

# **Part E**

## **Guidelines on General Procedural Matters**



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## Chapter I – 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, in so far 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 II – Communications and notifications

### 1. Communications

#### 1.1 General remarks

Communications are 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-III, 5); or
- (vi) if a decision is to be based on grounds on which the parties have not yet had an opportunity to comment (see E-X, 1).

#### 1.2 Number of communications

Since each communication issued may entail prolonging the proceedings, the proceedings are conducted in such a way as to manage with as few communications as possible. If a communication has to be issued, it will 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  
Rule 127

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; other communications are not subject to formal notification.

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, if so agreed by the addressee, 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 Electronic notification

Rule 127(2)

Where a user has agreed to receive communications electronically, the electronic document is deemed to be delivered to the addressee on the date it bears unless it has failed to reach its destination.

Even if the addressee can access the electronic document before the date of the document, the decisive date for the purpose of the notification fiction under Rule 127(2) is the date of the document.

In the event of any dispute concerning the delivery of the electronic document, it is incumbent on the EPO to establish that the document has reached its destination and to establish the date on which it did so.

If notification is contested and the EPO establishes that the document ~~has~~ reached its destination more than seven days after the date it bears, a period triggered by the deemed receipt of that document will be extended by the number of days by which these seven days ~~we~~are exceeded (see the EPO notice ~~from the EPO~~ dated 6 March 2023, OJ EPO 2023, A29). Rule 134(1) applies only once the period is extended according to the safeguard under Rule 127(2). See E-II, 2.4 for an example.

Notification may occur in electronic form to an activated Mailbox. Electronic notification comprises the decisions, summonses, notices and communications contained in a list published on the EPO website. The Mailbox may also be accessed through MyEPO Portfolio. For further details, see the decision of the President of the EPO dated 9 October 2023 concerning the web-based online service MyEPO Portfolio (OJ EPO 2023, A89) and the EPO notice dated 9 October 2023, (OJ EPO 2023, A90).

In the event that further means are introduced for electronic notification, the conditions and details will follow from the decisions governing the use of such means.

#### **2.4—2.3 Notification by postal services**

All notifications by postal services must be by registered letter (see also OJ EPO 2019, A57). 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.

Rule 126

~~Under Rule 126(2) as in force until 31 October 2023, 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.~~

~~With effect from 1 November 2023, Rule 126(2) is amended to read as follows: "Where notification is effected in accordance with **paragraph 1**, the A notified document shall be deemed to be delivered to the addressee on the date it bears unless it has failed to reach the addressee. In the case of notification irregularities, the safeguards set out in E-II, 2.3 apply.~~

Rule 126(2)

#### Example:

An examination report under Art. 94(3) bears a date of 30 January 2024 and sets a time limit of four months. The report is delivered on 3 February 2024, which is four days after the date it bears. Thus, there will be no extension under the safeguard and the document will be deemed notified on 30 January 2024. The four-month period triggered by the notification on 30 January 2024 falls on 30 May 2024, on which no mail is delivered in Munich (public holiday). Consequently, the time limit is extended under Rule 134(1) until 31 May 2024.

By contrast, if the document is delivered on 9 February 2024, i.e. ten days after the date it bears, the period will be extended by three days to expire on 2 June 2024 under Rule 126(2). Since 2 June 2024 is a Sunday, the period is further extended under Rule 134(1) to expire on 3 June 2024.

~~In the event of any dispute concerning the delivery of the document, it shall be incumbent on the EPO to establish that the document has reached its destination and to establish the date on which the document was delivered~~

~~to the addressee. If the EPO establishes that the document was delivered to the addressee more than seven days after the date it bears, a period for which the deemed receipt of that document is the relevant event under Rule 131, paragraph 2, shall expire later by the number of days by which the seven days were exceeded." (see the decision of the Administrative Council of 13 October 2022, OJ EPO 2022, A101, and the notice from the EPO dated 25 November 2022, OJ EPO 2022, A114).~~

Notification is deemed to have been effected, even if acceptance of the ~~letter~~ document 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**

*Rule 127*

~~Under Rule 127(2) as in force until 31 October 2023, 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.~~

~~With effect from 1 November 2023, Rule 127(2) is amended to read as follows: "Where notification is effected by means of electronic communication, the electronic document shall be deemed to be delivered to the addressee on the date it bears, unless it has failed to reach its destination. In the event of any dispute concerning the delivery of the electronic document, it shall be incumbent on the EPO to establish that the document has reached its destination and to establish the date on which it reached its destination. If the EPO establishes that the electronic document has reached its destination more than seven days after the date it bears, a period for which the deemed receipt of that document is the relevant event under Rule 131, paragraph 2, shall expire later by the number of days by which the seven days were exceeded." (see the decision of the Administrative Council of 13 October 2022, OJ EPO 2022, A101, and the notice from the EPO dated 25 November 2022, OJ EPO 2022, A114).~~

~~Currently, notification may occur in electronic form to an activated Mailbox. Electronic notification comprises the decisions, summonses, notices and communications contained in a list published on the EPO website. For the Mailbox service, 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).~~

~~The Mailbox may also be accessed through MyEPO Portfolio. For further details, see the decision of the President of the EPO dated 11 May 2022 concerning the web-based online service MyEPO Portfolio~~

~~(OJ EPO 2022, A51) and the notice from the EPO dated 11 May 2022, (OJ EPO 2022, A52).~~

~~In the event that further means are introduced for electronic notification, the conditions and details will follow from the decisions governing the use of such means.~~

## **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 addressees themselves and indicating the date of receipt, is accepted as proof. If it is evident from a reply from the addressees that they have received the document, although they do 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 III – Oral proceedings

### 1. General

#### 1.1 Introduction

By "oral proceedings" is meant formal proceedings within the meaning of Art. 116. The term does not include consultations such as occur in examination proceedings and limitation/revocation proceedings (see C-VII, 2). In view of Rule 81(2), such consultations are not allowed in opposition proceedings in which more than one party is involved unless the consultations concern 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 appointed officer and during the examination and opposition procedure before the whole division.

Art. 18(2)

Art. 19(2)

Art. 113

In matters lying within its competence, oral proceedings can be held before the Legal Division. Such proceedings are non-public in both *ex parte* and *inter partes* proceedings.

The right to oral proceedings forms a substantial part of the right to be heard under Art. 113.

#### 1.2 Format of oral proceedings

Oral proceedings are held by videoconference. In exceptional circumstances, where there are serious reasons against holding the oral proceedings by videoconference, they may be held on the premises of the EPO, either at the request of a party or at the instigation of the division (OJ EPO 2022, A103, OJ EPO 2022, A106). Examples of serious reasons are, in particular, reasons relating to a participant to the oral proceedings as an individual (e.g. a proven visual impairment that prevents a representative from following oral proceedings on screen) and reasons related to the nature and subject-matter of the proceedings (e.g. where they involve the demonstration or inspection of an object where the haptic features are essential, to the extent that this is possible in accordance with the applicable provisions). Sweeping objections against the reliability of videoconferencing technology or the non-availability of videoconferencing equipment will, as a rule, not qualify as serious reasons in this regard.

Participants must ensure that their videoconferencing equipment meets the technical requirements specified. They are encouraged to perform a test call well before the oral proceedings take place.

In addition to the summons, participants will receive an email confirming the date, time and the videoconference contact details to be used to establish the connection (in the form of a link or by other suitable means) and containing any further appropriate information, including on the organisation of the videoconference.

### 1.3 Request for oral proceedings to be held on EPO premises

A request that oral proceedings be held by way of exception on the premises of the EPO needs to be filed as early as possible, preferably together with the request for oral proceedings. The granting of a request for oral proceedings to be held on the premises of the EPO will be at the discretion of the competent division.

If the request for oral proceedings on the premises of the EPO cannot be allowed and is received after the summons to oral proceedings, the division will inform the parties that the oral proceedings will take place by videoconference as set out in the summons and include a brief reasoning as to why the request cannot be granted. If the request is received before the summons has been issued, the reasons for the refusal will be given in the annex to the summons. In either case, a refusal of this type is not separately appealable.

If a request for oral proceedings on the premises of the EPO is allowable and is received after the summons to oral proceedings by videoconference has been issued, the parties will be informed that oral proceedings will be held on the premises of the EPO as requested; where possible, the date of the oral proceedings will remain unchanged.

### 1.4 Request to hold on-site oral proceedings at a particular site

A request to hold oral proceedings at a particular EPO site is not admissible; a refusal by the competent department to accept such a request is not subject to appeal (see T 1142/12).

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

*Art. 116(1)*

If, in the course of proceedings, a party requests oral proceedings, the competent department must grant this request as further explained in this section. The EPO will not inform any party concerned of this right but will expect them – if they do not obtain satisfaction from the competent department – to request oral proceedings (if they so wish) before a decision is reached.

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).

*Art. 116(2)*

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).

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

With a conditional request for oral proceedings, i.e. if any party concerned has indicated that the request for oral proceedings has been made solely as



a precaution to cover the eventuality that the case they have 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, if the competent department considers that a decision on the matter may be reached on the basis of the written evidence on file 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 having unconditionally requested the oral proceedings, and providing there is no valid request for oral proceedings from a party adversely affected by the decision envisaged, the decision may be issued in writing without oral proceedings being held (T 1050/09).

### **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), any opponent still remains a party to the proceedings until such time as their 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**

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, irrespective of the form in which the oral proceedings were held.

*Art. 116(1)*

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-VI, 2). Only if the division, in the oral proceedings, has not announced a decision, but has decided to continue the proceedings in writing, can further submissions be examined. Such may be the case e.g. when the examining division indicates that it intends to grant a patent (or to limit a granted patent in limitation proceedings) on the basis of the documents filed during the oral proceedings.

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

### **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-IV, 1.3 and 1.6.1). The competent department will 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 is to settle as far as possible all outstanding questions relevant to the decision. To this end proceedings will be carefully prepared after examination of all the written matter submitted and with this in mind the most appropriate date for conducting oral proceedings is chosen.

When preparing oral proceedings, particularly in opposition, the division considers 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. 18(2) and 19(2)).

In so far 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 that it 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-VI, 2). Any observations should be received in time for them to be communicated to the other parties at the latest one month before the oral proceedings. The time limit for submission of observations is 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 a summons to oral proceedings be issued in substantive examination?

See C-VIII, 5.1 for when a summons to oral proceedings can be issued in examination proceedings.

~~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) will generally be sent before the division issues a summons to oral proceedings (see C-III, 4).~~

~~In particular, 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 in general not appropriate 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).~~

~~Exceptionally, summons to oral proceedings may be issued as the first action in examination proceedings, provided that the criteria set out in C-III, 5 are met.~~

~~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**

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

*Rule 115(1)*

*Art. 119*

The division sets a single date for the oral proceedings, i.e. one day or, in particular cases, more than one consecutive day. No pre-announcement of the date will be made. Oral proceedings may be set for any working day on which the EPO is open at the relevant site.

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. New documents may be cited in the annex to the summons (T 120/12), together with an explanation of their significance. However, examiners must carefully consider on a case-by-case basis whether citing a new document would introduce a new line of argument. At an early stage in the procedure, they must consider sending a further communication before issuing any summons if a new document needs to be cited. For the additional requirements of the accompanying note if the summons is issued as the first action in examination, see C-III, 5. The summons as well as the annexed communication can only be appealed together with the final decision unless a separate appeal is allowed (see E-X, 3).

*Rule 116(1)*

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) stipulates that at least two months' notice of the summons must be given unless the parties agree to a shorter period. Such agreement must be present in the public part of the file.

*Rule 115(1)*

Harmonised with the standards applied in the written procedure (E-VIII, 1.2), the practice outlined below is 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 is 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, where oral proceedings have been adjourned due to a lack of time, or where the date of the oral proceedings is changed to a later date (see also E-III, 7.1.3).
- (iv) Where the summons is issued as the first action in examination, six months are foreseen between the despatch of the summons and the date of the oral proceedings (see C-III, 5).

The summons must state that if parties duly summoned do not appear as summoned or fail to connect to the oral proceeding by videoconference, as the case may be, the proceedings may continue without them.

In opposition proceedings, where multiple oppositions have been filed, as a rule, a single hearing in oral proceedings is scheduled, even if the oppositions are based on different grounds (see D-I, 6). This means that all the parties must be summoned to attend them and may present comments on all grounds raised.

## **7. Change of date, cancellation or maintenance of oral proceedings**

### **7.1 Changing the date of oral proceedings**

#### **7.1.1 Requests to change the date of oral proceedings**

A request to change the date 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) and appropriate evidence, where necessary.

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, the Unified Patent Court or a national court or patent office
  - for the same date or
  - for the preceding or following day or
  - for at least one of the two preceding or two following days where participation in the oral proceedings requires travelling to or from 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 must indicate the circumstances (e.g. school holidays) which prevent the holidays from being rescheduled.

If the grounds for changing the date of 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 and annex a brief reasoning as to why in its view the criteria are not met.

The reasons that can be invoked to change the date 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.

In opposition proceedings, in particular if more than one opponent is involved, a more strict approach may be applied to prevent a series of changes of date (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.

As Mondays and Fridays are normal working days, oral proceedings will be scheduled for these days, too. The fact that this may necessitate 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 change the starting time in order to enable the party to travel on the same day.

### **7.1.2 Change of date of oral proceedings at the instigation of the division**

In exceptional cases the division might have to instigate the change of date of oral proceedings for reasons similar to those mentioned above. The date of the oral proceedings will, however, be changed only if a suitable replacement cannot be found.

### **7.1.3 Change of date of oral proceedings – defined notice period**

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

## **7.2 Cancellation or maintenance of oral proceedings**

### **7.2.1 General**

In response to submissions made by a party in reply to the summons to oral proceedings, the division may also decide to cancel the oral proceedings and continue the procedure in writing. If it takes such a decision, it notifies the parties accordingly. In the absence of such notification, the parties must be aware that oral proceedings will be held. However, as an additional service in examination proceedings, if oral proceedings are not cancelled following such submissions, the division informs the applicant that the date and time set for the oral proceedings are maintained.

### **7.2.2 Withdrawal of the request for oral proceedings**

If the request for oral proceedings is explicitly withdrawn, or if a written statement is to be interpreted as equivalent to a withdrawal of the request for oral proceedings (because the party has indicated that it will not attend – see T 3/90, T 696/02 and T 1027/03 – or has requested a decision according to the state of the file – see OJ EPO 2020, A124), it is within the discretion of the division to decide whether the scheduled oral proceedings are to be maintained or to be cancelled.

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 any applicant or patentee decides not to attend the oral proceedings, they are 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 their absence. The procedural principles require that the party to the proceedings is not taken by surprise by the decision (see also E-III, 8.3.3).

## 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-III, 9), are public before the opposition divisions in so far 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 any of the parties wishes to give information about sales figures or other commercial secrets in support of their case. Generally, the public will only be excluded whilst such information is being given. The public is also excluded during discussions about a request for exclusion of a document from file inspection (see D-II, 4.3) and when a decision on the matter is pronounced. The parties other than the requester(s), as well as their representatives, may also be excluded as being part of the public (e.g. in the case of a request for exclusion of a medical certificate from file inspection). *Art. 116(4)*

[Members of the public may be granted remote access to opposition oral proceedings via a link provided upon request. See OJ EPO 2022, A106, for details about the request and the conditions.](#)

### 8.2 Conduct of oral proceedings

Before the Receiving Section oral proceedings will be conducted by the appointed officer and before the examining or opposition divisions by the chair of the division concerned. Before the Legal Division, oral proceedings will be conducted by one legally qualified member of the Legal Division.

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. In the case of oral proceedings by videoconference, the person conducting them must ascertain that no technical problems have prevented the oral proceedings from being conducted in accordance with the right to be heard and the right to oral proceedings (see E-III, 8.2.3).

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 is to 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 Participation of parties and their representatives from different locations**

A party, its representative and any persons accompanying the parties or representatives, as well as witnesses and experts, may connect to the videoconference from different locations.

### **8.2.2 Participation of members of the division from different locations**

The members of the examining and opposition divisions may equally connect to the oral proceedings by videoconference from different locations. In such cases, the members of the division will deliberate and vote among themselves via a separate communication channel. The venue of oral proceedings will be deemed to be the location where the division is set up.

The applicant or representative will be informed of the remote participation of the members of the division at the beginning of the oral proceedings, after the connection has been established and before they are formally opened.

### **8.2.3 Technical problems**

OJ EPO 2022, A103

Where technical problems occur such that the oral proceedings held by videoconference 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 parties, due to the technical problems, might be taken by surprise by the grounds mentioned in an adverse decision on which they have not had an opportunity to comment.

If the sound or image transmission of any of the participants taking part in the oral proceedings is lost, the chair will stop the proceedings until the transmission is re-established.

If a participant is disconnected for more than a few minutes, a member of the division will contact that party to see if they are having technical problems. Any relevant information will be shared with all parties.

If a party reconnects after a temporary connection failure, the chair will make sure that no information has been missed. Some arguments might have to be repeated.

If, despite all efforts of the participants, technical problems prevent the oral proceedings by videoconference from being conducted in accordance with the parties' rights under Art. 113 and Art. 116, the videoconference will be terminated. A new summons to oral proceedings will be issued. As a rule, new oral proceedings will be held by videoconference unless there are serious reasons for not doing so (E-III, 1.2).



### **8.2.4 Recording**

The recording of oral proceedings by the parties is not permitted (see E-III, 10.1). At the beginning of the videoconference, the chair will therefore remind all participants that recording of the videoconference is prohibited.

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

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

The division will check the ID document of one representative or authorised employee of each party unless this person is personally known. For other representatives, authorised employees and accompanying persons (including those who will be making oral submissions, see E-III, 8.5) present for a given party, it is sufficient that their identity is confirmed orally by the person whose ID documents were checked or who is personally known to at least one member of the division. This applies independently of whether a representative is a professional representative or a legal practitioner. Equally, if a party is not represented but personally present together with an accompanying person, it is sufficient to check the ID document of that party.

However, the division checks the ID documents of all parties, witnesses and experts summoned to give evidence before the EPO. Moreover, the division may check ID documents of other attendees where this is considered necessary, e.g. because the identity of an accompanying person is challenged by another party or where the division has serious doubts about the identity of the person.

The identity document may be presented in one of following ways:

- If the identity document is an EPO badge, by showing it to the camera at the beginning of the videoconference in the public meeting room.
- If the identity document is a national ID card or passport, by showing it to a member of the division in a separate non-public meeting room.
- By sending a copy to the email address provided to the parties at the beginning of the oral proceedings.
- By using the EPO online filing options up to two days prior to the oral proceedings.

For data protection reasons, copies of identification documents sent by email are deleted and not included in the file; copies submitted via the EPO online filing options are placed in the non-public part of the file.

In order for the division to be able to confirm the identity of the person concerned, the full name (first name and surname) and the picture of the ID should be visible. All the other information on the identity document can be kept hidden if so wished, as long as it is possible to recognise that it is an official identity document.

Professional representatives need to file authorisations only in exceptional cases (see the decision of the President of the EPO dated 12 July 2007, 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

- (i) a professional representative acting under a sub-authorisation
- (ii) a professional representative from the same agency as the representative acting in the case, or
- (iii) 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 My Files 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 – by email in the case of oral proceedings by videoconference (OJ EPO 2020, A71) – an individual authorisation.

Any person without an authorisation will be requested to submit one without delay. If they are 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 must be reminded to file the authorisation.

### 8.3.2 Opening the oral proceedings

After opening the oral proceedings any person conducting them will introduce the parties present. They 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-III, 10).

### 8.3.3 Late arrival, non-appearance and failure to connect

#### 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 any party who has been duly summoned to oral proceedings does not appear as summoned or fails to connect to the oral proceedings by videoconference, as the case may be, the oral proceedings may be conducted without them, since a party should not be able to delay issuance of a decision by failing to appear or connect.

*Rule 115(2)*

It is to be noted that if any party appears or connects **before the end** of the oral proceedings, they have the right to be heard.

If the party appears or connects 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.

If, however, an allowable request for a change of date of oral proceedings has been filed (see E-III, 7.1.1), the proceedings are postponed and a new date fixed. If the filing of the request was delayed due to the carelessness of the party concerned, the proceedings may, depending on the circumstances, still be postponed; if this happens in opposition proceedings, a decision on the apportionment of costs may have to be taken (see D-IX, 1.4).

*Art. 104(1)*

#### 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-VI, 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, in so far 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 applicants an opportunity to exercise their rights under Art. 113(1). In examination proceedings, when applicants file amended claims before oral proceedings which they subsequently do not attend, they may expect a decision based on objections which might arise against such claims in their 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 annex to the summons to oral proceedings must include all the objections that are likely to be discussed during oral proceedings and 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.

Where auxiliary requests are filed before the summons to oral proceedings is issued, these requests must be commented on in terms of both admissibility and allowability. However, the reasoning given in the preliminary opinion is to focus on the main request; only a brief indication of the essential reasons for the non-allowability of the subject-matter or the non-admissibility of the auxiliary requests is to be provided. It is to be noted that this brief indication of the essential reasons for not allowing or not admitting the auxiliary requests has to be thorough enough to ensure that the applicant has been informed of the objections raised by the examining division and has thus been given the opportunity to comment on them (see C-V, 1.1 and C-V, 4.7.1.1).

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

In so far 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 will 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 will be given the opportunity of making a final reply.

The submissions of the party or parties may be prepared in writing, although they are expected to be made extemporaneously as far as possible. Passages from documents already introduced into the proceedings which are referred to again may 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 or the Legal Division. In opposition proceedings the division will 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 will 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 will make sure that requirements such as typed-form, signature and dating of the submissions are met (T 733/99). See also E-III, 8.7 and OJ EPO 2020, A71.

### **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 or the Legal Division (T 1556/06), and, in the case of oral proceedings on the EPO premises, if the necessary equipment is available in the room in which the oral proceedings are held. Generally, screens are available in most meeting rooms; however, requests to provide further equipment such as projectors will be refused.

Care must 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, screensharing).

#### **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 will 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 must be found between the presenter's interest in defending the case in the most appropriate manner and the other 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 will 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-VI, 2).

~~The same considerations apply to oral proceedings before the Legal Division where they constitute *inter partes* proceedings.~~

#### 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 will 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-VI, 2);
- (b) the submissions contribute to the resolution of the questions at issue.

~~The same considerations apply to oral proceedings before the Legal Division where they constitute *ex parte* proceedings.~~

#### 8.5.2 Written submissions during oral proceedings by videoconference

Where oral proceedings are held as a videoconference, documents filed subsequently as referred to in Rule 50 must be filed by email (OJ EPO 2020, A71, **Art. 1(1)**). This also applies to authorisations.

Where filed documents require signature, this signature ~~may be~~ is preferably applied to the attached document. ~~-or- Alternatively, to it may appear in the text of the accompanying email, -which will also be annexed to the minutes.~~ The signature must take the form of a string of characters (such as an email signature with the sender's name and position) or a facsimile signature.

OJ EPO 2020, A71,  
**Art. 2**

The documents are to be sent to the email address indicated during the videoconference by the competent department.

OJ EPO 2020, A71,  
**Art. 3**

Any emails and attached documents filed by a party during oral proceedings with more than one party will be forwarded by the division to the other parties present at the proceedings unless the party in question has already sent them direct to the email address indicated by the other parties. Therefore,

OJ EPO 2022, A106

each party must communicate to the ~~chair~~ division and, where possible, to the other parties at the beginning of the oral proceedings the email address it wishes to use for receiving copies of such documents. Parties and representatives must ensure that they can immediately take note of any document sent to the email address indicated by them.

OJ EPO 2020, A71,  
Art. 4

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 of the Administrative Instructions under the PCT). 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 party must be promptly informed during the videoconference. Where the deficiencies cannot be remedied during the videoconference or within the time limit set, 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 division ~~or (in the case of consultations) the examiner~~ and which can be reproduced in a legible form. Otherwise they are deemed not to have been filed.

If an attachment is infected with a computer virus or contains other malicious software, it will be deemed to be illegible. The EPO is not obliged to receive, open or process any such attachment.

OJ EPO 2020, A71,  
Art. 5

No paper documents need be filed to confirm documents filed by email.

OJ EPO 2020, A71,  
Art. 6

All submissions made by email during a videoconference must be annexed to the minutes 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, 2.3 and Special edition No. 3, OJ EPO 2007, J.3). A confidentiality note which is routinely included in emails is not to be regarded as a request to exclude these submissions from the public file.

OJ EPO 2022, A106

If the division consents, a party may present its screen for illustrative purposes. An item displayed in that way will not be considered as a document submitted by that party.

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

With respect to facts, evidence or amendments not submitted in due time or arguments presented at a late stage in the proceedings, including during oral proceedings, see E-VI, 2.

## 8.7 Handwritten amendments in oral proceedings

### 8.7.1 General principles

The requirement of Art. 2(7) of the decision of the President of the EPO dated 25 November 2022 that the description, claims and abstract, as well as the request for grant, must be typed or printed in principle extends to documents

Rules 50(1) and 86  
Rule 49(2)  
OJ EPO 2022, A113



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 these requirements lies with the applicant/proprietor.

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

If the oral proceedings take place by way of exception ~~In order to assist the parties, including parties using their own laptops or other electronic devices during oral proceedings~~ on the premises of the EPO, the parties may use the EPO provides EPO's 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).

Parties are recommended to prepare electronic copies of documents likely to be amended. Published patent applications and specifications are available via the European publication server. See D-IV, 5.3 for the preferred way to amend the description in opposition proceedings.

For the procedures in examination and opposition oral proceedings, see E-III, 8.7.2 and 8.7.3 respectively.

### 8.7.2 Procedure in examination proceedings

In examination proceedings, the formal requirements prescribed by the President under Rule 49(2) apply equally to application documents submitted during oral proceedings by email or by hand.

*OJ EPO 2022, A113*

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.

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

- (a) If a decision to refuse a patent application is imminent and formally non-compliant documents making up the application are on file, to avoid prolonging the proceedings the examining division will 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 announces the following:
- the amended application fulfils the requirements of the EPC except for certain formal requirements, e.g. the ones regarding handwritten amendments; and
  - the procedure will be continued in writing.

After the closure of the oral proceedings, the formalities officer on behalf of the examining division (see A-III, 3.2) will invite the applicant to file formally correct documents within two months. Where the amendments submitted in reply to this invitation differ from the patentable subject-matter established at the oral proceedings, the procedure described in C-V, 4.7 is to be applied.

### 8.7.3 Procedure in opposition proceedings

~~The preferred way to amend the description during oral proceedings in opposition is by submitting amended paragraphs replacing specific numbered paragraphs of the B-publication of the patent. This allows the opposition division and the opponents to verify the amendments efficiently. It is not necessary to supply entire amended pages.~~

Rule 82(2), third sentence, 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 the requirements of Art. 2(7) of the decision of the President of the EPO dated 25 November 2022 (OJ EPO 2022, A113) prior to the interlocutory decision on the documents on the basis of which the patent is to be maintained. The proprietor 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 parties will nevertheless be encouraged to file compliant documents during oral opposition proceedings.

In contrast, in written opposition proceedings, an interlocutory decision to maintain the patent as amended may be issued only on the basis of formally compliant documents since the invitation in Rule 82(2) applies only to documents filed during oral proceedings (see H-IV, 5.3).

If, in oral proceedings, the interlocutory decision of the opposition division was based on documents which do not comply with Art. 2(7) of the decision of the President of the EPO dated 25 November 2022, 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) will 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 therefore requests 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, 3.3.2.1).

### **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 must 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 an amendment of the claims, it informs the applicant of the fact and allows 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-III, 8.11) – so that the case takes a significant turn, the parties must be informed thereof.

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

The chair must allow any member of the examining or opposition division who so requests to put questions. They 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-IV, 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. Where oral proceedings are held by videoconferences and the members connect to the oral proceedings from different locations (see E-III, 8.2.2), the members will deliberate and vote among themselves via a separate communication channel. If new aspects emerge during the discussion and require further questions to be put to the parties, the proceedings may be restarted. Any person conducting the proceedings may thereafter give the decision of the department. Otherwise they 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-III, 9), it is free, as a result of further reflection, to inform the parties that it intends to depart from the procedure which it has announced.

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

If the patent is to be granted or maintained in an amended form, it is 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 two to four 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 will 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 is expected to make the necessary changes either in the oral proceedings or during a break.

### 8.11.2 Adjournment of oral proceedings due to lack of time

If possible, oral proceedings should not last more than eight working hours. However, they may be extended slightly if an imminent conclusion seems likely. If not, the chair terminates the discussions for that day at an appropriate point to allow time for possible arrangement of a new date. Continuing oral proceedings on a day other than the one set out in the summons requires a new summons with a notice period of at least two months according to Rule 115(1) ~~to be issued~~ unless all parties agree to a shorter period of notice. See E-III, 6 for the general practice adopted for setting the date of oral proceedings. The explicit agreement of all parties is necessary and must be recorded in the minutes.

The new summons must indicate the points that still need to be discussed during the upcoming oral proceedings (Rule 116(1)). It is at the discretion of the division whether to indicate the points that are closed or to provide a provisional opinion on the points that are still open. A new final date for making submissions is not fixed under Rule 116 in the new summons if the subject of the proceedings has not changed (see E-VI, 2.2.2). Otherwise, a new date is fixed under Rule 116 and at least two months' notice is given under Rule 115 unless the parties agree to a shorter period. The minutes of the oral proceedings which took place are to be issued in advance of the upcoming oral proceedings, preferably no later than when the new summons is issued.

If the agreed date is too close for the parties to be able to receive the new summons in time (e.g. the next day or a day in the same week), it is necessary that the parties waive their right to receive a new summons. The respective statements of the parties must also be recorded in the minutes.

## 9. Delivery of the decision

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-III, 8.11 and E-X, 2.3).

*Rule 111(1) and (2)*

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." or

"Patent grant proceedings relating to European patent application No. ... are interrupted/resumed as from ..."

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-XII, 1, E-XII, 7 and E-XII, 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-X) 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 further ensures 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 are made public as well.

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

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

### **10.1 Formal requirements**

Minutes of oral proceedings must be drawn up.

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. Following the proceedings, the minutes are formatted.

*Rule 124(1)*

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. If exceptionally the employee responsible cannot sign the minutes, one of the other members of the division may sign them on the employee's behalf subject to the conditions defined in E-X, 2.3. 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, the EPO may make sound recordings of the oral proceedings. However, no person other than an EPO employee is allowed to make any recording or retransmit any part of the oral proceedings, whether image or sound or both (see OJ EPO 1986, 63, OJ EPO 2022, A106).

Sound recordings are made only in the case of taking of evidence (E-IV, 1.7).  
~~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 is 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-III, 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 or into which the 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) order of the decision.

The term "statement" within the meaning of Rule 4(6) is to be interpreted narrowly as the exception to the rule of using the language of proceedings in the written procedure rather than as allowing the recording of all arguments made in another official language during the oral proceedings.

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

See E-III, 10.3 for requests for recording specific statements in the minutes.

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

Minutes have an important function as evidence of respect for the right to be heard (Art. 113(1)). They 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, are developed in the decision, and therefore are only 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 are not, however, expected to be an exhaustive recollection of everything that was said during the oral proceedings. Rather, they are limited to the essentials and are 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 is normally not necessary, in case of doubt the record of such statements is read out to the parties concerned before the decision is taken and announced.

Requests from parties for recording specific statements are accepted if the statements form part of the essentials of the oral proceedings and are relevant for reaching the decision. Otherwise, they may be refused since recording statements that a party considers might be useful in subsequent proceedings is not the function of the minutes. See E-III, 10.2 for the language requirements.

If new facts or evidence are submitted during the oral proceedings, the minutes must make clear that the division has examined them under Art. 114(1). They must also indicate whether or not the division, after having heard the parties, subsequently disregarded them under Art. 114(2).

Art. 113(1)  
Rule 124(1)



The minutes 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 are developed in the grounds for the decision.

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

The minutes must also contain procedural information, such as how the proceedings are to be continued after closure of the oral proceedings or whether the public was excluded for the whole or part of the oral proceedings.

The structure of the minutes mirrors the course of oral proceedings (see E-III, 8 and sub-points).

If a decision is given (see E-III, 9), it 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 despatch 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. If the request for correction is filed within the period for filing the grounds for appeal, the division will make every effort to deal with it promptly to the extent possible so that the party can refer to the communication in the appeal.

It is at the discretion of the writer of the minutes (and of the chair who authenticates them) to decide what is considered essential and relevant in the meaning of Rule 124(1) (T 212/97). The minutes are 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).

## Chapter IV – Taking and conservation of evidence

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

#### 1.1 General remarks

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

Art. 117  
Rule 117

#### 1.2 Means of evidence

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

Art. 117(1)

It is generally desirable for parties to produce evidence in respect of all the facts alleged in support of their 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-IV, 1.8.1); and
- inspection.

The most appropriate way of obtaining evidence in the individual case depends on the facts which have to be proven and on the availability of the evidence. To prove prior use in an opposition, the opponents usually offer as evidence the production of documents, the hearing of witnesses or parties, or they present 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 is to be judged (for the evaluation of evidence, see E-IV, 4).

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

If the testimony of a witness is offered, the opposition division may decide to hear this person in order to verify the facts for which this witness is brought forward, e.g. the prior use of the claimed product in an undertaking or the existence of an obligation to secrecy. For adequate substantiation the notice of opposition must 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-IV, 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, this 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-III, 10.2 and E-V.

Evidence can be taken on the premises of the EPO or by videoconference. For details regarding the taking of evidence by videoconference see OJ EPO 2020, A135.

### 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, the date, time and place of the investigation and whether it will be conducted by videoconference. 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 any party concerned will normally know beforehand whom they wish to be heard as a witness or expert.

*Rule 117*

*Art. 119* 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-X, 3).

### **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, whether it will be conducted by videoconference 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-IV, 1.10);

*Rule 118(2)(c)* (iii) an indication that a party, witness or expert who has been summoned to appear before the European Patent Office on its premises may, at their request, be heard by videoconference; and

*Rule 118(2)(d)* (iv) an indication that any party, witness or expert may request to be heard by the competent court of their country of residence and a requirement that they inform the EPO within a time limit to be fixed by the EPO whether they are prepared to appear before it (see E-IV, 3.2.2 (iii) and (iv)).

*Rule 119(3)* Even if evidence is not taken in oral proceedings, all parties to the proceedings may attend an investigation. Parties not summoned are 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-IV, 1.3) or if the case in question is expected to give rise to particular legal issues, it is advisable that the division 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 either on the premises of the EPO or by videoconference. A party, witness or expert can even be heard by videoconference if the oral proceedings are otherwise conducted on the premises of the EPO. For details see OJ EPO 2020, A135.

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-III, 8.2, E-III, 8.3, E-III, 8.9 and E-III, 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-IV, 1.4). This is different from hearing oral submissions by a person accompanying the representative during oral proceedings, which can be allowed at the discretion of the division (see G 4/95 and E-III, 8.5).

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

After opening the proceedings for the taking of evidence, the official in charge of the taking of evidence, i.e. in substantive examination and opposition proceedings the chair 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 is heard. If any party makes such a request they must 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-VI, 2).

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

Before any party, witness or expert may be heard, they must be informed that the EPO may request the competent court in the country of residence of the person concerned to re-examine their 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 persons giving evidence being asked their 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*. Any person testifying is to be instructed to give a full and logical account of what they know 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 chair or any other member of the department concerned. As regards the entitlement of other members of the

division to put questions, see E-III, 8.10. When formulating questions the same considerations apply as for the parties (see E-IV, 1.6.7).

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

*Rule 119(3)*

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.

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", must 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-III, 8.10.

### **1.6.8 Hearing of a witness no longer necessary**

The testimony of a witness summoned to oral proceedings is heard if the facts which the testimony is supposed to corroborate are relevant to the decision (see E-IV, 1.2). Therefore, the witness is not heard if the facts to be proved are no longer relevant due to developments before or during oral proceedings before the witness is heard. This may be the case for example if the public availability of the relevant prior art has been proven by another means of evidence or if the patent is to be revoked on another ground for opposition and the patent proprietor submits no admissible auxiliary requests for the assessment of which the testimony would be relevant.

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

*Rule 124(1)*

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

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

*Rule 124(2)*

The minutes will normally be taken down by a member of the competent department carrying out the taking of evidence. The most efficient way of noting testimony is by way of dictation on to a dictating machine, in the process of which the person hearing the evidence will summarise the testimony in small sections, taking into account any objections raised by the persons being heard, and dictate it in this form on to a dictating machine. If the dictated passage does not correspond in full to their testimony, the persons being heard must raise any objections immediately. This is pointed out to them at the beginning of their testimony. At the end of their testimony,



they will be asked to approve the dictated minutes, which they will have listened to as they were dictated. Their approval or any objections are to 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-III, 10.1) may be recorded on sound recording apparatus.

## 1.8 Commissioning of experts

### 1.8.1 Decision on the form of the opinion

If the competent department decides of its own motion to obtain an expert opinion (D-VI, 1, sixth paragraph), it will have to decide in what form it is submitted by the expert whom it appoints. The opinion is 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-IV, 1.6).

*Rule 121(1)*

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 informs 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 states 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 any expert must include: a precise description of their task, the period laid down for the submission of their opinion, the names of the parties to the proceedings and particulars of the rights which they may invoke under the provisions of Rule 122(2) to (4) (regarding travel and subsistence expenses and fees, see E-IV, 1.10).

*Rule 121(2)(a)-(d)*

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

As a rule, the parties to proceedings before the EPO meet the costs they have 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-IV, 1.10). The competent body may make the taking of evidence conditional upon deposit with the EPO by the party who requested the evidence to be taken of a sum the amount of

*Art. 104(1) and (2)  
Rule 122(1) and (2)*

which is to be fixed by reference to an estimate of the costs. This procedure is 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 witnesses or experts have waived their 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), **second 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.

## **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-IV, 1.10.3). This applies equally to witnesses and experts who are summoned by and appear before the EPO in the course of oral proceedings held by videoconference for travel to the place where they make themselves available to appear before the EPO by videoconference (e.g. a videoconference facility provided by one of the parties or a venue with a sufficiently stable internet connection).

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-IV, 1.10.3). These payments must be made to the witnesses and experts after they have fulfilled their duties or tasks.

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

*Rule 122(4)*

For the details governing the entitlements of witnesses and experts set out under E-IV, 1.10.1 and E-IV, 1.10.2, see OJ EPO 1983, 100. 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 Procedure

It is for the competent division to decide whether to take evidence by way of inspection of a model. If it considers this to be necessary, it must take a decision in the form of an order to take evidence (see E-IV, 1.4), setting out the relevant facts to be proved as well as the date, time and place of the inspection.

Where possible, the inspection is to be carried out on the premises of the EPO. However, if in view of the characteristics of the model (e.g. form, size, material) or due to security constraints an inspection cannot be carried out on EPO premises (see also the notice from the EPO dated 20 December 2016, OJ EPO 2017, A6), the model may be inspected at a different location. In particular if such undertakings are located far away, the division may commission one of its members to carry out the inspection on its behalf (see E-IV, 1.3).

In general, any object which can be made available for inspection on the premises of the EPO can also be inspected during oral proceedings by videoconference unless such inspection would result in a disadvantage for a party where, e.g. the haptic feel, texture or handling experience of the object is of relevance.

In accordance with Rule 124(1), minutes must be taken, including the essential aspects and the result of the inspection.

### 1.11.3 Keeping the model

Even if the division does inspect the model, the EPO is not obliged to keep it. It is for the division to decide whether a model is to be kept by the EPO. However, as a general rule, models which would require special precautions or security measures if kept in the EPO are returned to the party.

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 a label on the file. If it is to be returned, the formalities officer informs the submitter that the model should be preserved in view of possible opposition or appeal proceedings 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 must 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 are always kept if the division has looked at them.

**2. Conservation of evidence****2.1 Requirements**

*Rule 123(1)* On request, the EPO may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. This could for example be the case where an important witness is about to emigrate to a distant country or where perishable matter, e.g. a food-stuff, is adduced as involving a use made accessible to the public.

**2.2 Request for the conservation of evidence**

*Rule 123(2)* The request for the conservation of evidence must contain:

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

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

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

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

## **3. Taking of evidence by courts or authorities of the contracting states**

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

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

### **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;

- Rule 120(2)* (ii) the competent department considers it advisable for the evidence of a party, witness or expert it has heard to be re-examined under oath or in an equally binding form (see E-IV, 3.2.1);
- Rule 120(1)* (iii) there has been no reply to the summons by the expiry of a period fixed by the competent department in the summons (see E-IV, 1.5(iii)); or
- Rule 120(1)*  
*Rule 150(3)* (iv) any party, witness or expert who has been summoned before that department requests the latter in accordance with E-IV, 1.5(iii) to allow their evidence to be heard by a competent court in their country of residence. If the party, witness or expert simply refuses to be heard by the responsible division, they are notified that the competent national court will have the relevant national legal possibilities to oblige them to appear and to testify.

### 3.3 Letters rogatory

- Rule 150(2)* The EPO must draw up letters rogatory in the language of the competent authority or must attach to such letters rogatory a translation into the language of that authority.
- Rule 150(1)* Letters rogatory must be addressed to the central authority designated by the contracting state.

### 3.4 Procedures before the competent authority

- Rule 150(5)* The EPO must be informed of the time when, and the place where, the enquiry is to take place and must inform the parties, witnesses and experts concerned.
- Rule 120(3)*  
*Rule 150(6)* 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.

### 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 has the power and the duty to assess whether the alleged facts are sufficiently established based on evidence. The proceedings under the EPC are governed by the principle of free evaluation of evidence. This principle allows, and requires, a competent department to decide according to its own discretion and conviction, by taking into account the entire content of the parties' submissions. There are no firm rules according to which certain types of evidence are, or are not, convincing. This does not mean that the evaluation of evidence may be arbitrary, rather the evidence must be assessed comprehensively and dutifully. The only decisive factor is whether the department is convinced of the truth of the factual allegation, i.e. how credible the department classifies a piece of evidence. To do this, the department must put all the arguments for and against a factual statement in relation to the required standard of proof. In doing so, the department remains bound by the laws of the logic and by probability based on experience. The department sets out in the decision the reasons for reaching its conclusions (G 2/21).

The principle of free evaluation of evidence may not be used to simply disregard an admissibly submitted piece of evidence that is relied upon by a party in support of an inference that is challenged and is decisive for the final decision, for example to prove the presence of a technical effect. Disregarding it as a matter of principle would deprive the party of a basic legal procedural right enshrined in Art. 113(1) and 117(1). For example, the mere fact that evidence is post-published is not a sufficient reason not to take it into account.

~~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-VI, 2.

### 4.2 Types of evidence

When evaluating submissions made, the difference between facts, evidence and arguments must 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, documents are submitted (evidence). The opponent then contends that the method claimed does not involve an inventive step, because the skilled person, on the basis of common general knowledge, would have combined

the submitted documents 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 must 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 the 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 has to 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 may 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 is to be paid to the following:

- (i) what is important is what witnesses can relate concerning the points at issue on the basis of their own knowledge or views, and whether they have 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 is to 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 are 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 are 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-IV, 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 is agreed in advance. During the demonstration itself care must be taken to ensure that the characteristics or conditions of operation claimed for the invention are complied with. Where an invention is compared under test with an item forming part of the state of the art, as far as possible the same or comparable test conditions must be applied to both.

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

### 1. Use of an official language

Any party to oral proceedings before the EPO may, in lieu of the language of the proceedings, use one of the other official languages of the EPO, on condition that such party either gives notice to the EPO at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings. In the former case, it is the responsibility of the EPO to provide for interpretation at its own expense. *Rule 4(1) and (5)*

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 all parties have indicated that they will use another official language, the division may depart from the language of the proceedings so as to manage without or with fewer 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 may clarify it in another. Under no circumstances however can 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 they make 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 parties are unable to give one month's notice through no fault of their own, and, although they have 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 postpones the oral proceedings if they occur at the examination stage. However, in opposition proceedings, the oral proceedings continue if the parties agree and the employees of the EPO *Rule 4(1)*

involved in the proceedings can cope with the language. In other cases, the EPO postpones the oral proceedings and any costs incurred by the innocent party as a result of the postponement are 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 is 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 is 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 in oral proceedings an official language of the EPO other than the language of proceedings. The parties must be informed accordingly prior to the oral proceedings unless it can be reasonably assumed that they would not object to this, e.g. because they have equally requested to use that different official language.

However, employees may not depart from the language of the proceedings without good reason. Unless the parties are competent in the language used, the EPO provides 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 or the Legal Division considers it appropriate and subject to explicit agreement of all parties concerned, the minutes may be recorded in the official language actually employed in the oral proceedings.

Prior to the agreement of the parties, their attention is 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, is recorded in the minutes.

Statements made in English, French or German are entered in the minutes of the proceedings in the language employed (Rule 4(6)).

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 are entered in the minutes in the language employed and the EPO subsequently provides in the minutes a translation into the language of the proceedings.



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

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

#### **1.1 General remarks**

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

*Art. 114(1)*

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

However, the obligation to undertake such examination must 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 will 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**

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-VI, 1.2. Otherwise, the department informs 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-III, 9).

### **2.1 General principles 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-VI, 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 are as a general rule to be treated as late-filed and only to be admitted under Art. 114(1) if they are *prima facie* relevant because the



opponent must be prepared for this type of amendment and must have provided material during the nine-month opposition period.

If the new facts and submissions are not *prima facie* relevant, they are to be disregarded under Art. 114(2). An exception to this rule is 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 will 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 has to be admitted into the proceedings because the subject of the proceedings has changed. At a late stage in the proceedings such unforeseeable amendments are subject to the criterion of "clear allowability" (see H-II, 2.7.1).

## 2.2 Submissions filed in preparation for or during oral proceedings

If oral proceedings are arranged, the 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 E-III, 6 and D-VI, 3.2).

### 2.2.1 New facts and evidence

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 been filed after the date indicated in the summons under Rule 116 unless they have to be admitted because the subject of the proceedings has changed.

Rule 116(1)

For instance, if the opposition division states in the annex to the summons that the patent is likely to be revoked, and a timely filed request for amendment is admitted but relates 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 will 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, new facts and evidence submitted by the opponent will be treated as late-filed even if submitted before the final date, i.e. they will be admitted only if they are *prima facie* relevant unless there are other aspects militating in favour of admitting them, such as a large number of dependent claims in the patent as granted (E-VI, 2.1).

Similarly, if in the provisional and non-binding opinion the opposition 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).

### 2.2.2 Amendments filed in preparation for or during oral proceedings

Rule 116(2)

Rule 116(2) imposes the same obligations on the applicant or patent proprietor when submitting new documents which meet the requirements of the EPC (i.e. new amendments to the description, claims and drawings) as Rule 116(1) imposes on the parties in submitting new facts and evidence.

The examining or opposition division has the discretion to disregard amendments filed after the date set under Rule 116(1) as being late-filed unless they have to be admitted because the subject of the proceedings has changed. Amendments submitted before the date set under Rule 116(1) cannot, as a rule, be considered as being late-filed.

The following are examples of what would normally constitute a change of subject of the proceedings:

- the opposition division admits under Art. 114(1) new facts and evidence or a new ground of opposition because they are *prima facie* relevant;
- the examining division cites a further relevant document for the first time (H-II, 2.7);
- the examining or opposition division departs from a previously notified opinion: for example, contrary to its preliminary opinion set out in the annex to the summons, the opposition division concludes during oral proceedings that an objection prejudices the maintenance of the patent.

In these examples, a request from the applicant or proprietor for a corresponding amendment cannot be rejected as being late-filed even if submitted after the date set under Rule 116(1). If, however, after a change of opinion by the division, the applicant or proprietor files a new request that reintroduces subject-matter against which the division has already raised an objection, the division has discretion to disregard the new request due to it being *prima facie* not allowable.

On receipt of amendments filed after the final date set under Rule 116(1), the division therefore first analyses whether the amendments were filed in due course in response to a change of the subject of the proceedings. Only if this is not the case does the division have the discretion to disregard the amendments. This discretion is to be exercised according to the principles set out in E-VI, 2.2.3. The mere fact that amendments are filed after a given date is not on its own a legal basis for not admitting them.

### 2.2.3 Principles relating to the exercise of discretion

In exercising its discretion under Art. 114(2) and Rule 116(1) and (2), the division must assess all relevant factors of the case.

*Art. 114(2),  
Rule 116(1) and  
Rule 116(2)*

The division will in the first place have to consider the relevance of the late-filed facts or evidence (see E-VI, 2) or the allowability of the late-filed amendments on a *prima facie* basis. If these facts or evidence are not *prima facie* relevant, i.e. if they do not appear to affect the outcome of the proceedings (T 320/15), or if these amendments are not clearly allowable (see H-II, 2.7.1), they will not be admitted.

For instance, 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 can be admitted into the proceedings. However, the division will consider admitting such requests into the proceedings if they relate to the subject-matter of dependent claims as granted.

Convergence of requests is another of the relevant factors that the division may consider when exercising its discretion (for a definition of convergence, see H-III, 3.3.2.2).

For the purpose of admissibility, a late-filed document's relevance is normally 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).

Before admitting these submissions, the division will next consider procedural expediency, the possibility of abuse of the procedure (e.g. one of the parties is obviously protracting the proceedings) and the question whether the parties can reasonably be expected to familiarise themselves in the time available with the new facts or evidence or the proposed amendments.

As regards procedural expediency, where the late-filed facts or evidence are relevant but their introduction would cause a prolonged adjournment of the proceedings, the division may decide not to admit these facts or evidence in the proceedings. An example would be where the witness 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). Similarly, 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.

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 knowingly abstains from raising an assertion of public prior use based on its own activities until late in the proceedings, even though the evidence in its support had become fully available earlier (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).

Concerning the question of whether the parties can reasonably be expected to familiarise themselves in the time available with the new facts or evidence or the proposed amendments:

- 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 must always expect to have to discuss subject-matter based on dependent claims as granted if they are reasonable in number.
- The proprietor is in principle free to withdraw previously submitted amendments and defend the patent as granted unless this would constitute an abuse of the proceedings.

#### **2.2.4 Right to be heard**

*Art. 113(1)*

Generally, the parties must be heard before the division decides on whether or not to admit late-filed submissions.

For instance, if the opponent introduces a new ground for opposition during oral proceedings, they must always be granted the right to be heard. This means that the division must give the parties the opportunity to put forward arguments and duly consider them before deciding on the admissibility of the new ground. Similarly, where the opponent files pertinent new material, the patent proprietor must be given a chance to present comments and submit amendments. 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 grants, where easily comprehensible subject-matter is involved, the parties an opportunity to familiarise 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 will 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 must 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.

The reasons for the decision on the admissibility of late-filed facts, evidence and requests have to be provided in the written decision and must not come as a surprise. A mere reference to the division's discretionary power is not sufficient (E-X, 2.10). In examination proceedings, reasons only need to be provided if the late-filed facts, evidence or requests are not admitted.

### 2.2.5 Costs

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

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

*Art. 115  
Rule 114(1)*

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 2017, A86). Observations may be filed anonymously.

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 third parties are sent acknowledgment of the receipt of their observations (if these were not filed anonymously), the EPO does not specifically inform them 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 observations, including those filed anonymously, become part of the file. They are communicated without delay to applicants or proprietors, who may comment on them. If they call into question the patentability of the invention

*Rule 114(2)*

in whole or in part, the examining or opposition division will take them into account in the next office action. If the observations relate to alleged prior art available other than from a document, e.g. from use, this is 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 in examination after dispatch of a Rule 71(3) communication but before the decision to grant (EPO Form 2006A) has been handed over to the EPO postal service will be considered by the examining division. If they are relevant, the examining division will resume examination. Otherwise, brief substantive feedback will be provided in the file.

Observations by third parties received after the decision has been pronounced in oral proceedings (e.g. in the case of a refusal or in opposition) or issued in written proceedings and handed over to the EPO postal service (e.g. in the case of a grant decision or if, in opposition, no oral proceedings were held), will be included in the file without taking note of their content.

Observations by third parties received once proceedings are no longer pending will be neither taken into account nor made available for file inspection. They will however be made available for file inspection and considered if the proceedings before the EPO become pending again, e.g. upon the start of any opposition or limitation proceedings.

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. Where the observations are received at a time when a reply from the applicant to a communication is outstanding, this period starts from receipt of the reply at the EPO.

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.

Where a third-party observation was filed during the international phase, the EPO as designated/elected Office will consider its content upon entry into the European phase once this becomes available to it. The examining division will make every effort to issue the next office action within three months after expiry of the period under Rule 161, but only on condition that the third party has clearly expressed its wish to achieve expedited treatment in the European phase, that the observation was filed non-anonymously and that it was substantiated. A third party wishing to achieve such a result in the European phase must, therefore, make this clear in the observation or file the observation with the EPO as designated/elected Office.

#### **4. External complaints**

External complaints can concern any service or product delivered by the EPO and can be submitted by any person, including parties to proceedings before the EPO (for enquiries as to the processing of files, see E-VIII, 7).

Complaints can be submitted using the online form available at [epo.org/complaint](https://epo.org/complaint).

Complaints are forwarded to a dedicated EPO department responsible for

- (i) ensuring that the complaint is dealt with fairly and efficiently and that suitable measures are taken to address it; and
- (ii) providing a comprehensive reply to the complaint.

The complaint handling procedure does not replace the procedures laid down by the EPC; nor does the department responsible for handling complaints take decisions on procedural requests. Hence, the relevant department competent for the respective proceedings decides on:

- (a) complaints relating to procedural and/or substantive aspects of specific pending proceedings which are submitted by a party to those proceedings. All parties to the proceedings will be informed accordingly.
- (b) complaints relating to substantive issues which are submitted by a third party while proceedings are pending before the EPO. Such a submission will be treated as a third-party observation (see E-VI, 3).

The department responsible for handling complaints promptly forwards any complaint relating to appeal proceedings to the EPO Boards of Appeal Unit.

Complaints having a substantive and/or procedural bearing on proceedings before the EPO, as well as replies thereto by the department responsible for handling complaints, will only exceptionally be excluded from file inspection (see D-II, 4.3; decision of the President of the EPO concerning documents excluded from file inspection, OJ EPO 2007, Special edition No. 3, J.3).

*Art. 128(4)*  
*Rule 144(d)*





## Chapter VII – Interruption, stay and consolidation 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 their 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 their 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 their being prevented for legal reasons resulting from action taken against their 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 (see the 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 date. The date is set in such a manner as to allow this person to familiarise himself with the matter. *Rule 142(2)*

If, three years after the publication of the date of interruption in the European Patent Bulletin, the EPO has not been informed of the identity of the person authorised to continue the proceedings, it may set a date on which it intends to resume the proceedings of its own motion.

This date may be postponed upon reasoned request and submission of relevant documentary evidence in the case of a claim of succession in title in respect of the European patent application/European patent concerned.

As a consequence of the *ex officio* resumption, the proceedings will continue with the applicant/proprietor registered in the European Patent Register, and procedural actions may become necessary and/or fees due (see also the notice from the EPO dated 29 May 2020, OJ EPO 2020, A76).

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-VIII, 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). Thus, such renewal fees may be paid without additional fee at the date of resumption and in the amounts applicable on that date. They may also be paid within six months of said date, provided that an additional fee is also paid within said period (Rule 51(2)).

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**

If third parties provide evidence that they have instituted proceedings against the applicant seeking a decision within the meaning of Art. 61(1), the proceedings for grant are stayed unless the third parties communicate to the EPO in writing their consent to the continuation of proceedings. This consent is irrevocable. For further details see A-IV, 2.2 and subsections, and D-VII, 4.1.

*Rule 14(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 and the party/ies will be informed thereof. If the party/ies do(es) not agree in writing with the intention to stay, and if the examining or opposition division maintains its opinion, a decision to stay will be despatched. A decision to stay the proceedings or refusing a request to stay is not separately appealable; it can only be appealed together with the final decision on the application/patent (see E-X, 3).

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-VII, 2).

## **4. Consolidation of proceedings**

The examining or opposition division or the Legal Division may consolidate proceedings if this is considered useful in order to expedite proceedings in the specific circumstances of the case (see J 17/92).

Consolidation is considered *inter alia* if the parties and the underlying facts of the proceedings are identical. It is for the responsible division to decide whether proceedings are to be consolidated in the interest of procedural efficiency and with a view to expediting proceedings and, if so, for what purpose. Consolidation may concern the entire procedure or only individual procedural steps such as the taking of evidence or the conduct of oral proceedings.

The parties are to be informed of consolidation. This information includes a statement about the purpose of consolidation. Where proceedings are consolidated for the taking of evidence, this is to be notified in the order to take evidence and in the annex to the summons to oral proceedings. These must be sent to all parties to the consolidated proceedings. Likewise, submissions from the parties filed in respect of only one of the proceedings which are relevant to the consolidated parts of the proceedings must be included in all the files concerned.

Upon fulfilment of its purpose, consolidation is to be set aside and the proceedings are to be continued separately. Again, the parties must be informed accordingly.

A decision to consolidate proceedings is not subject to a separate appeal but may be appealed only together with the final decision unless the decision allows a separate appeal (see E-X, 3). The same applies *mutatis mutandis* to a decision setting aside consolidation.

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

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

#### 1.1 Determination of time limits

The EPC imposes time limits upon parties to proceedings. 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 applicants to indicate whether they desire 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-VIII, 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 is based, in principle, on the amount of work which is likely to be required to perform the operation in question (minimum of two months, maximum of four months, exceptionally six months). 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;
- (iii) communications from the Legal Division – two 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 is 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-VIII, 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*

*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 date of notification (see E-II, 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 (see E-VIII, 1.6).

*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 (see E-VII, 1.1), 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 E-VII, 1.5). The time limits in force at the date of the stay of proceedings under Rule 14 due to national entitlement proceedings, with the exception of those for payment of the renewal fees, are interrupted. Rule 14(4) applies to the calculation of time limits after the resumption of proceedings (see A-IV, 2.2.4).

### 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. For example, if a request for restoration of a priority right is filed upon entry into the European phase on expiry of the 31-month time limit under Rule 159(1) but the request is not granted resulting in the loss of the right of priority, the 31-month time limit will

not be deferred. 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

### 1.6.1 Extension of time limits set by the EPO under Rule 132

Other than in cases in respect of which the EPC specifies a fixed period which may not be extended, the duration of time limits may be extended on request. 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.

*Rule 132*

In opposition proceedings, requests to extend time limits over and above the normal period of four months, both for communications from an opposition division raising matters of substance and communications issued by the formalities officer, or two months for communications requesting an act of a merely formal or minor character (E-VIII, 1.2), will only be granted in exceptional, duly substantiated cases. For a communication under Art. 101(1) and Rule 79 or Rule 81(2) and Rule 81(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.

In other proceedings, a request for extension, even if filed without reasons, is normally allowed if it is for not more than two months and the total period set does not thereby exceed six months. A request for a longer extension, especially if the total period set exceeds six months, is allowed only exceptionally, when the reasons given are sufficient to show convincingly that a reply in the period previously set will not be possible. Such exceptional circumstances might be e.g. the fact that representatives or clients are so seriously ill that they 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) are not accepted as a sufficiently exceptional circumstance (see Notice of the Vice-President of Directorate-General 2 of the EPO, OJ EPO 1989, 180).

If the request for an extension is granted, the parties are informed of the new time limit. Otherwise, they are told that the relevant sanction has taken effect or will take effect.

An application will be removed from the PACE programme (see E-VIII, 4) if the applicant has requested an extension of a time limit (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-VIII, 1.8 and E-VIII, 1.9.2).

If the request for extension of a time limit filed in good time has been rejected and any applicant considers this unjust, they can only overcome the ensuing loss of rights by requesting a decision under Rule 112(2) and/or further processing under Art. 121(1) and Rule 135(1) (see E-VIII, 2), as applicable.

*Art. 106(2)*

Where the reimbursement of the fee for further processing is requested and this is rejected, such decision is open to appeal, either together with the final decision or separately, as the case may be (see J 37/89).

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. Rather, the opposition proceedings will proceed to the next stage, and this could be a decision under Art. 101(2) or (3).

## **1.6.2 Extension of periods under Rule 134**

### **1.6.2.1 Extension of periods under Rule 134(1)**

*Rule 134(1)*

Periods that expire on a day on which at least one of the filing offices of the European Patent Office (i.e. Munich, The Hague or Berlin) is not open for receipt of documents (e.g. because a public holiday is observed at the location of the EPO's filing office) or on which mail is not delivered for other reasons (with the exception of a general dislocation in the transmission or delivery of mail, which is subject to the provision of Rule 134(2) – see E-VIII, 1.6.2.3) are extended to the first day thereafter on which all the filing offices are open again for receipt of documents and on which mail is delivered.

An extension pursuant to Rule 134(1) also applies in the event that any one of the means of electronic filing provided by the EPO under Rule 2(1) is not available, regardless of any restrictions on the documents which may be filed by the means of electronic filing that suffered the outage.

- If a means of electronic filing is unavailable for four hours or more because of scheduled maintenance, Rule 134(1), second sentence, applies. If the unavailability of a means of electronic filing lasts less than four hours and is announced at least two working days in advance, Rule 134(1), second sentence, does not apply.
- In the case of unplanned outages, users who are unable to file a document should contact the EPO's Customer Services. If it is confirmed that the unavailability of the service is attributable to the EPO, said users will not suffer any adverse consequences; they may also request that the EPO declare under Rule 134(1), second sentence, that the missed period is extended to the date on which the document was filed.
- If a payment period expires on a day on which one of the accepted means of making payment to the EPO for a Euro-direct or Euro-PCT application is unavailable, the payment period is extended to the first working day thereafter on which all such means of making payment are available unless the outage lasts less than four hours and is announced at least two working days in advance.

For further details see OJ EPO 2020, A120.



### 1.6.2.2 Extension of periods under Rule 134(2) and Rule 134(5)

Where there is a general dislocation in the delivery or transmission of mail in a contracting state, any period expiring during such dislocation is extended for parties who are resident in the state concerned or have appointed a representative with a place of business in that state. Where the state concerned is the state in which the EPO is located, the extension applies to all parties and representatives, irrespective of their residence. The beginning and the end of the period of such general dislocation is published in the Official Journal.

*Rule 134(2) and (4)*

Equally, where an individual party can provide evidence of a dislocation of the delivery or transmission of mail due to an exceptional occurrence inside or outside EPC contracting states (such as, in particular, a natural disaster, war, civil disorder or a general breakdown of any of the means of electronic communication accepted by the EPO for the filing of documents), a late submission or payment will be deemed to be received in due time, provided that

*Rule 134(5)*

- the dislocation affected the locality where that party or their representative resides or has their principal place of business,
- the dislocation existed on any of the last ten days of the period at issue, and
- the transmission or payment is effected within five days from the end of the dislocation, together with
- a formal request of the party concerned under Rule 134(5), accompanied by appropriate evidence.

### 1.6.2.3 Scope of application of Rule 134

An extension under Rule 134 applies to all periods under the EPC (see E-VIII, 1.1), including, in particular:

- the time limits for the filing of submissions, e.g. replies to EPO communications;
- the time limit under Rule 37(2) for the onward transmission to the EPO of applications filed with the central industrial property office of a contracting state (see A-II, 1.6);
- the priority period under Art. 87(1) (see A-III, 6.6);
- the opposition period under Art. 99(1);
- the period for entry into the European phase under Rule 159(1);
- the periods for the payment of fees (see A-X, 6.1), including, *mutatis mutandis*, the expiry of the period to pay renewal fees with an additional fee in accordance with Rule 51(2) and the expiry of the periods under Rule 51(3) and (4) (see A-X, 5.2.4).

By contrast, an extension under Rule 134 does not affect:

- the pendency of the earlier application when filing a divisional application (see A-IV, 1.1.1);
- the beginning of the six-month period for the payment of a renewal fee with an additional fee under Rule 51(2) unless the due date for the renewal fee is deferred to the expiry of a period, for instance in the case of Rule 159(1)(g) (see A-X, 5.2.4);
- the due date for the renewal fees for a divisional application and the beginning of the four-month period under Rule 51(3) (see A-IV, 1.4.3);
- the date of the start of the search, which is relevant for the entitlement to a refund of the search fee (see A-X, 10.2.1);
- the date of the start of substantive examination, which is relevant for filing a PPH request (see E-VIII, 4.3) or the entitlement to a refund of the examination fee (see A-VI, 2.5);
- the date on which a request under Rule 22 (registration of transfers) or Rule 54 (certified priority document) is deemed to be filed, where the payment date is decisive, because these requests are deemed to have been filed only when the corresponding administrative fee has been paid.

The extension equally does not affect the final date for making written submissions in preparation for oral proceedings under Rule 116, strictly speaking. However, a general dislocation in the delivery of mail or other exceptional occurrence under Rule 134(5) will be taken into account by an examining or opposition division in exercising its discretion whether to admit submissions filed after the date set under Rule 116 (see E-III, 8.5, sub-item (iv)). Given that the date fixed under Rule 116 is meant to ensure adequate preparation of the oral proceedings, a party making submissions after that date must show that it has taken reasonable efforts to do so as early as reasonably possible.

### 1.7 Late receipt of documents

Rule 133(1)

If a document received late was delivered to a recognised postal service provider 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. The five days are calendar days, not working days. 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). 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.

Recognised postal service providers are the designated operators within the meaning of Article 1 of the Universal Postal Convention as well as Chronopost, DHL, Federal Express, flexpress, TNT, SkyNet, UPS and Transworld (see the decision of the President of the EPO dated

11 March 2015, OJ EPO 2015, A29). The document must have been sent as a registered letter or equivalent and, if posted outside Europe, by airmail. At the request of the EPO, confirmation of receipt by the postal service provider must be provided as evidence that the document was delivered in due time.

### **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-VI, 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-VIII, 1.9.1, a formalities officer will note such loss of rights and communicate this to the person concerned. The communication will be notified to the person concerned as a matter of course (see also D-IV, 1.4.1).

*Art. 119*  
*Rule 112(1)*

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

If the party concerned considers that the finding of the EPO is inaccurate, they 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. It is advisable to apply for the appropriate legal remedy as an auxiliary request to that under Rule 112(2) in order to observe the relevant time limit for that request (see E-VIII, 2 and E-VIII, 3.1.3). The competent department will deal with the request under Rule 112(2) first. If it is allowable, all other requests are redundant and any related fees paid will be refunded. If it is not allowable, one decision will deal with the various requests in the order in which they were filed. If applicants fail to observe the time limit for requesting a decision under Rule 112(2), they 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

*Art. 121(1) and (2)  
Rule 135(1) and (3)  
Art. 2(1),  
item 12, RFees*

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 within two months of the communication concerning either the failure to observe a time limit or a loss of rights. Further processing must be requested by payment of the prescribed fee. The omitted act must be completed within the period for making the request. The request is not deemed to have been filed until the respective fee for further processing has been paid. If the fee for further processing has been paid in due time but the omitted act has not been completed within the period for making the request, the request is inadmissible.

If several acts have the same legal basis, they form a unitary procedural act and are subject to a unitary time limit (see J 26/95). Further processing in respect of such a time limit is subject to the payment of a single fee for further processing. The amount of the single fee depends on the number and character of the omitted acts forming the unitary procedural act.

The following examples serve to illustrate this:

- Requesting examination under Art. 94(1) in conjunction with Rule 70(1) requires filing a written request for examination and paying the examination fee. As both actions have the same legal basis, they form a unitary procedural act subject to a unitary time limit. If both actions were omitted, the single fee for further processing amounts to the sum of the flat fee and 50% of the examination fee (Art. 2(1), item 12, first and third indents, RFees). If only the examination fee was not paid in due time, the fee for further processing amounts to 50% of the examination fee (Art. 2(1), item 12, first indent, RFees). If only the written request for examination was omitted, the fee for further processing amounts to the flat fee (Art. 2(1), item 12, third indent, RFees).
- The filing fee and the additional fee due if the application comprises more than 35 pages must be paid within the time limit set by Rule 38(1) and (2). As the additional fee is part of the filing fee, the payment of these two fees forms a unitary procedural act subject to a unitary time limit. Hence, one fee for further processing is due. If both fees were

not paid in due time, the single fee for further processing comprises 50% of the filing fee and 50% of the additional fee (see Art. 2(1), item 12, first indent, RFees). If only one fee was not paid in due time, the single fee for further processing amounts to 50% of that omitted fee (see Art. 2(1), item 12, first indent, RFees).

An exception to the above principle concerns Rule 71(3):

- Approval of the text communicated under Rule 71(3) requires paying the fee for grant and publishing and, where applicable, claims fees (Rule 71(4)) and filing the translations of the claims within a four-month period (Rule 71(5)). As these actions have the same legal basis, they form a unitary procedural act subject to a unitary time limit. By way of exception to the principle that the single fee for further processing is computed on the basis of the number of omitted acts, Art. 2(1), item 12, second indent, RFees stipulates that only one flat fee for further processing is due in the event of late performance of any or all of the acts required under Rule 71(3), i.e. paying the fee for grant and publishing and filing the translations of the claims. If in addition claims fees were not paid in due time, the single fee for further processing amounts to the sum of the flat fee **and** 50% of the claims fees (see Art. 2(1), item 12, second and first indent, RFees). If only the claims fees were not paid in due time, the single fee for further processing amounts to 50% of the claims fees (Art. 2(1), item 12, first indent, RFees). For European patent applications filed before 1 April 2009 and international applications entering the European phase before that date, any page fees under Art. 2(2), item 7.2, RFees are part of the fee for grant and printing. Therefore, if only page fees were not paid in due time, the fee for further processing amounts to the flat fee (Art. 2(1), item 12, second indent, RFees).

Actions not forming a unitary procedural act are subject to time limits expiring independently of one another, each resulting in the application being deemed withdrawn. If such time limits expire on the same date, the missing of each independent time limit results in the application being deemed withdrawn (see J 26/95). This applies regardless of whether the applicant is informed of the non-performance of procedural acts in one communication or in several communications. In such cases, a fee for further processing is due in respect of each unobserved time limit. For an example, see E-VIII, 3.1.3.

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.

Where the omitted act is a substantive response (e.g. to the extended European search report or to a communication under Art. 94(3)), a mere procedural request (e.g. a request for oral proceedings) does not qualify as completion of the omitted act and therefore cannot lead to further processing being granted (see B-XI, 8 and C-IV, 3).

*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, 56a(1) and (3) to (7), 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 their 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 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 in respect of the time limit for requesting further processing is to be requested (see E-VIII, 2), and not in respect of the originally missed time limit.

*Rule 131(1)* 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-VIII, 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.

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

*Rule 51(2)* – payment of a renewal fee plus additional fee;

*Rule 135(1)*

- requesting further processing in respect of the time limit for replying to a communication from the examining division under Art. 94(3);
- 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(3)*
- filing notice of appeal and/or grounds 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 Art. 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-XIV, 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 receipt of this communication (see J 27/90).

Unlike the time limit for other cases as described above, 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 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.

The principles regarding unitary and independent procedural acts described in E-VIII, 2 apply *mutatis mutandis* to establishing the number of requests for re-establishment of rights, in particular for establishing the relevant fees to be paid. Where one unitary procedural act is omitted by not performing one or more actions forming that act, only one fee for re-establishment is due. Where several independent procedural acts are omitted, each resulting in the application being deemed withdrawn, a fee for re-establishment is due for each omitted act.

These principles also apply to cases where re-establishment of rights must be requested in respect of the time limit(s) for requesting further processing (see Rule 136(3)). In such cases, the number of unobserved time limits, each resulting in the application being deemed withdrawn and requiring a request for further processing, determines the number of requests for re-establishment and the corresponding number of fees for re-establishment.

#### *Example 1*

An international application comprises more than 35 pages and was published in a language other than an official language of the EPO. The acts required for entry into the European phase upon expiry of the 31-month period under Rule 159(1) were omitted. Due to their different legal nature, the individual acts required under Rule 159(1) do not form a unitary procedural step but are legally independent and subject to independent time limits. The table below provides a schematic illustration regarding further processing and re-establishment of rights (for information on the remedies available for non-observance of the time limits under Rule 159(1), see the individual sections under E-IX, 2).

Box I of the table lists the number of independent unobserved time limits. Box II indicates the fee for further processing corresponding to each unobserved time limit. Box III provides the fee for re-establishment corresponding to each unobserved time limit.

In the example, for a request for further processing to be allowed, completion of the omitted acts (i.e. all acts that were to be performed within the 31-month period) and payment of five fees for further processing (two of which comprise two fees) are required within the two-month period under Rule 135(1). If that period is missed, the applicant may request re-establishment of rights in respect of the period. The request requires completion of the omitted acts and payment of the corresponding number of fees for re-establishment of rights within the period under Rule 136(1). The omitted acts are those that were to be performed within the 31-month period and payment of the corresponding five fees for further processing. Payment of five fees for re-establishment of rights corresponds to the number of five independent fees for further processing.



Omitted acts	Time limits missed (box I)	Number of fees for further processing (box II)	Number of fees for re-establishment (box III)
Filing of the translation	1	1	1
Payment of the filing fee	1 (unitary)	1 (comprising 50% of the filing fee and 50% of the additional fee)	1
Payment of the additional fee for an application comprising more than 35 pages			
Payment of the designation fee	1	1	1
Payment of the search fee	1	1	1
Filing of the request for examination	1 (unitary)	1 (comprising a flat fee and 50% of the examination fee)	1
Payment of the examination fee			
Resulting number of fees to be paid	5 non-observed time limits	5 fees for further processing, 2 of them comprising 2 fees	5 fees for re-establishment

### Example 2

The applicant missed the time limit for requesting further processing in respect of the time limit for replying to a communication from the examining division under Art. 94(3) as well as the time limit to pay the renewal fee with the additional fee. As these time limits expire independently of one another and both have been missed by the applicant, each resulting in the application being deemed withdrawn, a request for re-establishment has to be filed in respect of each unobserved time limit (J 26/95). In such cases, a fee for re-establishment has to be paid in respect of each request. In the case of independent time limits, in particular where they expire on different dates, the reasons for missing them and the date of removal of the cause of non-compliance may be different.

### Example 3

After a decision to refuse by the examining division, the applicant missed both the time limit for filing the notice and the time limit for filing the statement of grounds of appeal. Both time limits were missed for the same reason.

Despite two time limits being missed, only one re-establishment fee has to be paid as both periods were triggered by the same event, i.e. the notification of the decision, and both time limits were missed on the same grounds. In such a case, re-establishment in respect of both periods has to be examined together and, as the result would inevitably be the same in both cases, one re-establishment fee is considered to be sufficient.

If the time limits for filing the notice and the grounds were missed for different reasons, there would be no causal connection and two fees for re-establishment would have to be 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 on which the original request for re-establishment had been based (see J 5/94). Any new facts introduced at this stage are not admissible and are, therefore, not taken into consideration by the deciding instance.

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

Art. 122(1)

Applicants can have their rights re-established only if they show that they were 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 requesters must show not only the existence of those circumstances, but also that they 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 applicants and then, by virtue of delegation, to the representative duly entrusted by the applicant to act on their behalf in prosecuting the application (see J 3/93). The obligations of the applicant and those of their 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.

Applicants are entitled to rely on their representative. To the extent that applicants are on notice that instructions are required in order to meet a time limit, they have 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 applicants from suffering the consequences of their own mistakes or negligence.

European representatives are responsible in the procedure before the EPO and must be presumed to be supervising their own work continuously (see T 1095/06). When professional representatives have been instructed by their client to perform a particular procedural action and do not receive in due time the necessary additional instructions or required means, they must in principle take all necessary measures to try to obtain these instructions from their client and ascertain their true wishes (see T 112/89 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 applicants entrust a further party with taking care of their 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**

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 if the request is not granted, except in opposition proceedings, as opponents are party to the re-establishment proceedings (see E-VIII, 3.1.2).

*Rule 136(4)*

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-XII, 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-VIII, 3.1.1 to E-VIII, 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). 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 restore 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 the 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 the end of the period under Rule 161(1), or the request for accelerated examination (whichever is later).

In particular for PCT applications entering the European phase where the EPO acted as (S)ISA, accelerated examination can only start after expiry of the six-month period under Rule 161(1), even if acceleration has been requested under the PACE programme. In order for examination to start immediately, on entry into the European phase the applicant must explicitly waive the right to the communication pursuant to Rule 161(1) and Rule 162(2) and fulfil all corresponding requirements (see the notice from the EPO dated 30 November 2015, OJ EPO 2015, A94).

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-VIII, 4).

### 4.3 Patent Prosecution Highway (PPH)

The Patent Prosecution Highway (PPH) enables an applicant whose claims have been determined to be allowable to have a corresponding application which has been filed with a PPH partner office processed in an accelerated manner while at the same time allowing the offices involved to exploit available work results. A request before the EPO must be filed before substantive examination has begun.

A PPH request can be based on:

- (i) the latest PCT work product (WO-ISA or IPRP/IPER) established by one of the PPH partner offices as ISA or IPEA (PPH based on PCT work products); or
- (ii) any national work product (office action indicating allowable claims) established during the processing of a national application or of a PCT application that has entered the national phase before one of the PPH partner offices (PPH based on national work products).

Currently, the EPO's PPH partner offices are: JPO (Japan), KIPO (South Korea), CNIPA (China), USPTO (USA), ILPO (Israel), CIPO (Canada), IMPI (Mexico), IPOS (Singapore), IPA (Australia), SIC (Colombia), MyIPO (Malaysia), IPOPHL (Philippines), INPI (Brazil), INDECOPI (Peru) and SAIP (Saudi Arabia). The PPH programmes with ROSPATENT (Russian Federation) and EAPO (Eurasia) have been suspended.

*OJ EPO 2022, A44*

*OJ EPO 2022, A45*

*OJ EPO 2022, A58*

*OJ EPO 2022, A59*

### 5. Accelerated processing of oppositions

In cases where an infringement action in respect of a European patent is pending before the Unified Patent Court or 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 Unified Patent Court, the national court or the competent authority of a contracting state that infringement or revocation actions are pending (D-VII, 1.2 and Supplementary publication 3, OJ EPO 2023, 9).

### 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. This option is also available to the courts and competent authorities of the contracting states (see **Art. 10 Rules of Procedure of the Boards of Appeal**, OJ EPO 2019, A63, as amended by OJ EPO 2021, A19).

### 7. Enquiries

In specific cases, parties to proceedings before the EPO may have an interest in enquiring about the progress of the file and thus obtaining information on when the next Office action is to be expected. A specific procedure for enquiries is available to all parties to proceedings before the EPO's departments of first instance, and applies to enquiries filed on or after 1 November 2016 (see the notice from the EPO dated 2 August 2016, OJ EPO 2016, A66).

Under this procedure, an enquiry is processed and replied to only if it is filed online using EPO Form 1012. It may be submitted for only one application or patent at a time. The EPO will promptly issue an acknowledgement of receipt. Both the enquiries and the replies from the EPO form integral parts of the file and, as such, are open to file inspection.

Specific parameters may have an impact on the handling time for enquiries. For example, the non-payment of the renewal fee by the due date under Rule 51(1) may delay the EPO's handling of an enquiry.

In general, the EPO will reply to enquiries by indicating the period within which the next Office action may be expected, taking into account the workload in the technical area concerned and the internal deadline for the completion of the pending action.

Nevertheless, in the following cases an enquiry will automatically cause the EPO to issue the next action within one month from receipt of the enquiry:

- where the extended/partial European search report in respect of European patent applications filed on or after 1 June 2014 (including international applications entering the European phase where the EPO did not act as (S)ISA) has not been issued within six months from the filing date or from expiry of the period under Rule 161(2); or
- where an Office action in respect of an application which is being processed under the PACE programme or for which a previous enquiry has been made has not been performed within the committed period;

and within six months from receipt of the enquiry:

- where the extended/partial European search report in respect of European patent applications (including PCT applications entering the European phase where the EPO did not act as (S)ISA) filed before 1 June 2014 and which do claim priority (second filings) has not been issued.

Unlike the PACE programme, the filing of enquiries does not imply a general acceleration of the prosecution of European patent applications. Prosecution of the application can be accelerated by separately requesting application of the PACE programme (see E-VIII, 4).

## **8. Renunciation of rights**

### **8.1 Withdrawal of application or designation**

Applicants may withdraw their application at any time as long as the application is pending, provided that no third parties have proven to the EPO that they have initiated proceedings concerning entitlement to the application pursuant to Rule 14. With regard to the pendency of an application, see A-IV, 1.1.1.



The same 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.

## 8.2 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 or, where multiple priorities are claimed, the earliest priority date remaining (see A-VI, 1.1 and A-III, 6.3).

## 8.3 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 is to be submitted during the proceedings or the division has to 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.

## 8.4 Surrender of patent

A patent may not be surrendered in opposition proceedings by the proprietor filing a declaration of surrender with the EPO. Such a surrender must be declared before the competent authorities in the designated states in question (see D-VII, 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).

*Rule 84(1)*



## Chapter IX – 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). If an applicant enters the European phase without having requested international preliminary examination under PCT Chapter II, the EPO will act as a "designated Office". If before entering the European phase the application was processed under PCT Chapter II, the EPO will act in the European phase as an "elected Office". 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.

*Art. 153(1)(a) and (b)*  
*Art. 153(2)*  
*Art. 150(2)*

In addition to being a designated and, where appropriate, elected Office, the EPO may act as a receiving Office under the PCT within the terms set out in Art. 151. 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 an International Searching Authority specified for Supplementary International Search (SISA) under the PCT (see also the EPO-WIPO Agreement, OJ EPO 2017, A115, OJ EPO 2018, A24, and OJ EPO 2018, A35). 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 the cases mentioned under (i) - (iii), the applicant files, in addition, a demand for international preliminary examination with an IPEA other than the EPO. The EPO is an "elected Office";
- (v) in the cases mentioned under (i) - (iii), the applicant files, in addition, a demand for international preliminary examination with the EPO as International Preliminary Examining Authority. The EPO may carry out this function irrespective of whether it was the receiving Office. It can, however, only act as an IPEA if the international search was carried out by the EPO, the Austrian, Spanish, Swedish, Finnish or Turkish Patent Office, the Nordic Patent Institute or the Visegrad Patent Institute. The EPO thus acts as IPEA and is also an elected Office;

- (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), there will be 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 43bis PCT) will have been prepared by the search division of the EPO.

For further details on the procedure before the EPO as RO, ISA, IPEA or SISA, see the Guidelines for search and examination at the EPO as PCT authority (GL/PCT-EPO) and the Guide for applicants: "Euro-PCT Guide: PCT procedure at the EPO".

## 2. EPO as designated or elected Office

Art. 150(2)

Art. 27(1) PCT

In proceedings before the EPO relating to international applications, the provisions of the PCT apply, 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 prevalence of the PCT provisions and the requirements of Art. 150 and Art. 153 relating to international applications under the PCT in the European phase, the instructions in the earlier chapters of these Guidelines do not always apply to the procedure before the EPO as designated or elected Office.

This section deals with the specific aspects of the procedure before the EPO as designated or elected Office. It addresses, in subsections E-IX, 2.2 to 2.5 and 2.10, the formalities examination of international applications upon entry into the European phase **in so far as it differs** from that applicable to European direct applications, by reference to the instructions in the appropriate sections of Part A.

### 2.1 Entry into the European phase

#### 2.1.1 Requirements for entry into the European phase

Rule 159

"Entry into the European phase" is not an act in itself but a series of acts to be performed. In order to initiate the European phase, the applicant must perform the following acts within 31 months from the filing date or, if priority has been claimed, from the earliest priority date:

- supply the translation if the Euro-PCT application was not published in one of the EPO's official languages (see E-IX, 2.1.3),
- specify the application documents on which the European grant procedure is to be based,
- pay the filing fee provided for in Art. 78(2), including the additional page fee for applications with more than 35 pages (see E-IX, 2.1.4),

- pay the designation fee (and any extension or validation fees) if the period under Rule 39 has expired earlier (see E-IX, 2.3.11),
- pay the search fee if a supplementary European search report is to be drawn up (see E-IX, 2.1.4 and E-IX, 2.5.3),
- file the request for examination and pay the examination fee if the period under Rule 70(1) has expired earlier (see E-IX, 2.1.4),
- pay the renewal fee for the third year if the period under Rule 51(1) has expired earlier (see E-IX, 2.3.12),
- where applicable, file the certificate of exhibition mentioned in Art. 55(2) (see E-IX, 2.4.3).

Depending on the circumstances of the particular application, the applicant may additionally have to complete one or more of the following acts within the 31-month time limit:

- pay any claims fees due (see E-IX, 2.3.8),
- file the designation of the inventor (see E-IX, 2.3.4),
- furnish the file number or the certified copy of the application(s) of which priority is claimed (see E-IX, 2.3.5),
- furnish a sequence listing complying with the standard (see E-IX, 2.4.2),
- furnish the indications on the applicant mentioned in Rule 163(4) in respect of any applicant (see E-IX, 2.3.1),
- appoint a professional representative (see E-IX, 2.3.1),
- furnish a copy of the results of any search carried out by or on behalf of the authority with which the priority application was filed (see A-III, 6.12).

Applicants are strongly recommended to use the most recent edition of Form 1200 available as editable electronic document from the EPO website (*epo.org*), 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. The form and any other documents must be filed with the EPO, they may not be sent to the IB or to an authority of an EPC contracting state.

The documents on which the proceedings in the European phase are to be based can best be indicated in section 6 of Form 1200; further details may be provided on an additional sheet. The applicant must make sure that the indications in section 6 and/or on the additional sheet correspond to any indications given in the table for section 6 provided for the calculation of the additional (page) fee to be paid for applications comprising more than 35 pages (see A-III, 13.2). If the applicant has filed test reports

*Rule 159(1)(b)*

(e.g. comparative examples in support of inventive step) with the EPO as IPEA, it is assumed that the EPO may also use them in the European grant proceedings.

If the applicant does not specify the application documents on which the European grant procedure is to be based, the international application as published as well as any amendments made in the international phase are considered to form part of the procedure. The additional fee to be paid for an application comprising more than thirty-five pages will be calculated on the basis of the international application as published; any amendment pages not specified as replacing the corresponding pages of the international publication will be taken as additional pages (see A-III, 13.2).

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

The initial processing and formal examination of international applications are carried out in the international phase by PCT authorities under the PCT.

Unless there is a specific request for early processing (see E-IX, 2.8), 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). The EPO will, however, prior to the expiry of the 31-month time limit, perform any purely administrative tasks such as adding documents relating to the European phase to the file and recording the professional European representative appointed to act on behalf of the applicant in the European phase, to ensure the correct notification of correspondence once the ban on processing has been lifted. 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).

### 2.1.3 Translation of the international application

Where the international application was not published in 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 of the published application 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). The language of the translation determines the language of the proceedings before the EPO.

The translation must include:

- |   |  |
|---|--|
| <i>Rule 49.5(a) and (k)<br/>PCT</i>               | (i) the description (as originally filed; the title as established by the ISA under Rule 37.2 PCT, if applicable), |
| <i>Rule 49.5(a) PCT</i>                           | (ii) the claims (as originally filed),   |
| <i>Rule 49.5(a), (d) and<br/>Rule 49.5(f) PCT</i> | (iii) any text matter in the drawings except for the expression "Fig." (as originally filed),                      |

*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(1), item 12,  
RFees*

*Art. 14(2) and (3),  
153(4)  
Rule 159(1)(a)*

- NB:** In relation to items (i) to (iii) above, in the case of a correction of erroneously filed elements or parts under Rule 20.5bis(d) PCT by the receiving Office (see C-III, 1.3), the translation must include both the erroneously filed application documents and the correct application documents with an indication as to which pages relate to the correct and which to the erroneously filed application documents,
- (iv) the abstract (as published), *Rule 49.5(a) PCT*
  - (v) any published request for rectification under Rule 91.3(d) PCT;
  - (vi) any text matter contained in the sequence listing unless the text in the sequence listing is available to the EPO in English; the translation is to be furnished in the form of a copy of the complete sequence listing complying with the applicable WIPO standard including a translation of the text matter; *Rules 12.1(d) and 49.5(a-bis) PCT*
  - (vii) any references to deposited biological material furnished separately, *Rule 49.3 and 49.5(h) PCT*
  - (viii) if the EPO acts as **designated Office**, and the applicant wishes the amended claims under Art. 19 PCT to form the basis of further proceedings, *Art. 19 PCT*  
*Rule 49.3, 49.5(a)(ii) and (c-bis) PCT*  
*Rules 3 and 137(4)*
    - the amendments under Art. 19 PCT in the form of a translation of the complete set of claims furnished under that provision and the statement under Art. 19(1) PCT, if submitted to the IB, and,
    - the accompanying letter, indicating the basis for the amendments in the application as filed (Rule 46.5(b) PCT), so as to allow the examiner to understand and take the amendments into account (see also E-IX, 3.4),
  - (ix) if the EPO acts as **elected Office**, *Art. 39(1), 36(2)(b) and (3)(b) PCT*  
*Rules 70.16 and 74.1(a) PCT*
    - all annexes to the international preliminary examination report (IPER), i.e. any replacement sheets and accompanying letters referred to in Rule 70.16 PCT that allow the examiner to understand the amendments, regardless of whether protection is sought for the same version of the application documents as was the subject of the IPER,
    - any amendments made to the claims under Art. 19 PCT (cf. item (viii) above) if the applicant wishes these amendments to form the basis of further proceedings and they are not annexed to the IPER (for instance because they were considered reversed by an amendment under Art. 34 PCT). *Rule 76.5(iv) PCT*
- If the applicant does not furnish the translation of any of the items (i) or (ii) above within the 31-month period, the application is deemed to be withdrawn under Rule 160(1). *Art. 24(1)(iii) or 39(2) PCT*  
*Rule 160(1)*

- Rule 49.5(c-bis), (g), (h) PCT* If the applicant does not furnish the translation of any of the items (ii) to (ix) above within the 31-month period, the EPO will invite him to furnish the translation within a two-month period from notification of the respective communication under Rule 159(1)(a). The same applies if, in the case of a correction of erroneously filed elements or parts under Rule 20.5bis(d) PCT by the receiving Office (see C-III, 1.3), translations of the erroneously filed application documents (in relation to items (i) to (iii) above) have not been filed. If the applicant does not comply with this invitation
- Art. 24(1)(iii) or 39(2) PCT; Rule 160(1)* – as regards items (iii) to (vii) above, the application is deemed to be withdrawn;
- as regards translations of erroneously filed application documents (in relation to items (i) to (iii) above) in the case of a correction of erroneously filed elements or parts under Rule 20.5bis(d) PCT by the receiving Office, the application is deemed to be withdrawn;
- Art. 39(2) PCT; Rule 160(1)* – as regards the replacement sheets referred to in item (ix) above, the application is deemed to be withdrawn;
- Rule 49.5(c-bis) PCT; Rule 3(2)* – as regards the replacement sheets referred to in item (viii) above, the EPO will disregard the amendments under Art. 19 PCT;
- Rule 49.5(c) PCT; Rule 3(1)* – as regards the accompanying letter and the statement referred to in item (viii) above, the EPO will disregard that letter and that statement and may proceed under Rule 137(4) where applicable (see E-IX, 3.4);
- Rule 49.5(c) PCT; Rule 3(1)* – as regards the accompanying letters referred to item (ix) above, the EPO will disregard those letters and may proceed under Rule 137(4) where applicable (see E-IX, 3.4).

Where the application is deemed to be withdrawn under Rule 160(1), 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), see E-VIII, 2).

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.

- Art. 153(4) Art. 14(2)* A translation, whether filed on entry into the European phase under Art. 153(4) or in the international phase under Rule 12.3 or 12.4 PCT, may always be brought into conformity with the application as filed. The conditions set out in A-VII, 7 apply.



#### 2.1.4 Filing fee, designation fee, request for examination and search fee

Under Rule 159(1)(c), applicants 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), they must pay the 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 (see also E-IX, 2.5.2). Where a supplementary European search report needs to be drawn up, a search fee must also be paid to the EPO within this period (see also E-IX, 2.5.3). 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.

*Rule 159(1)*  
*Rule 160*  
*Art. 2(1), item 12,*  
*RFees*

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 (see E-VIII, 2).

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

The instructions in 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 further examination as regards entitlement is necessary.

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

The provisions for late filing of missing parts (Rule 56) or correction of erroneously filed application documents or parts (Rule 56a) completely contained in the priority document apply if the EPO is designated/elected Office. Similar options exist under the PCT in relation to the receiving Office (Rule 20.5 to 20.8 PCT). These sets of provisions apply in parallel. For a request under Rule 56 or Rule 56a to be allowed by the EPO as designated/elected Office, it must have been filed, together with the documents required under Rule 56(3) or Rule 56a(4) respectively, within two months from the date of filing or from a communication of the receiving Office under Rule 20.5(a) PCT or Rule 20.5bis(a) PCT, as the case may be (see Rule 56(2) and Rule 56a(3)), and the applicant must have effectively requested "early processing" under Art. 23(2) PCT (see E-IX, 2.8) before expiry of the two-month period under Rule 56(2) or Rule 56a(3).

*Rule 56*  
*Rule 56a*  
*Rule 20 PCT*

Incorporations by reference by the receiving Office under Rule 20.5bis(d) PCT, i.e. without changing the filing date, will be effective before the EPO as designated or elected Office for international applications filed on or after 1 November 2022 (see C-III, 1.3). For details see the notice from the EPO dated 23 June 2022, OJ EPO 2022, A71. On entry into the European phase, the normal procedures apply on the basis that the correct and erroneously filed parts are thus considered part of the application as filed.

*Art. 24, 25, 26,  
27 and 48 PCT  
Rule 82bis and  
82ter PCT  
Rule 139*

In addition, Art. 26, 27 and 48 PCT, Rules 82bis and 82ter PCT and Rule 139 EPC apply.

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 unless correction as a consequence of review by the EPO as designated/elected Office under Art. 24 or 25 PCT or Rule 82ter PCT applies (see E-IX, 2.9). In respect of the procedure for establishing the date of filing in the case of elements or parts erroneously filed under Rule 20.5bis(d) PCT, see C-III, 1.3. 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-IX, 3.1).

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

### **2.3.1 Representation, address for correspondence**

The instructions in 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).

If the agents acting in the international phase are professional representatives entitled to practise before the EPO, such representatives are not automatically considered appointed for the European phase. If any applicant has mandated them to act on their behalf also in the European phase, the representatives need to identify themselves accordingly to the EPO as designated/elected Office. The only case in which professional representatives acting in the international phase are automatically considered appointed for the European phase is if they were validly appointed in the procedure before the EPO as receiving Office, ISA or IPEA and it is clear from the respective file that the appointment extends to representation in the European phase. The same principles apply where applicants having their residence or principal place of business in an EPC contracting state are represented by an authorised employee (see A-VIII, 1.3).

Applicants, in particular those not resident in an EPC contracting state, are recommended to appoint a professional representative before the EPO in

good time, i.e. before initiating proceedings before the EPO as designated/elected Office (see also E-IX, 2.1.2).

However, up to expiry of the 31-month time limit under Rule 159, applicants having neither a residence nor their principal place of business within the territory of one of the contracting states may either comply with any requirement themselves or act through a professional representative entitled to practise before the EPO. This means that applicants having neither a residence nor the principal place of business within the territory of one of the contracting states may themselves, within the 31-month time limit, for example sign and file EPO Form 1200, submit amendments, file a translation of the application, file a request for early processing, etc.

Applicants having neither a residence nor their principal place of business within the territory of one of the contracting states who do not themselves take the required steps for entry into the European phase within the 31-month time limit may, after expiry of that time limit, perform these and the other procedural steps (e.g. filing a request for re-establishment of rights) only through a professional representative entitled to practise before the EPO.

In case of failure to appoint a professional representative where this is required, the EPO invites the applicant to do so within a time limit of two months. Until the EPO is informed of a (valid) appointment, any procedural step taken by the applicant will be deemed not to have been taken. If the deficiency is not corrected in due time, the application will be refused; the applicant may request further processing (see E-VIII, 2).

*Rule 163(5) - (6)*

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

*Rule 163(4) - (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 applicants fail to reply in time to the above-mentioned invitation, they may request further processing.

Applicants (whether natural or legal persons) whose residence or principal place of business is in an EPC contracting state and who act without a professional representative may make use of an address for correspondence which is different from their address of residence. See A-III, 4.2.1.

### **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 (EPO 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 an inventor has been named in the PCT request, the latter cannot waive their 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). Applicants will be notified of this decision according to Rule 111. They may request further processing (see E-VIII, 2).

### 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.

#### 2.3.5.1 Priority document

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 processing (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), (b) or (b-bis) PCT, the EPO may not ask the applicant himself to furnish a copy.

*Rule 163(2)*

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the 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 18 October 2018, OJ EPO 2018, A78, 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, where the applicant has complied with Rule 17.1(a), (b) or (b-*bis*) PCT the EPO as a designated Office may not ask the applicant himself to furnish it with a copy of the priority document (Rule 17.2(a) PCT, second sentence).

If the priority document is not on file, substantive examination may nevertheless be started, 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.

On the other hand, 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 subsections and 6.10).

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

### 2.3.5.2 Information on prior art

The applicant must, on entry into the European phase, file the results of any search carried out by or on behalf of the office of first filing for each application whose priority is claimed (see A-III, 6.12).

### 2.3.5.3 Restoration of priority

The provisions for restoration of priority right (see A-III, 6.6) also exist under the PCT (Rules 26*bis*.3 and 49*ter* PCT). Under the PCT, restoration of the 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 as designated or elected Office (Rule 49*ter*.2(b)(i) PCT).

The EPO only 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; see also E-VIII, 3.2 and the notice from the EPO dated 7 November 2007, OJ EPO 2007, 692). As a consequence, any request for restoration of priority rights granted by a receiving Office under the "unintentional" criterion does not have any effect before the EPO as designated/elected Office (Rule 49*ter*.1(b) PCT).

As set out hereafter, if the applicant has already filed a request for restoration of priority with the receiving Office, a (new) request need not always be filed upon entry into the European phase.

*Rule 49ter PCT*  
*Art. 122*  
*PCT Newsletter*  
*9/2015, 10*

If the priority right was restored by the receiving Office under the "due care criterion", no new request need be filed with the EPO as designated/elected Office, since the EPO will, in principle, recognise the decision of the receiving Office. If, however, the EPO has reasonable doubt that the requirements for grant were met, it will notify the applicant accordingly. In this communication the reasons for such doubt will be indicated and a time limit will be set within which the applicant may submit comments.

Consequently, if the applicant wants the priority claim to be valid in the procedure before the EPO as designated/elected Office, a request for restoration must always be filed if, in the procedure before the receiving Office:

- no request for restoration of priority right was filed;
- a request for restoration of priority right was rejected;
- a request for restoration of priority right was granted under the "unintentional criterion".

The EPO as designated/elected Office will grant a request for restoration of priority right only if the following requirements are met:

- (i) the filing date is within two months of the date of expiry of the priority period;
- (ii) the failure to claim the right of priority within the priority period occurred in spite of due care required by the circumstances having been taken;
- (iii) a request for restoration of priority is filed within one month from the date on which the 31-month time limit for entry into the European phase expired or from the effective date of early entry into the European phase (see E-IX, 2.8); where the application is deemed withdrawn under Rule 160(1) for failure to comply with a requirement under Rule 159(1), the request for restoration of priority may still be filed together with a timely request for further processing in respect of the 31-month time limit under Rule 159(1) or, failing this, with a timely request for re-establishment of rights in respect of the period for requesting further processing;
- (iv) the fee for restoration of priority (Art. 2(1), item 13, RFees) is duly paid within the time limit mentioned under point (iii); the further considerations made under point (iii) also apply to this fee;
- (v) the request is accompanied by a statement of reasons for the failure to file the international application within the priority period and is preferably accompanied by any declaration or other evidence in support of the statement of reasons.

### 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 instructions in 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 has to ensure that the corresponding material is excluded from the translation as furnished by the applicant (see E-IX, 2.1.3).

### 2.3.8 Claims fee

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

If they have not been paid by then, under Rule 162(2), they may still be paid within the six-month period under Rule 161(1) and (2). Rule 162(2) distinguishes between two situations in which the applicant must ensure payment of claims fees before expiry of the six-month period:

*Rule 162(2)*

Rule 162(2), first sentence, covers the situation in which the applicant does not file amendments after expiry of the 31-month period and before expiry of the six-month period under Rule 161. In this case, the applicant must ensure that any claims fees not yet paid for the set of claims filed within the 31-month period are paid before expiry of the six-month period under Rule 161.

#### *Example:*

A Euro-PCT application X contains 27 claims on expiry of the 31-month period. The applicants pay five claims fees within the 31-month period. They must ensure that seven claims fees are paid before expiry of the six-month period under Rule 161.

Rule 162(2), second sentence, covers the situation in which the applicants file an amended set of claims after expiry of the 31-month period and before expiry of the six-month period under Rule 161. In this case, they must compute the number of claims fees due on the basis of the claims on file on expiry of the six-month period under Rule 161. Before expiry of this period, they must ensure that any claims fees are paid for the number of claims on file on expiry of this period which exceeds the number of claims for which claims fees were paid within the 31-month period.

#### *Example:*

A Euro-PCT application Y contains 27 claims on expiry of the 31-month period. The applicants pay five claims fees within the 31-month period. After expiry of the 31-month period and before expiry of the six-month period under Rule 161, they file an amended set of 32 claims. The applicants must

compute the number of claims fees on the basis of the claims on file on expiry of the six-month period, i.e.  $32 - 15 = 17$ . Since they have already paid five claims fees, they must pay 12 claims fees ( $17 - 5 = 12$ ) before expiry of the six-month period under Rule 161.

If there are more than 15 claims on file on expiry of the six-month period under Rule 161, any of the sixteenth and each subsequent claim for which no claims fee has been paid is deemed to be abandoned under Rule 162(4) (see also the notice from the EPO dated 16 December 2016, OJ EPO 2016, A103).

Where a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned. The loss of rights may be remedied by a request for further processing (see E-VIII, 2). 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.

### 2.3.9 Drawings

The provisions of the EPC concerning the filing of drawings (see A-II, 5 and A-III, 3.2) are identical with the corresponding provisions of the PCT and therefore no supplementary examination is necessary, provided that the provisions of Rule 11 PCT have been complied with (see also E-IX, 2.3.2).

### 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, in so far 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.

### 2.3.12 Renewal fees

The renewal fees for a Euro-PCT application are due in respect of the third and each subsequent year, calculated from the date of filing of the Euro-PCT application as accorded by the receiving Office. If, according to Rule 51(1), the renewal fee for the third year fell due within the 31-month time limit for entry into the European phase, the due date is deferred and the fee may still be paid without surcharge up to expiry of the 31-month time limit (see A-X, 5.2.4).

Rule 159(1)(g)



## 2.4 Instructions in 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 filed an effective request for early processing (see J 18/09, Reasons 9, and E-IX, 2.8).

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 E-IX, 2.1.2, E-IX, 2.1.3 and E-IX, 2.1.4).

### 2.4.2 Sequence listings

In relation to A-IV, 5 ("Applications relating to nucleotide and amino acid sequences"), where the Euro-PCT application discloses nucleotide or amino acid sequences, a sequence listing in electronic form drawn up in compliance with the applicable WIPO standard must be available to the EPO as designated/elected Office on expiry of the 31-month time limit. As a rule, it will be available to the EPO if it was contained in the international application under Rule 5.2 PCT or filed under Rule 13~~ter~~ PCT with the EPO acting as ISA/SISA or IPEA. It will also be accessible to the EPO if it is made available by WIPO on PATENTSCOPE and can be downloaded in a usable form.

*Rule 163(3)*

If such a sequence listing is not available to the EPO and has not been filed by the applicant, at the expiry of the 31-month time limit, the applicant will be invited to furnish the sequence listing in electronic form in accordance with the applicable WIPO standard and pay a late-furnishing fee within a period of two months (see Rule 163(3) and 30(3)). The sequence listing may not be filed on paper or in PDF format (see the decision of the President of the EPO dated 9 December 2021 (OJ EPO 2021, A96) and point 6 of the notice from the EPO dated 9 December 2021 (OJ EPO 2021, A97)).

If the required sequence listing is not filed within the time limit set, the application is refused. The refusal may be remedied by a request for further processing (see E-VIII, 2).

### 2.4.3 Certificate of exhibition

As regards the requirements described in A-IV, 3 ("Display at an exhibition"), for Euro-PCT applications the certificate of exhibition, where relevant, is to be filed within the 31-month time limit for entry into the European phase. If the document is not filed in due time, the applicant is informed of this in a communication under Rule 112(1). The omission may be remedied by a

*Rule 159(1)(h)*

request for further processing, which will be granted if within two months from notification of the communication the certificate is furnished and the fee for further processing is paid (see E-VIII, 2).

#### **2.4.4 Biological material**

*Rule 31*

With respect to A-IV, 4 ("Applications relating to biological material"), no remedy is available before the EPO as designated/elected Office upon entry into the European phase if the specific requirements for the sufficient disclosure of the invention have not been met in the international phase. If, however, on filing the international application a reference to the deposit of biological material complying with Rule 31 was made but no proof of the deposit in the form of a copy of the deposit receipt issued by the depositary institution was submitted, the applicant is strongly advised to do so upon entry into the European phase. See also F-III, 6.5.

If the Euro-PCT application was not published by the IB in an official language of the EPO, the biological material referred to in the application is available upon request to any person (only) from the date of publication of the translation by the EPO (see E-IX, 2.5.1). In this case, if the applicant files the statement under Rule 32(1) before the technical preparations for publication of the translation by the EPO are completed, the biological material concerned will be made available only by the issue of a sample to an independent expert nominated by the requester (see A-IV, 4.3).

### **2.5 Instructions in 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**

*Art. 153(3) and  
(4)  
Rule 159  
Art. 67*

The international publication of a Euro-PCT application in an official language of the European Patent Office takes the place of publication of the European patent application and will be mentioned in the European Patent Bulletin. If the international publication of the Euro-PCT application is in another language, a translation into one of the official languages must be filed with the EPO within 31 months of the priority date (Art. 22(1) PCT and Rule 159(1)(a)), see E-IX, 2.1.3. The EPO will publish the translation of the application submitted by the applicant upon entry into the European phase. In that case the provisional protection is, subject to Art. 67(2) and (3), only effective as from the date of publication of the translation by the EPO.

The translation of the international application is published together with the bibliographic data as an A document and includes all documents that were part of the international publication as originally published:

- the description as originally filed;
- the claims as originally filed;
- any claims amended under Art. 19 PCT, including any related statement of which a translation has been filed (see E-IX, 2.1.3, **items (viii) and (ix)**);

- any drawings as originally filed;
- the sequence listing forming part of the description;
- the abstract;
- any appendices to the application;
- any certificate(s) of the deposit of biological material;
- the translation of the international search report (Rule 44*bis*.3 PCT).

The mandatory translation of the annexes to the IPER and any amendments to the application documents filed on or after entry into the European phase are not published.

If Rule 20.5*bis*(d) PCT applies (see C-III, 1.3), the publication will comprise the translation of both the erroneously filed application documents and the correct application documents. The front page of the publication will make reference to the fact that the notification of incompatibility under Rule 20.5*bis*(d) PCT applies to the application if the application was filed between 1 July 2020 and 31 October 2022. The notification of incompatibility was withdrawn with effect from 1 November 2022 and is no longer indicated for applications filed on or after that date.

Pursuant to Art. 153(6), the international search report takes the place of the European search report. Once the supplementary European search report has been drawn up, this will be mentioned in the European Patent Bulletin. The supplementary search report itself is not published but is available via file inspection (see A-XI, 2.2).

If the translation is not supplied, the application is to be deemed withdrawn (see E-IX, 2.1.3). 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) pursuant to Rule 165 (see G-IV, 5.2).

*Rule 160(1)*  
*Rule 165*

### 2.5.2 Request for examination

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-IX, 2.1.4.

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

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-IX, 2.8) and if any required supplementary European search report is available.

### 2.5.3 Supplementary European search

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)*

Rule 70(2) (see A-VI, 2.2, third 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). Applicants making use of Form 1200 for entry into the European phase may waive the right to be asked whether they wish to proceed further by ticking a check box in **section 12.2** (see the notice from the EPO dated 7 July 2017, OJ EPO 2017, A74).

## 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; 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-IX, 2.2 and 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

*Art. 23 PCT*  
*Rule 44bis.2 PCT*

When acting as a designated Office, the EPO must not process or examine an international application before expiry of the period applicable under Art. 22 PCT (Art. 23(1) PCT). However, the EPO may, on the express request of the applicant, process or examine an international application at any time (Art. 23(2) PCT). 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(2) and*  
*40(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 applicants must clearly express that they wish the processing of their application before the EPO as designated/elected Office to commence early. Applicants using EPO Form 1200 may file a request by ticking a check box in **section 12.1** (see the notice from the EPO dated 7 July 2017, OJ EPO 2017, A74).

*Rule 159(1)*

For the request to be effective, applicants must comply with the requirements stipulated in Rule 159(1) as if the 31-month time limit expired on the date they request 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 applicants wish not only the processing of the application before the EPO as designated/elected Office but also the examination of the application to start, they must have filed a valid request for examination (including payment of the examination fee), even if the time limit under Rule 70(1) has not yet expired at the date of effective entry into the European phase, since examination will be taken up only if a request for examination has been validly filed (see E-IX, 2.5.2). Furthermore, if a request for examination is filed before the EPO has, where applicable, sent the supplementary European search report to the applicants, examination will start only upon receipt of an indication from them that they wish to proceed further with the application and, if required, a response to the extended European search report (see E-IX, 2.5.3).

For international applications filed between 1 July 2020 and 31 October 2022, correction of erroneously filed elements or parts under Rule 20.5bis(d) PCT by the receiving Office is not effective in proceedings before the EPO as designated/elected Office in accordance with the EPO's declaration of incompatibility (Rule 20.8 PCT). Thus, applicants who want to make use of the abridged procedure (by requesting that the correct application documents be disregarded or by indicating that they wish to pursue the application containing the correct application documents with the date of receipt of those application documents as the filing date – see C-III, 1.3) must inform the EPO accordingly at the time the request for early processing is validly filed or at the latest before the communication under Rules 20.8(c) and 82ter.1(c) and (d) PCT is issued.

*Rule 20.5bis PCT  
OJ EPO 2022, A3*

The automatic debiting procedure may be used for effecting payment of the fees falling due on filing the request (see Annex A.1 and Annex A.2 to the ADA, Supplementary publication 3, OJ EPO 2022). However, automatic debiting can only be performed if the EPO can establish whether or not a page fee needs to be included as part of the filing fee (see A-III, 13.2). This is only possible if the EPO has access to the documents referred to in Art. 20 PCT, i.e. if:

- the international application has already been published at the time the request for early processing is received,
- the EPO is the receiving Office, or

- the EPO is acting as (S)ISA or IPEA.

If none of the above documents is available to the EPO on the day the request for early processing is filed, applicants are advised to choose another means of payment. Otherwise the fees due will be debited on the date of receipt of the documents referred to in Art. 20 PCT from the International Bureau (Rule 47.4 PCT) and the date on which the request for early processing takes effect will be postponed to that date.

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.

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.

## **2.9 Review by the EPO as a designated/elected Office and rectification of errors made by the receiving Office or the International Bureau**

### **2.9.1 Review by the EPO under Art. 25 PCT**

*Art. 25 PCT, Rules 51  
and 82ter PCT  
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.

To obtain such a review by the EPO as designated Office, applicants must take the following steps within the two-month time limit under Rule 51.1 PCT:

- request the IB to send copies of documents in the files promptly to the EPO as designated Office,
- pay the filing fee under Rule 159(1)(c) and, where required,
- furnish a translation of the Euro-PCT application.

Applicants are recommended to undertake the remaining steps for entry into the European phase under Rule 159(1) at the same time, possibly together with a request for early processing (see E-IX, 2.8).

The formalities officer acting on behalf of the examining division is competent to take decisions in relation to these applications (see the decision of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6), 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, taking into account as the date of filing of the application the date it was originally filed with the PCT receiving Office and claiming the priority date of the international application, as applicable.

### **2.9.2 Review by the EPO under Art. 24 PCT and excuse of delays under Art. 48(2) PCT**

Pursuant to Art. 24(2) PCT, the EPO as designated/elected Office may maintain the application as a European application even if this is not required by virtue of Art. 25(2) PCT (see also OJ EPO 1984, 565, Reasons 4). The filing of a request under Art. 24(2) PCT is governed by the same requirements as a request for review under Art. 25(2) PCT (see E-IX, 2.9.1), with the exception that the two-month time limit under Rule 51 PCT does not apply (see J 19/16, Reasons 6). Such requests may have to be combined with a request for re-establishment of rights under Art. 122 or further processing under Art. 121 (see E-VIII, 2 and E-VIII, 3) as the appropriate means of remedying the non-observance of a time limit under the EPC.

*Art. 24(2), 48(2),  
Rule 82bis PCT  
Art. 122, 121*

### **2.9.3 Rectification of errors made by the receiving Office or the International Bureau**

If the applicant proves to the satisfaction of the EPO that the international filing date is incorrect owing to an error made by the receiving Office or that the priority claim has been erroneously considered not to have been made, and if the error is such that, had it been made by the EPO itself, the EPO would rectify it under the EPC, the EPO must rectify the error on the applicant's request and treat the international application as if it had been accorded the rectified international filing date or as if the priority claim had not been considered not to have been made (see also E-IX, 2.9.1).

*Rule 82ter.1(a) PCT*

Further, if a receiving Office accords the international filing date on the basis of incorporation by reference of missing parts under Rule 20.5 PCT, the EPO as designated/elected Office will review of its own motion whether the requirements of Rule 82ter.1(b)(i)-(iii) PCT have been complied with. In particular, the EPO will consider whether the element or part incorporated by reference was indeed missing. For instance, where the international application contained a description and a claim or claims on the international filing date, it is not possible to replace these elements with elements from a priority application. It is also not possible to add elements from a priority application if this would result in the international application having, for instance, two (or more) descriptions or two (or more) sets of claims. As of 1 July 2020, such cases may however be handled by the receiving Office

*Art. 11(1)(iii)(d), (e),  
Rule 4.18, Rule  
20.5bis PCT, 20.6,  
82ter.1(b) PCT*

under Rule 20.5*bis* PCT (see E-IX, 2.9.4 for the determination of the filing date in such a case).

Rule 82*ter*.1(c), (d)  
PCT

If the EPO does not agree with the finding of the receiving Office, it will notify the applicant that it intends to consider the (later) date on which the missing element or part was furnished as the international filing date in the European patent grant procedure, giving the applicant the opportunity to comment in accordance with Art. 113(1). In the case of missing parts, the applicant may also request that the missing part concerned be disregarded in the European patent grant procedure. In that case, the missing part will be considered not to have been furnished and the EPO will not treat the international application as if the international filing date had been corrected.

#### **2.9.4 Determination of filing date in the case of erroneously filed elements or parts of the international application**

Rule 20.5*bis*, 20.8(b-*bis*) PCT

Rule 20.5*bis* PCT, which entered into force on 1 July 2020, allows applicants to correct an erroneously filed element (description or claims) or part of the description, claims or drawings (including all drawings) contained in an international application. Following the entry into force of new Rule 56a on 1 November 2022, the notification of incompatibility under Rule 20.8(b-*bis*) PCT of this provision with the EPC legal framework has been withdrawn. As a consequence, incorporation by reference by the receiving Office under Rule 20.5*bis*(d) PCT, i.e. without changing the filing date, will be effective before the EPO as designated or elected Office for international applications filed on or after 1 November 2022.

For international applications filed between 1 July 2020 and 31 October 2022, the limitation under the procedure described in E-IX, 2.2 and C-III, 1.3 remains unchanged. If the receiving Office considered the correct application documents to be incorporated by reference under Rule 20.5*bis*(d) PCT, i.e. without changing the filing date, this incorporation will not be effective in proceedings before the EPO as designated/elected Office. For the procedure applied for establishing the filing date and the application documents forming the basis of proceedings, see C-III, 1.3.

#### **2.10 Inspection of files**

Art. 30(2) PCT  
Rule 94.2*bis* 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 (see A-XI, 2 and A-XI, 3).



### 3. The communication according to Rule 161

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

Where the EPO has not drawn up an international search report (as ISA) or a supplementary international search report (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, 4.3.2); a supplementary European search report and search opinion are 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, applicants may explicitly waive their 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 notice from the EPO 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-VIII, 4).

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

Where the EPO has drawn up an international search report (ISR) or a supplementary international search report (SISR), no supplementary European search report is prepared (see the decision of the Administrative Council of 28 October 2009, OJ EPO 2009, 594, and B-II, 4.3.1, B-II, 4.3.2).

*Rule 161(1)*

In these cases, a written opinion of the ISA (WO-ISA) or a supplementary international search report (SISR) with explanations under Rule 45*bis*.7(e) PCT and – if the EPO was also IPEA – an international preliminary examination report (IPER) will already have been transmitted to the applicant during the international phase.

The applicant is 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-IX, 3.3.1). The time limit for response is six months from the invitation according to Rule 161(1) and is not extendable.

The communication under Rule 161(1) is issued promptly after expiry of the time limit for entry into the European phase and is combined with the communication under Rule 162(2) inviting the applicant to pay any claims fees due (see E-IX, 2.3.8).

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) unless one of the exceptions described in E-IX, 3.3 applies. Further processing is available for this loss of rights (see E-VIII, 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-IX, 4.3.2) or when issuing the invitation under Rule 164(2) (see C-III, 3.1), provided that the application is not deemed to be withdrawn.

In order to proceed with the examination of the application without having to wait until the expiry of the six-month time limit for response, applicants may explicitly waive their right to a communication pursuant to Rule 161(1) and Rule 162. Provided that, on entry into the European phase, they have 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 Rule 162 will be issued (see the notice from the EPO dated 5 April 2011, OJ EPO 2011, 354). 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-VIII, 4).

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-IX, 4.3.

Where a translation of the priority document 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

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).

#### 3.3.1 Earlier filed amendments or comments

A reply to the communication under Rule 161(1) may not be necessary where amendments or observations have already been filed that can be considered to be a valid reply. This is the case in the following situations:

- (i) If the applicant has filed new amendments and/or comments upon entry into the regional phase before the EPO, provided that
  - the applicant has indicated on entry into the European phase that such amendments and/or comments are to form the basis for further prosecution of the application (see E-IX, 2.1.1), and
  - they constitute a valid response (see B-XI, 8).
- (ii) If the applicant filed amendments according to Art. 19 and/or 34 PCT in the international phase, and if the EPO prepared the WO-ISA or SISR but no IPER (either because the applicant did not demand PCT 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, provided that the applicant
  - has indicated on entry into the European phase that these amendments are maintained,
  - has provided a copy of the amendments under Art. 34 PCT, filed with the IPEA other than the EPO, as well as any necessary translations in the language of the proceedings.

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).

If the requirements of Rule 137(4) were not fulfilled for amendments already filed, the required indications are to be made in reply to the Rule 161(1) communication (see E-IX, 3.4).

In cases (i) and (ii) above, no communication under Rule 161(1) and 162 is issued if applicants have explicitly waived their right to these and have already paid any claims fees due (see E-IX, 3.2).

#### 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) and 162 is issued if applicants have explicitly waived their right to these and have already paid any claims fees due (see E-IX, 3.2).

### 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-IX, 3.3.1 and the case mentioned in E-IX, 3.3.2 where the applicants are not required to respond to the WO-ISA, SISR or IPER prepared by the EPO (in response to the invitation under Rule 161(1)), they **may** still do so by filing further amendments and/or comments if they so wish. 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).

## 3.4 Rule 137(4) applies

In the case of Euro-PCT applications for which an international search report or supplementary European search report has been drawn up by the EPO since 1 April 2010, 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 H-III, 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). Corresponding requirements exist for amendments made in the international phase (Rules 46.5, 66.8 and 70.2 PCT).

## 4. Examination procedure

### 4.1 At least one communication in examination

If deficiencies persist in the application even after applicants have filed their response to the WO-ISA, supplementary international search report or IPER (as required by Rule 161(1)), the examining division will in general 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)

Rule 137(4)

has been issued. In exceptional cases, summons to oral proceedings may be issued as the first action in examination proceedings (see C-III, 5).

#### 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, 3.1.

*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) is raised (see also F-V, 7 and H-IV, 4).

*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 any other 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.

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. 14(1)*

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

*Art. 41 and 42 PCT*

- (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.

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

### 4.3.1 Comparative test results

Where the EPO has established the IPER and refers therein to the submission of test reports, applicants are taken to agree to the use of these reports as the basis for proceedings before the EPO when they use 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-IX, 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 applicants provide convincing arguments, appropriate amendments or relevant counter-evidence in their response to the IPER according to Rule 161(1), or conversely where the applicant provides amendments in response to the IPER which introduce further deficiencies.

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

*Rule 161(1)*

*Rule 159*

## Chapter X – Decisions

### 1. Basic principles of decisions

#### 1.1 General remarks

Decisions subject to appeal are taken by the Receiving Section, the examining divisions, the opposition divisions and the Legal Division. Unless otherwise specified, the principles described in this chapter apply to all such decisions. They also apply to decisions taken by formalities officers to whom this work is entrusted (see the decisions of the President of the EPO dated 12 December 2013, OJ EPO 2014, A6, and 23 November 2015, OJ EPO 2015, A104).

*Art. 106(1)*

*Art. 113(1)*

According to Art. 113(1), 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.

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

#### 1.2 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, however, 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 will 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-VIII, 1.8.

#### 1.3 Form and content

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

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 (operative part), and, if necessary;
- the facts and submissions;
- the reasoning;
- the communication of the possibility of appeal (Rule 111(2)); and
- the signature(s) and the name(s) of the employee(s) responsible.

*Rule 113(1)*

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.

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)).

### **1.3.1 Order**

The order (or "operative part") of the decision, must clearly state the request of the parties and the extent to which this request is complied with (T 756/14). It 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".

### **1.3.2 Facts and submissions**

Facts and submissions have to be given in so far 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 is given. These points, however, are to be covered in detail in the subsequent reasoning.

### **1.3.3 Reasoning**

The statement of grounds must first set out and substantiate the reasons for the decision, citing the individual EPC articles and rules involved.

For decisions taken by the examining or opposition division, see E-X, 2.6.

The deciding instance will draft the decision based on one or more grounds forming the basis of the decision, as appropriate. It is essential that the parties 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 having a subsequent ground contradict an earlier one. Furthermore, the chain of grounds must be structured so that it starts with the main ground.

All significant arguments advanced by a party to the proceedings are carefully examined and comprehensively discussed in the decision.

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.

## **2. Decisions taken by the examining or opposition divisions**

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

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

In opposition proceedings, if the patent is to be revoked, it must 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 must 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 parties so that they have 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 parties have had sufficient opportunity to comment and their 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.

### **2.1 Right to be heard**

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 may 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, by making 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, the result is 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.

## **2.2 Authoritative text of documents**

*Art. 113(2)*

The EPO must decide upon the European patent application or the European patent only in the text submitted 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.

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-X, 2.9). 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.

### 2.3 Requirements as to form

Decisions taken by the examining or opposition divisions have to adhere to the principles laid down in E-X, 1. Where a decision is produced by means of a computer, the file copy contains the names and the actual signature(s) of the employee(s) responsible.

*Rule 111(1)*

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 chair) may sign it on their behalf (see T 243/87). However, in such a situation, a brief written explanation as to why one member is signing on behalf of another must be provided (T 2348/19). 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).

The decision must be drafted using only the language of proceedings in order to meet the requirements of Rule 111(2). Arguments of parties in another official language must be summarised in the language of proceedings. Deviation is possible in exceptional cases only, such as where necessary to address questions of fact, evidence or law, for example in relation to witness statements.

### 2.4 Facts and submissions

For general aspects relating to facts and submissions, see E-X, 1.3.2. Facts and submissions which are irrelevant to the decision, e.g. requests for amendment which are not maintained, are to be omitted. It must be ensured that the facts and submissions are consistent with the contents of the minutes of oral proceedings (also see E-III, 10.3).

The facts and submissions must clearly indicate what is the subject of the application and show on which documents the decision is based. In examination, this requirement is achieved by including a detailed reference to the application documents which are subject to the decision, including, in particular, any amendments to the claims or to the description as well as

maintained auxiliary requests. In addition, the examining division may cite the text of any important claim(s) or passages of the description in the decision. In opposition, 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.

## 2.5 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 subsections, describes the procedure to be followed in case of such a request.

## 2.6 Reasoning of decisions

If the division is of the opinion that no patent can be granted, it will substantiate this in a decision citing the individual EPC articles and rules involved. For important general aspects relating to the reasoning of decisions, see the example below and E-X, 1.3.3.

### *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.

Art. 113(1)  
Rule 111(2)

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 must 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.

The conclusions drawn from the facts and evidence, e.g. publications, must be made clear. In particular, there must be consistency between the reasons and the facts as set out in the decision and in the minutes (also see E-X, 2.4). 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. Therefore, reference is made to each particular passage in the publication. 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.

The arguments put forward by the examiner during the proceedings 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 must make clear why none of those arguments persuaded the examining division to depart from the final result.

It is particularly important that special attention 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 need to be given which are intended to provide further proof of what has already been proven.

The decision is a standalone document and must 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 will not contain any matter on which the parties have not had an opportunity to comment.

## 2.7 Content

The decision normally deals 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 includes 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 must give the reasons for rejecting that request.

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

## 2.8 Analysing the parties' arguments

All significant arguments advanced by a losing party to the proceedings are 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.

## 2.9 Main and auxiliary requests

If during **examination proceedings** a main and auxiliary requests have been filed (see E-X, 2.2) 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 a brief indication of the essential reasons why the higher-ranking requests are not allowable or not admissible (see C-V, 1.1). If the applicant, in response to the communication pursuant to Rule 71(3), maintains higher-ranking requests which are not allowable or not admissible, 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 or non-admissibility of each request which ranks higher than the allowable request. In respect of the allowable request, the decision to refuse must mention that applicants have failed to give their approval to it.

Similarly, if in **opposition proceedings** the proprietor has submitted in addition to the 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.

In so far 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.

## 2.10 Late-filed submissions

*Art. 114(2)*  
*Rule 116*

If an examining or opposition division has exercised its discretion under Art. 114(2) or 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 Art. 114(2) or Rule 116 is not sufficient (see T 755/96). For details on how to exercise this discretion, see E-VI, 2 and H-II, 2.7.

## 2.11 Refusal to admit amendments under Rule 137(3)

*Rule 137(3)*

When, in exercising its discretion under Rule 137(3), the examining division refuses to admit amended claims, it must give reasons for so doing. For details on how to exercise this discretion, see H-II, 2.3 and H-II, 2.7.

If no other requests are on file, then there is no text agreed by the applicant and the application is to be refused under Art. 113(2).

### 3. Decisions which do not terminate proceedings – interlocutory decisions

A decision that does not terminate the proceedings as regards one of the parties is termed an interlocutory decision. An interlocutory decision can only be appealed together with the final decision unless it allows separate appeal. *Art. 106(2)*

The competent department will 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 will be the exception rather than the rule and will be given only if the duration or cost of the proceedings as a whole is thereby reduced. The interests of the parties will also be borne in mind as appropriate.

In the normal course, an interlocutory decision will 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 (see E-X, 1.3.3).

If it is decided not to allow separate appeal, the reasons for this ruling may be given in the final decision instead.

A ruling to allow a separate appeal must be part of the order of the decision (E-X, 1.3.1) (T 756/14).

### 4. Binding nature of decisions on appeals

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, in so far as the facts, e.g. the subject-matter of the patent and the relevant state of the art, are the same. *Art. 111(2)*

An opposition division is not bound by a decision of a board of appeal on appeal against a decision from an examining division (see T 167/93). 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, however,

takes due notice of the assessment of these facts, evidence and arguments as contained in the reasons of the decision of the board of appeal.

### 5. Information as to means of redress

*Rule 111(2)*

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.

### 6. Notification

*Art. 119*

Decisions must be notified as a matter of course (see E-II, 2).

### 7. Expiry of the term of the European patent

*Art. 63*

*Art. 89*

According to Art. 63(1), the term of the European patent is 20 years from the date of filing of the application. Under specific circumstances the contracting states can extend that term (Art. 63(2)).

The expiry of the 20-year term does not have an effect on the pendency of the European patent application. An applicant may still have a legitimate interest in the grant of the patent in view of provisional protection provided for in Art. 67(1). This means that examination of the application must continue unless the applicant withdraws the application or allows it to lapse by not responding to a communication issued by the examining division.

*Rule 75*

*Rule 84*

*Rule 98*

An opposition or an appeal can be filed even if the European patent has been surrendered or has lapsed in all contracting states (see D-I, 2 and E-XII, 2 respectively). For the effect of the expiry of the 20-year term on pending opposition proceedings, see D-VII, 5.1.

Similarly, a request for limitation or revocation can be filed after the expiry of the term of the European patent.



## Chapter XI – Impartiality of ~~the examining or opposition divisions~~

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 party 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 responsible superior of the members of the division along with the statement of the member(s) concerned on the facts and circumstances put forward by the party. The responsible superior will decide on the challenge and issue a reasoned decision in writing.

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 proceedings will continue. In either case, the superior's decision will be communicated to the parties as an annex to a communication from the division or to the division's decision, and will be referred to in the facts and submissions part of division's decision.

If the challenge to impartiality is raised in oral proceedings, the proceedings are interrupted in order for the responsible 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 superior considers the challenge 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 responsible superior holds that the challenge to impartiality is either inadmissible or not allowable, the division will inform the parties accordingly and the oral proceedings will continue. In either case, the superior's decision will be communicated to the parties, normally as an annex to the division's decision, and will be referred to in the facts and submissions part of that decision.



## Chapter XII – Appeals

### 1. Suspensive effect

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. Parties to the proceedings who feel that they have been adversely affected by the apportionment of costs may therefore only file an appeal against the decision on costs if they also lodge 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. It must contain the name and the address of the appellant as provided in Rule 41(2)(c), an indication of the decision impugned and a request defining the subject of the appeal. *Art. 108*  
*Rule 99(1)*

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. For appeals filed on or after 1 April 2018 by natural persons and entities referred to in Rule 6(4) and (5), i.e. small and medium-sized enterprises, non-profit organisations, universities and public research *Rule 6(4), (5)*

organisations, a reduced fee for appeal is payable, provided that a declaration of entitlement is filed at the latest by the time of payment of the reduced fee (see the notice from the EPO dated 18 December 2017, OJ EPO 2018, A5).

*Rule 99(2)*

Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed. In the statement of grounds of appeal, the appellant must indicate the reasons for setting aside the impugned decision or the extent to which it is to be amended and the facts and evidence on which the appeal is based.

## **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, an examining division or exceptionally an opposition division if all oppositions were withdrawn and the proprietor has filed 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-X, 2.6.

In either case, whether the appealed decision is rectified or the appeal is remitted to the board, a decision issued by the examining or opposition division may be signed only by the 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

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 does not address any comments of substance to the board. Internal notes made by division members about the merits of the appeal are kept in the non-public part of the dossier and are not sent to the board of appeal.

*Art. 109(2)*

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 parties concerned had no opportunity of presenting their 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 checks whether the decision was correct in substance. Interlocutory revision

is only allowed 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-XII, 7.3). If interlocutory revision is made and new objections arise, the division communicates 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 is 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 takes 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, see T 2445/11).

If amendments made to the independent claims clearly do not meet the requirements of Art. 123(2), interlocutory revision is not granted, but the division sends 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 checks 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 is allowed, 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 the main request examined by the boards of appeal.

**7.4.4 Response to communication pursuant to Rule 58 filed with the appeal**

If, in response to the Receiving Section's refusal of the application pursuant to Art. 90(5), the related deficiencies are fully rectified so as to overcome the grounds for refusal, interlocutory revision is granted by the Receiving Section.

*Example:*

On the date of filing, the drawings did not comply with the requirements set by the President under Rule 49(2). The application was subsequently refused (Art. 90(5)) since the applicant filed the same poor-quality drawings in reply to the communication under Rule 58. When filing an appeal complying with the requirements of Art. 108, the applicant also files drawings of sufficient quality, thereby correcting the deficiency on which the refusal was based. Since the underlying ground for the refusal has been overcome and the reasoning in the decision under appeal no longer applies, the Receiving Section grants interlocutory revision and does not refer the case to the boards of appeal.

**8. Rules of Procedure of the Boards of Appeal**

Details of the procedure before the boards of appeal, including on the acceleration of appeal proceedings, can be found in the **Rules of Procedure of the Boards of Appeal** (see OJ EPO 2019, A63, as amended by OJ EPO 2021, A19). The Enlarged Board of Appeal has also adopted **Rules of Procedure** (see OJ EPO 2015, A35).

**9. Remittal to the examining or opposition division after appeal**

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.

In situation (a) above, grant or maintenance is handled by the formalities officer. ~~and the dossier goes back to the~~ The division ~~merely for checking~~



provides input by verifying the classification and title and adding any references to supplementary technical information (STIN) or newly cited documents (CDOC). The examining division also carries out a top-up search for national prior rights and provides information about whether any are found to be *prima facie* relevant, if this has not already been done in the proceedings. This information may assist the applicant in deciding whether to request Unitary Patent protection or choose the traditional validation route (C-IV, 7.2).

If the applicant requests further amendments under Rule 71(6), the application will be deemed withdrawn under Rule 71(7) as the procedure under Rule 71(6) cannot be applied in view of Art. 111(2).

Where the case is remitted with the order to grant, or maintain, the patent on the basis of documents with handwritten amendments, the formalities officer on behalf of the competent division invites the applicant, or proprietor, to file a formally compliant version of the amended text under Art. 94(3) or Rule 82(2), as the case may be (see E-III, 8.7.2 and E-III, 8.7.3 respectively).

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 will 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:

- the parties must be given the opportunity to submit further requests, and
- 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 XIII – 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, checks whether a European patent is the "subject of the action".

The examining division responsible for the technical opinion gives 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 in so far as the questions put are of a technical character. However, the examining division may not be too restrictive in this regard but will 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 attempts 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 will decline to make any specific statement on whether a patent is valid or on whether it is infringed. It also does 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 will be excluded from the examining division set up under Art. 25. Where this is not practicable, the national court and the parties are 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 will 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 also drafts the written opinion and circulates 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 chair arranges a meeting to resolve the matter. The final opinion is signed by all members of the division.

### **4. Language to be used**

In principle the language to be used is 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 must be in that language or translated into that language. The opinion is also produced in that language. However, where appropriate, the examining division will 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(1),  
item 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-XIII, 3.1), 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-XIII, 5.1 or E-XIII, 5.2, above have been met, the examining division establishes the technical opinion as soon as possible.

The opinion is sent to the national court. Any papers received from the court which belong to the national proceedings are 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 is informed that the EPO is willing to send one member of the division provided that 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 XIV – 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 (see the 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 (see the 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 respect of a pending European patent application (see A-IV, 1.1.1 and J 10/93) 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 (see *epo.org*).

*Art. 72*

*Rule 22(1) and (2)*

Where the request relates to multiple applications, a separate fee has to be paid for each application.

With effect from ~~As of~~ the entry into force of amended Rule -22(1) EPC on 01 April.04. 2024, the conditions under which payment of an administrative fee is due is laid down by the President of the EPO.

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). Art. 72 requires that, for an assignment, the signatures of the parties appear on the documents submitted as evidence of the transfer. Assignment documents filed electronically (see ~~A-II, 1.2.2 A-II, -1.1.1~~) may, instead of handwritten signatures, bear qualified electronic signatures (see notice from the EPO dated 22 October 2021; OJ EPO 2021, A86).

With effect from the ~~As of~~ entry into force of ~~-~~amended Rule ~~-~~22(1)~~-EPC~~ on 01 April ~~.04.2024~~, electronic signatures as determined by the President of the EPO are accepted on assignment documents.

Where a document is signed on behalf of a legal person, only such persons as are entitled to sign by law, by the legal person's articles of association or equivalent or by a special mandate may do so. National law applies in that respect. In all cases, an indication of the signatory's entitlement to sign, e.g. his/her position within the legal entity where the entitlement to sign results directly from such a position, is to be given. The contracting parties have to ensure that the signatories are duly authorised in accordance with the national law applicable to sign such a document. The EPO, however, reserves the right to request documentary proof of the signatory's authority to sign if the circumstances of a particular case necessitate this. In such cases, if the evidence presented is found to be unsatisfactory, the EPO informs the party requesting the transfer accordingly and invites them to remedy the stated deficiency within a given time limit. ~~Where the entitlement results from a special authorisation, this authorisation (a copy thereof, which need not be certified) has to be submitted in every case. The EPO will in particular examine whether the signatory is empowered to enter into a legally binding contract on behalf of the legal entity.~~

As a general rule, the authorisation to represent a party in proceedings before the EPO within the meaning of Rule 152, be it an individual or a general authorisation, is not as such considered to empower the representative to enter into such a contract.

~~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 the legitimate applicant/proprietor is.

#### 4. Transfer of the European patent

Rule 22 applies *mutatis mutandis* to the registration of a transfer of the European patent during the opposition period or during opposition proceedings.

Rule 85

#### 5. Changes of name

Mere changes of name, i.e. changes that do not involve a modification of the legal identity of the applicant, can be entered in the European Patent Register upon request and production of relevant documentary evidence as long as the application (cf. A-IV, 1.1.1) or the proceedings before the EPO are pending. Such registration is free of charge.

#### 6. Licences and other rights

##### 6.1 Registration

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.

Art. 71

Art. 73

Rule 23(1)

Rule 24(a) and  
(b)

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-XIV, 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 the registration

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. Cancellation is only possible until publication of the mention of the grant.

Rule 22(2)

Rule 23(2)