

# **Part C**

## **Guidelines for Procedural Aspects of Substantive Examination**



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## Chapter I – Introduction

### 1. General remark

In this Part C of the Guidelines the term "examiner" is used to mean the examiner entrusted with substantive examination forming part of the Examining Division, which is responsible for the final decision. *Art. 18*

Chapters C-II to IX set out the general procedure for examination, together with guidance on particular matters where necessary. They do not provide detailed instructions on matters of internal administration.

### 2. Work of an examiner

Under the "Early Certainty from Search" (ECfS) scheme, completing examination files already started is prioritised over beginning work on new files, and grants are expedited once a positive search opinion has been issued.

The attitude of the examiner is very important. He should always try to be constructive and helpful. While it would of course be quite wrong for an examiner to overlook any major deficiency in an application, he should have a sense of proportion and not pursue unimportant objections. He should bear in mind that, subject to the requirements of the EPC, the drafting of the description and claims of a European application is the responsibility of the applicant or his authorised representative.

The attention of the examiner is particularly directed to the instruction in paragraph 4 of the General Part of the Guidelines. This applies not only in relation to other departments of the EPO. It also means, for example, that the other members of an Examining Division should not attempt to repeat the work of the primary examiner (see C-VIII, 4).

### 3. Overview

Part C of the Guidelines deals with matters of examination procedure (see Chapters C-II to IX).

Matters of substantive law, i.e. the requirements which a European application must fulfil, are dealt with in Parts F, G and H.

### 4. Purpose of examination

The purpose of preparing the search opinion (see B-XI) and of the subsequent examination proceedings is to ensure that the application and the invention to which it relates meet the requirements set out in the relevant Articles of the EPC and the Rules of its Implementing Regulations. The prime task of the Examining Division is to deal with the substantive requirements; the criteria by which an examiner judges whether they have been met are dealt with in detail, insofar as appears necessary, in Parts F, G and H. As for the formal requirements (see Part A), these are initially the responsibility of the Receiving Section. *Art. 94(1)*  
*Art. 164(1)*  
*Rule 62(1)*

*Rule 70(2)*

The examination is to be carried out in accordance with Art. 94(3) and (4), Art. 97, Rule 71(1) to 71(7), Rule 71a(1) to 71a(6) and Rule 72. The examiner's first step is to study the description, drawings (if any) and the claims of the application. However, as the examiner will normally already have done this when he carried out the search (see B-XI, 3), he should concentrate on any amendments and/or comments filed by the applicant in response to the search opinion (see B-XI, 8). If amendments were made and these have not been identified and/or their basis in the application as filed not indicated by the applicant (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see H-III, 2.1.1).

## Chapter II – Formal requirements to be met before the Division starts substantive examination

### 1. Request for examination

In order that examination of a European application can begin, the applicant is required to file a request for examination, which, however, is not deemed to be filed until after the examination fee has been paid. The request for examination may be filed from the date on which the application is filed up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report. If the request for examination is not filed within this period, the application is deemed to be withdrawn. However, in such a case, the applicant has the possibility of filing a request for further processing pursuant to Art. 121. According to Rule 70(1), the request for examination may not be withdrawn.

*Art. 94*  
*Art. 121*  
*Rule 70*  
*Art. 122(4)*  
*Rule 136(3)*

Subject to certain exceptions, the applicant must also respond to the search opinion within the above-mentioned period for filing the request for examination (see B-XI, 9 and C-II, 3.1), unless the EPO invites him to confirm an early request for examination according to Rule 70(2), in which case he must respond to the search opinion within the period provided for under Rule 70(2) (see C-II, 1.1).

*Rule 70a(1) and (3)*

Responsibility for examining the application passes from the Receiving Section to the Examining Division at the time when a request for examination is filed. This is subject to two exceptions:

*Rule 10*  
*Rule 70(2)*

- (i) if the applicant has filed a request for examination before the European search report has been sent to him, then the Examining Division is responsible only from the time when the confirmation of the request is received by the EPO following an invitation under Rule 70(2);
- (ii) if the applicant has filed a request for examination before the European search report has been sent to him and has also waived the right to receive an invitation to confirm under Rule 70(2) (see C-VI, 3), then the Examining Division is responsible only from the time when the search report is sent to the applicant.

#### 1.1 Confirmation of the intention to proceed further with the application

If the applicant has filed a request for examination before the search report has been transmitted to him, the EPO will invite him to confirm, within a six-month period, that he desires to proceed further with his application. This six-month period is calculated from the mention of the publication of the European search report. Where the applicant also has to respond to the search opinion, his response is required within this same period (see B-XI, 8 and C-II, 3.1). In these cases, the applicant's response to the search opinion is interpreted as the confirmation required by Rule 70(2),

*Rule 70(2) and (3)*  
*Art. 121*  
*Art. 11 RFees*  
*Rule 70a(2) and (3)*

even where not explicitly expressed as such. If the applicant fails to confirm his desire to proceed further with the application in due time in reply to this invitation, the application will be deemed to be withdrawn. In this case, however, the means of redress provided for in Art. 121 (further processing of the application) will apply (see A-VI, 2.2 and 2.3). For the conditions applicable to a refund of the examination fee if the application is withdrawn, refused or deemed to be withdrawn, see A-VI, 2.5.

### 1.2 Euro-PCT applications

*Art. 153(4), (6) and (7)*

*Art. 150(2)*

*Rule 159(1)(f)*

If the application has proceeded via the PCT (Euro-PCT application), the six-month period under Rule 70(1) begins with the publication of the PCT search report or the declaration under Art. 17(2)(a) PCT. However, as is laid down in Art. 150(2), the time limit for requesting examination in a Euro-PCT case does not expire before the time prescribed in Art. 22 PCT and Art. 39 PCT (i.e. not before the time limit of Rule 159(1)(f)). The time limit will not be affected by whether a supplementary European search pursuant to Art. 153(7) needs to be made or whether the international application pursuant to Art. 153(4) is again published by the EPO.

*Art. 121*

*Rule 136(3)*

*Rule 160(1)*

If the request for examination of a Euro-PCT application has not been filed within the time limit, the application is deemed withdrawn under Rule 160(1). In such a case, however, the applicant has the possibility of filing a request for further processing pursuant to Art. 121.

Where the Euro-PCT application is subject to the preparation of a supplementary European search report (see B-II, 4.3), once this search report to the applicant has been dispatched to him, the applicant is sent a communication according to Rule 70(2), inviting him to confirm the request for examination within six months of the notification of that communication (see E-VIII, 2.5.3).

### 1.3 Invention to be examined

*Rule 36*

It is to be noted that where the search report and the search opinion have been drawn up to cover several inventions lacking unity, the applicant is free to select the invention to be examined in the application under consideration. The others will be subject to objections of lack of unity and may be divided out according to Rule 36 (see C-III, 3.2 and C-IX, 1.3).

## 2. Allocation of the application

The dossier will normally be allocated to an Examining Division responsible for the examination of applications in the technical field in which the particular application has been classified by the Search Division or ISA which carried out the search. It is usual for the primary examiner entrusted with the examination of the application in accordance with Art. 18(2) to be the same person who prepared the (supplementary) European search report and search opinion or, where the EPO was the ISA or the authority specified for the supplementary international search, the international search report and WO-ISA or the supplementary international search report.

There may, however, be instances where it is appropriate to allocate the application to an Examining Division comprising examiners who are not normally responsible for the indicated part of the IPC and who might not have been involved at the search stage. There are a number of possible reasons for this: e.g. to make it possible, where appropriate, that an original and a divisional application are dealt with by the same Examining Division (this could sometimes be more efficient even when the two applications are classified in different technical fields); or if the classification of the published application does not correspond to the subject-matter of the application in the form in which it reaches the substantive examiner (e.g. because the application has been amended after receipt of the search report and search opinion).

### **3. Response filed before first communication in examination**

#### **3.1 Response to the search opinion**

Following receipt of the search report and search opinion, and prior to the first communication from the examining division, the applicant must (subject to certain exceptions) respond to the search opinion, by filing amendments to the description, claims or drawings and/or filing his observations on the objections raised in the search opinion (see B-XI, 8 for details, in particular as to the exceptions where no reply is required). In order to avoid delays, care should be taken to comply with the requirements of Rule 137(4) when filing such amendments (see OJ EPO 2009, 533, point 7). Any amendments filed at this stage are made by the applicant of his own volition in accordance with Rule 137(2) (for more details, see C-III, 2.1).

*Rule 137(2)*

*Rule 70(2)*

*Rule 70a*

The applicant's response to the search opinion required by Rule 70a (or filed voluntarily in response to search opinions not requiring a response) will be taken into account by the Examining Division when drafting the first communication. Failure to respond to this communication in due time will result in the application being deemed withdrawn according to Art. 94(4), although this loss of rights is subject to further processing (with regard to what constitutes a valid response, see B-XI, 8).

*Art. 94(3) and (4)*

*Rule 62(1)*

If the European search report or supplementary European search report was accompanied by a search opinion but was drawn up before 1 April 2010 (such that a reply to the search opinion was not mandatory – see B-XI, 8) and the applicant did not reply to it, a communication referring to the search opinion and setting a time limit for reply would have been issued as the first communication under Art. 94(3). Failure to respond to this communication in due time would have resulted in the application being deemed withdrawn according to Art. 94(4).

The procedure explained in the above paragraphs also applies to Euro-PCT applications for which the EPO prepares a supplementary European search report and a search opinion (see B-II, 4.3 and B-XI, 1.1).

#### **3.2 Response to PCT actions prepared by the EPO**

For Euro-PCT applications where the EPO acted as the International Searching Authority (ISA) and, where a demand under Art. 31 PCT was

*Rule 161(1)*

filed, also as the International Preliminary Examining Authority, or as the authority specified for supplementary international search, the applicant will already have responded to a negative WO-ISA, IPER or supplementary international search report prepared by the EPO (unless the communication under Rule 161 was issued before 1 April 2010 - see E-VIII, 3.3.3).

This response may comprise amendments and/or observations filed in response to the communication under Rule 161(1) (or possibly filed earlier - see E-VIII, 3.3.1). Any amendments filed at this stage are made by the applicant of his own volition in accordance with Rule 137(2) (for more details see C-III, 2.2). This response will be taken into account by the Examining Division when drafting the first communication according to Art. 94(3). For more details, see E-VIII, 4.1, 4.2 and 4.3.

### **3.3 The invitation under Rule 70a(1)**

Under Rule 70a(1) the applicant is invited to respond to the ESOP within the period referred to in Rule 70(1) or, where applicable, within the period referred to in Rule 70(2) (see B-XI, 8), unless the applicant has waived the communication under Rule 70(2) (see C-VI, 3).

Where the request for examination (including payment of the examination fee) is filed after the search report has been transmitted to the applicant, the applicant must respond to the ESOP within the period referred to in Rule 70(1). In such cases the invitation under Rule 70a(1) is sent in a single communication together with the communication according to Rule 69(1) (see A-VI, 2.1). This combined communication under Rule 70a(1) and Rule 69(1) is issued shortly after the mention of the publication of the European search report in the European Patent Bulletin (in general, this is approximately one week later).

Where the request for examination (including payment of the examination fee) is filed before the search report has been transmitted to the applicant, the applicant must respond to the ESOP within the period referred to in Rule 70(2). In such cases the invitation under Rule 70a(1) is sent in a single communication together with the communication according to Rule 70(2). With regard to how the period referred to in Rule 70(2) is calculated for these cases, see C-II, 1.1, for Euro-direct applications and C-II, 1.2, for Euro-PCT applications for which a supplementary European search report is prepared.

### **4. Designation fee(s), extension and validation fees**

Under Rule 39(1), the designation fee(s) can be validly paid up to the same time limit as the examination fee and therefore will be generally paid at the same time as the examination fee. The examination whether and to what extent a designation fee has been validly paid has been entrusted to the formalities officer by virtue of Rule 11(3); see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6. The same applies to the examination as to whether extension or validation fees have been paid, see A-III, 12.2.

*Rule 39(1)*  
*Art. 90(3)*



**5. Copy of the search results on the priority or priorities**

Where the EPO notes, at the time the Examining Division assumes responsibility, that a copy of the results of a search on the claimed priority or priorities as referred to in Rule 141(1) has not been filed by the applicant and is not deemed to be duly filed under Rule 141(2) (see A-III, 6.12), it invites the applicant to file, within a period of two months, the copy or a statement that the results of the search referred to in Rule 141(1) are not available to him. This requirement applies to European or Euro-PCT applications filed on or after 1 January 2011 (see OJ EPO 2009, 585). This communication is also sent in cases where the priority in question has since been withdrawn or has lapsed.

*Rule 70b(1)*

Failure to reply to this invitation in due time results in the application being deemed to be withdrawn. Further processing is available for this loss of rights (see E-VII, 2).

*Rule 70b(2)*

The search results provided by the applicant will be included in the file and will be open to file inspection (see A-XI).



## Chapter III – The first stage of examination

### 1. Missing parts and elements

#### 1.1 European applications

##### 1.1.1 Missing drawings or parts of the description filed under Rule 56

Where the applicant has supplied missing drawings or parts of the description after accordance of a filing date (see A-II, 5) under Rule 56, and the Receiving Section has determined that the missing drawings or parts of the description are "completely contained" in the claimed priority application, the application is not re-dated to the date on which the missing drawings or parts of the description were supplied.

*Rule 56*

The Examining Division may review the findings of the Receiving Section on the applicability of Rule 56(3), unless there has been a decision of the Board of Appeal.

Normally the review of the findings will have been initiated at the search stage (see B-III, 3.3.1, and B-XI, 2.1). However, it can still be done for the first time during substantive examination.

For the criteria for determining whether the "completely contained" requirement of Rule 56(3) is satisfied, see A-II, 5.4.2.

Should the Examining Division come to the conclusion that the missing elements are not "completely contained" in the priority document, contrary to the original finding of the Receiving Section, it will raise an objection under Rule 56 in the first communication under Art. 94(3), presenting detailed arguments as to why the "completely contained" requirement is not satisfied. The communication will contain a warning of the possible consequence of re-dating because of non-compliance with the requirements of Rule 56(3) and, if re-dating would result in the filing date being more than 12 months after the claimed priority date, also a warning of the resultant loss of priority right.

Note that if the review was initiated at the search stage and an objection under Rule 56 was raised in the EESR, the applicant may already have submitted a response to the search opinion (required by Rule 70a or filed voluntarily in response to a search opinion not requiring a response). The Examining Division will treat this response in the same manner as the reply to the first communication.

If the applicant replies by withdrawing the missing parts, the examination will be continued as normal with the original filing date, but without the missing parts (see also F-III, 10).

If the applicant replies by arguing convincingly that the "completely contained" requirement is satisfied, the examination will be continued as normal with the missing parts and with the original filing date.

If the applicant maintains the missing parts and his arguments are not convincing, the Examining Division will issue a further communication under Art. 94(3) informing him of the impending re-dating of the application to the date on which the missing parts were received at the EPO. This communication gives the applicant a further opportunity to withdraw the subsequently filed missing parts within a time limit of two months (Rule 132(2)) so as to restore the original filing date or to request an appealable decision on the re-dating. It indicates the reasons why the "completely contained" requirement is not met, and also deals with any counter-arguments presented by the applicant.

If the applicant does not reply in due time to the communication informing him of the impending re-dating of the application, the application is deemed to be withdrawn (Art. 94(4)).

If the applicant opts to withdraw the subsequently filed missing parts, the re-dating of the application will be deemed not to have been made (see also B-XI, 2.1). The examiner will continue the examination procedure as normal with the original filing date, but without the missing parts (see also F-III, 10).

#### *Rule 111*

If the applicant does not agree with the finding, he may (within two months (Rule 132(2)) request an appealable decision on the matter. In this case, the Examining Division will issue a reasoned decision, informing the applicant of the new date of filing, of the reasons for the re-dating and (where appropriate) of the detrimental effect of the re-dating on the claimed priority right. This decision will allow a separate appeal according to Art. 106(2).

Once the period for filing an appeal has expired without an appeal being filed, the examiner will resume examination on the basis of the new date of filing. Note that the EESR may contain documents which could become relevant as a result of the re-dating.

If the applicant files an appeal in due time, competence for the file passes to the Board of Appeal for reviewing the decision on the accordance of a filing date. While the case is pending before the Board of Appeal, the Examining Division will not continue substantive examination. Once the Board of Appeal has issued a decision, the file will be returned to the examiner, who will be bound on this point by the decision of the Board (Art. 111(2)). He will then resume examination on the basis of the filing date fixed by the Board.

#### **1.1.2 Claims filed after accordance of a date of filing**

#### *Art. 123(2)*

If the claims were not present at the date of filing the application, the Examining Division must check whether the subsequently filed claims satisfy the requirements of Art. 123(2). If the basis for these subsequently

filed claims in the application as filed has not been indicated by the applicant (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see H-III, 2.1.1).

## **1.2 Euro-PCT applications - Missing elements and parts filed under Rule 20.5 and 20.6 PCT**

In the case of PCT applications, missing drawings and parts of the description, but also missing claims, may have been filed at the receiving Office for international applications under Rule 20.5 and 20.6 PCT, and its finding can be reviewed in accordance with Rule 82ter.1 PCT. The Examining Division will review this finding in all cases in which the filing date was retained on the basis of the "completely contained" requirement using the same criteria as applied when assessing compliance with Rule 56(3) EPC (see A-II, 5.4.2).

If either the EPO acted as the ISA or a supplementary EESR has been issued, this review will normally have been initiated at the search stage (see B-III, 3.3.1, and B-XI, 2.1). However, it can still be done for the first time during substantive examination. The procedure is the same as for European applications (see C-III, 1.1.1).

## **2. Amendments made by the applicant of his own volition**

Any amendment, including any made by the applicant of his own volition, must satisfy the following conditions:

- (i) it must not add subject-matter to the content of the application as filed (see H-IV, 2.3 and H-V, 1 to 7); *Art. 123(2)*
- (ii) it must not itself cause the application as amended to be objectionable under the EPC, e.g. the amendment must not introduce a lack of clarity into the claims (Art. 84); and
- (iii) it must comply with Rule 137(5) (see H-II, 6).

If the amendments do not meet these conditions, the applicant should be told that the amended application cannot be allowed. Apart from the amendments referred to in C-III, 2.1 and 2.2, which are admissible under Rule 137(2), the applicant may correct obvious errors at any time (see H-VI, 2.2.1).

If amendments are made and these are not identified and/or their basis in the application as filed not indicated by the applicant (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see H-III, 2.1.1).

### **2.1 Amendments made in response to the search opinion**

The amendments referred to in C-II, 3.1 are made by the applicant "of his own volition" (the applicant is required to respond to the search opinion in *Rule 137(2) and (3)*

the EESR, but does not necessarily have to respond by filing amendments; he can also respond by filing observations on the search opinion – see B-XI, 8). This means that the applicant is not restricted to amendment(s) necessary to remedy a defect in his application. Further amendments may be made only with the consent of the Examining Division (see H-II, 2.3).

## **2.2 Amendments made in response to the WO-ISA, IPER or supplementary international search report**

*Rule 137(2)*

For Euro-PCT applications where the EPO acted as International Searching Authority (ISA) or as the authority specified for supplementary international search (SISA), any amendments which the applicant files in response to the communication under Rule 161(1) (see E-VIII, 3.3.4) are made by the applicant of his own volition. This means that they may be submitted to overcome objections raised in the WO-ISA, IPER or supplementary international search report or they may be suggested for some other reason, e.g. to remedy some lack of clarity which the applicant himself has noted in the original documents. In order to avoid delays, care should be taken to comply with the requirements of Rule 137(4) when filing such amendments. Furthermore, the applicant may also file observations in place of or in addition to amendments.

## **2.3 Searches under Rule 164(2)**

*Rule 164(2)*

For Euro-PCT applications where the EPO acted as ISA or as SISA, the Examining Division under Rule 164(2) assesses the application documents upon expiry of the six-month time limit set in the communication under Rule 161 or 162. For any claimed invention or group of inventions within the meaning of Art. 82 which was not searched by the EPO in its capacity as ISA or SISA, the Examining Division issues an invitation to pay search fees.

The application documents as amended may contain claims directed to a non-searched invention in situations other than where the application documents which are to serve as the basis for examination do not meet the requirement of unity of invention.

For instance, the amended application may contain just one invention, but it may be an invention that was claimed but not searched by the EPO as (S)ISA in the international phase. In this case, there is no non-unity objection for this set of claims and the reasoning in the invitation needs only to refer to the non-unity objection in the WO-ISA and to the fact that no additional fee was paid for this invention during the international phase.

It may well be that an invention in the application documents was not even claimed in the application documents that served as the basis for the procedure in the international phase and has been imported from the description (see F-V, 13.1(iv)). In such cases an invitation to pay search fees under Rule 164(2) for any non-searched invention is to be issued by the Examining Division, irrespective of whether lack of unity persists in the claims. The invitation under Rule 164(2) must state that this is a new invention not searched in the international phase, and the reasons therefor. If other inventions are also present in the claims of such a case, which were

also not searched (but were claimed in the PCT phase), in the same invitation the applicant must also be invited to pay further search fees in respect of those inventions.

The invitation under Rule 164(2) must be sent before any communication according to Art. 94(3). It is to be noted that for Rule 164(2) to apply, the claims must be sufficiently clear to allow the identification of a non-searched invention by which the procedure under Rule 164(2) is triggered. If the claims are so unclear that a non-searched invention cannot be identified, the first action must be issuance of a communication under Art. 94(3) setting out the objections under Art. 84. Should it turn out later in the procedure that amended claims are indeed directed to a non-searched invention, the applicant must file a divisional application for any such subject-matter. Recourse to Rule 164(2) is not provided for if, as a result of further amendments or clarification, (further) non-searched inventions are identified, since the procedure under Rule 164(2) applies to the application documents as submitted by the applicant as the basis for examination.

If auxiliary requests are submitted before a search under Rule 164(2) is performed, only the main request is taken into account for the purpose of the search (notwithstanding the exceptions relating to Rule 62a or 63 cases where main and auxiliary requests are both considered at the search stage, see B-VIII, 3.2.2 and 4.2.2).

If any search fee(s) is/are paid in time, the results of the search(es) are communicated to the applicant as an annex to a communication under Art. 94(3) and Rule 71(1) and (2) or under Rule 71(3), as set out in Rule 164(2)(b). This annex is entitled "Search result according to Rule 164(2)".

If search fees are not paid in due time under Rule 164(2), a communication under Art. 94(3) and Rule 71(1) and (2) or under Rule 71(3) will be issued and the Examining Division will require deletion from the claims of any non-searched subject-matter that was not searched either because a search fee under Rule 164(2) was not paid (see H-II, 7) or for a different reason (see H-II, 6). Before the patent is granted, this subject-matter should be either deleted from the description and drawings or indicated as not forming part of the claimed invention (see F-IV, 4.3(iii)).

A communication under Rule 164(2)(b) deals with all objections for each of the inventions searched in accordance with Rule 164(2). For claims relating to inventions already searched by the EPO in the international phase which have been amended but still lack unity, it is sufficient to argue in detail why lack of unity is still present. The communication, where appropriate, further requests the applicant to limit the application to a single searched invention (see Rule 164(2)(c)).

It follows from Rule 164(2)(b) and (c) that the special procedure under Rule 164(2) as set out in H-II, 2.3 ends upon expiry of the time limit set in the communication issued under paragraph (b). This means that the

applicant's right to make amendments of his own volition ends upon expiry of the time limit set in that communication.

Furthermore, the special procedure as set out in F-V, 13.1(iv), which exempts amendments from the requirements of Rule 137(5), first sentence, ends upon expiry of the time limit under Rule 161(1). Such amendments will result in an invitation under Rule 164(2)(a) and allow the applicant to obtain a search of unsearched subject matter referred to in Rule 137(5). However, any amendments submitted after expiry of the time limit under Rule 161(1) are subject to the requirements of Rule 137(5), first sentence (see H-II, 6.2).

The EPO's obligations under Rule 164(2) are fulfilled and the applicant's rights under this Rule are exhausted once a single communication under Rule 164(2) has been sent. It follows that in cases of cascading non-unity no (further) invitation under Rule 164(2) is sent. The same applies if claims are added or existing claims amended so that they relate to non-searched inventions in the course of the examination procedure.

Exceptional cases may arise where the following sequence of events has occurred in the international phase:

- (i) The EPO acted as ISA in the international phase.
- (ii) The EPO acting as ISA invited the applicant to pay one or more additional international search fees in accordance with Art. 17(3)(a) PCT and Rule 40 PCT (due to a lack of unity according to Rule 13 PCT).
- (iii) The applicant paid at least one such additional search fee.
- (iv) The additional search(es) led to a further objection as to a lack of unity a posteriori (a cascading lack of unity), resulting in one of the inventions identified in the invitation under Art. 17(3)(a) PCT and Rule 40 PCT being further sub-divided and resulting in sub-inventions not originally identified in that invitation.
- (v) The EPO did not search all such sub-inventions.

In the above case, the EPO will invite the applicant to pay search fees for any such unsearched sub-inventions in the claims which are to form the basis for examination on expiry of the six-month period under Rule 161(1), in accordance with Rule 164(2).

Where the EPO was the SISA in accordance with Rule 45bis.9 PCT, it may make a finding of a lack of unity of the international application according to Rule 45bis.6(a) PCT. However, in the procedure before the SISA, the applicant cannot pay additional supplementary international search fees, and the Supplementary International Search Report will be directed only to the invention or unitary group of inventions first mentioned in the claims (Rule 45bis.6(a) PCT). Where such an application contains unsearched



inventions in the claims which are to form the basis for examination on expiry of the six-month period under Rule 161(1), a communication according to Rule 164(2) is issued, allowing the applicant to have these inventions searched upon payment of search fees and permitting him to pursue one of them in the examination proceedings.

Rule 164(2)(b) provides for a right to amend the application in response to the results of any search under Rule 164(2). This means that the applicant may make amendments of his own volition once in response to the communication under Art. 94(3) to which the search results under Rule 164(2) are annexed (H-II, 2.3).

### 3. Unity of invention

#### 3.1 Relation to unity in search; limitation to searched invention

An objection of lack of unity of invention, if applicable, should already have been raised at the search stage. If such an objection was not raised, but the Examining Division nevertheless considers that the requirements of Art. 82 are not met, the question of lack of unity will be addressed as early as possible during examination.

*Art. 82*

##### 3.1.1 No additional search fees paid

If the applicant has not availed himself of the opportunity to have the search results on the other inventions included in the search report because he has paid no additional search fees in response to the invitation under Rule 64(1) (see B-VII, 1.2) or Rule 164(1) (see B-VII, 2.3), he will be taken to have elected that the application should proceed on the basis of the invention which has been searched (see G 2/92). In cases where a communication according to Rule 164(2) has been sent, Rule 164(2)(c) requires the applicant to delete all unsearched inventions from the claims.

*Rule 64*

*Rule 164(1) and (2)*

It must be taken into account that the final responsibility for establishing whether the application meets the requirement of unity of invention ultimately rests with the Examining Division (see T 631/97). When considering the issue of unity, the Examining Division will consider both the reasons given in the search opinion and the applicant's response thereto (see B-XI, 8 for details of when a response to the search opinion is required); for Euro-PCT cases where no supplementary European search report is prepared, the Examining Division will consider the reasons given in the WO-ISA, IPER or supplementary international search report prepared by the EPO and the applicant's response thereto as required by Rule 161(1) (see E-VIII, 3.2). In the absence of any convincing response from the applicant to the issue of unity as raised earlier, the Examining Division will normally initially uphold the position taken earlier (see B-XI, 1.2) and will then require deletion of all the inventions other than that which has been searched. If the Examining Division is convinced, e.g. by arguments from the applicant, that the opinion on unity at the search stage was incorrect, then an additional search is performed for that part of the subject-matter which is judged to be unitary with an invention which was searched (see B-II, 4.2(iii) and C-IV, 7.2) and the examination is carried out on those claims which comply with the requirement of unity of

invention. The applicant may file a divisional application for any excised subject-matter (see C-III, 3.2).

### **3.1.2 Additional search fees paid**

If the applicant has taken the opportunity to have other inventions searched, then he may determine that the application is to proceed on the basis of any of these, the other(s) being deleted. If the applicant has not yet done so, the examiner should at the beginning of substantive examination, if he maintains the objection of lack of unity (see C-III, 3.1.1), invite the applicant to state on which invention the prosecution of the application should be based and to limit the application accordingly by excising those parts belonging to the other inventions. For the latter inventions, the applicant may file divisional applications (see C-III, 3.2).

### **3.1.3 Invitation to pay additional search fees combined with invitation to restrict the scope of the search**

In exceptional cases an invitation to pay additional search fees under Rule 64(1), Rule 164(1) or Rule 164(2) may be combined with an invitation to restrict the scope of the search under Rule 62a(1) and/or Rule 63(1).

When the application enters the examination phase or, in the case of Rule 164(2), after the reply to the first communication, the examiner will check whether the claims on which substantive examination is based meet the requirement of unity of invention (Art. 82) and cover only subject-matter which has been searched. If the claims lack unity of invention, the applicant will be invited to limit the claims to one searched invention and to exclude all unsearched subject-matter from the scope of the claims. If in reply to the objection raised by the examiner the applicant fails to respond adequately (either by amending the claims or by submitting convincing arguments) and the non-unity objection can be maintained, the application will be refused under Art. 97(2) in conjunction with Art. 82 (see H-II, 7.3 and 7.4).

If the original set of claims has been amended before entering the examination phase or, in the case of Rule 164(2), in reply to the first communication such as to meet the requirements of Art. 82, but includes subject-matter that was excluded from the search following an invitation under Rule 62a(1) and/or Rule 63(1), the examiner will either (i) invite the applicant to limit the set of claims to the searched subject-matter under Rule 62a(2) and/or Rule 63(3), or (ii) raise an objection under Rule 137(5) against the claim(s) concerned (see H-II, 6.2). In Rule 164(2) cases, if the first communication already included the relevant objections/invitations and the right to be heard has been respected, the application may be refused.

If in reply to the invitation under Rule 62a(2) or Rule 63(3) the applicant fails to respond adequately (either by amending the claims or by submitting convincing arguments), the application may be refused under Art. 97(2) (see F-IV, 3.3).

## **3.2 Excision of other inventions; filing divisional applications**

For inventions which the applicant has deleted in accordance with C-III, 3.1.1 or 3.1.2, the applicant may file divisional applications.

The filing of a divisional application is only possible if the application being divided is still pending (see A-IV, 1.1.1).

### 3.3 Refund of additional search fees

If the applicant has paid further search fees in response to an invitation under Rule 64(1), 164(1) or (2) and has requested a refund of these, the Examining Division is required to review the validity of the finding of lack of unity (see also F-V, 10 to 13).

*Rule 64(2)*

*Rule 164(5)*

Requests for refunds should be handled promptly. If the examiner concludes that a request for refund should not be granted, an interlocutory decision to that effect should be issued at the earliest opportunity, subject to the requirements of Art. 113(1), and the issuing of the decision should not normally be left until the final decision on the application. Of course, if the stage in the procedure at which the examiner is in a position to issue the decision on the refund coincides with the issuing of either a Rule 71(3) communication or a decision refusing the application, then in the former case the interlocutory decision can be issued with the Rule 71(3) communication, and in the latter case the decision on the refund can be included in the decision refusing the application. An interlocutory decision issued on this matter will allow separate appeal under Art. 106(2).

Before an interlocutory decision is issued which refuses the request to refund additional search fees under Rule 64(2), the applicant should be informed of the Examining Division's preliminary opinion in a communication under Art. 94(3). The arguments presented by the applicant in his reply to the search opinion should be taken into account in this preliminary opinion. Furthermore, a time limit should be set in order to give the applicant the possibility to comment on the Examining Division's preliminary opinion. At the same time, the applicant can be informed that he may request an interlocutory decision on the refund which will allow separate appeal under Art. 106(2). If these requirements are fulfilled, the applicant's right to be heard under Art. 113(1) is respected. The same procedure applies to the refund of search fees paid under Rule 164(1) and (2).

Rule 164(5) provides for a refund of any search fee paid under Rule 164(1) or (2) in line with Rule 64(2) (see A-X, 10.2.2). Where the applicant pays a search fee in response to the Rule 164(2) invitation and at the same time contests the basis for requiring payment of a search fee and requests its refund under Rule 164(5), the Examining Division may deal directly with this issue in the communication according to Art. 94(3) and Rule 71(1) or (2) which accompanies the search results under Rule 164(2). Such an immediate review of the applicant's request is not possible in Rule 64(1) and 164(1) cases until such time as the Examining Division assumes responsibility for the application.

Moreover, it is essential to bear in mind that the review under Rule 64(2) or 164(5) is restricted to a reconsideration of the validity of that original finding under the circumstances existing at the time the Rule 64(1), 164(1) or (2) invitation was sent, taking into account only the

prior art which was available at that time. For more details on the assessment of unity of invention see F-V.

The issue of refunds of additional **international** search fees paid to the EPO acting as ISA in response to an invitation under Art. 17(3)(a) PCT, however, does not arise in the European phase, because these fees were paid in the international phase, which is closed by this stage of the procedure. The applicant may contest the payment of additional international search fees to the EPO acting as ISA by paying these under protest according to Rule 40.2(c) PCT. However, this must be done in the **international** phase (see also the Decision of the President of the EPO dated 24 March 2010, OJ EPO 2010, 320 and the Notice from the EPO dated 24 March 2010, OJ EPO 2010, 322).

### 3.4 Changing from one searched invention to another

Once the applicant has limited the claims to one searched invention, the Examining Division will refuse to admit amendments which involve switching to a different searched invention (for further information see H-II, 7.1).

## 4. First communication

*Rule 71(1) and (2)*  
*Rule 132*  
*Art. 94(3)*

If deficiencies persist in the application even after the applicant has filed his response to the search opinion, the Examining Division will issue a communication according to Art. 94(3) and Rule 71(1), (2) in subsequent examination proceedings and will consider the applicant's reply thereto before issuing a negative decision or a summons to oral proceedings.

When drawing up such a communication, the Examining Division will take into account the documents (if any) cited in the search report and any further documents found as the result of the search referred to in C-IV, 7.1, as well as any amendments proposed, or comments made, by the applicant in reply to the search opinion (see B-XI, 8) or in reply to the communication under Rule 161(1) (see E-VIII, 3). The examiner should identify in this communication any requirements of the EPC which, in his opinion, the application does not satisfy. The communication will give reasons for any objections raised and will invite the applicant within a specified period to file his observations or submit amendments. The filed application documents are not sent back to the applicant although a copy of the description and claims may be sent in appropriate cases (see H-III, 2). When the applicant has replied, the examiner will then re-examine the application.

If no search opinion has been issued (see C-VI, 3, F-V, 13.1(ii) and B-XI, 1.1), the examiner's first communication under Art. 94(3) will, as a general rule (see B-XI, 3) and by analogy with the search opinion, cover all objections to the application (see B-XI, 3.4, for exceptional cases where not all objections are raised).

## 4.1 Reasoning

### 4.1.1 Reasoned objections

As with the search opinion, for each objection the communication should indicate the part of the application which is deficient and the requirement of the EPC which is not met, either by referring to specific Articles or Rules, or by other clear indication; it should also give the reason for any objection where this is not immediately apparent (for more details see B-XI, 3.2).

*Rule 71(2)*

### 4.1.2 Positive statements/suggestions

Where appropriate, the communication should also contain positive statements on patentability where some of the claims meet the patentability requirements (see B-XI, 3.2.2). In this phase of the proceedings, the examiner should make such statements in particular where the claims for which a positive conclusion is reached have not yet been commented on.

Concerning making suggestions on how to overcome objections, see B-XI, 3.8.

## 4.2 Invitation to file comments and amendments

The communication should include an invitation to the applicant to file his observations, to correct any deficiencies and, if necessary, to submit amendments to the description, claims and drawings. It must also state the period within which the applicant must reply. Failure to reply in due time will cause the application to be deemed withdrawn (see C-VI, 1 and E-VII, 1). Further processing applies to this loss of rights (E-VII, 2).

*Rule 71(1) and (2)*  
*Art. 94(3) and (4)*

## 5. Requesting information on prior art (not confined to priority)

The EPO may invite the applicant to submit, within a period of two months, information on prior art which has been taken into consideration in national or regional patent proceedings concerning an invention to which the European patent application relates. This in particular encompasses search results with respect to filings whose priority is not being claimed, and it also enables the EPO to request, *inter alia*, the copy of the results of the search on the priority or priorities referred to in Rule 141(1), where the search results were not available to the applicant when requested under Rule 70b(1) (see the Notice from the EPO dated 28 July 2010, OJ EPO 2010, 410). Failure on the part of the applicant to comply with this invitation results in the application being deemed to be withdrawn under Art. 124(2). Further processing is available for this loss of rights (see E-VII, 2).

*Art. 124*  
*Rule 141(3)*

In view of the considerable work such invitations may imply for applicants, further requests under Rule 141(3) will be issued only in individual cases, where there are cogent reasons to suspect the existence of additional, relevant prior art.

This invitation is an independent communication, and the above-mentioned time limit is non-extendable. The invitation can be sent by itself or at the same time as a communication according to Art. 94(3). If sent at the same time, the time limits set in both communications are independent of one

another. Any information on prior art provided by the applicant will be included in the file and will be open to file inspection (see A-XI).

#### **6. Evaluation of prior art documents cited in search report and late priority claim**

As explained in A-III, 6.5.1 and 6.5.2, the applicant has the right to correct or to introduce a priority claim within 16 months of the earliest priority (with a minimum of four months from the European filing date in the case of corrections). When this happens before finalisation of the search report, the examiner may review the draft search report to take into account the change in the effective date of the application. In cases where the search report was issued on the basis of the original priority status (i.e. addition or correction of a priority claim is effected after the search report is drawn up), the primary examiner at the substantive examination stage should re-evaluate the relevance of the documents cited in the search report. Where it appears that the prior art available to the examiner is unlikely to reflect the state of the art in a sufficiently complete way for the purpose of a patentability assessment, the examiner should then conduct an additional search (see C-IV, 7.2). No further search report will be issued in these cases: the applicant will be informed of any newly-found documents in a communication pursuant to Art. 94(3) (with copies of such documents annexed to that communication).

## Chapter IV – Examination of replies and further stages of examination

### 1. General procedure

Following the applicant's reply to the search opinion (see B-XI, 8), WO-ISA, IPER or supplementary international search report prepared by the EPO (see E-VIII, 3) or to the first communication, the examiner must examine the application, taking into account observations or amendments made by the applicant.

Where the application is one of those mentioned in H-III, 2.1.4, Rule 137(4) requires that any amendments made by the applicant in reply to the search opinion, WO-ISA, IPER or supplementary international search report be identified and their basis in the application as filed indicated. Failure to comply with this requirement may result in the Examining Division sending a communication according to Rule 137(4). For more details of the procedure, see H-III, 2.1.1 and 2.1.2.

In the case of one or more auxiliary request(s) directed to alternative texts for grant of a patent, every such request qualifies as a text submitted or agreed by the applicant within the meaning of Art. 113(2) and therefore must be dealt with in the order indicated or agreed to by the applicant, up to and including the highest-ranking allowable request, if any (see also H-III, 3 and C-V, 1.1). It is also to be noted that, for the types of application mentioned in H-III, 2.1.4, Rule 137(4) must also be complied with in respect of auxiliary requests, which may also be subject to a communication according to Rule 137(4).

### 2. Extent of examination of replies

After the first examination stage, provided that the:

- search opinion,
- WO-ISA (when prepared by the EPO),
- explanation accompanying the supplementary international search report under Rule 45*bis*.7(e) PCT (when prepared by the EPO, see the Notice from the EPO dated 24 March 2010, OJ EPO 2010, 316, point 6),
- IPER (when prepared by the EPO), or
- first communication (see B-XI, 1.1 and 8)

was comprehensive and clear (see B-XI, 3, and C-III, 4 and 4.1), the examiner will not normally need to completely reread the application but rather should concentrate on the amendments themselves, the related passages, and the deficiencies previously noted.

### 3. Further action upon examination of replies

*Art. 94(3)*

The examiner should be guided at this stage by the over-riding principle that a final position (grant or refusal) should be reached in as few actions as possible, and he should control the procedure with this always in mind. The EPC provides that the process of communicating with the applicant described in C-III, 4, is repeated "as often as necessary".

In most cases, the applicant will have tried to deal with all the examiner's objections (see B-XI, 8).

*Art. 113(1)*

If examination of the applicant's reply shows that despite his submissions objections persist, and provided that at least one communication has been sent in examination proceedings (see C-III, 4 and E-VIII, 4.1) and the applicant has been given the right to be heard (Art. 113(1)), i.e. the decision is based solely on grounds on which he has had an opportunity to comment, the application is to be refused (see T 201/98).

If examination of the applicant's reply shows that he has not dealt with all the main objections in his reply, it may be appropriate to draw the deficiencies to his attention, e.g. by telephone. But if no positive reaction is to be expected, the examiner should consider recommending to the other members of the Examining Division that the application be refused immediately (again provided that at least one communication has been sent in examination proceedings).

In most cases, however, examination of the applicant's reply will show that there are good prospects of bringing the proceedings to a positive conclusion, i.e. in the form of a decision to grant. In such cases, if there are still objections to be met, the examiner must consider whether they can best be resolved by a further written communication, a telephone discussion or a personal interview. It may be useful if the examiner makes suggestions on how to overcome objections (see B-XI, 3.8, and C-III, 4.1.2).

If substantial differences of opinion exist, the issues are generally best dealt with in writing. If, however, there seems to be confusion about points in dispute, e.g. the applicant seems to have misunderstood the examiner's arguments or the applicant's own arguments are unclear, then an interview may be useful. If, on the other hand, the matters to be resolved are minor, they can be settled more expeditiously over the telephone. Interviews or telephone discussions with the applicant or his representative are more fully considered in C-VII, 2. Telephone discussions or interviews do not constitute oral proceedings (see E-II).

#### 3.1 Further action where a request for a translation of the priority application was sent earlier in examination proceedings

*Rule 53(3)*

In cases where an invitation under Rule 53(3) to file a translation of one or more priority applications was sent earlier in examination proceedings (either separately or at the same time as a communication under Art. 94(3) – see A-III, 6.8.2), a subsequent communication (under Art. 94(3) or Rule 71(3), or a summons to oral proceedings) cannot be sent until the



translation is filed or the period for further processing has expired (see also E-II, 5.1). This also applies in cases where the Rule 53(3) invitation was sent at the same time as a previous communication under Art. 94(3) and the applicant has already replied to that communication (e.g. by filing amendments), but has not yet provided the translation and the original time limit or the period for further processing is still running.

#### **4. Later stages of examination**

Similar considerations apply to later stages of examination on the understanding that, having regard to the principle stated in C-IV, 3, the greater the number of actions which have already taken place, the greater is the likelihood that the most appropriate action is to refer the application to the other members of the Examining Division for a decision. Where this decision is to refuse the application, particular care should be taken to ensure that the decision does not offend against Art. 113(1).

#### **5. Examination of amendments**

Any amendment must satisfy the conditions listed in C-III, 2. When it was effected must also be established.

#### **6. Admissibility of amendments made by the applicant**

For matters relating to the admissibility of amendments made in examination proceedings see H-II, 2. *Rule 137(2) and (3)*

#### **7. Search-related issues in examination**

##### **7.1 Search for conflicting European applications**

The examiner should make a search for any additional conflicting European applications falling within the area defined by Art. 54(3), unless this was already covered by the search report.

This is because as a general rule the search files will not be complete in respect of such material at the time the main search is made. Since priority dates claimed (if any) may not be accorded to all or part of the application but may be accorded to the appropriate part of a conflicting application (see F-VI, 2.1), this search should be extended so as to cover all European applications published up to eighteen months after the filing of the application under consideration. On condition that the priority claim is valid for the whole content of the patent application under examination, the top-up search may exceptionally be performed at the earliest 18 months from the priority date. If the examiner is unable to complete this "topping-up" search at the time the search opinion or the first communication under Art. 94(3) is prepared, he should ensure that such search is completed before the application is reported to be in order for the grant of a patent. In the rare case in which the application is found to be in order before this search can be completed (e.g. due to a request for accelerated prosecution of an application not claiming priority, "PACE", see Notice from the EPO dated 4 May 2010, OJ EPO 2010, 352), the grant of a patent should be postponed until the topping-up search can be completed (T 1849/12).

In addition to retrieving Art. 54(3) documents which were not available at the time of the original search, the top-up search takes into consideration, *inter alia*, potentially relevant prior art cited by other Patent Offices on applications belonging to the same patent family as the application under examination at the EPO, and therefore needs to be performed for any file at the start and end of examination.

In the framework of the refund of examination fees (see A-VI, 2.5), the launch of a top-up search is triggered at the start of examination. This creates a marker which serves as evidence in the file that the Examining Division has started its substantive work.

## **7.2 Additional searches during examination**

An additional search will sometimes be required either at the first stage of amendment or subsequently. This may arise for a number of reasons.

An additional search may be necessary:

- (i) where a declaration or a partial search taking the place of the search report under Rule 63 has been issued at the search stage after an invitation under Rule 63(1) (see B-VIII, 3, 3.1 and 3.2), and subsequently the deficiencies which rendered a meaningful search impossible under Rule 63 have been corrected by amendment complying with Rule 137(5) (see H-II, 6.1) or successfully refuted by the applicant;
- (ii) where the applicant successfully argues that a plurality of independent claims in the same category, which led to a limitation of the search report in accordance with Rule 62a (see B-VIII, 4.1 and 4.2), is in fact allowable according to the exceptions provided for in Rule 43(2) (see F-IV, 3.2);
- (iii) where a particular part of the application has not been searched because of an objection of lack of unity of invention, and the arguments put forward by the applicant have convinced the Examining Division that unity is given;
- (iv) where the claims have been so amended that their scope is no longer covered by the original search;
- (v) where a search report under Rule 61 was issued containing no prior art documents because the technical features were found to be notorious (see B-VIII, 2.2.1) and the Examining Division does not share this opinion;
- (vi) where no prior art document was cited for features which were considered to be part of the common general knowledge and the Examining Division does not share this opinion or the common general knowledge is challenged by the applicant (see G-VII, 2 and 3.1);

- (vii) exceptionally, where the applicant states that he made a mistake in the acknowledgement of prior art (see G-VII, 5.1) or the examiner believes that material relevant to obviousness might be found in technical fields not taken into account during the search;
- (viii) where the applicant has introduced a new priority claim after the date of filing (see C-III, 6).

If the application has been filed under the PCT, the search report will be the international search report made under the PCT, which will be accompanied by a supplementary European search report, unless the Administrative Council has decided that a supplementary report is to be dispensed with (see E-VIII, 3.2). Both of these reports will have to be considered by the examiner when deciding whether any additional search is required.

*Art. 153(6) and (7)*

For searches under Rule 164(2) see C-III, 2.3.

### **7.3 Search at the examination stage**

Although in principle all search work (other than for Art. 54(3) material) should be done at the search stage, in exceptional circumstances the examiner is not barred from looking for a relevant document whose existence he knows of or has reason to suspect, if he can retrieve that document in a short time.

### **7.4 Citing documents not mentioned in the search report**

A copy of any document cited by the examiner but not mentioned in the search report, for example one found in a search under C-IV, 7.1 or 7.2, should be sent to the applicant and identified in the electronic dossier (see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, J.2).

## **8. New submissions in reply to summons**

New requests filed in reply to a summons to oral proceedings will normally be discussed at the oral proceedings. As a rule there is no provision for detailed discussion before the oral proceedings.

The Examining Division should strive to review newly-filed requests in good time before oral proceedings so that the proceedings can be cancelled if necessary, in particular where a newly-filed main request is considered patentable.



## Chapter V – The final stage of examination

### 1. Communication under Rule 71(3)

#### 1.1 Text for approval

Once the Examining Division has decided that a patent can be granted it must inform the applicant of the text on the basis of which it intends to do so. This text may include amendments and corrections made by the Examining Division on its own initiative which it can reasonably expect the applicant to accept. In case of doubt as to whether the applicant would agree to the amendments proposed by the Examining Division, the applicant should be contacted by telephone or an official communication has to be written. The applicant's agreement to such amendments will usually be noted in the minutes in the communication according to Rule 71(3) (see C-VII, 2.5). *Rule 71(3)*

Examples of amendments where no such consultation with the applicant is required are the following:

- (a) bringing a statement of invention in the description into conformity with the claims
- (b) deletion of vague general statements in the description (see F-IV, 4.4) or of obviously irrelevant matter (see F-II, 7.4)
- (c) insertion of values in SI units (see F-II, 4.13)
- (d) insertion of reference numerals in claims, unless the applicant is known to object to this or has previously objected to this
- (e) introduction of a summary of background art which clearly represents the prior art closest to the invention
- (f) amendments which, in spite of the fact that they change the meaning or scope of an independent claim, would very clearly have to be made, so that it can be assumed that the applicant would not object to them (see for example G-VI, 7.1.2, G-VI, 7.1.3 and G-VI, 7.1.4)
- (g) correction of linguistic and other minor errors
- (h) reformulation of method-of-treatment claims into an allowable format (see G-II, 4.2).

Examples of amendments which may not be proposed without consulting the applicant are:

- (i) amendments which significantly change the meaning or scope of the claims, if there are different ways of amending the claim, so that the examiner cannot assume to which possibility the applicant will agree.

- (ii) deletion of entire claims, with the exception of so-called "omnibus claims" (i.e. claims reading "An apparatus substantially as described herein", or the like)
- (iii) combining claims so as to overcome a novelty or inventive step objection.

With regard to such amendments and corrections made by the Division, it is important to bear in mind that the above list is designed to avoid changes which the applicant is more likely to reject, thus helping to avoid delays in the conclusion of examination proceedings. The standard marks used by the Division for indicating amendments and corrections using the electronic tool are listed in C-V, Annex.

The text is communicated to the applicant by despatching a communication under Rule 71(3), in which the applicant is furthermore invited to pay the fee for grant and publishing (see C-V, 1.2) and to file a translation of the claims in the two official languages of the EPO other than the language of the proceedings (see C-V, 1.3) within a period of four months, which is non-extendable. If the applicant pays the fees and files the translations within this period (and files or requests no corrections or amendments to the text proposed for grant in the Rule 71(3) communication, see C-V, 4.1), he will be deemed to have approved the text intended for grant (Rule 71(5)).

If during examination proceedings a main and auxiliary requests have been filed (see C-IV, 1 and E-IX, 3) and one of the requests is allowable, the communication pursuant to Rule 71(3) is to be issued on the basis of the (first) allowable request and must be accompanied by an explanation of the reasons why the higher-ranking requests are not allowable (see also H-III, 3).

Handwritten amendments by the applicant to the description, claims and abstract, unless they involve graphic symbols and characters and chemical or mathematical formulae, are no longer accepted in strict compliance with Rule 50(1) in conjunction with Rule 49(8) (see OJ EPO 2013, 603, and A-III, 3.2). For the procedure to follow in oral proceedings, see E-II, 8.7.

### **1.2 Grant and publishing fee**

The communication under Rule 71(3) also invites the applicant to pay the fee for grant and publishing within the same non-extendable four-month period. Note that for European patent applications filed before 1 April 2009 and international applications entering the regional phase before that date the fee for grant and printing may include an element depending on the number of pages, but for applications filed or entering the regional phase on or after that date this additional element is payable as part of the filing fee (see A-III, 13.2).

### **1.3 Translations of the claims**

The communication under Rule 71(3) also invites the applicant to file a translation of the claims in the two official languages of the EPO other than

the language of the proceedings within the same non-extendable four-month period.

If the application contains different sets of claims for particular Contracting States (see H-III, 4), a translation of all the sets of claims must be filed.

Only one copy of the translation need be filed.

The examiner should not concern himself with the quality of the translation filed.

The translation should meet the requirements pursuant to Rule 50(1).

*Rule 50(1)*

#### **1.4 Claims fees due in response to Rule 71(3) communication**

If the text of the European patent application serving as the basis for grant contains more than fifteen claims, the Examining Division requests the applicant to pay, within the period under Rule 71(3), claims fees in respect of each claim over and above that number, unless he has already done so under Rule 45(1) or Rule 162(1) and (2) (see A-III, 9). Where there is more than one set of claims, fees are incurred under Rule 45(1), Rule 162(1) and 162(2) or Rule 71(4) only for the set with the greatest number of claims.

*Rule 71(4)*

*Rule 45(1)*

*Rule 162(1) and (2)*

If the text on which the Rule 71(3) communication is based contains fewer claims than the set of claims in respect of which claims fees were paid on filing under Rule 45 or on entry into the European phase under Rule 162, no refund of claims fees will be made.

Where the communication under Rule 71(3) is based on an auxiliary request, it is the number of claims in that auxiliary request which determines the claims fees which are due in response to this communication. However, if the applicant then replies by requesting a grant based on a higher request, no claims fees need to be paid in response to that Rule 71(3) communication (see C-V, 4.1).

#### **1.5 Other information in the communication under Rule 71(3)**

An annex to the communication under Rule 71(3) states the Contracting States which have been validly designated, the title of the invention in the three EPO official languages, the international patent classification and the registered name of the applicant.

The communication under Rule 71(3) also states that, where a renewal fee falls due between the notification of this communication and the proposed date of publication of the mention of the grant, publication will be effected only after the renewal fee and any additional fee have been paid (see C-V, 2).

Where the Examining Division changes its opinion after an earlier negative communication, it will communicate the reasons for this change, unless they are clear from the applicant's reply, from a communication or from the minutes of a telephone conversation.

During the grant procedure an applicant may submit further technical information, for example:

- comparative tests
- further examples
- statements concerning the effects and/or advantages of the invention.

Technical information which extends beyond the content of the application as filed, however, cannot be included in the application by way of amendment (Art. 123(2), H-IV and H-V). Such information is added to the file, which is open to inspection (Art. 128(4)). The existence of such information is indicated on the cover page of the patent specification.

All further documents which were neither cited in the application as filed nor mentioned in the search report but have been cited during the examination procedure are to be indicated, even if they have not been used in an objection concerning novelty or inventive step. This also applies to documents which are cited to show, for instance, a technical prejudice.

## **2. Grant of a patent**

*Rule 71(5)*  
*Art. 97(1)*

If the applicant pays the fee for grant and publishing and any claims fees due under Rule 71(4) and files the translation of the claims within the specified period (and files or requests no corrections or amendments to the text proposed for grant in the Rule 71(3) communication, see C-V, 4.1), he is deemed to have approved the text intended for grant.

For cases where applicants make use of the Rule 71(3) waiver procedure, see C-V, 4.11.

The above also applies where the Rule 71(3) communication was based on an auxiliary request, provided that the applicant does not reply to the Rule 71(3) communication by requesting that a grant be based on a higher request. This means that, in the absence of any indication to the contrary, the above acts imply approval of the text of the auxiliary request upon which the Rule 71(3) communication was based as well as the abandonment of all higher requests.

The above also applies where the Rule 71(3) communication included proposals by the Examining Division for amendments or corrections of the text intended for grant (see C-V, 1.1). Consequently, provided the applicant does not reject these proposed amendments or corrections in his reply, the completion of the above acts constitutes approval of the text containing the amendments or corrections as proposed by the Examining Division.

*Rule 71a(1)*

Once all the requirements set out in C-V, 1.1 to 1.4, are met, the decision to grant the European patent is issued, provided that renewal fees and any additional fees already due have been paid.



If a renewal fee becomes due after notification of the Rule 71(3) communication but before the next possible date for publication of the mention of the grant of the European patent, the decision to grant is not issued and the mention of the grant is not published until the renewal fee has been paid. The applicant is informed accordingly. If the renewal fee or any additional fee is not paid in time, the application is deemed to be withdrawn (see A-X, 5.2.4).

*Rule 71a(4)*  
*Art. 86(1)*

In the rare case that examination was accelerated to such an extent that the communication under Rule 71(3) is issued before the designation fee becomes due, the decision to grant will not be issued and the mention of the grant of the patent will not be published until the designation fee has been paid. The applicant is informed accordingly. For European patent applications filed before 1 April 2009 or international applications entering the regional phase before that date this publication will not take place until the designation fees have been paid and the designation of States for which no designation fees have been paid has been withdrawn (see also A-III, 11.1 and 11.3).

*Rule 71a(3)*

The decision to grant does not take effect until the date on which the grant is mentioned in the European Patent Bulletin.

*Art. 97(3)*

### **3. Application deemed withdrawn**

If the applicant fails to pay the fee for grant and publishing or the claims fees or to file the translation in due time, the application is deemed to be withdrawn unless, within the period under Rule 71(3), the applicant files or requests corrections or amendments to the text proposed for grant in the Rule 71(3) communication (see C-V, 4.1).

*Rule 71(7)*

### **4. Amendments or corrections filed in reply to a Rule 71(3) communication**

If the applicant, within the period under Rule 71(3), requests amendments or corrections to the communicated text which are reasoned (with regard to the reasoning required, see C-V, 4.3), the Examining Division will issue a new communication under Rule 71(3) if it gives its consent (i.e. if it finds the amendments admissible and allowable, see C-V, 4.6); otherwise it will resume the examination proceedings (see C-V, 4.7).

*Rule 71(6)*

In this and sections C-V, 4.1 to 4.10, unless otherwise stated, the terms "*amendment(s)*" and "*correction(s)*" refer only to amendments or corrections of the application documents and not of other documents (e.g. bibliographic data, the designation of the inventor, etc.).

For applicants who wish to waive their right to receive a further communication under Rule 71(3), see C-V, 4.11.

#### **4.1 No payment of fees or filing of translations necessary**

In the case referred to in C-V, 4, the applicant will not be required to pay the fee for grant and publishing or any claims fees in reply to the first communication under Rule 71(3), nor will he be required to file any translations of the claims within this period. This applies irrespective of

whether the Examining Division subsequently finds these amendments or corrections to be admissible and allowable and irrespective of whether the amendments or corrections are reasoned (see C-V, 4.3).

This also applies if the applicant requests the reversal of amendments proposed by the Examining Division in the Rule 71(3) communication (see C-V, 1.1). Furthermore, it also applies if the Rule 71(3) communication was based on an auxiliary request and the applicant replies by requesting that a grant be based on a higher request.

However, the relevant fees must be paid and the required translations must be filed if amendments or corrections are filed under the Rule 71(3) waiver procedure (see C-V, 4.11).

#### **4.2 Crediting of fees paid voluntarily**

Although the payment of fees in response to the Rule 71(3) communication is not required where the applicant files amendments or corrections in his response thereto (see C-V, 4.1), the applicant can still pay these fees voluntarily. If he does so, the amount of the fees paid will be credited to the payment of the same fees in response to a subsequent Rule 71(3) communication (issued either directly or after resumption of examination - see C-V, 4.6 and 4.7.2 respectively).

This crediting will be dealt with according to the procedures explained in A-X, 11. This is subject to the following: if the amount of the claims fees due in response to the second Rule 71(3) communication is less than the amount voluntarily paid in response to the first Rule 71(3) communication, a refund will be made of the excess paid, since the higher claims fees were not due when paid in response to the first Rule 71(3) communication.

If, after such voluntary payment, the application is withdrawn, deemed to be withdrawn or refused, a refund of the voluntarily paid fee for grant and publishing will be possible under the conditions explained in A-X, 10.2.7. Furthermore, since the claims fees were paid when they were not due, these will also be refunded under the same conditions.

#### **4.3 Amendments or corrections should be reasoned**

The reasoning accompanying amendments or corrections filed in response to the Rule 71(3) communication should indicate respectively:

- why the applicant considers that the amended application documents comply with the EPC, in particular the requirements of patentability, Art. 123(2) and Art. 84;
- why the applicant considers that the errors and their proposed corrections are evident according to Rule 139.

If, within the period under Rule 71(3), the applicant files amendments or corrections which are **not** reasoned, no payment of the fee for grant and publishing or claims fees is necessary nor is the filing of translations (see C-V, 4.1). However, the lack of any reasoning means that such

amendments or corrections are more likely to lead to a resumption of the examination procedure (see C-V, 4.7).

#### 4.4 Admissibility of amendments

The criteria for assessing the admissibility of such amendments are dealt with in detail in H-II, 2.5 and sub-sections. *Rule 137(3)*

By way of exception, in cases where the Rule 71(3) communication was also the first communication in examination proceedings, amendments filed in response thereto **must** be admitted into the proceedings under Rule 137 in cases (i) to (iii) mentioned in H-II, 2.2. However, where a **further** Rule 71(3) communication is sent in respect of such cases (see C-V, 4.6 and 4.7.2), any amendments filed in response thereto must be consented to by the Examining Division according to Rule 137(3) (see H-II, 2.5).

#### 4.5 Adaptation of the description

If the amendments or corrections filed by the applicant in the Rule 71(3) period concern the claims, the applicant should consider whether this necessitates any adaptation of the description. In order to avoid potential delays in cases where adaptation is necessary, it is preferable for the applicant to provide an adapted description when filing amended claims in the Rule 71(3) period.

If no such adapted description is filed, the Examining Division may carry out the adaptation itself and propose these amendments to the description in the second Rule 71(3) communication (see C-V, 4.6.3). Alternatively, it may resume examination (see C-V, 4.7) and send a communication according to Art. 94(3) requesting the applicant to provide the adapted description before issuing a second Rule 71(3) communication (see C-V, 4.7.2).

#### 4.6 Amendments/corrections admitted and allowable - second

##### **Rule 71(3) communication sent**

If the amendments and/or corrections filed within the period under Rule 71(3) are admitted under Rule 137(3) and also comply with the EPC, the Examining Division will send a second communication under Rule 71(3) based thereon. *Rule 71(6)*

A second Rule 71(3) communication may also be sent under the waiver procedure if the waiver cannot be consented to by the Examining Division without further amendments or corrections which it can reasonably expect the applicant to accept (see C-V, 1.1 and 4.11).

##### **4.6.1 Applicant rejects amendments proposed by Examining Division in first Rule 71(3) communication**

A second communication under Rule 71(3) is also sent if the applicant requests reversal of amendments proposed by the Examining Division in the first communication under Rule 71(3) and the Examining Division overturns its previous opinion, finding that the amendments that it had proposed were not necessary, possibly as a consequence of argumentation or evidence provided by the applicant in his reply to the first Rule 71(3)

communication (in the absence of such convincing argumentation or evidence, examination will normally be resumed, see C-V, 4.7).

#### **4.6.2 Second Rule 71(3) invitation based on higher request initially rejected in first Rule 71(3) invitation**

In cases where the first Rule 71(3) communication was based on an auxiliary request (see H-III, 3, in particular H-III, 3.1 and 3.3 and sub-sections), the first communication under Rule 71(3) would have been accompanied by an explanation of why the higher requests were not considered to be allowable (see C-V, 1.1). If the applicant replies to this first Rule 71(3) communication indicating that he wishes a grant to be based on one of these higher requests which the Examining Division had previously held not to be allowable (see C-V, 1.1), such a request will normally lead to examination being resumed (see C-V, 4.7). The Examining Division may reverse its opinion, for example due to convincing argumentation or evidence filed by the applicant with his reply to the first Rule 71(3) communication. If the applicant is successful in this regard, the Examining Division will send a second communication under Rule 71(3) based on this higher request.

#### **4.6.3 Examining Division proposes amendments in second Rule 71(3) communication**

As with the first communication under Rule 71(3), the Examining Division may propose amendments to the applicant's latest request on which the second Rule 71(3) communication is based (this request includes amendments or corrections filed in response to the first Rule 71(3) communication). The types of amendment which may or may not be proposed by the Examining Division in the second Rule 71(3) communication are the same as those mentioned in C-V, 1.1. However, in the second communication under Rule 71(3), the Examining Division cannot re-propose amendments which were previously proposed and then rejected by the applicant. Where the Examining Division considers that such an amendment is necessary to overcome an objection, it should consider resuming examination (see C-V, 4.7).

#### **4.7 Amendments not admitted and/or not allowable, examination resumed**

*Rule 71a(2)*

Until the decision to grant the European patent, the Examining Division may resume the examination proceedings at any time. This applies *inter alia* when the applicant files non-allowable or inadmissible amendments in response to the Rule 71(3) communication.

The Examining Division may also resume the examination proceedings under the Rule 71(3) waiver procedure if the waiver is not consented to by the Examining Division (see C-V, 4.11).

##### **4.7.1 Communications/oral proceedings after resumption**

*Art. 94(3)*

*Rule 71(1) and (2)*

Where the grounds or evidence behind the finding of non-allowability or inadmissibility of the amendments have not yet been dealt with in examination proceedings, before issuing a summons to oral proceedings or a decision to refuse (see C-V, 4.7.3) the Examining Division will send a

communication according to Art. 94(3) and Rule 71(1) and (2) explaining this finding.

If one of the following situations applies, the Examining Division will have to appoint oral proceedings before issuing a decision to refuse (see C-V, 4.7.3): *Art. 116(1)*

- (i) oral proceedings have been requested, but have not yet been held, or
- (ii) oral proceedings have been held, but:
  - the subject of the proceedings has changed such that a right to subsequent oral proceedings arises under Art. 116(1) (e.g. as a result of the amendments filed in response to the Rule 71(3) communication), and
  - the applicant has requested subsequent oral proceedings.

If the grounds and evidence behind the finding of non-allowability or inadmissibility of the amendments have been dealt with in examination proceedings, but not yet in oral proceedings, a summons to oral proceedings can be issued directly, provided at least one communication under Art. 94(3) and Rule 71(1) and (2) has been issued.

Requests for oral proceedings must be allowed as long as proceedings before the EPO are still pending, i.e. until the decision to grant has been handed over to the internal post (see G 12/91 and T 556/95, especially reasons for the decision 4.4).

If the following criteria are satisfied, the application may be refused directly: *Art. 97(2)*

- (a) the grounds and evidence behind the non-allowance or non-admittance of the request filed in response to the Rule 71(3) communication have already been dealt with in examination proceedings (Art. 113(1));
- (b) the applicant has received at least one communication according to Art. 94(3) and Rule 71(1) and (2) (see C-III, 4); and
- (c) the applicant's right to oral proceedings on request has been respected (Art. 116(1)).

#### **4.7.2 Agreement reached on a text - second Rule 71(3) communication**

If the resumption of examination described in C-V, 4.7.1, results in an allowable and admissible text being filed or results in the applicant convincing the Examining Division that the text already filed in response to the Rule 71(3) communication is in fact admissible and allowable, a second Rule 71(3) communication is sent based on this agreed text. Such cases are dealt with in the same way as described in C-V, 4.6. *Rule 71(6)*

**4.7.3 No agreement reached on a text - refusal***Art. 97(2)*

If, after resumption of examination, no agreement can be reached on a text, the application is refused (see C-V, 14). For details on conducting the resumed examination proceedings before issuing this decision, see C-V, 4.7.1.

**4.8 Fees to be paid within the second Rule 71(3) period**

Where the applicant files amendments or corrections in response to the first communication under Rule 71(3), he does not have to pay either the fee for grant and publishing or the claims fees (see C-V, 4.1). A second Rule 71(3) communication may then be issued either immediately (where the amended/corrected text is allowable - see C-V, 4.6) or after examination is resumed and an allowable text is agreed on (see C-V, 4.7.2).

**4.8.1 Claims fees**

In order for the text on which the second Rule 71(3) communication is based to be deemed approved according to Rule 71(5), it is necessary for the applicant to pay any claims fees which are due in response to the communication, thus also avoiding deemed withdrawal of the application under Rule 71(7) (for the calculation of claims fees due at this stage see C-V, 1.4).

Since no claims fees would normally have been paid in response to the first Rule 71(3) communication, the number of claims in the text on which this first communication was based plays no role in calculating the amount of the claims fees due in response to the second Rule 71(3) communication. However, in cases where the applicant paid the claims fees voluntarily in response to the first Rule 71(3) communication, or under the Rule 71(3) waiver procedure (see C-V, 4.11), the amount paid is credited according to Rule 71a(5) (see C-V, 4.2 and A-X, 11.2).

**4.8.2 Fee for grant and publishing**

In order for the text on which the second Rule 71(3) communication is based to be deemed approved according to Rule 71(5), it is necessary for the applicant to pay the fee for grant and publishing in response to the communication, thus also avoiding deemed withdrawal of the application under Rule 71(7).

*Art. 2(2), No 7.2 RFees*

For European applications filed before 1 April 2009 or international applications entering the European phase before that date, the fee for grant and publishing incorporates a fee for each page of the application over and above 35 (see C-V, 1.2 and A-III, 13.2). If the number of pages of such an application changes between the first and the second Rule 71(3) communication, it is the number of pages on which the second Rule 71(3) communication is based which is used to calculate the amount of this fee. Where the applicant paid the fee voluntarily in response to the first Rule 71(3) communication, the amount paid will be credited according to Rule 71a(5) (see C-V, 4.2 and A-X, 11.1).

#### **4.9 Applicant disapproves of the text proposed for grant**

The applicant may reply to the communication under Rule 71(3) by simply disapproving of the text proposed therein and not paying any fees or filing the translations of the claims. In such cases, the application is not deemed to be withdrawn under Rule 71(7). Instead, if the following criteria are fulfilled, the application will be refused under Art. 97(2) for failure to comply with Art. 113(2), because there is no text agreed to by the applicant:

- (i) the Examining Division did not propose any amendments or corrections to the application in the communication under Rule 71(3),
- (ii) the Rule 71(3) communication was not based on an auxiliary request, and
- (iii) the applicant filed no amendments or corrections with his disapproval.

If the applicant has already been sent one communication in examination proceedings according to Art. 94(3) and Rule 71(1) and (2) (see C-III, 4 and E-VIII, 4.1) and his right to oral proceedings on request has been respected (Art. 116(1)), then the application can be refused directly without further communication with the applicant.

If criterion (i) is not met, the applicant's disapproval is interpreted as a rejection of the amendments or corrections proposed by the Examining Division in the Rule 71(3) communication. If criterion (ii) is not met, the applicant's disapproval is interpreted as a request to base a grant on a higher request. If criterion (iii) is not met, the applicant's disapproval is interpreted as a desire to proceed with the application as amended or corrected by him in response to the Rule 71(3) communication. If any of these criteria are not met, either examination is re-opened as indicated in C-V, 4.7 or, if the applicant's submissions result in an allowable text, a second Rule 71(3) communication is sent (see C-V, 4.6). Where criterion (ii) is not met and it is not clear which higher request the applicant wishes to pursue, the Examining Division must request the applicant to clarify this in resumed examination proceedings.

Where, within the Rule 71(3) period, the applicant first files only his disapproval of the text and then later (still within the Rule 71(3) period) files a request for correction/amendment, the procedure explained above does not apply. In such cases, the procedure for handling requests for amendment/correction filed in reply to the Rule 71(3) communication as defined in C-V, 4.1 to 4.8, is to be applied.

**4.10 Amendments/corrections filed in second Rule 71(3) period**

In cases where a second Rule 71(3) communication is sent (see C-V, 4.6 and 4.7.2) and the applicant replies within this second Rule 71(3) period by doing one or more of the following, the procedures explained in C-V, 4.1 to 4.9, apply *mutatis mutandis*:

- (i) filing further amendments or corrections (including the amendments or corrections allowable within the Rule 71(3) waiver procedure, under the conditions described in C-V, 4.11),
- (ii) rejecting amendments proposed by the Examining Division in the second Rule 71(3) communication, or
- (iii) reverting to a higher-ranking request (where the second Rule 71(3) communication is based on an auxiliary request).

In particular, in such cases the applicant will not be required to pay the fee for grant and publishing or any claims fees, nor will he be required to file translations of the claims within this second period under Rule 71(3). If the Examining Division agrees to a text (either with or without resumption of examination), a third communication under Rule 71(3) is then sent. This does not apply where a waiver on receiving a further Rule 71(3) communication was validly filed and consented to by the Examining Division (see C-V, 4.11).

Furthermore, if the applicant replies to the second Rule 71(3) communication by rejecting amendments proposed by the Examining Division in the first Rule 71(3) communication (where these have not been superseded), the procedures described in C-V, 4.1 to 4.9 likewise apply *mutatis mutandis* (no need to pay fees or file translations etc).

**4.11 Rule 71(3) waiver**

In response to a communication under Rule 71(3), applicants may expressly indicate that they wish to waive their right to receive a further Rule 71(3) communication when filing amendments or corrections to the text proposed by the Examining Division which do not require resumption of the substantive examination proceedings. Provided that the necessary conditions indicated below are fulfilled and the Examining Division has no objections to the amendments or corrections, the Examining Division is deemed to have consented to the waiver (for detailed information see the Notice from the EPO dated 8 June 2015 concerning the possibility to waive the right to a further communication under Rule 71(3) EPC, OJ EPO 2015, A52).

A waiver expressed in response to a Rule 71(3) communication is only effective in respect of the following Rule 71(3) communication.

In order for the right to receive a further communication under Rule 71(3) to be effectively waived, the following conditions must be fulfilled within the four-month period under Rule 71(3):



- the waiver must be expressly indicated
- a translation of the claims (including the requested amendments or corrections, if any) in the two official languages other than the language of the proceedings must be filed
- the requisite fees for grant and publication must be paid
- the claims fees in respect of the sixteenth and each subsequent claim must be paid, unless they have already been paid under Rule 45 or Rule 162
- the amendments or corrections must be identified and their basis in the application as filed must be indicated (Rule 137(4)). The relevant pages of the Druckexemplar containing the amendments or corrections must be filed.

If all these formal requirements are fulfilled and the Examining Division has no objections to the amendments or corrections requested by the applicant, the Examining Division is deemed to have consented to the waiver. The waiver can only be deemed to be consented to if the amendments or corrections requested do not require resumption of the substantive examination proceedings, for example spelling mistakes or incorrect reference to the drawings. In this case no further communication under Rule 71(3) will be sent to the applicant. Instead, "Information under Rule 71(3) EPC" (Form 2004W) will be published in the European Patent Register, with the aim of informing the applicant and the public of the text in which the Examining Division intends to grant the patent and the related bibliographic data, as approved by the applicant. The decision to grant the European patent is then issued, provided that renewal fees and any additional fees already due have been paid. No further amendments or corrections of any kind may be made by the Examining Division on its own initiative, even if it can reasonably expect the applicant to accept them.

If consent cannot be given to the waiver because the formal requirements (as to the fees to be paid or the translations of the claims to be filed) are not fulfilled, a further Rule 71(3) communication will be sent to the applicant as provided for in Rule 71(6) (see C-V, 4.6). The same applies if additional changes are considered necessary by the Examining Division. When it is not possible to issue a further Rule 71(3) communication, examination will be resumed by sending a communication under Art. 94(3) and Rule 71(1) and (2) in line with C-V, 4.7 and subsections. The same is also true where the Rule 71(3) communication was based on an auxiliary request and the applicant has replied by requesting that the grant be based on a higher-ranking request.

Where a further communication under Rule 71(3) is subsequently issued, the applicant is required to express approval of the text of the patent as possibly amended or corrected by the Examining Division (Rule 71a(1)). Reference is made to C-V, 6.2.

With regard to the payment of fees, see the procedure for crediting or refunding of amounts of fees already paid in C-V, 4.2, and A-X, 10.2.7, and A-X, 11.

If fees for an application are paid under the automatic debiting procedure, where a waiver has been expressed in response to a Rule 71(3) communication, the fee for grant, including the fee for publication/printing (Art. 2(2) RFees), and any additional claims fees due under Rule 71(4) must be paid separately by another means of payment allowed under RFees (see point 12 AAD and Re point 12 AAD in Annex A.2 to the ADA). These fees will not be debited automatically.

After grant of a patent, errors remaining in the text of the patent as approved cannot be corrected under Rule 140 (see G 1/10, OJ EPO 2013, 194, and H-VI). For correction of errors in publication and formatting/editing errors, see H-VI, 4.

### **5. Further requests for amendment after approval**

*Rule 137(3)*

The criteria for assessing the admissibility of such amendments are dealt with in detail in H-II, 2.6. The procedure for dealing with such late-filed amendments is explained in C-V, 6.

### **6. The Examining Division resumes examination after approval of the text**

#### **6.1 When does the Examining Division resume examination after approval?**

*Rule 71a(2)*

Subsequent to the applicant's approval in response to the Rule 71(3) communication (see C-V, 2), the Examining Division may resume the examination procedure at any time up to the moment the decision to grant is handed over to the EPO's internal postal service for transmittal to the applicant (see G 12/91). This will seldom occur, but may be necessary if e.g. the applicant files further prior art which necessitates further substantive examination, if the Examining Division becomes aware of very relevant prior art following observations by third parties under Art. 115, if the applicant files amendments or corrections (having already approved the text), or if the Examining Division becomes aware in some other way of circumstances which are such as to cause the subject-matter claimed to fail to comply with the EPC.

The resumption of examination after approval is subject to the same considerations as where examination is resumed due to amendments filed in the Rule 71(3) period (see C-V, 4.7.1). In particular, the applicant's right to comment (Art. 113(1)), his right to at least one communication under Art. 94(3) and Rule 71(1) and (2) in examination proceedings (see C-III, 4) and his right to oral proceedings on request (Art. 116(1)) must be respected.

*Rule 137(3)*

The criteria applied in assessing the admissibility of amendments or corrections filed by the applicant after approval are dealt with in H-II, 2.6.

## 6.2 A further communication under Rule 71(3)

A second Rule 71(3) communication is sent out if the resumed examination results in a text on the basis of which a patent can be granted (substantive amendments directed to resolving the issues which gave rise to the resumption of examination are possible). *Rule 71(6)*

If the translations of the claims have already been filed (see C-V, 1.3) and the fees have already been paid (see C-V, 1.2 and 1.4) in reply to a previous communication under Rule 71(3), e.g. in the case of resumption of examination after approval (see C-V, 6, and Rule 71(6)), the applicant must express his agreement as to the text to be granted (Rule 71a(1)) within the non-extendable four-month period mentioned in the further Rule 71(3) communication (e.g. by approving the text and verifying the bibliographic data, by confirming that grant proceedings can continue based on the documents on file and/or by stating which translations of the claims already on file are to be used). This also applies if a further Rule 71(3) communication was sent because the Examining Division did not consent to the applicant's wish to waive his right to such a communication (see C-V, 4.11).

## 6.3 Crediting of fees under Rule 71a(5)

If, in response to an invitation under Rule 71(3), the applicant has already paid the fee for grant and publishing or the claims fees, the amount paid shall be credited if a further such invitation is issued. For more details on this procedure, see A-X, 11. *Rule 71a(5)*

## 7. Correction of errors in the decision to grant

Under certain circumstances, a decision to grant a European patent may be corrected. For more details see H-VI, 3.

## 8. Further processing

If the applicant overruns the time limit set under Rule 71(3), he may request further processing under Art. 121 (see E-VII, 2). The omitted act in respect of this further processing request is either: *Art. 121*

- (i) completion of all of the following acts referred to in Rule 71(3) and (4):
  - (a) payment of the fee for grant and publishing,
  - (b) payment of any claims fees due, and
  - (c) filing of the translations of the claims; or
- (ii) completion of one or more of the following acts:
  - (a) filing amendments and/or corrections to the application documents,
  - (b) rejecting amendments proposed by the Examining Division in the communication under Rule 71(3), or

- (c) requesting a grant to be based on a higher request with respect to the auxiliary request on which the Rule 71(3) communication was based.

### **9. Refund of the fee for grant and publishing**

*Rule 71a(6)*

If the application is refused, withdrawn prior to notification of the decision on the grant of a European patent or, at that time, deemed to be withdrawn, the fee for grant and publishing shall be refunded (for more details see A-X, 10.2.7).

### **10. Publication of the patent specification**

The decision to grant contains the date of the mention of the grant of the European patent and is sent to the applicant when the technical preparations for printing the patent specification have been completed.

*Art. 98*

*Rule 73*

*Art. 14(6)*

As soon as possible after the mention of the grant is published in the Bulletin, the EPO publishes the patent specification containing the description, claims (in the three official languages) and any drawings. The front page of the published specification shows *inter alia* the Contracting States which are still designated at the time of grant (or the designation of which has been withdrawn after completion of the technical preparations for printing). With regard to the form in which the publication takes place, see the Decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.3.

Mistakes in the specification of a European patent arising in the course of its production have no effect on the content of the patent granted. For this, only the text on which the decision to grant the patent is based is decisive (see H-VI, 4). If necessary, the Office may arrange for correction to be made public as soon as any mistake in a specification is discovered. This is done by means of a note in the European Patent Bulletin and publication of a corrigendum, the sole purpose being to bring the specification into line with the content of the decision to grant (see Rule 143(2) and the Decision of the President of the EPO dated 14 October 2009, OJ EPO 2009, 598, Art. 1, point 2).

### **11. Withdrawal before publication of the patent specification**

*Rule 73*

The specification of the European patent is not published if the application is withdrawn before termination of the technical preparations for publication. If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed. The EPO will, however, try (in accordance with the principles of J 5/81) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily. The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80). The applicant is bound by an effective declaration of withdrawal (see J 25/03, J 4/97; and J 10/87).

### **12. Certificate**

*Rule 74*

As soon as the European patent specification has been published, the EPO issues the proprietor with a certificate attesting that the European patent

has been granted to the person named in the certificate. Where there is more than one proprietor, each of them is issued with a certificate. The proprietor may request that a certified copy of the certificate with the specification attached be supplied to him upon payment of an administrative fee. For further details see the Decision of the President of the EPO dated 16 July 2013, OJ EPO 2013, 416.

### 13. European Patent Bulletin

If no notice of opposition is recorded in the dossier of the European patent within nine months of publication of the mention of grant, the patent proprietor is informed and an appropriate entry is published in the European Patent Bulletin (point 1, Art. 1, Decision of the President of the EPO dated 14 October 2009, OJ EPO 2009, 598). If, subsequently, it emerges that an opposition was filed in time, the proprietor is again informed and a correction is published in the Bulletin.

*Art. 129(a)*

### 14. Refusal

A decision to refuse the application cannot be issued without a first communication in examination having been sent (see C-III, 4, and E-VIII, 4.1). Therefore the Examining Division may not refuse the application directly after the reply to the search opinion under Rule 70a(1) or directly after the reply to the WO-ISA under Rule 161(1), even if the objections raised in the search opinion or WO-ISA remain the same and there is no pending request for oral proceedings.

If, despite the applicant's submissions, i.e. amendments or counter-arguments, objections persist after the applicant's reply to the first communication under Art. 94(3) in examination, then even at this stage a refusal can be issued (subject to oral proceedings being held, if these are requested). In the event that refusal is contemplated at this or any later stage of examination proceedings, the examiner should bring the application before the other members of the Examining Division, which may then decide to refuse the application. In any event, at some stage, the primary examiner will consult the other members of the Examining Division with a view to establishing whether the application should be refused or a patent should be granted. If the Division intends to refuse the application, a written reasoned decision is necessary and this will normally be prepared by the primary examiner (see E-IX, 4 and 5). In preparing the decision, the examiner must take care to abide by the general principles set out in Art. 113(1), i.e. the decision must be based on grounds or evidence on which the applicant has had the opportunity to comment (see E-IX, 1.1 and 1.2).

*Art. 97(2)*

*Art. 113(1)*

*Rule 111*

*Art. 109*

*Art. 111(1) and*

*Art. 111(2)*

In addition, the applicant's attention must be directed to the provisions for appeal laid down in Art. 106 to 108. If oral proceedings take place (see E-II), the decision may be given orally but must subsequently be notified in writing, the time limit for appeal then running from the date of such notification.

If the applicant appeals against the decision and the Examining Division considers, in the light of the applicant's statement, that the appeal is

admissible and well-founded, it should rectify its decision accordingly within three months after receipt of the statement of grounds. Otherwise, the appeal will be considered by a Board of Appeal. If a decision to refuse a patent is reversed on appeal, the application may be referred back to the Examining Division for further examination. In such a case, the further examination will normally be entrusted to the examiner who performed the original examination. The Examining Division is bound by the *ratio decidendi* of the Board of Appeal, insofar as the facts are the same.

### **15. Decision according to the state of the file**

A special case is where the applicant does not file comments or amendments in reply to the examiner's communication but requests a decision "according to the state of the file" or "on the file as it stands", meaning that the applicant wishes to close the debate and a decision is taken on the basis of the current status of the application and any supporting arguments. The decision, which may be appealed, may only be based on grounds and evidence on which the applicant has had an opportunity to present his comments (Art. 113(1)).

#### **15.1 The request for a decision according to the state of the file**

An applicant may file a request for a decision according to the state of the file at any stage during examination proceedings, provided that at least one communication in examination has been sent (see also C-V, 15.4). The request should be explicit and unambiguous, preferably using the wording "according to the state of the file" or "on the file as it stands".

If the request is not clear in this respect, the examiner should solve the ambiguity with an enquiry to the applicant.

A request for a decision according to the state of the file does not imply the withdrawal of a pending request for oral proceedings. Consequently, when filing a request for such a decision, it is recommended that the applicant also withdraws any pending request for oral proceedings (conditional or otherwise). If the applicant does not do so, the examiner will request him to clarify in writing that he withdraws his request for oral proceedings before a decision according to the state of the file can be issued.

#### **15.2 Decision by means of a standard form**

The examiner may be in a position to refuse the application using a standard form referring to the previous communication. In order to comply with the requirement that such a decision be reasoned (Rule 111(2)), this is only possible where the previous communication properly identifies the application documents on file, is well-reasoned and complete with respect to the grounds and the reasons for the refusal of the current request and addresses all the arguments raised by the applicant. A further condition is that no new arguments or amendments have been submitted by the applicant since the previous communication.

Although it is possible by way of exception to refer to more than one communication in the standard form, the examiner should carefully consider the requirements of Rule 111(2). In particular, if the different

communications deal with different sets of claims, such that it is not clear which of the reasons given by the Examining Division in its communications might be essential to the decision to refuse, a fully reasoned decision should be issued instead (see C-V, 15.3).

### **15.3 Issuing a self-contained decision**

If the conditions set out in C-V, 15.2 are not met, it is necessary to issue a self-contained decision to refuse in order to comply with Rule 111(2). This is necessary, for example, where the numerous objections raised in the previous communications with respect to different sets of claims render unclear the grounds and the reasons for the refusal. This also applies if the applicant has made further submissions (including amendments) since the previous communication, where these do not cause the subsequent decision to be based on grounds or evidence on which the applicant has not had the opportunity to present his comments. In all cases, the requirements of Art. 113(1) should be carefully considered (see also E-IX, 1).

### **15.4 Issuing a further communication (no refusal)**

If it appears that the previous communications were insufficiently reasoned or incomplete, or if the applicant has filed amendments and/or arguments since the previous communication, the examiner should carefully consider Art. 113(1) and Rule 111(2) before issuing a refusal (see E-IX, 1). A further communication may have to be issued with sufficient reasoning, unless oral proceedings are to be held (see E-II, 2), in which case the reasoning would be given in the summons (Rule 116(1)). In the communication or summons the applicant should be informed that his request for a decision according to the state of the file could not be followed.



## **Annex**

### **Standard marks for indicating amendments or corrections by the Divisions**




#### **1. Insertion of letters and words**

Any insertion to the text made using the electronic tool is made in-line. No marks need to be put separately in the margins, top or bottom of the page.

In the produced PDF of the "working copy" of the "Druckexemplar", the tool will insert amendment bars to the right of amendments and indicate amended pages as such. The tool also adds a pair of insertion signs that mark the beginning and end of each in-line insertion:

Mark	Explanation
	Denotes the beginning of text inserted
	Denotes the end of text inserted

"No break", "line break" or "paragraph break" signs precede and succeed the signs above to indicate whether the inserted text should be kept in the same line or a new line or a paragraph should start before or after the inserted text:

Mark	Explanation
	No breaks: inserted text is kept on the same line (this is the default)
	Line break: starts a new line (must be set if needed)
	Paragraph break: starts a new paragraph (must be set if needed)

In case of inserting an entire newly-filed page, e.g. a page numbered "1a", the construct [insert page 1a] is used.



## Chapter VI – Time limits and acceleration of examination

### 1. Time limits for response to communications from the examiner

#### 1.1 General considerations

The general considerations relating to time limits are set out in E-VII. The time limit for response to a communication from the examiner should in general be between two and four months in accordance with Rule 132. The period to be allowed will be determined by the examiner taking all the factors relevant to the particular application into account. These include the language normally used by the applicant or his representative; the number and nature of the objections raised; the length and technical complexity of the application; the proximity of the EPO to the applicant or, if he has one, his representative; and the distance separating applicant and representative.

This time limit can be extended if the applicant so requests before it expires (see E-VII, 1.6). Failure to respond to a communication according to Art. 94(3) and Rule 71(1) and (2) in time results in the application being deemed to be withdrawn. This loss of rights is subject to further processing (see E-VII, 2).

*Art. 94(1) and (4)  
Rule 132*

#### 1.2 Special circumstances

In certain special circumstances the examiner may allow up to six months for the time limit. The six-month period may be appropriate, for instance, if the applicant resides a long way from his representative and the language of the proceedings is not one to which the applicant is accustomed; or if the subject-matter of the application or the objections raised are exceptionally complicated (for more information see E-VII, 1.2).

The search opinion is not a communication under Art. 94(3).

### 2. Influencing the speed of examination proceedings – PACE

With a request for accelerated examination under the programme for accelerated prosecution of European patent applications (PACE), the applicant can speed up the proceedings at the examination stage (see Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93). For further information, see E-VII, 4.2.

### 3. Further ways to accelerate examination

Where the applicant files a request for examination before the search report is transmitted to him, he may also dispense with the need to comply with the invitation pursuant to Rule 70(2), and file a categorical request for examination whatever the result of the search may be, by which the procedure can also be accelerated (see Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93). In this case, confirmation that he desires to proceed further with his application is deemed to be given when the search report is transmitted to him, so that in accordance with Rule 62(1) the search report is not accompanied by a search opinion.

*Rule 70(2)  
Art. 11(b) RFees  
Rule 62(1)*

Under these circumstances, if the application is not in order for grant, a communication under Art. 94(3) and Rule 71(1) and (2) is transmitted to the applicant. If the application is in order for grant, the subsequent procedure will depend on whether or not it is possible at that time to carry out the search for conflicting European applications according to Art. 54(3) (see C-IV, 7.1 and B-XI, 7). If that search can be carried out, and assuming that it does not identify any conflicting applications, then the communication under Rule 71(3) is transmitted to the applicant. If it cannot yet be carried out, then the communication from the examining division will be postponed until the said search is completed and the applicant will be informed accordingly. If the European patent application is subsequently withdrawn before the substantive examination has begun, 75% of the examination fee will be refunded (for more details see A-VI, 2.5).

The applicant can also accelerate the processing of Euro-PCT applications by waiving his right to the communications under Rule 161 and Rule 162 (see E-VIII, 3.1).

## Chapter VII – Other procedures in examination

### 1. General remark

In this Chapter the term "applicant" is intended to mean "representative" where the applicant has appointed one. In this case, the procedures described in this Chapter should be conducted with that representative.

### 2. Telephone conversation, personal interview, e-mail

There are instances where personal consultation, by telephone or interview, can be helpful in advancing the procedure. A telephone conversation can be held between the applicant and the formalities officer and/or the examiner, whereas an interview is held only between the applicant and the examiner.

Personal consultation is at the discretion of the formalities officer or examiner. If the applicant requests personal consultation, the request should be granted unless the nature of the issue to be discussed requires formal proceedings or the examiner believes that no useful purpose would be served by such a discussion. For example, where substantial differences of opinion exist in examination, written procedure or oral proceedings are normally more appropriate.

With regard to consultations in response to the EESR before the application has entered the examination phase, see B-XI, 8.

When a consultation is arranged, whether by telephone, by e-mail or in writing, and whether by the examiner or the applicant, the matters for discussion should be stated. If the arrangement is made by telephone, the examiner should record the particulars and briefly indicate, in the file, the matters to be discussed.

A decision cannot be taken during a personal consultation with an examiner, as all decisions must be taken by the whole Examining Division.

#### 2.1 Telephone consultations

A telephone conversation can take place at the initiative of either the applicant or the examiner.

When an applicant wishes to enquire about an application, EPO 1Line Customer Services (1LCS) is usually the first point of contact. 1LCS informs the appropriate department of the enquiry, and that department will contact the applicant as soon as possible to follow it up.

Typical situations in which applicants telephone the EPO are:

- (i) the applicant wishes to make an enquiry about a procedural issue, such as how to proceed in particular circumstances (note however that the examiner is not normally in charge of formal issues, such as extensions of time limits and payment of fees);

- (ii) there appears to be an error in the communication or in the applicant's reply which makes it difficult for the applicant or the examiner to prepare the next reply/communication (e.g. wrong document cited, communication based on wrong set of claims, new submissions referred to but not included).

Typical situations in which examiners may consider it appropriate to call the applicant are:

- (iii) it appears that there is confusion about certain points in dispute, e.g. the applicant seems to have misunderstood the arguments of the examiner or vice versa, so that the written procedure does not lead anywhere;
- (iv) the application seems to be ready for grant except that the examiner needs to clarify some minor issues with the applicant or would like to discuss a proposal for amendments to overcome the objections raised;
- (v) amendments/corrections requested by the applicant after the Rule 71(3) communication have been submitted but the examiner cannot agree to the request.

## **2.2 Interviews**

Generally, telephone consultations are preferred over interviews due to the difference in location and the time needed. If the applicant considers that an interview would be more appropriate, he should provide reasons.

An interview may be appropriate if, for example, the applicant is visiting the EPO for some other reason and would like to take the opportunity to discuss the application personally with the examiner without incurring further travel costs. This particularly applies where:

- the representative is accompanied by an applicant or inventor
- the applicant would like to clarify certain technical details, e.g. by demonstrating a particular device or showing a presentation which cannot be included in a written response.

In such a case, an appointment must be arranged beforehand, preferably following the procedure set out in C-VII, 2.1.

The examiner decides whether an interview is appropriate. Depending on the objections on file and the time frame, he may suggest that holding oral proceedings would appear more appropriate (see E-II, 2). This is in particular the case where a negative decision is likely.

## **2.3 Persons attending the interview**

The interviewee must be a person entitled to act for the applicant before the EPO. If the applicant is a natural or legal person having his residence or

place of business in a contracting state, interviews may only be conducted with:

- (a) the applicant (see A-VIII, 1.1),
- (b) a professional representative (see A-VIII, 1.1) or
- (c) a duly authorised employee of the applicant (see A-VIII, 1.2) or, to the extent defined in Art. 134(8), a legal practitioner (see A-VIII, 1.4).

Regarding (c), see also A-VIII, 1.5.

If the applicant is a natural or legal person having neither residence nor place of business in a contracting state, interviews may only be conducted with:

- a professional representative (see A-VIII, 1.1) or
- a legal practitioner (see A-VIII, 1.4 and 1.5).

Unless he is already known personally to the examiner conducting the interview, the person taking part in the interview must produce an official identity document.

The person entitled to act before the EPO, i.e. one of the persons listed above, may be accompanied by other persons, whose identity does not need to be checked. On request of the person entitled to act, such other persons may be allowed to take part in the interview if their participation is relevant to the proceedings.

From the Examining Division, only the examiner dealing with the case will normally be present. However, there is no objection to one or even both of the other members of the Examining Division participating in the interview. When the inventor or an expert is attending the interview, it is recommended that at least the chairman of the Examining Division should also attend. However, the applicant or representative does not have the right to demand that additional members of the Examining Division be present. If a request is made for an interview with all three members, it will usually be advisable to appoint oral proceedings instead.

## **2.4 Conduct of an interview or telephone conversation**

The interview will normally be conducted solely by the examiner dealing with the application. It is not a formal procedure (for formal oral proceedings before the Examining Division, see E-II), and the character of the minutes of the interview depends upon the nature of the matters under discussion (see C-VII, 2.5). It should always be made clear to the applicant that any agreement reached must ultimately be subject to the views of the other members of the Examining Division.

If a fresh objection of substance is raised at an interview and no amendment to meet it is agreed at the time, the objection must be confirmed by a

communication of the minutes thereof, giving the applicant a fresh period within which to reply.

When the telephone is used to settle outstanding matters, the normal procedure should be for the examiner to telephone the applicant stating the number of the application he wishes to discuss and requesting the applicant to telephone back at a specified time. A note must be made in the minutes, giving particulars and identifying the matters discussed and any agreements reached. Any matters on which agreement was not reached should also be noted and the arguments adduced by the applicant should be summarised.

### **2.5 Effect of statements made in an interview or by telephone**

Oral statements made by telephone or at an interview must be confirmed in writing in order to be procedurally effective. Indeed, such statements are not normally legally binding. Such a statement cannot, for instance, be effective to meet a time limit (see, however, C-VII, 2.6). For the purpose of the European grant procedure, except in oral proceedings, only written statements are effective and only from the date on which they are received by the Office. Where appropriate, the applicant/representative should therefore be advised to submit his observations or amendments in writing.

For the use of e-mail where the interview before the Examining Division is held as a video-conference, see C-VII, 2.7.

### **2.6 Minutes of an interview or telephone conversation**

Where the interview is concerned with the clarification of obscurities, the resolution of uncertainties, or putting the application in order by clearing up a number of minor points it will usually be sufficient if the examiner makes a note in the minutes of the matters discussed and the conclusions reached or amendments agreed. If, however, the interview is concerned with resolving weightier matters, such as questions of novelty, inventive step, unity or whether the amendment introduces fresh subject-matter, then a fuller note of the matters discussed should be made in the minutes (see below).

The minutes should list the participants, summarise the main results and state any oral requests. They must be signed by the examiner. Documents filed during a personal interview, such as new claims or an amended description, must be listed in the minutes and signed by the applicant/representative.

With regard to weightier matters which are discussed, it should always be the aim when drafting the minutes to specify in concrete terms the topics discussed, together with any amendments agreed, any opposing views, the reasons for any change of opinion and any conclusions drawn, unless these are clear from other documents in the dossier. In particular, the reasons for any amendments required by the examiner should be clearly indicated.

The use of indefinite, ambiguous or universally applicable statements in minutes should be avoided. For example, statements such as "Amendments to the claims were proposed to take account of the prior art cited in the search report" are of no assistance to members of the public, other members of the Division, or indeed the primary examiner himself at later stages of the procedure. The same applies to conclusions worded in a generalised manner.

In every case the minutes of an interview or telephone consultation should be placed in the dossier and a copy communicated to the applicant or his representative to notify him, even where a telephone consultation merely changes/confirms/cancels the time/date of a proposed interview. However, by way of exception, telephone consultations relating to amendments agreed immediately preceding completion of the communication according to Rule 71(3) may be reflected in that communication, provided that there is no uncertainty for the public as to what was agreed. The amendments must be identified as exactly as possible.

The minutes of interviews or telephone conversations should always indicate whether the next action is due to come from the applicant or the examiner. The minutes when dispatched to the applicant may:

- (i) be dispatched for information only, in which case if a time limit is still running, it should be observed; if no time limit is running, no action is required from the applicant;
- (ii) be dispatched such as to extend a running time limit, in which case the applicant must reply within that extended time limit, or
- (iii) be dispatched such as to set a new time limit for response, in which case the applicant must reply within this new time limit.

However, a time limit may only be set in connection with the dispatch of minutes of an interview or telephone consultation if a communication from the Examining Division has been issued. Otherwise the minutes must be sent as an annex to a first communication according to Art. 94(3).

The minutes of an interview or telephone conversation, including all documents provided by an applicant or representative in an interview and annexed to them, are part of the file, and as such open to public inspection. A-XI, 2.1, explains the circumstances in which documents may be excluded from public inspection.

## **2.7 Use of e-mail**

At present, e-mail has no legal force in proceedings under the EPC and thus cannot be used to validly perform any procedural act and, in particular, cannot be used to comply with time limits (see OJ EPO 2000, 458 and A-VIII, 2.5).

As an exception, documents filed subsequently as referred to in Rule 50 (other than authorisations) may be filed by e-mail where interviews and oral

proceedings before the Examining Division are held as a video-conference (for details, in particular on signature and format of attachments, see the Decision of the President of the EPO dated 20 April 2012, OJ EPO 2012, 348, and E-II, 11.3.2).

The above OJ notice and decision of the President also stress the importance of ensuring that any exchange of information is duly documented on file and that confidentiality issues should be carefully considered.

### **2.7.1 Examples of where e-mail could be used**

Typical examples where e-mail could be useful are:

- (i) arranging a date for an interview
- (ii) if during a telephone consultation particular amendments to claims are being discussed the applicant might want to communicate these immediately, i.e. during the consultation to the examiner for easier discussion
- (iii) shortly before oral proceedings: sending an electronic copy of amended claims in addition to the official submission made e.g. by fax; this would ensure that the examining division gets the documents well in time for preparation of the oral proceedings
- (iv) during interviews and oral proceedings held as a video-conference: submitting further documents as referred to in Rule 50, including amended application documents (for details, see E-II, 11.3.2).

E-mails cannot replace an official communication under Art. 94(3).

### **2.7.2 Initiation of e-mail**

Neither the examiner nor the applicant should use e-mail without having previously agreed to this, e.g. during a telephone consultation. There must be mutual agreement between the examiner and the applicant to such use. Furthermore, the mere fact that an e-mail address is indicated on a letter head does not mean that the examiner can simply use such an e-mail address for file-related topics.

If, on the other hand, an examiner receives an e-mail from an applicant concerning procedural requests or addressing any substantive issues without previous agreement, such an e-mail cannot simply be ignored but must be dealt with, ensuring that the content is put in the official file (see also T 599/06); it is recommended that such an e-mail be replied to with the clear message that e-mail is not an official means of communication and that any requests should be filed by permitted means (see A-II, 1.1, 1.2 and 1.3). See however C-VII, 2.6, and E-II, 11.3.2, for the use of e-mail during an interview or oral proceedings held as a video-conference.



### **2.7.3 Confidentiality**

For non-published applications, confidentiality issues should be carefully considered and substantive matters should not form part of any e-mail correspondence concerning such applications.

### **2.7.4 Filing of amended documents and new requests**

As stated above, e-mail cannot be used to perform procedural acts (except, under certain conditions, during oral proceedings or interviews held as a video-conference; see C-VII, 2.6, and E-II, 11.3.2). If, e.g. shortly before oral proceedings, the applicant would like to submit new requests and/or amended documents, this should be done by fax, since only this ensures that the filed documents are given a valid date of receipt and form part of the file. Experience has shown that faxes are normally visible in the electronic file on the same day. As stated in C-VII, 2.7.1(iii), an informal copy, in addition to the fax, can be sent to the examiner for the convenience of the Division if this is felt necessary due to the short time frame.

### **2.7.5 Inclusion in the file of any e-mail exchange**

If e-mail is used, it is essential to ensure that the exchange of e-mails is properly documented in the file. This should be done by noting the e-mail exchange (including data relating to addressee and date) in the minutes and sending them to the applicant for information with no time limit. This ensures that the exchange is included in the public part of the file and that the applicant is aware of this.

Submissions filed by e-mail during an interview or oral proceedings held as a video-conference, including all attachments, should be printed and annexed to the minutes of the oral proceedings (see E-II, 11.3.2, for details).

## **3. Taking of evidence**

### **3.1 General remark**

The general considerations relating to the taking of evidence are set out in E-III. This section deals only with the kind of evidence most likely to arise in pre-grant proceedings, viz. written evidence.

### **3.2 Producing evidence**

An Examining Division would not, as a general rule, require evidence to be produced. The primary function of the examiner in proceedings before grant is to point out to the applicant any ways in which the application does not meet the requirements of the EPC. If the applicant does not accept the view of the examiner, then it is for the applicant to decide whether he wishes to produce evidence in support of his case and, if so, what form that evidence should take. The Examining Division should afford the applicant a reasonable opportunity of producing any evidence which is likely to be relevant.

However, this opportunity should not be given where the Examining Division is convinced that no useful purpose would be served by it, or that undue delay would result.

### **3.3 Written evidence**

Written evidence could include the supply of information, or the production of a document or of a sworn statement. To take some examples:

To rebut an allegation by the examiner of lack of inventive step, the applicant might supply information as to the technical advantages of the invention. Again he might produce a sworn statement, either from himself or from an independent witness, purporting to show that workers in the art have been trying for a long time unsuccessfully to solve the problem with which the invention is concerned, or that the invention is a completely new departure in the relevant art.

## **4. Oral proceedings**

The general considerations relating to oral proceedings are set out in E-II.

If a request for oral proceedings, even conditional, was filed before the Examining Division became responsible for the application (see C-II, 1), the Division must honour the request, even if it was not repeated in examination.

On dealing with new requests filed in reply to a summons to oral proceedings, see C-IV, 8.

## **5. Examination of observations by third parties**

The general considerations relating to observations from third parties are set out in E-V, 3.

## Chapter VIII – Work within the Examining Division

### 1. General remarks

An Examining Division will normally consist of three technical examiners. *Art. 18(2)* However, within the Examining Division made responsible for the application, one member (the primary examiner) will, as a general rule, be entrusted to carry out all the work up to the point of a decision to grant a patent or refuse the application. This means that this examiner is entrusted to act on behalf of the Examining Division in all communications with the applicant up to that point, but he may confer informally with the other members of the Division at any time if a special point of doubt or difficulty arises. Where reference is made in this Part C of the Guidelines to the "examiner", this normally means the primary examiner, and it should be understood that this primary examiner is always acting in the name of the Examining Division. This examiner is normally the examiner who drafted the search report.

As stated above, the examiner may seek the advice of other members of the Examining Division, if necessary, at any stage in the examination. However, a point will be reached when it becomes appropriate for the examiner to refer the case formally to the other members of the Examining Division. This will arise if he considers the case is in order to proceed to grant or, alternatively, where there seems no possibility of amendment which would overcome his objections or where the applicant has not overcome these objections, and the examiner considers the case is in order to proceed to refusal. There are also other circumstances in which reference to the Examining Division is appropriate, e.g. oral proceedings may be suggested by the examiner or requested by the applicant because an impasse has been reached. In considering whether to refer the application to the Division, the examiner should be guided by the principle stated in C-IV, 3.

The primary examiner should also bear in mind that when he issues a communication he does so in the name of the Division, and applicants are entitled to assume that if the examiner had doubts as to the views of the rest of the Division he would have discussed the matter with them beforehand.

As soon as the application has passed to the Examining Division under Rule 10, that Division will have ultimate responsibility, but formal matters will normally be dealt with by a formalities officer (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6). The examiner should not spend time checking the work done by the Receiving Section or the formalities officer, but if he believes a formalities report is incorrect or incomplete he should refer the application to the formalities officer for further consideration.

## **2. Recommendation to grant**

If the examiner considers that the application satisfies the requirements of the EPC and is thus in order to proceed to grant, he should make a brief written report (the "votum"). As a general rule, it will be appropriate in this report for the examiner to give the reasons why, in his opinion, the subject-matter as claimed in the application is not obvious having regard to the state of the art. He should normally comment on the document reflecting the nearest prior art and the features of the claimed invention which make it patentable, although there may be exceptional circumstances where this is not necessary, e.g. where patentability is based on a surprising effect. He should also indicate how any apparently obscure but important points have ultimately been clarified, and if there are any borderline questions which the examiner has resolved in favour of the applicant he should draw attention specifically to these.

## **3. Recommendation to refuse**

When referring to the Examining Division an application which is not in order for grant of a patent, the examiner should confer with the other members of the Division, bringing to their attention the points at issue, summarising the case history to the extent necessary to enable the other members to obtain a quick grasp of the essential facts, and recommending the action to be taken, e.g. refusal, or grant conditional upon certain further amendments. As the other members will need to study the case themselves, there is no need for a detailed exposition. It will be useful, however, to draw attention to any unusual features or to points not readily apparent from the documents themselves. If the examiner recommends refusal and the issue seems clear-cut, he may already provide a draft reasoned decision for issue by the Examining Division (see C-V, 14); if the issue is not clear-cut, the drafting of the reasoned decision should be deferred until the Division has discussed the case.

## **4. Tasks of the other members of the Examining Division**

*Art. 18(2)*

When an application is referred to the other members of the Division, they will first consider the case individually and each will indicate his opinion on the course of action to be taken. If there is complete agreement with the recommendation of the primary examiner, no further consultation of the Division will be necessary. When further action is needed, the primary examiner will be entrusted with the work. If, however, there is not complete agreement immediately with the primary examiner, or at least one member of the Division wishes to discuss the case further, further consultation of the Division will be arranged. In such discussions, the Division should try to reach a unanimous opinion, but where this seems unlikely, the difference of opinion must be resolved by voting. When the Division is enlarged to four members (see C-VIII, 7), the chairman has a casting vote should this be necessary.

The other members of the Examining Division should bear in mind that their function generally is not to perform a complete re-examination of the application. If, following a discussion, the conclusions of the examiner

entrusted with the examination are generally considered to be reasonable, the other members should accept them.

### **5. Further communication with the applicant**

If, in the opinion of the Examining Division, the possibility exists of amending the application to bring it into a form which meets the requirements of the EPC, then the primary examiner should be entrusted with the task of informing the applicant that the Examining Division is of the opinion that the application should be refused on certain grounds unless satisfactory amendments are submitted within a stated period (see C-VI, 1). If, within the time limit, satisfactory amendments are made, the examiner will then report back to the Examining Division recommending that the application should proceed to grant. If not, he should report back recommending refusal.

### **6. Decision**

Any decision is issued by the Examining Division as a whole and not by an individual examiner. All members, therefore, sign the written decision irrespective of whether or not it was a unanimous one. A seal may replace the signature.

*Rule 113*

### **7. Enlargement of the Examining Division; consultation of a legally qualified examiner**

If the Examining Division considers that the nature of the decision so requires, it is enlarged by the addition of a legally qualified examiner.

*Art. 18(2)*

The participation of a legally qualified examiner or at least internal consultation of Directorate Patent Law, the department responsible for providing legally qualified members for Examining and Opposition Divisions, will be required if a difficult legal question arises which has not yet been solved by the Guidelines or by jurisprudence.

If the Examining Division has been enlarged by the addition of a legally qualified examiner, it consists of four members. In this case, in the event of parity of votes, the vote of the chairman will be decisive. As a rule, this enlargement of the Examining Division will be required in cases where evidence has to be taken according to Rule 117 (including the giving of evidence by witnesses - see E-III). The addition of a legally qualified examiner is to be considered also in the case of oral proceedings. Such enlargement will also be necessary in cases involving technical opinions (Art. 25 - see E-XII, 3.1).

Depending on the nature of the problem, as an alternative to the enlargement of the Examining Division, internal consultation of a legally qualified examiner in Directorate Patent Law may take place. For instance, doubts may arise whether an application concerns an invention within the meaning of Art. 52(2) or whether the claimed invention is excluded from patentability by virtue of Art. 53. Consultation of a legally qualified examiner may also be appropriate in cases where legal considerations are predominant in respect to a decision, as in proceedings following a request for re-establishment of rights according to Art. 122. The formalities officer

may also consult Directorate Patent Law in cases within the scope of the duties transferred to him according to Rule 11(3) (see the Decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6).

## Chapter IX – Special applications

### 1. Divisional applications (see also A-IV, 1)

#### 1.1 General remarks

Subsequent to the filing of a European application or upon entry into the European phase of a Euro-PCT application, a divisional application may be filed. The divisional application is accorded the same date of filing as the parent application and has the benefit of any right of priority of the parent application in respect of the subject-matter contained in the divisional application. However, the parent application must be pending when a divisional application is filed (A-IV, 1.1.1). A European application may give rise to more than one divisional application. A divisional application may itself give rise to one or more divisional applications. *Art. 76(1)*

Divisional applications are to be treated in the same manner as ordinary applications and subject to the same requirements as these unless specific provisions of the EPC, in particular Art. 76 or Rule 36, require something different (G 1/05, G 1/06).

#### 1.2 Voluntary and mandatory division

The applicant may file a divisional application of his own volition (voluntary division). The most common reason, however, for filing a divisional application is to meet an objection under Art. 82 due to lack of unity of invention (mandatory division). If the examiner raises an objection due to lack of unity, the applicant is allowed a period (see C-VI, 1) in which to limit his application to a single invention. The limitation of the parent application has to be clear and unconditional. The communication inviting the applicant to limit the application due to lack of unity should therefore include a reference to the fact that if the application is not limited within the set time limit the application may be refused. *Art. 82*

#### 1.3 Abandonment of subject-matter

The mere deletion of subject-matter in the parent application is not prejudicial to the later filing of a divisional application. When deleting subject-matter, the applicant should, however, avoid any statements which could be interpreted as abandonment with substantive effect, thereby impeding the valid filing of a divisional application for that subject-matter (see also H-III, 2.5, last paragraph).

#### 1.4 Examination of a divisional application

The substantive examination of a divisional application should in principle be carried out as for any other application but the following special points need to be considered. The claims of a divisional application need not be limited to subject-matter already claimed in claims of the parent application. Furthermore, no abuse of the system of divisional applications can be identified in the mere fact that the claims of the application on which the Examining Division had then to decide had a broader scope than the claims granted in relation with the parent application (see T 422/07). *Art. 76(1)*

However, under Art. 76(1), the subject-matter may not extend beyond the content of the parent application as filed. If a divisional application as filed contains subject-matter additional to that contained in the parent application as filed, it can be amended later in order that its subject-matter no longer extends beyond the earlier content, even at a time when the earlier application is no longer pending (see G 1/05). If the applicant is unwilling to remedy the defect by removal of that additional subject-matter, the divisional application must be refused under Art. 97(2) due to non-compliance with Art. 76(1).

It cannot be converted into an independent application taking its own filing date. Moreover, a further divisional application for this additional subject-matter should also be refused under Art. 97(2) due to non-compliance with Art. 76(1).

*Art. 123(2)*

Amendments made to a divisional application subsequent to its filing must comply with the requirements of Art. 123(2), i.e. they may not extend the subject-matter beyond the content of the divisional application as filed (see G 1/05 and T 873/94). If those amendments have not been identified and/or their basis in the application as filed not indicated by the applicant (see H-III, 2.1) and the application is one of those mentioned in H-III, 2.1.4, the Examining Division may send a communication according to Rule 137(4) requesting the applicant to provide this information (see H-III, 2.1.1).

If the subject-matter of a divisional application is restricted to only a part of the subject-matter claimed in the parent application, this part of the subject-matter must be directly and unambiguously derivable from the parent application as being a separate part or entity, i.e. one which can even be used outside the context of the invention of the parent application (see T 545/92).

In the case of a sequence of applications consisting of a root (originating) application followed by divisional applications, each divided from its predecessor (see A-IV, 1.1.2), it is a necessary and sufficient condition for a divisional application of that sequence to comply with Art. 76(1), second sentence, that anything disclosed in that divisional application be directly and unambiguously derivable from what is disclosed in each of the preceding applications as filed (see G 1/06).

### **1.5 Description and drawings**

The description and drawings of the parent application and the or each divisional application should in principle be confined to matter which is relevant to the invention claimed in that application. However, amendment of the description should be required only where it is absolutely necessary. Thus the repetition in a divisional application of matter in the parent application need not be objected to unless it is clearly unrelated to or inconsistent with the invention claimed in the divisional application. As for the matter of cross-references, there is no need for the examiner to check in the description since, under present practice, cross-references are always made between the parent and divisional applications. These appear



on the front page of the respective application and patent published after receipt of the divisional application, unless the technical preparations for publication have already been completed.

## 1.6 Claims

The parent and divisional applications may not claim the same subject-matter, even in different words (for further information, see G-IV, 5.4). The difference between the claimed subject-matter of the two applications must be clearly distinguishable. As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B.

## 2. Applications resulting from a decision under Art. 61

### 2.1 General remarks

In certain circumstances, before a patent has been granted on a particular application, it may be adjudged as a result of a final decision of a national court that a person other than the applicant is entitled to the grant of a patent thereon. In this event this third party may either:

- (i) prosecute the application as his own application in place of the applicant; Art. 61(1)(a)
- (ii) file a new European patent application in respect of the same invention; or Art. 61(1)(b)
- (iii) request that the application be refused. Art. 61(1)(c)

If the third party adopts the first of these options, he becomes the applicant in place of the former applicant and the prosecution of the application is continued from the position at which it was interrupted.

If, however, the third party files a new application under Art. 61(1)(b), the provisions of Art. 76(1) apply to this new application *mutatis mutandis*. This means that the new application is treated as though it were a divisional application i.e. it takes the date of filing and the benefit of any priority right of the original application. The examiner must therefore ensure that the subject-matter content of the new application does not extend beyond the content of the original application as filed. The original application is deemed to be withdrawn on the date of filing of the new application for the designated States concerned. Art. 61(1) and (2)  
Rule 17(1)

### 2.2 Original application no longer pending

In cases where the original application has been withdrawn, refused or deemed to be withdrawn and is thus no longer pending, Art. 61(1)(b) is applicable, thus allowing the third party to still file a new European patent application in respect of the same invention (see G 3/92).

**2.3 Partial entitlement***Rule 18(1)*

If, by a final decision, it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, then the foregoing considerations apply only to that part. In such a case, option (i) mentioned in C-IX, 2.1 is not open to the third party and, regarding option C-IX, 2.1(ii), the new application must be confined to that part of the original subject-matter to which he has become entitled. Similarly, the original application must, for the designated States concerned, be confined to the subject-matter to which the original applicant remains entitled. The new application and the amended original application will stand in a relationship to each other similar to that pertaining between two divisional applications, and they will each stand in a relationship to the original application similar to that in which divisional applications stand in relation to the application from which they are divided. The guidance set out in C-IX, 1.4, 1.5 and 1.6 is therefore applicable to this situation.

**2.4 Entitlement for certain designated States only***Rule 18(2)*

Where the final decision on entitlement applies only to some of the designated States, the original application may contain different claims, description and drawings for those States compared with the others (see H-III, 4.1, last paragraph, and 4.3).

If the sole result of the application of Art. 61(1) is to divide the right to the grant between the original applicant and the third party so that each may apply for the entire subject-matter for different designated States, each application should be examined in the normal way without regard to the other, with the proviso that the subject-matter of each application must not extend beyond that of the original application.

**3. Applications where a reservation has been entered in accordance with Art. 167(2)(a) EPC 1973**

See H-III, 4.4.

**4. International applications (Euro-PCT applications)**

For more details on this topic, see E-VIII.