether any claims fees due have been paid (see also III, 9)

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

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

(v) check whether in the case of an application with nucleotide and/or amino acid sequences a prescribed sequence listing has

also been filed (see also IV, 5, and the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 and the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2).

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

2. Representation

2.1 Requirements

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

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

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

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

2.2 Non-compliance

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

3. Physical requirements

3.1 General remarks

Art. 90(3)

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

3.2 Documents making up the application, replacement documents, translations

It is the responsibility of the Receiving Section to ensure that the documents making up the application, i.e. request, description, claims, drawings and abstract, meet the requirements of Rule 49(2) to (9) and (12) and, with regard to drawings, the requirements of Rule 46, to the extent necessary for the purpose of a reasonably uniform publication of the application under Rule 68(1). The Receiving Section should

therefore not draw the attention of the applicant to any deficiencies under Rule 46(2)(i) or (j) or question whether tables included in the claims meet the requirements of Rule 49(9). In the event of deficiencies under Rule 30, the Receiving Section must invite the applicant to remedy them (Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 and the Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2; see also IV, 5).

Rule 10
Art. 94(1)
Rule 70(2)
Rule 49(1)
Rule 50(1)

Once the application is transferred to it, the Examining Division assumes responsibility for formal matters, and should pay particular attention to the more technical requirements of Rule 46 and Rule 49 including particularly the above-mentioned requirements under Rule 46(2)(i) and (j) and Rule 49(9) and those laid down in Rule 49(10) and (11). The particular requirements for drawings are dealt with in Chapter X. With regard to the more technical requirements, such as those of Rule 46(2)(f) and (h), the Receiving Section should, in case of doubt, consult and take the advice of the Search Division. The Receiving Section should also consider taking action when the Search Division draws its attention to a deficiency which it had overlooked. It should be noted that, in accordance with Rule 46(3), flow sheets and diagrams are to be considered as drawings. As indicated in IX, 2.2, replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) or (4) are subject to the same requirements as the documents making up the application.

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

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

3.2.2 Physical requirements of late-filed application documents

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

In the event that late-filed missing parts of the description, or drawings result in a change of the date of filing, the applicant can withdraw the late-filed parts of the description, or drawings up to one month after

being notified of the change in filing date (Rule 56(6)). Consequently, if the late-filed missing parts of the description, or drawings:

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

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

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

3.3 Other documents

The formalities officer should also ensure that documents other than those referred to in III, 3.2 meet the requirements set out in IX, 2.3, i.e. be typewritten or printed with a margin of about 2.5 cm on the left-hand side of each page.

3.4 Signature

Documents, with the exception of annexed documents, filed after filing the application must be signed by the applicant or his representative (see IX, 3).

4. Request for grant

4.1 General remarks

Rule 41(1)

The request for grant must be made on the appropriate EPO form (Form 1001), even though the request (the indication that a patent is sought, referred to in II, 4.1(i)) need initially be in no particular form. Paper versions of Form 1001 are available to applicants free of charge from the EPO or competent national authorities with which applications may be filed. The form is furthermore available via the EPO website on the Internet and is also included in the *epoline*® Online Filing software, which is obtainable free of charge from the EPO (see: www.epo.org).

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

4.2 Examination of the Request for Grant form

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

4.2.1 Information on the applicant

The request must contain, in the manner specified in Rule 41(2)(c), the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Where the

application is in the name of more than one applicant, the requirement must be satisfied for each applicant. At this stage in the proceedings, the formalities officer should have regard to the provisions of II, 2 governing the entitlement of the person named as applicant to apply for a patent.

4.2.2 Signature

The request must be signed by the applicant or his representative. If there is more than one applicant, each applicant or his representative must sign the request. For further details as to the signature of the request, see IX, 3.2 to 3.4. *Rule 41(2)(h)*

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

5. Designation of inventor

5.1 General remarks

Every application must designate the inventor. The designation is incorporated in the *epoline*® Online Filing software. When filing on paper, the designation is filed in a separate document where the applicant is not the inventor or the sole inventor; otherwise the designation must be effected in the Request for Grant form by placing a cross in the appropriate box in Section 22. Where the designation is effected in a separate document, a trilingual form available free of charge from the EPO or the central industrial property offices of the Contracting States should preferably be used. *Art. 81* *Rule 41(2)(j)*

5.2 Waiver of right to be mentioned as inventor

The inventor designated by the applicant may address to the EPO a written waiver of his right to be mentioned as inventor in the published European patent application and the European patent specification, in which case his name is not mentioned in the published European patent application, the European patent specification, the Register of European Patents (Rule 143(1)(g)) and, consequently, the European Patent Bulletin, always provided that the waiver is received in time. Moreover, in accordance with Rule 144(c), the designation of the inventor as well as the waiver is then excluded from file inspection pursuant to Art. 128(4). *Rule 20(1)* *Rule 143(1)(g)* *Rule 144(c)* *Art. 129(a)*

5.3 Designation filed in a separate document

Where the designation is filed in a separate document it must contain the surname, given names and full address (to meet the customary requirements for postal delivery) of the inventor, the statement, referred to in Art. 81, indicating the origin of the right to the patent and the signature of the applicant or his representative. *Rule 19(1)*

In the case of assignment, the words "by agreement dated ..." suffice, in the case of inventions by employees a mention that the inventor(s)

is/are employee(s) of the applicant(s) and in the case of succession a mention that the applicant(s) is/are heir(s) of the inventor(s).

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

Rule 19(2) The EPO does not verify the accuracy of the information given in the designation of the inventor.

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

5.4 Notification

Rule 19(3) and (4) If the applicant is not the inventor or is not the sole inventor, the Receiving Section must notify the inventor of the data contained in the document designating the inventor together with the data mentioned in Rule 19(3) relating to the application. It should be noted, however, that neither the applicant nor the inventor may invoke either the omission of this notification or any errors contained in it.

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

No notification is made where the inventor addresses to the EPO a written waiver of the notification under Rule 19(3) (cf. Notice of the EPO, OJ 5/1991, 266). The waiver must be filed with the designation of inventor and contain the information to be supplied to the inventor by the EPO under Rule 19(3), i.e.:

(i) the number and date of filing of the European patent application, if known;

(ii) where the priority of an earlier application is claimed, the date and State of the earlier application, and its number, if known;

(iii) the name of the applicant;

(iv) the title of the invention;

(v) the Contracting States designated in Section 32.1 of the Request for Grant form; and

(vi) the name(s) of any co-inventor(s).

5.5 Deficiencies

Where a designation is not filed, or where the designation filed is deficient (e.g. inventor's name or address or the signature of the applicant is missing) so that it cannot be considered as validly filed, the applicant is informed that the European patent application will be refused if the deficiency is not remedied within the period prescribed under Rule 60(1), which is within 16 months of the date of filing or, if priority is claimed, of the date of priority. This time limit is deemed to have been met if the information is communicated before completion of the technical preparations for publication (see VI, 1.2). If the deficiencies are not rectified in due time, the application is refused and the applicant is notified accordingly (as regards divisional applications, see IV, 1.5). Further processing is possible according to Art. 121 and Rule 135.

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

5.6 Incorrect designation

An incorrect designation may be rectified provided a request is received accompanied by the consent of the wrongly designated person and by the consent of the applicant for or the proprietor of the patent where the request is not filed by that party. If a further inventor is to be designated, the consent of the inventor(s) previously designated is not necessary (see J 8/82, OJ 4/1984, 155). The provisions of III, 5.3 and 5.4 apply to the corrected designation mutatis mutandis. Rectification may also be requested after the proceedings before the EPO are terminated.

Rule 21(1)

Where an incorrect designation has been rectified and where the incorrect designation was entered in the European Patent Register or published in the European Patent Bulletin, its rectification or cancellation shall also be published therein.

Rule 21(2)

6. Claim to priority (see also C-V)

6.1 General remarks

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

(i) the previous application was filed in or for a State or WTO member recognised as giving rise to a priority right in accordance with the provisions of the EPC;

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

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

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

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

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

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

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

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

6.2 Applications giving rise to a right of priority

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

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

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

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

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

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

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

In view of the wording of Art. 87(1) which refers to filings "in or for" any State party to the Paris Convention or member of the WTO, priority may be claimed of an earlier first filed national application, European application or international application. A list of the countries party to the Paris Convention is published on WIPO's website and is regularly published in the Official Journal of the EPO. Likewise a list of the members of the WTO is published on the website of the WTO, and this list is also regularly updated.

The decisions G 2/02 and G 3/02 (OJ 10/2004, 483) previously excluded the possibility of claiming priority from an application filed at the industrial property authority of members of the WTO which were not also signatory states to the Paris Convention (Art. 87(1) EPC 1973). This exclusion no longer applies under the revised Art. 87(1).

6.3 Multiple priorities

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

Art. 88(2)

6.4 Examination of the priority document

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

6.5 Declaration of priority

An applicant wishing to claim priority must file a declaration of priority indicating:

Art. 88(1)
Rule 52(1)
Rule 41(2)(g)
Art. 90(4)

(i) the date of the previous application,

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

(iii) its file number.

The declaration of priority shall preferably be made on filing the European patent application (Rule 52(2)). In such a case the

declaration of priority, indicating at least the date on which and the country for which the earlier application was filed, should be present in the Request for grant form (Rule 41(2)(g)). However, if a priority claim is added or corrected after the Request for grant form has been filed (see III, 6.5.1 and 6.5.2), the applicant will not be invited by the EPO to file a corrected Request for grant under Rule 58.

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

(a) the applicant supplies the certified copy on time

(b) it is in an official language of the EPO

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

then the requirements of Rule 52(1) with regard to providing the date and file number of the priority are met.

6.5.1 Filing a new priority claim

Rule 52(2)

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

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

6.5.2 Correcting an existing priority claim

Rule 52(3)

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

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

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

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

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

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

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

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

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

(iii) failure to supply a file number or to indicate the correct file number.

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

However, where the applicant has failed to indicate the file number of the previous application, as required by Rule 52(1), before expiry of the time limit under Rule 52(2), he is invited by the EPO to provide it within a period to be specified according to Rule 59. Failure to reply in time to this communication results in the loss of the priority right in question according to Art. 90(5). Further processing does not apply to the time limit under Rule 59 either, since it is also excluded by Rule 135(2).

6.6 Priority period

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

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

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

Rules 133 and 134 apply to the priority period under Art. 87(1). In the event that the date indicated for the previous application is subsequent

to or the same as the date of filing, the procedure set out in III, 6.5.2 also applies (with regard to the possibility of effecting correction of clerical or similar errors, see V, 3).

According to Art. 122 and Rule 136(1) it is possible to obtain re-establishment of rights in respect of the priority period (twelve months according to Art. 87(1)). The request for re-establishment must be filed within two months of expiry of the priority period (Rule 136(1)) and the omitted act, i.e. the establishment of a date of filing for the European application, must also be completed in this period (Rule 136(2)). For more details on requesting re-establishment of rights see E-VIII, 2.2.

6.7 Copy of the previous application (priority document)

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

A paper copy of the previous application for which priority is claimed (priority document) must be filed before the end of the sixteenth month after the date of priority. Where multiple priorities are claimed, the above-mentioned time limit runs from the earliest date of priority.

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

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

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

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

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

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

Rule 53(2) together with the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236 provide for the following exceptions to the requirement that a priority document be filed: *Rule 53(2)*

If the previous application is:

(i) a European patent application;

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

(iii) a Japanese patent or utility model application;

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

(v) a US patent application or provisional patent application subject to the document exchange agreement with the USPTO,

then the EPO will include free of charge a copy of the previous application in the file of the European patent application. No request is necessary to this end. However, if the language of the previous application was not one of the official languages of the EPO, it may still be necessary to file the translation or declaration under Rule 53(3) (see III, 6.8).

Where the applicant has already supplied a copy of the priority in the context of a request to base late-filed parts of the description or drawings on the claimed priority under Rule 56 (see II, 5.4(v)). the applicant does not need to file it again. However, if the copy already provided was not certified as to its content and/or filing date, the applicant will need to provide the missing certification within the above time limit.

If the applicant fails to provide a certified copy of the priority document within the above-mentioned period (Rule 53(1)), the EPO will invite him to provide it within a period to be specified according to Rule 59. If the applicant fails to provide it within this period, the priority right in question is lost (Art. 90(5)). Further processing does not apply to the time limit according to Rule 59, since this is excluded according to Rule 135(2). *Art. 90(4) and (5)* *Rule 59*

6.8 Translation of the previous application

Where the previous application claimed as priority is not in an official language of the EPO and the validity of the priority claimed is relevant to the assessment of the patentability of the invention concerned, the EPO shall invite the applicant for or proprietor of the European patent to file a translation into an official language of the EPO within a period to be specified. *Art. 88(1)* *Rule 53(3)*

Since the applicant for a European patent might not have to file a translation in the examination procedure, in cases where the validity of

the claimed priority becomes relevant in the assessment of patentability in opposition proceedings, the EPO may make the above invitation during the opposition procedure.

In practice, the Search, Examining or Opposition Division dealing with the patent application or patent will inform the Formalities Officer that a translation of the priority is required and the Formalities Officer will then despatch the above communication.

If the applicant for or proprietor of the European patent does not provide the translation in time, then the intermediate document(s) which resulted in the validity of the priority claimed becoming relevant for the assessment of patentability will be considered to belong to the prior art under Art. 54(2) or Art. 54(3) as applicable. There is no further invitation to the applicant or proprietor to file the translation. However, if the applicant fails to observe this time limit, he can request further processing according to Art. 121 and Rule 135.

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

The applicant for or proprietor of the European patent can file a translation of his priority of his own motion at any time during examination or opposition proceedings before the EPO.

Alternatively, a declaration that the European patent application is a complete translation of the previous application may be submitted within those same time limits (see also C-V, 3.4 and D-VII, 2). The declaration may already be made by crossing the appropriate box in the Request for Grant form (Form 1001). This declaration is only valid if the text of the European application as filed is an exact translation of the text of the earlier application of which priority is claimed. If the European application did not contain claims on the date of filing (see II, 4.1), the applicant can file these later (see III, 15). In such cases, for the declaration to be valid, the description of the European application must be an exact translation of the description of the claimed priority, regardless of whether the priority application contained claims on its filing date. However, where the European application contains claims on its date of filing and the priority application did not contain claims on its filing date or contained fewer claims on its filing date, the declaration is not valid. Furthermore, if the European application contains more or less text than is contained in the earlier application as filed, such a declaration cannot be accepted. Where the declaration cannot be accepted for any of the above reasons, in order to comply with the requirement for filing a translation, a complete translation must be filed within the above-mentioned time limit. A merely different arrangement of the various elements (i.e. the claims vs. the description) of the application does not affect the validity of such a declaration (see Legal Advice No. 19/1999, OJ 5/1999, 296).

6.9 Non-entitlement to right to priority

A European patent application has no right to priority if:

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

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

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

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

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

6.10 Loss of right to priority

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

(i) the declaration of priority is not filed in due time (see III, 6.5.1);

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

(iii) the copy of the previous application is not filed in due time (see III, 6.7).

6.11 Notification

The applicant is notified of any non-entitlement to, or loss of, a priority right. The computation of time limits that depend on the priority will take this new situation into account. This also applies where entitlement to a priority right is surrendered. The termination of a priority right has no effect on a time limit which has already expired (see also C-V, 3.4 and E-VIII, 1.5). If the search has not yet been carried out, the Receiving Section notifies the Search Division of a loss of, or non-entitlement to, a priority date. *Rule 112(1)*

7. Title of the invention

7.1 Requirements

Rule 41(2)(b)

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

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

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

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

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

7.2 Responsibility

Rule 41(2)(b)

The ultimate responsibility for ensuring that the title accords with the provisions of the Implementing Regulations rests with the Examining Division. The Receiving Section should nevertheless take action to avoid, if possible, the publication of applications having titles which are clearly non-informative or misleading. It is necessary therefore that the Receiving Section takes cognisance of the provisions of Rule 41(2)(b) as set out in III, 7.1. In the event of obvious non-compliance with the provisions, the EPO will of its own motion change the title, if this appears necessary, without informing the applicant there and then. Only when the application is about to be published will the applicant be notified whether the title proposed by him has been changed (see OJ 4/1991, 224).

8. Prohibited matter

8.1 Morality or "ordre public"

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

The application must not contain statements or other matter contrary to "ordre public" or morality. Such matter may be omitted when the application is published, the published application indicating the place and number of words or drawings omitted. (Where drawings are omitted regard should be had to the physical requirements of III, 3.2). The Receiving Section may check the description, claims and drawings to ascertain whether they contain offending matter. In order not to delay unduly the formalities examination, if carried out, this will

entail a cursory examination to ensure that the application does not contain the following prohibited matter: statements constituting an incitement to riot or to acts contrary to "ordre public", racial, religious or similar discriminatory propaganda, or criminal acts and grossly obscene matter. The Receiving Section may also take action to prevent the publication of such matter where the Search Division draws its attention to such matter which it had overlooked. The applicant is notified of the material omitted. In practice, it will usually be the Search Division which brings the existence of such material in the application to the attention of the Receiving Section.

8.2 Disparaging statements

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

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

9. Claims fee

Rule 45(1) to (3)
Rule 112(1)
Rule 37(2)
Art. 2, No. 15, RFees

A European application which contains more than fifteen claims at the time of filing the claims (see the paragraph below) incurs payment of a claims fee in respect of each claim over and above that number. For applications filed and international applications entering the regional phase on or after 1 April 2009, a higher amount is payable for each claim in excess of 50. The claims' order is their sequence at their time of filing. If an application contains more than one set of claims, Rule 45 is only applicable for the set of claims containing the highest number of claims (see Legal Advice No. 3/85 rev., OJ 11/1985, 347). The claims fees must be paid within one month after the claims are filed.

The claims may be filed at the following stages:

(i) on the European filing date (see II, 4.1.5)

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

(iii) after the European filing date, by the applicant of his own motion before the EPO sends a communication according to Rule 58 (see III, 15)

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

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

In cases where:

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

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

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

Features of a claim deemed to have been abandoned pursuant to Rule 45(3) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims (J 15/88, OJ 11/1990, 445).

Regarding Euro-PCT applications entering the European phase, see VII, 1.3 and 3.8.

10. Abstract

10.1 General remark

Art. 78(1)(e)
Art. 90(3)
Rule 57(d)

Every application for a patent must contain an abstract. The effect of non-compliance with this requirement is dealt with in III, 16.

10.2 Content of the abstract

The definitive content of the abstract is the responsibility of the EPO. Since the definitive content of the abstract must be determined and transmitted to the applicant along with the search report, in practice this means in particular the Search Division. However, where it is obvious that the abstract filed does not belong to the application, and this should normally be confirmed by the Search Division, the applicant is informed that the document filed does not constitute an abstract and that unless he corrects the deficiency the sanction referred to in III, 16 will apply. *Rule 66*

10.3 Figure accompanying the abstract

If the application contains drawings, the applicant should indicate the figure (or exceptionally figures) of the drawings which he suggests should accompany the abstract. Where this requirement is not met, the Search Division decides which figure(s) to publish. For the further procedure see B-XI, 4. *Rule 47(4)*

11. Designation of Contracting States

11.1 General remarks

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

11.2 European patent applications filed on or after 1 April 2009

11.2.1 Designation fee; time limits

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

For applications filed on or after 1 April 2009 this is a flat designation fee covering all EPC Contracting States. Therefore, for these applications, the system of charging designation fees for individual designated states (see A-III, 11.3) no longer applies. For European divisional applications see also A-IV, 1.3.4 and A-IV, 1.4.1. *Art. 2, No. 3 RFees*

For European patent applications, the designation fee must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report. *Rule 39*

For divisional applications and new applications under Art. 61(1)(b), the designation fee must be paid within six months of the date on which *Rule 17(3)* *Rule 36(4)*

the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application or the new European patent application (see A-IV, 1.4.1).

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

11.2.2 Payment of designation fee

Rule 39(2)

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

Art. 2, No. 3 RFees
Art. 6(1) RFees

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

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

11.2.3 Consequences of non-payment of the designation fee

Rule 39(2)

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

In this case, the EPO sends the applicant a communication under Rule 112(1) notifying him of this loss of rights. In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 (see E-VIII, 2.1).

The loss of rights ensues on expiry of the normal period under Rule 39(1) and not upon expiry of the period for further processing (see G 4/98, OJ 3/2001, 131, mutatis mutandis).

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

11.2.4 Withdrawal of designation

Art. 79(3)
Rule 39(2) and
Rule 39(3)
Rule 15

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

In neither case is the designation fee refunded. The designation of a Contracting State may not be withdrawn as from the time when a third party proves to the EPO that he has initiated proceedings concerning entitlement and up to the date on which the EPO resumes proceedings for grant.

The applicant may withdraw designations when filing the European application, for example to avoid overlapping prior national rights with

the priority application according to Art. 139(3). Timely payment of the designation fee will not cause those designations which have been withdrawn to be re-activated.

For European divisional applications see A-IV, 1.3.4.

11.2.5 Euro-PCT applications entering the European phase

For Euro-PCT applications entering the European phase, the designation fee must be paid within 31 months of the filing or priority date, if the time limit specified in Rule 39(1) has expired earlier. *Rule 159(1)(d)*

According to Rule 160(1), if the designation fee for the Euro-PCT application entering the European phase is not paid within the basic period under Rule 159(1)(d), the European patent application (see Art. 153(2)) is deemed to be withdrawn. If the EPO finds that such deemed withdrawal of the European patent application has occurred, it notifies the applicant of this loss of rights according to Rule 112(1). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 (see E-VIII, 2.1). *Rule 160* *Art. 153(2)*

For the designation fee in relation to Euro-PCT applications entering the European phase, see also A-VII, 1.3 and A-VII, 3.11.

11.3 European patent applications filed before 1 April 2009

In this section reference is made to the old version of the relevant provisions, which remain applicable to European patent applications filed and Euro-PCT applications entering the European phase before 1 April 2009.

11.3.1 Designation fee; time limits

The designation of a Contracting State is subject to payment of a designation fee. A single joint designation fee is payable for Switzerland and Liechtenstein. The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee. *Art. 79(2)* *Rule 39, old version* *Art. 149(1)* *Art. 2, Nos. 3 and 3a RFees, old versions*

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

For divisional applications and new applications under Art. 61(1)(b) filed before 1 April 2009, the designation fees must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application or the new European patent application (see IV, 1.4.1). *Rule 17(3), old version* *Rule 36(4), old version*

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

11.3.2 Consequences of non-payment of designation fees

Rule 39(2), old version

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

If the designation fee for a particular Contracting State is not paid in time, the EPO sends the applicant a communication under Rule 112(1) notifying him of the deemed withdrawal of the designation in question according to Rule 39(2). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 in respect of this partial loss of rights (see E-VIII, 2.1). This communication is not sent if the applicant waives the right to receive it in respect of the state in question, by crossing the appropriate box in the Request for grant form. By crossing this box, the applicant waived his right to further processing in respect of the designation or designations in question.

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

11.3.3 Amount paid insufficient

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

If, during the period for requesting further processing, designation fees are paid without an additional sum sufficient to cover the amount of the further processing fee, it is first necessary to establish how many designation fees including the further processing fee are covered by the total sum paid for that purpose. The applicant must then be invited, pursuant to Art. 6(2), first sentence, RFees, to inform the EPO for which Contracting States the designation fees plus further processing fee are to be used (see J 23/82, OJ 4/1983, 127, mutatis mutandis). For the subsequent procedure, see III, 11.3.7.

11.3.4 Application deemed to be withdrawn

Rule 39(3), old version

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

If no designation fees are paid on time leading to a deemed withdrawal of the application under Rule 39(3), old version, the EPO sends the applicant a communication according to Rule 112(1) notifying him of this loss of rights. In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 in respect of this total loss of rights (see E-VIII, 2.1).

Where the application is deemed to have been withdrawn because of failure to pay the designation fees, the loss of rights ensues on expiry of the normal period under Rule 39(1). Similarly, the deemed withdrawal of a designation of a Contracting State takes effect upon expiry of the normal period under Rule 39(1), and not upon expiry of the period for further processing (see G 4/98, OJ 3/2001, 131, mutatis mutandis). The applicant is notified of the loss of rights and can remedy it by requesting further processing according to the procedures explained in III, 11.3.2.

11.3.5 Request for Grant form

Art. 79(1) and (2)

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

The applicant has time – until expiry of the period for paying the designation fees (Rule 39(1) and Rules 17(3) and 36(4)) – to decide which Contracting States he actually wants his patent to cover. This he does by paying the designation fees for those States, which may include an additional sum required to validate a request for further processing.

11.3.6 Indication of the Contracting States

Art. 2, No. 3, RFees
Art. 6(1) RFees

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

If, on the other hand, the applicant intended to pay fewer than seven designation fees when filing the application, he should have indicated the relevant Contracting States in the appropriate Section of the Request for Grant form (Form 1001, versions prior to April 2009). This helped to ensure that the designation fees paid were properly entered in the books. If designation fees are not paid within the basic time limit, a communication under Rule 112(1) is issued.

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

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

11.3.7 Amount payable

Art. 6(2), 1st sentence, RFees
Art. 8(2), 2nd sentence, RFees, old version
Rule 39(2), old version
Rule 112(1)

If, given the amount payable under the time limit in question, the sum paid for designation fees during the periods under Rule 39(1) or Rule 135(1) does not cover all the Contracting States indicated in the Request for Grant form (Form 1001), and the payer failed to indicate for which Contracting States the fees are intended, then he is requested to indicate which States he wishes to designate, within a period stipulated by the EPO (see also III, 11.3.3). If he fails to comply in due time, then Art. 8(2) RFees applies: the fees are deemed to have been paid only for as many designations as are covered by the amount paid, in the order in which the Contracting States have been designated (see J 23/82, OJ 4/1983, 127, mutatis mutandis). The

designation of Contracting States not covered by the fees are deemed withdrawn, and the applicant is notified of the loss of rights (see III, 11.3.4 paragraph 3, regarding the time at which loss of rights ensues).

11.3.8 Withdrawal of designation

Art. 79(3)
Rule 39(3) and (4), old versions
Rule 15

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

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

11.3.9 Euro-PCT applications entering the European phase

Rule 159(1)(d)

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

Rule 160, old version
Art. 153(2)

Pursuant to Rule 160(2), the designation of any Contracting State for which no designation fee has been paid in time is deemed to be withdrawn. According to Rule 160(1), if no designation fee for the Euro-PCT application entering the European phase is paid at all within the basic period under Rule 159(1)(d), the European patent application (see Art. 153(2)) is deemed to be withdrawn. If the EPO finds that such deemed withdrawal of the European patent application or the designation of a Contracting State has occurred, it notifies the applicant of this loss of rights according to Rule 112(1). In response to this communication, the applicant can request further processing according to Art. 121 and Rule 135 (see E-VIII, 2.1).

For designation fees in relation to Euro-PCT applications entering the European phase, see also VII, 1.3 and 3.11.

12. Extension of European patent applications and patents to States not party to the EPC

12.1 General remarks

At the applicant's request and on payment of the prescribed fee European patent applications (direct or Euro-PCT) and thus patents

can be extended to States for which an Extension Agreement with the EPO has become effective (Extension States).

Extension may be requested for the following States:

Albania (AL)	since 1 February 1996;
Serbia (RS)	since 1 November 2004; and
Bosnia and Herzegovina (BA)	since 1 December 2004

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

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

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

12.2 Time limit for payment of extension fee

Under the applicable national provisions of the Extension States, the extension fee must be paid within the periods prescribed by the EPC for the payment of designation fees (see III, 11.2.1, A-III, 11.2.5, and VII, 1.3). If the extension fee is not paid within the applicable period, the request for extension is deemed withdrawn. If no designations of EPC Contracting States are deemed withdrawn under Rule 39(2) and the extension fee has not been paid within the applicable basic time

limit (Rules 39(1), 17(3), 36(4) and 159(1)(d)), a communication under Rule 112(1) is not issued, and further processing will not be possible in respect of the extensions which are deemed to be withdrawn. However, if:

(i) one or more extensions are deemed withdrawn due to the applicant's failure to pay extension fees on time, and

(ii) one or more designations of EPC Contracting States are deemed to be withdrawn because the designation fee(s) in respect of such state(s) is/are not paid on time (see III, 11.2.3 and A-III, 11.3.2) and:

(a) the applicant has not actively withdrawn these designations and

(b) the applicant has not waived the right to receive a Rule 112(1) communication in respect of these designations

then the EPO will notify the applicant of the loss of rights with regard to both the designations *and extensions* in question according to Rule 112(1). In this case, the applicant may then request further processing according to Art. 121 and Rule 135 in respect of both the designations *and extensions* which were deemed to be withdrawn. As regards the amount of the fee for further processing in respect of the extension fees , Art. 2, No. 12 RFees applies mutatis mutandis.

Furthermore, re-establishment of rights according to Art. 122 and Rule 136 is not possible in respect of payment of the extension fee.

12.3 Withdrawal of extension

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

12.4 Extension deemed requested

All Extension States are deemed requested (see, however, III, 12.1, 4th paragraph, regarding Euro-PCT applications) and are therefore indicated in the published application. These States, and those for which the extension fee has been paid, are indicated in the Register of European Patents and in the European Patent Bulletin.

12.5 National register

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

13. Filing and search fees

13.1 Payment of fees

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

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

(ii) for European divisional applications or European applications filed according to Art. 61(1)(b), within one month from the date of filing of the divisional or Art. 61(1)(b) application *Rule 36(3)* *Rule 17(2)*

(iii) for Euro-PCT applications, within 31 months of the filing date or, where applicable, from the earliest claimed priority date* *Rule 159(1)*

* Note that when a supplementary European search report is not prepared by the EPO (see B-II, 4.3), no search fee is required for the Euro-PCT application (Rule 159(1)(e)).

With regard to applications of types (i) and (ii), the EPO will check that these fees have been paid. If either fee is not paid on time, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1); the applicant can respond by requesting further processing according to Art. 121 and Rule 135. *Art. 90(3)* *Rule 57(e)* *Art. 78(2)* *Rule 36(3)* *Rule 17(2)*

With regard to Euro-PCT applications (type (iii)), see VII, 1.3.

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

This section relates only to applications filed and international applications entering the European phase on or after 1 April 2009 (See also Notice from the EPO dated 26 January 2009, OJ 2/2009, 118). *Rule 38(2) and Rule 38(3)* *Art. 2, No. 1a RFees*

An additional fee is payable as part of the filing fee for European patent applications which are filed on or after 1 April 2009 and comprise more than thirty-five pages. The amount of the fee is calculated according to the number of pages over thirty-five. The language reduction under Rule 6(3) applies. The additional fee is payable within one month of the filing date of the application or of the date of filing a European divisional application or a European application according to Article 61(1)(b). If the application is filed without claims or by reference to a previously filed application, the additional fee is payable within one month of filing the first set of claims or one month of filing the certified copy of the application referred to in Rule 40(3), whichever expires later. The additional fee is calculated on the basis of the pages of the description, claims, any drawings and one page for the abstract, in the language of filing. The pages of the request for grant (EPO Form 1001) and those

forming part of a sequence listing within the meaning of Rule 30(1) are not counted, provided the sequence listing contained in the description complies with WIPO Standard St. 25. If the application is filed by reference to a previously filed application, the pages of the certified copy, excluding those for the certification and for bibliographic data, are taken as the basis for the calculation. If the application is filed without claims, the additional fee takes account of the pages of the first set of claims filed.

For international (Euro-PCT) applications entering the European phase on or after 1 April 2009, the additional fee is payable as part of the filing fee within the 31-month period of Rule 159(1). It is calculated on the basis of the international application as published, any amendments under Article 19 PCT and one page for the abstract. If there is more than one page of bibliographic data, the further pages are not counted. The pages of the latest set of any amended documents (Article 34 PCT, amendments filed upon entry) on which European phase processing is to be based (Rule 159(1)(b)) will also be taken into account where available to the EPO by the date of payment of the additional fee within the thirty-one months. If the applicant intends pages of the international publication or of amendments to be replaced by pages of the latest set of amendments, and therefore to be excluded from the calculation, he must also, at the latest by the date of payment, identify these replacement pages and clearly indicate the pages which they are to replace. This information should preferably be given in the relevant section of the form for entry into the European phase (EPO Form 1200). Otherwise any new pages filed at this stage will be taken to be additional pages. Form 1200 is disregarded in the calculation of the additional fee.

Example:

International application, published in English, containing 100 pages:

abstract	1
description	50
claims	20
drawings	20
claims, Art. 19 PCT	9

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

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

-> number of pages to be paid for: 46

Pages of amendments filed after the date of payment of the additional fee, in particular during the Rule 161(1) or (2) period (see A-VII, 7), are not taken into account. Consequently, if amendments are filed at this stage which reduce the number of pages already paid for, no refund will be made.

If the additional fee is not paid on time, the application is deemed to be withdrawn. The EPO will notify the applicant of the loss of rights according to Rule 112(1); the applicant can request further processing according to Art. 121 and Rule 135. The amount of the fee for further processing is computed according to the number of pages on file at expiry of the relevant period for which the additional fee, calculated as set out above, has not been paid. *Art. 2, No. 12 RFees*

14. Translation of the application

There are three situations in which a translation of the European application will be required:

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

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

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

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

The EPO will check that this requirement has been complied with. If the applicant has not filed the translation, the EPO will invite him to rectify this deficiency under Rule 58 within a period of two months in accordance with the procedure explained in III, 16. *Art. 90(3)* *Rule 57(a)*

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

the applicant may request re-establishment according to Art. 122 and Rule 136 for failure to comply with the time limit under Rule 58.

15. Late filing of claims

Art. 80
Rule 40(1)

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

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

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

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

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

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

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

16. Correction of deficiencies

16.1 Procedure formalities officer

Art. 90(3)

Where, during the examination for compliance with the requirements set out in earlier sections of this Chapter, it is noted that there are deficiencies which may be corrected, the formalities officer must give the applicant the opportunity to rectify each such deficiency within a

specified period. A summary of the most common potential deficiencies at this stage of the procedure and the provisions governing their rectification is given below:

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

The formalities officer should in his first report to the applicant raise all the formal objections that become evident from a first examination of the application, except that, as noted in III, 3.2, the Receiving Section should not draw the attention of the applicant to deficiencies under Rule 46(2)(i) and (j) or question the inclusion of tables in the claims. It is likely that certain matters cannot be finally disposed of at this stage, e.g. filing of priority documents for which the period for filing has not expired, and further reports may be necessary. If the applicant is required to appoint a representative but has not done so, the formalities officer should in his first report not only cover this deficiency but any other obvious deficiencies as it should be assumed that the applicant on receipt of the report will appoint a representative within the period allowed.

16.2 Period allowed for remedying deficiencies

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

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

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

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

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

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

(vi) no claims (III, 15).

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

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

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

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

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

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

Rule 45

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

Art. 90(5)
Rule 59

Deficiencies under (viii) are to be corrected within a period to be specified by the EPO from a communication according to Rule 59 pointing out the failure to supply the certified copy and/or the file number of the priority document. This period under Rule 59 cannot be less than two months or more than four months (Rule 132(2)). Failure to correct this deficiency in time leads to the loss of the priority right. Further processing is excluded for this loss of rights according to Rule 135(2).

Art. 78(2)

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

Where appropriate, the Search Division is informed of any loss of rights.

Chapter IV

Special provisions

1. European divisional applications (see also C-VI, 9.1)

1.1 General remarks

1.1.1 When may a divisional application be filed?

With regard to when a divisional application may be filed, there are two requirements which must be met:

(i) the application to be divided (the "parent" application on which the divisional is based) must be pending (see IV, 1.1.1.1), and

(ii) at least one of the following two periods must not yet have expired:

(a) the period for voluntary division under Rule 36(1)(a) (see IV, 1.1.1.2)

(b) the period for mandatory division under Rule 36(1)(b), where applicable (see IV, 1.1.1.3)

The term "earlier application" in Rule 36(1) refers to the immediate parent application on which the divisional application is based. This term is distinct from the term "earliest application" also appearing in Rule 36(1), although in the case of a first-generation divisional application (where the immediate parent is not itself a divisional) they both refer to the same application.

1.1.1.1 The earlier application must be pending

Art. 76
Rule 36(1)

A European patent application may be divided only when it is pending. In order to divide a European application, the applicant files one or more European divisional applications. It is irrelevant what kind of application the European patent application which is divided, i.e. the parent application, is. The parent application could thus itself be an earlier divisional application. In the case of the parent application being a Euro-PCT application, a divisional application can only be filed once the Euro-PCT application is pending before the EPO acting as a designated or elected Office, i.e. the Euro-PCT application must have entered the European phase.

As noted above, the parent application must be pending when a divisional application is filed. In the case of an application being filed as a divisional application from an application which is itself a divisional application, it is sufficient that the latter is still pending at the filing date of the second divisional application. An application is pending up to (but **not** including) the date that the European Patent Bulletin mentions the grant of the patent (OJ 2/2002, 112). It is not possible to validly file

a divisional application when the parent application has been refused, withdrawn or is deemed to be withdrawn (see also the next two paragraphs).

If an application is deemed to be withdrawn due to the non-observance of a time limit (e.g. following failure to pay the filing fee (Art. 78(2)), to pay the fee for grant and publishing or the claims fees, or to file the translation of the claims (Rule 71(7)) in due time), the application is no longer pending when the non-observed time limit has expired, unless the loss of rights, as communicated pursuant to Rule 112(1), is remedied. This may be effected either by means of an allowable request for further processing or, where further processing does not apply to the time limit in question, or the time limit for further processing has been missed, re-establishment of rights (which in the latter case is a request for re-establishment in respect of the period for further processing - see E-VIII, 2) or, if the applicant considers that the finding of the EPO was inaccurate, by applying for a decision pursuant to Rule 112(2), whereupon either the competent EPO department shares his opinion and rectifies its decision or that department gives an unfavourable decision which is subsequently overturned on appeal.

Once an application has been refused, a divisional application can no longer be validly filed, unless the applicant files a notice of appeal, in which case the decision to refuse cannot take effect until the appeal proceedings are over. As the provisions relating to the filing of divisional applications also apply in appeal proceedings (Rule 100(1)), a divisional application may be filed while such appeal proceedings are under way (provided that at least one of the periods under Rule 36(1)(a) and Rule 36(1)(b) has not yet expired - see IV, 1.1.1.2 and 1.1.1.3).

1.1.1.2 Voluntary division

Rule 36(1)(a)

A divisional application may be filed on the basis of a pending earlier (parent) application before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued (see, however, IV, 1.1.1.3). The events from which the period for voluntary division is calculated are:

(i) notification of a first communication according to Art. 94(3) and Rule 71(1), (2), where this is not preceded by a communication according to Rule 71(3), or

(ii) notification of a communication according to Rule 71(3), where this is not preceded by a communication according to Art. 94(3) and Rule 71(1), (2).

Notification of the search opinion (see B-XII, 1.1) does not cause this twenty-four-month period to start because the Examining Division is not yet responsible for the application (see C-VI, 1.1). However, in

cases where the applicant has waived his right to receive the communication according to Rule 70(2) (see C-VI, 1.1.2), no search opinion is issued, but rather a communication according to Art. 94(3) and Rule 71(1), (2) (see B-XII, 8), and notification of this communication *does* cause the twenty-four-month period to start. When calculating the twenty-four-month period for voluntary division, the ten-day rule applies in calculating the date of notification of the above communications (Rule 126(2) - see E-I, 2.3 and E-VIII, 1.4).

The earlier (parent) application on which the divisional is to be based has to be pending at the time the divisional application is filed. If it lapses or is withdrawn before the first communication is sent in respect thereof in examination proceedings, a divisional application may no longer be filed (see IV, 1.1.1.1). The same applies if the earlier (parent) application ceases to be pending after notification of the first communication referred to above but before expiry of the twenty-four-month period.

1.1.1.3 Mandatory division

Rule 36(1)(b)

A divisional application may be filed on the basis of a pending earlier (parent) application before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Art. 82, provided it was raising that specific objection for the first time. Where the period for mandatory division according to Rule 36(1)(b) expires later than the period for voluntary division according to Rule 36(1)(a), a divisional application may be filed within this later period on the basis of a pending earlier (parent) application. The events from which the period for mandatory division is calculated are:

(i) notification of a communication according to Art. 94(3) and Rule 71(1), (2) which is either:

  (a) the first communication in the examination procedure, where this raises a specific objection of lack of unity for the first time or confirms a previous finding of lack of unity already raised during the international, European or supplementary European search, or

  (b) a subsequent communication in the examination procedure, where this raises a specific objection of lack of unity for the first time.

(ii) notification of a summons to oral proceedings, where a specific objection of lack of unity is raised for the first time therein;

(iii) the date of oral proceedings, where a specific objection of lack of unity is raised for the first time during those oral proceedings, provided that the minutes of those oral proceedings reflect this newly raised objection of lack of unity (see E-III, 10.2);

(iv) notification of the minutes of a telephone call or a personal interview, where a specific objection of lack of unity is raised for the first time during that telephone call or personal interview and, in the case of a personal interview, the minutes are notified to the applicant or his representative at a later date, provided that the minutes reflect this newly raised objection of lack of unity (see C-VI, 6.2);

(v) the date of a personal interview, where a specific objection of lack of unity is raised for the first time during that personal interview and the minutes are notified to the applicant or his representative in person on termination of said interview, provided that the minutes reflect this newly raised objection of lack of unity (see C-VI, 6.2);

(vi) notification of a communication according to Rule 71(3), where the text proposed for grant by the Examining Division is an auxiliary request and where the accompanying reasoning indicating why the higher requests were not allowable (see C-VI, 14.1) raises for the first time a specific objection of lack of unity to at least one of those non-allowed higher requests.

In cases (i)(a), (i)(b), (ii), (iv) and (vi), when calculating the twenty-four-month period for mandatory division, the ten-day rule applies to calculation of the date of notification of these communications (Rule 126(2) - see E-I, 2.3 and E-VIII, 1.4).

Note that notification of a search opinion raising an objection of lack of unity of invention does not cause the period for mandatory division to start according to Rule 36(1)(b) (see point (i)(a) above), because the Examining Division is not yet responsible for the application (see C-VI, 1.1). However, in cases where the applicant has waived his right to receive the communication according to Rule 70(2) (see C-VI, 1.1.2), no search opinion is issued, but rather a communication according to Art. 94(3) and Rule 71(1), (2) (see B-XII, 8), and notification of this communication, where it raises an objection of lack of unity, *does* cause the twenty-four-month period for mandatory division to start.

For first-generation divisional applications (where the earlier application on which the divisional is based is not itself a divisional), it is not possible for the period for mandatory division to expire earlier than the period for voluntary division. In most cases the two periods will expire at the same time, because the unity objection is typically raised in a first communication from the Examining Division or, if already raised at the search stage, is maintained therein. A confirmation in a later communication in examination of a lack of unity objection previously raised in examination proceedings does not cause the period for mandatory division to start again. In particular, where the Examining Division raises an objection of lack of unity in the first communication and in response the applicant deletes some of the

additional inventions, but more than one invention remains in the claims and the Examining Division then issues a second communication (or a summons to oral proceedings) which maintains the previous objection of lack of unity in part (adapted to the deletion of some of the claimed inventions), this does not cause the period for mandatory division to start again, since the objection is not a new one.

However, where a *different* objection of lack of unity is subsequently raised, this *does* cause the twenty-four-month period for mandatory division to start again. This applies in cases where, for example, an invention identified in a previous non-unity objection is further sub-divided in a subsequent objection raised in the examination procedure.

Furthermore, an objection according to Rule 137(5) does not qualify as an objection according to Art. 82, in particular for the purposes of calculating the period for mandatory division (see C-VI, 5.2). However, the period for mandatory division does start if a communication raising an objection under Rule 137(5) also contains a further objection according to Art. 82.

1.1.1.4 Second- and subsequent-generation divisional applications

Voluntary division (Rule 36(1)(a))

For the filing of second-generation divisional applications (i.e. divisional applications based on an earlier application which is itself also a divisional), the event which starts the period for voluntary division is the first communication in respect of the *earliest* application for which a communication has been issued. This is determined as illustrated by the following example:

Example 1

- EP1 is the original European application,
- EP2 is a divisional application based on EP1 and
- EP3 is a divisional application based on EP2.

Where a first communication (see IV, 1.1.1.2) has already been issued for EP1 when EP3 is filed (this is the usual situation), the period for voluntary division of EP2 (by the filing of EP3) is calculated from the date of notification of this first communication in respect of EP1. However, all that is required is that EP2 is still pending when EP3 is filed; EP1 does not need to be pending. This is because EP1 is the *earliest* application in respect of which a first communication has been issued (used to calculate the period for voluntary division), but it is not the *earlier* application which has been divided (this is EP2), and it is the *earlier* application (EP2) which must be pending according to Rule 36(1).

If no first communication has been issued for either EP1 or EP2 when EP3 is filed, the divisional is filed in time according to Rule 36(1), provided that EP2 is still pending.

Voluntary division in branched families of divisional applications

In cases where there are two divisional applications each derived from the same earlier (parent) application, the periods for voluntary division of the two divisional applications are calculated independently:

Example 2

- EP1 is the original European application,
- EP2a is a divisional application based on EP1 and
- EP2b is a divisional application based on EP1.

In example 2, the period for voluntary division of EP2a is calculated with reference to the appropriate communication issued in respect of EP1 or EP2a (as indicated under example 1 above) but not EP2b. Likewise, the period for voluntary division of EP2b is calculated with reference to the appropriate communication issued in respect of EP1 or EP2b but not EP2a. These cases are treated in the same way as example 1 above, but ignoring any divisional applications which are not in a direct line from the divisional being filed to the earliest application.

Mandatory division (Rule 36(1)(b))

In example 1, the period for mandatory division of EP2 (by filing EP3) is calculated from the first communication in examination raising a specific objection of lack of unity for the first time (see IV, 1.1.1.3).

1.1.1.5 Legal remedies for late filing of a divisional application

Failure to file within the applicable twenty-four-month period

Art. 121
Art. 122

The periods specified in Rule 36(1)(a) and Rule 36(1)(b) are excluded from further processing (Rule 135(2)). If a divisional application is not filed within the later-expiring of the periods specified in Rule 36(1)(a) and Rule 36(1)(b) (see IV, 1.1.1.2 and 1.1.1.3), the applicant may request re-establishment of rights in respect of this failure (see E-VIII, 2.2). The applicant must (i) request re-establishment (Rule 136(1)) and (ii) complete the omitted act (i.e. file the divisional application - Rule 136(2)) within a period of two months from the removal of the cause of non-compliance with the above-mentioned period (but at the latest within one year of expiry of the unobserved period).

Re-establishment of rights pursuant to Art. 122 is excluded in respect of the requirement for a divisional application to be filed while the

earlier application is pending (J 10/01, not published in OJ). This is because, unlike the twenty-four-month periods for voluntary and mandatory division under Rule 36(1)(a) and (b), this requirement of Rule 36(1) does not constitute a time limit for the filing of a divisional application, but rather a point in time by which a divisional must be filed. Consequently, further processing is also not available.

1.1.2 Persons entitled to file a divisional application

Only the applicant on record may file a divisional application. This means that, in the case of a transfer of an application, a divisional application may only be filed by or on behalf of the new applicant if the transfer was duly registered and therefore effective (Rule 22) at the filing date of the divisional application.

1.2 Date of filing of a divisional application; claiming priority

1.2.1 Date of filing

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

Art. 76(1), 2nd sentence

A divisional application filed in due form, i.e. meeting the requirements of Art. 80 and Rule 40(1) (see II, 4.1 et seq.), is accorded the same date of filing as the parent application. The question of whether it is confined to subject-matter contained in the parent application is not decided until the examination procedure (see C-VI, 9.1.4 et seq.).

Art. 80
Rule 40(1)

Since Rule 40(1) does not require that a European application contain any claims on its date of filing, the same applies to a European divisional application. The applicant can file the claims after the filing of the divisional application according to the procedures detailed in III, 15. This may be done after the parent application is no longer pending and after expiry of the periods for voluntary and mandatory division, provided that the requirements of Rule 40(1) were satisfied with regard to the divisional (i) while the parent application was still pending and (ii) before expiry of the relevant period (see IV, 1.1.1, 1.1.1.1, 1.1.1.2 and 1.1.1.3).

1.2.2 Claiming priority

A priority claimed in the parent application may apply also to the divisional application. Provided that the parent application's priority claim has not lapsed, the divisional application retains that priority; it is not necessary to claim it formally a second time. A parent application’s priority claim will, however, not be retained, if that priority claim is withdrawn in the divisional application. For the withdrawal of a priority claim see C-V, 3.5 and E-VIII, 6.2 and 6.3. If a copy and any translation of the priority application have been filed in respect of the parent application before the divisional application is filed, it is not necessary to file the priority documents again in respect of the divisional

Rule 53(2) and (3)

application. The EPO makes a copy of these documents and places them in the file of the divisional application (see Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, B.2).

If, when the divisional application is filed, the priority document has not been filed in respect of the parent application, it must be filed in respect of the divisional application and, if the priority of the parent application's remaining subject-matter is to be retained, in respect of the parent application also. The applicant can also inform the EPO, within the time limit set for filing priority documents in the divisional application proceedings, that he has in the meantime submitted these documents in respect of the parent application. If the subject-matter of the divisional application relates only to some of the priorities claimed in the parent application, priority documents in respect of the divisional application need be filed for those priorities only.

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

1.3 Filing a divisional application

1.3.1 Where and how to file a divisional application?

Rule 36(2) A divisional application must be filed by delivery by hand or by post
Rule 35(1) with the EPO in Munich, The Hague or Berlin. It may also be filed using the *epoline*® Online Filing software (Art. 5 of the Decision of the President dated 26 February 2009, OJ EPO 3/2009, 182). The filing of a European divisional application with a national authority has no effect in law; the authority may however, as a service, forward the European divisional application to the EPO. If a competent national authority chooses to forward the application, it is not deemed received until the documents are filed at the EPO.

The divisional application may be filed by reference to the earlier application from which it derives (the parent application). The procedures are as provided for in Rule 40(1)(c), (2) and (3) (see II, 4.1.3.1). It will not be necessary for the applicant to file a copy or translation of the previous (parent) application according to Rule 40(3), since these will already be available to the EPO in the file of the previous (parent) application.

1.3.2 Request for grant

Rule 41(2)(e) The request for grant of a patent must contain a statement that a divisional application is sought and state the number of the parent application. If the request is deficient, as can arise if there is no indication that the application constitutes a divisional application, although some of the accompanying documents contain an indication to that effect, or if the number is missing, the deficiency may be corrected in the manner indicated in III, 16. The applicant is also advised to include in the request for grant information relating to

communications issued in respect of the earlier and earliest application on which the divisional application is based. This information makes it easier to calculate the periods for voluntary and mandatory division (see IV, 1.1.1.2 and 1.1.1.3 respectively).

1.3.3 Language requirements

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

1.3.4 Designation of Contracting States

All Contracting States designated in the earlier application at the time of filing a European divisional application, are deemed to be designated in the divisional application (see also G 4/98, OJ 3/2001, 131). If no designations have been withdrawn in respect of the parent application, then all Contracting States adhering to the EPC at the date of filing of the parent are automatically designated in the divisional application when it is filed. Conversely, Contracting States, the designations of which have been withdrawn in respect of the parent application at the time of filing the divisional application, cannot be designated in respect of the divisional application. *Art. 76(2)* *Rule 36(4)*

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

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

1.3.5 Extension States

For the extension to specific states not party to the EPC of European patents arising from divisional applications, see III, 12.1.

1.4 Fees

1.4.1 Filing, search and designation fee(s)

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

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

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

Rule 36(3) and (4)

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

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

1.4.2 Claims fees

Rule 45(1)

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

1.4.3 Renewal fees

Art. 86(1)
Art. 76(1)
Rule 51(3)
Art. 2, No. 5, RFees

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

renewal fee in addition to those to be made good falls due, or a renewal fee falls due for the first time.

If, within the four-month period referred to above, a further renewal fee falls due or a renewal fee falls due for the first time, it may be paid without an additional fee within that period. It may otherwise still be validly paid within six months of the due date, provided that at the same time the additional fee of 50% of the renewal fee paid late is paid. When calculating the additional period the principles developed by the Legal Board of Appeal should be applied (see J 4/91, OJ 8/1992, 402).

Rule 51(3)
Art. 2, No. 5, RFees

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

Example:

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

1.5 Designation of the inventor

The provisions of III, 5.5 apply with regard to the designation of the inventor, except that, where the designation of the inventor has not been provided or is deficient (i.e. it does not comply with Rule 19), the applicant will be invited to provide or correct it within a period to be specified by the EPO, which must be a minimum of two months (Rule 132(2)). The divisional application requires a separate designation, independent of the parent application on which it is based.

Rule 60(2)

1.6 Authorisations

The provisions of IX, 1.5 and 1.6 apply with regard to authorisations in respect of the divisional application. If, according to these provisions,

the representative has to file an authorisation, he may act on the basis of an individual authorisation filed in respect of the parent application only if it expressly empowers him to file divisional applications.

1.7 Other formalities examination

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

1.8 Further procedure

Divisional applications are searched, published and examined in the same way as other European patent applications. The search fee is refunded if the conditions of Art. 9(2) of the Rules relating to Fees are met (see the Notice from the President of the EPO dated 13 December 2001, OJ 1/2002, 56, for divisional applications filed before 1 July 2005, the Decision of the President of the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, M.2 for divisional applications filed on or after 1 July 2005 for which the search is completed before 1 April 2009, and the Decision of the President of the EPO dated 22 December 2008, OJ 2/2009, 96 for divisional applications for which the search is completed on or after 1 April 2009). Here, the term "filed" refers to the date on which the divisional application is received at the EPO, not the filing date, which is the same as the filing date for the parent application (Art. 76(1)). The time limit for filing the request for examination begins to run with the date of mention of the publication of the search report concerning the divisional application.

2. Art. 61 applications

2.1 General

Art. 61(1)
Rule 16

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

Art. 61(1)(a)

(i) prosecute the application as his own application in place of the applicant (see IV, 2.6 and 2.9);

Art. 61(1)(b)

(ii) file a new European patent application in respect of the same invention (see IV, 2.7 and 2.9); or

Art. 61(1)(c)

(iii) request that the application be refused (see IV, 2.8 and 2.9).

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

2.2 Staying the proceedings for grant

Rule 14(1)

If a third party provides proof to the EPO that he has opened proceedings against the applicant for the purpose of seeking a judgement that he is entitled to the grant of the European patent – which proof may take the form of confirmation by the court – the EPO will stay the proceedings for grant unless the third party consents to the continuation of such proceedings. Such consent must be communicated in writing to the EPO; it is irrevocable. However, proceedings for grant may not be stayed before the publication of the European patent application. Staying must be ordered by decision. This is an interim decision, which under Art. 106(2) may only be appealed together with the final decision. These matters are dealt with by the Legal Division (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, G.1).

Under Art. 164(1), the Protocol on Recognition is an integral part of the European Patent Convention. It governs the jurisdiction and recognition of decisions for EPC Contracting States.

2.3 Resumption of the proceedings for grant

Rule 14(3)

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

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

Rule 14(2)

Where proof is provided to the EPO that a decision which has become final has been given in the proceedings concerning entitlement to the grant of a European patent, the EPO must communicate to the applicant and any other parties that the proceedings for grant will be

resumed as from the date stated in the communication unless a new European patent application pursuant to Art. 61(1)(b) has been filed for all designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the proceedings for grant.

2.4 Interruption of time limits

Rule 14(4)

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

Example: The six-month time limit under Art. 94(1) and Rule 70(1) begins on 1 July 2008. Proceedings are stayed on 23 September 2008 and resumed on 4 August 2009. The last day of the period already elapsed is 22 September 2008. The time which has not elapsed is therefore 8 days and 3 months, begins on 4 August 2009 and ends on 11 November 2009.

2.5 Limitation of the option to withdraw the European patent application

Rule 15

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

2.6 Prosecution of the application by a third party

Art. 61(1)(a)

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

2.7 Filing a new application

Art. 61(1)(b)
Art. 76(1)

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

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

Art. 61(2)

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

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

(iii) filing, search, designation and claims fees – see IV, 1.4.1 and 1.4.2; *Rule 17(2) and (3)* *Rule 45(1)*

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

(v) language requirements - see IV, 1.3.3.

However, arrangements for renewal fees are different. For the year in which the new application is filed and for the years beforehand, no renewal fees are payable. *Rule 51(6)*

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

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

The earlier application is deemed to be withdrawn on the date of filing of the new application for the Contracting States designated therein in which the decision has been taken or recognised. *Rule 17(1)*

2.8 Refusal of the earlier application

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

2.9 Partial transfer of right by virtue of a final decision

If by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, Art. 61 and Rules 16 and 17 apply to such part. *Rule 18(1)*

3. Display at an exhibition

3.1 Certificate of exhibition; identification of invention

Where an applicant states when filing his application that the invention which is the subject of the application has been displayed at an official or officially recognised international exhibition falling within the terms of the Convention on international exhibitions, he must file a certificate of exhibition within four months of the filing of the European patent application. The exhibitions recognised are published in the Official Journal. The certificate, must: *Art. 55(1)(b) and (2)* *Rule 25*

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

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

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

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

3.2 Defects in the certificate or the identification

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

4. Applications relating to biological material

4.1 Biological material; deposit thereof

Rule 26(3)

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

Rule 31(1)(c) and (d)
Rule 31(2)

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

Rule 31(2)(a)

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

Rule 31(2)(b)

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

Rule 31(2)(c)

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

The above time limit according to Rule 31(2) is excluded from further processing by Rule 135(2).

Moreover, when the depositor and applicant are not identical, the same time limit applies for submitting a document satisfying the EPO that the depositor has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with Rule 33(1) and (2) or Rule 32(1). *Rule 31(1)(d)*

The depositary institution must be one appearing on the list of depositary institutions recognised for the purposes of Rules 31 to 34, as published in the Official Journal of the EPO. This list includes the depositary institutions, especially the International Depositary Authorities under the Budapest Treaty. An up-to-date list is regularly published in the Official Journal. *Rule 33(6)*

4.1.1 New deposit of biological material

If biological material deposited according to Rule 31 ceases to be available from the recognised depositary institution, an interruption in availability shall be deemed not to have occurred if: *Rule 34*

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

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

The non-availability may occur because, for example:

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

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

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

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

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

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

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

4.1.2 The application was filed by reference to a previous application

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

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

4.2 Missing information; notification

Art. 97(2)
Rule 31
Art. 83

When the Receiving Section notices that the information required under Rule 31(1)(c) (indication of the depositary institution and the accession number of the culture deposit) or the information and the document referred to in Rule 31(1)(d) (authorisation to refer to the deposit and the consent to it being made available) is not contained in or has not yet been submitted with the application, it should notify the applicant of this fact as this information can only be validly submitted within the time limits specified in Rule 31(2). In the case of missing information pursuant to Rule 31(1)(c), the deposit must be identified in the patent application as filed in such a way that the later submitted accession number can be traced back without ambiguity. This can normally be done by indicating the identification reference given by the depositor within the meaning of Rule 6.1(a)(iv) of the Budapest Treaty (see G 2/93, OJ 5/1995, 275). The applicant is also informed when a deposit with a recognised depositary institution is referred to but no receipt from the depositary institution has been filed. Any further action is a matter for the Examining Division. See also C-II, 6, in particular 6.3(ii), as regards the Examining Division's treatment of applications relating to biological material. The time limit according to Rule 31(2) for

supplying the information required by Rule 31(1)(c) and (d) is excluded from further processing by Rule 135(2).

4.3 Availability of deposited biological material to expert only

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

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

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

If the applicant duly informs the EPO under Rule 32(1), the biological material is issued only to an expert recognised by the President of the EPO or approved by the applicant. *Rule 32(2)*

The list of recognised microbiological experts, giving their particulars and their fields of activity, is published in the Official Journal (see OJ 8/1992, 470). *Rule 33(6)*

5. Applications relating to nucleotide and amino acid sequences

If nucleotide and amino acid sequences within the meaning of Rule 30(1) are disclosed in the European patent application, they are to be represented in a sequence listing which conforms to WIPO Standard ST. 25. The sequence listing should, where it is filed together with the application, be placed at the end of the application (see WIPO Standard ST. 25, point 3). The sequence listing may be filed on paper. In that case, a copy of the sequence listing must also be submitted in computer-readable form. Where the European patent application is filed online, the computer-readable form is to be attached. Data in computer-readable form must comply with WIPO Standard ST. 25, paragraph 39ff. Where the application is filed on paper, the information recorded on the electronic data carrier must be identical to the sequence listing on paper which constitutes the legally determinative version. The applicant or his representative must submit a statement to that effect accompanying the data carrier in accordance with Rule 30(1) and WIPO Standard ST. 25. See the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 and the accompanying Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2. Where a *Rule 57(j)* *Rule 30(1) and (2)*

sequence listing is filed or corrected after the filing date, the applicant is required to submit a statement that the sequence listing so filed or corrected does not include matter which goes beyond the content of the application as filed.

Art. 90(3)
Rule 30(3)

The Receiving Section will inform the applicant of any deficiencies as to the sequence listing or as to the necessary statements and invite him to remedy the deficiencies and pay a late furnishing fee within a non-extendable period of two months. If the requirements of Rule 30 in conjunction with the Decision of the President of the EPO dated 2 October 1998 are not complied with in due time, where appropriate following the invitation to do so from the Receiving Section, which includes the payment of the late furnishing fee, the application will be refused according to Rule 30(3).

Art. 121
Rule 135

The applicant may request further processing of the application.

5.1 Sequence listings filed under Rule 56

If the application as originally filed does not disclose any sequences, such that the EPO cannot be aware of any deficiency, then no communication according to Rule 30(3) or Rule 56(1) will be sent to the applicant. In such cases, the applicant may, under Rule 56(2), file the missing parts of the description relating to sequences of his own motion within two months of the date of filing (see II, 5.2). According to Rule 57(j), any sequence information thus filed will be checked for compliance with Rule 30(1) in conjunction with the rules laid down by the President of the EPO, including the requirement to furnish the listing on a prescribed data carrier and to furnish the statement of identity of the listing on the data carrier with the written listing.

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

If, on the other hand, the sequence information thus filed already conforms to the requirements of Rule 30(1), no Rule 30(3) communication will be sent.

The above applies regardless of whether or not the late-filed parts of the description result in a change of the date of filing (see II, 5.3) or if the late-filed missing parts can be based on the claimed priority, allowing the original date of filing to be maintained (see II, 5.4). If, however, the late-filed parts of the description result in a change of the filing date, any communication according to Rule 30(3) which might be required will only be sent after the one-month period for the withdrawal of the late-filed parts has expired without the applicant having withdrawn them (see II, 5.5).

Where the application as filed contains a sequence listing which does not contain all the sequences disclosed in the application documents,

the sequence listing, due to this incompleteness, cannot be considered as complying with WIPO Standard ST. 25. Hence, the applicant will be invited under Rule 30 to file a standard compliant sequence listing and to pay the late furnishing fee.

In the case where the applicant inserts a sequence listing which conforms to the requirements of Rule 30(1) into the description as a late-filed part of the description according to Rule 56, the sequence listing so added is considered part of the description on the date of filing (regardless of whether or not this has changed). That is to say, in this case Rule 30(2) does not apply.

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

Where the application is filed by reference to a previously filed application (see II, 4.1.3.1), and that previously filed application contained sequence listings on its date of filing, then those sequence listings form part of the application as originally filed. This is subject to the exception that, where the sequences only appear in the claims and not in the description or drawings of the previously filed application, and the applicant did not include the claims of the previously filed application in the reference, then those sequences are not included in the European application as originally filed, even if the applicant subsequently filed a sequence listing complying with WIPO Standard ST. 25 later on in the prosecution of that previously filed application (later filed sequence listings are not part of the description according to Rule 30(2)).

Where the previously filed application is not available to the EPO, it will not be possible to carry out the check according to Rule 57(j) on the compliance of the listing with Rule 30(1) until the applicant files the certified copy and any translation required, which must be done within two months of the date of filing (Rule 40(3)). After the certified copy and translation, where applicable, are received, if it transpires that the listing contained therein does not comply with Rule 30(1) in conjunction with the rules laid down by the President of the EPO, the European Patent Office will send a communication according to Rule 30(3) inviting the applicant to correct any deficiencies (including the lack of a statement of identity of the listing on the data carrier with the written listing and/or the lack of the listing on the prescribed data carrier) and pay the late furnishing fee (see IV, 5).

If the previous application referred to is a European application or an International application filed with the EPO as receiving Office, and this application satisfied the requirements of Rule 30 or Rule 5(2) PCT in combination with WIPO Standard ST. 25 *on its date of filing* then all the requirements of Rule 30(1) are satisfied automatically on the date of filing of the European application filed by reference to this application.

In all other cases, however, the applicant will have to ensure that all the requirements of Rule 30(1), in conjunction with the rules laid down by

the President of the EPO, are met. This means that if the previously filed application referred to is not one of the above types of application, even where it contains a written sequence listing conforming to WIPO Standard ST. 25, the applicant will still have to provide a computer-readable form of the sequence listings complying with WIPO Standard ST. 25 and a statement that the information recorded on the data carrier is identical to the written sequence listing, in order to satisfy the requirements of Rule 30(1) in conjunction with the rules laid down by the President of the EPO. This includes the case where the previously filed application was a European application or International application filed with the EPO as receiving Office, but where one or more of the elements required to satisfy the requirements of Rule 30(1) or Rule 5(2) PCT in conjunction with WIPO Standard ST. 25 were not present on the date of filing. If this is not the case, the procedure in IV, 5 will be followed (a communication under Rule 30(3) will be sent).

6. Conversion into a national application

Art. 135

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

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

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

Art. 135(3)
Rule 155(2)

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

Chapter V

Communicating the formalities report; amendment of application; correction of errors

1. Communicating the formalities report

After a formalities examination, the Receiving Section or, where appropriate, the Examining Division, issues a report to the applicant if the application is found to be formally defective. The report will identify all the particular requirements of the EPC which the application does not satisfy and, in the case of deficiencies which can be corrected, will invite the applicant to correct such deficiencies within specified periods (see III, 16). The applicant will be notified of the consequences, e.g. application deemed withdrawn, priority right lost, which result from the deficiencies or failure to take appropriate action within due time.

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

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

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

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

2. Amendment of application

2.1 Filing of amendments

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

Prior to the receipt of the European search report the applicant may amend his application only if the Receiving Section has invited him to remedy particular deficiencies, including the case where no claims are present in the application as originally filed, wherein the applicant must rectify this deficiency by filing a set of claims in response to a communication according to Rule 58 (see III, 15). After receipt of the European search report and before receipt of a first communication from the Examining Division, i.e. also during the period in which the application may still be with the Receiving Section, the applicant may of his own volition amend the description, claims and drawings (Rule 137(2)). Furthermore, where a search opinion accompanies the search report under Rule 62(1), the applicant must respond to it by filing observations and/or amendments (see B-XII, 9 for details and exceptions to this requirement). However, the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as

filed (regarding the publication of claims thus amended in response to the European search report under Rule 137(2), see also VI, 1.3).

2.2 Examination of amendments as to formalities

Rule 58
Rule 137(1)

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

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

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

Amendments which extend beyond the remedying of deficiencies and which are filed prior to receipt of the search report may be taken into consideration in the subsequent procedure provided that, on receipt of the search report, the applicant declares that he wishes them to be maintained.

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

The procedure for effecting amendments is dealt with in E-II.

3. Correction of errors in documents filed with the EPO

Rule 139

Linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. Requests for such amendments may be made at any time. However, if the error to be corrected concerns items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction, the request for correction must be filed as soon as possible, and at least in time that it could be incorporated in the publication of the European patent application. With regard to correction of priority claims, specific provisions apply, with a view to protecting the interests of third parties, which allow the applicant to correct priority claims and lay down a time limit for doing so (see Rule 52(3) and III, 6.5.2). This

ensures that corrected priority information is available when the application is published. The applicant can only correct the priority claim later than this date, in particular after publication of the application, under certain limited circumstances, where it is apparent on the face of the published application that a mistake has been made. See J 2/92, J 3/91 and J 6/91, OJ 6/1994, 375, 365 and 349, respectively, as well as J 11/92, OJ 1-2/1995, 25, and J 7/94, OJ 12/1995, 817. Each of these decisions indicated situations under EPC 1973 in which the correction of priority data too late for a warning to be published with the application could be allowed. These same situations apply mutatis mutandis under EPC 2000 to the acceptance of requests to correct priority claims after the end of the time limit according to Rule 52(3). Regarding correction of the date indicated for the previous filing, see also III, 6.6.

Rule 139, 2nd sentence

If the error is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else could have been intended than what is offered as the correction. Such a correction may be effected only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see G 3/89 and G 11/91, OJ 3/1993, 117 and 125; see also C-VI, 5.4). The documents to be considered in assessing whether or not the correction is allowable are those of the application as originally filed, including any late-filed missing parts of the description, or drawings filed according to Rule 56, regardless of whether this resulted in a change of the date of filing (see II, 5 *et seq*). However, claims filed after the filing date in response to an invitation according to Rule 58 (see III, 15) cannot be used in assessing the allowability of the request.

In the case of electronic filing of European patent applications, the technical documents (description, claims, abstract and drawings) may be attached in their original format, provided this format is one listed in the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.5. Pursuant to this Decision, these technical documents may also be attached in a format other than those listed, provided that the applicant informs the EPO, when filing the application, where the EPO can reasonably acquire the corresponding software. If, on the date of filing, the documents making up the European patent application are available both in the format provided by the *epoline*® Online Filing software and in another admissible format in accordance with the above-mentioned Notice, the documents in the latter format can also be used in order to determine whether a request for correction of the description, claims, or drawings is allowable.

It is in particular not allowable to replace the complete application documents (i.e. description, claims and drawings) by other documents which the applicant had intended to file with his request for grant (see G 2/95, OJ 10/1996, 555). The Examining Division decides on the request for correction. If a request for correction is pending before

termination of the technical preparations for publication, a reference to the request is published on the front page.

Chapter VI

Publication of application; request for examination and transmission of the dossier to Examining Division

1. Publication of application

1.1 Date of publication

The application is published as soon as possible after the expiry of a period of eighteen months from the date of filing or, where priority is claimed, from the earliest priority date. The application may, however, be published before that date if requested by the applicant and provided the filing and search fees have been validly paid. If the decision granting the patent becomes effective before expiry of the period referred to above, the application and the patent specification will both be published early. *Art. 93(1)*

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

1.2 No publication; preventing publication

The application is not published if it has been finally refused or deemed withdrawn or withdrawn before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day five weeks before the end of the eighteenth month from the date of filing or priority (see the Notice from the EPO, OJ 6/2006, 406). The application is, however, published if, upon termination of the technical preparations for publication, a request for a decision under Rule 112(2) has been received but no final decision has yet been taken (see OJ 11/1990, 455). *Rule 67(2)*

If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed.

The EPO will however try (in accordance with the principles of J 5/81, OJ 4/1982, 155) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily.

Rule 15

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

1.3 Content of the publication

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

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

The publication also indicates as designated Contracting States all States party to the EPC on the date the application was filed, unless individual states have been withdrawn by the applicant before the termination of the technical preparations for publication. When a European application filed before 1 April 2009 is published, the States for which protection is actually sought may not yet be known, because the time limit under Rule 39(1) for paying the designation fees is still running. Those definitively designated – through actual payment of designation fees – are announced later in the Register of European Patents and the European Patent Bulletin (see Information from the EPO, OJ 10/1997, 479). For European divisional applications, see A-IV, 1.3.4.

Rule 68(2) and (4)
Rule 66
Rule 139

The publication also contains any new or amended claims filed by the applicant under Rule 137(2), together with the European search report and the abstract determined by the Search Division if the latter are available before termination of the technical preparations for publication. Otherwise the abstract filed by the applicant is published. The search opinion is not published with the European search report (Rule 62(2)). It is however open to file inspection (see XII, 2.1). If a request for correction under Rule 139 of errors in the documents filed with the EPO is allowed, it must be incorporated in the publication. If

upon termination of the technical preparations for publication a decision is still pending on a request for correction of items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction, this must be mentioned on the front page of the publication (see the case law in V, 3), as must a request for correction of errors in the description, claims or drawings (see V, 3). If the EPO has received a communication from the applicant under Rule 32(1), ("expert solution"), this too must be mentioned. Further data may be included at the discretion of the President of the EPO.

With the exception of documents which must be translated, originals of documents filed are used for publication purposes where these documents meet the physical requirements referred to in IX, 2, otherwise the amended or replacement documents meeting these requirements are used. Prohibited material may be omitted from the documents before publication, the place and number of words or drawings omitted being indicated (see III, 8.1 and 8.2). Documents incorporated in an electronic file are deemed to be originals (Rule 147(3)).

1.4 Publication in electronic form only

All European patent applications, European search reports and European patent specifications are now published in electronic form only, on a publication server (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.3 and OJ 2/2005, 126). These documents are not published on paper.

1.5 Separate publication of the European search report

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

2. Request for examination and transmission of the dossier to the Examining Division

2.1 Communication

Rule 69(1) and (2)

The Receiving Section communicates to the applicant the date on which the European Patent Bulletin mentioned the publication of the European search report and draws his attention to the provisions with regard to the request for examination as set out in Art. 94(1) and (2) and Rule 70(1). The applicant may not invoke the omission of the communication. If the communication wrongly specifies a later date than the date of the mention of the publication, the later date is decisive as regards the time limit for filing the request for examination (see VI, 2.2) and also for responding to the search opinion (see B-XII, 9 and VI, 3) unless the error is apparent. In the communication, the applicant is also informed that the designation fee(s) must be paid within six months of the date on which the European Patent Bulletin mentioned the publication of the search report (see III, 11.2 and 11.3).

2.2 Time limit for filing the request for examination

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

The request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request for examination is not deemed to have been filed until the examination fee has been paid. If the applicant does not file the request for examination, including the payment of the examination fee, within the above time limit, then the procedure explained in VI, 2.3 applies.

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

The mandatory Request for Grant form (Form 1001), contains a written request for examination. The applicant has only one procedural act – payment in due time of the examination fee (Art. 94(1) and Rule 70(1)) – to worry about.

Art. 11(a) RFees

On the other hand, there is nothing to stop him paying the examination fee at the same time as he files the application. If, after receipt of the European search report, he decides not to pursue the application further and does not react to the invitation pursuant to Rule 70(2), the application will be deemed withdrawn pursuant to Rule 70(3), and the examination fee will be refunded in its entirety (see VI, 2.5).

Point 12 AAD
Point 6.1(b) AAD

If the applicant has filed an automatic debit order, the examination fee will normally be debited at the end of the six-month period. For cases in which he wishes the application to be transmitted earlier to the Examining Division, see the AAD in Annex A.1 of Supplement No. 1 to OJ 3/2009).

Rule 70(1)

The request for examination may not be withdrawn.

Regarding Euro-PCT applications entering the European phase, see VII, 1.3 and 5.2.

2.3 Legal remedy

Art. 94(2)
Rule 112(1)

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

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

If the applicant has validly filed a request for examination before the European search report has been transmitted to him, the Receiving Section invites him according to Rule 70(2) to indicate within six months from the date of the mention of the publication of the search report in the European Patent Bulletin whether he desires to proceed further with his application. If he fails to respond to this request in time, the application is deemed to be withdrawn and the applicant is notified accordingly. In this case, the applicant may also avail himself of the legal remedy under Art. 121 and Rule 135 (further processing of the application). Regarding reimbursement of the examination fee, cf. VI, 2.2 and XI, 10.2.4. C-VI, 1.1.2 describes the procedure in respect of a categorical request for examination, as provided for in

Rule 10(4), where the applicant waives the right to the communication according to Rule 70(2).

Regarding Euro-PCT applications entering the regional phase, see VII, 1.3 and 5.2.

2.4 Transmission of the dossier to the Examining Division

Art. 16
Art. 18(1)
Rule 10

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

The dossier as transmitted to the Examining Division contains the following, some of which are present in a paper dossier, while others are present in a corresponding computer dossier:

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

(ii) any certificate filed in relation to display at an exhibition (see IV, 3) and any information furnished under Rule 31 when the application relates to biological material (see IV, 4);

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

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

(v) the applicant's response to the search opinion (see B-XII, 9) or to the WO-ISA/IPER prepared by the EPO (see C-VI, 3.5.1); and

(vi) all relevant correspondence. Copies of certain EPO communications to applicants or inventors – currently EPO Forms 1048, 1081, 1082 and 1133 – are kept only in the corresponding computer dossier: their most important elements can at all times be printed out (as EPO Form 1190) and placed in the paper dossier.

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

2.5 Refund of examination fee

Art. 11 RFees

The examination fee is refunded:

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

(ii) at a rate of 75% if the European patent application is withdrawn, refused or deemed to be withdrawn after the Examining Divisions have assumed responsibility but before substantive examination has begun. This applies in particular where the applicant does not respond to the search opinion on time (leading to the application being deemed to be withdrawn under Rule 70a(3) - see B-XII, 9), but does file on time either the request for examination according to Rule 70(1) (see C-VI, 1.1) or confirmation that he wishes to proceed with the application according to Rule 70(2) (see C-VI, 1.1.1). An applicant unsure whether substantive examination has begun and wanting to withdraw the application only if he will receive the 75% refund may make withdrawal contingent upon the refund ("conditional" withdrawal).

2.6 Reduction in examination fee

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

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

3. Response to the search opinion

Rule 70a

The applicant is required to respond to the search opinion within the time limit under Rule 70(1) or, if a communication under Rule 70(2) is sent (see C-VI, 1.1.1), within the time limit under Rule 70(2). If the applicant fails to respond to the search opinion on time, the application is deemed to be withdrawn (Rule 70a(3)). For more details see B-XII, 9.

Chapter VII

Applications under the Patent Cooperation Treaty (PCT) before the EPO acting as a designated or elected Office

1. General

1.1 Introduction

The general considerations relating to applications under the PCT for which the EPO acts are set out in E-IX.

Pursuant to Art. 153(2), an international application for which the EPO acts as a designated or elected Office is deemed to be a European patent application. For information about time limits and procedural steps before the EPO as a designated or an elected Office under the PCT, see the Guide for applicants "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT".

Art. 153(2)

In order to initiate the European phase, the requirements for entry into the European phase according to Rule 159 must be complied with (see VII, 1.2 and 1.3). For entry into the European phase, applicants are strongly recommended to use the most recent edition of Form 1200 obtainable from the EPO free of charge in printed form, as editable electronic document from the EPO website or as part of the epoline® Online Filing software.

This Chapter deals with the **differences** from the practice set out in earlier Chapters of this Part A of the Guidelines when dealing with such international applications as a designated or elected Office. However, it is necessary to consider briefly some of the provisions applicable to international applications as set out in VII, 1.2, 1.3 and 1.4 below.

1.2 Initial processing and formal examination; copy of the international application; translation

The initial processing and formal examination of international applications in the international phase are carried out by PCT authorities and under provisions of the PCT. Unless there is a specific request from the applicant, the EPO acting as a designated or elected Office may not process or examine an international application prior to the expiry of 31 months from the date of filing of the application or, if priority has been claimed, from the earliest priority date (see E-IX, 5.5 and 6.2). Since the EPO has not exercised the waiver referred to in Art. 20(1)(a) PCT, a copy of the international application will be furnished by the International Bureau. The EPO does not require the applicant to furnish a copy of the international application under Art. 22 PCT, even if the International Bureau has not communicated a copy under Art. 20 PCT (see PCT Gazette 14/1986, 2367).

Art. 23 PCT
Art. 40 PCT
Rule 49.1(a-bis) PCT
Art. 24(1)(iii) PCT
Rule 159(1)
Rule 160
Art. 121
Art. 2, No. 12, RFees

Where the language of the international application is not an official language of the EPO, the applicant is required, in accordance with Art. 22 or 39 PCT and Rule 159(1)(a), to furnish a translation within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date. The application is deemed to be withdrawn if the translation is not furnished within that period (Rule 160(1)). If the EPO finds that the application is deemed to be withdrawn for this reason, it communicates 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 and a valid request for further processing (including the payment of the requisite fee) are filed (Art. 121 and Rule 135(1)).

1.3 Filing fee, designation fee, request for examination, search fee and claims fees

Rule 159(1)
Rule 160
Art. 2, No. 12, RFees

Under Rule 159(1)(c), the applicant must pay the filing fee, including any additional fee for pages in excess of thirty-five (see A-III, 13.2), within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date. Further, under Rule 159(1)(d), he must pay the designation fee(s) within this period, if the time limit specified in Rule 39(1) has expired earlier. Under Rule 159(1)(f), the request for examination must also be filed within this period, if the time limit specified in Rule 70(1) has expired earlier. Where a supplementary European search report needs to be drawn up, a search fee must also be paid to the EPO within this period. Failure to pay in due time the filing fee, the additional fee, the search fee or the designation fee, or to file the request for examination, means that the application is deemed to be withdrawn.

For applications entering the European phase before 1 April 2009 (see A-III, 11.3.2), payment of no designation fee at all in due time similarly means that the application is deemed to be withdrawn, and any designation of a Contracting State for which the designation fee has not been paid in due time is also deemed to be withdrawn. If the EPO finds that the application or the designation of a Contracting State is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 160(3)). However, for these applications, if the applicant used Form 1200 for Entry into the European phase and waived the right to receive a communication according to Rule 160(3) in respect of designations other than those indicated specifically on Form 1200 by crossing the appropriate box in the appropriate section of the Form, a communication pursuant to Rule 160(3) is issued only where, contrary to his originally declared intention in Form 1200, he has failed to pay designation fees for States for which he had indicated his intention to pay.

The communication under Rule 160(3) and the communication according to Rule 112(1) are sent together in one and the same communication. In response to this notification of a loss of rights, the

applicant can request further processing. Any loss of rights ensues on expiry of the normal period (G 4/98, OJ 3/2001, 131).

If applicable, the claims fees under Rule 162 must also be paid within the normal period referred to above. If they are not, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to pay. If amended claims are filed during this grace period, they form the basis for calculating the number of claims fees due. Where a claims fee has not been paid in time, the claim concerned is deemed to be abandoned. Features of a claim deemed to have been abandoned pursuant to Rule 162(4) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims. *Rule 162*

1.4 PCT vs. EPC provisions

In proceedings before the EPO relating to international applications, the provisions of the PCT are applied, supplemented by the provisions of the EPC. In case of conflict, the provisions of the PCT prevail. The EPO cannot require compliance with requirements relating to form or contents of the international application different from or additional to those which are provided for in the PCT. As a result of the overriding PCT provisions and the requirements of Part X of the EPC, i.e. Art. 150 to 153, relating to international applications pursuant to the PCT, the practice set out in the earlier Chapters of this Part A of the Guidelines does not necessarily hold good for international applications. In particular, where the PCT international publication was in an official EPO language, it is not necessary for the Receiving Section to subject the copy of the application furnished to the EPO to a formalities examination except to the extent indicated later. On the other hand, where it is necessary to furnish a translation of the international application, the Receiving Section must carry out for that translation a more extensive formalities examination. *Art. 150(2)*

The formalities examination of an international application, **insofar as it differs** from that applicable to European direct applications, is considered in what follows by reference to the provisions of appropriate sections of the earlier Chapters of this Part A. Unless otherwise specified, the comments relate to the translation of the international application.

2. Provisions of Chapter II ("Filing of applications and examination on filing")

The provisions of II, 1 ("Where and how applications may be filed") do not apply to international applications, except where explicit reference is made to international applications, including Euro-PCT applications.

The PCT requirements corresponding to those of II, 2 ("Persons entitled to file an application") are more restrictive, as in general the applicant must be a resident or national of a PCT Contracting State and therefore no supplementary examination should be necessary.

The provisions of II, 3 ("Procedure on filing") do not apply.

The provisions for late filing of missing parts completely contained in the priority document (Rule 56) exist also under the PCT (Rule 20.5 - 20.8 PCT).

The date of filing (see II, 4 ("Examination on filing")) of a Euro-PCT application is that accorded under the PCT by the PCT authority which acted as the receiving Office. Nevertheless, the payment of the filing fee and the search fee and, where applicable, the supply of a translation pursuant to Art. 153(4) and Rule 159(1) should be checked. The period for supplying the translation and for payment of the above-mentioned fees is as specified in VII, 1.2 and 1.3.

If the application is not deemed to be withdrawn, a copy of the application is referred to the Search Division for drawing up any supplementary European search report, if necessary (see E-IX, 5.4).

3. Provisions of Chapter III ("Examination of formal requirements")

3.1 Representation

The provisions of III, 2 ("Representation") apply to international applications whether furnished in an official language or in translation. A professional representative having a right to practice before the PCT International Authorities is not necessarily authorised to act before the EPO (see Art. 27(7) PCT). For the representation of applicants before the EPO as designated or 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".

Rule 163(4) to (6)

If there is more than one applicant and the following information was not provided for one or more of those applicants in the International phase and is still missing at the expiry of the 31-month period under Rule 159(1):

(i) address

(ii) nationality

(iii) State of residence or principal place of business

the EPO will invite the applicant to furnish these indications within two months. Failure to do so will lead to refusal of the application. The same applies if the requirements for representation are not met at the end of the 31-month period, with the same consequence for failure to correct the deficiency in time. If the applicant fails to reply in time to the above-mentioned invitation, he may request further processing.

3.2 Physical requirements

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

3.3 Request for grant

The request for grant (see III, 4 ("Request for grant")) for international applications will appear on the PCT Request form (Form PCT/RO/101). This form corresponds in general to the EPO Request for Grant form (Form 1001) and provides for the entry of the information listed in Rule 41(2), with the exception of the items referred to in sub-paragraphs (e) and (f) thereof.

3.4 Designation of inventor

Rule 163(1)

The requirement, as set out in III, 5 ("Designation of inventor"), that the designation of inventor is filed in a separate document where the applicant is not the inventor or the sole inventor has to be complied with irrespective of the language of the international application, unless the inventor has already been named in the PCT request. Where the inventor has been named in the PCT request, he cannot waive his right to be mentioned in the published application. If the inventor has not been named in the international application at the expiry of the period of 31 months from the date of filing, or, in the case of priority, from the earliest date of priority claimed, the EPO invites the applicant to file the designation of inventor within a period of two months. Failure to rectify this deficiency in time, leads to refusal of the application according to Rule 163(6). The applicant will be notified of this decision according to Rule 111. He may request further processing.

3.5 Claim to priority

Rule 17.1 and 17.2 PCT

The claim to priority (see III, 6 ("Claim to priority")) for an international application refers to the date, or dates, claimed under the PCT. Normally, the copy of the previous application, referred to in III, 6.7, i.e. the priority document, is furnished to the EPO as designated Office by the International Bureau and not by the applicant. In accordance with Rule 17.2 PCT, the International Bureau will be requested by the EPO to furnish it with a copy as standard practice promptly, but not earlier than international publication, or, where the applicant has requested early examination (in accordance with Art. 23(2) PCT), not earlier than the date of the request. Where the applicant has complied with Rule 17.1(a) and (b) PCT, the EPO may not ask the applicant himself to furnish it with a copy.

Rule 163(2)

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the period of 31 months, the EPO invites the applicant to furnish the number or the copy within a specified period. However, Rule 53(2) and the Decision of the President of the EPO dated 17 March 2009, OJ EPO 4/2009, 236, providing an exception to the requirement that a copy of the previous

application be furnished (see III, 6.7), also apply to international applications entering the European phase. Furthermore, as just mentioned, where the applicant has complied with Rule 17.1(a) or (b) PCT the EPO as a designated Office may not ask the applicant himself to furnish it with a copy of the priority document (Rule 17.2(a) PCT, second sentence).

If the priority document is not on file, substantive examination may nevertheless be started. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing.

Art. 88(1)
Rule 53(3)

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed on request from the EPO in accordance with Rule 53(3) (see III, 6.8 and 6.10).

The provisions for restoration of priority rights (see III, 6.6) exist also under the PCT (Rules 26bis.3 and 49ter PCT). Under the PCT, restoration of right of priority can be made either in the international phase before the receiving Office (Rule 26bis.3 PCT) or in the regional phase before the EPO as designated Office (Rule 49ter.2 PCT).

It should be noted that the EPO both as a Receiving Office and as a designated Office will only accept the restoration of priority rights if it is made under the "due care" criterion (Rules 26bis.3(a)(i) and 49ter.2(a)(i) PCT). As a consequence, any restoration of priority rights made by a receiving Office under the "unintentional" criterion does not have an effect with the EPO as designated Office (Rule 49ter.1(b) PCT).

3.6 Title of the invention

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

3.7 Prohibited matter

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

3.8 Claims fee

The time limit for paying the claims fee referred to in III, 9 is, as indicated in VII, 1.3, 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (Rule 162(1)).

3.9 Drawings

The provisions of II, 5 with regard to the filing of drawings are identical with the corresponding provisions of the PCT and therefore no supplementary examination should be necessary.

3.10 Abstract

The abstract (see III, 10 ("Abstract")) is included in the copy of the international application supplied to the EPO.

3.11 Designation fee

The time limit for paying the designation fee is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date, if the time limit specified in Rule 39(1) has expired earlier (Rule 159(1)(d)) (see III, 11.2.5 and A III, 11.3.9 for further details). If, subsequent to the receipt of the international application by the EPO and prior to the date on which processing or examination may start, the regional designation of all Contracting States of the EPC is withdrawn, the Euro-PCT application, insofar as it is deemed to be a European application pursuant to Art. 153(2), is deemed to be withdrawn.

For information on the requirements for extension of a Euro-PCT application to States for which an Extension Agreement with the EPO has become effective, see III, 12.

4. Provisions of Chapter IV ("Special provisions")

4.1 Divisional applications

In relation to IV, 1 ("European divisional applications") there is no provision in the PCT for filing divisional applications. One or more European divisional applications may be filed in respect of subject-matter contained in an earlier Euro-PCT application, but not before the latter application is pending before the EPO acting as designated or elected Office, i.e. has entered the European phase (see IV, 1.1.1). The divisional application must be filed in the language of the proceedings of the earlier application (see IV, 1.3.3).

4.2 Sequence listings

Rules 5.2 and 13ter PCT apply to the filing of sequence listings (see IV, 5 ("Applications relating to nucleotide and amino acid sequences")). The EPO as International Searching Authority (see E-IX, 3) makes use of the opportunity under Rule 13ter.1 PCT to invite the applicant where appropriate to furnish it with the prescribed sequence listing in electronic form according to WIPO Standard ST. 25, paragraph 39 ff (see Art. 4 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.1 with the accompanying Notice from the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, C.2 (point II)). The furnishing of sequence listings in response to an invitation under Rule 13ter.1 PCT is subject to a late furnishing fee (see Rule 13ter.1(c) PCT).

Rule 163(3)

For Euro-PCT applications entering the regional phase before the EPO, the applicant will be invited to furnish a sequence listing in accordance with WIPO Standard ST. 25 and pay a late furnishing fee within a period of two months, if such a sequence listing is not available to the EPO at the expiry of the period for entry into the regional phase (see Rule 163(3) and Rule 30(3)).

5. Provisions of Chapter VI ("Publication of application; request for examination and transmission of the dossier to Examining Division")

5.1 Publication of the international application

Art. 153(3) and (4)

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

5.2 Request for examination

Art. 153(6)
Art. 150(2)
Rule 159(1)(f)

The time limit for filing the request for examination referred to in VI, 2 runs from the date of publication under Art. 21 PCT of the international search report. However, this time limit will not expire before the time prescribed by Rule 159(1)(f) (31 months from the priority date). See also VII, 1.3.

5.3 Supplementary European search

Rule 70(2)

If a supplementary European search report has to be drawn up in respect of an international application which is deemed to be a European patent application, the applicant is entitled to receive the invitation provided for in Rule 70(2) (see VI, 2.3, 2nd paragraph, and J 8/83, OJ 4/1985, 102).

6. Reduction and refunds of fees in respect of international (PCT) applications

See XI, 9.3 and 10.2.

7. The communication according to Rule 161

Rule 161(1)

If the EPO has acted as the ISA and, where a demand was filed, also as the IPEA for a Euro-PCT application, it gives the applicant the opportunity to comment on the written opinion of the ISA or the International Preliminary Examination Report and, where appropriate, invites him to correct any deficiencies noted therein and to file amendments within a period of one month from the respective communication. If the applicant does not respond in due time, the application will be deemed to be withdrawn, subject to certain exceptions (see C-VI, 3.5.1 for details). If the EPO has acted as ISA, but another office has acted as IPEA, under Rule 161(1) the applicant is required to respond to the written opinion prepared by the EPO as

ISA and not to the International Preliminary Examination Report prepared by the other office.

Where the EPO draws up a supplementary European search report on a Euro-PCT application (see B-II, 4.3), the application may be amended once within a period of one month from a communication informing the applicant accordingly. The application as amended serves as the basis for the supplementary European search. Failure to respond to this communication will not result in any sanction. However, the applicant will be required to respond to a search opinion accompanying the supplementary European search report for such an application, subject to certain exceptions (see B-XII, 9 for details). *Rule 161(2)*

If, on expiry of the time limit according to Rule 161(1) or (2), Rule 137(4) is not complied with in respect of amendments on which the further procedure is to be based (see C-VI, 5.7), after the Examining Division has assumed responsibility for the application (see C-VI, 1.1) it may send a communication according to Rule 137(4), requesting the applicant to remedy this deficiency (see C-VI, 3.5.1 and C-VI, 5.7.1), provided that the application is of one of the types mentioned in C-VI, 5.7.4.

Chapter VIII

Languages

1. Provisions concerning the language of the proceedings

1.1 Admissible languages; time limit for filing the translation of the application

European patent applications can be filed in any language. However, if filed in a language other than an official language of the EPO (English, French or German), a translation into English, French or German must be filed within two months of the date of filing (Rule 6(1)). Such translation may be subsequently brought into conformity with the original text of the application (but see VIII, 6.2). For the procedure where the translation is not filed in time, see III, 14.

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

Where the description is filed by reference to a previously filed application (see II, 4.1.3.1) and the previously filed application used for the reference is not in an official language of the EPO, the applicant must also file a translation into one of those languages within two months of the date of filing. With regard to the procedure when the translation is not filed on time, see also III, 14.

Rule 40(3)

However, the use of a non-EPO language does not automatically qualify the application for a reduction in the filing fee. This is only available under certain circumstances (see XI, 9.2.1 and 9.2.2).

1.2 Language of the proceedings

The language (chosen from English, French or German) in which the application is filed, or into which it is subsequently translated, constitutes the "language of the proceedings". Amendments to a European patent application or European patent must be filed in the language of the proceedings. This language is also used by the EPO in written proceedings. (As regards documents which are not filed in the correct language, see VIII, 4 below).

Art. 14(3)
Rule 3(2)

1.3 European divisional applications; Art. 61 applications

Any European divisional application must be filed in the language of the proceedings of the earlier application from which it is divided. Alternatively, if the earlier (parent) application was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application. In this case a translation into the language of the proceedings for the earlier application shall then be filed within two months of the filing of the divisional application (see A-III, 14). The same applies for the filing of a new European patent application under Art. 61(1)(b).

Rule 36(2)
Art. 61(2)

2. Derogations from the language of the proceedings in written proceedings

Rule 3(1)
Art. 14(3) and (4)
Rule 6(2)

In written proceedings before the EPO any party may use any official language of the EPO. However, in such proceedings the EPO uses the language of the proceedings in the sense of Art. 14(3). Natural or legal persons having their residence or principal place of business within an EPC Contracting State having a language other than English, French or German as an official language, and nationals of that state resident abroad, may file documents which have to be filed within a time limit in an official language of that state. For example, an Italian or Swiss applicant may file a reply to a communication from the Examining Division issued under Art. 94(3) in the Italian language. A translation of this document, into an official language of the EPO must be filed (Rule 6(2)). The translation can be into any EPO official language, regardless of the language of the proceedings.

Normally, the period allowed for filing this translation is one month after filing of the document, but if the document is a notice of opposition or appeal, or a petition for review (Art. 112a), the period extends to the end of the opposition or appeal period or the period for the petition for review, if this period expires later.

3. Documents to be used as evidence

Rule 3(3)

Documents which are to be used as evidence may be filed in any language. This applies during any proceedings before the EPO and applies especially to publications (for instance, an extract from a Russian periodical cited by an opponent to show lack of novelty or lack of inventive step). However, the department dealing with the case may require a translation in one of the languages of the EPO, at the choice of the person filing the document. If the document is filed by the applicant in pre-grant proceedings, the EPO should require a translation, unless the examiners are fully competent in the language concerned. In most cases, however, such documents will be filed in opposition proceedings and a translation should be required. The department concerned may require this translation to be filed within a time limit. This is to be fixed on a case-by-case basis. The period allowed should depend on the particular language concerned and on the length of the document to be translated, taking into account the provisions of Rule 132 (minimum of two months, maximum of four months, exceptionally six months). Failure to provide the translation within the specified time limit means that the EPO may disregard the document in question.

4. Documents filed in the wrong language

4.1 Documents making up a European patent application

Art. 78(1)

As explained in VIII, 1.1, all the documents making up a European application can be filed in any language (i.e. those listed in II, 4.1, plus the claims if present on the date of filing and any text of the drawings present on the date of filing). Consequently, it is not possible to file

these documents in the wrong language, provided that they are all in the same language and are furnished on the date of filing.

Divisional applications and applications according to Art. 61(1)(b), however, must be filed in the language of the proceedings of the earlier parent application from which they derive (see IV, 1.3.3).

4.2 Other documents

If any document other than those making up the application (e.g. a letter from the applicant in reply to an invitation under Art. 94(3)) is not filed in one of the prescribed languages or, where the applicant avails himself of Art. 14(4), the required translation is not filed in due time, it is deemed not to have been received. The person who has filed the document must be notified accordingly by the EPO. Accompanying documents relating to performance of a procedural act subject to a time limit (e.g. filing the designation of the inventor, the certified copy of the earlier application for which priority is claimed or that application's translation under Rule 53(3) into one of the official languages of the EPO) are dealt with as follows: if the European application number is given, the document goes into the dossier and the procedural act is recognised as having been performed, but any other contents are ignored. Regarding the signature of accompanying documents, see IX, 3.1.

Art. 14(4)
Rule 3(1) and (2)

According to Art. 115, following the publication of the European patent application, any person may file observations in writing concerning the patentability of the invention in respect of which the application has been filed. These written observations must be filed in English, French or German. Otherwise, they are deemed not to have been received.

Art. 115
Rule 114(1)

Even though deemed not to have been received, the document not filed in the prescribed language will become part of the file and therefore accessible to the public according to Art. 128(4). Observations by third parties and notices of oppositions will be communicated to the applicant or the patent proprietor, respectively, even if they have not been filed in the prescribed language and are therefore deemed not to have been filed (see Art. 14(4) and Rule 3(1) regarding the notice of opposition or Art. 14(4) and Rule 114(1) regarding third party observations) (see D-IV, 1.2.1 (v) regarding the legal consequences where a notice of opposition or notice of intervention of the assumed infringer is filed in a non-prescribed language).

Art. 128(4)
Art. 14(4)

5. Translation of the priority document

This point is dealt with in III, 6.8, C-V, 3.4 and D-VII, 2.

6. Authentic text

6.1 General remark

The text of an application or patent in the language of the proceedings is the authentic text. It follows therefore that the translation of the

Art. 70(1)

claims of the patent specification required by Art. 14(6) is for information only.

6.2 Conformity of translation with the original text

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

Where the applicant has filed an application in a language other than an official language of the EPO in accordance with Art. 14(2), or the application was filed by reference to a previously filed application which was not in an official language of the EPO (see II, 4.1.3.1) and the question arises as to whether a particular amendment proposed by the applicant or proprietor extends the content of the application or patent beyond the content of the application as filed and thus offends against Art. 123(2), the EPO should normally assume, in the absence of proof to the contrary, that the original translation into English, French or German is in conformity with the text in the original language, which can be any language (e.g. Japanese). However, it is the original text which constitutes the basis for determining such a question. Similarly, it is the original text which determines the content of the application as filed for the purposes of Art. 54(3) (see C-IV, 7.1). An erroneous translation from the original language of filing may be brought into conformity with the original language at any time during proceedings before the EPO, i.e. during pre-grant proceedings and also during opposition proceedings. But during opposition proceedings any amendment to bring the translation into conformity must not be allowed if it offends against Art. 123(3), that is if it is an amendment of the claims of the patent which extends the protection conferred.

7. Certificate of translation

Rule 5

The EPO has the power to require the filing of a certificate, certifying that a translation supplied corresponds to the original text, within a period to be determined by it. The exercise of this power should be determined on a case-by-case basis and ought to be used only when the official concerned has serious doubts as to the accuracy of the translation. The certificate could be called for either from the person who made the translation or from some other competent person. Failure to file the certificate in due time will lead to the document being deemed not to have been received unless the EPC provides otherwise. This partial loss of rights is subject to further processing under Art. 121 and Rule 135.

Rule 71(3)

Certificates are not in principle required in respect of the translations of the claims into the other two official languages required under Rule 71(3).

8. Derogations from the language of the proceedings in oral proceedings

Rule 4

These derogations are dealt with in E-V.

Chapter IX

Common provisions

1. Representation

1.1 Representation by a professional representative

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

Art. 133(1) and (2)
Art. 90(3)
Rule 152

1.2 Representation by an employee

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

Art. 133(3)
Art. 134(1)
Rule 152

1.3 Common representative

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

Art. 133(4)
Rule 151(1)

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

For Rule 151 to apply, each party or his duly authorised representative must have signed the document (request for grant, notice of opposition, etc.) giving rise to his participation (see also III, 4.2.2 and IX, 3.2 and 3.4). Otherwise the party cannot take part in the proceedings, nor therefore be represented by a common representative.

1.4 List of professional representatives; legal practitioners

Art. 134(1) and (8)

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

1.5 Signed authorisation

Rule 152

Representatives acting before the EPO must on request file a signed authorisation (see IX, 3.2) within a period to be specified by the EPO. If the requirements of Art. 133(2) are not fulfilled, the same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. Professional representatives who identify themselves as such will be required to file a signed authorisation only in certain cases (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, L.1). However, a legal practitioner entitled to act as a professional representative in accordance with Art. 134(8) or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, must file a signed authorisation; in Euro-PCT proceedings, persons representing clients in these capacities are not required to file signed authorisations if they have already filed an authorisation expressly covering proceedings established by the EPC with the EPO as receiving Office.

The authorisation can also be filed by the applicant. This also applies where the applicant is obliged to be represented, as fulfilling the requirement to be represented is not itself a procedural step under Art. 133(2) to which the rule of obligatory representation applies.

An authorisation remains in force until its termination is communicated to the EPO. The authorisation will not terminate upon the death of the person who gave it unless the authorisation provides to the contrary.

1.6 General authorisation

An authorisation may cover more than one application or patent. Also, a general authorisation enabling a representative to act in respect of all the patent transactions of the party making the authorisation may be filed. A corresponding procedure applies to the withdrawal of an authorisation.

Art. 133(2)
Rule 152(2), (4), (7), (8) and (9)

1.7 Invitation to file authorisation

Where the appointment of a legal practitioner entitled to act as professional representative in accordance with Art. 134(8), or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, is communicated to the EPO without an authorisation being filed, the representative is invited to file the authorisation within a period to be specified by the EPO. Where a party having neither residence nor principal place of business within a Contracting State has failed to fulfil the requirements of Art. 133(2) (cf. IX, 1.1), the invitation will be sent to him. The same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. The period may be extended in accordance with Rule 132 on request by the representative or party as the case may be (see E-VIII, 1.6). If such authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application will, without prejudice to any other legal consequences provided for in the EPC, be deemed not to have been taken. The party is informed accordingly.

Rule 152(2) and (6)
Rule 132

2. Form of documents

2.1 Documents making up the European patent application

The physical requirements which the documents making up the European patent application, i.e. request, description, claims, drawings and abstract, must satisfy are set out in Rule 49 and with regard to drawings in Rule 46. The President of the EPO may lay down further special formal or technical requirements for the filing of documents, in particular with regard to the filing of documents by technical means (Rule 2(1)). Notes on the preparation of OCR-readable patent applications were published in OJ 1-2/1993, 59. In relation to the drawings, the particular requirements are dealt with in Chapter X. The latter Chapter should, however, also be consulted with regard to the other documents mentioned, as the comments therein on the provisions of Rule 49 are of general application. Here, attention

need only be drawn to Rule 49(7) which states that "the lines of each sheet of the description and of the claims shall preferably be numbered in sets of five, the numbers appearing on the left side, to the right of the margin".

2.2 Replacement documents and translations

Rule 49(1)
Rule 50(1)

Replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) or Rule 40(3) are subject to the same requirements as the documents making up the application.

2.3 Other documents

Rule 50(2)

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

2.4 Number of copies

Documents relating to more than one application or patent (e.g. a general authorisation), or having to be communicated to more than one party, only need to be filed in one copy. However, letters accompanying submitted documents (in particular Form 1038) must be filed in one copy for each file to which the document they accompany relates.

For example, where two different applications share a common priority claim, the applicant only needs to file one copy of the priority document, but this must be accompanied by two different letters each relating to one or the other application (preferably two copies of Form 1038). Each letter (or Form 1038) must be duly signed and indicate one or the other of the two application numbers in respect of which the priority document is being filed (see also IX, 3.1).

2.5 Filing of subsequent documents

Rule 2(1)

After a European patent application has been filed, documents as referred to in Rule 50 may be filed by delivery by hand or by post or, with the exception of authorisations and priority documents, may be filed by fax at the EPO's filing offices (see II, 1.2). Such documents may not be filed on diskette, by teleteX, by e-mail, telegram, telex or similar means (see also the Notice dated 12 September 2000 concerning correspondence with the Office via e-mail, OJ 10/2000, 458). If documents relating to European patent applications are filed by fax, written confirmation reproducing the contents of the documents filed by these means and complying with the requirements of the Implementing Regulations to the EPC must be supplied on invitation from the EPO within a period of two months. If the applicant fails to comply with this request in due time, the fax is deemed not to have been received (cf. the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3).

Written confirmation is required if the documents so communicated are of inferior quality.

If in a fax a party avails himself of Art. 14(4), the subsequent copy must be filed in the same language as the fax, in which case the copy is deemed to have been received on the date of filing of the fax. The period under Rule 6(2) for filing the translation under Art. 14(4) begins on the day following the date of filing of the fax. *Art. 14(4)* *Rule 6(2)*

For the filing of subsequent documents in electronic form, either online or on electronic data carriers, see additionally II, 1.3, 2nd paragraph.

3. Signature of documents

3.1 Documents filed after filing the European patent application

All documents other than annexes filed after filing the European patent application must be signed by the person responsible. The principles of Art. 133 are that only the applicant or his representative may act in the European patent grant procedure. Documents filed after filing the European patent application may therefore be effectively signed only by these persons. *Rule 50(3)* *Art. 133*

Documents such as the priority document or the translation thereof must be accompanied by a separate letter or at least bear a note on the document itself that it is addressed to the EPO, duly signed by a person authorised to act before the EPO. This also applies, for example, to the designation of inventor if this has been signed by an applicant with neither residence nor principal place of business in one of the Contracting States to the EPC. As regards the authorisation, see IX, 1.5. The signature of the entitled person confirming performance of a written act of procedure helps to clarify the state of the proceedings. It shows whether the act of procedure has been validly performed, and also prevents circumvention of the provisions relating to representation. Form 1038 (Letter accompanying subsequently filed items) may also be used as a separate letter. A separate form must be used for each file (see the Notice from the EPO, OJ 1-2/1991, 64). The same applies when, instead of using Form 1038, the applicant submits an accompanying letter with the document in question (see also IX, 2.4). In the case of electronic filing, several documents for a file can be attached on a single Form 1038E.

If the signature is omitted on a document not falling within the meaning of IX, 3.2, the EPO must invite the party concerned to sign within a fixed time limit. This also applies if the document in question bears the signature of an unentitled person (e.g. the secretary of an authorised representative), a deficiency which for the purposes of the time limits under way is treated as equivalent to omission of the signature of an entitled person. If signed in due time, the document retains its original date of receipt; otherwise it is deemed not to have been received. Likewise, documents filed electronically must be signed by an entitled *Rule 50(3)*

person, although they may be transmitted using a smart card issued to another person. See also IX, 3.2 below.

3.2 Documents forming part of the European patent application

In addition to the documents referred to in IX, 3.1 above, certain documents forming part of the application must be signed. These documents include the request for grant, the designation of the inventor and, where applicable, the authorisation of a representative. In the case of electronic filing of a European patent application, a facsimile image of the signer's handwritten signature, a text-string signature or an enhanced electronic signature may be used to sign the aforementioned documents (Art. 7 of the Decision of the President of the EPO dated 26 February 2009, OJ EPO 3/2009, 182).

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

3.3 Form of signature

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

Where a document is filed by fax, the reproduction on the facsimile of the signature of the person filing the document will be considered sufficient. The name and position of that person must be clear from the signature (cf. Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, A.3).

3.4 Joint applicants

Rule 151(1)

If there is more than one applicant (see IX, 1.3), each applicant or his representative must sign the request for grant and, where applicable, the appointment of the common representative. This also applies if one of the applicants is considered the common representative pursuant to Rule 151(1), first sentence. However, the common representative may sign the designation of inventor and all documents filed after the filing of the application pursuant to Rule 50(3). Authorisations on behalf of more than one applicant must be signed by all applicants.

Chapter X

Drawings

This Chapter of the Guidelines deals with the requirements to be met by drawings contained in the application or patent. However, it should be noted that the comments on the provisions of Rule 49 apply generally to the documents making up the European patent application and documents replacing them.

Rule 49
Rule 50

1. Graphic forms of presentation considered as drawings

1.1 Technical drawings

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

Rule 46(3)

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

Rule 49(9)

1.2 Photographs

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

2. Representation of drawings

2.1 Grouping of drawings

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

Rule 49(9)

2.2 Reproducibility of drawings

In accordance with Rule 49(2) the drawings must be so presented as to admit of electronic as well as of direct reproduction by scanning, photography, electrostatic processes, photo offset and micro-filming, in an unlimited number of copies.

Rule 49(2)

2.3 Figure accompanying the abstract

As regards the figure, or exceptionally figures, to accompany the abstract, where a European patent application contains drawings, reference should be made to III, 10.3 and B-XI, 3(vi) and 4. The figure(s) illustrating the abstract must be the figure(s) most representative of the invention and must be chosen from the drawings accompanying the application. It is therefore not permissible to draw a special figure for the abstract which differs from the other figures in the application.

3. Conditions regarding the paper used

Rule 49(3) Drawings must be on sheets of A4 paper (29.7 cm x 21 cm) which must be pliable, strong, white, smooth, matt and durable (recommended paper weight: 80-120 g/m^2, see OJ 1-2/1994, 74).

Rule 49(2) All sheets must be free from cracks, creases and folds. Only one side of the sheet may be used. The use of card is not allowed.

Rule 49(12) Each sheet must be reasonably free from erasures and must be free from alterations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

Any corrections made must be durable and permanent, so that they cannot give rise to any doubt. They must be made on all copies of the application. Special products for corrections, such as white masking fluid, may be used, provided they are indelible and comply with the other requirements under Rule 49(12).

Rule 49(4) The sheets must be connected in such a way that they can easily be turned over, separated and joined together again.

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

4. Presentation of the sheets of drawings

4.1 Usable surface area of sheets

Rule 46(1) On sheets containing drawings, the usable surface area may not exceed 26.2 cm x 17 cm. These sheets may not contain frames round the usable or used surface. The minimum margins are as follows: top side: 2.5 cm; left side: 2.5 cm; right side: 1.5 cm; bottom: 1 cm.

4.2 Numbering of sheets of drawings

Rule 49(6) All the sheets contained in the European patent application must be numbered in consecutive Arabic numerals. These must be centred at the top of the sheet, but not in the top margin.

Rule 46(1) The sheets of drawings must be numbered within the maximum usable surface area as defined in Rule 46(1). Instead of numbering the sheet

in the middle, it will, however, be acceptable for it to be numbered towards the right-hand side if the drawing comes too close to the middle of the edge of the usable surface. This numbering should be clear, for example in numbers larger than those used for reference numbers.

Rule 49(6) requires all application sheets to be numbered consecutively. According to Rule 49(4), the application consists of all the following documents: the request, the description, the claims, the drawings and the abstract. The numbering should preferably be effected by using three separate series of numbering each beginning with one, the first series applying to the request only and being already printed on the form to be used, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable only to the sheets of the drawings and commencing with the first sheet of such drawings. *Rule 49(4)*

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

5. General layout of drawings

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

5.1 Page-setting

As far as possible all figures of the drawings should be set out upright on the sheets. If a figure is broader than it is high, it may be set out so that the top and bottom of the figure lie along the sides of the sheet with the top of the figure on the left side of the sheet. *Rule 46(2)(h)*

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

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

5.2 Numbering of figures

The different figures must be numbered consecutively in Arabic numerals, independently of the numbering of the sheets. *Rule 46(2)(h)*

This numbering should be preceded by the abbreviation "FIG", whatever the official language of the application. Where a single figure is sufficient to illustrate the invention, it should not be numbered and the abbreviation "FIG" must not appear. Rule 46(2)(d) also applies to numbers and letters identifying the figures, i.e. they must be simple and clear and may not be used in association with brackets, circles, or *Rule 46(2)(d)*

inverted commas. They should also be larger than the numbers used for reference signs.

An exception to Rule 46(2)(h) referred to above may be permitted only as regards partial figures intended to form one whole figure, irrespective of whether they appear on one or several sheets. In this case the whole figure may be identified by the same number followed by a capital letter (e.g. FIG 7A, FIG 7B).

5.3 Whole figure

Rule 46(2)(h)

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

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

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

6. Prohibited matter

Rule 48(1) and (2)

The provisions as to the omission of prohibited matter within the meaning of Rule 48(1)(a) (see III, 8.1 and C-II, 7.2) also apply to drawings.

Rule 48(1)(c)

Statements or other matter of the type referred to under Rule 48(1)(c) (see C-II, 7.4) which are likely to appear in drawings are in particular various kinds of advertising, e.g. where the applicant includes in the drawing obvious business or departmental markings or a reference to an industrial design or model, whether registered or not. By doing so, matter would be introduced which is clearly irrelevant or unnecessary, which is expressly prohibited by Rule 48.

7. Executing of drawings

7.1 Drawings of lines and strokes

Rule 46(2)(a)
Rule 49(2)

Rule 46(2)(a) sets certain standards for lines and strokes in the drawing, to permit satisfactory reproduction by the various means described in Rule 49(2).

The drawings must be executed in black.

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

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

All lines must be drawn with the aid of drafting instruments save those for which no instrument exists, e.g. irregular diagrams and structures. *Rule 46(2)(e)*

7.2 Shading

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

7.3 Cross-sections

7.3.1 Sectional diagrams

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

Each sectional figure should be capable of being quickly identified, especially where several cross-sections are made on the same figure, e.g. by inscribing the words "Section on AB", or to avoid the use of lettering, by marking each end of the cross-section line on the diagram with a single Roman numeral. This number will be the same as the (Arabic) numeral identifying the figure where the section is illustrated. For example: "Figure 22 illustrates a section taken along the line XXII-XXII of Figure 21".

7.3.2 Hatching

A cross-section must be set out and drawn in the same manner as a normal view whose parts in cross-section are hatched with regularly spaced strokes, the space between strokes being chosen on the basis of the total area to be hatched. *Rule 46(2)(b)*

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

7.4 Scale of drawings

If the scale of the figure is such that all the essential details would not be clearly distinguished if the figure is reproduced, electronically or photographically, with a linear reduction in size to two-thirds, then the figure must be redrawn to a larger scale, and if necessary the figure should be split up into partial figures so that a linear reduction in size to two-thirds is still intelligible. *Rule 46(2)(c)*

The graphic representation of the scale of drawings in cases where its inclusion is considered useful must be such that it is still usable when

the drawing is reproduced in reduced format. This excludes indications of size such as "actual size" or "scale ½", both on the drawings and in the description, in favour of graphic representations of the scale.

7.5 Numbers, letters and reference signs

Rule 46(2)(d) Numbers, letters and reference signs and any other data given on the sheets of drawings, such as the numbering of figures, pages of the drawing, acceptable text matter, graduations on scales, etc., must be simple and clear, and not used in association with any brackets, inverted commas, circles or outlines whatsoever. Signs such as 6' and 35" are not regarded as including inverted commas and are therefore permitted.

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

7.5.1 Leading lines

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

Rule 46(2)(a) Leading lines must be executed in the same way as lines in the drawing, viz. in accordance with Rule 46(2)(a).

7.5.2 Arrows

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

(i) a freestanding arrow indicates the entire section towards which it points;

(ii) an arrow touching a line indicates the surface shown by the line looking along the direction of the arrow.

7.5.3 Height of the numbers and letters in the drawings

Rule 46(2)(g) Under Rule 46(2)(g), a minimum size of 0.32 cm is required for all numbers and letters used on the drawings so that their reduction in size to two-thirds remains easily legible.

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

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

Rule 46(2)(i) Reference signs not mentioned in the description and claims may not appear in the drawing, and vice versa.

Reference signs appearing in the drawing must be given in the description and the claims taken as a whole. As regards use of these signs in the claims, reference should be made to C-III, 4.19

Features of a drawing should not be designated by a reference in cases where the feature itself has not been described. This situation may arise as a result of amendments to the description involving the deletion of pages or whole paragraphs. One solution would be to strike out on the drawing reference signs which have been deleted in the description. Such corrections would have to be made in accordance with Rule 49(12). *Rule 49(12)*

Where for any reason a figure is deleted then of course the applicant or proprietor ought to delete all reference signs relating solely to that figure appearing in the description and claims.

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

7.5.5 Consistent use of reference signs as between drawings

The same features, when denoted by reference signs, must, throughout the application, be denoted by the same signs. *Rule 46(2)(i)*

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

7.6 Variations in proportions

Rule 46(2)(f)

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

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

8. Text matter on drawings

Rule 46(2)(d) and (g)

It should first be noted that Rule 46(2)(d) and (g) also applies to text matter on the drawings.

For indications of the type "section on AB", see X, 7.3.1.

Rule 46(2)(j)

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

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

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

9. Conventional symbols

Rule 49(10)

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

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

10. Amendments to drawings

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

Amendments to drawings are, in general, subject to the same rules as apply in respect of amendments to other application documents and therefore do not require further analysis here. Reference may be made to III, 16; V, 2; B-XII, 9; C-VI, 3.3, 4.6, 4.7, 5, 5.7 and 5.7.1 to 5.7.4; and E-II.

The general rule governing the admissibility of amendments, which the examiner must always bear in mind, is that they must not extend the content of the application as filed, i.e. they must not have the effect of introducing new material. *Art. 123(2)*

If drawings which depart substantially from the physical requirements laid down in the Rules are filed in order to establish a particular date of filing or retain a priority date, the Receiving Section will permit such drawings to be amended or replaced so as to provide drawings complying with the Rules, provided that it is clear that no new material is thereby introduced into the application. In view of this proviso, applicants should take care that any "informal" drawings which they file clearly show all the features necessary to illustrate the invention.

11. Graphic forms of presentation not considered as drawings

11.1 Chemical and mathematical formulae

Chemical or mathematical formulae may be written by hand or drawn if necessary, but it is recommended that appropriate aids such as stencils or transfers be used. For practical reasons, formulae may be grouped together on one or more sheets annexed to the description and paginated with it. It is recommended in such cases that each formula be designated by a reference sign and the description should contain references to these formulae whenever necessary. *Rule 49(8)*

The chemical or mathematical formulae must employ symbols in general use and must be drawn in such a way that they are completely unambiguous. Figures, letters and signs which are not typed must be legible and identical in form in the various formulae, irrespective of the document in which they appear. *Rule 49(11)*

Chemical or mathematical formulae appearing in the text of the application or patent must have symbols, the capital letters of which are at least 0.21 cm high. Where they appear on sheets of drawings, these symbols must be at least 0.32 cm high. *Rule 49(8)* *Rule 46(2)(g)*

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

11.2 Tables

11.2.1 Tables in the description

For the sake of convenience, the tables may also be grouped together in one or more sheets annexed to the description and paginated with it. *Rule 49(9)*

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

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

Rule 49(5) and (8)

It should be remembered that the characters must satisfy the requirements of Rule 49(8) and that Rule 49(5) regarding the maximum usable surface areas of sheets applies to tables as well.

11.2.2 Tables in the claims

Rule 49(9)

The claims may include tables if this is desirable in view of the subject-matter involved. In this case, the tables must be included in the text of the relevant claim; they may not be annexed to the claims nor may reference be made to tables contained in or annexed to the description. Rule 43(6) stipulates that the claims may refer to other application documents only where this is absolutely necessary (see C-III, 4.17). The mere desire to eliminate the need to prepare further copies does not constitute absolute necessity.

Chapter XI

Fees

1. General

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

– the current version of the Rules relating to Fees and the schedule of fees;

– important implementing rules to the Rules relating to Fees;

– the payment and refund of fees and costs;

– other notices concerning fees and prices; and

– international applications, including Euro-PCT applications entering the European phase,

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

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

2. Methods of payment

Fees may be paid in the following ways: *Art. 5 RFees*

(i) by payment or transfer to a bank account held by the EPO;

(ii) by debiting a deposit account opened in the records of the EPO in Munich (see XI, 4.2 and 4.3).

Payment by cheque delivered or sent directly to the EPO was abolished with effect from 1 April 2008 (OJ 11/2007, 533 and OJ 11/2007, 626).

Neither the PCT, nor the EPC allows for payment of any fee due by way of compensation (offset) with any fee to be refunded.

By way of exception, certain fees and costs at the Munich Information Office, namely for photocopies made by the EPO staff or by the requester in the course of file inspection or for purchases of patent information products, other copies of EPO documents and publications, may also be paid by credit card (Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, M.4).

3. Currencies

Art. 5 RFees
Point 3 ADA

The fees due to the EPO shall be paid in euro. A debit order shall be in euro.

4. Date considered as date on which payment is made

4.1 Payment or transfer to a bank account held by the European Patent Organisation

Art. 7(1), (3) and (4) RFees

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

4.2 Deposit accounts with the EPO

4.2.1 General remarks

Art. 7(2) RFees

The Arrangements for deposit accounts (hereinafter abbreviated to "ADA") and their annexes were published as Supplement No. 1 to OJ 3/2009. A distinction must be drawn, in connection with deposit accounts, between:

Point 4 ADA

(i) payments to replenish deposit accounts; and

Point 6 ADA

(ii) payments of fees or of expenses for publications or services of the EPO by debiting the deposit account.

4.2.2 Inpayments to replenish a deposit account

Points 3 and 4 ADA

Inpayments to replenish a deposit account are to be made in euro. Payments in a different currency will only be accepted if freely convertible. Payments must be made to an EPO bank account. However, the deposit account will always be credited in euro (the only

currency in which these accounts are kept) after conversion at the current rate of exchange.

4.2.3 Debiting the deposit account

The debit order must be clear, unambiguous and unconditional. It must contain particulars necessary to identify the purpose of the payment, including the amount of each fee or expense concerned, and must indicate the number of the account which is to be debited. The Boards of Appeal have decided that a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear (see T 152/82, OJ 7/1984, 301). Debiting occurs in principle on the basis of a written debit order signed by the account holder. The various ways in which a debit order may be filed, including online and fax filing, are given in point 6.2 ADA. Paper confirmation is not required.

Points 6.2 and 6.3 ADA

4.2.4 Date of receipt of the debit order; insufficient funds

Provided that there is a sufficient amount in the deposit account on the date of receipt of the debit order by the EPO, that date will be considered as the date on which the payment is made. This is also applicable where a debit order is filed together with an application under point 6.9 or point 6.12 ADA with a competent national authority of a Contracting State. If the debit order is not received at the EPO until after expiry of the period allowed for payment of fees which can be paid on filing, that period is deemed to have been observed if evidence is available or presented to the EPO to show that the debit order was filed with the competent authority of the Contracting State at the same time as the application, provided that sufficient funds were available in the account at the time the period expired.

Points 6.3, 6.9, 6.10 and Point 6.12 ADA

If on the date of receipt of a debit order, the account does not contain sufficient funds to cover the total fee payments indicated for an application (shortfall), the debit order is not carried out for it and the account holder is informed accordingly by the Treasury and Accounts Department of the EPO. By replenishing the account and paying an administrative fee, the holder can ensure that the date of receipt of the debit order is deemed to be the date on which payment was effected. The administrative fee is 30% of the shortfall. The Arrangements for deposit accounts further fix a maximum and a minimum amount for this administrative fee.

Points 6.4, 6.5 and 6.6 ADA

4.3 Automatic debiting procedure

A deposit account may also be debited on the basis of an automatic debit order signed by or on behalf of the account holder (automatic debiting procedure). Such an order may only be filed on behalf of the applicant or the patent proprietor or his representative and extends to all types of fees covered by the automatic debiting procedure and payable by him in respect of the proceedings specified in the automatic debit order. As the proceedings progress, each such fee is automatically debited and treated as having been paid in due time. The automatic debit order may not be restricted to specific types of fees.

Point 8 ADA

The Arrangements for the automatic debiting procedure (abbreviated to "AAD") plus explanatory notes are published as Annexes A.1 and A.2 to the ADA in Supplement No. 1 to OJ 3/2009.

5. Due date for fees

5.1 General

5.1.1 Due date

Art. 4(1) RFees
Rule 51(1), 2nd sentence

In the EPC, the term "due date" has a special meaning, namely the first day on which payment of a fee may be validly effected, not the last day of a period for such payment (see XI, 6 "Payment in due time"). The due date for fees is generally laid down by provisions of the EPC or of the PCT. If no due date is specified, the fee is due on the date of receipt of the request for the service incurring the fee concerned. A fee may not be validly paid before the due date. The only exception to that principle is with renewal fees, which may be validly paid up to three months before the due date (see XI, 5.2.4).

Payments made before the due date which are not valid may be refunded by the EPO. If payment is made shortly before the due date, it is possible that the EPO will not return the payment. In this case, however, payment only takes effect on the due date. See XI, 5.2.4 regarding renewal fees for a European patent application.

5.1.2 Amount of the fee

When the fees are generally increased, the date of payment is set as the relevant date for determining the amount of the fees (cf. Art. 2 of the Decision of the Administrative Council dated 5 June 1992, OJ 7/1992, 344). Setting the date of payment as the relevant date makes it unnecessary as a rule to ascertain the actual due date for determining the amount of the fee. Fees cannot validly be paid before the due date (with the exception of renewal fees – see XI, 5.1.1). Thus, for example, the fee for grant and publishing cannot be validly paid in advance before notification of the communication under Rule 71(3).

5.2 Due date for specific fees

5.2.1 Filing fee, search fee, designation fee

The filing, search and designation fees are due on the day the European patent application is filed. For the additional fee payable as part of the filing fee, see A-III, 13.2.

5.2.2 Examination fee

The examination fee is due when the request for examination is filed. Since the latter is contained in the prescribed form for the request for grant (Form 1001), the examination fee may be paid straight away on the date of filing of the European patent application if the application is filed with said prescribed Form 1001. It may be paid up to expiry of the period laid down in Rule 70(1).

5.2.3 Fee for grant and publishing

The fee for grant and publishing fall due on notification of the communication under Rule 71(3) requesting that this fee be paid. Under Rule 71(6), the same applies for claims fees, unless they were already paid under Rule 45(1) and (2) or Rule 162(1) and (2).

5.2.4 Renewal fees

Rule 51(1) and (2)

Renewal fees for a European patent application in respect of the coming year are due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than three months before they fall due. Renewal fee payments which are not valid will be refunded by the EPO. If payment is made only shortly before the permissible prepayment period, the EPO may elect not to return the payment. In this case, however, payment only takes effect on the first day of the permissible prepayment period. If the renewal fee has not been paid on or before the due date, it may be validly paid within six months of the said date, provided that the additional fee is paid within this period. For the calculation of the additional period, see J 4/91, OJ 8/1992, 402. Whilst the applicant's attention is drawn to this possibility, he may not invoke the omission of such notification (see J 12/84, OJ 4/1985, 108, and J 1/89, OJ 1-2/1992, 17). See also Legal Advice No. 5/93 rev., OJ 4/1993, 229, for Euro-PCT applications. For renewal fees for European divisional applications see IV, 1.4.3.

The obligation to pay renewal fees terminates with the payment of the renewal fee due in respect of the year in which the mention of the grant of the European patent is published (Art. 86(2); see OJ 6/1984, 272).

5.2.5 Claims fees

Claims fees are due upon the filing of the first set of claims, which may be the date of filing or which may occur later (see III, 9 and 15).

5.2.6 Fees for limitation/revocation, opposition, appeal, petition for review

All of these fees are due on the date that the document in question is filed (request for limitation, request for revocation, notice of opposition, notice of appeal and petition for review).

6. Payment in due time

6.1 Basic principle

A fee is considered to have been paid in due time if the date of payment (see XI, 4) fell on or before the last day of the relevant time limit – or the time limit extended pursuant to Rule 134.

6.2 Ten-day fail-safe arrangement

6.2.1 Requirements

Art. 7(3) and (4) RFees

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

(i) he effected payment through a banking establishment; or

(ii) he duly gave an order to a banking establishment to transfer the amount of the payment; or

Point 6.8 ADA

(iii) he despatched at a post office a letter bearing the address of one of the filing offices (see II, 1.1) of the EPO containing the debit order, provided that there is a sufficient amount in the account on the date on which the time limit expires,

then he is considered to have observed the period for payment, even if the payment is entered in the bank account of the European Patent Organisation after the expiry of the period or if a debit order despatched to the EPO is received there after the expiry of the period.

Art. 7(3)(b) and (4) RFees
Point 6.8(b) ADA

However, if, in such a case, the payment has been effected later than 10 days before expiry of the period for payment, but still within that period, a surcharge of 10% on the relevant fee or fees, but not exceeding EUR 150, must be paid in order for the period for payment to be considered observed.

6.2.2 Application of the ten-day fail-safe arrangement to replenishment of deposit account

Point 5.2 ADA

The ten-day fail-safe arrangement under Art. 7(3), (a) and (b), second half sentence RFees applies mutatis mutandis to payments to replenish deposit accounts. If one of the steps referred to under XI, 6.2.1(i) and (ii) is carried out in order to replenish a deposit account, then for the purpose of complying with time limits for payment by issuing debit orders, the account is considered to have been replenished on the tenth day after one of those steps was taken. For the application of the administrative fee, see A-XI, 4.2.4.

6.2.3 Debit orders

Points 6.9 ADA, Point 6.10 and Point 6.12 ADA

For debit orders accompanying applications filed with a competent national authority, see XI, 4.2.4.

6.2.4 Payment of fee at the normal fee rate

Where a fee can either be paid within a normal period at the normal fee rate or within the period for further processing with the requisite further processing fee, if the normal period for payment is considered to have been observed when applying the ten-day fail-safe arrangement, the above-mentioned further processing fee need not be paid.

6.2.5 Amount of fee payable

As noted in XI, 5.1.2, the amount of fee payable is always that applying on the date of payment (see also the transitional provisions in the Administrative Council decisions revising fees). The payer cannot therefore in this respect seek to rely on the ten-day fail-safe arrangement in order to benefit from an old amount, arguing that he gave instructions for payment before the entry into force of the new amount of fee (see J 18/85, OJ 8/1987, 356); Art. 7(3) and (4) RFees protects the applicant in the event of late payment from the legal consequences of expiry of the payment period, but not from the obligation to make up any differences resulting from an increase in the amount of fee in the meantime.

6.2.6 Noting of loss of rights

Rule 112

If an applicant who has been sent a communication under Rule 112(1) noting non-compliance with a time limit for payment claims that the payment was made in due time pursuant to Art. 7(1), (3) and (4) RFees and points 5.2, 6.5, 6.8 or 6.10 of the Arrangements for deposit accounts, he must apply for a decision pursuant to Rule 112(2) and submit the requisite evidence.

7. Purpose of payment

7.1 General

7.1.1 Condition for valid payment

An essential condition for a valid payment to the EPO in the case of payment or transfer to a bank account held by the European Patent Organisation is that the amount is entered in that account. The payment is valid in respect of the amount entered. If an insufficient amount has been paid by mistake, it is not possible to rectify the error by having the shortfall paid subsequently deemed to be paid on the original date of payment. Payment is a matter of fact whereby a certain amount is transferred to and put at the disposal of the EPO. It is not, therefore, a procedural declaration which may be corrected pursuant to Rule 139. The same applies to debit orders (see T 170/83, OJ 12/1984, 605, reasons 8). Therefore, time limits for payment are in principle deemed to have been observed only if the full amount of the fee has been paid in due time. However, the EPO may, where this is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment (Art. 8(1) RFees).

7.1.2 Purpose of payment

Art. 6 RFees

A distinction must be drawn between these conditions for valid payment and the indication of the purpose of the payment. Indication of the purpose of the payment serves to identify the proceedings for which the fee is intended (e.g. for fee payments, the application number) and the specific type of fee. If the purpose of the payments cannot immediately be established, the person making the payment will be requested to communicate the purpose in writing within a

specified period. If he complies with this request in due time, the payment and the original payment date remain valid. This is also the case when the clarification involves re-assigning the payment to another application. Otherwise the payment will be considered not to have been made. The Boards of Appeal have decided that if the purpose of the payment has evidently been given incorrectly, this deficiency is not prejudicial if the intended purpose can be established without difficulty from the remaining information. The inadvertent use of a fee by the EPO for a different purpose from that evidently intended by the person making the payment has no effect on the purpose intended by that person (see J 16/84, OJ 12/1985, 357). Similarly, a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear. Instructions to carry out the order must be given by the EPO department qualified to recognise what is clearly intended (see T 152/82, OJ 7/1984, 301).

In the case of changes to the purpose of payment not arising from Art. 6(2) RFees, the date of payment is the date of receipt of the request for the change.

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

Art. 2, No. 3, RFees, old version

The following applies only to applications filed before 1 April 2009.

Art. 6(1) RFees

The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee. Such payments simply need to be marked "designation fees" in order for the purpose of the payment to be established. If fewer than seven designation fees are paid and the payment agrees with the declaration in the appropriate section of the Request for Grant form (Form 1001), payment should once again simply be marked "designation fees". However, if the payment differs from the intended payment as stated in the request form, the Contracting States for which the payment is now intended should be indicated with the payment.

If there is no such indication and the amount paid is insufficient to cover all the Contracting States mentioned in the appropriate section of the request form, the procedure under III, 11.3.7 applies.

If an automatic debit order has been issued (see the appropriate sections of Form 1001), the applicant must inform the EPO prior to expiry of the basic period under Rule 39(1) if he wishes to pay designation fees for Contracting States other than those indicated in the request form. If not, an amount equal to seven times the amount of one designation fee or the designation fees for the Contracting States indicated in the request form is debited.

The same applies where Form 1200 is used for entry into the European phase of a Euro-PCT application, if the application enters the regional phase before 1 April 2009.

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

7.3.1 Claims fees payable on filing the European patent application

If the applicant pays the claims fees for all the claims incurring fees, the indication "claims fees" suffices to identify the purpose of the payment. If the amount paid is insufficient to cover all the claims fees, the procedure under III, 9 applies. *Rule 45(1)*

7.3.2 Claims fees payable before the grant of the European patent

In the communication under Rule 71(6), the applicant may be requested to pay claims fees due before grant of the European patent. If the applicant fails to pay the fee for all the claims in due time, the application is deemed to be withdrawn (Rule 71(7)). *Rule 71(6)*

8. No deferred payment of fees, no legal aid, no discretion

The EPC makes no provision for deferring payment of fees (see J 2/78, OJ 6-7/1979, 283, reasons 3, German text only) or for granting legal aid. An indigent party still has the possibility of applying for legal aid from the competent national authority. However, the time limit for payment is not extended in such a case; a party claiming national legal aid must make the corresponding arrangements as early as possible so that he is in a position to pay the fee in due time. The EPO has also no discretion in waiving or refunding, without any legal basis, fees that have become due (see J 20/87, OJ 3/1989, 67).

9. Reduction of fees

9.1 General

The EPC provides in certain cases for the reduction of the filing fee, examination fee, opposition fee, fee for appeal, limitation or revocation fee and fee for petition for review. The reduction is fixed in the Rules relating to Fees as a percentage of the fee.

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

9.2 Reduction under the language arrangements

9.2.1 Conditions

European applications can be filed in any language. If filed in a language other than an official language of the EPO, a translation must be furnished. Consequently, the languages which can be used for filing European applications fall into three categories: *Art. 14(2)*

(i) official languages of the EPO

(ii) official languages of Contracting States which are not official languages of the EPO, such as Dutch, Italian or Spanish (hereinafter "admissible non-EPO languages"), and

(iii) all other languages, such as Chinese, Japanese or Russian.

Art. 14(4)

Furthermore, documents which have to be filed within a time limit may also be filed in an "admissible non-EPO language" if the applicant has his residence or principal place of business within the territory of a Contracting State having this as an official language or if the applicant is a national of such a Contracting State. See VIII, 1.1 and 1.2.

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

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

The reduction is only allowed if the translation into an EPO official language is filed in due time, that is to say at the earliest at the same time as when the European patent application or the document subject to a time limit is filed in the admissible non-EPO language (see G 6/91, OJ 9/1992, 491).

9.2.2 Reduction of the filing fee

According to G 6/91 (OJ 9/1992, 491), the entitlement to the fee reduction only exists if the essential element of the act in question is filed in the admissible non-EPO language. In the case of the filing of the European application, the presence of a description is necessary for the accordance of a date of filing (Rule 40(1)(c)), but claims are no longer required for this. According to J 4/88 (OJ 12/1989, 483), only the description and claims needed to be in this language to qualify for the fee reduction (not the Request for grant for example). However, since claims are no longer required for a date of filing, the essential element is now the description.

Consequently, the filing fee is reduced if the European patent application (i.e. at least the description) is filed in an admissible non-EPO language (i.e. an official language of a Contracting State which is not an official language of the EPO). The reduction only applies when the application is filed by a resident or national of a Contracting State having this language as an official language. For example, a national and resident of Mexico filing a European application in Spanish does not qualify for a fee reduction, nor does an applicant filing in Japanese, regardless of his nationality or residence.

Where the application is filed by reference to a previously filed application (see II, 4.1.3.1), and the previously filed application referred to, is in an admissible non-EPO language and the applicant

satisfies the residency and/or nationality criteria mentioned above, then the applicant is also entitled to the reduction in the filing fee. For the purposes of the reduction, it does not matter whether or not the applicant requested that the claims of the previously filed application take the place of the claims in the application as filed (see above).

Since the additional fee which is payable if the application comprises more than thirty-five pages forms part of the filing fee, the reduction applies also to it.

9.2.3 Reduction of the examination fee

Art. 14(4)
Rule 6(3)

The applicant will be allowed a reduction in the examination fee if the request for examination is filed in an admissible non-EPO language and a translation of the request for examination in an EPO official language is also filed. For the reduction to be allowed, the request for examination in the admissible non-EPO language may already be filed as part of the request for grant (Form 1001), since the form already contains a pre-printed box for the request for examination in the official languages of the EPO and the request for examination in the admissible non-EPO language can be entered in the box provided for the request for examination. Alternatively, for the reduction to be allowed, the request for examination in the admissible non-EPO language and the translation of the request may be filed later, namely up to the date of payment of the examination fee, provided that the translation is filed no earlier than simultaneously with the request (see J 21/98, OJ 8-9/2000, 406, and G 6/91, OJ 9/1992, 491). In order to benefit from the reduction, it is not necessary to file subsequent additional documents for the examination proceedings in an admissible non-EPO language.

For the case where a reduction in the examination fee for the above reasons coincides with a reduced examination fee because the EPO drew up the international preliminary examination report, see XI, 9.3.2.

9.2.4 Reduction of the opposition fee

Art. 14(4)
Rule 6(3)

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

9.2.5 Reduction of the appeal fee

Art. 14(4)
Rule 6(3)

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

9.2.6 Reduction of the fee for limitation and revocation

Art. 14(4)
Rule 6(3)

A reduction in the fee for limitation and the fee for revocation is allowed if the request for limitation or revocation is filed in an admissible non-EPO language as well as in an EPO official language in translation. In order to qualify for the reduction, the applicant must file the items referred to in Rule 92(2)(a), (b), (c) and (e) in the admissible non-EPO language.

9.2.7 Reduction of the fee for the petition for review

Art. 14(4)
Rule 6(3)

A reduction of the fee for the petition for review is allowed if the petition for review is filed in an admissible non-EPO language as well as in an EPO official language in translation. In order to qualify for the reduction, the applicant must file the item referred to in Rule 107(2) in the admissible non-EPO language

9.3 Special reductions

9.3.1 Reduction of the search fee for a supplementary European search

Art. 153(7)

The search fee for a supplementary European search report is reduced for PCT applications for which the Patent Office of the USA, Japan, China, Australia, Russia or Korea was the International Searching Authority. In these cases, the supplementary search fee is reduced by a fixed amount (see OJ 11/2005, 548).

The search fee for a supplementary European search report is also reduced by a fixed amount for PCT applications for which the Patent Office of Austria, Finland, Spain or Sweden or the Nordic Patent Institute was the International Searching Authority (cf. OJ EPO 12/2007, 642 and OJ EPO 1/2008, 12).

PCT applications for which the Patent Office of Canada was the International Searching Authority do not qualify for any reduction in the supplementary search fee (see OJ 3/2006, 192 and OJ 11/2005, 577).

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

Art. 14(2) RFees

Where the EPO has drawn up the international preliminary examination report in respect of an international application, the examination fee is reduced by 50% if the EPO is the designated Office (elected Office).

If the conditions for a reduction under the language arrangements (see XI, 9.2.3) are also fulfilled, the examination fee is first reduced by 50%, then by a further 20%, i.e. the total reduction is 60% of the full fee.

9.3.3 Reduction of the fees for the international search and international preliminary examination of an international application

The fees for the international search and preliminary examination of an international application are reduced by 75% if the application is filed by a natural person who is a national and a resident of a state which is not an EPC Contracting State and which, on the date of filing of the application or of the demand, is listed as a low-income or lower-middle-income economy by the World Bank (OJ EPO 11/2008, 521).

10. Refund of fees

10.1 General remarks

10.1.1 Fee payments lacking a legal basis

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

(i) the payment must relate to proceedings that are pending; and

(ii) the date of payment (see XI, 4) must be on or after the due date (see XI, 5.1.1).

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

If the payment is made before or on the due date and if, no later than that date, the legal basis ceases to exist (e.g. because the patent application is deemed to be withdrawn or is withdrawn), the amount paid is to be refunded. This also applies to renewal fees validly paid before the due date (Rule 51(1), second sentence).

10.1.2 Fee payments which are not valid

If fees have not been validly paid they must be refunded. Examples: filing fee, search fee, designation fee or examination fee paid late, as laid down under the provisions relating to further processing (Art. 121 and Rule 135), without the further processing fee required by Rule 135(1) and Art. 2, No. 12 RFees. Fees paid on or after the due date are refunded only if there is a particular reason for a refund (see XI, 10.2).

10.1.3 Insignificant amounts

Where the sum paid is larger than the fee, the excess will not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. It has been decided that any amount up to EUR 10 constitutes an insignificant amount (Art. 1 of the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, M.3).

Art. 12 RFees

10.2 Special refunds

10.2.1 Refund of the search fee

Art. 9 RFees

The search fee for a European or supplementary European search is refunded in cases provided for in Art. 9 RFees and in the Decision of the President of the EPO dated 22 December 2008, OJ 2/2009, 96, which applies to European patent applications in respect of which the European or supplementary European search is completed on or after 1 April 2009. Details on criteria for refund of search fees are given in the Notice from the EPO dated 9 January 2009, OJ 2/2009, 99.

10.2.2 Refund of the further search fee

Rule 64(2)

If an applicant, following a communication from the Search Division, has paid a further search fee but the Examining Division, at the applicant's request, has found that there was no justification for charging the further search fee, the latter will be repaid.

10.2.3 Refund of the international search fee

Rule 16.2 and 16.3 PCT
Rule 41 PCT

The international search fee will be refunded in the cases specified in Rules 16.2, 16.3 and 41 PCT and in Annex C of the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (WIPO) under the PCT (OJ 11/2007, 617). Following amendment of the provisions set out in Annex C, Part II(3) of the above mentioned agreement, any refund of the international search fee paid for an international application filed on or after 1 January 2004 will be granted to the extent set out in the Notice from the President of the EPO dated 14 July 2007, Special edition No. 3, OJ EPO 2007, N.3 for international applications for which the international search is completed before 1 April 2009, and in the Decision of the President of the EPO dated 22 December 2008, OJ 2/2009, 114 for international applications for which the international search is completed on or after 1 April 2009. Details on the criteria for the refund of international search fees are given in the Notice from the EPO dated 9 January 2009, OJ 2/2009, 99.

10.2.4 Refund of the examination fee

Art. 11 RFees

The examination fee will be refunded in the situations described in Art. 11 RFees (see VI, 2.2, 3rd paragraph, and 2.5).

If an international application and a European application are consolidated in accordance with the conditions laid down by Legal Advice No. 10/92 rev., OJ 11/1992, 662, the examination fee paid in respect of the European patent application will be refunded in full if the request for consolidation was made before the Examining Division had taken responsibility for both applications or at a rate of 75% if the Examining Division had already taken responsibility for both applications but had not yet begun substantive examination of the second application when consolidation was requested. This also applies where there has been an international preliminary examination under Chapter II PCT.

10.2.5 Refund of the international preliminary examination fee

For international applications filed on or after 1 January 2004 the EPO has discontinued the rationalised international preliminary examination procedure (OJ 11/2001, 539). Consequently, no request for ''detailed'' examination will be required, and the fee refund for the rationalised procedure is no longer available.

10.2.6 Refund pursuant to Rule 37(2)

Rule 37(2)

If a European patent application filed with a competent national authority is deemed to be withdrawn pursuant to Art. 77(3), all fees, in particular the filing, search and designation fees and any claims fees paid, will be refunded.

10.2.7 Refund of claims fees and of the fee for grant and publishing

Art. 97(1)
Rule 71(5)

The fee for grant and publishing will be refunded if the European patent application is withdrawn before communication of the decision to grant. If it is withdrawn after communication of the decision to grant, the fee for publishing cannot be refunded as it is part of the fee for grant. If, following a communication under Rule 71(5), the application is refused, withdrawn or deemed to be withdrawn, the fee for grant and publishing and any claims fees paid under Rule 71(6), are refunded.

10.3 Method of refund

If the person to whom the refund is payable holds a deposit account with the EPO, the refund may take the form of crediting that deposit account. If the payer wishes any refund to be made to a deposit account, he can give the number of the account in the space provided in the Request for Grant form. Otherwise refunds will be made by means of a cheque.

10.4 Person to whom refund is payable

Fees will be refunded to the party concerned. However, if the party's representative is authorised to receive payments, the refund will be made to the representative. A refund will not be made to a third party who paid the fee (see Legal Advice No. 6/91 rev., points 4 and 5, OJ 11/1991, 573).

10.5 Re-allocation instead of refund

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

Chapter XII

Inspection of files; communication of information contained in files; consultation of the Register of European Patents; issuance of certified copies

1. General

Provision is made for inspection of files and communication to the public of information contained in files. This applies to the files of European patent applications and European patents. *Art. 128*

For international (PCT) applications, see E-IX, 5.8 and 6.4.

The provisions governing inspection of files are contained in Art. 128 and Rules 144 and 145, those for communication of information in Rule 146. *Rule 144, Rule 145 Rule 146*

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

2. Inspection of files

2.1 Extent of file inspection

Inspection of the files of European patent applications and of European patents is granted in respect of the original documents or of copies thereof or, if the files are stored on other media, in respect of these media. All parts of the file compiled when conducting the examination, opposition and appeal procedure with the parties are open for inspection. It also includes the search opinion if applicable. *Rule 145(1) Rule 147(2)*

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

The parts of the file excluded from inspection are: *Art. 128(4)*

(i) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal; *Rule 144(a)*

(ii) draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties; *Rule 144(b)*

Rule 144(c)

(iii) the designation of the inventor if he has waived his right to be mentioned as inventor under Rule 20(1);

Rule 144(d)

(iv) any other document excluded from inspection by the President of the EPO on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent. These documents include documents relating to file inspection and requests for accelerated search and accelerated examination under the "PACE" programme (if submitted using EPO Form 1005 or in a separate document) (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.3);

Art. 38(1) PCT
Rule 94 PCT

(v) subject to Rules 94.2 and 94.3 PCT, the files of the international preliminary examination for a Euro-PCT application in respect of which the EPO is the international preliminary examining authority and for which an international preliminary examination report has not yet been established (see OJ 7/2003, 382; see also E-IX, 5.8 and 6.4).

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

2.2 Procedure for file inspection

Rule 145(2)

The President of the EPO determines all file inspection arrangements, including the circumstances in which an administrative fee is payable (see the Decisions of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.2).

Files that are available in electronic form can be inspected free of charge online via the Register Plus online service (see also the above mentioned Decision of the President of the EPO).

Other forms of file inspection, e.g. by furnishing paper copies, are available on request. No particular form is prescribed for the request, except that it must be filed in writing with the EPO at one of its filing offices. The EPO offers a form via its website on the Internet. The request should contain information about the payment of the fee. Requests filed by fax (see IX, 2.5) or submitted through the Internet will be processed without confirmation.

Rule 145(2)

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

2.3 Restrictions to file inspection

Subsequent to the publication of the European patent application any person may inspect and obtain information from the files. Inspection of files and communication of information are subject to the restrictions laid down in Rule 144 (see XII, 2.1). If it is decided that certain papers marked "confidential" are not to be excluded from file inspection under Rule 144, they are returned to the sender (see T 516/89, OJ 8/1992, 436).

Art. 128(4)
Rule 146
Rule 145
Rule 144

2.4 Confidentiality of the request

Correspondence from the proceedings relating to the inspection of files conducted between the EPO and the person requesting the inspection is filed in the non-public part of the file. The EPO does not provide the applicant with any information about the proceedings relating to the inspection of files (see, however, XII, 2.5, third paragraph).

2.5 File inspection before publication of the application

Until such time as the European patent application is published, the files may be inspected only by the applicant or with his consent. Secure File Inspection, which is available via My.epoline® allows the applicant to inspect online the public part of the files relating to his own as yet unpublished application (see Notice from the EPO dated 9 December 2003, OJ 1/2004, 61). If a third party requests file inspection without at the same time submitting the applicant's consent, the EPO will not release the files until the applicant's approval has been presented.

Art. 128(1)

However, prior to publication of the European patent application, any person who can prove that the applicant has invoked his rights under the application against him may also inspect the files. The rights under a European patent application are also deemed to have been invoked where rights under a first filing in a Contracting State have been invoked and the subsequent European application is mentioned at the same time (see J 14/91, OJ 8/1993, 479). If such proof is not furnished together with the request, the EPO will invite the requester within a specified period to supply proof. If he fails to do so in due time, the request will be refused.

Art. 128(2)

In case of a request for inspection of the files under Art. 128(2), the applicant is entitled to notification of the identity of the person making the request. Professional representatives requesting inspection of the files on behalf of a third party pursuant to Art. 128(2) must accordingly give the third party's name and address and file an authorisation.

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

Art. 128(3)

Prior to publication of a European divisional application the file of this divisional application may only be inspected in the cases described in Art. 128(1) and (2). This also applies where the parent application has already been published. However, where a European divisional application or a new European patent application filed under Art. 61(1)(b) is published, the files of the earlier application may be inspected prior to the publication of that earlier application and without the consent of the relevant applicant.

2.6 Publication of bibliographic data before publication of the application

Art. 128(5)

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

3. Communication of information from the files

Rule 146

Subject to the restrictions provided for in Art. 128(1) to (4) and Rule 144, the EPO may, upon request, communicate information concerning any file of a European patent application or European patent. This may be subject to the payment of an administrative fee.

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

Correspondence from the proceedings relating to the communication of information conducted between the EPO and the person requesting the information is filed in the part of the file which is not accessible to the public. The EPO does not provide the applicant with any information about the proceedings relating to the communication of information.

4. Consultation of the European Patent Register

Art. 127
Rule 143

The European Patent Register, containing the particulars specified in Rule 143, may be consulted in order to ascertain the state of the proceedings and the legal status of patent rights. Entries are made in the European Patent Register up to expiry of the period of opposition or the termination of opposition proceedings. Where applicable, the date and purport of any decision taken in revocation or limitation proceedings (Art. 105b(2)) and/or on a petition for review (Art. 112a) are also included (Rule 143(1)(x) and (y)). The correction of the designation of the inventor, may be made at any time. The Online European Patent Register via the Internet (www.epoline®.org) can be accessed free of charge. Apart from the data entered in the European Patent Register, the Online Register includes additional application and procedural data not published in the European Patent Bulletin. Register data may also be obtained by telephone from the Information Offices in Munich, The Hague, Berlin or Vienna.

5. Certified copies

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

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

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

6. Priority documents issued by the EPO

Rule 54

Any priority document (i.e. the certified copy of the European application together with the certificate stating the date of filing thereof) will only be issued to the (original) applicant or his successor in title. In the case of applications filed in a language other than an official language of the EPO (Art. 14(2)), the priority document relates to the application as originally filed, not to the translation in one of the official languages of the EPO.

The President of the EPO determines all necessary arrangements, including the form of the priority document and the circumstances in which an administrative fee is payable.