

# **Part E**

## **Guidelines on General Procedural Matters**



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## **Introduction**

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



## Chapter I – Communications and notifications

### 1. Communications

#### 1.1 General remarks

Communications should be sent, *inter alia*:

- (i) if a party has to be informed of deficiencies, together, where appropriate, with a request to remedy those deficiencies, e.g. in accordance with Rule 55, 58, 59, 62a, 63, 64(1), 71(1), 77(2), 95(2) or 108(2);
- (ii) if a party is to be invited to file observations on particular questions or to submit documents, evidence, etc., to clarify the issues involved;
- (iii) if, in the opinion of the Examining or Opposition Division, the patent cannot be granted or maintained in the text requested by the applicant or proprietor of the patent, but could possibly be granted or maintained in an amended text of more limited scope;
- (iv) if information necessary to the conduct of the proceedings has to be communicated to the parties, e.g. in accordance with Rule 14(2) and (3), 35(4) or 142(2) and (3);
- (v) for preparing oral proceedings, (see E-II, 5); or
- (vi) if a decision is to be based on grounds on which the parties have not yet had an opportunity to comment (see E-IX, 1).

#### 1.2 Number of communications

Since each communication issued may entail prolonging the proceedings, the proceedings should be conducted in such a way as to manage with as few communications as possible. If a communication has to be issued, it should cover all the points which are necessary, or likely to be of importance, for the particular stage of the proceedings, e.g. the preparation of oral proceedings or of a decision.

#### 1.3 Form of decisions, communications and notices

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

*Rule 113(1) and (2)*

## 2. Notification

### 2.1 General remarks

*Art. 119*  
*Rule 125*  
*Rule 126*

The EPO as a matter of course notifies those concerned of decisions and summonses, and of any notice or other communication from which a time limit is reckoned, or of which those concerned must be notified under other provisions of the EPC, or of which notification has been ordered by the President of the EPO. Notifications may, where exceptional circumstances so require, be given through the intermediary of the central industrial property offices of the Contracting States. In proceedings before the EPO, any notification to be made must take the form of the original document, or a copy thereof certified by or bearing the seal of the EPO, or a computer print-out bearing such seal, or an electronic document containing such seal or otherwise certified. Copies of documents emanating from the parties themselves do not require such certification.

### 2.2 Method of notification

*Rule 125(2) and (3)*

Notification is to be made by postal services, by delivery on the premises of the EPO, by public notice or by means of electronic communication as determined by the President of the EPO and under the conditions laid down by him governing their use. Further details concerning notifications are given in Rules 126 to 129. Notification through the central industrial property office of a Contracting State competent to deal with the addressee must be made in accordance with the provisions applicable to that office in national proceedings.

### 2.3 Notification by postal services

*Rule 126*

Decisions incurring a period for appeal or a petition for review, summonses and other documents as decided on by the President of the EPO must be notified by registered letter with advice of delivery or equivalent. All other notifications by postal services must be by registered letter. The President of the EPO has, so far, not named any other documents to be notified by registered letter with advice of delivery or equivalent.

The letter is deemed to be delivered to the addressee on the tenth day following its handover to the postal service provider, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it is incumbent on the EPO to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.

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

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

## **2.4 Electronic notification**

Where a user has agreed to receive communications electronically, the electronic document is deemed to be delivered to the addressee on the tenth day after its transmission unless it has failed to reach its destination or has reached it at a later date. The date of transmission is the date indicated on the document, provided that the addressee has access to it in the Mailbox by that date. For further details, see the Decision of the President of the EPO dated 11 March 2015 concerning the pilot project to introduce new means of electronic communication in EPO proceedings (OJ EPO 2015, A28) and the Notice from the EPO dated 30 March 2015 (OJ EPO 2015, A36).

*Rule 127*

## **2.5 Notification to representatives**

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

*Rule 130*

## **2.6 Irregularities in the notification**

Where a document has reached the addressee, if the EPO is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document is deemed to have been notified on the date established by the EPO as the date of receipt. In cases where the EPO is not able to prove the actual date of notification, a letter for instance, sent by the addressee himself which indicates the date of receipt, is accepted as proof. If it is evident from a reply from the addressee that he has received the document, although he does not mention the date of its notification, the date on which that reply was written is to be regarded as the date of notification.

*Rule 125(4)*



## Chapter II – Oral proceedings

### 1. General

By "oral proceedings" is meant formal proceedings within the meaning of Art. 116. The term therefore does not include informal personal interviews or telephone conversations, such as occur in examination proceedings and limitation/revocation proceedings (see C-VII, 2). In view of Rule 81(2), such informal personal interviews or telephone conversations are not allowed in opposition proceedings, in which more than one party is involved, unless the interview or telephone conversation concerns matters which do not affect the interests of other parties. An example is proceedings for examining the admissibility of opposition, provided this involves only the EPO and the opponent concerned.

Oral proceedings will take place before the competent body, e.g. within the Receiving Section before the competent formalities officer and during the examination and opposition procedure before the whole Division. The right to oral proceedings forms a substantial part of the right to be heard under Art. 113.

*Art. 18(2)*

*Art. 19(2)*

*Art. 113*

### 2. Oral proceedings at the request of a party

If, in the course of proceedings, a party requests oral proceedings, the competent department must grant this request. The EPO will not inform the party concerned of this right but will expect him – if he does not obtain satisfaction from the competent department – to request oral proceedings (if he so wishes) before a decision is reached.

*Art. 116(1)*

Under Art. 116(1), parties can request oral proceedings at any time, provided a decision has not yet been issued. In particular, a request for oral proceedings made before the decision to grant or to limit has been handed over to the internal post has to be allowed (see T 556/95 and G 12/91).

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

*Art. 116(2)*

The competent department will decide on the most appropriate date for the oral proceedings, which should only be held after the issues to be determined are sufficiently clear (see E-II, 5).

With a conditional request for oral proceedings, i.e. if the party concerned has indicated that the request for oral proceedings has been made solely as a precaution to cover the eventuality that the case he has put forward is not accepted, oral proceedings will be held only if a negative decision against the party concerned is envisaged.

With an unconditional request for oral proceedings, on the other hand, if the competent department considers that a decision on the matter may be reached on the basis of the written evidence obtained and intends to take a decision (e.g. in accordance with Art. 97, 101 or 105b) which fully concurs with the case put forward by the party or parties which requested the oral proceedings, the party or parties concerned should be informed accordingly and asked whether the request or requests for oral proceedings will be maintained even though the decision concurs with the case put forward. If the request is not expressly withdrawn, oral proceedings must be held.

A request to have oral proceedings held at an EPO site other than that indicated in the summons is not allowable (see T 1012/03).

### **2.1 Request for oral proceedings by an opponent whose opposition is to be rejected as inadmissible or is deemed not to have been filed**

Under Art. 116(1), oral proceedings may be requested only by a party to pending proceedings. If the Opposition Division notes deficiencies in the notice of opposition under Rule 77(1), the opponent still remains a party to the proceedings until such time as his opposition is rejected as inadmissible. This also applies when deficiencies lead to the opposition being deemed not to have been filed (see D-IV, 1.4.1).

### **3. Request for further oral proceedings**

Art. 116(1)

The EPO may reject a request for further oral proceedings before the same department where the parties and the subject of the proceedings are the same.

Oral proceedings, particularly in opposition proceedings, are held to give the opportunity to finally discuss all matters raised and are normally terminated with a decision announced orally. The Division is bound by that decision, once announced, and it cannot reopen the proceedings to allow further submissions to be filed or to take into account new facts (see the last two paragraphs of E-V, 2). Only if the Division, in the oral proceedings, has not announced a decision, but has decided to continue the proceedings in writing, can further submissions be examined. Such may be the case e.g. when the Examining Division indicates that it intends to grant a patent (or to limit a granted patent in limitation proceedings) on the basis of the documents filed during the oral proceedings.

Thus, as a rule, in examination, limitation or opposition proceedings there will be no justification for further oral proceedings, for example where one of the parties wishes to re-examine from a different viewpoint a subject already discussed in the course of the proceedings, either before or during the original oral proceedings. However, if the oral proceedings are not terminated with a decision and after the oral proceedings the subject of the proceedings changes, for example where fresh evidence is admitted into the proceedings after the original oral proceedings, then further oral proceedings will generally have to be held if requested (see T 194/96).

#### **4. Oral proceedings at the instance of the EPO**

The competent department of the EPO may arrange for oral proceedings to take place without a request from a party if it considers this to be expedient. *Art. 116(1)*

Oral proceedings will normally only be expedient if after an attempt at written clarification there are still questions or doubts which have a crucial bearing on the decision to be reached and which may be more efficiently or surely settled by oral discussion with the party or parties or if it is necessary to take evidence as part of oral proceedings (see E-III, 1.3 and 1.6.1). The competent department should also bear in mind the need for economy in such procedures, since oral proceedings give rise to costs for both the EPO and the party or parties.

#### **5. Preparation of oral proceedings**

The purpose of oral proceedings should be to settle as far as possible all outstanding questions relevant to the decision. To this end proceedings should be carefully prepared after examination of all the written matter submitted and with this in mind the most appropriate date for conducting oral proceedings chosen.

When preparing oral proceedings in opposition proceedings, the Opposition Division should consider carefully whether complex legal issues are likely to arise, and it may therefore decide to enlarge the Division by adding a legally qualified member (Art. 19(2)).

Insofar as certain questions relevant to the decision are considered by the EPO to require discussion, it will in many cases be expedient to inform the party or parties in a notice and possibly also to invite one or more of the parties to submit written observations or to produce evidence, where appropriate. Parties may produce evidence in support of their arguments on their own initiative. Where, however, the evidence is such as should have been put forward at an earlier stage, e.g. in opposition proceedings pursuant to D-IV, 1.2.2.1(v) and 5.4, it is for the competent body to consider whether the evidence not filed in due time is to be admitted (see E-V, 2). Any observations should be received in time for them to be communicated to the other parties at the latest one month before the oral proceedings. The time limit for submission of observations should be fixed accordingly, particularly where the invitation to file observations is issued at the same time as the summons to oral proceedings.

##### **5.1 When can summons to oral proceedings be issued in substantive examination?**

At the beginning of substantive examination, if the Examining Division is of the opinion that the application cannot be granted directly, at least one substantive communication within the meaning of Art. 94(3) must be sent before the Division can consider issuing a summons to oral proceedings (see C-III, 4).

In particular it should be noted that neither the search opinion of an EESR or a supplementary search (ESOP) nor an opinion or report from the PCT procedure (WO-ISA, SISR, IPRP or IPER) is a communication under

Art. 94(3), so that even if the applicant has replied thereto, it is not possible to send a summons as a first communication in European substantive examination.

Nor are the following communications/requests considered as substantive communications from the Examining Division for this purpose: invitation under Rule 62a or Rule 63, communication under Rule 137(4), request under Rule 53(3), request under Art. 124 and Rule 141, invitation under Rule 164(2)(a).

In examination proceedings, where the applicant has been invited to provide a translation of the priority according to Rule 53(3) (see A-III, 6.8.2, and F-VI, 3.4), no summons to oral proceedings will be issued until either the translation is provided or the period for further processing in respect of the time limit according to Rule 53(3) has expired.

## **6. Summons to oral proceedings**

*Rule 115(1)*  
*Art. 119*

All parties must be duly summoned to oral proceedings by notification. The summons must state the subject and the date and time of the oral proceedings.

The Division should set a single date for the oral proceedings, i.e. one day or, in particular cases, more than one consecutive days. No pre-announcement of the date by phone or fax will be made.

*Rule 116(1)*

The summons will be accompanied by a note drawing attention to the points which need to be discussed, normally containing the provisional and non-binding opinion of the Division. The summons will also fix a date up to which written submissions may be filed or amendments which meet the requirements of the EPC may be submitted (see also D-VI, 3.2).

*Rule 115(1)*

Rule 115(1) stipulates that at least two months' notice of the summons must be given unless the parties agree to a shorter period.

Harmonised with the standards applied in the written procedure (E-VII, 1.2), the practice outlined below should be followed in setting the date of the oral proceedings to allow the parties sufficient time for preparing and filing submissions:

- (i) Any time limit (even shorter than two months) may be set provided that prior agreement has been reached with the parties.
- (ii) Normally, the summons should be issued at least four months ahead of the day of the oral proceedings in examination and at least six months ahead of the day of the oral proceedings in opposition.
- (iii) Between two and four months' notice can be given without preliminary agreement only in specific circumstances, since the parties would have very limited time for filing submissions before the date fixed in the summons. Examples are where, in examination, the summons follows an extensive exchange between the first examiner

and the applicant, or where the oral proceedings must be postponed (see also E-II, 7.2).

- (iv) A longer time limit may be set where appropriate, e.g. where it is clear that in the circumstances of the specific case the time limit as per point (ii) above cannot be adhered to or where the division is facing problems finding a suitable room.

The summons must state that if a party duly summoned does not appear as summoned, the proceedings may continue without him.

In opposition proceedings as a rule, even oral proceedings requested on the basis of totally different grounds for opposition should be conducted as a single set of proceedings.

In cases of multiple oppositions, all oral proceedings requested should be dealt with in a single session, even if the oppositions are based on different grounds. This means that all the parties must be summoned to attend them and may present comments on all grounds raised.

## **7. Postponement of oral proceedings**

### **7.1 Requests for the postponement of oral proceedings**

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

Serious reasons to request a change of the date for oral proceedings may be, for instance:

- a previously notified summons to oral proceedings of the same party in other proceedings before the EPO or a national court
  - for the same date or
  - for the preceding or following day or
  - for the two preceding or two following days where the other oral proceedings are to take place at a geographically distant location,
- serious illness,
- a death within the family,

- the marriage of a person whose attendance in oral proceedings is relevant,
- military service or other obligatory performance of civic duties,
- business trips which have been firmly booked before notification of the summons to oral proceedings,
- holidays which have already been firmly booked before notification of the summons to oral proceedings. In the case of holidays scheduled but not yet booked, the representative should indicate the circumstances (e.g. school holidays) which prevent the holidays from being rescheduled.

If the grounds for postponing the oral proceedings submitted by a party do not meet the above criteria, the Division will inform the parties that the oral proceedings will take place as set out in the summons.

The reasons that can be invoked for postponement only apply to those participants whose presence is essential to the oral proceedings, e.g. the representative or a witness.

If during the procedure substantive submissions were made by several representatives of a firm, an indication must be given why none of those who previously made such submissions can present the case at the oral proceedings, i.e. why the representative who cannot attend is essential or why the others are also unable to attend.

It should be noted that in opposition proceedings, in particular if more than one opponent is involved, a more strict approach may be applied to prevent a series of postponements (see T 1102/03).

Grounds which, as a rule, are not acceptable are, for instance:

- a summons to oral proceedings before the EPO or a national court notified after the summons in the relevant proceedings,
- excessive work pressure.

In order to make effective use of the available meeting rooms, and as Mondays and Fridays are normal working days, oral proceedings will be scheduled for these days. The fact that the representative and/or the parties have to travel at weekends is not a sufficient reason to change the date of the oral proceedings. The departments of first instance will however, circumstances permitting, try to be flexible where there is a request to postpone the starting time in order to enable the party to travel on the same day.

## **7.2 Postponement of oral proceedings at the instigation of the Division**

In exceptional cases the Division might have to instigate postponement of oral proceedings for reasons similar to those mentioned above. The proceedings should, however, be postponed only if a suitable replacement cannot be found.

## **7.3 Postponement of oral proceedings – defined notice period**

The notice period defined in Rule 115(1), i.e. at least two months, is valid also in case of a postponement, unless the parties have agreed on a shorter period (see also E-II, 6(iii), and E-II, 8.11.1).

# **8. Conduct of oral proceedings**

## **8.1 Admission of the public to proceedings**

Oral proceedings before the Receiving Section, the Examining Divisions and the Legal Division are not public. *Art. 116(3)*

Oral proceedings, including delivery of the decision (see E-II, 9), are public before the Opposition Divisions insofar as the Opposition Division does not decide otherwise in cases where admission of the public could have serious and unjustified disadvantages, in particular for a party to the proceedings. This could, for example, be the case if one of the parties wishes to give information about sales figures or other commercial secrets in support of his case. Generally, the public will only be excluded whilst such information is being given. *Art. 116(4)*

## **8.2 Conduct of oral proceedings**

Before the Receiving Section oral proceedings will be conducted by the formalities officer and before the Examining or Opposition Divisions by the Chairman of the Division concerned.

The responsibilities of the person conducting the proceedings will include keeping order and conducting the proceedings as regards their formal and substantive aspects.

The person conducting the proceedings must in particular ensure that, where necessary, a list is prepared of all disputed or unclear points relevant to the decision to be reached, that these are discussed and that the party or parties have the opportunity of commenting on them.

On the other hand, the oral proceedings are to be conducted strictly and efficiently, so that the submissions of the party or parties and the discussions are not unnecessarily digressive and do not deal with points which are of no relevance to the decision to be reached. Repetition should be avoided as far as possible. In particular, written material submitted at the appropriate time to the competent department and to the party or parties which has already been the subject of proceedings need not be read out *in extenso*. A simple reference to such written material may suffice.

### **8.2.1 Use of laptops or other electronic devices during either *ex parte* or *inter partes* oral proceedings**

As a general rule, the use of laptops or other electronic devices during oral proceedings is allowed provided they do not cause disturbance to the participants and are not used for sound recording (see the Notice of the Vice-Presidents Directorates General 2 and 3 dated 25 February 1986 and issued in OJ EPO 1986, 63).

Only in exceptional circumstances, where, for example, the use of an electronic device disturbs the oral proceedings and despite warning of the Division the disturbance is not remedied, can the Division decide not to admit the use of the incriminated device. It should be taken into consideration that it is normal for a representative to rely on electronically stored documents to present his case and he may be put in a difficult position if the Division denies him the right to use his laptop.

## **8.3 Opening of oral proceedings: non-appearance of a party**

### **8.3.1 Checking the identity and authorisations of participants at oral proceedings**

Professional representatives need to file authorisations only in exceptional cases (see Decision of the President of the EPO, Special edition No. 3, OJ EPO 2007, L.1).

Authorisations need be checked only if a party is represented by a person whose authorisation is not apparent from the file. If it is established that the person is either

- (a) a professional representative acting under a sub-authorisation
- (b) a professional representative from the same agency as the representative acting in the case, or
- (c) a natural person (e.g. executive director) authorised by law in the party's country of business to act on behalf of that party

then no further check is required.

If however the person is:

- (a) a professional representative who is neither from the same agency nor acting under a sub-authorisation, and his/her attendance at the oral proceedings is his/her first appearance in the procedure, or
- (b) a legal practitioner or a party's employee who is not an authorised professional representative

then the procedure is as follows:

In case (a), the Division will check the file to see whether the previous representative's authorisation has lapsed. A change in representative or the

termination of the authorisation of a previous representative may have been effected via an electronic notification through the MyFiles service (see OJ EPO 2012, 352). If the previous representative's authorisation has lapsed, no further action is required. If not, the representative concerned will be requested to provide a reference to a registered general authorisation or to file an individual authorisation.

In case (b), the Division will request the person concerned to provide a reference to a registered general authorisation or to file an individual authorisation.

A person without an authorisation will be requested to submit one without delay. If he is unable to do so straight away, a time limit of two months will be set for its submission. The fact that the authorisation was missing, and the time limit set for submitting it, must be recorded in the minutes. The proceedings then continue in the normal way, except that no decision can be pronounced at the end. Instead, the decision is issued in writing once the missing authorisation has been filed. At the end of the proceedings, the party concerned should be reminded to file the authorisation.

The person conducting the proceedings will have the particulars of the persons taking part taken and their authorisations checked, where necessary, before the start of the oral proceedings. Parties and their representatives must identify themselves unless they are known to the person conducting the proceedings or any of the members of the Examining or Opposition Division.

### **8.3.2 Opening the oral proceedings**

After opening the oral proceedings the person conducting them will introduce the parties present. He will have the particulars of the persons taking part in the proceedings recorded and will establish in what capacity they are present. Details of these steps and any consequences thereof will be recorded in the minutes (see E-II, 10).

### **8.3.3 Late arrival or non-appearance at oral proceedings**

#### **8.3.3.1 General**

If an absent party was not duly summoned, this is noted in the minutes and the oral proceedings are closed. A new date must be fixed for further oral proceedings.

If a party who has been duly summoned to oral proceedings does not appear as summoned, the oral proceedings may be conducted without him, since a party should not be able to delay issuance of a decision by failing to appear. This applies also in case of an explicit withdrawal of the request for oral proceedings or if a party has indicated that he will not attend (which is normally interpreted as equivalent to a withdrawal (see T 3/90, T 696/02 and T 1027/03)).

*Rule 115(2)*

If the Division decides that oral proceedings are nevertheless to be conducted, this means that there are objections still outstanding that need

to be discussed at the oral proceedings. Consequently the applicant and/or patentee can expect that problems relating to the requests filed in reply to the summons to oral proceedings will be dealt with at the oral proceedings.

If the applicant and/or patentee decides not to attend the oral proceedings, he is thereby choosing not to make use of the opportunity to comment at the oral proceedings on any of the objections, but to rely on the arguments as set out in the written submissions. The decision may be given orally in his absence. The procedural principles require that the party to the proceedings is not taken by surprise by the decision.

It is to be noted that if a party appears **before the end** of the oral proceedings, he has the right to be heard.

If the party appears only **after the proceedings** have been closed, the Division may reopen them at its discretion, subject to two conditions:

- (a) the Division has not pronounced a decision under Art. 97(1) or (2) or Art. 101(2) or an interlocutory decision under Art. 106(2) maintaining the patent in amended form according to Art. 101(3) (see also D-VI, 7.2.2) or a decision to reject the request for limitation under Rule 95(4).
- (b) all parties to the proceedings agree to the reopening.

*Art. 104(1)*

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

### 8.3.3.2 Procedure in opposition proceedings

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

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

In other words, what the Enlarged Board of Appeal ruled out in G 4/92 was the possibility of taking decisions against the absent party on the basis of a surprising course of events at the oral proceedings, which changes the

legal and factual framework of the case in an unforeseeable way (see T 414/94).

An absent party cannot be considered taken by surprise if during oral proceedings the other side attempts to overcome objections raised before the oral proceedings. In particular, a submission during oral proceedings of a more restricted and/or formally amended set of claims with a view to overcoming the objections of the opponent is not considered a "new fact" (see T 133/92 and T 202/92). Nor is it unexpected that amended claims are examined for formal admissibility and for compliance with Art. 123(2) and (3) (see T 341/92).

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

#### **8.3.3.3 Procedure in examination proceedings**

Oral proceedings give the applicant an opportunity to exercise his rights under Art. 113(1). In examination proceedings, when an applicant files amended claims before oral proceedings which he subsequently does not attend, he may expect a decision based on objections which might arise against such claims in his absence. A decision can be taken based on facts and arguments presented earlier in the proceedings and/or based on new arguments which may be expected to be raised (see OJ EPO 2008, 471).

In examination proceedings, the summons to oral proceedings should include all the objections that are likely to be discussed during oral proceedings and should indicate that amended claims in response to the communication will have to be examined at the oral proceedings for compliance with the EPC. This ensures that the applicant's right to be heard (Art. 113(1)) is respected and that the proceedings are not delayed unnecessarily if an applicant does not attend oral proceedings.

#### **8.4 Opening of the substantive part of the proceedings**

Insofar as necessary, the person conducting the proceedings will outline the stage reached in the proceedings and will indicate the most important matters in dispute according to the file. In examination or opposition proceedings this may also be done by the primary examiner.

#### **8.5 Submissions by the parties**

After the introduction referred to above, the party or parties will be allowed the floor in order to put their cases and to make applications on procedural matters and state the grounds thereof. In the normal course of events each party should have only one opportunity of making a comprehensive statement.

In opposition proceedings the opponents will generally speak first and the patent proprietor afterwards. Where there are a number of opponents, it may be expedient to grant the patent proprietor an opportunity of replying

directly after the statement of each individual opponent. The opponents and the patent proprietor should be given the opportunity of making a final reply.

The submissions of the party or parties may be prepared in writing, although they should as far as possible be made extemporaneously. Passages from documents already introduced into the proceedings which are referred to again should only be read out where their precise wording is relevant.

Submissions by a person who is not qualified under Art. 133 and 134 to represent parties to proceedings before the EPO may be admitted at oral proceedings when this person accompanies a professional representative representing that party. Such submissions, however, cannot be made as a matter of right, but only with the permission and at the discretion of the Examining or Opposition Division. In opposition proceedings the Division should consider in exercising its discretion whether (see G 4/95):

- (i) the party on behalf of which the person is to speak has filed a request to this effect;
- (ii) the party making the request has indicated the name of the person, the subject-matter of the submission and the person's qualification to speak on this matter;
- (iii) the request has been filed sufficiently in advance of the oral proceedings;
- (iv) in the case of a late-filed request, either there are exceptional circumstances justifying the admission of the submission or all the other parties agree to the making of the submission; and
- (v) the submissions are made under the continuing responsibility and control of the professional representative.

If neither of the alternative conditions mentioned under (iv) are met, a late-filed request should be refused. The time limit to be applied when deciding whether a request was late-filed is that fixed in the summons under Rule 116.

If a party is represented by an authorised employee rather than a professional representative, the same considerations apply in respect of a person accompanying the authorised employee. As no other party is affected, Examining Divisions can adopt a more liberal approach than Opposition Divisions.

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

If written submissions are made during oral proceedings, the Division should make sure that requirements such as typed-form, signature and dating of the submissions are met (T 733/99). See also E-II, 8.7.

#### **8.5.1 Use of computer-generated slideshows in oral proceedings**

In oral proceedings a computer-generated slideshow cannot be used as a matter of right, but only with the permission of and at the discretion of the Examining or Opposition Division (T 1556/06).

Care should be taken that presentations of computer-generated slideshows do not negatively impact the efficient conduct of oral proceedings (e.g. interruptions for the technical preparations for the presentation). Similar considerations apply to the use of other visual aids (e.g. flipcharts, pictures).

Furthermore, with computer-generated slideshows it must be borne in mind that requests to provide equipment such as projectors for the presentation of a computer-generated slideshow must be refused. Screens, however, should be available in most meeting rooms.

##### **8.5.1.1 Opposition proceedings (inter partes)**

As a prerequisite, copies of the material to be presented must be provided in good time before the oral proceedings, i.e. Rule 116 applies. These copies are treated like any other submission made in writing.

The Opposition Division should decide whether the presentation of a computer-generated slideshow would facilitate the proceedings, after having heard the parties and taking into account whether allowing or refusing the use of the presentation would be detrimental to any participant.

A balance should be found between the presenter's interest in defending his case in the most appropriate manner, and the opposing party's need to fully understand the submissions made and to have a true opportunity to respond.

The presentation of computer-generated slideshows in oral proceedings should be allowed if in the absence of this visual aid it would be much more difficult to follow the party's submissions. For example, slides showing:

- (a) the structure or functioning of a product which is complex, or
- (b) complicated reaction schemes,
- (c) complex formulae, or
- (d) the operation of a complex apparatus

might be considered by the Opposition Division to facilitate the discussion.

If copies of the material to be presented have not been filed in good time, or if the slides contain new matter, the presentation may be disregarded under

Art. 114(2) and Rule 116. In this case the Opposition Division will apply the same criteria for admissibility as are used for other late-filed facts or evidence (see E-II, 8.6).

#### **8.5.1.2 Examination proceedings (ex parte)**

As no other party is affected, Examining Divisions may adopt a more liberal approach than Opposition Divisions. Therefore, Examining Divisions should consider allowing the presentation of a computer-generated slideshow even if the slides are not communicated in advance of the oral proceedings, provided that:

- (a) the Examining Division feels able to deal with this late-filed material without unduly lengthening the proceedings. The same considerations as for other late-filed facts and evidence apply (see E-II, 8.6);
- (b) the room in which oral proceedings are held provides adequate basic facilities (e.g. a screen);
- (c) the submissions contribute to the resolution of the questions at issue.

#### **8.6 Facts, evidence or amendments introduced at a late stage**

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

#### *Rule 116(1)*

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

Examples of such changes would be:

- In timely response to the points raised in the note annexed to the summons, the proprietor files amendments which have the result that a new document becomes relevant; in such a case the opponent should be allowed to present this document and must be given a chance to comment on the amendments (Art. 113(1)). For the purpose of admissibility, a document's relevance should normally be decided relative to the amended claims against which it is cited. Documents that have limited relevance to an initial set of claims may acquire new relevance as a result of subsequent amendments to those claims (T 366/11).
- A new ground of opposition is introduced during oral proceedings: the opponent should always be granted the right to be heard, even

where the arguments concern a late-filed ground of opposition and new arguments and evidence related to it (T 117/02).

Rule 116(2) imposes the same obligations on the applicant or patent proprietor when submitting new documents which meet the requirements of the EPC (i.e. new amendments to the description, claims and drawings) as Rule 116(1) imposes on the parties in submitting new facts and evidence. Here the Division also has the discretion to disregard amendments because they are filed too late before the oral proceedings. However, where the opponent files, before the indicated date, pertinent new material, the patent proprietor must be given a chance to present his comments and submit amendments (Art. 113(1)).

*Rule 116(2)*

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

In exercising this discretion, the Division will in the first place have to consider the relevance of the late-filed facts or evidence (see E-V, 2) or the allowability of the late-filed amendments, on a *prima facie* basis. If these facts or evidence are not relevant or if these amendments are clearly not allowable, they will not be admitted. Before admitting these submissions, the Division will next consider **procedural expediency**, the **possibility of abuse of the procedure** (e.g. one of the parties is obviously protracting the proceedings) and the question whether the parties **can reasonably be expected** to familiarise themselves in the time available with the new facts or evidence or the proposed amendments.

*Rule 116(1) and (2)*

As regards **procedural expediency**: where the late-filed facts or evidence are relevant, but their introduction would cause a prolonged adjournment of the proceedings, the Division may decide to not admit these facts or evidence in the proceedings. An example would be where the witness lives abroad and still has to be found or lengthy tests are still necessary. The Division may, however, also postpone the proceedings and in doing so may have to consider the apportionment of costs in opposition proceedings (Art. 104).

Examples of possible **abuse of the proceedings** would be:

- The patent proprietor introduces at short notice a proliferation of auxiliary requests which are not a reaction to the course of the proceedings.
- The opponent files an assertion of public prior use, based on activities of the opponent himself, late in the absence of good reasons for the delay (see T 534/89).
- The applicant or patent proprietor presents a large number of requests, or incomplete variants of requests, and invites the Division to choose, shifting the responsibility for determining the content of the application or patent to the Division. It is the duty of any party to

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

In opposition proceedings the parties should be heard on such matters. If the Opposition Division approves the introduction of new facts or evidence and if the other parties have not had sufficient time to study them, it should, where easily comprehensible subject-matter is involved, grant the parties an opportunity of familiarising themselves with it, possibly by briefly interrupting the oral proceedings. If this is not feasible, the other parties must, upon request, be given the opportunity to comment in the proceedings subsequent to the oral proceedings, where appropriate in a further set of oral proceedings. Where possible, however, oral proceedings should not be adjourned. Where possible, legal commentaries, decisions (of a Board of Appeal, for example) and reports on legal decisions which are to be referred to in oral proceedings should be notified to the Opposition Division and the other parties in good time before the proceedings. They may, however, be quoted or submitted for the first time in the oral proceedings themselves if the Opposition Division agrees after consulting the parties.

As regards the costs which may be incurred for late submissions, see D-IX, 1.4.

## **8.7 Handwritten amendments in oral proceedings**

### **8.7.1 General principles**

*Rules 50(1) and 86*

The requirement of Rule 49(8) that the description, claims and abstract, as well as the request for grant, must be typed or printed in principle extends to documents replacing application documents and to amended patent specification documents (see also A-III, 3.2).

Responsibility for formally correct submissions and, in particular, for compliance with Rule 49(8) lies with the applicant/proprietor.

In examination, the formal requirement of Rule 49(8) applies to documents submitted during oral proceedings as well. Documents containing handwritten amendments will normally be accepted by the division as a basis for discussion during oral proceedings until agreement is reached on the final text of the patent. However, a final decision granting a patent may be taken only on the basis of documents which are formally compliant.

For opposition proceedings, two situations have to be distinguished:

- (i) In written proceedings, a final decision on the documents on the basis of which the patent is to be maintained may be taken only on the basis of formally compliant documents.
- (ii) For oral proceedings, Rule 82(2), third sentence (OJ EPO 2015, A82), provides for one exception to the principle that a decision determining the final text of the patent may be based only on formally compliant documents. Pursuant to this provision, in oral

opposition proceedings, the patent proprietor is by way of exception not required to file documents compliant with Rule 49(8) prior to the interlocutory decision on the documents on the basis of which the patent is to be maintained. He may choose to submit a formally compliant version of the amended text only within the time limit under Rule 82(2) (OJ EPO 2016, A22). The same applies *mutatis mutandis* to opposition appeal proceedings. The parties will nevertheless be encouraged to file documents compliant with Rule 49(8) during oral opposition proceedings.

It is noted that deletions, correction of the numbering of the figures and insertion of reference numbers and associated arrows in drawings are considered as typewritten amendments.

In order to assist the parties, including parties using their own laptops or other electronic devices, the EPO provides technical facilities that allow for compliance with the formal requirements, in particular computers equipped with a word processor and a printer, network printers and copiers enabling documents to be printed from a USB stick, and internet access in public areas via a public wireless network (see OJ EPO 2013, 603).

It is recommended that parties bring electronic copies of documents likely to be amended, on a medium free of computer viruses or malware.

Published patent applications and specifications are made available via the European publication server.

### **8.7.2 Procedure in examination proceedings**

If the applicant is unable to provide formally correct amendments during oral proceedings, the following applies:

- (a) If a decision to refuse a patent application is imminent and handwritten documents making up the application are on file, to avoid prolonging the proceedings the Examining Division should go ahead and issue the decision, based on substantive arguments. It may however mention this formal deficiency in the decision.
- (b) If there is agreed patentable subject-matter, the Examining Division should invite the applicant to file the submissions in typed or printed form within two months. Should the applicant fail to do so, the application is deemed to be withdrawn. If the amendments submitted differ from what was agreed in the oral proceedings, the procedure described in C-V, 4.7 applies.

### **8.7.3 Procedure in opposition proceedings**

If, in oral proceedings, the interlocutory decision of the Opposition Division was based on documents which do not comply with Rule 49(8), i.e. which contain handwritten amendments, the Opposition Division will invite the proprietor in the communication under Rule 82(2) to file a formally compliant version of the amended text. The invitation will specify the formally deficient amended paragraphs and/or claims for which

replacement paragraphs and/or claims need to be filed. The same applies where a decision of the boards of appeal remits the case to the department of first instance with the order to maintain the patent on the basis of amended documents with handwritten amendments.

In reply to the invitation of the Opposition Division under Rule 82(2) the proprietor will have to submit replacement paragraphs and/or claims which contain a formally compliant verbatim reproduction of the text as determined by the interlocutory decision (or the decision of the board of appeal). Any divergence between the text matter of the formally deficient paragraphs (and/or claims) specified in the invitation under Rule 82(2) and the text of the replacement paragraphs (and/or claims) will trigger a communication under Rule 82(3). A communication under Rule 82(3) will also be sent, if the proprietor does not reply at all or not in time, if the replacement paragraphs and/or claims are incomplete or if the replacement paragraphs and/or claims are again formally deficient.

If a formally compliant version of the verbatim text of the specified amended paragraphs (and/or claims) is not submitted within two months from the notification of the communication under Rule 82(3), the patent will be revoked.

#### **8.8 Use of Rule 137(4) for amendments filed during oral proceedings in examination**

A communication under Rule 137(4) should not be sent in respect of amendments filed during oral proceedings (see H-III, 2.1.3), since this would unduly delay the procedure. Making a request under Rule 137(4) during oral proceedings would have the consequence of staying the proceedings for one month, while waiting for the applicant's answer.

The Examining Division should therefore request the applicants to provide a basis for any amendments submitted during oral proceedings before any new amendments can be admitted into the proceedings.

In special cases, e.g. where there are many auxiliary requests which are difficult to check for compliance with the requirements of Art. 123(2) and the requests do not comply with Rule 137(4), the Examining Division may exercise its discretion by not admitting these requests under Rule 137(3) rather than raising an objection under Rule 137(4) (see H-II, 2.3 and H-III, 3.3.1.1).

#### **8.9 Discussion of the facts and of the legal position**

A discussion will be conducted with the party or parties concerning those technical or legal questions which are relevant to the decision and which, after the parties have made their submissions, do not appear to have been sufficiently clarified or discussed or are seemingly contradictory. Where necessary, it should be ensured that the party or parties file requests which are to the point and that the applicant or proprietor formulates the claims appropriately.

If the Examining Division finds that some patentable subject-matter results from a limitation or an amendment of the claims, it should inform the applicant of the fact and allow him an opportunity to submit amended claims based thereon.

If the competent department intends to depart from a previous legal assessment of the situation with which the parties are acquainted or from a prevailing legal opinion, or if facts or evidence already introduced into the proceedings are seen in a different light – e.g. during the deliberations of the Examining or Opposition Division (see E-II, 8.11) – so that the case takes a significant turn, the parties should be informed thereof.

#### **8.10 Right of the other members of the Division to put questions**

The Chairman must allow any member of the Examining or Opposition Division who so requests to put questions. He may determine at which point in the proceedings such questions may be put.

In oral proceedings, questions may be put to the parties in connection with their statements or the discussion of the facts or of the legal position. When evidence is taken as part of oral proceedings questions may also be put to the witnesses, parties and experts called. As regards the right of the parties to put questions, see E-III, 1.6.7.

#### **8.11 Closure of oral proceedings**

If the competent department considers that the matter has been sufficiently thoroughly discussed, it must decide on the subsequent procedure to be followed. Where the department consists of a number of members – as in the case of the Examining or Opposition Divisions – they must, if necessary, deliberate on the matter in the absence of the parties. If new aspects emerge during the discussion and require further questions to be put to the parties, the proceedings may be restarted. The person conducting the proceedings may thereafter give the decision of the department. Otherwise he should inform the party or parties of the subsequent procedure and then close the oral proceedings.

While the department is bound by the decision it issues on substantive matters (see E-II, 9), it is free, as a result of further reflection, to inform the parties that it intends to depart from the procedure which it has announced.

The subsequent procedure may, for example, consist in the department issuing a further communication, imposing certain requirements on one of the parties, or informing the parties that it intends to grant or maintain the patent in an amended form. As regards the delivery of a decision in the last case, see E-II, 9.

If the patent is to be granted or maintained in an amended form, it should be the aim to reach an agreement upon the final text in the oral proceedings. If, however, by way of exception the Examining or Opposition Division indicates during the oral proceedings that it would be willing to grant or maintain a European patent provided that certain amendments are made which could not reasonably have been foreseen from the earlier

procedure, the applicant or patent proprietor will be given a time limit of normally 2 to 4 months in which to submit such amendments. If the applicant or patent proprietor fails to do so, the application will be refused or the patent will be revoked.

#### **8.11.1 Requesting postponement during oral proceedings**

Oral proceedings in examination, limitation or opposition are intended to bring the proceedings to a close, and parties are expected to prepare themselves fully.

The Division should therefore normally refuse any request from a party that the proceedings be postponed or continued in writing.

Even if the description needs to be revised to bring it into conformity with amended claims, the applicant or proprietor should be expected to make the necessary changes either in the oral proceedings or during a break.

Continuing oral proceedings on a day other than the one set out in the summons requires a new summons according to Rule 115(1) to be issued unless all parties can agree to a shorter period of notice.

### **9. Delivery of the decision**

*Rule 111(1) and (2)*

The delivery of the decision will follow a statement by the person conducting the proceedings announcing the operative part of the decision (see also E-II, 8.11 and E-IX, 4).

The operative part may, for example, read as follows:

"The patent application ... is refused." or

"The opposition to the patent ... is rejected." or

"The patent ... is revoked." or

"Taking account of the amendments made by the proprietor in the opposition proceedings, the patent and the invention to which it relates satisfy the requirements of the Convention." or

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

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

Once a decision has been pronounced, submissions of the party or parties cannot be considered any longer and the decision stands, subject to the correction of errors in accordance with Rule 140. It may only be amended by appeal (see E-XI, 1, E-XI, 7 and E-XI, 8).

No pronouncement need be made at this point as to the reasons for the decision or the possibility of appeal. However, the Examining or Opposition Division may give a short explanation of the reasons for the decision.

Subsequently the decision in writing (see E-IX) containing the reasoning and information as to right of appeal must be notified to the parties without undue delay. The period for appeal will only begin to run from the date of notification of the written decision.

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

The division should further ensure that the result of oral proceedings in opposition is made available to the public online immediately after the hearing. If the patent is maintained on the basis of amendments filed during oral proceedings, these amendments should be made public as well.

## **10. Minutes of oral proceedings**

As regards the minutes of taking of evidence, see E-III, 1.7.

### **10.1 Formal requirements**

Minutes of oral proceedings must be drawn up.

*Rule 124(1)*

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

The minutes must be authenticated by the employee responsible for drawing them up and by the employee who conducted the oral proceedings, either by signature or by other appropriate means. They are not signed by the parties. The parties must be provided with a copy of the minutes. Copies must be notified to them as soon as possible after the oral proceedings.

*Rule 124(3) and (4)*

Provided the parties have been informed, oral proceedings may be recorded on sound recording apparatus. However, no person other than an EPO employee is allowed to introduce any such apparatus into the hearing room (see Notice of the Vice-Presidents of the Directorates-General 2 and 3 dated 25 February 1986 concerning sound recording devices in oral proceedings before the EPO, OJ EPO 1986, 63).

Sound-recordings should be made only in specific exceptional circumstances, for example if the Division expects

- (a) witness testimony

- (b) complex proceedings (e.g. because of the subject-matter or number of parties)
- (c) requests for amendments to the minutes because of the importance of the case.

The recording should be kept until the end of any possible proceedings. Copies of the recording will not be provided to the parties.

The minutes must first include the date of the proceedings, the names of the members of the department, e.g. the Opposition Division, present and the name or names of the minute-writer or writers. Minutes must also include the details referred to in E-II, 10.3.

### **10.2 Language**

The minutes are normally written in the language of the proceedings under Art. 14(3), i.e. the EPO official language in which the application was filed or into which it was translated. The exceptions are set out in Rule 4(6).

Amendments to the text of the description or claims of the application or patent must be recorded in the minutes in the language of the proceedings under Art. 14(3).

Where the exact wording is important, or if the parties so insist, the minutes must record the following, word for word, in the EPO official language actually used by the party or into which his statements were translated, as provided for in Rule 4(6):

- (a) requests of the parties
- (b) legally relevant statements by parties, witnesses, experts and division members, and
- (c) tenor of the decision.

For derogations from the language of proceedings see E-IV, 6.

### **10.3 Subject-matter of minutes**

*Rule 124(1)*

Minutes must contain the essentials of the oral proceedings and the relevant statements made by the parties, together with arguments relevant to the decision and not contained in the parties' written submissions. Details of the arguments raised by the parties, however, should be developed in the decision, and therefore should only be briefly reported in the minutes.

Relevant statements are, for example, new or amended procedural submissions or the withdrawal thereof, the fresh submission or amendment or withdrawal of application documents, such as claims, description and drawings, and statements of surrender.

The essentials of the oral proceedings include new statements by the party or parties and by the member or members of the department concerning

the subject-matter of the proceedings. In examination and opposition proceedings, the essentials are principally new statements arguing the presence or lack of novelty, inventive step and other patentability criteria. The minutes should not, however, be an exhaustive recollection of everything that was said during the oral proceedings. Rather, they should be limited to the essentials and be as brief and concise as possible.

Vague or general statements are to be avoided. Also, care must be taken to ensure that statements crucial to the decision are correctly recorded. Although this should normally not be necessary, in case of doubt the record of such statements should be read out to the parties concerned before the decision is taken and announced. If new facts or evidence are submitted during the oral proceedings, the minutes should make clear that the division has examined them under Art. 114(1). They should also indicate whether or not the Division, after having heard the parties, subsequently disregarded them under Art. 114(2).

The minutes should briefly summarise the following elements, where present:

- (a) arguments relevant for the decision as submitted by the parties, which, if they are already known from the written procedure, can be referred to as such,
- (b) the substance of any new requests by the parties, preferably in the form of a brief statement referring to documents containing these requests, which must be attached to the minutes, and
- (c) objections, arguments and/or requests to the parties voiced by a member of the Division, focusing on the points relevant for the decision which should be developed in the grounds for the decision.

The minutes should conclude by indicating the decision taken by the Division or, if no final decision is taken, the outcome of the proceedings. This part should be preceded by a record of the parties' final requests as indicated in point (b) above.

The minutes should also contain procedural information, such as how the proceedings are to be continued after closure of the oral proceedings.

If a decision is given, for the decision (see E-II, 9) must be reproduced in the minutes.

The minutes with the result reached during the proceedings are communicated to the parties as soon as possible.

#### **10.4 Request for correction of minutes**

If a party to oral proceedings considers the minutes thereof not to fulfil the requirements of Rule 124, it may file a request to that effect, with a proposed correction, as soon as possible after receipt of the minutes in question.

The Examining/Opposition Division is competent to decide upon the request (T 1198/97, T 68/02 and T 231/99). In response to a request for correction the Division will either issue corrected minutes of the oral proceedings or dispatch a communication stating that the minutes already contain the essentials of the oral proceedings and the relevant statements of the parties and give reasoning thereto (see T 819/96). The communication from the Division cannot on its own be subject to an appeal (T 1198/97 and T 1063/02).

It is at the discretion of the writer of the minutes (and of the chairman who authenticates them) to decide what is considered essential and relevant in the meaning of Rule 124(1) (T 212/97). The minutes should be corrected when they show deficiencies with regard to the aspects mentioned, for example if essential submissions or similarly important procedural statements are missing, or if they are incorrectly reflected in the minutes (T 231/99, T 642/97 and T 819/96).

## **11. Oral proceedings and interviews held by video-conference**

### **11.1 Requests for video-conferencing**

#### **11.1.1 Discretion regarding grant of requests for video-conferences**

Oral proceedings by video-conference are permitted only in the case of *ex parte* proceedings before an Examining Division. They are not allowed for opposition or PCT Chapter II cases or for the taking of oral evidence. Requests for them should be filed in the same way as other requests which are filed during pending proceedings. The request should specify which technology (ISDN or IP) the applicant intends to use.

The Examining Division should normally grant a request for oral proceedings by video-conference unless there are specific reasons for refusing it. Criteria for refusing are, for example, the unsuitability of the subject-matter of the application, the high complexity of the case, or the need to see or handle samples or models. The unavailability of video-conference rooms on the date set for the oral proceedings is also a reason for refusing the request.

If the Examining Division decides to refuse such a request, the requesting party must be informed in a communication setting out the reasons for the refusal. No appealable decision will be issued on the matter (OJ EPO 2012, 354). A purely systematic refusal, e.g. on the grounds that the video-conferencing system is not technically reliable, is not acceptable.

The request for holding an interview or oral proceedings as a video-conference should be filed as early as possible, preferably together with the request for an interview or oral proceedings. In case the request for oral proceedings by video-conference is made before the summons has been sent, the Division should exercise its discretion as stated above. If the subject-matter of the application is considered suitable for a video-conference, the Division should try to accommodate this wish when

finding a suitable date. If the request for a video-conference cannot be granted, the reasons will be indicated in the summons to oral proceedings.

The EPO also receives requests from applicants wishing to use the EPO video-conference facilities to hold proceedings at other EPO premises (e.g. when the applicant is in Munich and the proceedings are to be held in The Hague). The EPO video-conference facilities are for internal use only and such requests are to be refused with reference to OJ EPO 2012, 354, point 3.

#### **11.1.2 Status of oral proceedings held by video-conference**

Oral proceedings held by video-conference are equivalent to oral proceedings held in the traditional manner on the premises of the EPO. Consequently a request for further oral proceedings before the same department (whether by video-conference or in any other form) may be rejected where the parties and the subject of the proceedings are the same (Art. 116(1)). The applicant will therefore no longer be required to file a waiver declaration.

### **11.2 Preparations for the video-conference**

#### **11.2.1 Room reservations**

Rooms equipped for video-conferences are available at all locations. The formalities officer will take care of the room reservation as is the case for traditional oral proceedings.

For oral proceedings, the video-conference rooms should in principle be reserved for at least half a day. For interviews, a starting time and an estimated finishing time should be given.

It is important that the starting time and the video-conference dial-up number are communicated to the applicant by the formalities officer, as at the time arranged it is the applicant who dials the number to establish the video-conference link (the applicant making the request bears the transmission costs).

For interviews, the time at which the booking ends should also be communicated to the applicant.

#### **11.2.2 Document camera**

A document camera can be made available in each video-conference room. With this device a copy of the document is transferred to the party's monitor. No paper copy of the document is produced with this device. Experience has shown that parties prefer a hard copy of documents, so it is preferable to fax or e-mail documents to each other.

### **11.3 Submissions**

#### **11.3.1 Fax**

During the video-conference the participating party will be able to file submissions by fax. The examiner or Examining Division may in turn send

documents to the party in the same manner. A clean copy of these submissions will need to be resent if the quality does not ensure suitable reproduction.

A fax machine is available in each video-conference room.

### **11.3.2 E-mail**

Where interviews and oral proceedings before an Examining Division are held as a video-conference, documents filed subsequently as referred to in Rule 50 may be filed by e-mail (see Decision of the President of the EPO dated 20 April 2012 concerning the filing of documents by e-mail during interviews and oral proceedings held as a video-conference, OJ EPO 2012, 348). This does not apply to authorisations.

Where filed documents require signature, this signature may be applied to the attached document or to the text of the accompanying e-mail. The signature must take the form of a string of characters or of a facsimile signature. The string of characters which is selected by the signatory to provide evidence of his identity and of his intent to authenticate the message in question must clearly indicate the person's name and position. A facsimile signature must be the facsimile reproduction of the person's signature.

The documents are to be sent to the e-mail address indicated during the video-conference. Amended application documents are to be filed as attachments. Attachments containing these amended application documents must be in PDF format and must comply with the WIPO Standard for Filing and Processing in Electronic Form (Annex F). Where an attachment containing these amended application documents is not in PDF format or does not comply with the WIPO Standard or is illegible or incomplete, the Examining Division or the examiner must promptly inform the applicant during the video-conference. Where the deficiencies cannot be remedied during the video-conference or within the time limit set by the Examining Division, that document (or that part of the document which is illegible or incomplete) is deemed not to have been received.

Other attachments may be sent in any format which can be opened by the Examining Division or (in the case of an interview) the examiner and which can be reproduced in a legible form. Otherwise they are deemed not to have been filed.

No paper documents need be filed to confirm documents filed by e-mail, unless the applicant is invited to supply confirmation by the Examining Division or the examiner during the video-conference. In response to such an invitation, confirmation is to be supplied within a period of two months. If the applicant fails to comply with this invitation in due time, the documents are deemed not to have been received.

All submissions made by e-mail during a video-conference must be printed and annexed to the minutes of the interview or the oral proceedings, unless the exceptions under Rule 144 and the decision of the President of the

EPO dated 12 July 2007 concerning documents excluded from file inspection apply (see A-XI, 2.1 and Special edition No. 3, OJ EPO 2007, J.3). A confidentiality note which is routinely included in e-mails is not to be regarded as a request to exclude these submissions from the public file. It must be borne in mind that e-mail filing does not offer the same protection against access by third parties as, for instance, EPO Online Filing.

#### **11.4 Technical problems**

The video-conference will automatically start when the applicant dials in. If the video-conference does not start at the arranged time, the Examining Division should contact the representative or his office by telephone. If the representative cannot be contacted, or if the connection is not established for technical reasons, the video-conference should be terminated and new summons should be issued for conventional oral proceedings.

Where technical problems occur such that the oral proceedings held by video-conference cannot be conducted openly and fairly, for example due to a total or partial breakdown in communication, the right to be heard might possibly be violated (Art. 113(1)). The applicant, due to the technical problems, might be taken by surprise by the grounds mentioned in an adverse decision on which he has not had an opportunity to comment. In such cases it is advisable to terminate the video-conference and to issue new summons for conventional oral proceedings. It should be noted that the EPO will not attempt to re-establish the line in case of technical problems, but the applicant may be contacted by phone and asked to do so.

Under these circumstances, it is at the discretion of the Examining Division to decide whether the new summons would be for a further video-conference or for conventional oral proceedings.

#### **11.5 Checking the identity of the representative**

If the representative is not personally known to at least one member of the Examining Division, it is necessary to check his identity. This can be done by requesting the representative to show his ID card with the document camera or to fax a copy of it. For data protection reasons, the faxed copy of the ID card should not be included in the file.

#### **11.6 Recording of the video-conference**

The recording of oral proceedings by the parties is not permitted (see Notice of the Vice-Presidents Directorates-General 2 and 3 dated 25 February 1986 concerning sound recording devices in oral proceedings before the EPO, OJ EPO 1986, 63). At the beginning of the video-conference the Chairman should therefore remind the applicant or his representative that recording of the video-conference is prohibited (see also E-II, 10.1).



## Chapter III – Taking and conservation of evidence

### 1. Taking of evidence by the departments of the EPO

#### 1.1 General remarks

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

Art. 117  
Rule 117

#### 1.2 Means of evidence

The party or parties may at any time during proceedings submit evidence in support of alleged facts (see E-II, 5, E-IX, 1.2, D-IV, 5.3 and 5.4, and D-VI, 3). This should be done at the earliest opportunity. When such evidence is such as should have been put forward at an earlier stage it is for the competent department to consider whether it is expedient (see E-V, 2) to allow the new evidence to be introduced.

Art. 117(1)

It would generally be desirable for a party to produce evidence in respect of all the facts alleged in support of his case, in order, for example, to show whether a particular technique was generally known to industry or whether there was any prejudice against a particular technique.

Facts adduced by a party will, however, normally be deemed true, even without supporting evidence, if it is clear that no doubts exist concerning them, if they do not contradict one another or if no objection is raised. In such cases the facts need not be supported by evidence.

There will however be occasions, particularly in opposition proceedings, in which the arguments of the party or parties must be supported by evidence. This will for example be the case where reference is made to prior art, for instance in the form of an oral description, a use or perhaps a company publication and there is some doubt as to whether, and if so when, such prior art was made available to the public.

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

- production of documents;
- hearing the parties;
- hearing witnesses;
- sworn statements in writing;
- requests for information, for instance from a publisher concerning the date of publication of a book

- opinions by experts (see E-III, 1.8.1); and
- inspection.

The most appropriate way of obtaining evidence in the individual case depends on the facts which have to be proven and on the availability of the evidence. To prove prior use in an opposition, the opponent usually offers as evidence the production of documents, the hearing of witnesses or parties, or he presents sworn statements in writing. It is at the Opposition Division's discretion to evaluate this evidence, there being no fixed rules as to how any category of evidence should be judged (for the evaluation of evidence, see E-III, 4).

If the documents produced (e.g. patent documents) leave no doubt as to their contents and date of availability to the public and are more relevant for the patent in suit than other evidence offered, reasons of procedural efficiency may lead the Opposition Division to not pursue the other evidence at first.

If the testimony of a witness is offered, the Opposition Division may decide to hear this person in order to verify the facts for which this witness is brought forward, e.g. the prior use of the claimed product in an undertaking or the existence of an obligation to secrecy. For adequate substantiation the notice of opposition should make clear these facts, as witnesses are meant to serve for corroboration of facts brought forward, not for supplying these facts in place of the opponent. The above applies likewise to hearing the parties (see also E-III, 1.6).

The "sworn statements in writing" referred to in Art. 117(1)(g) are unknown in some national legal systems, which instead have their own instruments (see T 558/95).

Whether a written statement ("affidavit") is made under oath or not is only one of the criteria applied by the Opposition Division in its evaluation of the evidence adduced. Apart from its relevance for the case, other criteria are the relationship between the person making the statement and the parties to the proceedings, the personal interest of that person, the context in which the statement was made, etc. Such a statement does not go beyond its literal content and does not allow the Opposition Division to assess the associated or background factors. If the alleged facts are contested by the other party, the Opposition Division does not generally base its decision on such a statement, but summons the person making the statement as a witness, if so offered by the party. The ensuing hearing of the witness allows the Opposition Division and the parties to put questions to the witness and thus enables the Opposition Division to establish the facts on the basis of that person's testimony. If that person is not offered as a witness, the Opposition Division will not pursue this evidence further.

Inspection will enable direct observations to be made and direct impressions to be formed of the object or process concerned. It may, for example, involve the demonstration of a product or process requested by

the applicant or proprietor of the patent to substantiate the method of operation of the subject-matter of the patent where this is disputed by the Examining or Opposition Division.

Evidence in the form of documents normally stays on the file. Only exceptionally and on reasoned request can documents filed as evidence be returned unconsidered, e.g. if they were third-party statements filed in breach of a confidentiality agreement and the other parties agree to the request (see T 760/89).

### 1.3 Taking of evidence

The department responsible for the taking of evidence in the form of a hearing of witnesses, parties and experts will, in substantive examination and opposition proceedings, be the Division before which the taking of evidence as part of oral proceedings would normally take place. If evidence is to be taken, the Examining or Opposition Division will normally have been enlarged to include a legally qualified member. The Division may commission one of its members to examine the evidence adduced. Generally, he will be the primary examiner under Art. 18(2) or 19(2). A member may, for example, be commissioned pursuant to Rule 119(1), for the purposes of an inspection, such as in the form of a demonstration of a process or the investigation of an object, particularly in undertakings located far away.

*Art. 117(2)*

*Rules 118 to 120*

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

The language for taking evidence and writing the minutes is governed by Art. 14(3) (language of the proceedings) and Rule 4 (derogations from the provisions concerning the language of the proceedings in oral proceedings); see also E-II, 10.2 and E-IV.

### 1.4 Order to take evidence

Where the competent department of the EPO considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it must make a decision to this end (order to take evidence), setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation. If oral evidence of witnesses and experts is requested by a party but the witnesses and experts are not simultaneously named, the party is requested, either prior to the issue of the order to take evidence or in the order itself, to make known within a specified time limit the names and addresses of the witnesses and experts whom it wishes to be heard. The time limit to be computed in accordance with Rule 132(2) will be not less than two months and not more than four months, since the party concerned will normally know beforehand whom he wishes to be heard as a witness or expert.

*Rule 117*

The order to take evidence must be notified to the parties. It may be appealed only together with the final decision, unless it allows separate appeal (see E-IX, 6).

*Art. 119*

### 1.5 Summoning of parties, witnesses and experts

Art. 119

Rule 118(1) and (2)

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

Rule 118(2)(a)

(i) an extract from the order to take evidence, indicating in particular the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses and experts are to be heard;

Rule 118(2)(b)

(ii) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke (see E-III, 1.10); and

Rule 118(2)(c)

(iii) an indication that the party, witness or expert may request to be heard by the competent court of his country of residence and a requirement that he informs the EPO within a time limit to be fixed by the EPO whether he is prepared to appear before it (see E-III, 3.2.2 (iii) and (iv)).

Rule 119(3)

Even if evidence is not taken in oral proceedings, all parties to the proceedings may attend an investigation. Parties not summoned should be informed thereof within the period laid down in Rule 118(2), together with a statement that they may attend.

### 1.6 Hearing of parties, witnesses and experts

#### 1.6.1 General remarks

Where the Examining or Opposition Division holds hearings for the purpose of taking evidence (see E-III, 1.3) and if the case in question is expected to give rise to particular legal issues, it is advisable that the Division should be enlarged by the addition of a legally qualified examiner, if this is not already the case (see D-II, 2.2).

The evidence of witnesses is normally taken at oral proceedings.

The hearing will be either public or non-public, depending on the oral proceedings themselves (Art. 116(3) and (4)).

Where a hearing is held in connection with oral proceedings, the considerations set out in E-II, 8.2, 8.3, 8.9 and 8.10 are directly applicable, and where this is not the case they apply *mutatis mutandis*.

The hearing of an "expert" in the sense of Rule 117 requires as a precondition a decision to take evidence (see E-III, 1.4). This is different from hearing oral submissions by a person accompanying the representative during oral proceedings, which can be allowed at the discretion of the Division (see G 4/95 and E-II, 8.5).

### **1.6.2 Witnesses and experts not summoned**

After opening the proceedings for the taking of evidence, the official in charge of the taking of evidence, i.e. in substantive examination and opposition proceedings the Chairman of the Division concerned or the member commissioned for the taking of evidence, will determine whether any party requests that any other person present but not summoned should be heard. If a party makes such a request he should briefly state why and to what purpose the person concerned should give testimony. The department in question will then decide on whether or not to grant the request (for the admission of facts or evidence not filed in due time see E-V, 2).

### **1.6.3 Guidance to persons heard**

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

*Rule 119(2)*

### **1.6.4 Separate hearings**

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

### **1.6.5 Examination as to personal particulars**

The hearing will begin by the person giving evidence being asked his given names, family name, age, occupation and address. Witnesses and experts must also be asked whether they are related by blood or marriage with any of the parties and whether they have a material interest in a particular party being successful in the proceedings.

### **1.6.6 Examination as to *res gestae***

The examination as to personal particulars will be followed by the examination as to *res gestae*. The person testifying should be instructed to give a full and logical account of what he knows concerning the subject-matter of the hearing. Further questions may have to be put to clarify and supplement statements and to establish on what the knowledge of the person testifying is based. Such questions may be put by the member commissioned for the taking of evidence, where applicable, the Chairman or any other member of the department concerned. As regards the entitlement of other members of the Division to put questions, see E-II, 8.10. When formulating questions the same considerations apply as for the parties (see E-III, 1.6.7).

### **1.6.7 Entitlement of parties to put questions at hearings**

The parties may put relevant questions to the testifying parties, witnesses and experts including, e.g. in opposition proceedings, witnesses and experts testifying on behalf of other parties. The official in charge of the taking of evidence will determine at what point in the proceedings such questions may be put.

*Rule 119(3)*

Any doubts on the part of the competent department, e.g. the Opposition Division, or a party as to the admissibility of a question must be settled by the competent department. "Leading questions", i.e. questions which already contain the statement which one would like to hear from the witness, practically only requiring him to answer by "yes" or "no", should be avoided, because they do not allow to properly establish the witness' own recollection of the facts. Questions may further not be directed to facts which require no further discussion, which are in no way relevant to the subject-matter for which the taking of evidence has been ordered, or if they aim at establishing facts in respect of which no evidence has been offered. A decision to reject a question cannot be challenged. As regards the entitlement of other members of the Division to put questions, see E-II, 8.10.

### **1.7 Minutes of taking of evidence**

#### *Rule 124(1)*

Minutes of the taking of evidence must be drawn up as described in E-II, 10, subject to the following qualifications:

The minutes of the taking of evidence must, in addition to the essentials of the taking of evidence, also record as comprehensively as possible (almost verbatim as far as the essential points are concerned) the testimony of the parties, witnesses or experts.

#### *Rule 124(2)*

The minutes will normally be taken down by a member of the competent department carrying out the taking of evidence. The most efficient way of noting testimony is by way of dictation on to a dictating machine, in the process of which the person hearing the evidence will summarise the testimony in small sections, taking into account any objections raised by the person being heard, and dictate it in this form on to a dictating machine. If the dictated passage does not correspond in full to his testimony, the person being heard should raise any objections immediately. This should be pointed out to him at the beginning of his testimony. At the end of his testimony, he will be asked to approve the dictated minutes, which he will have listened to as they were dictated. His approval or any objections should be included in the dictated text. The dictated minutes are typed out and the parties are provided with a copy as soon as possible. It is not necessary to play back the minutes or to obtain approval of them if the testimony has been recorded verbatim and directly, using technical means.

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

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

### **1.8 Commissioning of experts**

#### **1.8.1 Decision on the form of the opinion**

#### *Rule 121(1)*

If the competent department decides of its own motion to obtain an expert opinion (D-VI, 1, 6th paragraph), it will have to decide in what form it should

be submitted by the expert whom it appoints. The opinion should be drawn up in written form only in cases where the competent department considers that this form is adequate in view of the content of the opinion and provided that the parties agree to this arrangement. As a rule, in addition to submitting a written opinion and introducing it orally, the expert will also be heard (see E-III, 1.6).

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

### **1.8.2 Objection to an expert**

The parties may object to an expert. Therefore, before commissioning an expert to make an opinion, the competent department should inform the parties of the expert whom it intends to ask to draw up an opinion and of the subject-matter of the opinion. The communication to the parties should state a time limit within which objections to the expert may be made. If the parties do object to an expert, the competent department will decide on the objection. *Rule 121(4)*

### **1.8.3 Terms of reference of the expert**

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

## **1.9 Costs arising from oral proceedings or taking of evidence**

As a rule, each party to proceedings before the EPO meets the costs he has incurred. This principle notwithstanding, the competent body in the opposition proceedings may for reasons of equity (see D-IX, 1.4) decide to apportion in some other way the costs arising for the parties in respect of oral proceedings or taking of evidence (see D-IX, 1) and the costs arising for the EPO in respect of witnesses and experts (see E-III, 1.10). The competent body may make the taking of evidence conditional upon deposit with the EPO by the party who requested the evidence to be taken of a sum the amount of which is to be fixed by reference to an estimate of the costs. This procedure should be applied where at the request of a party to grant or opposition proceedings evidence is to be taken by hearing witnesses or seeking an expert opinion, unless no costs will arise because the witness or expert has waived his right to indemnification. If the party requesting evidence to be taken does not comply with the requirement of making such a deposit, the evidence need not be taken. In opposition proceedings the party requesting the evidence bears the costs of indemnifying witnesses or experts, unless for reasons of equity in individual cases other arrangements are made for the apportionment of costs under Art. 104(1) in conjunction with Rule 88. Any shortfall between the deposit lodged and the amounts payable by the EPO under Rule 122(4), 2nd sentence, is fixed by the EPO of its own motion. Any unused amount of the deposit lodged is refunded. The EPO's internal costs arising through oral proceedings or taking of evidence, e.g. any associated staff travel and subsistence costs, are to be met by the EPO itself. *Art. 104(1) and (2)*  
*Rule 122(1) and (2)*

## **1.10 Entitlements of witnesses and experts**

### **1.10.1 Expenses for travel and subsistence**

*Rule 122(2)*

Witnesses and experts who are summoned by and appear before the EPO are entitled to appropriate reimbursement, by the EPO, of expenses for travel and subsistence (see E-III, 1.10.3). This applies even if the witnesses or experts are not heard, e.g. where evidence is to be produced concerning an alleged prior use and shortly before the taking of evidence such prior use is substantiated by a document already published. Witnesses and experts may be granted an advance on their expenses for travel and subsistence. Witnesses and experts who appear before the EPO without being summoned by it but are heard as witnesses or experts will also be entitled to appropriate reimbursement of expenses for travel and subsistence.

### **1.10.2 Loss of earnings, fees**

*Rule 122(3)*

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

### **1.10.3 Details of the entitlements of witnesses and experts**

*Rule 122(4)*

The Administrative Council of the European Patent Organisation has laid down the details governing the entitlements of witnesses and experts set out under E-III, 1.10.1 and 1.10.2, see document CA/D 5/77 (published in Supplement to OJ EPO 1/2010, 71). Payment of amounts due must be made by the EPO.

## **1.11 Models**

### **1.11.1 When may models be submitted?**

The EPC makes no express provision for the submission of models, but there is nothing to stop a party from submitting one himself. Models are not part of the application or patent, and therefore cannot be used to disclose the invention (Art. 83).

Models may be useful in EPO proceedings if they serve to substantiate the patentability of an invention, e.g. by showing that a given device actually works or does so particularly advantageously. Models may also be filed, e.g. in opposition proceedings, to illustrate the state of the art, especially prior use under Art. 54(2). Models as items for inspection therefore constitute evidence under Art. 117(1)(f).

### **1.11.2 Must the model be considered?**

The Division decides whether it needs to take evidence by inspection (Rule 117, first sentence), i.e. whether to consider the model at all.

Even if the Division does inspect the model, the EPO is not obliged to keep it. The party will keep the model, in his own interest, for subsequent proceedings.

### 1.11.3 Keeping the model

Thus practical considerations determine whether the EPO keeps a model if the party does not wish to do so. This decision is taken by the Division. However, models which would require special precautions or security measures if kept in the EPO must be returned at once. Generally, the EPO should keep models admitted as evidence only if they are crucial to the decision.

### 1.11.4 Procedure

On receipt, the model is sent to the primary examiner, who decides whether to keep it. Models useful in examination proceedings are likely to be useful for opposition proceedings too. They should therefore be kept until the opposition period expires or a final decision is taken on any opposition filed.

The formalities officer is responsible for implementing the decision to keep or return the model. If the model is to be kept, the formalities officer notes this on the label. If it is to be returned, the formalities officer informs the submitter accordingly and notes the date of return on the label.

### 1.12 Video recordings

A party to the proceedings may request that a video recording be shown at the oral proceedings. Such a request should include the recording as such as well as specifying the type of equipment needed.

If video recordings are submitted, the Division decides whether showing them will assist the proceedings. Video data carriers should always be kept if the Division has looked at them.

## 2. Conservation of evidence

### 2.1 Requirements

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

*Rule 123(1)*

### 2.2 Request for the conservation of evidence

The request for the conservation of evidence must contain:

*Rule 123(2)*

- (i) the name, address and nationality of the person filing the request and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 41(2)(c); *Rule 123(2)(a)*
- (ii) sufficient identification of the European patent application or European patent in question; *Rule 123(2)(b)*
- (iii) the designation of the facts in respect of which evidence is to be taken; *Rule 123(2)(c)*

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

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

### **2.3 Competence**

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

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

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

### **2.4 Decision on the request and the taking of evidence**

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

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

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

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

### **3.1 Legal co-operation**

*Art. 131(2)* Upon receipt of letters rogatory from the EPO, the courts or other competent authorities of Contracting States will undertake, on behalf of the EPO and within the limits of their jurisdiction, any necessary enquiries.

## 3.2 Means of giving or taking evidence

### 3.2.1 Taking of evidence on oath

The principal case where evidence is taken by a competent court will be the hearing of parties, witnesses or experts. In such instances the competent department may request the competent court to take the evidence on oath or in an equally binding form. *Rule 120(3)*

### 3.2.2 Evidence taken by a competent court

The competent department will, if necessary, request a competent court to take evidence, where appropriate under oath, where: *Rule 120(3)*

- (i) the taking of evidence by that department would entail disproportionately high travelling costs or the taking of evidence by the competent court appears to be appropriate on other grounds;
- (ii) the competent department considers it advisable for the evidence of a party, witness or expert it has heard to be re-examined under oath or in an equally binding form (see E-III, 3.2.1); *Rule 120(2)*
- (iii) there has been no reply to the summons by the expiry of a period fixed by the competent department in the summons (see E-III, 1.5(iii)); or *Rule 120(1)*
- (iv) a party, witness or expert who has been summoned before that department requests the latter in accordance with E-III, 1.5(iii), to allow his evidence to be heard by a competent court in his country of residence. If the party, witness or expert simply refuses to be heard by the responsible Division, he should be notified that the competent national court will have the relevant national legal possibilities to oblige him to appear and to testify. *Rule 120(1)*  
*Rule 150(3)*

## 3.3 Letters rogatory

The EPO must draw up letters rogatory in the language of the competent authority or must attach to such letters rogatory a translation into the language of that authority. *Rule 150(2)*

Letters rogatory should be addressed to the central authority designated by the Contracting State. *Rule 150(1)*

## 3.4 Procedures before the competent authority

The EPO must be informed of the time when, and the place where, the enquiry is to take place and must inform the parties, witnesses and experts concerned. *Rule 150(5)*

If so requested by the EPO, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority. Whether the parties may put questions or not will depend on the laws of the Contracting States concerned. *Rule 120(3)*  
*Rule 150(6)*

### **3.5 Costs of taking evidence**

*Rule 150(7)*

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

### **3.6 Taking of evidence by an appointed person**

*Rule 150(8)*

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

## **4. Evaluation of evidence**

### **4.1 General remarks**

The competent department must examine whether the conclusions drawn by the parties from the evidence and facts are correct and give grounds for the conclusions it itself freely arrives at on the basis of the situation as a whole.

The state of the art to be taken into consideration in individual cases for the purposes of Art. 54 is that laid down in G-IV, 1 to 5 and 7, and G-V.

The competent department is not obliged to take into consideration any facts or evidence not presented by the parties in due time, except within the limits specified in E-V, 2.

### **4.2 Types of evidence**

When evaluating submissions made, the difference between facts, evidence and arguments should be observed.

#### *Example:*

The opponent asserts that the preamble to claim 1 is described in document A, the characterising portion in document B (facts). To prove this, he submits the documents (evidence). He then contends that the method claimed does not involve an inventive step, because the skilled person, on the basis of his common general knowledge, would have combined them in such a way as to arrive at the subject-matter of claim 1 (argument).

Evidence admissible in EPO proceedings is not confined to that listed in Art. 117(1). "Taking of evidence" within the meaning of Art. 117 comprises the submission or gathering of evidence of any kind, particularly the filing of documents.

Pure arguments are not evidence (see T 642/92).

### **4.3 Examination of evidence**

When evidence is submitted, the first thing to establish is what fact is being asserted, and then whether that fact is relevant to the decision. If not, the assertion is no longer considered and the evidence is not examined further. If the alleged fact is relevant, the next point is whether it is proven by the evidence submitted.

When evidence is examined, since the EPC says nothing about how the outcome of taking of evidence should be assessed, the principle of unfettered consideration applies. This means that its content and its significance for the proceedings are assessed in the light of the particular circumstances of each individual case (e.g. time, place, type of evidence, position of witness in firm, etc.). The principle of unfettered consideration also means that EPO departments are empowered to evaluate evidence submitted by the parties in any appropriate manner, or indeed to disregard it as unimportant or irrelevant. In particular it has to be decided on a case-by-case basis when a particular piece of evidence is sufficient.

When deciding whether an alleged fact is accepted, the Division may use the criterion of the "balance of probabilities", which means that it is satisfied that one set of facts is more likely to be true than the other. Furthermore, the more serious the issue, the more convincing must be the evidence to support it (see T 750/94). For example, if a decision might result in revocation of the patent in a case concerning alleged prior use, the available evidence has to be very critically and strictly examined. In particular, in case of alleged prior use for which little if any evidence would be available to the patentee to establish that no prior use had taken place, the Division should cede to the stricter criterion close to absolute conviction, i.e. beyond any reasonable doubt (see T 97/94).

When parties make conflicting assertions, the Division must decide which evidence is the most convincing. If it cannot establish which allegation is right on the basis of the evidence put forward, it must decide on the basis of the burden of proof, i.e. against the party bearing that burden but unable to prove its point convincingly.

### **4.4 Asking for evidence**

When pointing out that it cannot accept a line of argument because certain facts have not been proven, the Division must do so as neutrally and objectively as possible. In particular, it may neither

- (a) require a specific kind of evidence (see T 474/04), nor
- (b) prescribe the content of the evidence (e.g. the wording of a sworn statement in writing (see T 804/92).

The taking of evidence in each of the forms listed in Art. 117 is done at the discretion of the EPO department in question, i.e. only if that department

considers it necessary. This will be the case, for example, if a fact relevant to the decision needs to be proven.

#### **4.5 Evaluation of the testimony of a witness**

After the witnesses have been heard, the party or parties must be given an opportunity of making observations. The observations may be made either in oral proceedings following the taking of evidence or exceptionally in writing after transmission of the minutes of the taking of evidence. The decision on this matter will rest with the competent department. The parties may file requests accordingly.

Only when this has been done should the competent department proceed to evaluate the evidence. Where a witness's testimony which is crucial to the decision has been challenged by a party but the department regards it as credible, or where a witness's oral or written testimony is disregarded in its decision as being not credible, the department concerned must state the grounds for its view in its decision.

In evaluating a witness's oral or written testimony, special attention should be paid to the following:

- (i) what is important is what a witness can relate concerning the points at issue on the basis of his own knowledge or views, and whether he has practical experience in the field in question. Second-hand assertions based on something heard from third parties are for the most part worthless on their own. It is also important from the point of view of the evaluation whether the witness was involved in the event himself or only knows of it as an observer or listener;
- (ii) in the event of long intervals of time (several years) between the event in question and the testimony, it should be borne in mind that most people's power of recall is limited without the support of documentary evidence;
- (iii) where testimony appears to conflict, the texts of the statements concerned should be closely compared with one another.

Apparent contradiction in the testimony of witnesses may sometimes be resolved in this way. For example, a close examination of apparently contradictory statements by witnesses as to whether a substance X was commonly used for a particular purpose may show that there is in fact no contradiction at all, in that while one witness was saying specifically that substance X was not used for that particular purpose, the other witness was saying no more than that substances like X, or a certain class of substances to which X belonged, were commonly used for this particular purpose without intending to make any statement regarding substance X itself;

- (iv) an employee of a party to the proceedings can be heard as a witness (see T 482/89). The possible partiality of a witness determines how

the evidence is assessed, not whether it is admissible (see T 443/93).

#### **4.6 Evaluation of the testimony of parties**

Oral or written evidence given by parties or their refusal to give evidence should be evaluated in the light of their special interest in the matter. Because of their special interest, the testimony of parties possibly should not be evaluated on the same level as that of neutral witnesses. This applies above all where parties have been present when witnesses have been heard and have ascertained the attitude of the competent department. The considerations set out in E-III, 4.5 (Evaluation of the testimony of a witness) apply *mutatis mutandis*.

#### **4.7 Evaluation of an expert opinion**

The competent department must examine whether the grounds on which an expert opinion is based are convincing. Notwithstanding its discretion in the evaluation of evidence, it may not disregard an expert opinion in the absence of grounds based on adequate specialist knowledge of its own or of another expert, irrespective of whether the latter expert is an independent expert commissioned under Rule 121 or an expert who testifies at the request of one of the parties.

#### **4.8 Evaluation of an inspection**

In the case of a demonstration, a specific test programme under specific conditions should be agreed in advance. During the demonstration itself care must be taken to ensure that the characteristics or conditions of operation claimed for the invention are complied with. Where an invention is compared under test with an item forming part of the state of the art, as far as possible the same or comparable test conditions must be applied to both.



## Chapter IV – Derogations from the language of the proceedings in oral proceedings

### 1. Use of an official language

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

*Rule 4(1) and (5)*

A party must be clear as to which official language it wishes to use. It then has a right to both speak and hear that language, as long as the conditions of Rule 4 have been fulfilled. The party does not, however, have a right to have one language in which it will speak and a different language in which it will hear (see T 774/05).

The language of the proceedings as defined in Art. 14(3) cannot be changed. This means that any amendments to the application or patent have to be filed in the language of the proceedings (Rule 3(2)).

If at all possible, the Division should try to manage without interpreters (this question normally arises only in opposition proceedings). The parties' summonses are therefore accompanied by information which encourages them to agree how this can be achieved.

It may be possible to agree to limit the interpreting to "one-way", i.e. from one language into another but not the other way round. If a comment made in one language has clearly been misunderstood, the Division should be prepared to clarify it in another. Under no circumstances however should its members officially act as interpreters.

### 2. Language of a Contracting State or other language

Any party may likewise use one of the official languages of the Contracting States, other than English, French or German, on condition that he makes provision for interpreting into the language of the proceedings. However, if the parties and the EPO agree, any language may be used in oral proceedings without interpreting or prior notice.

*Rule 4(1) and (4)*

### 3. Exceptions from sections 1 and 2

Derogations from the provisions of Rule 4(1) are permitted, and these are at the discretion of the EPO. Clearly such permission must depend on the circumstances of the individual case. It may, for example, be envisaged that a party is unable to give one month's notice through no fault of his own, and, although he has made arrangements for an interpreter, the latter is unable (e.g. through illness) to attend. If, in such circumstances, the EPO is unable to provide for interpreting, it should postpone the oral proceedings if they occur at the examination stage. However, in opposition proceedings, the oral proceedings should continue if the parties agree and the

*Rule 4(1)*

employees of the EPO involved in the proceedings can cope with the language. In other cases, the EPO should postpone the oral proceedings and any costs incurred by the innocent party as a result of the postponement should be a matter for apportionment under Art. 104.

#### **4. Language used in the taking of evidence**

*Rule 4(3)*

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

#### **5. Language used by employees of the EPO**

*Rule 4(2)*

Employees of the EPO may use any one of English, French or German in the course of all oral proceedings. If, prior to the commencement of oral proceedings, an employee is aware that he may need to use a language other than the language of the proceedings, he should ensure that the parties involved are informed of his intention. However, employees should not depart from the language of the proceedings without good reason, and unless the parties involved are competent in the language used and express no objection, the EPO should provide for interpreting into the language of the proceedings at its own expense.

#### **6. Language used in the minutes**

Where the official language actually employed in oral proceedings is not the language of the proceedings as defined in Art. 14(3), if the Examining or Opposition Division considers it appropriate and subject to explicit agreement of all parties concerned, the minutes may be recorded in the language actually employed in the oral proceedings.

Prior to the agreement of the parties, their attention should be drawn to the fact that the EPO will not provide translations of the minutes into the language of the proceedings as defined in Art. 14(3). This condition, as well as the declaration of agreement of the party or parties, should be recorded in the minutes.

Statements made in English, French or German are entered in the minutes of the proceedings in the language employed.

Statements made in any other language must be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent made during oral proceedings must be entered in the minutes in the language of the proceedings. If the proceedings are conducted in a language other than English, French or German and no interpretation is

effected, statements should be entered in the minutes in the language employed and the EPO should subsequently provide in the minutes a translation into the language of the proceedings.



## **Chapter V – Examination by the EPO of its own motion; facts, evidence or grounds not submitted in due time; observations by third parties**

### **1. Examination by the EPO of its own motion**

#### **1.1 General remarks**

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

*Art. 114(1)*

#### **1.2 Limits on the obligation to undertake examination**

However, the obligation to undertake such examination should be kept within limits in the interests of procedural expediency. For example, in opposition proceedings, an offer to prove that an alleged public prior use took place should not be taken up if the opponent making such an allegation has ceased to participate in the proceedings and the necessary evidence cannot be easily obtained at a reasonable cost.

The unity of the subject-matter of the European patent is not to be examined in opposition proceedings (G 1/91, see D-V, 2.2).

### **2. Late filed submissions**

(Where submissions of the parties are filed late in respect of the date indicated in the note to the summons to oral proceedings pursuant to Rule 116(1), refer primarily to E-II, 8.6.)

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

*Art. 114(2)*

This also applies to grounds for opposition not submitted in due time, together with supporting facts and evidence in opposition proceedings (see D-V, 2.2). Note in this respect that according to G 1/95 and G 7/95, Art. 100(a) does not constitute one single ground for opposition, but has to be considered a collection of individual grounds for opposition, i.e. individual legal bases for objection to the maintenance of a patent.

This applies not only to distinctly different objections, such as subject-matter which is not patentable (Art. 52(2)) as compared to subject-matter which is not capable of industrial application (Art. 57), but also to an objection for lack of novelty as opposed to an objection for lack of inventive step.

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

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

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

The above applies in written proceedings; in oral proceedings submissions can only be considered up to the pronouncement of the decision (see E-II, 9).

## 2.1 General examples in opposition proceedings

As far as the assessment of late filing in opposition proceedings is concerned, the rulings of the Enlarged Board of Appeal in G 9/91 and G 10/91 apply. According to these decisions, in principle, the opposition is to be examined to the extent and on the grounds submitted during the period for opposition. Under Art. 114(1) the Opposition Division may go beyond this framework if *prima facie* maintenance of the patent is prejudiced. The principles developed by the Enlarged Board with respect to new grounds also apply to late-filed facts and evidence (see T 1002/92). Therefore late-filed facts and evidence are to be admitted into the proceedings only if they are *prima facie* relevant, i.e. if they would change the envisaged decision, see E-V, 2.

If a patent proprietor replies to a notice of opposition by amending the patent, such a request for amendment cannot be considered as late-filed and has to be admitted into the proceedings (Rule 79(1)).

Thus, if the proprietor limits the patent to the subject-matter of a dependent claim as granted, new facts and evidence submitted by the opponent in reply to this amendment should as a general rule be treated as late-filed and only be admitted under Art. 114(1) if they are *prima facie* relevant because the opponent should have been prepared for this type of amendment and should have provided material during the nine-month opposition period.

If the new facts and submissions are not *prima facie* relevant, they should be disregarded under Art. 114(2). An exception to this rule would be where the patent specification as granted contained a large number of dependent claims and the opponent could not reasonably have been expected to deal with all of them in the notice of opposition.

If, however, the proprietor amends the patent at an early stage of the proceedings in a manner not foreseeable by the opponent, e.g. by taking up features disclosed in the description, the opponent should have the opportunity to provide new facts and evidence, i.e. possibly even to submit a new ground for opposition and new documents. Such a submission would have to be admitted into the proceedings because the subject of the proceedings has changed. At a late stage in the proceedings such unforeseeable amendments would be subject to the criterion of "clear allowability" (see H-II, 2.7.1).

## 2.2 Examples concerning oral proceedings in opposition procedure

If oral proceedings are arranged, the Opposition Division issues a summons together with an annex drawing attention to the points to be discussed (Rule 116(1)) and normally containing the Division's provisional and non-binding opinion (see D-VI, 3.2). The following situations may arise:

- (a) The Division should admit new facts and evidence only if they are *prima facie* relevant. Furthermore, if new facts and evidence are admitted under Art. 114(1) because they are *prima facie* relevant, a request of the proprietor for corresponding amendment would have to be admitted even if submitted after the above final date, because the subject of the proceedings has changed.

It should however be noted that if in the provisional and non-binding opinion the Division reaches the conclusion that maintenance of the patent is not prejudiced by the facts and evidence submitted so far by the opponent, this fact *per se* does not give the opponent the right to have new facts and evidence admitted into the proceedings, even if submitted before the final date fixed under Rule 116(1).

If during the oral proceedings the Opposition Division, contrary to its provisional opinion set out in the annex to the summons, reaches the conclusion that the patent should be revoked, a request of the

proprietor for (further) amendment should be admitted into the proceedings (see E-II, 8.6).

- (b) If the Opposition Division states in the annex to the summons that the patent is likely to be revoked, requests for amendment should be admitted if they are filed before the final date fixed under Rule 116. If such requests relate to subject-matter not covered by the claims as granted, the subject of the proceedings has changed. Consequently new facts and evidence submitted by the opponent in response to these requests should be admitted into the proceedings, even if they arrive after the final date set under Rule 116.

However, if the proprietor's requests relate to amendments based only on claims as granted and are reasonable in number, new facts and evidence submitted by the opponent should be treated as late-filed even if submitted before the final date, i.e. they should be admitted only if they are *prima facie* relevant. Relevant facts and evidence submitted at a late stage of the proceedings, possibly not until the oral proceedings for example, could give rise to a decision on apportionment of costs, see D-IX, 1.2, if so requested by the proprietor.

- (c) If the Opposition Division states in the annex to the summons that the patent is likely to be revoked, and the proprietor in response submits amendments after the final date set under Rule 116(1), possibly not until the oral proceedings, the Division could, in principle, treat such requests as late-filed and apply the criterion of "clear allowability" (see H-II, 2.7.1) in judging whether they should be admitted into the proceedings. However, the Division should consider admitting such requests into the proceedings if they relate to the subject-matter of dependent claims as granted.

It may only become apparent in the oral proceedings that the pending request submitted to overcome grounds for opposition is not allowable under the EPC. The opponent should always expect to have to discuss subject-matter based on dependent claims as granted if they are reasonable in number.

However, if late-filed requests are based on subject-matter not previously covered by the claims, they will normally not be admitted into the proceedings also for reasons of procedural efficiency. Admission of such requests could give rise to a postponement of oral proceedings, and to a decision on apportionment of costs.

### 3. Observations by third parties

Following publication of the European patent application under Art. 93, any person may present observations concerning the patentability of the invention. Although lack of novelty and/or inventive step are the most common observations, third-party observations may also be directed to clarity (Art. 84), sufficiency of disclosure (Art. 83), patentability

Art. 115

Rule 114(1)

(Art. 52(2) and (3), 53 or 57) and unallowable amendments (Art. 76(1), 123(2)).

Such observations must be filed in writing in English, French or German and must include a statement of the grounds on which they are based. The person filing them may not be a party to the proceedings before the EPO. The web interface provided by the EPO is the preferred means of filing such observations (see OJ EPO 2011, 418 and 420).

Documentary evidence and, in particular, publications submitted in support of the arguments may be filed in any language. However, the EPO may request that a translation into one of its official languages be filed within a period to be specified; otherwise the evidence will be disregarded. *Rule 3(3)*

Although the third party is sent acknowledgment of the receipt of his observations (if these were not filed anonymously), the EPO does not specifically inform him of any further action it takes in response to them. However, the outcome of the evaluation by the competent Division will briefly be indicated in the respective office action from the EPO (e.g. in a communication or in the intention to grant) and will thus be visible to the public.

The EPO will make every effort to issue the next office action within three months of receipt of third-party observations under Art. 115 by the Examining Division, provided the observations are substantiated and have not been filed anonymously.

The observations are communicated to the applicant or proprietor without delay and he may comment on them. If they call into question the patentability of the invention in whole or in part, they must be taken into account in any proceedings pending before a department of the EPO until such proceedings have been terminated. If the observations relate to alleged prior art available other than from a document, e.g. from use, this should be taken into account only if the alleged facts either are not disputed by the applicant or proprietor or are established beyond reasonable doubt. Observations by third parties received after the decision to grant/refuse the application has been pronounced in oral proceedings or issued in written proceedings (see G 12/91) will be included in the file without taking note of their content. Observations by third parties received once proceedings are no longer pending (e.g. after publication of the mention of the grant) will be neither taken into account nor made available for file inspection. They will however be made available for file inspection upon the start of opposition proceedings. *Rule 114(2)*

The EPO will generally apply the practice regarding third-party observations filed in the Euro-direct procedure *mutatis mutandis* to third-party observations filed during the international phase upon entry of the Euro-PCT application into the European phase.



## Chapter VI – Interruption and stay of the proceedings

### 1. Interruption

#### 1.1 Cases in which the proceedings may be interrupted

Pursuant to Rule 142(1), proceedings before the EPO are interrupted in one of the following events: *Rule 142(1)*

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

In principle, the EPO interrupts proceedings pursuant to Rule 142 ex officio. In the case of Rule 142(1)(a) last sentence, however, proceedings are interrupted on request only.

#### 1.2 Responsible department

The Legal Division of the EPO bears sole responsibility for the interruption and resumption of proceedings under Rule 142 (Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). *Art. 20*

#### 1.3 Date of interruption

An interruption is registered (in general retroactively) with legal effect from the date of the occurrence of the event. In cases where proceedings are interrupted on request, the interruption is effected as from the date of receipt of the request at the EPO.

The parties are informed of the interruption of proceedings and the reasons for it. The date of interruption as well as the date of resumption of proceedings are recorded in the European Patent Register. *Rule 143(1)(t)*

#### 1.4 Resumption of proceedings

When, in the cases referred to in Rule 142(1)(a) or (b), the EPO has been informed of the identity of the person authorised to continue the proceedings before the EPO, it notifies that person and, where applicable, any third party, that the proceedings will be resumed as from a specified *Rule 142(2)*

date. The date should be set in such a manner as to allow this person to familiarise himself with the matter.

Communications and decisions of the EPO which have been notified during the interruption period are to be regarded as null and void and will be notified anew after resumption of proceedings by the responsible department.

*Rule 142(3)*

In the case referred to in Rule 142(1)(c), the proceedings will be resumed when the EPO has been informed of the appointment of a new representative of the applicant or when the EPO has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, the EPO has not been informed of the appointment of a new representative within a period of three months after the beginning of the interruption of the proceedings, it communicates to the applicant for or proprietor of the patent:

*Rule 142(3)(a)*

(i) where Art. 133(2) (mandatory appointment of a representative) is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified; or

*Rule 142(3)(b)*

(ii) where Art. 133(2) is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

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

### **1.5 Resumption of time limits**

*Rule 142(4)*

Time limits in force on the date of interruption of the proceedings begin again, in their original length, as from the day on which the proceedings are resumed, with the exception of the time limits for requesting examination and for paying renewal fees.

If the time limit for filing the request for examination is in force on the date of interruption of the proceedings, it is suspended (J 7/83; see also E-VII, 1.4). Thereafter it resumes for the time it still has to run, or for at least the two months prescribed by Rule 142(4), second sentence.

Concerning renewal fees falling due during the period of interruption, Rule 142(4) has to be interpreted as deferring the due date for their payment until the date the proceedings are resumed (J 902/87). If the time limit for paying renewal fees with the additional fee referred to in Rule 51(2) is in force on the date of interruption of the proceedings, it is suspended and begins to run again for the remaining period on the date of resumption.

### **2. Stay of proceedings under Rule 14 due to pending national entitlement proceedings**

*Rule 14(1)*

If a third party provides evidence that he has instituted proceedings against the applicant seeking a decision within the meaning of Art. 61(1), the proceedings for grant are stayed unless the third party communicates to the

EPO in writing his consent to the continuation of proceedings. This consent is irrevocable. For further details see A-IV, 2.2 and sub-sections, and D-VII, 4.1.

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

Where a referral to the Enlarged Board of Appeal is pending and the outcome of examination or opposition proceedings depends entirely on the answer to the questions referred to the Enlarged Board of Appeal, the proceedings may be stayed by the Examining or Opposition Division on its own initiative or on request of a party or the parties.

The party/ies will be informed of the intention to stay the proceedings. If no reply is received from the party/ies with regard to the intention to stay, or if the party/ies explicitly agree(s), the proceedings will be stayed automatically. If the party/ies do(es) not agree in writing with the intention to stay, but the Examining or Opposition Division maintains its opinion, a decision to stay will be dispatched.

During the stay of proceedings, a PACE request will have no effect. After their resumption, proceedings are again accelerated. Where the proceedings are not stayed, they will be decided according to existing practice.

A stay of proceedings due to dependency on a referral to the Enlarged Board of Appeal is to be distinguished from a stay of proceedings pursuant to Rule 14 (see E-VI, 2).



## Chapter VII – Time limits, loss of rights, further and accelerated processing and re-establishment of rights

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

#### 1.1 Determination of time limits

The EPC imposes time limits upon parties to proceedings. In the EPC, a "time limit" is a period of time of defined duration, calculated in full years, months, weeks or days, by reference to a relevant event (J 18/04), within which an act vis-à-vis the EPO has to be completed.

*Art. 120  
Rule 131*

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

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

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

#### 1.2 Duration of the periods to be specified by the EPO on the basis of EPC provisions

The length of such periods should be based, in principle, on the amount of work which is likely to be required to perform the operation in question. However, in order to facilitate the work of parties and the EPO it has been decided, as a general rule, to adopt a uniform practice with respect to time limits. This practice is at present as follows:

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

Where a communication according to Art. 94(3) in examination is accompanied by a request for a translation of a priority document (Rule 53(3)), the period set for reply to that communication and for providing the translation is the same and is at least four months, regardless of the severity of the objections raised in the communication according to Art. 94(3) (see also A-III, 6.8.2).

*Rule 70(2)*

A longer time limit of up to six months should be set only in the exceptional cases where it is clear that in the circumstances a four-month time limit cannot be adhered to. Each case must be judged on its individual merits and it is difficult to give general guidance, but a six-month time limit might be justified if for example the subject-matter of the application or patent or the objections raised are exceptionally complicated. Note that in this case an extension of the time limit (i.e. beyond six months) will be allowed only in exceptional cases (E-VII, 1.6). Where the applicant is invited to submit the indication provided for in Rule 70(2), a six-month time limit running from the publication of the search report is appropriate.

### **1.3 Time limits which may be freely determined**

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

### **1.4 Calculation of time limits**

*Rule 131*  
*Rules 126, 127*  
*Rule 134*

Although Rule 131 allows other possibilities, any period fixed by the EPO will usually be specified in full months which will be calculated from the receipt of the communication by the person to whom it is addressed (see Rule 126(2)). Rule 131 gives precise details for the determination of the day of expiry of the period, whilst Rule 134 contains provisions covering certain contingencies, e.g. that the EPO is not open on the day on which a time limit expires, or that there is a general disruption in the postal facilities between the EPO and a Contracting State.

*Rule 142*

When proceedings have been interrupted because of the death of the applicant or proprietor or for any of the other reasons specified in Rule 142, time limits are subject to the provisions of Rule 142(4). The time limits for the payment of the examination fee and the renewal fees are suspended (see J 7/83).

### **1.5 Effect of change in priority date**

*Art. 88(2)*

Certain time limits run from the date of priority, or in the case of multiple priorities, from the earliest date of priority. Where this date no longer applies (e.g. the right of priority is lost in accordance with the provisions of Art. 90(5)), any such time limits become determinable from the amended date of priority. This does not restore any loss of rights resulting from a time limit having already expired before the loss of priority date. Part A of the Guidelines deals with the procedure to be followed (see A-III, 6.9 to 6.11).

## 1.6 Extension of a time limit

Apart from the automatic extension of time limits under Rule 134 (see E-VII, 1.4) and cases in respect of which the EPC specifies a fixed period which may not be extended, the duration of time limits may be extended, but the request must be submitted in writing before expiry of the period that has been set. The extended period is to be calculated from the start of the original period. No written confirmation is required for requests for extension of time limits filed by fax. For any communication raising a matter of substance, a request for extension, even if filed without reasons, should normally be allowed if the total period set does not thereby exceed six months. A short time limit for correcting a mere formal or minor deficiency should be extended under the same circumstances by two months. However, a request for a longer extension, especially if the total period set exceeds six months, should be allowed only exceptionally, when the reasons given are sufficient to show convincingly that a reply in the period previously laid down will not be possible. Such exceptional circumstances might be e.g. the fact that a representative or client is so seriously ill that he cannot deal with the case in time; or the need to perform extensive biological experiments or tests. On the other hand, foreseeable or avoidable circumstances (e.g. leave, pressure of other work) should not be accepted as a sufficiently exceptional circumstance (see Notice of the Vice-President of Directorate-General 2 of the EPO, OJ EPO 1989, 180).

*Rule 132*

In opposition proceedings, requests to extend time limits over and above the normal period of four months for communications from an Opposition Division raising matters of substance or two months for other communications (GL E-VII, 1.2), will only be granted in exceptional, duly substantiated cases.

For a communication under Art. 101(1) and Rule 79 or 81(2) and (3) all parties to the proceedings can request an extension, irrespective of whether they were invited in the communication to reply: if the extension is exceptionally granted to one of the parties, it automatically applies to all other parties.

If the request for an extension is granted, the party should be informed of the new time limit. Otherwise, he should be told that the relevant sanction has taken effect or will take effect.

An application will be removed from the PACE programme (see E-VII, 4), if the applicant has requested an extension of time limits (OJ EPO 2015, A93, point A.4).

In examination proceedings, failure to respond to a communication according to Art. 94(3) results in deemed withdrawal of the application (see E-VII, 1.8 and 1.9.2).

The failure of a party to reply to a communication from the Opposition Division within the period set does not lead directly to any legal consequence. However, the opposition proceedings will proceed to the next stage, and this could be a decision under Art. 101(2) or Art. 101(3).

*Art. 106(2)*

If the request for extension of a time limit filed in good time has been rejected and the applicant considers this unjust, he can only overcome the ensuing loss of rights by requesting further processing under Art. 121(1) and Rule 135(1). At the same time, he may request reimbursement of the fee for further processing. A decision rejecting the request for reimbursement is open to appeal, either together with the final decision or separately, as the case may be (see J 37/89).

*Rule 133(1)*

### **1.7 Late receipt of documents**

If a document received late was posted or delivered to one of the postal service providers recognised by the President of the EPO (Chronopost, DHL, Federal Express, flexpress, TNT, SkyNet, UPS and Transworld) at least five days before expiry of the time limit and was received no later than three months after expiry of the time limit, it will be deemed to have been received in due time under Rule 133 (see Decision of the President of the EPO dated 11 March 2015, OJ EPO 2015, A29). This legal fiction applies to all time limits to be observed vis-à-vis the EPO and/or the national authorities, including the priority period laid down in Art. 87(1). The document must have been sent as a registered letter or in a form of consignment corresponding to registration and, if posted outside Europe, by airmail. Within the meaning of Rule 133, a document is deemed to have been posted or delivered to a delivery service within Europe if it was despatched in one of the states belonging to the European Conference of Postal and Telecommunications Administrations (CEPT) (in addition to the EPC Contracting States these are the states listed below) or in a state which is generally understood to be part of Europe. At the request of the EPO, confirmation of registration by the post office or of receipt by the delivery service must be provided as evidence that the document was posted in due time. Despite this legal fiction that the time limit has been observed, the filing date of the document remains the day on which it was actually received.

The following non-Contracting States belong to the CEPT (updated 1 November 2012):

Andorra, Azerbaijan, Belarus, Bosnia and Herzegovina, Georgia, Moldova, Montenegro, Russian Federation, Ukraine and Vatican.

### **1.8 Failure to respond within a time limit**

If a party has not acted within a time limit, various sanctions may be applied depending on the circumstances. For instance, under Art. 90(2) and Rule 55 the application will not be proceeded with; under Art. 90(5) the application will be refused or a right of priority lost; under Rule 5 a document may be deemed not to have been received. If the request for examination has not been filed in time, the application is deemed to be withdrawn (Art. 94(2)), and this sanction may also apply in those cases where the applicant fails to meet a time limit set by the EPO (e.g. the time limit for replying to an invitation to amend under Art. 94(3)).

If a particular time limit is not complied with and, in contrast to cases where mandatory legal sanctions are laid down (e.g. revocation of the European

patent if the publishing fee is not paid in due time (Rule 82(3)), no specific legal sanction is laid down in the EPC, submissions and requests from the parties made after expiry of the time limit but before a decision is handed over to the EPO's internal postal service for transmittal to the parties are to be regarded in the rest of the proceedings as if they had been received in time (see G 12/91); any facts or evidence are, however, to be treated as not filed in due time (Art. 114(2), see also E-V, 1.2).

## **1.9 Loss of rights**

### **1.9.1 Cases of loss of rights**

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

*Rule 112*

### **1.9.2 Noting and communication of loss of rights**

If there has been a loss of any right as described in E-VII, 1.9.1, a formalities officer will note such loss of rights and communicate this to the person concerned. The communication will be notified to the person concerned as a matter of course (see also D-IV, 1.4.1).

*Art. 119*

*Rule 112(1)*

### **1.9.3 Decision on loss of rights**

If the person concerned considers that the finding of the EPO is inaccurate, he may, within two months after notification of the communication, apply for a decision on the matter by the EPO.

*Rule 112(2)*

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

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

## **2. Further processing**

If the European patent application is to be refused or is refused or deemed to be withdrawn following failure to reply within a time limit vis-à-vis the EPO, the application is allowed to proceed if the applicant makes a request for further processing of the application. Further processing must be requested by payment of the prescribed fee within two months of the communication concerning either the failure to observe a time limit or a loss of rights. The omitted act must be completed within the period for making

*Art. 121(1) and (2)*

*Rule 135(1) and (3)*

the request. The request is not deemed to have been filed until this fee has been paid.

A request for further processing may also be filed between expiry of the unobserved time limit and notification of the communication concerning either the failure to observe a time limit or a loss of rights.

The department competent to decide on the omitted act also decides on the request for further processing.

A mere request for oral proceedings is not to be seen as completion of the omitted act and therefore cannot lead to further processing being granted (B-XI, 8).

*Rule 135(2)*

As a general rule, further processing is the legal remedy for failure to observe a time limit during proceedings before grant, even where the consequence is a partial loss of rights (e.g. loss of priority right). However, the possibility of requesting further processing is ruled out for the periods referred to in Art. 121(4) and Rules 6(1), 16(1)(a), 31(2), 36(2), 40(3), 51(2) to (5), 52(2) and (3), 55, 56, 58, 59, 62a, 63, 64, 112(2) and 164(1) and (2).

### **3. Re-establishment of rights**

*Art. 122(1)*

An applicant for or proprietor of a European patent who, despite taking all due care required by the circumstances, was unable to observe a time limit vis-à-vis the EPO may apply to have his rights re-established.

#### **3.1 Admissibility of the request**

##### **3.1.1 Time limits covered**

*Art. 122(1)*

Failure to observe the time limit must have the direct consequence of causing the refusal of the European patent application or of a request, or the deeming of the European patent application to have been withdrawn, or the revocation of the European patent, or the loss of any other right or means of redress. This means, for example, that in opposition proceedings there can be no re-establishment of rights in respect of the time limits for the patent proprietor's submission of his observations on the written statements of the other parties to the proceedings or on communications from the Opposition Division. Likewise, there can be no re-establishment of rights in case of failure to observe the time limit for the payment of the renewal fees under Rule 51(1) as valid payment is still possible under Rule 51(2).

*Art. 122(4)*

*Rule 136(3)*

Re-establishment of rights is ruled out in respect of all periods for which further processing is available and in respect of the period for requesting re-establishment of rights. This means that re-establishment of rights comes into play where further processing is excluded in respect of a specific period or where the time limit for requesting further processing has expired. In the latter case, re-establishment of rights is to be requested in respect of the time limit for requesting further processing (see E-VII, 2), and not in respect of the originally missed time limit.

A “time limit” is taken to mean a specific period of time within which an act vis-à-vis the EPO must be completed (see E-VII, 1.1). Re-establishment of rights is therefore not admissible e.g. in respect of failure to be present on the date of appointed oral proceedings.

*Rule 131(1)*

The following are examples of cases where re-establishment of rights may be requested. They concern the time limits for:

- payment of a renewal fee plus additional fee; *Rule 51(2)*
- requesting further processing in respect of the time limit for replying to a communication from the Examining Division under Art. 94(3); *Rule 135(1)*
- filing the translation of any amended claims in opposition proceedings; *Rule 82(2)*
- filing the request for a decision by the Opposition Division on the awarding of costs; *Rule 88(2)*
- filing notice of appeal; and *Art. 108*
- filing a petition for review by the Enlarged Board of Appeal. *Art. 112a(4)*

### 3.1.2 Entitlement to file the request

The wording of Article 122(1) implies that re-establishment of rights is available only to applicants and proprietors. Therefore, opponents are in principle not entitled to request re-establishment of rights, e.g. in respect of the time limit for filing an appeal (see T 210/89). However, an opponent who has filed an appeal can request re-establishment of rights in respect of the time limit for submitting the grounds for appeal (see G 1/86).

Where re-establishment of rights is requested by the patent proprietor in respect of a time limit connected with the opposition procedure, the opponents are party to the re-establishment proceedings (see T 552/02 and T 1561/05).

In the case of transfer of an application or patent, the request for re-establishment of rights may only be filed by the registered applicant (E-XIII, 3).

*Rule 22(3)*

### 3.1.3 Form of the request and applicable time limit

As a rule, the request for re-establishment of rights must be filed in writing within two months from the removal of the cause of non-compliance with the time limit, but at the latest within one year of expiry of the unobserved time limit. The omitted act must be completed within this period.

*Rule 136(1), (2)*

Where the “cause of non-compliance with the time limit” involved some error in the carrying out of the party’s intention to comply with the time limit, the removal of the cause of non-compliance occurs on the date on which the person responsible for the application is made aware of the fact that a time limit has not been observed or ought to have noticed the error if all due

care had been taken. The removal of the cause of non-compliance is a matter of fact which has to be determined in the circumstances of each individual case. In the absence of circumstances to the contrary, where a communication under Rule 112(1) has been duly sent, it may be assumed that the removal was effected by this communication (see J 27/90).

A request for re-establishment in respect of the priority period (Art. 87(1)) or the period for filing a petition for review by the Enlarged Board of Appeal (Art. 112a(4)) must however be filed within two months of expiry of the relevant period.

A request for re-establishment is not deemed to be filed until after the fee for the re-establishment of rights has been paid.

### **3.1.4 Substantiation of the request**

The request must state the grounds on which it is based, and must set out the facts on which it relies. Thus, it must set forth the precise cause of non-compliance with the time limit concerned (i.e. the fact or obstacle preventing the required action within the time limit), specify at what time and under which circumstances the cause occurred and was removed, and present the core facts making it possible to consider whether all due care required by the circumstances had been taken in order to comply with the time limit concerned (see J 15/10). General statements with no indication of the concrete facts or events that caused the time limit to be missed do not satisfy the requirement for a duly substantiated request under Rule 136(2).

Once the time limit for filing the request for re-establishment has expired, the requester may clarify or supplement the alleged facts and, where appropriate, submit further evidence. However, the requester cannot alter the factual basis of the request (see J 5/94). Late-filed submissions introducing new facts are not taken into consideration by the deciding instance.

### **3.2 Merit of the request**

*Art. 122(1)*

An applicant can have his rights re-established only if he shows that he was unable to observe a time limit vis-à-vis the EPO in spite of all due care required by the circumstances having been taken. The obligation to exercise due care must be considered in the light of the situation as it stood before the missed time limit expired. "All due care" means all reasonable care, i.e. the standard of care that the notional reasonably competent patentee, applicant or representative would employ in all the relevant circumstances (see T 30/90).

For cases where the cause of non-compliance with a time limit involves some error in the carrying out of the party's intention to comply with the time limit, all due care is considered to have been taken if non-compliance with the time limit results either from exceptional circumstances or from an isolated mistake within a normally satisfactory monitoring system.

A finding of exceptional circumstances justifying the re-establishment of rights is dependent on the individual facts of the case. Examples include inter alia organisational upheavals and sudden serious illnesses. In such cases, the requester must show not only the existence of those circumstances, but also that he took all due care, e.g. by carefully preparing the reorganisation or by having an effective staff substitution system.

Where an isolated mistake within a normally satisfactory monitoring system is alleged, the relevant party must show that the monitoring system normally works well. Such a system must include an independent, effective cross-check mechanism. However, this requirement does not apply to relatively small entities/patent departments (see T 166/87 and J 11/03).

The duty to exercise all due care applies first and foremost to the applicant and then, by virtue of delegation, to the representative duly entrusted by the applicant to act on his behalf in prosecuting the application (see J 3/93). The obligations of the applicant and those of his representative are clearly distinct and depend on the relationship between them (see T 112/89 and J 19/04). In this regard, the scope of the mandate and any express instructions given to the representative are taken into account.

The applicant is entitled to rely on his representative. To the extent that the applicant is on notice that instructions are required in order to meet a time limit, he has however a duty to take all due care in the circumstances to meet the time limit (see T 381/93). The fact that the professional representative has acted correctly does not exempt the applicant from suffering the consequences of his own mistakes or negligence.

The European representative is responsible in the procedure before the EPO and must be presumed to be supervising his own work continuously (see T 1095/06). When the professional representative has been instructed by his client to perform a particular procedural action and does not receive in due time the necessary additional instructions or required means, he must in principle take all necessary measures to try to obtain these instructions from his client and ascertain his true wishes (see T112/89 and J 19/04).

Professional representatives can delegate routine tasks, such as typing, posting letters, noting time limits or checking due dates, to assistants. In those cases, the same strict standard of care is not expected of the assistant as is demanded of the representative himself. The representative must however show that the assistants have been carefully selected, duly instructed and periodically supervised (see J 5/80 and T 439/06).

If the applicant entrusts a further party with taking care of his application matters, e.g. a non-European representative or a fee payment agency, it has to be established that such a party has taken the due care required of an applicant for or proprietor of a European patent (see J 3/88). In particular, a non-European representative must also show that a reliable system for the monitoring of time limits was in place when the time limit was missed (see J 4/07).

### 3.3 Decision on re-establishment of rights

*Rule 136(4)*

The department competent to decide on the omitted act is also competent to decide on the request for re-establishment of rights. The grounds for the decision need only be stated in case the request is not granted, except in opposition proceedings, as opponents are party to the re-establishment proceedings (see E-VII, 3.1.2).

The department which took the contested decision will have to consider re-establishment of rights in respect of an unobserved time limit for appeal when the conditions for granting interlocutory revision are fulfilled (see E-XI, 7). It can, however, only decide to allow re-establishment if it can do so within the three-month time limit of Art. 109(2) and the conditions for re-establishment (see E-VII, 3.1.1 to 3.1.4) are fulfilled. In all other cases, the appeal, together with the application for the re-establishment of rights, must be submitted to the competent Board of Appeal.

*Art. 122(3)*

*Rule 51(4)*

If the request is granted, the legal consequences of the failure to observe the time limit will be deemed not to have ensued. Any renewal fees which may have fallen due between the expiry of the missed time limit and the notification of the decision to grant the request for re-establishment will be due on that latter date. Valid payment will still be possible within four months of that date. If a renewal fee was already due when the loss of rights occurred but could still be paid under Rule 51(2), it may still be paid within six months of the date of notification of the decision re-establishing the rights, provided that the additional fee is also paid within that period.

If other time limits the non-observance of which would also lead to a loss of rights were already running when the loss of rights occurred, on granting the request for re-establishment the EPO will send the applicant a communication triggering those time limits anew.

### 4. Accelerated prosecution of European patent applications

Applicants requiring faster search or examination can ask to have their applications processed under the programme for accelerated prosecution of European patent applications (PACE) (see the Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93; for PACE requests filed before 1 January 2016 see also OJ EPO 2010, 352). For information regarding additional ways to expedite the European grant procedure see OJ EPO 2015, A94).

Requests for participation in the PACE programme (PACE requests) must be filed online using the dedicated request form (EPO Form 1005), which must be filed online. The EPO will issue an acknowledgement of receipt promptly. Requests filed informally, i.e. without using the dedicated form, and/or on paper will not be processed by the EPO.

A PACE request may be filed only once during each stage of the procedure, i.e. search and examination, and for one application at a time. A PACE request filed during search will not trigger accelerated examination. If the applicant wishes to have the application examined in an accelerated

manner, a PACE request may be filed, once the application has entered the examination phase.

The EPO does not publish requests for accelerated search and/or examination and, by decision of the President dated 12 July 2007 (Special edition No. 3, OJ EPO 2007, J.3), they are excluded from file inspection.

An application will be taken out of the PACE programme if:

- the PACE request has been withdrawn,
- the applicant has requested an extension of time limits,
- the application has been refused,
- the application has been withdrawn,
- the application is deemed to be withdrawn.

This applies regardless of the legal remedies available under the EPC. In such cases it will not be possible to re-store the application to the PACE programme, i.e. a second request for that application during the same stage of the procedure will not be processed.

Additionally, accelerated prosecution will be suspended in the event of failure to pay renewal fees by the due date stipulated in Rule 51(1).

Accelerated prosecution under the PACE programme can be provided only where practically feasible and subject to the workload of the Search and Examining Divisions. In certain technical fields there may be constraints due to the numbers of incoming PACE requests. Applicants requesting accelerated prosecution for all or most of their applications will, as a rule, be required by the EPO to limit the number of their PACE requests by making a selection.

#### **4.1 Accelerated search**

For European patent applications filed on or after 1 July 2014 (including PCT applications entering the European phase where the EPO did not act as (S)ISA) the EPO strives to issue the extended/partial European search report within six months from the filing date or from expiry of the period under Rule 161(2). Hence, no PACE request is needed.

For European patent applications (including PCT applications entering the European phase where the EPO did not act as (S)ISA) which were filed before 1 July 2014 and which do claim priority (second filings), on receipt of a PACE request the EPO makes every effort to issue the extended/partial European search report within six months from receipt of the request.

Without prejudice to the above an accelerated search can only start:

- (i) after receipt of the applicant's response to a communication under Rule 62a or 63, or expiry of the respective time limit;
- (ii) in all cases: when the application documents on filing are complete enough for the extended search report to be drawn up. That means, in particular, that the accelerated search can only start once the claims, the description, the translations required and, where applicable, the drawings and a sequence listing conforming to the rules for the standardised representation of nucleotide or amino acid sequences have been filed;
- (iii) for PCT applications entering the European phase where the EPO did not act as (S)ISA: after expiry of the six-month period under Rule 161(2), even if acceleration has been requested under the PACE programme. In order for the supplementary European search to start immediately, on entry into the European phase the applicant must explicitly waive the right to communications pursuant to Rules 161(2) and 162(2) and pay any claims fees due (see Notice from the EPO dated 30 November 2015, OJ EPO 2015, A93).

If the EPO has invited the applicant to pay further search fee(s) under Rule 64(1), second sentence, or 164(1)(b), the final search report under Rule 64(1), last sentence, or 164(1)(c) cannot be drawn up until the applicant's response to the invitation to pay further search fee(s) has been received or until the respective time limit has expired.

#### **4.2 Accelerated examination**

Accelerated examination can, in principle, be requested at any time after the Examining Division has assumed responsibility for the application (Rule 10(2), (3)).

For PCT applications entering the European phase where the EPO also acted as (S)ISA, accelerated examination can, in principle, be requested at any time, for example

- on entry into the European phase before the EPO, or
- together with any response to the WO-ISA, IPER or SISR required under Rule 161(1).

When accelerated examination is requested, the EPO makes every effort to issue the next office action within three months of receipt by the Examining Division of the application, the applicant's response under Rule 70a or 161(1) or the request for accelerated examination (whichever is later).

The EPO strives to produce subsequent examination communications within three months of receipt of the applicant's reply, provided that the application is still being processed under the PACE programme (see E-VII, 3).

## 5. Accelerated processing of oppositions

In cases where an infringement action in respect of a European patent is pending before a national court of a Contracting State, a party to the opposition proceedings may request accelerated processing. The request may be filed at any time. It must be filed in written reasoned form. In addition, the EPO will also accelerate the processing of the opposition if it is informed by the national court or competent authority of a Contracting State that infringement actions are pending (see the Notice of the EPO dated 17 March 2008, OJ EPO 2008, 221).

## 6. Accelerated processing before the Boards of Appeal

Parties with a legitimate interest may ask the Boards of Appeal to deal with their appeals rapidly. The Boards can speed up an appeal as far as the procedural regulations allow. Requests for accelerated processing must be submitted to the competent Board either at the beginning of or during proceedings. They should contain reasons for the urgency together with relevant documents. This option is also available to the courts and competent authorities of the Contracting States (see the Notice from the Vice-President Directorate-General 3 dated 17 March 2008, OJ EPO 2008, 220).

## 7. Renunciation of rights

### 7.1 Withdrawal of application or designation

The applicant may withdraw his application at any time as long as the application is pending, provided that no third party has proven to the EPO that he has initiated proceedings concerning entitlement to the application pursuant to Rule 15. With regard to the pendency of an application, see A-IV, 1.1.1.

*Rule 15*

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

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

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

*Art. 87(4)*

Where a patent application has been refused, proceedings are still pending until expiry of the period for filing an appeal. On the day after, proceedings are no longer pending if no appeal is filed. Therefore, an application which is refused either in written or oral proceedings can still be withdrawn in this period.

## **7.2 Withdrawal of priority claim**

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

## **7.3 Statement of withdrawal**

Any statement of withdrawal must be unqualified and unambiguous. It may, however, be conditional upon, e.g. avoidance of publication or refund of the examination fee. An unqualified and unambiguous withdrawal becomes effective the day it has been received by the EPO.

If such a statement of withdrawal is made orally during oral proceedings, then either a handwritten signed confirmation should be submitted during the proceedings or the Division should confirm the withdrawal in the minutes and read out the corresponding passage for confirmation in the oral proceedings. The withdrawal has effect from the date of the oral proceedings.

## **7.4 Surrender of patent**

*Rule 84(1)*

A patent may not be surrendered in opposition proceedings by the proprietor filing a declaration of surrender with the EPO. Such a surrender must be declared before the competent authorities in the designated states in question (see D-VII, 5.1). Nevertheless, if a proprietor unambiguously declares to the EPO the surrender (or abandonment or renunciation) of the patent, this is deemed equivalent to a request that the patent be revoked (see also D-VIII, 1.2.5).

## Chapter VIII – Applications under the Patent Cooperation Treaty (PCT)

### 1. General remarks

The EPO may be a "designated Office" or an "elected Office" for an international application filed under the Patent Cooperation Treaty (PCT) designating "EP" (Euro-PCT application). Such application is thereby deemed to be a European application (Euro-PCT application) for the purposes of the EPC. However, in the case of Euro-PCT applications, the provisions of the PCT apply in addition to those of the EPC, and where there is conflict between them, e.g. in the case of certain time limits, the provisions of the PCT prevail. According to Art. 153(1)(a), the EPO is a designated Office for Contracting States to the EPC in respect of which the PCT has entered into force, which are designated in the international application and for which the applicant wishes to obtain a European patent. If the applicant has elected a designated State, the EPO is an elected Office (Art. 153(1)(b), for details see E-VIII, 2.1.1).

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

*Art. 153(2)*

*Art. 150(2)*

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

*Art. 151*

*Art. 152*

*Rule 157*

*Rule 158*

- (i) the filing of the application and the international search take place at an office or offices other than the EPO (e.g. the Japan Patent Office). The EPO is a designated Office;
- (ii) the application is filed at another office (e.g. the United Kingdom Patent Office) but the EPO performs the international search. The EPO acts as International Searching Authority and is a designated Office;
- (iii) the application is filed at the EPO, which also performs the international search. The EPO acts as receiving Office, International Searching Authority and designated Office;
- (iv) in addition to the cases mentioned under (i) - (iii), the applicant files a demand for international preliminary examination. The EPO is the "elected Office";
- (v) the EPO is the International Preliminary Examining Authority. It may carry out this function without being the receiving Office, a designated Office or an elected Office. The EPO can, however, only act as an IPEA if the international search was carried out by the EPO, the Austrian, Spanish, Swedish or Finnish Patent Office or the Nordic Patent Institute;

- (vi) if the international search has been carried out by an office other than the EPO, the applicant may still request the EPO to perform a supplementary international search (SIS) in its capacity as SISA.

In case (i), the European application will be accompanied by an international search report drawn up by another office. In cases (ii) and (iii), the international search report and the "written opinion of the International Searching Authority" (WO-ISA) (Rule 43*bis* PCT) will be prepared by the Search Division of the EPO. In case (iv), the international search report and the international preliminary examination report may be drawn up by the EPO or by another International Searching Authority and International Preliminary Examining Authority.

For further details, in particular as to deadlines and procedural steps before the EPO as RO, ISA, IPEA or SISA, see the latest version of the Guide for applicants: "Euro-PCT Guide": PCT procedure at the EPO".

## **2. EPO as designated or elected Office**

### **2.1 General**

#### **2.1.1 Introduction**

Art. 153(2)

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

In order to initiate the European phase, the requirements for entry into the European phase according to Rule 159 must be complied with (see E-VIII, 2.1.2 and 2.1.3). For entry into the European phase, applicants are strongly recommended to use the most recent edition of Form 1200 obtainable from the EPO free of charge in printed form, as editable electronic document from the EPO website, as part of the Online Filing software or as part of the new online filing (CMS). For further details on the available filing methods see A-VIII, 2.5.

This Chapter deals with the **differences** from the practice set out in Part A of the Guidelines when dealing with such international applications as a designated or elected Office. First, however, some specific aspects of the processing of international applications in the procedure before the EPO as designated/elected Office are set out in E-VIII, 2.2, 2.3 and 2.4 below.

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

The initial processing and formal examination of international applications in the international phase are carried out by PCT authorities under the PCT. Unless there is a specific request from the applicant, the EPO acting as a designated or elected Office may not process or examine an international application prior to the expiry of 31 months from the date of filing of the application or, if priority has been claimed, from the earliest priority date (31-month time limit), (see E-VIII, 2.8 and 2.5.2). Since the EPO has not exercised the waiver referred to in Art. 20(1)(a) PCT, a copy of the international application will be furnished by the International Bureau. The EPO does not require the applicant to furnish a copy of the international application under Art. 22 or 39 PCT, even if the International Bureau has not yet communicated a copy under Art. 20 PCT at the time the application enters the European phase (see PCT Gazette 14/1986, 2367).

*Art. 23 PCT*

*Art. 40 PCT*

*Rule 49.1(a-bis) PCT*

*Art. 24(1)(iii) PCT*

*Rule 159(1)*

*Rule 160*

*Art. 121*

*Art. 2, No. 12, RFees*

Where the language of the international application is not an official language of the EPO, the applicant is required, in accordance with Art. 22 or 39 PCT and Rule 159(1)(a), to furnish a translation within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (31-month time limit).

Information on what the translation must include and further details concerning the requirement for filing a translation can be found in the latest version of the Guide for applicants: "Euro-PCT Guide": PCT procedure at the EPO".

The application is deemed to be withdrawn if the translation is not furnished within that period (Rule 160(1)). If the EPO finds that the application is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 160(2)). Rule 112(2) applies *mutatis mutandis*. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation and a valid request for further processing (including the payment of the requisite fee) are filed (Art. 121 and Rule 135(1)).

Where an international application was filed and published in the international phase in an official language of the EPO, it is not possible to change the language of the proceedings on entry into the European phase by filing a translation of that application into either of the other two official languages of the EPO (see G 4/08). In such cases, the language of the proceedings within the meaning of Art. 14(3) remains the language in which the application was published by WIPO's International Bureau and cannot be changed.

### 2.1.3 Filing fee, designation fee, request for examination, search fee and claims fees

Under Rule 159(1)(c), the applicant must pay the filing fee, including any additional fee for pages in excess of thirty-five (see A-III, 13.2), within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date. Further, under Rule 159(1)(d), he must pay the

*Rule 159(1)*

*Rule 160*

*Art. 2, No. 12, RFees*

designation fee within this period, if the time limit specified in Rule 39(1) has expired earlier. Under Rule 159(1)(f), the request for examination must also be filed within this period, if the time limit specified in Rule 70(1) has expired earlier. Where a supplementary European search report needs to be drawn up, a search fee must also be paid to the EPO within this period. Failure to pay in due time the filing fee, the additional fee, the search fee, the designation fee or the examination fee, or to file the request for examination, means that the application is deemed to be withdrawn.

If the EPO finds that the application is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 160(2)).

The communication under Rule 160(2) and the communication according to Rule 112(1) are sent together in one and the same communication. In response to this notification of a loss of rights, the applicant can request further processing. Any loss of rights ensues on expiry of the normal period (see G 4/98).

#### *Rule 162*

If applicable, the claims fees under Rule 162 must also be paid within the 31-month time limit referred to above. If they are not, they may still be validly paid within a non-extendable period of grace of six months of notification of a communication pointing out the failure to pay, which is combined with the communication under Rule 161. If amended claims are filed during this grace period, they form the basis for calculating the number of claims fees due. Where a claims fee has not been paid in time, the claim concerned is deemed to be abandoned. Features of a claim deemed to have been abandoned pursuant to Rule 162(4) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims.

#### **2.1.4 PCT vs. EPC provisions**

#### *Art. 150(2)*

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

Hereafter, the formalities examination of an international application upon entry into the European phase is considered, **insofar as it differs** from that

applicable to European direct applications, by reference to the provisions of appropriate sections of Part A.

## **2.2 Provisions of Chapter A-II ("Filing of applications and examination on filing")**

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

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

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

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

The date of filing (see A-II, 4 ("Examination on filing")) of a Euro-PCT application is that accorded under the PCT by the PCT authority which acted as the receiving Office. The formalities examination upon entry into the European phase encompasses all checks required to verify that the requirements of Rules 159 and 163 have been met.

If the application is not deemed to be withdrawn, a copy of the application is referred to the Search Division for drawing up any supplementary European search report, if necessary (see E-VIII, 3.1).

## **2.3 Provisions of Chapter A-III ("Examination of formal requirements")**

### **2.3.1 Representation**

The provisions of A-III, 2 ("Representation") apply to international applications whether furnished in an official language or in translation. An agent having a right to practise before the PCT International Authorities is not necessarily authorised to act before the EPO (see Art. 27(7) PCT). For the representation of applicants before the EPO as designated or elected Office see the latest version of the Guide for applicants: "Euro-PCT Guide": PCT procedure at the EPO".

If there is more than one applicant and the following information was not provided for one or more of those applicants in the International phase and is still missing at the expiry of the 31-month time limit under Rule 159(1): *Rule 163(4) to (6)*

- (i) address
- (ii) nationality
- (iii) State of residence or principal place of business

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

### **2.3.2 Physical requirements**

Although compliance of an international application with the PCT requirements as to form and content is, as a rule, ascertained during the international phase, the EPO may check Euro-PCT applications entering the European phase for compliance with Rule 11 PCT. If the application documents do not comply with this provision, the EPO will issue a communication indicating any deficiencies and invite the applicant to correct them within a time limit of two months under Rule 58.

Since the translation filed under Rule 159(1)(a) is filed for the procedure before the EPO as designated or elected Office, the translation must comply with the physical requirements as set out in A-III, 3 ("Physical requirements"). The requirements are in general identical with the corresponding requirements of the PCT.

### **2.3.3 Request for grant**

The PCT request corresponds in general to the EPO Request for Grant form (Form 1001) and provides for the entry of the information listed in Rule 41(2), with the exception of the items referred to in sub-paragraphs (e) and (f) thereof.

### **2.3.4 Designation of inventor**

*Rule 163(1)*

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

### **2.3.5 Claim to priority**

*Rule 17.1 and  
17.2 PCT*

The claim to priority (see A-III, 6 ("Claim to priority")) for an international application refers to the date, or dates, claimed under the PCT. Normally, the copy of the previous application, referred to in A-III, 6.7, i.e. the priority document, is furnished to the EPO as designated Office by the International Bureau and not by the applicant. In accordance with Rule 17.2 PCT, the International Bureau will be requested by the EPO to furnish it with a copy

as standard practice promptly, but not earlier than international publication, or, where the applicant has requested early examination (in accordance with Art. 23(2) PCT), not earlier than the date of the request. Where the applicant has complied with Rule 17.1(a) and (b) PCT, the EPO may not ask the applicant himself to furnish a copy.

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the 31-month time limit, the EPO invites the applicant to furnish the number or the copy within two months. However, Rule 53(2) and the Decision of the President of the EPO dated 9 August 2012, OJ EPO 2012, 492, providing an exception to the requirement that a copy of the previous application be furnished (see A-III, 6.7), also apply to international applications entering the European phase. Furthermore, as just mentioned, where the applicant has complied with Rule 17.1(a) or (b) PCT the EPO as a designated Office may not ask the applicant himself to furnish it with a copy of the priority document (Rule 17.2(a) PCT, second sentence).

*Rule 163(2)*

If the priority document is not on file, substantive examination may nevertheless be started, provided that neither intermediate documents (published in the priority period) nor Art. 54(3) documents exist which cause the patentability of the subject-matter claimed to depend on the validity of the priority right. However, no European patent may be granted until such time as the priority document is on file. In such a case, the applicant is informed that the decision to grant will not be taken as long as the priority document is missing. In such cases, however, the application may be refused without the priority document being on file, provided that the relevant prior art is neither an intermediate document nor an Art. 54(3) document, the relevance of which depends on the validity of the priority right. For more details on treatment of such cases in examination see F-VI, 3.4.

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

*Art. 88(1)*  
*Rule 53(3)*

The provisions for restoration of priority right (see A-III, 6.6) exist also under the PCT (Rules 26*bis*.3 and 49*ter* PCT). Under the PCT, restoration of right of priority can be made either in the international phase before the receiving Office (Rule 26*bis*.3 PCT) or upon entry into the European phase before the EPO (Rule 49*ter*.2(b)(i) PCT).

It should be noted that the EPO as both receiving Office and designated/elected Office applies the "due care" criterion in accordance with its practice under Art. 122 (Rules 26*bis*.3(a)(i) and 49*ter*.2(a)(i) PCT). As a consequence, any request for restoration of priority rights granted by a receiving Office under the "unintentional" criterion is not valid in the procedure before the EPO as designated/elected Office (Rule 49*ter*.1(b) PCT).

### **2.3.6 Title of the invention**

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

### **2.3.7 Prohibited matter**

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

### **2.3.8 Claims fee**

The time limit for paying the claims fee referred to in A-III, 9 is, as indicated in E-VIII, 2.1.3, 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (31-month time limit) (Rule 162(1)).

### **2.3.9 Drawings**

The provisions of A-II, 5 and A-III, 3.2 with regard to the filing of drawings are identical with the corresponding provisions of the PCT and therefore no supplementary examination should be necessary.

### **2.3.10 Abstract**

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

### **2.3.11 Designation fee**

The time limit for paying the designation fee is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (31-month time limit), if the time limit specified in Rule 39(1) has expired earlier (Rule 159(1)(d)) (see A-III, 11.2.5, for further details). If, subsequent to the receipt of the international application by the EPO and prior to the date on which processing or examination may start, the regional designation of all Contracting States of the EPC is withdrawn, the Euro-PCT application, insofar as it is deemed to be a European application pursuant to Art. 153(2) and Art. 11(3) PCT, is deemed to be withdrawn.

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

## **2.4 Provisions of Chapter A-IV ("Special provisions")**

### **2.4.1 Divisional applications**

In relation to A-IV, 1 ("European divisional applications") there is no provision in the PCT for filing divisional applications. One or more European divisional applications may be filed in respect of subject-matter contained in a pending Euro-PCT application, but not before the latter application has entered the European phase (see A-IV, 1.1), i.e. not before

the time limit under Rule 159(1) (in conjunction with Art. 22(1) PCT and Art. 22(3) PCT) has expired (see G 1/09, Reasons 3.2.5), and on condition that any requirement of Art. 22(1) PCT which must be fulfilled within that time limit for the application concerned is met (see J 18/09). Furthermore, divisional applications may be filed as from the date the applicant has requested early processing in accordance with Art. 23(2) PCT (see J 18/09, Reasons 9, and E-VIII, 2.9). For the sake of completeness it is noted that the requirements of Rule 36 for filing divisionals must be complied with (see A-IV, 1). The divisional application must be filed in the language specified in Rule 36(2) (see A-IV, 1.3.3). In order to avoid that the Euro-PCT application is deemed withdrawn at the time a divisional application is filed, the respective requirements of Rule 159(1) must be fulfilled within the relevant time limits (see also the latest version of the Guide for applicants: "Euro-PCT Guide": PCT procedure at the EPO").

### 2.4.2 Sequence listings

Rules 5.2 and 13~~ter~~ PCT apply to the filing of sequence listings (see A-IV, 5 ("Applications relating to nucleotide and amino acid sequences")). The EPO as International Searching Authority (see E-VIII, 3) makes use of the opportunity under Rule 13~~ter~~.1 PCT to invite the applicant where appropriate to furnish it with the prescribed sequence listing in electronic form according to WIPO Standard ST.25, paragraph 39 sqq. (see Art. 4 of the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372, and the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542 (point II)). The furnishing of sequence listings in response to an invitation under Rule 13~~ter~~.1 PCT is subject to a late furnishing fee (see Rule 13~~ter~~.1(c) PCT). If the required sequence listing is received after the applicable time limit but before the start of the international search, it will be considered by the EPO in its capacity as ISA as if it had been received within that time limit.

For Euro-PCT applications entering the regional phase before the EPO, the applicant will be invited to furnish a sequence listing in electronic form, i.e. in text format (TXT), in accordance with WIPO Standard ST.25 and pay a late furnishing fee within a period of two months, if such a sequence listing is not available to the EPO at the expiry of the 31-month time limit (see Rule 163(3) and 30(3)). The sequence listing should not be filed on paper or, in the case of electronic filing of the application, in PDF format. (see Art. 5 of the Decision of the President of the EPO dated 28 April 2011, OJ EPO 2011, 372, and the Notice from the EPO dated 18 October 2013, OJ EPO 2013, 542).

*Rule 163(3)*

## 2.5 Provisions of Chapter A-VI ("Publication of application; request for examination and transmission of the dossier to Examining Division")

### 2.5.1 Publication of the international application

The international publication of a Euro-PCT application in an official language of the European Patent Office takes the place of publication of the European patent application and will be mentioned in the European Patent Bulletin. If the international publication of the Euro-PCT application

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

is in another language, a translation into one of the official languages must be filed with the EPO within 31 months of the priority date (Art. 22(1) PCT and Rule 159(1)(a)). The EPO will publish the translation. Information as to what the translation must include and further details concerning the requirement to file a translation can be found in the latest version of the Guide for applicants: “Euro-PCT Guide”: PCT procedure at the EPO”.

*Rule 160(1)*

If the translation is not supplied, the application is to be deemed withdrawn (Art. 24(1) PCT, Rule 160(1)). Furthermore, in this case, the application which has been published under the PCT is not considered as comprised in the state of the art in accordance with Art. 54(3) (see G-IV, 5.2). However, if the EPO finds that the application is deemed to be withdrawn because the translation was not filed in due time, it must first communicate this to the applicant (Rule 160(2)). Rule 112(2) applies *mutatis mutandis*. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation is supplied, a request for further processing under Art. 121 and Rule 135(1) is filed, and the fee for further processing is paid.

### **2.5.2 Request for examination**

*Art. 153(6)*

*Art. 150(2)*

*Rule 159(1)(f)*

The time limit under Rule 70(1) for filing the request for examination referred to in A-VI, 2 runs from the date of publication under Art. 21 PCT of the international search report. However, this time limit will not expire before the time prescribed by Rule 159(1)(f) (31-month time limit). See also E-VIII, 2.1.3.

European substantive examination must normally not begin before expiry of the 31st month from the earliest priority date (Art. 23(1), 40(1) PCT). The only circumstance in which examination may begin earlier is if the applicant has expressly so requested (see E-VIII, 2.8) and if any required supplementary European search report is available.

### **2.5.3 Supplementary European search**

*Rule 70(2)*

If a supplementary European search report has to be drawn up in respect of an international application which is deemed to be a European patent application, the applicant is entitled to receive the invitation provided for in Rule 70(2) (see A-VI, 2.3, 2nd paragraph, and J 8/83). A time limit of six months from the notification of this communication is set for filing the confirmation required under Rule 70(2) and for response to the search opinion accompanying the supplementary European search report (Rule 70a(2) and the Notice from the EPO dated 15 October 2009, OJ EPO 2009, 533).

## **2.6 Reduction and refunds of fees in respect of international (PCT) applications**

See A-X, 9.3 and 10.2.

## **2.7 Communication to the EPO as a designated Office**

*Art. 20(1)(a) PCT*

*Rule 44bis.2 PCT*

A copy of the application together with the international search report or a declaration in accordance with Art. 17(2)(a) PCT is communicated by the International Bureau to the EPO as a designated Office in accordance with

Art. 20(1)(a) PCT. Furthermore, the EPO does not require the applicant to furnish a copy of the international application (Rule 49.1(a-bis) PCT). The EPO as a designated Office will then examine the application for compliance with the requirements of the EPC (see in particular E-VIII, 2.3).

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

## 2.8 Early processing

When acting as a designated Office, the EPO must not process or examine an international application before expiry of the period applicable under Art. 22 PCT (Art. 23(1) PCT). However, the EPO may, on the express request of the applicant, process or examine an international application at any time (Art. 23(2) PCT). If the International Bureau (IB) has not yet transmitted to the EPO a copy of the international application, the ISR and the WO-ISA, the applicant may but does not have to file with the IB a request to do so. If necessary, the EPO will take care of this itself.

*Art. 23 PCT*

*Rule 44bis.2 PCT*

A request for early processing under Art. 23(2) or 40(2) PCT may be filed with the EPO at any time before expiry of the 31-month time limit (Art. 22(3) PCT and Rule 159(1)). The request does not require a specific wording, but the applicant must clearly express that he wishes the processing of his application before the EPO as designated/elected Office to commence early.

*Art. 23(2) and  
40(2) PCT*

For the request to be effective, the applicant must comply with the requirements stipulated in Rule 159(1) as if the 31-month time limit expired on the date he requests early processing, i.e.: payment of the filing fee (including any additional fee under Art. 2(1), item 1a, RFees if the application comprises more than 35 pages), filing of a translation (if a translation is required under Art. 153(4)), specification of the application documents, and payment of the search fee (where a supplementary European search report has to be drawn up under Art. 153(7)). Which further requirements stipulated in Rule 159(1) must be complied with depends on the date on which early processing is requested, since the (regular) time limits for paying the designation fee (Rule 39(1)) and the renewal fee (Rule 51(1)) and for filing the request for examination and paying the examination fee (Rule 70(1)) may not have expired on the date the request for early processing is filed. Therefore, if any of these time limits is still running on that date (or, in the case of the renewal fee, if the due date according to Rule 51(1) is later than that date), the request for early processing will be effective without the requirement(s) concerned having been complied with (Art. 153(2), Art. 11(3) PCT). If pursuant to Rule 159(1)(h) a certificate of exhibition must be filed and this requirement is not met, this will not prevent the request for early processing from being effective, but it will affect the prior art that the EPO takes into account in the European phase.

*Rule 159(1)*

If on the date the request for early processing is filed any necessary requirement is not complied with, the request will be effective only as from the date on which all necessary requirements have been complied with.

If on the date the request for early processing is filed all necessary requirements for entry into the European phase are complied with, the request is effective and the Euro-PCT application will as from that date be processed in the same way as a Euro-PCT application which has entered the European phase by fulfilling the necessary requirements of Rule 159(1) within the 31-month time limit and without a request for early processing having been filed. On that date the international phase is thus terminated in respect of the EPO as designated/elected Office (J 18/09, Reasons 13). Moreover, since by filing an effective request for early processing the processing ban is lifted, as from that date it is no longer possible to claim the 31-month time limit under Rule 159(1). For details see the Notice from the EPO dated 21 February 2013, OJ EPO 2013, 156, as well as the latest version of the Guide for applicants: "Euro-PCT Guide": PCT procedure at the EPO".

## **2.9 Review by the EPO as a designated Office**

*Rule 159(2)*

The EPO may decide, in accordance with Art. 25 PCT, to allow an international application deemed to be withdrawn, or not accorded a filing date, to proceed as a European application. The Examining Division is competent to take decisions in relation to these applications, and the Receiving Section transfers copies of any documents received from the International Bureau under the circumstances of Art. 25(1)(a) PCT to the Examining Division. Where it is decided that the application can proceed as a European application, the search and examination is carried out as for other applications although the application may be accorded the date it was originally filed with the PCT receiving Office and may claim the priority date, if any, of the international application.

## **2.10 Inspection of files**

*Art. 30(2) PCT*

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

*Rule 94.3 PCT*

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

# **3. The communication according to Rule 161**

## **3.1 Applications for which a supplementary European search report is prepared**

Where the application under consideration derives from an international application for which the EPO did not act as ISA or as the authority charged

with the supplementary international search (SISA), the application is subject to a supplementary European search under Art. 153(7) (see B-II, 4.3, the Decision of the Administrative Council of 28 October 2009, OJ EPO 2009, 594, the Notice from the EPO dated 24 March 2010, OJ EPO 2010, 316 and the Notice from the EPO dated 5 April 2011, OJ EPO 2011, 354), and normally an EESR is issued accordingly (see B-XI, 1 and 2). The first communication is then issued as in C-III, 4.

In such cases, promptly after entry into the European phase, the applicant is invited to amend the application within a period of six months (see the Notice from the EPO dated 29 June 2010, OJ EPO 2010, 406, and the Notice from the EPO dated 15 October 2009, OJ EPO 2009, 533). All amendments and comments filed within this period will be taken into account in drawing up the supplementary European search report and the search opinion. The supplementary European search will be based on the last set of claims filed up to expiry of this period for which any claims fee due is paid.

*Rule 161(2)*

The applicant may, but is not required to, reply to the WO-ISA, IPER or SISR drawn up by an authority other than the EPO, normally in the form of amendments and/or comments filed with Form 1200 or in response to a communication under Rule 161(2). If the applicant does reply to the WO-ISA, IPER or SISR, the supplementary search report and the search opinion will be drawn up taking this reply into account (see B-II, 4.3 and B-XI, 2).

For proceeding directly to supplementary European search without having to wait until the six-month time limit under Rule 161(2) expires, the applicant may explicitly waive his right to a communication pursuant to Rules 161(2) and 162. No communication under Rule 161(2) or 162 is issued if, in addition to the waiver, the applicant has already paid any claims fees due (see the Notices from the EPO dated 4 May 2010, OJ EPO 2010, 352 and dated 5 April 2011, OJ EPO 2011, 354). If not, the communication will be issued and the application will be processed only after expiry of the six-month period, even if a request under the PACE programme has been filed (see E-VII, 3.2).

When preparing the first communication in examination for such cases, the examiner may have to consider the international search report (with the corresponding International Preliminary Report on Patentability (IPRP) or the International Preliminary Examination Report (IPER)), any supplementary international search report (SISR), any supplementary European search report (with the corresponding search opinion) prepared by the EPO (see B-II, 4.3) and any reply filed in response thereto (see C-II, 3.1).

### **3.2 Applications for which no supplementary European search report is prepared**

If the EPO acted as ISA, the authority specified for the supplementary international search (SISA) and/or IPEA, a written opinion of the ISA

*Rule 161(1)*

(WO-ISA), a supplementary international search report (SISR) and/or an international preliminary examination report (IPER) will already have been transmitted to the applicant during the PCT phase. For applications where a communication according to Rule 161 has not yet been issued by 1 April 2010 and where a supplementary European search report is not prepared (see B-II, 4.3 and the Decision of the Administrative Council of 28 October 2009, OJ EPO 2009, 594), the applicant will be required to respond to the WO-ISA or SISR prepared by the EPO or, where applicable, to the IPER prepared by the EPO as IPEA. This does not apply where amendments or observations have already been filed which can be considered to be a reply (subject to certain requirements, see E-VIII, 3.3.1 and 3.3.5). The time limit for response is six months from the invitation according to Rule 161(1) and is not extendable. Failure to respond to the WO-ISA, SISR or IPER within this period (by filing amendments and/or comments) leads to the application being deemed to be withdrawn according to Rule 161(1) (further processing is available for this loss of rights – see E-VII, 2). In all cases, the latest filed request on file after expiry of the time limit according to Rule 161(1) will then be taken into account when drafting the first communication (see E-VIII, 4.3.2) or when issuing the invitation under Rule 164(2) (see C-III, 2.3), provided that the application is not deemed to be withdrawn.

The communication under Rule 161(1) is issued promptly after expiry of the time limit for entry into the European phase.

In order to proceed with the examination of the application without having to wait until the expiry of the six-months' time limit for response, the applicant may explicitly waive his right to a communication pursuant to Rules 161(1) and 162. Provided that on entry into the European phase, he has also already responded, where required, to the WO-ISA, the IPER or the SISR and paid the claims fees, no communication under Rules 161 and 162 will be issued. If this is not the case, the communication will be issued and the application will be processed only after expiry of the six-month period, even in the presence of a request under the PACE programme (see E-VII, 3.2).

Where the EPO is an elected Office, the international preliminary examination report and the documents attached to it must be considered in accordance with E-VIII, 4.3.

Where a translation of the priority is required (see A-III, 6.8, and F-VI, 3.4), an invitation to file it according to Rule 53(3) may be sent by the Examining Division only after the period according to Rule 161(1) has expired (see A-III, 6.8.2).

### **3.3 Exceptions where a reply to the Rule 161(1) invitation is not required**

#### **3.3.1 Earlier filed amendments or comments**

In certain cases, even though the EPO was the ISA or the SISA, the applicant is not required to respond to the communication under Rule 161(1). These exceptions are explained below:

- (i) If the applicant has filed new amendments and/or comments upon entry into the regional phase before the EPO, he will still be sent a communication according to Rule 161(1), but in this case he will not be required to respond to it (note, however, that if the requirements of Rule 137(4) were not fulfilled for amendments already filed, it is advisable to make the required indications in reply to the Rule 161(1) communication in order to avoid a further communication according to Rule 137(4)).
- (ii) If the applicant filed amendments according to Art. 19 and/or 34 PCT in the international phase and these amendments are maintained on entry into the European phase, and if the EPO prepared the WO-ISA or SISR but no IPER (either because the applicant did not demand Chapter II or because the IPEA was an office other than the EPO), then these amendments are considered to constitute a response to the WO-ISA or SISR; the applicant will still be sent a communication according to Rule 161(1) in such cases, but he will not be required to respond to it (note, however, that if the requirements of Rule 137(4) were not fulfilled for amendments already filed, it is advisable to make the required indications in reply to the Rule 161(1) communication in order to avoid a further communication according to Rule 137(4)).

With regard to the above cases (i) and (ii), however, see also E-VIII, 3.3.5. Furthermore, if amendments have been filed under Art. 19 or 34 PCT and have been taken into consideration in the drawing up of an IPER by the EPO acting as IPEA, these are not considered to constitute a response to the IPER as required by Rule 161(1); in these cases, the applicant is required to respond to the IPER within the six-month period according to Rule 161(1).

In cases (i) and (ii) above, no communication under Rule 161(1) or 162 is issued if the applicant has explicitly waived his right to these and has already paid any claims fees due (see the Notice from the EPO dated 4 May 2010, OJ EPO 2010, 352 and the Notice from the EPO dated 5 April 2011, OJ EPO 2011, 354).

#### **3.3.2 Positive WO-ISA, SISR or IPER**

Where the WO-ISA, any supplementary international search report (SISR) or, where applicable, the subsequent IPER prepared by the EPO was positive (according to the same principles explained for European search opinions in B-XI, 3.9), the applicant is still sent a communication according to Rule 161(1), but is not required to respond to it. No communication under

Rule 161(1) or 162 is issued if the applicant has explicitly waived his right to these and has already paid any claims fees due (see the Notice from the EPO dated 4 May 2010, OJ EPO 2010, 352).

### **3.3.3 Rule 161 communication issued before 1 April 2010**

In cases where the Rule 161 communication was already issued before 1 April 2010, there is no requirement to respond to the WO-ISA prepared by the EPO or to the IPER prepared by the EPO as IPEA; if the applicant has not filed any amendments or comments upon entry into the regional phase before the EPO, the first communication will essentially be based on the content of said WO-ISA or IPER prepared by the EPO.

### **3.3.4 Voluntary reply to Rule 161(1) communication**

In cases (i) and (ii) mentioned in E-VIII, 3.3.1, and the case mentioned in E-VIII, 3.3.2, where the applicant is not required to respond to the WO-ISA, SISR or IPER prepared by the EPO (in response to the invitation under Rule 161(1)), he **may** still do so by filing further amendments and/or comments if he so wishes. Once again it is advisable that the requirements of Rule 137(4) are fulfilled for any such amendments when they are filed, thus avoiding a further communication according to Rule 137(4).

### **3.3.5 Indications on Form 1200**

In all cases mentioned in E-VIII, 3.3.1, it is important that the applicant clearly indicates on Form 1200 which documents are to form the basis for further prosecution of the application (see the latest version of the Guide for applicants: "Euro-PCT Guide: PCT procedure at the EPO"). Failure to make the appropriate indications on Form 1200 and/or provide copies and/or translations of the amended application documents as indicated below will result in the applicant being required to respond to the invitation according to Rule 161(1).

In particular:

- In case (i) mentioned in E-VIII, 3.3.1, comments and/or amendments (the latter according to Rule 159(1)(b)) which are filed on entry into the European phase will be considered to constitute a response to the WO-ISA, the SISR or the IPER only if the applicant indicates on Form 1200 that such amendments and/or comments are to form the basis for further prosecution of the application and have been filed no later than the date of filing of Form 1200.
- In case (ii) mentioned in E-VIII, 3.3.1, amendments filed in the international phase will be considered to be a response to the WO-ISA, the SISR or the IPER only if the applicant indicates on Form 1200 that these amendments are maintained on entry into the European phase and also provides a translation thereof in the language of the proceedings, where necessary. Furthermore, a copy of the amendments under Art. 34 PCT (not made before the EPO as IPEA) would also be required no later than the date of filing of Form 1200.

*Form 1200*

### 3.4 Rule 137(4) applies

If the application is of one of the types mentioned in H-III, 2.1.4, and if amendments which are to form the basis for further examination were filed either during the Rule 161(1) time limit or earlier, the requirements of Rule 137(4) must be complied with (the amendments must be identified and the basis for them in the application as filed indicated). If the applicant has not yet complied with these requirements on expiry of the time limit according to Rule 161(1), the Examining Division may request him to provide this information within a period of one month, by issuing a communication according to Rule 137(4). Failure to respond to this communication in time will lead to the application being deemed to be withdrawn (see H-III, 2.1 and 2.1.1). The Examining Division may send a Rule 137(4) communication before sending a communication according to Art. 94(3) and Rule 71(1), (2) or (3). It should also be noted that a matching requirement applies to amendments made in the international phase (Rules 46.5, 66.8 and 70.2 PCT).

*Rule 137(4)*

## 4. Examination procedure

### 4.1 At least one communication in examination

If deficiencies persist in the application even after the applicant has filed his response to the WO-ISA, supplementary international search report or IPER (as required by Rule 161(1)), the Examining Division will issue at least one communication according to Art. 94(3) and Rule 71(1) and (2) in subsequent examination proceedings and will consider the applicant's reply thereto before issuing a decision or a summons to oral proceedings. This applies regardless of whether a communication according to Rule 164(2)(a) has been issued.

### 4.2 No examination of multiple inventions in EP phase

Although under PCT Chapter II, where the EPO is the IPEA, the applicant can have multiple inventions examined in one IPER if further examination fees have been paid (or if the examiner has chosen not to invite the applicant to pay further fees), in the European procedure only one invention will be examined.

In cases where protection is sought for an invention not covered by the (supplementary) international search report, by the supplementary European search report or by a search carried out under Rule 164(2) because the search fee due was not paid, the Examining Division must invite the applicant to limit the application to one invention covered by one of these searches. The procedure under Rule 164(2) is set out in detail in C-III, 2.3.

*Rule 164(2)*

If after receipt of the (supplementary) European search report or, where applicable, after a communication under Rule 164(2)(b) the applicant files amended claims relating to an invention which differs from any of the originally claimed inventions and which does not combine with these inventions to form a single inventive concept, an objection under Rule 137(5) should be raised (see also F-V, 13, and H-II, 6).

*Rule 137(5)*

### 4.3 Substantive examination of a Euro-PCT application accompanied by an IPER

The substantive examination is conducted in the same way as with European applications. Where the EPO was the International Preliminary Examining Authority, the international preliminary examination will normally have been carried out by the examiner responsible for examining the related Euro-PCT application.

*Art. 14(1)*

The application to be examined will be accompanied by an international preliminary examination report drawn up in one of the official languages of the EPO. New documents in the original language may be attached in annex to the report (Art. 36(3)(a) PCT and Rule 70.16 PCT). The application will also be accompanied by a translation of the annexes, transmitted by the applicant, in the same language into which the international preliminary examination report was translated (Art. 36(3)(b) PCT).

*Art. 41 and 42 PCT*

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

*Rule 159(1)(b)*  
*Rule 161*

- (i) the applicant must be given the opportunity to amend the claims, the description and the drawings within a time limit prescribed pursuant to Rule 78.1(b) or 78.2 PCT (see also Rules 159(1)(b) and 161); and
- (ii) the EPO cannot require that the applicant furnish copies, or information on the contents, of any papers connected with the examination relating to the same application in any other elected Office.

#### 4.3.1 Comparative test results

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

#### 4.3.2 Basis for substantive examination

Normally, the documents which are indicated in the international preliminary examination report as forming the basis for that report will also form the basis for the substantive examination in the EPO as an elected Office in the European phase. New documents (claims, description, drawings) submitted during the international preliminary examination and replacing the earlier filed documents will be attached to the international preliminary examination report. If the documents attached to the international preliminary examination report are in a language other than the language of the proceedings of the European application in the European phase, the applicant must be requested to file the documents in the language of the proceedings within a fixed period.

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

#### **4.3.3 Consideration of the contents of the IPER**

If the international preliminary examination report has been drawn up by the EPO, it is to be regarded as an opinion for purposes of examination, and generally the first communication will be based on the opinion expressed in the IPER and the applicant's response to it filed in accordance with Rule 161(1) (if applicable, see E-VIII, 3). Such an opinion may be departed from if new facts relevant to assessing patentability are in evidence (e.g. if further prior art documents are to be cited or if evidence is produced of unexpected effects), where the substantive patentability requirements under the PCT and the EPC are different, where the applicant provides convincing arguments, appropriate amendments or relevant counter-evidence in his response to the IPER according to Rule 161(1), or conversely where the applicant provides amendments in response to the IPER which introduce further deficiencies.

*Rule 161(1)*

*Rule 159*

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



## Chapter IX – Decisions

### 1. Basis of decisions

#### 1.1 General remarks

The decisions of the EPO may only be based on grounds or evidence on which the parties concerned have had an opportunity to present their comments. *Art. 113(1)*

This provision is intended to ensure that no party can be taken by surprise by grounds for a decision against his application on which he did not have an opportunity to present his comments.

In substantive examination, the applicant must have an opportunity of presenting his comments on all the grounds invoked against his application.

Before an application is refused, the search under Art. 54(3) should be completed (see also C-IV, 7.1).

In opposition proceedings, if the patent is to be revoked, it should be ensured that the proprietor of the patent in particular is given sufficient opportunity to defend himself and, similarly, if the oppositions are to be rejected or if, despite the claims of the opponents, the patent is to be maintained in amended form, the opponents in particular should be given the same opportunity. A decision may be based on grounds indicated in a document from one of the parties, provided the document has been sent to the other party so that he has had an opportunity to comment.

If more than two months have elapsed between despatch of the document "only for information" and the issue of the decision, this generally means that the party has had sufficient opportunity to comment and his right to be heard has therefore not been infringed (T 263/93).

If the patent is to be maintained in amended form, there must be a text of the claims and description which has been approved by the patent proprietor (D-VI, 2), and the opponent(s) must have had an opportunity to comment on it.

#### 1.2 Examples

The right to be heard is a right not just to present comments but also to have those comments duly considered. Amendments and arguments submitted by a party need to be considered, and the party must be given an opportunity to comment on the grounds and evidence brought forward by the Examining Division (see T 1123/04 and T 852/07). A document should not be cited for the first time in a decision (see T 635/04) unless it has been introduced during oral proceedings. The use of fresh arguments in a decision still based on grounds and evidence communicated beforehand is not precluded (see T 268/00 and T 1557/07).

If a case is remitted from the Boards of Appeal for further prosecution, the Examining Division must check whether requests from examination proceedings prior to the appeal are still outstanding and must give the party an opportunity to comment (see T 1494/05). If the facts and grounds essential to a decision have been submitted by one party and if the party whose case is to be rejected has been afforded sufficient time to comment, the principle concerning the right to be heard set out in Art. 113(1) will have been respected. If the decision in opposition proceedings is to be based on grounds which were raised in the examination proceedings but not in the notice of opposition, the observations by the parties or the communications of the Opposition Division, these must be introduced (i.e. raised for discussion) by the Opposition Division in the opposition proceedings before the decision is given so as to afford the parties an opportunity to comment. If the opposition is based on lack of inventive step, the proprietor of the patent must expect that the prior art newly designated in the opposition proceedings will be considered in conjunction with the prior art described in the introductory part of an independent claim. However, if new facts and grounds are introduced during the proceedings or if the facts and grounds on which the envisaged decision is to be based were not stated so unambiguously and clearly in the written submissions of the parties as to give a party occasion to comment, the party concerned must be given an opportunity to submit an opinion and to produce evidence before the decision is given.

A patent proprietor's right to be heard has not however been violated if he makes only minor amendments to the claims in response to a communication from the Opposition Division setting out the material arguments against maintaining the patent as it stands, with the result that the grounds for revoking the patent remain essentially unchanged, provided the proprietor's comments have been duly considered.

In such a case, where the obstacles to maintenance have already been put to the proprietor and continue to apply, the patent may be revoked immediately, without any need to communicate again the full arguments on which the decision would be based.

## **2. Consideration of time limits**

A decision may not be given until any time limit set has expired, unless all the parties affected by the time limit expressly agree that it need no longer be observed or have submitted their final opinions before it expires. The decision to grant a patent may be given once the applicant is deemed to have approved the text submitted to him under Rule 71(5) and has fulfilled all other formal requirements, even if the time limit set in the Rule 71(3) communication has not yet expired.

Moreover, as a rule, decisions should not be given until an internal EPO time limit (e.g. 20 days) following upon the official time limit (but from which the parties may derive no rights) has expired, so as to ensure that documents received at the end of the period officially allowed have actually been entered in the files when the decision is being taken and can be taken into account in the decision.

With reference to submissions and applications received after expiry of a time limit, see E-VII, 1.8.

### 3. Authoritative text of documents

The EPO must decide upon the European patent application or the European patent only in the text submitted to it, or agreed, by the applicant or proprietor and last used as a basis for the proceedings. Consequently, for example, an amended version proposed by the Examining or Opposition Division (see C-V, 1.1, D-VI, 4.2 and 7.2.1) may only be adopted as a basis for the decision if it has been approved by the applicant or proprietor. *Art. 113(2)*

In the case of one or more auxiliary requests directed to alternative texts for grant or maintenance of a patent, every such request qualifies as a text submitted or agreed by the applicant or proprietor within the meaning of Art. 113(2) (see T 234/86), and therefore must be dealt with in the order indicated or agreed to by the applicant or proprietor, up to and including the highest-ranking allowable request, if any.

When considering such requests it is essential that they are treated in the correct order. Thus, for instance, if the only allowable request is an auxiliary request, but is accompanied by a higher auxiliary request for oral proceedings (e.g. a request that oral proceedings be held if the main request cannot be granted) then a communication under Rule 71(3) could not be issued on the basis of the allowable request, but instead oral proceedings in accordance with the higher request would have to be appointed, or a further communication under Rule 71(1) issued (see E-IX, 5.3). If the order of the requests is not clear from the applicant's submissions, then it would be necessary to contact the applicant to clarify the situation before proceeding.

### 4. Written form of decisions

#### 4.1 General remarks

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

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

The written decision will contain:

- the names of the parties to the proceedings (applicant, proprietor, opponents) and, if applicable, their representatives;
- the order, and, if necessary;
- the facts and submissions;
- the reasoning;
- the communication of the possibility of appeal (Rule 111(2)); and

- Rule 113(1)* – the signature(s) and the name(s) of the employee(s) responsible.

If the decision is produced by the employee responsible using a computer, the EPO seal may replace the signature. If it is produced automatically by a computer the employee's name may also be dispensed with (Rule 113(2)). The file copy contains the names and the actual signature(s) of the employee(s) responsible.

If, exceptionally, one or more Division members cannot sign the decision, e.g. owing to extended illness, only a Division member who was present at the oral proceedings (preferably the chairman) may sign it on their behalf (see T 243/87). A written decision signed by someone who did not take part in the oral proceedings at which the decision was pronounced is not legally valid (see T 390/86).

The presentation of the facts and the submissions, the reasoning and the communication of the means of redress are generally omitted when a decision merely meets the requests of all the parties concerned; this applies in particular to the decision to grant, which is based on the documents that the applicant has approved (Rule 71(5)). The same applies when the patent is maintained in an amended form, because this is preceded by a final interlocutory decision pursuant to Art. 106(2) concerning the documents on which the maintenance of the patent is to be based (see D-VI, 7.2.2). In individual cases, consideration may also be given to the reasoning of those decisions which merely meet the requests of the parties. If, for example, a number of reasons are invoked for a request for re-establishment, of which only one justifies re-establishment, a reasoned decision on re-establishment may be appropriate, in order to clarify the official action.

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

#### **4.2 Order**

The order may be, for example, as follows:

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

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

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

#### **4.3 Facts and submissions**

Facts and submissions have to be given insofar as they are significant for the decision.

Under facts, a brief description of the case and a summary of the main reasons on which the decision is based and of the most important replies of the parties should be given. These points, however, are to be covered in

detail in the subsequent reasoning. Facts and submissions which are irrelevant to the decision, e.g. requests for amendment which are not maintained, are to be omitted.

The facts and submissions must clearly indicate what is the subject of the application and show on which documents (in particular which claims) the decision is based. The text of the independent claim(s) and other especially important claims or passages of the description on which the decision is based must be cited verbatim in the language of the proceedings (Rule 3(2)) either by copying the text into the decision or annexing a copy of the claims. As regards the dependent claims, it may be sufficient to refer to the file content.

#### **4.4 Decision on the file as it stands**

Applicants may request a decision "on the file as it stands" or "according to the state of the file", e.g. when all arguments have been sufficiently put forward in the proceedings and the applicant is interested in a speedy appealable decision. C-V, 15 and sub-sections, describes the procedure to be followed in case of such a request.

### **5. Reasoning of decisions**

The statement of grounds must first set out and substantiate why the Division is of the opinion that no patent can be granted, citing the individual EPC articles and rules involved.

The Division will draft the decision based on one or more grounds forming the basis of the decision, as appropriate. It is essential in such cases that the parties should have been given an opportunity to comment on all the grounds on which the decision is based.

When several grounds are used in the decision, it is imperative to link them in a logical way, in particular avoiding that a subsequent ground contradict a preceding one. Furthermore, the chain of grounds should be structured so that it starts with the main ground.

#### *Example:*

Often an application lacking an inventive step also lacks clarity. The decision must clearly set whether the application is refused because the subject-matter of the claims is unclear and would also lack inventive step once clarified or whether it is refused because the subject-matter of the claims lacks inventive step and would have to be clarified once the inventive step objection is overcome.

The reasoning for each of the grounds on which the decision is based must contain, in logical sequence, those arguments which justify the order. It should be complete and independently comprehensible, i.e. generally without references. If, however, a question has already been raised in detail in a particular communication contained in the file, the reasoning of the decision may be summarised accordingly and reference may be made to the relevant communication for the details.

*Art. 113(1)  
Rule 111(2)*

The conclusions drawn from the facts and evidence, e.g. publications, must be made clear. The parts of a publication which are important for the decision must be cited in such a way that those conclusions can be checked without difficulty. It is not sufficient, for example, merely to assert that the cited publications show that the subject of a claim is known or obvious, or, conversely, do not cast doubt on its patentability; instead, reference should be made to each particular passage in the publications to show why this is the case.

The arguments put forward by the examiner during the proceedings should form the "skeleton" for the decision and already define a complete and unbroken chain of reasoning leading to refusal. The decision may be based only on reasons already communicated to the applicant (Art. 113(1)). The applicant's arguments must be dealt with either point by point at the appropriate juncture in the chain of reasoning or en bloc at the end. The latter approach is often preferable as it makes clear that the final result is based solely on reasons already communicated to the applicant in compliance with Art. 113(1). In the part refuting the applicant's arguments, the decision should make clear why none of those arguments persuaded the Examining Division to depart from the final result.

It is particularly important that special attention should be paid to important facts and arguments which may speak against the decision made. If not, the impression might be given that such points have been overlooked. Documents which cover the same facts or arguments may be treated in summary form, in order to avoid unnecessarily long reasoning.

The need for complete and detailed reasoning is especially great when dealing with contentious points which are important for the decision; on the other hand, no unnecessary details or additional reasons should be given which are intended to provide further proof of what has already been proven.

The decision is a standalone document and should include the statement that the application is refused. This serves to indicate that, in case of several grounds, all of them form the basis for the refusal.

The decisions should not contain any matter on which the parties have not had an opportunity to comment.

### **5.1 Content**

The decision should normally deal with all independent claims of the valid request(s) that were discussed during the proceedings. A single ground is enough to refuse an application, so it is not always necessary to deal with all the dependent claims. If however a particular dependent claim has been discussed, the decision should include the relevant arguments.

Any additional requests still outstanding must be dealt with in the refusal decision. If, for example, new oral proceedings were requested in circumstances where Art. 116(1), second sentence, applies, the decision should give the reasons for rejecting that request.

Formulations implying doubt or uncertainty, such as "seems" or "apparently", should be avoided in decisions.

## 5.2 Analysing the parties' arguments

All significant arguments advanced by a losing party to the proceedings should be carefully examined and comprehensively refuted in the decision. The decision must substantiate the Division's view that none of the submitted arguments overcome the objections it has raised.

However, facts not in dispute need be mentioned only briefly. Arguments by the parties which are clearly irrelevant to the issues involved do not need to be discussed.

## 5.3 Main and auxiliary requests

If during **examination proceedings** a main and auxiliary requests have been filed (see E-IX, 3) and none of these is allowable, the reasons for the decision to refuse the application pursuant to Art. 97(2) must not be limited to the main request, but must also comprise the reasons for the non-allowability of each auxiliary request. If one of the requests is allowable, the communication pursuant to Rule 71(3) is to be issued on the basis of the (first) allowable request and must be accompanied by an explanation of the reasons why the higher-ranking requests are not allowable (see C-V, 1.1). Should the applicant, in response to the communication pursuant to Rule 71(3), maintain higher-ranking requests which are not allowable, a decision to refuse the application pursuant to Art. 97(2) will normally be issued (see C-V, 4.7 and 4.6.2); the reasons must set out the grounds for the non-allowability of each request which ranks higher than the allowable request. In respect of the allowable request, the decision to refuse must mention that the applicant has failed to give his approval to it.

Similarly, if in **opposition proceedings** the proprietor has submitted in addition to his main request one or more auxiliary requests, none of which is allowable, the patent must be revoked and the decision must set out, in respect of each request submitted and maintained by the proprietor, the reasons for not allowing it. Where one of the proprietor's requests directed to the maintenance of the patent in amended form is allowable, an interlocutory decision is to be issued on the basis of the (first) allowable request; it has to set out the reasons why this request meets the requirements of the EPC and, additionally, the reasons why the higher-ranking requests do not.

Insofar as a decision includes the rejection of any of the multiple requests, such decision may not be taken until the applicant or proprietor has been informed, with respect to each of these requests, of the reasons for not allowing them, so that the applicant or proprietor is not deprived of the opportunity to present comments (Art. 113(1) – right to be heard). Similarly, an opportunity to comment must be granted to the opponent(s) with respect to an auxiliary request before it is held allowable by an interlocutory decision (see D-VI, 7.2).

Practical considerations will determine at which point in the decision the auxiliary request is dealt with.

#### **5.4 Late-filed submissions**

Rule 116  
Rule 137(3)

If an Examining or Opposition Division has exercised its discretion under Rule 116 to refuse late-filed facts, evidence or requests, its decision must give the reasons for its refusal. A mere reference to the discretionary power given under Rule 116 is not sufficient. The same applies to the exercise of an Examining Division's discretion to refuse amendments under Rule 137(3) (see T 755/96). For details on how to exercise this discretion, see H-II, 2.7.

#### **6. Decisions which do not terminate proceedings – interlocutory decisions**

Art. 106(2)

Interlocutory decisions may be given in principle. However, it should be borne in mind that pursuant to Art. 106(2), a decision which does not terminate proceedings as regards one of the parties can only be appealed together with the final decision, unless the decision allows separate appeal.

The competent department should use its discretion as to the need for an interlocutory decision (see, however, D-VI, 7.2.2 with respect to the interlocutory decision for maintenance of a patent in amended form in opposition proceedings). To avoid fragmentation of the proceedings, such decisions should be the exception rather than the rule and should be given only if the duration or cost of the proceedings as a whole is thereby reduced. The interests of the parties should also be borne in mind as appropriate. In the normal course, an interlocutory decision should be contemplated only for the purpose of ruling that separate appeal may be made, as only in this way can a decision be obtained on a preliminary point before the final decision terminating the proceedings is reached. (The proceedings must be suspended until the decision has become final.) It is especially important to allow separate appeal where the continuation of the proceedings depends on a preliminary ruling on a fundamental point of law, e.g. where different Boards of Appeal have given different rulings or conflicting decisions have been given by different Examining or Opposition Divisions and no decision on appeal has been given in the matter. Interlocutory decisions must state the reasons on which they are taken; if it is decided not to allow separate appeal, the reasons for this ruling may be given only in the final decision.

#### **7. Binding nature of decisions on appeals**

Art. 111(2)

If a department has to give a decision in a case which has already been remitted by the Board of Appeal for further prosecution to that department, it is bound by the *ratio decidendi* of the Board of Appeal, insofar as the facts, e.g. the subject-matter of the patent and the relevant state of the art, are the same.

An Opposition Division is not bound by a decision of a Board of Appeal on appeal against a decision from an Examining Division (see T 167/93). The exclusive phrasing of the last sentence of Art. 111(2), only mentioning the Examining Division being bound by the decision on appeal against a decision of the Receiving Section, makes this clear. Opposition

proceedings are entirely separate from the examination proceedings, and the Opposition Division is entitled to examine the facts, evidence and arguments anew, particularly since another party (the opponent) is now involved. It should, however, take due notice of the assessment of these facts, evidence and arguments as contained in the reasons of the decision of the Board of Appeal.

#### **8. Information as to means of redress**

Decisions of the EPO which are open to appeal must be accompanied by a written communication of the possibility of appeal. The communication must also draw the attention of the parties to the provisions laid down in Art. 106 to 108 and Rules 97 and 98, the text of which must be attached. The parties may not invoke the omission of the communication.

*Rule 111(2)*

#### **9. Notification**

Decisions must be notified as a matter of course (see E-I, 2).

*Art. 119*



## Chapter X – Impartiality of the Examining or Opposition Division

Members of the competent divisions may not take part in the decision on a case:

- (i) in which they may have any personal interest (partiality for subjective reasons) or
- (ii) in respect of which the applicant may have good reasons to suspect partiality (partiality for objective reasons).

For the objection to be admissible it must be raised immediately after the party has become aware of the reason for it. The request must also be accompanied by a reasoned statement of grounds setting out the facts and arguments in support of the objection and, where appropriate, any evidence. Unsubstantiated and merely general statements, e.g. based on the nationality of the examiner(s) concerned, are not admissible.

Any challenge to impartiality must be submitted to the competent division, which will forward it to the immediate superior of the members of the division (Rule 11(1)) along with the statement of the member(s) concerned on the facts and circumstances put forward by the party. The immediate superior will decide on the challenge. If the challenge to impartiality has been raised in written proceedings and has been considered allowable, the concerned member(s) of the division is/are replaced. If the challenge has been considered either inadmissible or not allowable, the reasons are issued in writing. These reasons are part of the final decision and will be appealable with it.

If the challenge to impartiality is raised in oral proceedings, the proceedings are interrupted in order for the immediate superior to assess the challenge. On the same day, the oral proceedings are resumed and the parties are informed on the outcome of the assessment. If the challenge is found allowable, the oral proceedings are then adjourned. Proceedings will be continued by a division in which the concerned member(s) is/are replaced.

If the challenge to impartiality is considered either inadmissible or not allowable, the oral proceedings will continue. The parties will be informed of the reasons during oral proceedings. These reasons become part of the final decision and are appealable with it.



## Chapter XI – Appeals

### 1. Suspensive effect

The Boards of Appeal are not bound by any instructions. Therefore this chapter deals in detail only with those questions which are relevant for interlocutory revision. At this stage of the proceedings the department of first instance is still competent.

*Art. 23(3)*

*Art. 109*

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

*Art. 106(1)*

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

### 2. Appeals after surrender or lapse of the patent

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

*Rule 98*

### 3. Appeals against the apportionment of costs

The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. A party to the proceedings who feels that he has been adversely affected by the apportionment of costs may therefore only file an appeal against the decision on costs if he also lodges an appeal against the decision on the opposition on other admissible grounds.

*Rule 97(1)*

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

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

*Rule 97(2)*

*Art. 13 RFees*

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

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

*Art. 107*

### 6. Time limit and form of appeal

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

*Art. 108*

## 7. Interlocutory revision

### 7.1 General remarks

*Art. 109(1)*

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

The obligation or possibility of rectification may thus arise in connection with a decision by the Receiving Section, the Legal Division or an Examining Division. In opposition proceedings, it only arises in the special case that all the notices of opposition have been withdrawn and the proprietor of the patent files an appeal.

*Art. 109(2)*

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

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

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

For the advantages of a decision covering more than one objection, see E-IX, 5.

The decision to allow interlocutory revision must be signed by all members of the Division as soon as they are available, even if this is after expiry of the three-month time limit.

In either case, whether the appealed decision is rectified or the appeal is remitted to the Board, the decision may be signed only by examiners belonging to the Division at the time of signature. If an examiner is absent for a long period or has left the department, a new member must be appointed to the Division.

### 7.2 Remittal to the Board of Appeal

*Art. 109(2)*

If the appeal is not allowed within three months after receipt of the statement of grounds, it must be remitted to the competent Board of Appeal

without delay, and without comment as to its merit. This means that the department of first instance should address no comments of substance to the Board. Internal notes made by Division members about the merits of the appeal should be kept in the non-public part of the dossier and should not be sent to the Board of Appeal.

The receipt of the statement of grounds of appeal is a prerequisite for the Examining Division when deciding whether the appeal is well-founded. Such statements can be filed at any time within four months from the notification of the decision (Art. 108). Therefore, the Examining Division will wait until all the grounds are received before deciding whether to allow interlocutory revision or to remit the appeal to the Board to ensure that the full content of the statement of grounds has been received.

### **7.3 Reimbursement of appeal fees**

In the event of interlocutory revision, reimbursement of appeal fees will be ordered by the department whose decision has been impugned if such reimbursement is equitable by reason of a substantial procedural violation. This is particularly the case when essential facts or evidence were not taken into consideration in arriving at a decision, e.g. where a document filed at the EPO in good time by the party concerned is not placed in the file before a decision is reached or where the decision is based on facts or evidence on which the party concerned had no opportunity of presenting his comments. The appeal fee is to be reimbursed, even if this was not explicitly requested by the appellant (see G 3/03).

*Rule 103(1)(a)  
Art. 109*

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

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

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

## **7.4 Examples**

### **7.4.1 No amended claims filed with the appeal**

If the applicant has filed an appeal but no amended claims, the Division should check whether the decision was correct in substance. Interlocutory revision should only be made if the decision was not correct in substance. A refund of the appeal fee is to be ordered if a substantial procedural violation has occurred (see E-XI, 7.3). If interlocutory revision is made and new objections arise, the Division should communicate these objections to

the applicant as often as necessary to reach a final decision on the file; this could include holding oral proceedings (again) and/or a second refusal.

*Example:*

The applicant points out in the letter of appeal that the Examining Division has overlooked a request for oral proceedings.

The Examining Division looks at the file and notes that this was indeed the case: interlocutory revision must be made, even if it results in a further refusal after oral proceedings have been held. The appeal fee must be refunded.

#### **7.4.2 Amended main/single request filed with the appeal**

If amendments clearly overcome the grounds for refusal, interlocutory revision should be granted even if further new objections arise. This is because the applicant has the right to examination in two instances (see T 219/93).

Important criteria are (see T 47/90):

1. the text is no longer the same
2. substantial amendments have been made.

"Substantial" amendments overcome grounds for refusal vis-à-vis the documents already cited in the decision (e.g. example (d) below).

The examiner has the discretion to decide whether, in each particular case, the amendments to the claims are such that examination has to be continued on a new basis, e.g. where a completely new line of inventive-step argumentation would be necessary.

In arriving at this decision, the examiner should take into account all the grounds mentioned in the original decision, including the main or supporting arguments already raised in previous objections to patentability to which the applicant has had an opportunity to respond and to which reference is made in the grounds of refusal (e.g. objections mentioned in previous communications, during personal consultation or at oral proceedings). This is in the interest of procedural efficiency and to the benefit of the applicant (no second appeal fee necessary).

If amendments made to the independent claims clearly do not meet the requirements of Art. 123(2), interlocutory revision should not be granted, but the Division should send the file to the Boards of Appeal. If there are doubts as to whether the amendments meet the requirements of Art. 123(2) or the amendments clearly meet the requirements of Art. 123(2), the Division should check whether the amended claims overcome the ground(s) for refusal as indicated above.

*Examples:*

- (a) The applicant has included a wording that has already been suggested by the examiner, the new claims are ready for grant but the description needs to be adapted: interlocutory revision must be granted since the grounds for the refusal have been overcome.
- (b) **Refusal for lack of novelty only.** New claims are clearly novel but not inventive. The question of inventive step had not been raised in the decision or in the previous procedure: there must be an interlocutory revision.
- (c) **Refusal for lack of novelty.** New claim 1 filed which includes a feature from dependent claim 3. This claim had already been discussed in the decision and was considered not to be inventive: no interlocutory revision.
- (d) **Refusal for lack of novelty over D1.** New claim 1 filed which includes a feature from the description. This feature had not been previously discussed *per se*; however, it is clearly disclosed in D1: no interlocutory revision since the ground for refusal – lack of novelty over D1 – has not been overcome.
- (e) **Refusal for lack of inventive step vis-à-vis D1 and D2.** New claims filed which include a feature from the description. This feature had not been previously discussed, but is clearly disclosed in D1, and therefore there is no change in the argumentation given: no interlocutory revision since the ground for refusal – lack of inventive step vis-à-vis D1 and D2 – has not been overcome.
- (f) **Refusal for lack of inventive step vis-à-vis D1 and D2.** New claim filed which includes five new features from the description. These features have not been previously discussed. The examiner notes that although these features are disclosed in D2, the lack-of-inventive-step argumentation would have to be revised: interlocutory revision should be made, since (i) the applicant has made substantial amendments to overcome the objections raised in the decision and (ii) the line of argumentation has to be revised.
- (g) **Refusal for novelty vis-à-vis D1.** New claims filed which clearly relate to unsearched subject-matter and which do not combine with the original searched claims to form a single general inventive concept: no interlocutory revision because said claims cannot be allowed in the proceedings.

#### 7.4.3 Main and auxiliary requests filed with the appeal

Interlocutory revision is never possible on the basis of an auxiliary request, even if an auxiliary request would overcome the grounds for the decision (T 919/95).

*Example:*

The main request is the same as the one refused (i.e. not amended). However, the auxiliary request corresponds to a suggestion made by the Examining Division and would thus be allowable. There can be no interlocutory revision since the applicant has the right to have his main request examined by the Boards of Appeal.

**8. Rules of Procedure for the departments of second instance**

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

**9. Remittal to the Division after appeal****9.1 Orders on remittal**

If a decision by an Examining or Opposition Division is appealed, the Board of Appeal may remit the case to the Division under Art. 111(1). In such cases, the exact wording of the orders must be complied with. Various situations may arise:

- (a) The case is remitted for grant or maintenance in amended or limited form on the basis of a complete text which has been finally decided by the Board.
- (b) The case is remitted for the description to be brought into line with claims whose wording has been finally decided by the Board.
- (c) The case is remitted for further prosecution.

**9.2 Consequences for the Division**

In situation (a) above, grant or maintenance is handled by the formalities officer, and the dossier goes back to the Division merely for checking the classification and title and adding any references to supplementary technical information (STIN) or newly cited documents (CDOC).

In situation (b) above, the Board has taken a final decision on the wording of the claims which ends the matter. The Division can no longer amend the claims or allow the applicant or proprietor to do so, even if new facts (e.g. new relevant citations) come to light (see T 113/92, Headnote No. 2, and T 1063/92, Headnote, second paragraph). Corrections under Rule 139, however, may still be allowable.

Applicants and proprietors should exercise all possible procedural economy when bringing the description into line with the claims' wording as decided by the Board of Appeal. Normally, therefore, completely retyped texts should not be accepted (see T 113/92, Headnote No. 1).

In situation (c) above, the Division whose decision was appealed is bound by the Board's *ratio decidendi*, in so far as the facts are the same

(Art. 111(2)). However, new relevant documents or facts which come to light must be taken into account. In particular:

- (a) the parties must be given the opportunity to submit further requests, and
- (b) the Division must check whether requests from examination or opposition proceedings prior to the appeal (e.g. for oral proceedings) are still outstanding – see T 892/92, Headnote.



## Chapter XII – Request from a national court for a technical opinion concerning a European patent

### 1. General

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

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

The Examining Division responsible for the technical opinion should give the parties an opportunity to submit arguments in writing if the court so permits. However, the parties have no right to be heard before the EPO. Nevertheless, where the Examining Division considers it necessary, it may invite the parties, via the court and provided that the court so permits, either to be heard before the Examining Division or to submit supplementary observations on specific points identified by the Examining Division. If the parties are heard, such a hearing is not considered to constitute oral proceedings within the meaning of Art. 116.

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

### 2. Scope of the technical opinion

The Examining Division is obliged to give a "technical opinion" upon request. This means that the Division is bound to give an opinion only insofar as the questions put are of a technical character. However, the Examining Division should not be too restrictive in this regard but should attempt to assist the national court as much as is reasonably possible, while remembering that the actual decision on infringement or revocation is exclusively a matter for the national court.

Generally speaking, the Examining Division should attempt to give a technical opinion on any question which is similar to those normally dealt with in European substantive examination work, even when the question has a legal, as well as a technical, aspect. On the other hand, the Examining Division should decline to make any specific statement on whether a patent is valid or on whether it is infringed. It should also not give any opinion on the extent of protection (Art. 69 and the accompanying Protocol).

A request from a national court is to be expected to be clearly and precisely formulated, so that the Examining Division will be in no doubt as to the

questions on which the court wishes to have an opinion. Since the court is responsible for deciding the issues of law involved in the questions and since most questions include a mixture of legal and technical aspects, the court is expected where possible to separate clearly the legal aspects from the technical aspects upon which it seeks the opinion of the EPO.

### **3. Composition and duties of the Examining Division**

#### **3.1 Composition**

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

In order to guarantee that the opinion given is not influenced by earlier proceedings within the EPO on the application/patent in question, examiners who have taken part in such earlier proceedings as members of an Examining or Opposition Division should be excluded from the Examining Division set up under Art. 25. Where this is not practicable, the national court and the parties should be informed of the proposed members of the Examining Division under Art. 25 and of which among these members participated in European examination or opposition proceedings on the case. The court should be asked to state whether, in the circumstances, the request for a technical opinion is maintained.

#### **3.2 Duties**

The primary examiner will act on behalf of the Examining Division and will normally be responsible for issuing communications to the court. The primary examiner should also draft the written opinion and should circulate the draft to the other members of the Examining Division for consideration. If any changes are proposed in the draft and there are differences of view on such changes, the Chairman should arrange a meeting to resolve the matter. The final opinion should be signed by all members of the Division.

### **4. Language to be used**

In principle the language to be used should be the language of the proceedings of the European patent; however, if the court so requests, another official language of the EPO may be used. At least the request itself, any submissions from the parties, and any amendments to the patent should be in that language or translated into that language. The opinion should also be produced in that language. However, where appropriate, the Examining Division should pay regard to the provisions of Art. 70(2) to (4).

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

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

## 5. Procedure

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

### 5.1 Formalities check

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

*Art. 2, No. 20, RFees*

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

### 5.2 Preliminary examination

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

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

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

### 5.3 Withdrawal of the request

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

*Art. 10 RFees*

### 5.4 Establishment and issue of the technical opinion

After any deficiencies as referred to in E-XII, 5.1 or E-XII, 5.2, above have been met, the Examining Division should establish the technical opinion as soon as possible.

The opinion should be sent to the national court. Any papers received from the court which belong to the national proceedings should be sent back with the opinion.

**5.5 File inspection**

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

**5.6 Appearance before the national court**

If, after the opinion is issued, the national court asks the Examining Division to appear before it, the court should be informed that the EPO is willing to send one member of the Division provided that his costs are paid and on the understanding that this member will be required only to answer questions on the technical opinion given and will not be required to give an opinion on additional matters unless notice in writing of these additional matters is given to the Examining Division at least one month before the appearance before the court.

## Chapter XIII – Registration of changes of name, transfers, licences and other rights

### 1. General

Pursuant to Rules 22 to 24 and 85 in conjunction with Rule 143(1)(w), rights and transfer of such rights relating to an application or a European patent are registered in the European Patent Register.

Transfers and changes of name are recorded as particulars of the applicant in accordance with Rule 143(1)(f).

### 2. Responsible department

The Legal Division of the EPO bears the sole responsibility for these registrations (Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 600). *Art. 20*

The Legal Division may entrust specific duties which do not require legal expertise to formalities officers (Decision of the President of the EPO dated 21 November 2013, OJ EPO 2013, 601).

### 3. Transfer of the European patent application

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

Art. 72 is an autonomous provision which exclusively governs the formal requirements of such transfers. The EPO registers a transfer of rights in the European Patent Register on request, upon fulfilment of the prerequisites of Rule 22. The request is not deemed to have been filed until an administrative fee has been paid. The amount of the fee is determined by the latest schedule of fees and expenses of the EPO. *Art. 72  
Rule 22(1) and (2)*

Rule 22 furthermore requires the production of documents providing evidence of such a transfer. Any kind of written evidence suitable for proving the transfer is admissible. This includes formal documentary proof such as the instrument of transfer itself (the original or a copy thereof) or other official documents or extracts thereof, provided that they immediately verify the transfer (J 12/00). Article 72 requires that the signatures of the parties appear on the documents submitted as evidence of the transfer.

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

If the request complies with the requirements of Rule 22(1), the transfer is registered with the date on which the request, the required evidence or the fee has been received by the EPO, whichever is the latest. In case of a minor deficiency, i.e. if all requirements were present but not fulfilled completely (e.g. the request was signed but the name and/or position of the person signing were missing), once rectified the effective date is the date of receipt of the original request for registration.

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

*Art. 20* Once a transfer has been duly entered in the European Patent Register, the registration cannot be undone, even if it appears that one or more requirements were actually not fulfilled for reasons not apparent at the time when the transfer was registered by the EPO, e.g. where doubts arise later as to the entitlement of the person signing on behalf of one of the parties to enter such a transfer agreement (see decisions J 16/14 to J 22/14). The original status quo is no longer restored until the valid legal situation has been established. In the meantime, proceedings may have to be stayed under Rule 14 or 78 until it is clear who is the legitimate applicant/proprietor.

#### **4. Transfer of the European patent**

*Rule 85* Rule 22 applies *mutatis mutandis* to the registration of a transfer of the European patent during the opposition period or during opposition proceedings.

#### **5. Changes of name**

Mere changes of name, which do not involve a modification of the legal identity of the applicant, are registered in the European Patent Register upon request and production of relevant documentary evidence. Such registration is free of charge.

#### **6. Licences and other rights**

##### **6.1 Registration**

*Art. 71*  
*Art. 73*  
*Rule 23(1)*  
*Rule 24(a) and (b)* A European patent application may give rise to rights *in rem*, may be licensed and may be the subject of legal means of execution. This includes contractual licences only (Art. 73). Licences and other rights may be geographically limited to parts of the territories of the designated Contracting States only.

In the case of co-applicants, the registration of licences requires the consent of each of the co-applicants.

Rule 22(1) and (2) apply *mutatis mutandis* to the registration of the grant, establishment or transfer of such rights (see E-XII, 3).

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

##### **6.2 Cancellation of licences**

*Rule 22(2)*  
*Rule 23(2)* A registration of licences or other rights is cancelled upon request, supported by documents providing evidence that the right has lapsed or by

the written consent of the proprietor of the right to the cancellation of that right. Rule 22(2) applies *mutatis mutandis*, i.e. the cancellation is subject to the payment of an administrative fee.