

PART A

GUIDELINES FOR FORMALITIES EXAMINATION

PART A

CONTENTS

page

CHAPTER I INTRODUCTION I-1

- | | | |
|----|--|-----|
| 1. | Overview | I-1 |
| 2. | Responsibility for formalities examination | I-1 |
| 3. | Purpose of Part A | I-1 |
| 4. | Other Parts relating to formalities | I-1 |

CHAPTER II FILING OF APPLICATIONS AND EXAMINATION ON FILING II-1

- | | | |
|-------|---|------|
| 1. | Where and how applications may be filed | II-1 |
| 1.1 | Filing of applications directly or by post | II-1 |
| 1.2 | Filing of applications by facsimile | II-1 |
| 1.3 | Filing of applications in electronic form | II-1 |
| 1.4 | Filing of applications by other means | II-2 |
| 1.5 | Subsequent filing of documents | II-2 |
| 1.6 | Cheques and debit orders | II-2 |
| 1.7 | Forwarding of applications | II-2 |
| 1a. | Application numbering systems | II-3 |
| 1a.1 | Applications filed before 1 January 2002 | II-3 |
| 1a.2 | Applications filed on or after 1 January 2002 | II-3 |
| 2. | Persons entitled to file an application | II-4 |
| 3. | Procedure on filing | II-4 |
| 3.1 | Receipt; confirmation | II-4 |
| 3.2 | Filing with a competent national authority | II-5 |
| 4. | Examination on filing | II-5 |
| 4.1 | Minimum requirements for according a date of filing | II-5 |
| 4.1.1 | Indication that a European patent is sought | II-5 |
| 4.1.2 | Identification of the applicant | II-6 |
| 4.1.3 | Description and claims | II-6 |
| 4.1.4 | Deficiencies | II-6 |
| 4.1.5 | Date of filing | II-6 |
| 4.2 | Further requirements | II-6 |
| 4.2.1 | Filing and search fees | II-6 |
| 4.2.2 | Translation | II-7 |
| 4.2.3 | Application deemed to be withdrawn | II-7 |
| 4.3 | Formal examination | II-7 |

CHAPTER III EXAMINATION OF FORMAL REQUIREMENTS III-1

- | | | |
|-----|--|-------|
| 1. | General | III-1 |
| 1.1 | Formal requirements | III-1 |
| 1.2 | Further checks | III-1 |
| 2. | Representation | III-1 |
| 2.1 | Requirements | III-1 |
| 2.2 | Non-compliance | III-2 |
| 3. | Physical requirements | III-2 |
| 3.1 | General remarks | III-2 |
| 3.2 | Documents making up the application, replacement documents, translations | III-2 |
| 3.3 | Other documents | III-2 |
| 3.4 | Signature | III-3 |

4.	Request for grant	III-3
4.1	General remarks	III-3
4.2	Examination of the Request for Grant form	III-3
4.2.1	Information on the applicant	III-3
4.2.2	Signature	III-3
5.	Designation of inventor	III-4
5.1	General remarks	III-4
5.2	Waiver of right to be mentioned as inventor	III-4
5.3	Designation filed in a separate document	III-4
5.4	Notification	III-4
5.5	Deficiencies	III-5
5.6	Incorrect designation	III-5
6.	Claim to priority (see also C-V)	III-6
6.1	General remarks	III-6
6.2	List of Contracting States to the Paris Convention	III-6
6.3	Multiple priorities	III-7
6.4	Examination of the priority document	III-7
6.5	Declaration of priority	III-7
6.6	Priority period	III-7
6.7	Copy of the previous application (priority document)	III-8
6.8	Translation of the previous application	III-9
6.9	Non-entitlement to right to priority	III-9
6.10	Loss of right to priority	III-9
6.11	Notification	III-10
7.	Title of the invention	III-10
7.1	Requirements	III-10
7.2	Responsibility	III-10
8.	Prohibited matter	III-10
8.1	Morality or "ordre public"	III-10
8.2	Disparaging statements	III-11
9.	Claims fee	III-11
10.	Filing of drawings	III-12
11.	Abstract	III-12
11.1	General remark	III-12
11.2	Content of the abstract	III-12
11.3	Figure accompanying the abstract	III-12
12.	Designation of Contracting States	III-12
12.1	General remarks	III-12
12.2	Designation fee; time limits	III-13
12.3	Consequences of non-payment of designation fees; period of grace	III-13
12.4	Surcharge paid insufficient	III-13
12.5	Application deemed to be withdrawn	III-13
12.6	Request for Grant form	III-14
12.7	Indication of the Contracting States	III-14
12.8	Amount payable	III-14
12.9	Withdrawal of designation	III-15
12.10	Euro-PCT applications entering the European phase	III-15
13.	Extension of European patent applications and patents to States not party to the EPC	III-15
13.1	General remarks	III-15
13.2	Time limit for payment of extension fee	III-16
13.3	Withdrawal of extension	III-17
13.4	Extension deemed requested	III-17
13.5	National register	III-17
14.	Correction of deficiencies	III-17
14.1	Procedure formalities officer	III-17
14.2	Period allowed for remedying deficiencies	III-17

**CHAPTER III – Annex LIST OF CONTRACTING STATES TO THE PARIS CONVENTION
(see III, 6.2)****III-19****CHAPTER IV SPECIAL PROVISIONS****IV-1**

1.	European divisional applications (see also C-VI, 9.1)	IV-1
1.1	General remarks	IV-1
1.1.1	When may a divisional application be filed?	IV-1
1.1.2	Persons entitled to file a divisional application	IV-1
1.2	Date of filing of a divisional application; claiming priority	IV-2
1.2.1	Date of filing	IV-2
1.2.2	Claiming priority	IV-2
1.3	Filing a divisional application	IV-2
1.3.1	Where to file a divisional application?	IV-2
1.3.2	Request for grant	IV-3
1.3.3	Language requirements	IV-3
1.3.4	Designation of Contracting States	IV-3
1.3.5	Extension States	IV-3
1.4	Fees	IV-3
1.4.1	Filing, search and designation fees	IV-3
1.4.2	Claims fees	IV-4
1.4.3	Renewal fees	IV-4
1.5	Designation of the inventor	IV-4
1.6	Authorisations	IV-5
1.7	Other formalities examination	IV-5
1.8	Further procedure	IV-5
2.	Art. 61 applications	IV-5
2.1	General	IV-5
2.2	Suspension of the proceedings for grant	IV-5
2.3	Resumption of the proceedings for grant	IV-6
2.4	Interruption of time limits	IV-6
2.5	Limitation of the option to withdraw the European patent application	IV-7
2.6	Prosecution of the application by a third party	IV-7
2.7	Filing a new application	IV-7
2.8	Refusal of the earlier application	IV-8
2.9	Partial transfer of right by virtue of a final decision	IV-8
3.	Display at an exhibition	IV-8
3.1	Certificate of exhibition; identification of invention	IV-8
3.2	Defects in the certificate or the identification	IV-8
4.	Applications relating to biological material	IV-8
4.1	Biological material; deposit thereof	IV-8
4.2	Missing information; notification	IV-9
4.3	Availability of deposited biological material to expert only	IV-9
5.	Applications relating to nucleotide and amino acid sequences	IV-10
6.	Conversion into a national application	IV-10

**CHAPTER V COMMUNICATING THE FORMALITIES REPORT; AMENDMENT OF
APPLICATION; CORRECTION OF ERRORS****V-1**

1.	Communicating the formalities report	V-1
2.	Amendment of application	V-1
2.1	Filing of amendments	V-1
2.2	Examination of amendments as to formalities	V-1
3.	Correction of errors in documents filed with the EPO	V-2

CHAPTER VI PUBLICATION OF APPLICATION; REQUEST FOR EXAMINATION AND TRANSMISSION OF THE DOSSIER TO EXAMINING DIVISION VI-1

- | | | |
|-----|---|------|
| 1. | Publication of application | VI-1 |
| 1.1 | Date of publication | VI-1 |
| 1.2 | No publication; preventing publication | VI-1 |
| 1.3 | Content of the publication | VI-2 |
| 1.4 | Publication in electronic form only | VI-2 |
| 1.5 | Separate publication of the European search report | VI-3 |
| 2. | Request for examination and transmission of the dossier to the Examining Division | VI-3 |
| 2.1 | Communication | VI-3 |
| 2.2 | Time limit for filing the request for examination | VI-3 |
| 2.3 | Period of grace | VI-4 |
| 2.4 | Transmission of the dossier to the Examining Division | VI-4 |
| 2.5 | Refund of examination fee | VI-5 |
| 2.6 | Reduction in examination fee | VI-5 |

CHAPTER VII APPLICATIONS UNDER THE PATENT COOPERATION TREATY (PCT) BEFORE THE EPO ACTING AS A DESIGNATED OR ELECTED OFFICE VII-1

- | | | |
|------|--|-------|
| 1. | General | VII-1 |
| 1.1 | Introduction | VII-1 |
| 1.2 | Initial processing and formal examination; copy of the international application; translation | VII-1 |
| 1.3 | National basic fee, designation fee, request for examination, search fee and claims fees | VII-2 |
| 1.4 | PCT vs. EPC provisions | VII-2 |
| 2. | Provisions of Chapter II ("Filing of applications and examination on filing") | VII-3 |
| 3. | Provisions of Chapter III ("Examination of formal requirements") | VII-3 |
| 3.1 | Representation | VII-3 |
| 3.2 | Physical requirements | VII-4 |
| 3.3 | Request for grant | VII-4 |
| 3.4 | Designation of inventor | VII-4 |
| 3.5 | Claim to priority | VII-4 |
| 3.6 | Title of the invention | VII-5 |
| 3.7 | Prohibited matter | VII-5 |
| 3.8 | Claims fee | VII-5 |
| 3.9 | Drawings | VII-5 |
| 3.10 | Abstract | VII-5 |
| 3.11 | Designation fee | VII-5 |
| 4. | Provisions of Chapter IV ("Special provisions") | VII-6 |
| 4.1 | Divisional applications | VII-6 |
| 4.2 | Sequence listings | VII-6 |
| 5. | Provisions of Chapter VI ("Publication of application; request for examination and transmission of the dossier to Examining Division") | VII-6 |
| 5.1 | Publication of the international application | VII-6 |
| 5.2 | Request for examination | VII-6 |
| 5.3 | Supplementary European search | VII-6 |
| 6. | Reduction and refunds of fees in respect of international (PCT) applications | VII-7 |

CHAPTER VIII LANGUAGES VIII-1

- | | | |
|-----|--|--------|
| 1. | Provisions concerning the language of the proceedings | VIII-1 |
| 1.1 | Admissible languages; time limit for filing the translation of the application | VIII-1 |
| 1.2 | Language of the proceedings | VIII-1 |
| 1.3 | European divisional applications; Art. 61 applications | VIII-1 |
| 2. | Derogations from the language of the proceedings in written proceedings | VIII-1 |
| 2a. | Documents to be used as evidence | VIII-2 |

3.	Documents filed in the wrong language	VIII-2
3.1	Documents making up a European patent application	VIII-2
3.2	Other documents	VIII-2
4.	Translation of the priority document	VIII-3
5.	Authentic text	VIII-3
5.1	General remark	VIII-3
5.2	Conformity of translation with the original text	VIII-3
6.	Certificate of translation	VIII-3
7.	Derogations from the language of the proceedings in oral proceedings	VIII-4

CHAPTER IX COMMON PROVISIONS

IX-1

1.	Representation	IX-1
1.1	Representation by a professional representative	IX-1
1.2	Representation by an employee	IX-1
1.3	Common representative	IX-1
1.4	List of professional representatives; legal practitioners	IX-2
1.5	Signed authorisation	IX-2
1.6	General authorisation	IX-2
1.7	Invitation to file authorisation	IX-3
2.	Form of documents	IX-3
2.1	Documents making up the European patent application	IX-3
2.2	Replacement documents and translations	IX-3
2.3	Other documents	IX-3
2.4	Number of copies	IX-3
2.5	Filing of subsequent documents	IX-4
3.	Signature of documents	IX-4
3.1	Documents filed after filing the European patent application	IX-4
3.2	Documents forming part of the European patent application	IX-5
3.3	Form of signature	IX-5
3.4	Joint applicants	IX-5

CHAPTER X DRAWINGS

X-1

1.	Graphic forms of presentation considered as drawings	X-1
1.1	Technical drawings	X-1
1.2	Photographs	X-1
2.	Representation of drawings	X-1
2.1	Grouping of drawings	X-1
2.2	Reproducibility of drawings	X-1
2.3	Figure accompanying the abstract	X-1
3.	Conditions regarding the paper used	X-2
4.	Presentation of the sheets of drawings	X-2
4.1	Usable surface area of sheets	X-2
4.2	Numbering of sheets of drawings	X-2
5.	General layout of drawings	X-3
5.1	Page-setting	X-3
5.2	Numbering of figures	X-3
5.3	Whole figure	X-3
6.	Prohibited matter	X-4
7.	Executing of drawings	X-4
7.1	Drawings of lines and strokes	X-4
7.2	Shading	X-4
7.3	Cross-sections	X-4
7.3.1	Sectional diagrams	X-4
7.3.2	Hatching	X-5
7.4	Scale of drawings	X-5
7.5	Numbers, letters and reference signs	X-5

7.5.1	Leading lines	X-5
7.5.2	Arrows	X-5
7.5.3	Height of the numbers and letters in the drawings	X-6
7.5.4	Consistent use of reference signs as between description, claims and drawings	X-6
7.5.5	Consistent use of reference signs as between drawings	X-6
7.6	Variations in proportions	X-7
8.	Text matter on drawings	X-7
9.	Conventional symbols	X-7
10.	Amendments to drawings	X-7
11.	Graphic forms of presentation not considered as drawings	X-8
11.1	Chemical and mathematical formulae	X-8
11.2	Tables	X-8
11.2.1	Tables in the description	X-8
11.2.2	Tables in the claims	X-9

CHAPTER XI FEES **XI-1**

1.	General	XI-1
2.	Methods of payment	XI-1
2a.	Currencies	XI-2
3.	Date considered as date on which payment is made	XI-2
3.1	Payment or transfer to a bank or giro account held by the European Patent Organisation	XI-2
3.2	Delivery or remittance of a cheque made payable to the EPO	XI-2
3.3	Deposit accounts with the EPO	XI-2
3.3.1	General remarks	XI-2
3.3.2	Inpayments to replenish a deposit account	XI-2
3.3.3	Debiting the deposit account	XI-2
3.3.4	Date of receipt of the debit order; insufficient funds	XI-3
3.4	Automatic debiting procedure	XI-3
4.	Due date for fees	XI-3
4.1	General	XI-3
4.1.1	Due date	XI-3
4.1.2	Amount of the fee	XI-4
4.2	Due date for specific fees	XI-4
4.2.1	Filing fee, search fee, designation fee, claims fees	XI-4
4.2.2	Examination fee	XI-4
4.2.3	Fees for grant and printing	XI-4
4.2.4	Renewal fees	XI-4
5.	(deleted)	XI-5
6.	Payment in due time	XI-5
6.1	Basic principle	XI-5
6.2	Ten-day fail-safe arrangement	XI-5
6.2.1	Requirements	XI-5
6.2.2	Application of the ten-day fail-safe arrangement to replenishment of deposit account	XI-5
6.2.3	Debit orders	XI-6
6.2.4	Payment of fee at the normal fee rate	XI-6
6.2.5	Amount of fee payable	XI-6
6.2.6	Noting of loss of rights	XI-6
7.	Purpose of payment	XI-6
7.1	General	XI-6
7.1.1	Condition for valid payment	XI-6
7.1.2	Purpose of payment	XI-7
7.2	Indication of the purpose of the payment in the case of designation fees	XI-7
7.3	Indication of the purpose of payment in the case of claims fees	XI-8
7.3.1	Claims fees payable on filing the European patent application	XI-8
7.3.2	Claims fees payable before the grant of the European patent	XI-8
8.	No deferred payment of fees, no legal aid, no discretion	XI-8

9.	Reduction of fees	XI-8
9.1	General	XI-8
9.2	Reduction under the language arrangements	XI-8
9.2.1	Conditions	XI-8
9.2.2	Reduction of the filing fee	XI-9
9.2.3	Reduction of the examination fee	XI-9
9.2.4	Reduction of the opposition fee	XI-9
9.2.5	Reduction of the appeal fee	XI-9
9.3	Special reductions	XI-9
9.3.1	Reduction of the search fee for a supplementary European search	XI-9
9.3.2	Reduction of the examination fee where the international preliminary examination report is being drawn up by the EPO	XI-10
9.3.3	Reduction of the fees for the international search and international preliminary examination of an international application	XI-10
10.	Refund of fees	XI-10
10.1	General remarks	XI-10
10.1.1	Fee payments lacking a legal basis	XI-10
10.1.2	Fee payments which are not valid	XI-11
10.1.3	Insignificant amounts	XI-11
10.2	Special refunds	XI-11
10.2.1	Refund of the search fee	XI-11
10.2.2	Refund of the further search fee	XI-11
10.2.3	Refund of the international search fee	XI-11
10.2.4	Refund of the examination fee	XI-11
10.2.5	Refund of the international preliminary examination fee	XI-12
10.2.6	Refund pursuant to Art. 77(5)	XI-12
10.2.7	Refund of claims fees and of the fees for grant and printing	XI-12
10.3	Method of refund	XI-12
10.4	Person to whom refund is payable	XI-12
10.5	Re-allocation instead of refund	XI-13

**CHAPTER XII INSPECTION OF FILES; COMMUNICATION OF INFORMATION CONTAINED
IN FILES; CONSULTATION OF THE REGISTER OF EUROPEAN PATENTS;
ISSUANCE OF CERTIFIED COPIES XII-1**

1.	General	XII-1
2.	Inspection of files	XII-1
2.1	Extent of file inspection	XII-1
2.2	Procedure for file inspection	XII-2
2.3	Restrictions to file inspection	XII-2
2.4	Confidentiality of the request	XII-2
2.5	File inspection before publication of the application	XII-2
2.6	Publication of bibliographic data before publication of the application	XII-3
3.	Communication of information from the files	XII-3
4.	Consultation of the Register of European Patents	XII-4
5.	Certified copies	XII-4
6.	Priority documents issued by the EPO	XII-4

CHAPTER I**INTRODUCTION****1. Overview**

This Part A of the Guidelines deals with the following:

- (i) the requirements and procedure relevant to the examination as to formalities of European patent applications (Chapters II to VI);
- (ii) the modification to the requirements and procedure of (i) when dealing with international applications filed under the PCT and entering the European phase (Chapter VII);
- (iii) formalities matters of a more general nature which can arise during the application procedure or the post-grant stage (Chapters VIII and IX),
- (iv) the presentation and execution of drawings and figurative representations accompanying a European patent application (Chapter X);
- (v) fee questions (Chapter XI);
- (vi) inspection of files, communication of information contained in files, consultation of the Register of European Patents and issuance of certified copies (Chapter XII).

2. Responsibility for formalities examination

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

3. Purpose of Part A

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

4. Other Parts relating to formalities

It is not the intention that the formalities staff should concern themselves with only this Part A of the Guidelines. It is expected that they will have to refer frequently to the other Parts and in particular Part E.

CHAPTER II**FILING OF APPLICATIONS AND EXAMINATION ON FILING****1. Where and how applications may be filed****1.1 Filing of applications directly or by post**

European patent applications may be filed in writing, directly or by post, at the EPO's filing offices in Munich, The Hague or Berlin. The EPO's sub-office in Vienna is not a filing office.

Art. 75(1)
Rule 24(1)

The opening hours of the filing offices of the EPO were published in OJ 12/1994, 954. Dates on which at least one of the filing offices of the EPO is not open to receive documents are likewise announced at regular intervals in the Official Journal of the EPO (see also E-VIII, 1.4).

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

European patent applications may also be filed (with the exception of divisional applications, see IV, 1.3.1) at the central industrial property office or other competent authority of a Contracting State if the national law of that State so allows (see II, 1.6).

1.2 Filing of applications by facsimile

Applications may also be filed by **facsimile** with the filing offices of the EPO or with the competent national authorities of those Contracting States which so permit, namely – at present – Austria (AT), Belgium (BE), Bulgaria (BG), Czech Republic (CZ), Denmark (DK), Finland (FI), France (FR), Germany (DE), Greece (GR), Iceland (IS), Ireland (IE), Liechtenstein (LI), Luxembourg (LU), Monaco (MC), Poland (PL), Portugal (PT), Slovakia (SK), Slovenia (SI), Spain (ES), Sweden (SE), Switzerland (CH) and United Kingdom (UK). For further details, see the brochure "National Law relating to the EPC", March 2003.

Where a document transmitted using such technical means is illegible or incomplete, the document is to be treated as not having been received to the extent that it is illegible or that the attempted transmission failed and the sender must be notified as soon as possible (see the Decision of the President of the EPO dated 6 December 2004, OJ 1/2005, 41, and the Notice from the EPO dated 6 December 2004, OJ 1/2005, 44). If a European patent application is filed by facsimile, a written confirmation is required only where the documents are of inferior quality. In this case, the EPO will invite the applicant to supply such documents within a non-extendable period of one month. If the applicant fails to comply with this invitation in due time, the European patent application will be refused. To prevent duplication of files, applicants are asked to indicate on the paper version of the application documents the application number or facsimile date and the name of the authority with which the documents were filed and to make it clear that these documents represent "confirmation of an application filed by facsimile".

Art. 91(3)

1.3 Filing of applications in electronic form

European patent applications and international (PCT) applications may be filed with the EPO in electronic form either **online** or on **electronic data**

carriers (see the Decision of the President dated 29 October 2002, OJ 11/2002, 543). At present, the sole data carrier permitted is CD-R as per IS 9660 (see the Notice from the EPO dated 29 October 2002 concerning the electronic filing of patent applications and other documents, OJ 11/2002, 545). Documents making up a European or an international patent application in electronic form must be prepared using either the epoline® Online Filing software or the PaTrAS software both of which includes the Request for Grant Form, unless the use of other software is permitted (see Art. 3 of the abovementioned Decision of the President, the above-mentioned Notice dated 29 October 2002, point 5.1, OJ 11/2002, 543 and 545 and the Notice from the EPO dated 19 March 2004, OJ 5/2004, 270), unless the use of other software is permitted.

Other documents may also be filed electronically in the grant proceedings (see the Notice from the EPO dated 3 December 2003, OJ 12/2003, 609). For the special case of the electronic filing of priority documents issued by the USPTO on or after 30 July 2004, see III, 6.7. No confirmation on paper is required for documents thus filed in electronic form (see Art. 5 of the above-mentioned Decision of the President).

European patent applications may also be filed in electronic form with the competent national authorities of those Contracting States which so permit, namely – at present – Finland (FI), France (FR), Germany, using the PaTrAS software (see the above-mentioned Notice dated 19 March 2004), Spain (ES) and the United Kingdom (UK).

1.4 Filing of applications by other means

As of 1.1.2003 European patent applications may no longer be filed with the EPO on **diskette** accompanied by a paper version prepared by means of the **EP-EASY** software (see the Notice from the EPO dated 1 October 2002, OJ 10/2002, 515). This applies also to the filing of European patent applications with the filing offices of Belgium (BE), Finland (FI), France (FR), Sweden (SE), Switzerland (CH) and the United Kingdom (UK).

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

1.5 Subsequent filing of documents

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

1.6 Cheques and debit orders

Point 6.9 ADA
Point 6.10 ADA
Point 6.2 ADA

Cheques may accompany only those European patent applications which are filed with the EPO. The national authorities competent to receive European patent applications do not accept cash or cheques but do accept debit orders for deposit accounts. To avoid the risk of payment being debited twice where a debit order is sent by facsimile, the original should not be filed subsequently (see points 6.2, 6.9 and 6.10 of the Arrangements for deposit accounts, Supplement No. 2 to OJ 1/2005, 3).

1.7 Forwarding of applications

Art. 77

The central industrial property office of a Contracting State is obliged to forward to the EPO, in the shortest time compatible with national law concerning the secrecy of inventions, applications filed (see II, 3.2) with

that office or with other competent authorities in that State (for cheque and debit order enclosures, see II, 1.5).

A time limit of six weeks after filing is specified for the onward transmission to the EPO of applications the subject-matter of which is obviously not liable to secrecy, this time limit being extended to four months or, where priority has been claimed, to fourteen months after the date of priority, for applications which require further examination as to their liability to secrecy. It should be noted, however, that an application received outside the specified time limits, either six weeks or four months, must be processed provided the application is received in Munich, The Hague or Berlin before the end of the fourteenth month after filing or, where appropriate, after the date of priority. Applications received outside this last mentioned time limit are deemed to be withdrawn. Re-establishment of rights in respect of the period under Art. 77(5) is not possible (see J 3/80, OJ 4/1980, 92), but a request for conversion under Art. 135(1)(a) may be filed (see IV, 6).

Art. 77(5)
Art. 135(1)(a)

If the time limit referred to in Art. 77(5) expires on a day on which there is an interruption or subsequent dislocation in the delivery of mail within the meaning of Rule 85(2), the time limit will extend to the first day following the end of the period of interruption or dislocation.

Rule 85(2)

1a. Application numbering systems

1a.1 Applications filed before 1 January 2002

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

The application number consists of nine digits. The first two digits (from left to right) of the application number indicate the filing year. The last (ninth) digit is a check digit. The third digit or third and fourth digits of the application number indicate(s) the place of filing.

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

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

1a.2 Applications filed on or after 1 January 2002

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

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

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

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

2. Persons entitled to file an application

- Art. 58 A European patent application may be filed by any natural or legal person, or any body equivalent to a legal person by virtue of the law governing it.
- Art. 60(3) For the purposes of proceedings before the EPO, the applicant shall be deemed to be entitled to exercise the right to the European patent.
- Art. 59
Art. 118 The application may be in the name of one person or several persons may be named as joint applicants. The application may also be filed by two or more applicants designating different Contracting States. It may arise that a first applicant designates one group of Contracting States and a second designates a different group of Contracting States, while both applicants jointly designate a third group of Contracting States. If the applicants for a patent are not the same for different Contracting States they will be regarded as joint applicants in proceedings before the EPO (see III, 4.2.1 and 12.1 as to when and under what circumstances the matter dealt with in this paragraph need be considered during the formalities examination).
- Art. 61(1) If it is adjudged that a person other than the applicant is entitled to the grant of a European patent that person has the option of prosecuting the application as his own application in place of the applicant (see IV, 2).

3. Procedure on filing

3.1 Receipt; confirmation

- Rule 24(2) The authority with which the application is filed – either the EPO (Munich, The Hague or Berlin) or the competent national authority – must mark the documents making up the application with the date of receipt and issue a receipt to the applicant (for the date of receipt of applications received by facsimile see the Notice from the EPO, dated 6 December 2004, OJ 1/2005, 44, point 5.1). The date of receipt should be so applied as not to obliterate any part of the documents or make them unsuitable for direct reproduction. The receipt must be issued without delay and include at least the application number, the nature and number of the documents and the date of their receipt. The receipt should also include the applicant's or representative's file reference number or any other information which would be helpful in identifying the applicant. The receipt of European patent applications filed online will be acknowledged electronically during the submission session. Where it becomes apparent that such acknowledgment was not successfully transmitted, the authority with which the application is filed will promptly transmit the acknowledgment by other means where the necessary indications furnished to it so permit (see the Notice dated 29 October 2002, point 8, OJ 11/2002, 545). On request, the EPO also provides confirmation by facsimile of the receipt of documents filed with it (see Notice from the EPO dated 6 December 2004, OJ 1/2005, 44, point 6.3). To ensure despatch of the receipt immediately after the documents are received:

- the request for the issue of a receipt by facsimile must be transmitted at the same time as the documents filed;
- the postal or fax address to which the receipt is to be sent must be stated; and

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

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

3.2 Filing with a competent national authority

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

Rule 24(3)

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

Rule 24(4)

Where an application is not received at the EPO from the central industrial property office of a Contracting State before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority and is consequently deemed to be withdrawn (see II. 1.6), the applicant must be notified accordingly; all fees must be refunded.

Art. 77(5)
Rule 69(1)
Rule 31(2)

4. Examination on filing

4.1 Minimum requirements for according a date of filing

The Receiving Section examines applications to determine whether they meet the minimum requirements for according a date of filing. These requirements are satisfied where the documents filed contain:

Art. 90(1)(a)

- (i) an indication that a European patent is sought;
- (ii) the designation of at least one Contracting State;
- (iii) information identifying the applicant; and
- (iv) a description and one or more claims in either English, French or German, or in a language which is an official language of a Contracting State as provided for in Art. 14(2) (see VIII, 3.1).

Art. 80(a)

Art. 80(b)

Art. 80(c)

Art. 80(d)

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

4.1.1 Indication that a European patent is sought

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

4.1.2 Identification of the applicant

The applicant is sufficiently identified whenever it is possible to establish the identity of the applicant beyond reasonable doubt on the basis of all data contained in the documents filed (cf. J 25/86, OJ 11/1987, 475). Where there is more than one applicant, each applicant must be similarly identified. Objection should not be raised at this stage with regard to the status of the applicant or his entitlement to apply, or where, in the case of joint applicants, there is doubt as to the Contracting States designated by the individual applicants.

4.1.3 Description and claims

The contents of the description and claims do not require close scrutiny – it is sufficient to identify a document (or documents) which appears to include a description and one or more claims. The requirements under Art. 80 for according a filing date are not fulfilled if the description and the claims are filed in two different official languages (see J 18/96, OJ 8/1998, 403).

4.1.4 Deficiencies

Art. 90(2)
Rule 39

If the Receiving Section notes deficiencies preventing the application being accorded a date of filing, it communicates them to the applicant and invites him to remedy them within a non-extendable period of one month of notification of the communication. If the applicant does not remedy the deficiencies in due time he is informed that the application will not be dealt with as a European application. Any fees which have been paid are refunded.

4.1.5 Date of filing

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

- (i) the date of receipt at the EPO or competent national authority; or
- (ii) the date, not later than the one-month period referred to in II, 4.1.4, on which the applicant rectifies any deficiencies. In the latter case, the applicant is informed of the date of filing accorded to his application.

It should be noted that where drawings are filed later than the date of filing, re-dating of the application may be required (see III, 10).

4.2 Further requirements

Art. 90(1)(b), (c)

An application that has been accorded a date of filing is checked by the Receiving Section to ascertain if:

- (i) the filing fee and the search fee have been paid in due time; and
- (ii) in the case provided for in Art. 14(2), the translation of the European patent application in the language of the proceedings has been filed in due time.

4.2.1 Filing and search fees

Art. 78(2)

The filing and search fees must be paid to the EPO within one month after the filing of the application (normal period). Where the application does not at first satisfy the requirements for the accordance of a date of filing,

"the filing of the application" means the date of filing as referred to in II, 4.1.5(ii).

If the fees have not been paid within the normal period, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within this period a surcharge is also paid. As indicated in XI 9.2.2, the filing fee is reduced when the language of the application is not an official language of the EPO. However, the communication pursuant to Rule 85a(1) should not be issued until the Receiving Section has satisfied itself that the application has been accorded a date of filing in accordance with Art. 80 (see J 18/96, OJ 8/1998, 403).

Rule 85a(1)
Art. 2, No. 3b, RFees
Rule 6(3)

4.2.2 Translation

The translation in English, French or German must be filed within three months after the filing of the application (see II, 4.2.1 as to what is understood by "filing of the application"), but no later than thirteen months after the earliest date of priority claimed (see VIII, 1.1).

Rule 6(1)

4.2.3 Application deemed to be withdrawn

An application that does not meet the requirements of II, 4.2 is deemed to be withdrawn. If the application is deemed withdrawn because of non-payment of the filing fee and search fee, loss of rights ensues on expiry of the normal period (see J 4/86, OJ 4/1988, 119, which applies *mutatis mutandis*, confirmed by G 4/98, OJ 3/2001, 131, reasons 7.2). The applicant is notified accordingly.

Art. 90(3)
Rule 69(1)

Art. 122(5) excludes re-establishment of rights in respect of the time limits under Art. 78(2) and Rule 85a (cf. II, 4.2.1) (see J 12/82, OJ 6/1983, 221). However, in the event of failure to observe the time limit under Rule 6(1), an application for re-establishment of rights is admissible (cf. II, 4.2.2).

Art. 122(5)
Art. 122

4.3 Formal examination

Once the "Examination on filing" under Article 90 has been completed and it has been established that the application is not deemed to be withdrawn pursuant to Article 90(3) in accordance with the previous paragraph, it is subject to a formal examination by the Receiving Section. At the same time a copy of the application (the "search sub-dossier") is referred to the Search Division to draw up the European search report and if applicable the search opinion (see B-I, 4.).

Art. 90
Art. 91(1)
Art. 92(1)

CHAPTER III**EXAMINATION OF FORMAL REQUIREMENTS****1. General****1.1 Formal requirements**

The formal requirements that an application has to meet and which are the subject of an examination by the Receiving Section are those specified in Art. 91(1)(a) to (g). These requirements relate to the following: Art. 91

- (i) representation;
- (ii) physical requirements of the application;
- (iii) abstract;
- (iv) request for grant;
- (v) claim to priority;
- (vi) designation fees (see also C-VI, 1.4);
- (vii) designation of inventor; and
- (viii) filing of drawings.

1.2 Further checks

In addition to the above, it is necessary for the Receiving Section to carry out a preliminary check of the description and claims in order to ensure that prohibited matter referred to in Rule 34 is omitted from the application as published and that the title of the invention, which will appear in the published application, is in general accord with the requirements of Rule 26(2)(b). The Receiving Section should also check whether any claims fees due have been paid (see also III, 9), whether the certificate of exhibition under Rule 23 has been filed where the invention has been displayed under Art. 55(1)(b) (see also IV, 3), whether in the case of European patent applications relating to biological material the information pursuant to Rule 28(1)(c) and (d) is complete (see also IV, 4) and whether in the case of an application with nucleotide and/or amino acid sequences a prescribed sequence listing has also been filed (see also IV, 5, and the Decision of the President of the EPO, Supplement No. 2 to OJ 11/1998).

Rule 34
Rule 31(1)
Rule 23
Art. 55(1)(b)
Rule 28
Rule 27a

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


2. Representation**2.1 Requirements**

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

- (i) the necessity for applicants who have neither a residence nor principal place of business in a Contracting State to be represented by an authorised professional representative or by an authorised legal practitioner fulfilling the requirements of Art. 134(7);

- (ii) that, where an applicant who is resident in or has his principal place of business in a Contracting State is represented by an employee, the employee is authorised; and
- (iii) that the authorisation, if any is required (see IX, 1.5 and the Decision of the President of the EPO, OJ 9/1991, 489), is in order, duly signed (see IX, 3.2 and 3.4) and is filed in due time.

2.2 Non-compliance

The effect of non-compliance with the provisions with regard to representation and the action to be taken by the formalities officer in dealing with any deficiency are considered in III, 14. 

3. Physical requirements

3.1 General remarks

Art. 91(1)(b)

Every application that is subject to formal examination is examined for compliance with the requirements as to form set out below. Non-compliance with the requirements is considered in III, 14.


3.2 Documents making up the application, replacement documents, translations

It is the responsibility of the Receiving Section to ensure that the documents making up the application, i.e. request, description, claims, drawings and abstract, meet the requirements of Rule 35(2) to (11) and (14) and, with regard to drawings, the requirements of Rule 32, to the extent necessary for the purpose of a reasonably uniform publication of the application under Art. 93(2). The Receiving Section should therefore not draw the attention of the applicant to any deficiencies under Rule 32(2)(i) or (j) or question whether tables included in the claims meet the requirements of Rule 35(11). In the event of deficiencies under Rule 27a, the Receiving Section must invite the applicant to remedy them (Decision of the President of the EPO, Supplement No. 2 to OJ 11/1998; see also IV, 5).

Art. 94(1)
Art. 96(2)
Rule 35(1)
Rule 36(1)

Once the application is transferred to it, the Examining Division assumes responsibility for formal matters, and should pay particular attention to the more technical requirements of Rule 32 and Rule 35 including particularly the above-mentioned requirements under Rule 32(2)(i) and (j) and Rule 35(11) and those laid down in Rule 35(12) and (13). The particular requirements for drawings are dealt with in Chapter X. With regard to the more technical requirements, such as those of Rule 32(2)(f) and (h), the Receiving Section should, in case of doubt, consult and take the advice of the Search Division. The Receiving Section should also consider taking action when the Search Division draws its attention to a deficiency which it had overlooked. It should be noted that, in accordance with Rule 32(3), flow sheets and diagrams are to be considered as drawings. As indicated in IX, 2.2, replacement documents and translations in an official language of documents filed under the provisions of Art. 14(2) are subject to the same requirements as the documents making up the application.

3.3 Other documents

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

of each page, and are filed in a sufficient number of copies so that each party will have a document for each application or patent (see IX, 2.4).

3.4 Signature

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

4. Request for grant

4.1 General remarks

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

Rule 26(1)

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

4.2 Examination of the Request for Grant form

The Receiving Section examines the request to ensure that it contains the information listed in Rule 26(2). The request form provides for the entry of that information. The petition for the grant (Rule 26(2)(a)) is an integral part of the form. The applicant must be allowed to correct deficiencies in the request to the extent indicated in III, 14.

4.2.1 Information on the applicant

The request must contain, in the manner specified in Rule 26(2)(c), the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Where the application is in the name of more than one applicant, the requirement must be satisfied for each applicant. At this stage in the proceedings, the formalities officer should have regard to the provisions of II, 2 governing the entitlement of the person named as applicant to apply for a patent.

4.2.2 Signature

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

Rule 26(2)(i)

(The provisions of Rule 26(2)(b), (e), (f), (g) and (h) dealing respectively with the title of the invention, divisional applications, Art. 61 applications, claim to priority and designation of Contracting States are considered under these headings in subsequent sections of this Chapter and in Chapter IV)

5. Designation of inventor

5.1 General remarks

Art. 81
Rule 26(2)(k)

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

5.2 Waiver of right to be mentioned as inventor

Rule 18(1)
Rule 92(1)(g)
Rule 93(c)
Art. 129(a)

The inventor designated by the applicant may address to the EPO a written waiver of his right to be mentioned as inventor in the published European patent application and the European patent specification, in which case his name is not mentioned in the published European patent application, the European patent specification, the Register of European Patents (Rule 92(1)(g)) and, consequently, the European Patent Bulletin, always provided that the waiver is received in time. Moreover, in accordance with Rule 93(c), the designation of the inventor as well as the waiver is then excluded from file inspection pursuant to Art. 128(4).

5.3 Designation filed in a separate document

Rule 17(1)

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

In the case of assignment, the words "by agreement dated ..." suffice, in the case of inventions by employees a mention that the inventor(s) is/are employee(s) of the applicant(s) and in the case of succession a mention that the applicant(s) is/are heir(s) of the inventor(s).

+

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

Rule 17(2)

The EPO does not verify the accuracy of the information given in the designation of the inventor.

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

5.4 Notification

Rule 17(3)
Rule 17(4)

If the applicant is not the inventor or is not the sole inventor, the Receiving Section must notify the inventor of the data contained in the document designating the inventor together with the data mentioned in Art. 128(5) relating to the application. It should be noted, however, that neither the applicant nor the inventor may invoke either the omission of this notification or any errors contained in it.

The inventor is notified at his address as indicated by the applicant. If the notification is returned to the EPO because the inventor is not known at the address indicated or has moved to an unknown new address, the

applicant is asked whether he knows the inventor's new address. If the applicant gives a new address, the inventor is notified at that address. Otherwise no further attempt at notification is made.

No notification is made where the inventor addresses to the EPO a written waiver of the notification under Rule 17(3) (cf. Notice of the EPO, OJ 5/1991, 266). The waiver must be filed with the designation of inventor and contain the information to be supplied to the inventor by the EPO under Rule 17(3), i.e.:

- (i) the number and date of filing of the European patent application, if known;
- (ii) where the priority of an earlier application is claimed, the date and State of the earlier application, and its number, if known;
- (iii) the name of the applicant;
- (iv) the title of the invention;
- (v) the Contracting States designated in Section 32.1 of the Request for Grant form; and
- (vi) the name(s) of any co-inventor(s).

5.5 Deficiencies

Where a designation is not filed, or where the designation filed contains a major deficiency (e.g. inventor's name or the signature of the applicant is missing) so that it cannot be considered as validly filed, the applicant is informed that the European patent application will be deemed to be withdrawn if the deficiency is not remedied within the period prescribed under Art. 91(5) or within a minimum period of two months as from notification of this communication, whichever period is the longer. If the deficiencies are not rectified in due time, the application is deemed to be withdrawn and the applicant is notified accordingly (as regards divisional applications, see IV, 1.5). Re-establishment of rights under Art. 122 is possible on request (see E-VIII, 2).

Art. 91(1)(f)
Rule 42(1)
Art. 91(5)
Art. 121
Art. 122

If the designation filed presents only minor deficiencies (e.g. inventor's address is missing), the applicant is invited to correct these within a time limit set by the EPO pursuant to Art. 91(2). If this is not corrected in due time, the application is refused (analogous to Art. 91(3)). Further processing of the application under Art. 121 or re-establishment of rights under Art. 122 is possible on request. Regarding the designation of inventor in divisional applications, see IV, 1.5.

5.6 Incorrect designation

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

Rule 19(1)

Where an incorrect designation has been rectified and where the incorrect designation was entered in the Register of European Patents or published in the European Patent Bulletin, such entry or publication must be

Rule 19(2)
Rule 19(3)

corrected. These provisions apply as well to the cancellation of an incorrect designation.

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

6.1 General remarks

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

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

- (i) the previous application was filed in or for a State recognised as giving rise to a priority right in accordance with the provisions of the EPC;
- (ii) the applicant for the European patent was the applicant, or is the successor in title to the applicant, who made the previous application;
- (iii) the European application is made during a period of twelve months from the date of filing of the first application; and
- (iv) the European application is in respect of the same invention as the invention disclosed in the previous application (see also C-V, 1).

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

Art. 87(3)

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

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

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

6.2 List of Contracting States to the Paris Convention

The recognised States, referred to at III, 6.1(i) above, are States party to the Paris Convention for the Protection of Industrial Property, or States not party to that Convention which have made an agreement with the EPO under Art. 87(5) EPC (to date, no such agreements have been concluded). In view of the wording of Art. 87(1) which refers to filings "in or for any State party to the Paris Convention", priority may be claimed of an earlier first filed national application, European application or international application. A list of States in respect of which the filing is recognised as giving rise to a priority right is annexed to this Chapter (III-Annex). These are the Contracting States to the Paris Convention for the Protection of Industrial Property. A list of the countries party to the Paris Convention is

published on WIPO's website and is regularly published in the Official Journal of the EPO.

However, the TRIPS Agreement does not entitle the applicant for a European application to claim priority from a first filing in a State which was not at the relevant dates a member of the Paris Convention but was a member of the WTO/TRIPS Agreement (G 2/02 and G 3/02 (OJ 10/2004, 483)).

6.3 Multiple priorities

The applicant may claim more than one priority based on previous applications in the same or different States. Where multiple priorities are claimed, time limits which are calculated from the priority date run from the earliest date of priority and, as a result, the European application must be made within twelve months from the earliest priority; this applies if earlier applications have been filed both in States that are parties to the Paris Convention and also in States that have concluded an agreement under Art. 87(5) EPC (to date, no such agreements have been concluded).

Art. 88(2)

6.4 Examination of the priority document

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

6.5 Declaration of priority

An applicant wishing to claim priority must file a declaration of priority indicating the date of the previous application, the State in or for which it was filed and its file number. The date and State of the previous application must be stated in the request for grant at the time of filing the European patent application. The request for grant may be corrected under Rule 88, first sentence, if it contains errors regarding the date and State of the earlier application, provided that the request for correction is made sufficiently early for the correction to be contained in the publication of the application or at least for a warning to be included in the published application. If the request is filed later it may, exceptionnaly, be allowed if it is apparent on the face of the published application that a mistake has been made (see V, 3 and other sources therein). The file number of the previous application must be indicated before the end of the sixteenth month after the date of priority claimed; failure to do so constitutes a deficiency which the applicant is requested to rectify (under application mutatis mutandis of the principles of J 1/80, OJ 9/1980, 289).

Art. 88(1)
Rule 38(1)
Rule 38(2)
Rule 26(2)(g)
Rule 88
Art. 91(2)
Rule 41(1)

6.6 Priority period

Where the date of the first filing given on filing the European patent application precedes the date of filing of the European patent application by more than one year, the applicant must be informed by the Receiving Section that there shall be no priority for the application unless within a period of one month he indicates a corrected date lying within the year preceding the date of filing. Rules 84a and 85 apply to the priority period under Art. 87(1). In the event that the date indicated for the previous application is subsequent to or the same as the date of filing, the applicant should be allowed a period of one month for indicating a corrected date (with regard to the possibility of effecting correction of clerical or similar errors, see V, 3).

Rule 41(3)
Rule 84a
Rule 85

6.7 Copy of the previous application (priority document)

Rule 38(3)
Art. 88(2)
Art. 91(2)
Rule 41(1)

A paper copy of the previous application for which priority is claimed (priority document) must be filed before the end of the sixteenth month after the date of priority. Failure to do so constitutes a deficiency which the applicant is requested to rectify (see J 1/80, OJ 9/1980, 289). Where multiple priorities are claimed, the above-mentioned time limit runs from the earliest date of priority.

The copy must be certified as an exact copy of the previous application by the authority which received the previous application and must be accompanied by a certificate issued by that authority stating the date of filing of the previous application (Rule 38(3), second sentence). The priority document submitted must be the original, i.e. contain the original of the certificate issued by the receiving authority.

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

- (i) the physical medium containing the or part of the priority document is prepared by the authority which received the previous application, such as to guarantee that its content cannot undetectably be altered subsequently;
- (ii) the content of the physical medium is certified by that authority as an exact copy of the previous application or the part contained therein; and
- (iii) the filing date of the previous application is also certified by that authority.

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

A digitally signed certified copy of a US patent application, as issued in electronic form by the USPTO on or after 30 July 2004, is accepted by the EPO as a priority document provided that it is filed together with the corresponding certification statement either as an attachment to an online submission of Form 1001, 1200 or 1038 or on CD. A paper printout of these electronic documents is not acceptable as a priority document (see Notice from the EPO dated 15 September 2004, OJ 11/2004, 562).

Rule 38(4)

Rule 38(4) together with the Decision of the President of the EPO dated 22 December 1998 (OJ 2/1999, 80) provide for the following exception to the requirement that a priority document be filed:

If the previous application is:

- (i) a European patent application;
- (ii) an international application filed with the EPO as receiving Office under the PCT;
- (iii) a Japanese patent or utility model application; or
- (iv) an international application filed with the Japanese Patent Office as receiving Office under the PCT,

then the EPO will include free of charge a copy of the previous application in the file of the European patent application. No request is necessary to this end. As soon as the EPO has included the copy of the previous

application, it informs the applicant accordingly (Decision of the President of the EPO dated 9 March 2000, OJ 5/2000, 227). However, if the language of the previous application was not one of the official languages of the EPO, it is still necessary to file the translation or declaration under Rule 38(5) (see III, 6.8 and the Notice from the EPO published in OJ 4/2002, 192).

6.8 Translation of the previous application

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed within the time limit set by the EPO, but at the latest within the non-extendable time limit laid down in Rule 51(4). Alternatively, a declaration that the European patent application is a complete translation of the previous application may be submitted within those same time limits (see also C-V, 3.2 and 3.3). The declaration may already be made by crossing the appropriate box in the Request for Grant form (Form 1001, Section 25a). This declaration is only valid if the text of the European application as filed is an exact translation of the text of the earlier application (description and claims) of which priority is claimed. If not, or if the European application contains more or less text than is contained in the earlier application as filed, such a declaration cannot be accepted and a complete translation must be filed. A merely different arrangement of the various elements (i.e. the claims vs. the description) of the application does not affect the validity of such a declaration (see Legal Advice No. 19/1999, OJ 5/1999, 296).

Art. 88(1)
Rule 38(5)

Failure to file the translation, or, where applicable, the declaration, constitutes a deficiency which the applicant is requested to rectify within a time limit specified by the EPO (see also III, 14.2).

Art. 91(2)
Rule 41(1)

If the required translation or declaration is not filed within the time limit, the right of priority is lost for the European patent application (see III, 6.10 and 6.11).

6.9 Non-entitlement to right to priority

A European patent application has no right to priority if:

- (i) the application was not filed within a period referred to in III, 6.1(iii) or the applicant has failed to indicate, within the period referred to in III, 6.6, a corrected date of priority preceding by no more than one year the date of filing of the European application;
- (ii) the previous application did not seek an industrial property right giving rise to a priority right (see III, 6.1); or
- (iii) the previous application does not give rise to a priority right in respect of the State in or for which it was filed (see III, 6.1(i) and 6.2).

Art. 87(1)
Rule 41(3)

Art. 87(1)

Art. 87(1), (5)

6.10 Loss of right to priority

The right to priority for a European patent application is lost where:

Art. 91(3)

- (i) the declaration of priority is not filed in due time (see III, 6.5); or
- (ii) the copy of the previous application or of any translation of the previous application is not filed in due time (see III, 6.7, 6.8).

6.11 Notification

Rule 69(1)

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

7. Title of the invention

7.1 Requirements

Rule 26(2)(b)

The request for grant must contain the title of the invention. A requirement of Rule 26(2)(b) is that the title must clearly and concisely state the technical designation of the invention and must exclude all fancy names. In this regard, the Receiving Section should take the following into account:

- (i) personal names, fancy names, the word "patent" or similar terms of a non-technical nature which do not serve to identify the invention should not be used;
- (ii) the abbreviation "etc.", being vague, should not be used and should be replaced by an indication of what it is intended to cover;
- (iii) titles such as "Method", "Apparatus", "Chemical Compounds" alone or similar vague titles do not meet the requirement that the title must clearly state the technical designation of the invention;
- (iv) trade names and trade marks should also not be used; the Receiving Section, however, need only intervene when names are used which, according to common general knowledge, are trade names or trade marks.

7.2 Responsibility

Rule 26(2)(b)

The ultimate responsibility for ensuring that the title accords with the provisions of the Implementing Regulations rests with the Examining Division. The Receiving Section should nevertheless take action to avoid, if possible, the publication of applications having titles which are clearly non-informative or misleading. It is necessary therefore that the Receiving Section takes cognisance of the provisions of Rule 26(2)(b) as set out in III, 7.1. In the event of obvious non-compliance with the provisions, the EPO will of its own motion change the title, if this appears necessary, without informing the applicant there and then. Only when the application is about to be published will the applicant be notified whether the title proposed by him has been changed (see OJ 4/1991, 224).

8. Prohibited matter

8.1 Morality or "ordre public"

Art. 53(a)
Rule 34(1)(a)
Rule 34(2)

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

to delay unduly the formalities examination it is sufficient that a cursory examination be undertaken to ensure that the application does not contain the following prohibited matter: statements constituting an incitement to riot or to acts contrary to "ordre public", racial, religious or similar discriminatory propaganda, or criminal acts and grossly obscene matter. The Receiving Section should also take action where the Search Division draws its attention to offending matter which it had overlooked. The applicant is notified of the material omitted.

8.2 Disparaging statements

According to Rule 34(1)(b), the application must not contain statements disparaging the products or processes of any particular person other than the applicant, or the merit or validity of applications or patents of any such person. However, mere comparisons with the prior art are not to be considered disparaging per se. Statements clearly coming within this category that become evident from the cursory examination referred to in III, 8.1, or to which attention is drawn by the Search Division, should be omitted by the Receiving Section when publishing the application. In cases of doubt the matter should be left for consideration to the Examining Division. The published application must indicate the place and number of any words omitted and the EPO must furnish, upon request, a copy of the passage omitted. The applicant is again notified of the material omitted. (See also treatment of prohibited matter in proceedings before the Examining Division, C-II, 7).

Rule 34(1)(b)
Rule 34(3)

9. Claims fee

A European application which contains more than ten claims at the time of filing incurs payment of a claims fee in respect of each claim over and above that number. The claims' order is their sequence at the time of filing. If an application contains more than one set of claims, Rule 31 is only applicable for the set of claims containing the highest number of claims (see Legal Advice No. 3/85 rev., OJ 11/1985, 347). The claims fees must be paid within one month after the filing of the application (see II, 4.2.1 as to what is understood by "filing of the application"). If the claims fees have not been paid in due time, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit. If a claims fee is not paid within the period of grace, the claim concerned is deemed to be abandoned and the applicant is notified to that effect. If the claims fees paid are insufficient to cover all the claims incurring fees (i.e. claim no. 11 onwards), and if when payment was made no indication was given as to which claims were covered by the fees paid, then the applicant is requested to specify which claims incurring fees are covered by the claims fees paid. The Receiving Section notifies the Search Division of claims that are deemed abandoned. Any claims fee duly paid is refunded only in the case referred to in Art. 77(5) (see II, 3.2, last paragraph).

Rule 31(1)
Rule 31(2)
Rule 69(1)
Art. 77(5)

Features of a claim deemed to have been abandoned pursuant to Rule 31(2) and which are not otherwise to be found in the description or drawings cannot subsequently be reintroduced into the application and, in particular, into the claims (J 15/88, OJ 11/1990, 445).

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

10. Filing of drawings

Art. 78(1)(d)
Art. 91(6)
Rule 43(1)
Rule 43(2)

An application must contain drawings (even though they may not meet the physical requirements referred to in III, 3) where they are referred to in the description or the claims and it is necessary therefore for the Receiving Section to make a check in that regard. Where the drawings were filed later than the date of filing of the application, the applicant is informed by the Receiving Section that the drawings and the reference to the drawings in the application will be deemed to be deleted unless the applicant requests within a non-extendable period of one month that the application be re-dated to the date on which the drawings were filed. Similarly, if the applicant has omitted to file some or all of the drawings referred to in the description or claims, he is invited to file them within a non-extendable period of one month and is informed that the application will be re-dated to the date on which they are filed or, if they are not filed within that period, that any reference to them in the application will be deemed to be deleted.

Rule 88, 2nd sentence

If the applicant requests the insertion of drawings by way of correction under Rule 88, second sentence, this request is to be decided upon before a communication under Rule 43 is issued. For the principles governing correction see V, 3.

11. Abstract**11.1 General remark**

Art. 78(1)(e)
Art. 91(1)(c)

Every application for a patent must contain an abstract. The effect of non-compliance with this requirement is dealt with in III, 14.

11.2 Content of the abstract

Rule 47(1)

The definitive content of the abstract is the responsibility of the Search Division. However, where it is obvious that the abstract filed does not belong to the application, and this should normally be confirmed by the Search Division, the applicant is informed that the document filed does not constitute an abstract and that unless he corrects the deficiency the sanction referred to in III, 14 will apply.

11.3 Figure accompanying the abstract

Rule 33(4)

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

12. Designation of Contracting States**12.1 General remarks**

All the States designated must be Contracting States to the EPC at the filing date of the application (for a list of the EPC Contracting States, see the General Part of the Guidelines, section 6). Any other State entered on the request for grant must be disregarded (see for the designation of Contracting States on the Request for Grant form, III, 12.6 and 12.7). As indicated in II, 2, when the application is in the name of joint applicants, each may designate different Contracting States; objection should be raised during the course of the examination for formal requirements if there is any ambiguity as to the States designated by the individual applicants.

12.2 Designation fee; time limits

The designation of a Contracting State is subject to payment of a designation fee. A single joint designation fee is payable for Switzerland and Liechtenstein. The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee.

Art. 79(2)
Art. 149(1)
Art. 2, No. 3 RFees
Art. 2, No. 3a RFees,
RFees

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

For divisional applications and new applications under Art. 61(1)(b), the designation fees must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application or the new European patent application (see IV, 1.4.1).

Rule 15(2)
Rule 25(2)

For Euro-PCT applications entering the European phase, see III, 12.10.

12.3 Consequences of non-payment of designation fees; period of grace

Where the designation fee has not been paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn (see also III, 12.5).

Art. 91(4)

However, if a designation fee for a European patent application has not been paid within the normal period, it may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within that period a surcharge is also paid. Designation fees in respect of which the applicant has dispensed with notification under Rule 85a(1) may still be validly paid under Rule 85a(2) within a non-extendable period of grace of two months of expiry of the normal period provided that within that period a surcharge is also paid (for calculation of aggregate time limits see Legal Advice No. 5/93 rev., OJ 4/1993, 229).

Rule 85a
Art. 2, No. 3b, RFees

In cases where the time limits for subsequent payment of designation fees under paragraphs 1 and 2 of Rule 85a expire at different times, all designation fees can still validly be paid up to the later date (J 5/91, OJ 11/1993, 657).

For Euro-PCT applications entering the European phase, see III, 12.10.

12.4 Surcharge paid insufficient

If during the periods of grace designation fees are paid without or without sufficient surcharge, it is first necessary to establish how many designation fees including surcharge are covered by the total sum paid for that purpose. The applicant must then be invited, pursuant to Art. 7(2), first sentence, RFees, to inform the EPO for which Contracting States the designation fees plus surcharge are to be used (see J 23/82, OJ 4/1983, 127). For the subsequent procedure, see III, 12.8.

Art. 7(2), 1st
sentence, RFees

12.5 Application deemed to be withdrawn

Where no designation fee is validly paid by expiry of the periods of grace under Rule 85a, the application is deemed to be withdrawn; the surrender of one or more priority claims subsequent to this legal consequence does not alter the position.

Art. 79(3)
 Art. 91(4)
 Rule 69(1)

Where the application is deemed to have been withdrawn because of failure to pay the designation fees, the loss of rights ensues on expiry of the normal period. Similarly, the deemed withdrawal of a designation of a Contracting State takes effect upon expiry of the normal period, and not upon expiry of the period of grace provided by Rule 85a (see G 4/98, OJ 3/2001, 131). The applicant is notified of the loss of rights only where, contrary to his originally declared intention in the Request for Grant form (Form 1001), he has failed to pay designation fees for States for which he had indicated his intention to pay.

Art. 122(5)

Re-establishment of rights in respect of the periods under Art. 79(2) and Rule 85a is excluded under Art. 122(5) (see J 12/82, OJ 6/1983, 221).

12.6 Request for Grant form

Art. 79(1), (2)

The designation of the Contracting States in which protection for the invention is desired shall be contained in the request for grant of a European patent, whereas the designation fees may be paid later.

The use of the prescribed Request for Grant form (Form 1001) with its pre-crossed declaration designating all Contracting States belonging to the EPC at the filing of the application (Section 32.1) ensures that all designations are made on the day the application is filed, giving the applicant time – until expiry of the period for paying the designation fees (Art. 79(2), Rules 15(2), 25(2) and 85a(1), (2)) – to decide which Contracting States he actually wants his patent to cover. This he does by paying the designation fees for those States, including any surcharge(s).

12.7 Indication of the Contracting States

Art. 2, No. 3, RFees
 Art. 7(1) RFees

The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee. Such payment simply need to be marked "Designation fees" in order for the purpose of the payment to be established.

If, on the other hand, the applicant intends to pay fewer than seven designation fees when filing the application, he should indicate the relevant Contracting States in Section 32.2b of the Request for Grant form (Form 1001). This helps to ensure that the designation fees paid are properly entered in the books and to avoid unnecessary communications under Rule 85a(1) and Rule 69(1) where the applicant has intentionally not paid the fees for certain States because he does not want a patent there. If designation fees are not paid within the basic time limit, communications under Rule 85a(1) and Rule 69(1) are issued only in respect of those States for which the applicant indicated his intention to pay. As regards the other designated States no communications are issued; he may, however, still pay the fees (plus surcharge) for these States up to the end of the period of grace under Rule 85a(2).

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

12.8 Amount payable

Art. 7(2), 1st
 sentence, RFees
 Art. 9(2), 2nd
 sentence, RFees
 Art. 91(4)
 Rule 69(1)

If, given the amount payable under the time limit in question, the sum paid for designation fees during the periods under Art. 79(2) or Rule 85a does not cover all the Contracting States indicated under Section 32.2b of the Request for Grant form (Form 1001), and the payer has failed to indicate for which Contracting States the fees are intended, then he is requested to indicate which States he wishes to designate, within a period stipulated by

the EPO (see also III, 12.4). If he fails to comply in due time, then Art. 9(2) RFees applies: the fees are deemed to have been paid only for as many designations as are covered by the amount paid, in the order in which the Contracting States have been designated (see J 23/82, OJ 4/1983, 127). The designation of Contracting States not covered by the fees are deemed withdrawn, and the applicant is notified of the loss of rights (see III, 12.5 paragraph 2, regarding the time at which loss of rights ensues).

12.9 Withdrawal of designation

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

Art. 97(4), (5)
Art. 79(3)
Rule 14

12.10 Euro-PCT applications entering the European phase

For Euro-PCT applications entering the European phase, the designation fees must be paid within 31 months of the filing or priority date, if the time limit specified in Art. 79(2) has expired earlier.

Rule 107(1)(d)

Pursuant to Rule 108(1), the designation of any Contracting State for which no designation fee has been paid in time is deemed to be withdrawn. If no designation fee for the Euro-PCT application entering the European phase is paid at all within the basic period under Rule 107(1)(d), the European patent application (see Art. 150(3)) is deemed to be withdrawn. If the EPO finds that such deemed withdrawal of the European patent application or the designation of a Contracting State has occurred, it informs the applicant accordingly. The loss of rights is deemed not to have occurred if, within two months from notification of the communication, the omitted act is performed and a surcharge under Art. 2, No. 3c, RFees is paid. If no Rule 108(3) communication is to be issued, there is an additional period of two months from expiry of the applicable time limit for payment of designation fees with surcharge Rule 108(4).

Rule 108
Art. 2, No. 3c, RFees
Art. 150(3)

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

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

13.1 General remarks

At the applicant's request and on payment of the prescribed fee European patent applications (direct or Euro-PCT) and thus patents can be extended to States for which an Extension Agreement with the EPO has become effective (Extension States).

Extension may be requested for the following States:

Latvia (LV)	since 1 May 1995;	=====
Albania (AL)	since 1 February 1996;	=====
the former Yugoslav		
Republic of Macedonia (MK)	since 1 November 1997;	
Croatia	since 1 April 2004;	
Serbia and Montenegro	since 1 November 2004; and	
Bosnia and Herzegovina	since 1 December 2004	

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

A request for extension to the above-mentioned States is deemed to be made with any European application filed after entry into force and before the termination of respective Extension Agreements. This applies also to Euro-PCT applications provided that the EPO has been designated for a European patent **and** the Extension State has been designated for a national patent in the international application. The request is deemed withdrawn if the extension fee is not paid within the prescribed time limit (see III, 13.2). It is by paying the extension fee that the applicant decides to extend his application to a certain Extension State. The declaration in Section 34 of the Request for Grant form (Form 1001) or Section 11 of Form 1200 for entry into the European phase before the EPO, where the applicant is asked to state whether he intends to pay the extension fee, is merely for information purposes and intended to assist in recording fee payments.

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

13.2 Time limit for payment of extension fee

Under the applicable national provisions of the Extension States, the extension fee must be paid within the periods prescribed by the EPC for the payment of designation fees (see III, 12.2, 12.10 and VII, 1.3). If the extension fee has not been paid within the applicable basic time limit (Art. 79(2), Rules 15(2), 25(2) and 107(1)(d)), a communication under Rule 85a(1) is not issued. However, the applicant may still validly pay the extension fee within a period of grace of two months after the expiry of the basic time limit provided that within this period a surcharge of 50% of the extension fee is also paid (Rule 85a(2)). As regards the ceiling of the surcharge, Art. 2, No. 3b and No. 3c, RFees applies *mutatis mutandis*. Rule 108(3) is not applicable to extension fees.

If the extension fee and where appropriate the surcharge are not paid within the specified periods, the request for extension is deemed withdrawn. No communication under Rule 69(1) is issued, nor is re-establishment of rights possible in respect of payment of the extension fee.

13.3 Withdrawal of extension

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

13.4 Extension deemed requested

All Extension States are deemed requested (see, however, III, 13.1, 4th paragraph, regarding Euro-PCT applications) and are therefore indicated in the published application. These States, and those for which the extension fee has been paid, are indicated in the Register of European Patents and in the European Patent Bulletin.

13.5 National register

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

14. Correction of deficiencies

14.1 Procedure formalities officer

Where the notes during the examination for compliance with the requirements set out in earlier sections of this Chapter that there are deficiencies which may be corrected, he must give the applicant the opportunity to rectify each such deficiency within a specified period. Some of these periods have been referred to previously (see periods specified in III, 5.5, 6.6, 9, 10 and 12.3), others are determined by the Receiving Section in accordance with Rule 84. The formalities officer should in his first report to the applicant raise all the formal objections that become evident from a first examination of the application, except that, as noted in III, 3.2, the Receiving Section should not draw the attention of the applicant to deficiencies under Rule 32(2)(i) and (j) or question the inclusion of tables in the claims. It is likely that certain matters cannot be finally disposed of at this stage, e.g. filing of priority documents for which the period for filing has not expired, and further reports may be necessary. If the applicant is required to appoint a representative but has not done so, the formalities officer should in his first report not only cover this deficiency but any other obvious deficiencies as it should be assumed that the applicant on receipt of the report will appoint a representative within the period allowed.

Art. 91(2)

14.2 Period allowed for remedying deficiencies

The EPO determines the periods for remedying the following deficiencies:

Rule 41(1), (2)

- (i) non-appointment of a representative where the applicant has neither his residence nor principal place of business in a Contracting State, or failure to file an authorisation where this is necessary (see IX, 1.5 and the Decision of the President of the EPO, OJ 9/1991, 489) (see also III, 2);
- (ii) documents making up the application not complying with physical requirements (see III, 3);
- (iii) request for grant (with the exception of the priority criteria) not satisfactory (see III, 4);

- (iv) abstract not filed (see III, 11);
- (v) non-payment of the claims fees (see III, 9); and
- (vi) priority document, file number or translation of the previous application is missing (see III, 6).

Rule 84
Art. 91(2), (3)

The period allowed for remedying any of the above deficiencies, apart from (v), must not be less than two months and not more than four months. As a general rule, the period is set at two months. If any of the listed deficiencies is not corrected within the time limit allowed, the application is refused (in cases (i) to (iv) above) or (in cases (v) and (vi) above) a loss of right occurs, and the applicant receives a communication from the EPO to that effect. Where appropriate, the Search Division is informed of such refusal or loss of rights.

CHAPTER III – Annex**LIST OF CONTRACTING STATES TO THE PARIS CONVENTION
(see III, 6.2)**

List of States (as on 3 January 2005) in respect of which the filing is recognised as giving rise to a priority right. The States in question are Contracting States to the Paris Convention for the Protection of Industrial Property. No agreements have so far been concluded pursuant to Art. 87(5) (see III, 6.2). (total: 169 States)

Albania	Ghana	Nigeria
Algeria	Greece	Norway
Andorra	Grenada	Oman
Antigua and Barbuda	Guatemala	Pakistan
Argentina	Guinea	Panama
Armenia	Guinea-Bissau	Papua New Guinea
Australia	Guyana	Paraguay
Austria	Haiti	Peru
Azerbaijan	Holy See	Philippines
Bahamas	Honduras	Poland
Bahrain	Hungary	Portugal
Bangladesh	Iceland	Qatar
Barbados	India	Romania
Belarus	Indonesia	Russian Federation
Belgium	Iran, Islamic Republic of	Rwanda
Belize	Iraq	Saint Kitts and Nevis
Benin	Ireland	Saint Lucia
Bhutan	Israel	Saint Vincent and the Grenadines
Bolivia	Italy	San Marino
Bosnia and Herzegovina	Jamaica	Sao Tome and Principe
Botswana	Japan	Saudi Arabia
Brazil	Jordan	Senegal
Bulgaria	Kazakhstan	Seychelles
Burkina Faso	Kenya	Sierra Leone
Burundi	Korea, Democratic	Singapore
Cambodia	People's Republic of	Slovakia
Cameroon	Korea, Republic of	Slovenia
Canada	Kyrgyzstan	South Africa
Central African Republic	Lao People's Democratic Republic	Spain
Chad	Latvia	Sri Lanka
Chile	Lebanon	Sudan
China	Lesotho	Surinam
Colombia	Liberia	Swaziland
Comoros	Libyan Arab Jamahiriya	Sweden
Congo	Liechtenstein	Switzerland
Congo, Democratic Republic of the	Lithuania	Syrian Arab Republic
Costa Rica	Luxembourg	Tajikistan
Côte d'Ivoire	Macedonia, the former Yugoslav Republic of	Tanzania, United Republic of
Croatia	Madagascar	Togo
Cuba	Malawi	Tonga
Cyprus	Malaysia	Trinidad and Tobago
Czech Republic	Mali	Tunisia
Denmark	Malta	Turkey
Djibouti	Mauritania	Turkmenistan
Dominica	Mauritius	Uganda
Dominican Republic	Mexico	Ukraine
Ecuador	Moldova, Republic of	United Arab Emirates
Egypt	Monaco	United Kingdom
El Salvador	Mongolia	United States of America
Equatorial Guinea	Morocco	Uruguay
Estonia	Mozambique	Uzbekistan
Finland	Namibia	Venezuela
France	Nepal	Viet Nam
Gabon	Netherlands	Yugoslavia
Gambia	New Zealand	Zambia
Georgia	Nicaragua	Zimbabwe
Germany	Niger	

CHAPTER IV

SPECIAL PROVISIONS

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

1.1 General remarks

1.1.1 When may a divisional application be filed?

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

Art. 76
Rule 25(1)

As noted above, the parent application must be pending when a divisional application is filed. In the case of an application being filed as a divisional application from an application which is itself a divisional application, it is sufficient that the latter is still pending at the filing date of the second divisional application. An application is pending up to (but **not** including) the date that the European Patent Bulletin mentions the grant of the patent (OJ 2/2002, 112). It is not possible to validly file a divisional application when the parent application has been refused, withdrawn or is deemed to be withdrawn (see also the next two paragraphs). Re-establishment of rights pursuant to Art. 122 is excluded as regards the filing of a divisional application (J 10/01, not published in OJ).

If an application is deemed to be withdrawn due to the non-observance of a time limit (e.g. following failure to file the designation of the inventor (Art. 91(5)), to pay the fees for grant and printing or the claims fees, or to file the translation of the claims (Rule 51(8)) in due time, the application is no longer pending when the non-observed time limit has expired, unless the loss of rights, as communicated pursuant to Rule 69(1), is remedied. This may be effected either by means of an allowable request for further processing or re-establishment of rights (see E-VIII, 2) or, if the applicant considers that the finding of the EPO was inaccurate, by applying for a decision pursuant to Rule 69(2), whereupon either the competent EPO department shares his opinion and rectifies its decision or that department gives an unfavourable decision which is subsequently overturned on appeal.

Once an application has been refused, a divisional application can no longer be validly filed, unless the applicant files a notice of appeal, in which case the decision to refuse cannot take effect until the appeal proceedings are over. As the provisions relating to the filing of divisional applications also apply in appeal proceedings (Rule 66(1)), a divisional application may be filed while such appeal proceedings are under way.

1.1.2 Persons entitled to file a divisional application

Only the applicant on record may file a divisional application. This means that, in the case of a transfer of an application, a divisional application may only be filed by or on behalf of the new applicant if the transfer was

duly registered and therefore effective (Rule 20) at the filing date of the divisional application.

1.2 Date of filing of a divisional application; claiming priority

1.2.1 Date of filing

Art. 76(1),
2nd sentence

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

Art. 80

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

1.2.2 Claiming priority

Rule 38(4), (5)

A priority claimed in the parent application may apply also to the divisional application. Provided that the parent application's priority claim has not lapsed, the divisional application retains that priority; it is not necessary to claim it formally a second time. A parent application's priority claim will, however, not be retained, if that priority claim is withdrawn in the divisional application. For the withdrawal of a priority claim see C-V, 3.5 and E-VIII, 6.2, 6.3). If a copy and any translation of the priority application have been filed in respect of the parent application before the divisional application is filed, it is not necessary to file the priority documents again in respect of the divisional application. The EPO makes a copy of these documents and places them in the file of the divisional application (see Legal Advice No. 19/99, OJ 5/1999, 296).

If, when the divisional application is filed, no priority documents have been filed in respect of the parent application, they must be filed in respect of the divisional application and, if the priority of the parent application's remaining subject-matter is to be retained, in respect of the parent application also. The applicant can also inform the EPO, within the time limit set for filing priority documents in the divisional application proceedings, that he has in the meantime submitted these documents in respect of the parent application. If the subject-matter of the divisional application relates only to some of the priorities claimed in the parent application, priority documents in respect of the divisional application need be filed for those priorities only.

Rule 38(2)

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

1.3 Filing a divisional application

1.3.1 Where to file a divisional application?

Art. 76(1)
Art. 75(3)
Rule 24(1)

A divisional application must be filed directly or by post with one of the filing offices of the EPO. It may also be filed using the *epoline*[®] Online Filing software (Art. 3 of the Decision of the President dated 29 October 2002, OJ 11/2002, 543; Notice dated 29 October 2002, point 3, OJ 11/2002, 545). The filing of a European divisional application with a national authority has no effect in law; the authority may however, as a

service, forward the European divisional application to the EPO. If a competent national authority chooses to forward the application, it is not deemed received until the documents are filed at the EPO.

1.3.2 Request for grant

The request for grant of a patent must contain a statement that a divisional application is sought and state the number of the parent application. If the request is deficient, as can arise if there is no indication that the application constitutes a divisional application, although some of the accompanying documents contain an indication to that effect, or if the number is missing, the deficiency may be corrected in the manner indicated in III, 14.

Rule 26(2)(e)

1.3.3 Language requirements

As indicated in VIII, 1.3, a divisional application must be filed in the language of the proceedings of the parent application. If the applicant has availed himself of Art. 14(2) in filing the parent application, he may also use for the divisional application the original language of the parent application, provided he is entitled to do so. He must then file a translation in the language of the proceedings of the parent application within three months after the filing of the parent application, but not later than thirteen months after the date of priority. The translation may, however, also be filed at any time within one month of the filing of the divisional application. The application is not accorded the date of filing of the parent application if these requirements are not met. If the translation is not filed within the above-mentioned time limit, the divisional application is deemed to be withdrawn pursuant to Art. 90(3).

Rule 4

Rule 6

1.3.4 Designation of Contracting States

In the divisional application only such Contracting States may be designated as, on the date it is filed, are still validly designated in the parent application (see also G 4/98, OJ 3/2001, 131). The designation of other States is without effect, and the applicant is notified of this.

Art. 76(2)

Rule 25(2)

1.3.5 Extension States

For the extension to specific states not party to the EPC of European patents arising from divisional applications, see III, 13.1.

1.4 Fees

1.4.1 Filing, search and designation fees

The filing fee and search fee for the divisional application must be paid within one month after it is filed (basic time limit). The designation fees must be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the divisional application.

Art. 76(3)

Rule 25(2)

Art. 79(2)

The search fee must be paid even if a further search fee has already been paid under Rule 46(1) in respect of the search report on the parent application for the part of the application which was lacking in unity and which is now the subject of the divisional application (for reimbursement of the search fee see IV, 1.8).

If the fees have not been paid within the normal period they may still be validly paid within the periods of grace under Rule 85a provided that within

Rule 85a

Art. 2, No. 3b, RFees

those periods a surcharge is also paid (see II, 4.2.1 and III, 12.2 and 12.3). The result of non-compliance with these provisions is as indicated in II, 4.2.3, for filing and search fees, and III, 12.4, 12.5 and 12.8 for designation fees.

1.4.2 Claims fees

Rule 31(1)

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

1.4.3 Renewal fees

Art. 86(1)
Art. 76(1)
Rule 37(3)
Art. 2, No. 5, RFees

For the divisional application, as for any other European patent application, renewal fees are payable to the EPO. They are due in respect of the third year and each subsequent year, calculated from the date of filing of the parent application. Pursuant to Art. 76(1), the date of filing the parent application is also the date from which the time limits for payment of the renewal fees for the divisional application (Art. 86(1)) are calculated. If, when the divisional application is filed, renewal fees for the parent application have already fallen due, these renewal fees must also be paid for the divisional application and fall due when the latter is filed. The period for payment of these fees is four months after the filing of the divisional application. If not paid in due time, they may still be validly paid within six months of the date on which the divisional application was filed, provided that at the same time the additional fee of 10% of the renewal fees paid late is paid. The same applies if on the date of filing of the divisional application a further renewal fee in addition to those to be made good falls due, or a renewal fee falls due for the first time.

Rule 37(3)
Art. 2, No. 5, RFees

If, within the four-month period referred to above, a further renewal fee falls due or a renewal fee falls due for the first time, it may be paid free of surcharge within that period. It may otherwise still be validly paid within six months of the due date, provided that at the same time the additional fee of 10% of the renewal fee paid late is paid. When calculating the additional period the principles developed by the Legal Board of Appeal should be applied (see J 4/91, OJ 8/1992, 402).

In the case of applications for re-establishment of rights in respect of renewal fees falling due within the four-month period laid down in Rule 37(3), second sentence, the period prescribed by Art. 122(2), third sentence, starts to run only after the four months have expired.

Example:

05.03.1990:	date of filing of parent application; filing of divisional application and due date of renewal fee for the third year;
13.01.1993:	renewal fee for the third year;
31.03.1993:	due date of renewal fee for the fourth year;
13.05.1993:	expiry of four-month period under Rule 37(3);
13.05.1994:	expiry of one-year period under Art. 122(2).

1.5 Designation of the inventor

Rule 42(2)

The provisions of III, 5.5 apply with regard to the designation of the inventor, except that the time limit for identifying the inventor may not expire less than two months after the notification of the communication of the Receiving Section informing the applicant of the omission of or deficiencies in the designation of inventor.

1.6 Authorisations

The provisions of IX, 1.5 and 1.6 apply with regard to authorisations in respect of the divisional application. If, according to these provisions, the representative has to file an authorisation, he may act on the basis of an individual authorisation filed in respect of the parent application only if it expressly empowers him to file divisional applications.

1.7 Other formalities examination

Other than for matters referred to in IV, 1.1 to 1.6, the formal examination of divisional applications is carried out as for other applications. The provisions of Rule 27a apply with regard to divisional applications relating to nucleotide or amino acid sequences filed after 1 January 1993 (see IV, 5).

1.8 Further procedure

Divisional applications are searched, published and examined in the same way as other European patent applications. The search fee is refunded if the conditions of Art. 10(1) of the Rules relating to Fees are met (see the Notice from the President of the EPO dated 13 December 2001, OJ 1/2002, 56). The time limit for filing the request for examination begins to run with the date of mention of the publication of the search report concerning the divisional application.

2. Art. 61 applications

2.1 General

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

- (i) prosecute the application as his own application in place of the applicant (see IV, 2.6 and 2.9); Art. 61(1)(a)
- (ii) file a new European patent application in respect of the same invention (see IV, 2.7 and 2.9); or Art. 61(1)(b)
- (iii) request that the application be refused (see IV, 2.8 and 2.9). Art. 61(1)(c)

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

2.2 Suspension of the proceedings for grant

If a third party provides proof to the EPO that he has opened proceedings against the applicant for the purpose of seeking a judgement that he is entitled to the grant of the European patent – which proof may take the form of confirmation by the court – the EPO will stay the proceedings for grant unless the third party consents to the continuation of such

proceedings. Such consent must be communicated in writing to the EPO; it is irrevocable. However, proceedings for grant may not be stayed before the publication of the European patent application. Suspension must be ordered by decision. This is an interim decision, which under Art. 106(3) may only be appealed together with the final decision. These matters are dealt with by the Legal Division (see OJ 9/1990, 404).

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

2.3 Resumption of the proceedings for grant

Rule 13(3)

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

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

Rule 13(2)

Where proof is provided to the EPO that a decision which has become final has been given in the proceedings concerning entitlement to the grant of a European patent, the EPO must communicate to the applicant and any other parties that the proceedings for grant will be resumed as from the date stated in the communication unless a new European patent application pursuant to Art. 61(1)(b) has been filed for all designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the proceedings for grant.

2.4 Interruption of time limits

Rule 13(5)

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

Example: The six-month time limit under Art. 94(2) began on 1 July 1982. Proceedings were suspended on 21 September 1982 and resumed on 1 August 1983. The last day of the period already elapsed is 20 September 1982. The time which has not elapsed is therefore 10 days and 3 months, begins on 1 August 1983 and ends on 10 November 1983.

2.5 Limitation of the option to withdraw the European patent application

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

Rule 14

2.6 Prosecution of the application by a third party

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

Art. 61(1)(a)

2.7 Filing a new application

A new European patent application under Art. 61(1)(b) may be filed in paper or electronic form with one of the filing offices of the EPO or with the competent authorities of a Contracting State, if the national law of that State so provides (for further details see II, 1.1). Rule 15(3) applies in respect of the forwarding of an application filed with a competent national authority.

Art. 61(1)(b)
Art. 75(1)
Art. 77(3), (5)
Rule 15(3)

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

- (i) accordance of the date of filing of the earlier application and entitlement to priority date – see IV, 1.2;
- (ii) information in the request for grant – see IV, 1.3.2;
- (iii) filing, search, designation and claims fees – see IV, 1.4.1 and 1.4.2;
- (iv) designation of inventor – see IV, 1.5.

Art. 61(2)

Art. 61(3), Rule 15(2)
Rule 85a, Rule 31(1)

Rule 37(4)

However, arrangements for renewal fees are different. For the year in which the new application is filed and for the years beforehand, no renewal fees are payable.

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

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

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

Rule 15(1)

2.8 Refusal of the earlier application

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

2.9 Partial transfer of right by virtue of a final decision

Rule 16(1) If by a final decision it is adjudged that a third party is entitled to the grant of a European patent in respect of only part of the matter disclosed in the European patent application, Art. 61 and Rule 15 apply to such part.

3. Display at an exhibition

3.1 Certificate of exhibition; identification of invention

Art. 55(1)(b)
Art. 55(2)
Rule 23 Where an applicant states when filing his application that the invention which is the subject of the application has been displayed at an official or officially recognised international exhibition falling within the terms of the Convention on international exhibitions, he must file a certificate of exhibition within four months of the filing of the European patent application. The exhibitions recognised are published in the Official Journal. The certificate, which must have been issued during the exhibition by the authority responsible for the protection of industrial property at the exhibition, must indicate the following:

- (i) that the invention was exhibited at the exhibition;
- (ii) the opening date of the exhibition; and
- (iii) the date of the first disclosure, if different from the opening date of the exhibition.

The certificate must be accompanied by an identification of the invention authenticated by the authority referred to above.

3.2 Defects in the certificate or the identification

The Receiving Section acknowledges receipt of the certificate and identification of the invention. The Receiving Section draws the applicant's attention to any manifest defects in the certificate or the identification in case it is possible to rectify the deficiencies within the four-month period allowed. The applicant is notified if the certificate or identification is not furnished within the time allowed.

4. Applications relating to biological material

4.1 Biological material; deposit thereof

Rule 23b(3) In accordance with Rule 23b(3), "biological material" means any material containing genetic information capable of reproducing itself or being reproduced in a biological system.

Rule 28(1)(c), (d)
Rule 28(2) Where in relation to an application concerning biological material an applicant states that he has deposited in accordance with Rule 28(1)(a) the biological material with a depositary institution recognised for the purposes of Rules 28 and 28a, he must, if such information is not contained in the application as filed, submit the name of the depositary institution and the accession number of the culture deposit and, where the biological material has been deposited by a person other than the

applicant, the name and address of the depositor, within whichever of the following periods is the first to expire:

- (i) within a period of sixteen months of the date of filing of the European patent application or the date of priority, this time limit being deemed to have been met if the information is submitted before completion of the technical preparations for publication of the European patent application; Rule 28(2)(a)
- (ii) if a request for early publication of the application is submitted, up to the date of such submission; or Rule 28(2)(b)
- (iii) if it is communicated that a right to inspection of the files pursuant to Art. 128(2) exists, within one month of such communication. Rule 28(2)(c)

Moreover, when the depositor and applicant are not identical, the same time limit applies for submitting a document satisfying the EPO that the depositor has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with Rule 28(3) or (4). Rule 28(1)(d)

The depositary institution must be one appearing on the list of depositary institutions recognised for the purposes of Rules 28 and 28a, as published in the Official Journal of the EPO. This list includes the depositary institutions, especially the International Depositary Authorities under the Budapest Treaty. An up-to-date list is regularly published in the Official Journal. Rule 28(9)

4.2 Missing information; notification

When the Receiving Section notices that the information required under Rule 28(1)(c) (indication of the depositary institution and the accession number of the culture deposit) or the information and the document referred to in Rule 28(1)(d) (authorisation to refer to the deposit and the consent to it being made available) is not contained in or has not yet been submitted with the application, it should notify the applicant of this fact as this information can only be validly submitted within the time limits specified in Rule 28(2). In the case of missing information pursuant to Rule 28(1)(c), the deposit must be identified in the patent application as filed in such a way that the later submitted accession number can be traced back without ambiguity. This can normally be done by indicating the identification reference given by the depositor within the meaning of Rule 6.1(iv) of the Budapest Treaty (see G 2/93, OJ 5/1995, 275). The applicant is also informed when a deposit with a recognised depositary institution is referred to but no receipt from the depositary institution has been filed. Any further action is a matter for the Examining Division. See also C-II, 6, in particular 6.3(ii), as regards the Examining Division's treatment of applications relating to biological material. Art. 97(1)
Rule 28
Art. 83

4.3 Availability of deposited biological material to expert only

Under Rule 28(4)(a) and (b), until the date on which the technical preparations for publication of the application are deemed to have been completed, the applicant may inform the EPO that, until the publication of the mention of the grant of the European patent or, where applicable, for twenty years from the date of filing if the application has been refused or withdrawn or is deemed to be withdrawn, the availability referred to in Rule 28 is to be effected only by the issue of a sample to an expert. Rule 28(4)

The above communication must take the form of a written declaration addressed to the EPO. This declaration may not be contained in the description and the claims of the European patent application, but may be given in the Request for Grant form (Form 1001, Section 30).

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

Rule 28(5) If the applicant duly informs the EPO under Rule 28(4), the biological material is issued only to an expert recognised by the President of the EPO or approved by the applicant.

Rule 28(9) The list of recognised microbiological experts, giving their particulars and their fields of activity, is published in the Official Journal (see OJ 8/1992, 470).

5. Applications relating to nucleotide and amino acid sequences

Rule 27a(1)
Rule 27a(4)
Rule 27a(2) If nucleotide and amino acid sequences corresponding to the definition in WIPO Standard ST.25, paragraph 2(ii), are disclosed in the European patent application, they should be represented in a sequence listing which conforms to this WIPO Standard. The sequence listing should preferably be filed as part of the description, although it may also be filed later, in which case it does not form part of the application. In addition to submission in written form on paper or electronically, the sequence listing must also be submitted in computer readable form either on an authorised electronic data carrier or as attached to the electronically filed application. Data in computer readable form must comply with WIPO Standard ST. 25, paragraph 39ff. The information recorded on the electronic data carrier must be identical to the written sequence listing which is the authentic version. The applicant or his representative must submit a statement to that effect accompanying the data carrier in accordance with Rule 27a(2). See the Decision of the President of the EPO dated 2 October 1998 and the accompanying Notice from the EPO, Supplement No. 2 to OJ 11/1998.

Art. 91(2)
Rule 41(1)
Art. 91(1)(b)
Art. 91(3) The Receiving Section will inform the applicant of any deficiencies in the written sequence listing, the electronic data carrier or the statement under Rule 27a(2) and invite him to remedy the deficiencies within a period of two months. If the requirements of Rule 27a in conjunction with the Decision of the President of the EPO dated 2 October 1998 are not complied with in good time, where appropriate following the invitation to do so from the Receiving Section, the application will be refused.

Art. 121 The applicant may request further processing of the application.

6. Conversion into a national application

Art. 135 The central industrial property office of a Contracting State must apply the procedure for the grant of a national patent or another protective right provided for by the legislation of this State at the request of the applicant for or the proprietor of the European patent under the circumstances specified in Art. 135(1). If the request for conversion is not filed within the three-month period specified in Art. 135(2), the effect referred to in Art. 66 will lapse.

Art. 136(2) The request for conversion is to be made to the EPO, except where the application is deemed withdrawn pursuant to Art. 77(5); in this case the request is filed with the central industrial property office with which the application was filed.

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

Art. 136(1)

CHAPTER V**COMMUNICATING THE FORMALITIES REPORT; AMENDMENT OF APPLICATION; CORRECTION OF ERRORS****1. Communicating the formalities report**

After a formalities examination, the Receiving Section or, where appropriate, the Examining Division, issues a report to the applicant if the application is found to be formally defective. The report will identify all the particular requirements of the EPC which the application does not satisfy and, in the case of deficiencies which can be corrected, will invite the applicant to correct such deficiencies within specified periods (see III, 14). The applicant will be notified of the consequences, e.g. application deemed withdrawn, priority right lost, which result from the deficiencies or failure to take appropriate action within due time.

In general, a time limit will be specified for meeting each particular objection. These time limits are either fixed by the EPC or left, subject to certain restrictions, to the discretion of the EPO (see E-VIII, 1). If a deficiency is not rectified within due time, then the legal effects that are envisaged will apply.

2. Amendment of application**2.1 Filing of amendments**

Prior to the receipt of the European search report the applicant may amend his application only if the Receiving Section has invited him to remedy particular deficiencies. After receipt of the European search report and before receipt of a first communication from the Examining Division, i.e. also during the period in which the application may still be with the Receiving Section, the applicant may of his own volition amend the description, claims and drawings. However, the European patent application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (regarding the publication of claims thus amended, see also VI, 1.3).

Rule 41(1)
Rule 86(2)
Art. 123(1)
Art. 123(2)
Rule 49(3)

2.2 Examination of amendments as to formalities

The Receiving Section examines amendments, filed before the receipt of the search report, for formal requirements. Such amendments must remedy the deficiencies notified by the Receiving Section. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies and this requirement makes it necessary for the Receiving Section to compare any amended description, claims and drawings with those originally filed. Where, for example, a fresh description is filed to replace an earlier description that was objected to on account of non-compliance with the physical requirements, the Receiving Section must compare both descriptions and the objection is not met until there is identity of content. Amendments which extend beyond the remedying of deficiencies and which are filed prior to receipt of the search report may be taken into consideration in the subsequent procedure provided that, on receipt of the search report, the applicant declares that he wishes them to be maintained.

Rule 41(1)
Rule 86(1)

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

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

3. Correction of errors in documents filed with the EPO

Rule 88

Linguistic errors, errors of transcription and mistakes in any document filed with the EPO may be corrected on request. Requests for such amendments may be made at any time. However, if the error to be corrected concerns items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction (e.g. priority claims), the request for correction must be filed as soon as possible, and at least in time that it could be incorporated in the publication of the European patent application. An exception to this rule may be allowed if it is apparent on the face of the published application that a mistake has been made (see J 4/82, OJ 10/1982, 385 as well as J 2/92, J 3/91 and J 6/91, OJ 6/1994, 375, 365 and 349, respectively, as well as J 11/92, OJ 1-2/1995, 25, and J 7/94, OJ 12/1995, 817). Regarding correction of the date indicated for the previous filing, see also III, 6.6.

Rule 88, 2nd sentence

If the error is in the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else could have been intended than what is offered as the correction. Such a correction may be effected only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the documents as filed (see G 3/89 and G 11/91, OJ 3/1993, 117, 125; see also C-VI, 5. 4).

In the case of electronic filing of European patent applications, the technical documents (description, claims, abstract and drawings) may be attached in their original format, provided this format is one listed in the Notice dated 29 October 2002 (OJ 11/2002, 545). Pursuant to this Notice, these technical documents may also be attached in a format other than those listed, provided that the applicant informs the EPO, when filing the application, where the EPO can reasonably acquire the corresponding software. If, on the date of filing, the documents making up the European patent application are available both in the format provided by the *epoline*[®] Online Filing software and in another admissible format in accordance with the above-mentioned Notice, the documents in the latter format can also be used in order to determine whether a request for correction of the description, claims, or drawings is allowable.

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

CHAPTER VI**PUBLICATION OF APPLICATION; REQUEST FOR EXAMINATION
AND TRANSMISSION OF THE DOSSIER TO EXAMINING DIVISION****1. Publication of application****1.1 Date of publication**

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

Art. 93(1)

If the applicant abandons his priority date, then the publication is deferred provided that the notification of the abandonment is received by the EPO before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day seven weeks before the end of the eighteenth month from the date of priority, if priority is claimed, or from the date of filing, if the priority is abandoned or if no priority is claimed (see the Decision of the President of the EPO dated 14 December 1992, OJ 1-2/1993, 55). The applicant is informed when they are actually completed, and also of the publication number and intended publication date. Where the notification of abandonment of the priority is received after that time, publication, if it has not already taken place, takes place as if the priority date applied, although a notice as to the abandonment of the priority will appear in the European Patent Bulletin (see C-V, 3.5). The same procedure is followed when the priority right is lost under Art. 91(3).

1.2 No publication; preventing publication

The application is not published if it has been finally refused or deemed withdrawn or withdrawn before the termination of the technical preparations for publication. These preparations are considered terminated at the end of the day seven weeks before the end of the eighteenth month from the date of filing or priority (see the Notice from the EPO, OJ 1-2/1993, 56). The application is, however, published if, upon termination of the technical preparations for publication, a request for a decision under Rule 69(2) has been received but no final decision has yet been taken (see OJ 11/1990, 455).

Rule 48(2)

If after termination of the technical preparations the application is withdrawn to avoid publication, non-publication cannot be guaranteed. The EPO will however try (in accordance with the principles of J 5/81, OJ 4/1982, 155) to prevent publication on a case-by-case basis if the stage reached in the publication procedure permits this reasonably easily.

The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80, OJ 5/1981, 141). The applicant is bound by an effective declaration of withdrawal (see Legal Advice No. 8/80, OJ 1/1981, 6), but may make it subject to the proviso that the content of the application is not made known to the public. This takes into account the procedural peculiarity that the applicant who makes his declaration of withdrawal later than seven weeks before the date of publication cannot know whether publication can

Rule 14

still be prevented. However, neither the application nor the designation of a Contracting State may be withdrawn as from the time a third party proves that he has initiated proceedings concerning entitlement and up to the date on which the EPO resumes the proceedings for grant.

1.3 Content of the publication

Art. 93(2)
Rule 49(2)
Rule 18
Rule 28(4)

The publication must contain the description, the claims and any drawings as filed, and specify, where possible, the person(s) designated as the inventor(s). It also indicates the designated Contracting States. When a European application is published, the States for which protection is actually sought may not yet be known, because the time limit under Art. 79(2) for paying the designation fees is still running. The publication therefore always shows as designated all States party to the EPC on the date the application was filed. Those definitively designated – through actual payment of designation fees – are announced later in the Register of European Patents and the European Patent Bulletin (see Information from the EPO, OJ 10/1997, 479).

Rule 49(3)
Rule 47(1)
Rule 88
Rule 49(1)

The publication also contains any new or amended claims filed by the applicant under Rule 86(2), together with the European search report and the abstract determined by the Search Division if the latter are available before termination of the technical preparations for publication. Otherwise the abstract filed by the applicant is published. The search opinion is not published with the European search report. It is however open to file inspection (see XII, 2.1). If a request for correction under Rule 88 of errors in the documents filed with the EPO is allowed, it must be incorporated in the publication. If upon termination of the technical preparations for publication a decision is still pending on a request for correction of items which third parties might expect to be able to take at face value, so that their rights would be jeopardised by correction (e.g. priority claims), this must be mentioned on the front page of the publication (see the case law in V, 3), as must a request for correction of errors in the description, claims or drawings (see V, 3). If the EPO has received a communication from the applicant under Rule 28(4), ("expert solution"), this too must be mentioned (see Announcement of the President of the EPO, OJ 9/1981, 358). Further data may be included at the discretion of the President of the EPO. The publication may not contain any designation of States finally deemed withdrawn or withdrawn by the applicant before the termination of the technical preparations for publication.

The originals of documents filed are used for publication purposes where these documents meet the physical requirements referred to in IX, 2, otherwise the amended or replacement documents meeting these requirements are used. Prohibited material is omitted from the documents before publication, the place and number of words or drawings omitted being indicated (see III, 8.1 and 8.2). Documents incorporated in an electronic file are deemed to be originals (Rule 95a(3)).

Sequence listings filed on the date of filing are published as part of the description, whereas sequence listings filed thereafter are published as an annex to the application documents or to the European patent specification (Art. 6 of the Decision of the President of the EPO, Supplement No. 2 to OJ 11/1998).

1.4 Publication in electronic form only

European patent applications which, on filing, contain a sequence listing or consist of more than four hundred pages may be published in electronic

form only, at present for example on *esp@cenet*[®] and *ESPACE*[®] EP CD-ROM. On request, the European Patent Office will also make them available on another suitable medium (Decision of the President of the EPO dated 9 June 2000, OJ 7/2000, 367).

1.5 Separate publication of the European search report

If not published with the application, the European search report is published separately.

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

2.1 Communication

The Receiving Section communicates to the applicant the date on which the European Patent Bulletin mentioned the publication of the European search report and draws his attention to the provisions with regard to the request for examination as set out in Art. 94(2) and (3). The applicant may not invoke the omission of the communication. If the communication wrongly specifies a later date than the date of the mention of the publication, the later date is decisive as regards the time limit for filing the request for examination (see VI, 2.2) unless the error is apparent. In the communication, the applicant is also informed that the designation fees must be paid within six months of the date on which the European Patent Bulletin mentioned the publication of the search report (see III, 12.2 and 12.3).

Rule 50(1)
Rule 50(2)

2.2 Time limit for filing the request for examination

The request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report (normal period). The request for examination is not deemed to have been filed until a written request has been filed and the examination fee paid. If the request for examination is not filed within the normal period, it may still be validly filed within a non-extendable period of grace of one month of notification of a communication pointing out the failure to observe the time limit, provided that within the period of grace a surcharge of 50% of the examination fee is also paid.

Art. 94(1), (2)
Rule 85b
Art. 2, No. 7, RFees

Immediate filing of the written request for examination, provided for in the prescribed Request for Grant form (Form 1001), rules out the possibility of a loss of rights where the applicant pays the examination fee during the prescribed period but fails to file the written request for examination. The applicant has only one more procedural act – payment in due time of the examination fee (Art. 94(2), Rule 85b) – to worry about.

Rule 26(1)

On the other hand, there is nothing to stop him paying the examination fee at the same time as he files the application. If, after receipt of the European search report, he decides to not pursue the application further and does not react to the invitation pursuant to Art. 96(1), the application will be deemed withdrawn pursuant to Art. 96(3) and the examination fee will be refunded in its entirety (see VI, 2.5).

Art. 10b RFees

If the applicant has filed an automatic debit order, the examination fee will only be debited at the end of the six month period. If he wishes the application to be transmitted earlier to the Examining Division, he should pay the fee separately (see Supplement No. 2 to OJ 1/2005, 18, re point 12 AAD).

Point 12 AAD
Re point 12 AAD
(Annex A.2 to the
ADA)

Art. 94(2)

The request for examination may not be withdrawn.

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

2.3 Period of grace

Art. 94(3)

Rule 85b

Rule 69(1)

Art. 122(5)

If the request for examination is not validly filed before expiry of the period of grace under Rule 85b, the application is deemed to be withdrawn and the applicant is notified accordingly. The loss of rights ensues on expiry of the normal period (see J 4/86, OJ 4/1988, 119). Art. 122(5) excludes re-establishment of rights in respect of the periods under Art. 94(2) and Rule 85b (see J 12/82, OJ 6/1983, 221, and E-VIII, 2.2.4).

Art. 96(1)

Art. 96(3)

Rule 69(1)

Art. 121 Art. 122

If the applicant has validly filed a request for examination before the European search report has been transmitted to him, the Receiving Section invites him to indicate within six months from the date of the mention of the publication of the search report in the European Patent Bulletin whether he desires to proceed further with his application. If he fails to respond to this request in time, the application is deemed to be withdrawn and the applicant is notified accordingly. However, where this occurs the applicant may avail himself of the legal remedies under both Art. 121 (further processing of the application) and Art. 122 (restitutio in integrum). Regarding reimbursement of the examination fee, cf. VI, 2.2 and XI, 10.2.4. C-VI, 1.1.2 describes the procedure in respect of a categorical request for examination.

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

2.4 Transmission of the dossier to the Examining Division

Art. 16

Art. 18(1)

If the Receiving Section finds that the request for examination was filed in due time, or the desire to proceed further with the application was indicated in due time (Art. 96(1)), it transmits the application to the Examining Division. Otherwise, it notes the loss of rights which has occurred (see Rule 69(1)).

The dossier as transmitted to the Examining Division contains the following:

- (i) all documents filed in relation to the application, including priority documents, translations and any amendments;
- (ii) any certificate filed in relation to display at an exhibition (see IV, 3) and any information furnished under Rule 28 when the application relates to biological material (see IV, 4);
- (iii) the European search report, if applicable the search opinion, the content of the abstract as drawn up by the Search Division, and the internal search note, if any;
- (iv) copies of documents cited in the search report, and two copies of the publication document(s); and
- (v) all relevant correspondence. Copies of certain EPO communications to applicants or inventors – currently EPO Forms 1048, 1081, 1082 and 1133 – are not kept in the dossier but are computerised: their most important elements can at all times be printed out (as EPO Form 1190) and placed in the dossier.

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

2.5 Refund of examination fee

The examination fee is refunded:

Art. 10b RFees

- (i) in full if the European patent application is withdrawn, refused or deemed to be withdrawn before the Examining Divisions have assumed responsibility; or
- (ii) at a rate of 75% if the European patent application is withdrawn, refused or deemed to be withdrawn after the Examining Divisions have assumed responsibility but before substantive examination has begun. An applicant unsure whether substantive examination has begun and wanting to withdraw the application only if he will receive the 75% refund may make withdrawal contingent upon the refund ("conditional" withdrawal) (see OJ 9/1988, 354).

2.6 Reduction in examination fee

Art. 14(4)
Rule 6(3)
Art. 12(1) RFees

Where applicants having their residence or principal place of business within the territory of a Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad avail themselves of the options provided for under Art. 14(2) or (4), the examination fee is reduced (Rule 6(3) in conjunction with Art. 12(1) RFees) (see XI, 9.2.1 and 9.2.3).

CHAPTER VII

APPLICATIONS UNDER THE PATENT COOPERATION TREATY (PCT)
BEFORE THE EPO ACTING AS A DESIGNATED OR ELECTED
OFFICE

1. General

1.1 Introduction

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

Pursuant to Art. 150(3), an international application for which the EPO acts as a designated or elected Office is deemed to be a European patent application. For information about time limits and procedural steps before the EPO as a designated or an elected Office under the PCT, see the Guide for applicants "How to get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT", April 2002. A new edition will be published soon. Fundamental changes of the Regulations under the PCT affecting the processing in the international phase entered into force on 1 January 2004. In the new edition only the new procedure, applicable to applications with a filing date on or after 1 January 2004, will be set out. The edition of April 2002, insofar as the former procedure in general is set out therein, is still useful for applications with a filing date before 1 January 2004.

Art. 150(3)

In order to initiate the European phase, the requirements for entry into the European phase according to Rule 107 must be complied with (see VII, 1.2 and 1.3). For entry into the European phase, applicants are strongly recommended to use the most recent edition of Form 1200 obtainable from the EPO free of charge in printed form, as editable electronic document from the EPO website or as part of the epoline® Online Filing software.

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

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

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

Art. 23 PCT
Art. 40 PCT
Rule 49.1(a^{bis}) PCT
Art. 24(1)(iii) PCT
Rule 107(1)
Rule 108
Art.2, No.3c, RFees

Where the language of the international application is not an official language of the EPO, the applicant is required, in accordance with Art. 22

or 39 PCT and Rule 107(1)(a), to furnish a translation within a period of 31 months from the date of filing or, if priority has been claimed, from the earliest priority date. The application is deemed to be withdrawn if the translation is not furnished within that period. If the EPO finds that the application is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 108(3)). Rule 69(2) applies *mutatis mutandis*. The loss of rights is deemed not to have occurred if, within two months as from notification of the communication, the translation is filed and a surcharge under Art. 2, No. 3c, RFees is paid.

1.3 National basic fee, designation fee, request for examination, search fee and claims fees

Rule 107(1)
Rule 106
Rule 108
Art.2, No.3c, RFees

Under Rule 107(1)(c), the applicant must pay the national basic fee provided for in Rule 106(a) 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 107(1)(d), he must pay the designation fees within this period, if the time limit specified in Art. 79(2) has expired earlier. Under Rule 107(1)(f), the request for examination must also be filed within this period, if the time limit specified in Art. 94(2) has expired earlier. Where a supplementary European search report needs to be drawn up, a search fee must also be paid to the EPO within this period. Failure to pay in due time the national basic fee, the search fee or a designation fee, or to file the request for examination, means that the application is deemed to be withdrawn. Any designation of a Contracting State for which the designation fee has not been paid in due time is deemed to be withdrawn. If the EPO finds that the application or the designation of a Contracting State is deemed to be withdrawn for this reason, it communicates this to the applicant (Rule 108(3)). However, if the applicant used Form 1200 for Entry into the European phase, a communication pursuant to Rule 108(3) is issued only where, contrary to his originally declared intention in Form 1200, he has failed to pay designation fees for States for which he had indicated his intention to pay. If no Rule 108(3) communication is to be issued, there is an additional period of two months from expiry of the applicable time limit for payment of designation fees with surcharge (Rule 108(4)). Where a Rule 108(3) communication is issued Rule 69(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 omitted act is completed and a surcharge under Art. 2, No. 3c, RFees is paid. Any loss of rights ensues on expiry of the normal period (G 4/98, OJ 3/2001, 131). For the exclusion of the re-establishment of rights, see E-VIII, 2.2.4.

Rule 110

If applicable, the claims fees under Rule 110 must also be paid within the normal period referred to above. If they are not, they may still be validly paid within a non-extendable period of grace of one month of notification of a communication pointing out the failure to pay. If amended claims are filed during this grace period, they form the basis for calculating the number of claims fees due. Where a claims fee has not been paid in time, the claim concerned is deemed to be abandoned. Features of a claim deemed to have been abandoned pursuant to Rule 110(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.

1.4 PCT vs. EPC provisions

Art. 150(2)

In proceedings before the EPO relating to international applications, the provisions of the PCT are applied, supplemented by the provisions of the

EPC. In case of conflict, the provisions of the PCT prevail. The EPO cannot require compliance with requirements relating to form or contents of the international application different from or additional to those which are provided for in the PCT. As a result of the overriding PCT provisions and the requirements of Part X of the EPC, i.e. Art. 150 to 158, relating to international applications pursuant to the PCT, the practice set out in the earlier Chapters of this Part A of the Guidelines does not necessarily hold good for international applications. In particular, where the PCT international publication was in an official EPO language, it is not necessary for the Receiving Section to subject the copy of the application furnished to the EPO to a formalities examination except to the extent indicated later. On the other hand, where it is necessary to furnish a translation of the international application, the Receiving Section must carry out for that translation a more extensive formalities examination.

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

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

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

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

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

The date of filing (see II, 4 ("Examination on filing")) of a Euro-PCT application is that accorded under the PCT by the PCT authority which acted as the receiving Office. Nevertheless, the payment of the filing fee (i.e. the "national basic fee" as it is called for a Euro-PCT application entering the European phase as part of the "national fee" (see Art. 158(2) and Rule 106)) and the search fee and, where applicable, the supply of a translation pursuant to Art. 158(2) should be checked. The period for supplying the translation and for payment of the above-mentioned fees is as specified in VII, 1.2 and 1.3.

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

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

3.1 Representation

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

get a European patent, Part 2: PCT procedure before the EPO – Euro-PCT", April 2002.

3.2 Physical requirements

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

3.3 Request for grant

The request for grant (see III, 4 ("Request for grant")) for international applications will appear on the PCT Request form (Form PCT/RO/101). This form corresponds in general to the EPO Request for Grant form (Form 1001) and provides for the entry of the information listed in Rule 26(2), with the exception of the items referred to in sub-paragraphs (e) and (f) thereof.

3.4 Designation of inventor

Rule 111(1)

The requirement, as set out in III, 5 ("Designation of inventor"), that the designation of inventor is filed in a separate document where the applicant is not the inventor or the sole inventor has to be complied with irrespective of the language of the international application, unless the inventor has already been named in the PCT request. Where the inventor has been named in the PCT request, he cannot waive his right to be mentioned in the published application. If the inventor has not been named in the international application at the expiry of the period of 31 months from the date of filing, or, in the case of priority, from the earliest date of priority claimed, the EPO invites the applicant to file the designation of inventor within a specified period.

3.5 Claim to priority

Rule 17.1 PCT Rule 17.2 PCT

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

Rule 111(2)

Where the file number or the copy of the previous application has not yet been submitted at the expiry of the period of 31 months, the EPO invites the applicant to furnish the number or the copy within a specified period. However, Rule 38(4) and the Decision of the President of the EPO dated 9 March 2000, OJ 5/2000, 227, providing an exception to the requirement that a copy of the previous application be furnished (see III, 6.7), also apply to international applications entering the European phase. Furthermore, as just mentioned, where the applicant has complied with Rule 17.1(a) or (b) PCT the EPO as a designated Office may not ask the

applicant himself to furnish it with a copy of the priority document (Rule 17.2(a) PCT, second sentence).

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

Where a translation of the previous application into one of the official languages of the EPO is required, it must be filed in accordance with Rule 38(5) (see III, 6.8 and 6.10);

Art. 88(1)
Rule 38(5)

3.6 Title of the invention

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

3.7 Prohibited matter

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

3.8 Claims fee

The time limit for paying the claims fee referred to in III, 9 is, as indicated in VII, 1.3, 31 months from the date of filing or, if priority has been claimed, from the earliest priority date (Rule 110(1)).

3.9 Drawings

The provisions of III, 10 ("Filing of drawings") with regard to the filing of drawings are identical with the corresponding provisions of Art. 14(2) PCT and therefore no supplementary examination should be necessary.

3.10 Abstract

The abstract (see III, 11 ("Abstract")) is included in the copy of the international application supplied to the EPO.

3.11 Designation fee

The time limit for paying the designation fee which, as already indicated, forms part of the "national fee" is 31 months from the date of filing or, if priority has been claimed, from the earliest priority date, if the time limit specified in Art. 79(2) has expired earlier (Rule 107(1)(d)) (see III, 12.10 for further details). If, subsequent to the receipt of the international application by the EPO and prior to the date on which processing or examination may start, the regional designation of all Contracting States of the EPC is withdrawn, the Euro-PCT application, insofar as it is deemed to be a European application pursuant to Art. 150(3), is deemed to be withdrawn.

For information on the requirements for extension of a Euro-PCT application to States for which an Extension Agreement with the EPO has become effective, see III, 13.

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

4.1 Divisional applications

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

4.2 Sequence listings

Rules 5.2 and 13ter PCT apply to the filing of sequence listings (see IV, 5 ("Applications relating to nucleotide and amino acid sequences")). The EPO as International Searching Authority (see E-IX, 3) makes use of the opportunity under Rule 13ter.1 PCT to invite the applicant where appropriate to furnish it with the prescribed sequence listing in electronic form. WIPO Standard ST. 25, paragraph 39 ff, applies (see Art. 4 of the Decision of the President of the EPO dated 2 October 1998 together with the accompanying Notice from the EPO (point III), Supplement No. 2 to OJ 11/1998).

Rule 111(3)

If a sequence listing is filed subsequently on entry of a Euro-PCT application into the European phase, Rule 111(3) will apply (see point IV of the above mentioned Notice).

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

5.1 Publication of the international application

Art. 158(1)
Art. 158(3)

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

5.2 Request for examination

Art. 157(1)
Art. 150(2)
Rule 107(1)(f)

The time limit for filing the request for examination referred to in VI, 2 runs from the date of publication under Art. 21 PCT of the international search report. However, this time limit will not expire before the time prescribed by Rule 107(1)(f) (31 months from the priority date). See also VII, 1.3.

5.3 Supplementary European search

Art. 96(1)

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 Art. 96(1) (see VI, 2.3, 2nd paragraph, and J 8/83, OJ 4/1985, 102).

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

See XI, 9.3 and 10.2.

CHAPTER VIII**LANGUAGES****1. Provisions concerning the language of the proceedings****1.1 Admissible languages; time limit for filing the translation of the application**

European patent applications must be filed in one of the official languages of the EPO, viz. English, French or German. However, a person having his residence or principal place of business in a Contracting State which has an official language other than English, French or German (the EPO official languages), or a national of such a State who is resident abroad, may file his European patent application initially in that language (admissible non-EPO language). This means, for example, that a Belgian company may file in Dutch, and that a Swedish national may file in the Swedish language. In such a case, a translation in English, French or German must be filed within three months after the initial filing, but if the application claims priority, the translation must be supplied not later than thirteen months after the earliest priority date, which could mean within one month of the initial filing of the European application). Such translation may be subsequently brought into conformity with the original text of the application (but see VIII, 5.2). If the translation is not filed in time, the application is deemed withdrawn. Under Art. 122 the legal remedy of re-establishment of rights is available.

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

1.2 Language of the proceedings

The language (chosen from English, French or German) in which the application is filed, or into which it is subsequently translated, constitutes the "language of the proceedings". Amendments to a European patent application or European patent must be filed in the language of the proceedings. This language is also used by the EPO in written proceedings. (As regards documents which are not filed in the correct language, see VIII, 3 below).

Art. 14(3)
Rule 1(2)

1.3 European divisional applications; Art. 61 applications

Any European divisional application must be filed in the language of the proceedings of the earlier application from which it is divided. However, where advantage is taken of Art. 14(2), the divisional application may be filed in the official language of the applicant's State (admissible non-EPO language, see VIII, 1.1) used for the earlier application but must then be translated into the language of the proceedings for the earlier application. The period for filing the translation is one month from the filing of the divisional application if that period expires later than the period referred to in Rule 6(1), first sentence (see VIII, 1.1); the same period applies for a new European patent application filed under Art. 61(1)(b).

Rule 4
Rule 6(1)

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

In written proceedings before the EPO any party may use any official language of the EPO. However, in such proceedings the EPO uses the language of the proceedings in the sense of Art. 14(3). If a document which has to be filed within a time limit is filed by the persons referred to in Art. 14(2) in an admissible non-EPO language (see VIII, 1.1), the prescribed translation may be filed in any of the official languages of the

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

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

2a. Documents to be used as evidence

Rule 1(3)

Documents which are to be used as evidence may be filed in any language. This applies during any proceedings before the EPO and applies especially to publications (for instance, an extract from a Russian periodical cited by an opponent to show lack of novelty or lack of inventive step). However, the department dealing with the case may require a translation in one of the languages of the EPO, at the choice of the person filing the document. If the document is filed by the applicant in pre-grant proceedings, the EPO should require a translation, unless the examiners are fully competent in the language concerned. In most cases, however, such documents will be filed in opposition proceedings and a translation should be required. The department concerned may require this translation to be filed within a time limit. This is to be fixed on a case-by-case basis. The period allowed must not be less than one month and should depend on the particular language concerned and on the length of the document to be translated.

3. Documents filed in the wrong language

3.1 Documents making up a European patent application

Art. 78(1)
Art. 80

As explained in VIII, 1.1, all the documents making up a European application (i.e. those listed in II, 4.1) must be filed in one of the languages referred to in Art. 14(1) and (2). If the description and claims are not filed in one of these languages, a date of filing cannot be accorded (Art. 80(d), see also J 9/01, not published in OJ). This is particularly the case when the application is wrongly filed in an admissible non-EPO language (for instance in Italian by an applicant who is resident in Sweden and is not an Italian national).

3.2 Other documents

Art. 14(5)
Rule 1(1), (2)
Art. 14(2)

If any document other than those making up the application (e.g. a letter from the applicant in reply to an invitation under Art. 96(2)) is not filed in one of the prescribed languages or, where the applicant avails himself of Art. 14(2), the required translation is not filed in due time, it is deemed not to have been received. The person who has filed the document must be notified accordingly by the EPO. Accompanying documents relating to performance of a procedural act subject to a time limit (e.g. filing the designation of the inventor, the certified copy of the earlier application for which priority is claimed or that application's translation under Rule 38(5) into one of the official languages of the EPO) are dealt with as follows: if the European application number is given, the document goes into the dossier and the procedural act is recognised as having been performed, but any other contents are ignored. Regarding the signature of accompanying documents, see IX, 3.1.

Art. 115(1)

According to Art. 115(1), following the publication of the European patent application, any person may file observations in writing concerning the patentability of the invention in respect of which the application has been filed. These written observations must be filed in English, French or German. Otherwise, they are deemed not to have been received.

Even though deemed not to have been received, the document not filed in the prescribed language will become part of the file and therefore accessible to the public according to Art. 128(4). Observations by third parties and notices of oppositions will be communicated to the applicant or the patent proprietor, respectively, even if they have not been filed in the prescribed language (see E-VI, 3 and D-IV, 1.1, cf. Rule 56(1) and D-IV, 1.2.1 (v) regarding the legal consequences where a notice of opposition or notice of intervention of the assumed infringer is filed in a non-prescribed language, and Rule 65(1) in the case of appeals by the opponent or the intervening infringer filed in a non-prescribed language).

Art. 128(4)

4. Translation of the priority document

This point is dealt with in III, 6.8 and 6.10 and C-V, 3.3.

5. Authentic text

5.1 General remark

The text of an application or patent in the language of the proceedings is the authentic text. It follows therefore that the translation of the claims of the patent specification required by Art. 14(7) is for information only.

Art. 70(1)

5.2 Conformity of translation with the original text

Where the facility provided for by Art. 14(2) has been used and the question arises as to whether a particular amendment proposed by the applicant or proprietor extends the content of the application or patent beyond the content of the application as filed and thus offends against Art. 123(2), the EPO should normally assume, in the absence of proof to the contrary, that the original translation into English, French or German is in conformity with the text in the original language, say Dutch. However, it is the original text which constitutes the basis for determining such a question. Similarly, it is the original text which determines the content of the application as filed for the purposes of Art. 54(3) (see C-IV, 6.1). An erroneous translation from Dutch or one of the other languages covered by Art. 14(2) may be brought into conformity with the original language at any time during proceedings before the EPO, i.e. during pre-grant proceedings and also during opposition proceedings. But during opposition proceedings any amendment to bring the translation into conformity must not be allowed if it offends against Art. 123(3), that is if it is an amendment of the claims of the patent which extends the protection conferred.

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

6. Certificate of translation

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

Rule 5

Certificates are not in principle required in respect of the translations of the claims into the other two official languages required under Rule 51(4).

Rule 51(4)

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

Rule 2

These derogations are dealt with in E-V.

CHAPTER IX**COMMON PROVISIONS****1. Representation****1.1 Representation by a professional representative**

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

Art. 133(1)
Art. 91(1)(a)
Art. 133(2)
Rule 101(1)

1.2 Representation by an employee

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

Art. 133(3)
Art. 134(1)
Rule 101(1)

1.3 Common representative

Joint applicants, joint proprietors of patents and more than one person giving joint notice of opposition or intervention may act only through a common representative. If the request for the grant of a European patent, the notice of opposition or the request for intervention does not name a common representative, the party first named in the relevant document will be considered to be the common representative. This representative can thus be a legal person. However, if one of the parties is obliged to appoint a professional representative this representative will be considered to be the common representative, unless the first named party in the document has appointed a professional representative. If during the course of proceedings transfer is made to more than one person, and

Art. 133(4)
Rule 100(1)

such persons have not appointed a common representative, the preceding provisions will apply. If such application is not possible, the EPO will require such persons to appoint a common representative within two months. If this request is not complied with, the EPO will appoint the common representative.

For Rule 100 to apply, each party or his duly authorised representative must have signed the document (request for grant, notice of opposition, etc.) giving rise to his participation (see also III, 4.2.2 and IX, 3.2 and 3.4). Otherwise the party cannot take part in the proceedings, nor therefore be represented by a common representative.

1.4 List of professional representatives; legal practitioners

Art. 134(1)
Art. 134(7)

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

1.5 Signed authorisation

Rule 101(1)

Representatives acting before the EPO must on request file a signed authorisation (see IX, 3.2) within a period to be specified by the EPO. If the requirements of Art. 133(2) are not fulfilled, the same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. Professional representatives who identify themselves as such will be required to file a signed authorisation only in certain cases (see the Decision of the President of the EPO, OJ 9/1991, 489). However, a legal practitioner entitled to act as a professional representative in accordance with Art. 134(7) or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, must file a signed authorisation; in Euro-PCT proceedings, persons representing clients in these capacities are not required to file signed authorisations if they have already filed an authorisation expressly covering proceedings established by the EPC with the EPO as receiving Office.

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

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

1.6 General authorisation

Art. 133(2)
Rule 101(2)
Rule 101(5), (6), (7)

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

1.7 Invitation to file authorisation

Where the appointment of a legal practitioner entitled to act as professional representative in accordance with Art. 134(7), or an employee acting for an applicant in accordance with Art. 133(3), first sentence, but who is not a professional representative, is communicated to the EPO without an authorisation being filed, the representative is invited to file the authorisation within a period to be specified by the EPO. Where a party having neither residence nor principal place of business within a Contracting State has failed to fulfil the requirements of Art. 133(2) (cf. IX, 1.1), the invitation will be sent to him. The same period will be specified for the communication of the appointment and, where applicable, for the filing of the authorisation. The period may be extended in accordance with Rule 84 on request by the representative or party as the case may be (see E-VIII, 1.6). If such authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application will, without prejudice to any other legal consequences provided for in the EPC, be deemed not to have been taken. The party is informed accordingly.

Rule 101(1)
Rule 84
Rule 101(4)

2. Form of documents

2.1 Documents making up the European patent application

The physical requirements which the documents making up the European patent application, i.e. request, description, claims, drawings and abstract, must satisfy are set out in Rule 35 and with regard to drawings in Rule 32. Notes on the preparation of OCR-readable patent applications were published in OJ 1-2/1993, 59. In relation to the drawings, the particular requirements are dealt with in Chapter X. The latter Chapter should, however, also be consulted with regard to the other documents mentioned, as the comments therein on the provisions of Rule 35 are of general application. Here, attention need only be drawn to Rule 35(9) which states that "the lines of each sheet of the description and of the claims shall preferably be numbered in sets of five, the numbers appearing on the left side, to the right of the margin".

2.2 Replacement documents and translations

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

Rule 35(1)
Rule 36(1)

2.3 Other documents

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

Rule 36(2)

2.4 Number of copies

Such documents as must be communicated to other persons or as relate to two or more European patent applications or European patents must be filed in a sufficient number of copies so that each party will have a document for each application or patent. If within a short period, which should be set at two to four weeks, the party concerned does not comply with this obligation in spite of a request by the EPO, the missing copies will be provided at the expense of the party concerned.

Rule 36(4)

2.5 Filing of subsequent documents

Rule 36(5)

After a European patent application has been filed, documents as referred to in Rule 36, may be filed directly or by post or, with the exception of authorisations and priority documents, may be filed by facsimile at the EPO's filing offices (see II, 1.1). Such documents may not be filed on diskette, by teleteX, by e-mail, telegram, telex or similar means (see also the Notice dated 12 September 2000 concerning correspondence with the Office via e-mail, OJ 10/2000, 458). If documents relating to European patent applications are filed by facsimile, at the request of the EPO department charged with the procedure, written confirmation reproducing the contents of the documents filed by these means and complying with the requirements of the Implementing Regulations to the EPC must be supplied within a non-extendable period of one month. If the applicant fails to comply with this request in due time, the facsimile is deemed not to have been received (cf. the Decision of the President of the EPO, OJ 1/2005, 41).

Written confirmation is required if

the documents so communicated are of inferior quality

(cf. Notice from the EPO, OJ 1/2005, 44).

Art. 14(4)
Rule 6(2)
Art. 122

If in a facsimile a party avails himself of Art. 14(4), the subsequent copy must be filed in the same language as the facsimile, in which case the copy is deemed to have been received on the date of filing of the facsimile. The period under Rule 6(2) for filing the translation under Art. 14(4) begins on the day following the date of filing of the facsimile. Re-establishment of rights may be requested in respect of the periods under Rules 36(5) and 6(2).

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

3. Signature of documents

3.1 Documents filed after filing the European patent application

Rule 36(3)
Art. 133

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

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

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

Rule 36(3)

3.2 Documents forming part of the European patent application

In addition to the documents referred to in IX, 3.1 above, certain documents forming part of the application must be signed. These documents include the request for grant, the designation of the inventor and, where applicable, the authorisation of a representative. In the case of electronic filing of a European patent application, a facsimile image of the signer's handwritten signature, an electronic signature or an enhanced electronic signature may be used to sign the afore-mentioned documents (Notice dated 29 October 2002, point 4, OJ 11/2002, 545).

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

3.3 Form of signature

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

Where a document is filed by facsimile, the reproduction on the facsimile of the signature of the person filing the document will be considered sufficient. The name and position of that person must be clear from the signature (cf. Notice of the EPO, OJ 1/2005, 44).

3.4 Joint applicants

If there is more than one applicant (see IX, 1.3), each applicant or his representative must sign the request for grant and, where applicable, the appointment of the common representative. This also applies if one of the applicants is considered the common representative pursuant to Rule 100(1), first sentence. However, the common representative may sign the designation of inventor and all documents filed after the filing of the application pursuant to Rule 36(3). Authorisations on behalf of more than one applicant must be signed by all applicants.

Rule 100(1)

CHAPTER X**DRAWINGS**

This Chapter of the Guidelines deals with the requirements to be met by drawings contained in the application or patent. However, it should be noted that the comments on the provisions of Rule 35 apply generally to the documents making up the European patent application and documents replacing them.

Rule 35
Rule 36

1. Graphic forms of presentation considered as drawings**1.1 Technical drawings**

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

Rule 32(3)

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

Rule 35(11)

1.2 Photographs

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

2. Representation of drawings**2.1 Grouping of drawings**

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

Rule 35(11)

2.2 Reproducibility of drawings

In accordance with Rule 35(3) the drawings must be so presented as to admit of electronic as well as of direct reproduction by scanning, photography, electrostatic processes, photo offset and micro-filming, in an unlimited number of copies.

Rule 35(3)

2.3 Figure accompanying the abstract

As regards the figure, or exceptionally figures, to accompany the abstract, where a European patent application contains drawings, reference should be made to III, 11.3 and B-XI, 3(vi) and 4. The figure(s) illustrating the abstract must be the figure(s) most representative of the invention and must be chosen from the drawings accompanying the application. It is

therefore not permissible to draw a special figure for the abstract which differs from the other figures in the application.

3. Conditions regarding the paper used

Rule 35(4) Drawings must be on sheets of A4 paper (29.7 cm x 21 cm) which must be pliable, strong, white, smooth, matt and durable (recommended paper weight: 80-120 g/m², see OJ 1-2/1994, 74).

Rule 35(3) All sheets must be free from cracks, creases and folds. Only one side of the sheet may be used. The use of card is not allowed.

Rule 35(14) Each sheet must be reasonably free from erasures and must be free from alterations, overwritings and interlineations. Non-compliance with this rule may be authorised if the authenticity of the content is not in question and the requirements for good reproduction are not in jeopardy.

Any corrections made must be durable and permanent, so that they cannot give rise to any doubt. They must be made on all copies of the application. Special products for corrections, such as white masking fluid, may be used, provided they are indelible and comply with the other requirements under Rule 35(14).

Rule 35(5) The sheets must be connected in such a way that they can easily be turned over, separated and joined together again.

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

4. Presentation of the sheets of drawings

4.1 Usable surface area of sheets

Rule 32(1) On sheets containing drawings, the usable surface area may not exceed 26.2 cm x 17 cm. These sheets may not contain frames round the usable or used surface. The minimum margins are as follows: top side: 2.5 cm; left side: 2.5 cm; right side: 1.5 cm; bottom: 1 cm.

Rule 35(7) Under Rule 35(7), no entries may be made in the margins. The drawings must be so set out that they do not overlap into the minimum margin defined in Rule 32(1).

4.2 Numbering of sheets of drawings

Rule 35(8) All the sheets contained in the European patent application must be numbered in consecutive Arabic numerals. These must be placed at the top of the sheet, in the middle, but not in the top margin.

Rule 32(1) The sheets of drawings must be numbered within the maximum usable surface area as defined in Rule 32(1). Instead of numbering the sheet in the middle, it will, however, be acceptable for it to be numbered towards the right-hand side if the drawing comes too close to the middle of the edge of the usable surface. This numbering should be clear, for example in numbers larger than those used for reference numbers.

Rule 35(5) Rule 35(8) requires all application sheets to be numbered consecutively. According to Rule 35(5), the application consists of all the following documents: the request, the description, the claims, the drawings and the abstract. The numbering should preferably be effected by using three

separate series of numbering each beginning with one, the first series applying to the request only and being already printed on the form to be used, the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract, and the third series being applicable only to the sheets of the drawings and commencing with the first sheet of such drawings.

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

5. General layout of drawings

The various figures on the same sheet of drawings must be laid out according to certain requirements as to page-setting and numbering, and figures divided into several parts must comply with particular requirements.

5.1 Page-setting

As far as possible all figures of the drawings should be set out upright on the sheets. If a figure is broader than it is high, it may be set out so that the top and bottom of the figure lie along the sides of the sheet with the top of the figure on the left side of the sheet.

Rule 32(2)(h)

In this case, if other figures are drawn on the same sheet, they should be set out in the same way, so that all the figures on a single sheet lie along parallel axes.

Where the sheet has to be turned in order to read the figures, the numbering should appear on the right-hand side of the sheet.

5.2 Numbering of figures

The different figures must be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.

Rule 32(2)(h)

This numbering should be preceded by the abbreviation "FIG", whatever the official language of the application. Where a single figure is sufficient to illustrate the invention, it should not be numbered and the abbreviation "FIG" must not appear. Rule 32(2)(d) also applies to numbers and letters identifying the figures, i.e. they must be simple and clear and may not be used in association with brackets, circles, or inverted commas. They should also be larger than the numbers used for reference signs.

Rule 32(2)(d)

An exception to Rule 32(2)(h) referred to above may be permitted only as regards partial figures intended to form one whole figure, irrespective of whether they appear on one or several sheets. In this case the whole figure may be identified by the same number followed by a capital letter (e.g. FIG 7A, FIG 7B).

5.3 Whole figure

Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures.

Rule 32(2)(h)

Partial figures drawn on separate sheets must always be capable of being linked edge to edge, that is to say no figure may contain parts of another.

The case may arise where the parts of a whole figure are drawn on a single sheet following a layout different from that of the whole figure, e.g. a very long figure divided into several parts placed one above the other and not next to one another on a sheet. This practice is permitted. However, the relationship between the different figures must be clear and unambiguous. It is therefore recommended that a scaled-down figure be included showing the whole formed by the partial figures and indicating the positions of the sections shown.

6. Prohibited matter

Rule 34(1)
Rule 34(2) The provisions as to the omission of prohibited matter within the meaning of Rule 34(1)(a) (see III, 8.1 and C-II, 7.2) also apply to drawings.

Rule 34(1)(c) Statements or other matter of the type referred to under Rule 34(1)(c) (see C-II, 7.4) which are likely to appear in drawings are in particular various kinds of advertising, e.g. where the applicant includes in the drawing obvious business or departmental markings or a reference to an industrial design or model, whether registered or not. By doing so, matter would be introduced which is clearly irrelevant or unnecessary, which is expressly prohibited by Rule 34.

7. Executing of drawings

7.1 Drawings of lines and strokes

Rule 32(2)(a)
Rule 35(3) Rule 32(2)(a) sets certain standards for lines and strokes in the drawing, to permit satisfactory reproduction by the various means described in Rule 35(3).

The drawings must be executed in black.

Heliographic prints seldom satisfy the requirements for drawings and it is therefore strongly advised that copies of this type should not be filed.

In all cases the thickness of the lines and strokes must take into account the scale, nature, execution and perfect legibility of the drawing and of the reproductions.

Rule 32(2)(e) All lines must be drawn with the aid of drafting instruments save those for which no instrument exists, e.g. irregular diagrams and structures.

7.2 Shading

The use of shading in figures is allowed provided this assists in their understanding and is not so extensive as to impede legibility.

7.3 Cross-sections

7.3.1 Sectional diagrams

Where the figure is a cross-section on another figure, the latter should indicate the position and may indicate the viewing direction.

Each sectional figure should be capable of being quickly identified, especially where several cross-sections are made on the same figure, e.g. by inscribing the words "Section on AB", or to avoid the use of lettering, by marking each end of the cross-section line on the diagram with a single Roman numeral. This number will be the same as the (Arabic) numeral

identifying the figure where the section is illustrated. For example: "Figure 22 illustrates a section taken along the line XXII-XXII of Figure 21".

7.3.2 Hatching

A cross-section must be set out and drawn in the same manner as a normal view whose parts in cross-section are hatched with regularly spaced strokes, the space between strokes being chosen on the basis of the total area to be hatched.

Rule 32(2)(b)

Hatching should not impede the clear reading of the reference signs and leading lines. Consequently, if it is not possible to place references outside the hatched area, the hatching may be broken off wherever references are inserted. Certain types of hatching may be given a specific meaning.

7.4 Scale of drawings

If the scale of the figure is such that all the essential details would not be clearly distinguished if the figure is reproduced, electronically or photographically, with a linear reduction in size to two-thirds, then the figure must be redrawn to a larger scale, and if necessary the figure should be split up into partial figures so that a linear reduction in size to two-thirds is still intelligible.

Rule 32(2)(c)

The graphic representation of the scale of drawings in cases where its inclusion is considered useful must be such that it is still usable when the drawing is reproduced in reduced format. This excludes indications of size such as "actual size" or "scale 1/2", both on the drawings and in the description, in favour of graphic representations of the scale.

7.5 Numbers, letters and reference signs

Numbers, letters and reference signs and any other data given on the sheets of drawings, such as the numbering of figures, pages of the drawing, acceptable text matter, graduations on scales, etc., must be simple and clear, and not used in association with any brackets, inverted commas, circles or outlines whatsoever. Signs such as 6' and 35" are not regarded as including inverted commas and are therefore permitted.

Rule 32(2)(d)

Numbers, letters and reference signs should preferably all be laid out the same way up as the diagram so as to avoid having to rotate the page.

7.5.1 Leading lines

Leading lines are lines between reference signs and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference sign and extend at least as far as the features indicated.

Leading lines must be executed in the same way as lines in the drawing, viz. in accordance with Rule 32(2)(a).

Rule 32(2)(a)

7.5.2 Arrows

Arrows may be used at the end of the leading lines provided that their meaning is clear. They may indicate a number of points:

- (i) a freestanding arrow indicates the entire section towards which it points;

- (ii) an arrow touching a line indicates the surface shown by the line looking along the direction of the arrow.

7.5.3 Height of the numbers and letters in the drawings

Rule 32(2)(g)

Under Rule 32(2)(g), a minimum size of 0.32 cm is required for all numbers and letters used on the drawings so that their reduction in size to two-thirds remains easily legible.

The Latin alphabet should normally be used for letters. The Greek alphabet is to be accepted however where it is customarily used, e.g. to indicate angles, wavelengths, etc.

7.5.4 Consistent use of reference signs as between description, claims and drawings

Rule 32(2)(i)

Reference signs not mentioned in the description and claims may not appear in the drawing, and vice versa.

Reference signs appearing in the drawing must be given in the description and the claims taken as a whole. As regards use of these signs in the claims, reference should be made to C-III, 4.11

Rule 35(14)

Features of a drawing should not be designated by a reference in cases where the feature itself has not been described. This situation may arise as a result of amendments to the description involving the deletion of pages or whole paragraphs. One solution would be to strike out on the drawing reference signs which have been deleted in the description. Such corrections would have to be made in accordance with Rule 35(14).

Where for any reason a figure is deleted then of course the applicant or proprietor ought to delete all reference signs relating solely to that figure appearing in the description and claims.

In the case of applications dealing with complex subjects and incorporating a large number of drawings, a reference key may be attached to the end of the description. This key may take whatever form is appropriate and contain all the reference signs together with the designation of the features which they indicate. This method could have the advantage of standardising the terminology used in the description.

7.5.5 Consistent use of reference signs as between drawings

Rule 32(2)(i)

The same features, when denoted by reference signs, must, throughout the application, be denoted by the same signs.

There would be considerable confusion if a single feature were allocated different reference signs in the various drawings. However, where several variants of an invention are described, each with reference to a particular figure, and where each variant contains features whose function is the same or basically the same, the features may, if this is indicated in the description, be identified by reference numbers made up of the number of the figure to which it relates followed by the number of the feature, which is the same for all variants, so that a single number is formed, e.g. the common feature "15" would be indicated by "115" in Fig. 1 while the corresponding feature would be indicated by "215" in Fig. 2. This system has the advantage that an individual feature and the figure on which it is to be considered can be indicated at the same time. It can also make complex cases involving many pages of drawings easier to read. Instead of the common reference sign being prefixed by the number of a figure, it

may, when the individual variants are described with reference to particular groups of figures, be prefixed by the number of the particular variant to which it relates; this should be explained in the description.

7.6 Variations in proportions

Elements of the same figure must be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure. Rule 32(2)(f)

As a preferred alternative to a difference in proportion within one figure for the purpose of achieving the necessary clarity, a supplementary figure may be added giving a larger-scale illustration of the element of the initial figure. In such cases it is recommended that the enlarged element shown in the second figure be surrounded by a finely drawn or "dot-dash" circle in the first figure pinpointing its location without obscuring the figure.

8. Text matter on drawings

It should first be noted that Rule 32(2)(d) and (g) also applies to text matter on the drawings. Rule 32(2)(d)
Rule 32(2)(g)

For indications of the type "section on AB", see X, 7.3.1.

The drawings must not contain text matter, except, when absolutely indispensable, a single word or a few words. Rule 32(2)(j)

Where text matter is deemed indispensable for understanding the drawing, a minimum of words should be used, and a space free of all lines of drawings should be left around them for the translation.

As regards the justification for text matter on drawings, see C-II, 5.1.

9. Conventional symbols

Known devices may be illustrated by symbols which have a universally recognised conventional meaning, provided no further detail is essential for understanding the subject-matter of the invention. Other signs and symbols may be used on condition that they are not likely to be confused with existing conventional symbols, that they are readily identifiable, i.e. simple, and providing that they are clearly explained in the text of the description.

Rule 35(12)

Different types of hatching may also have different conventional meanings as regards the nature of a material seen in cross-section.

10. Amendments to drawings

Amendments of the drawings are permitted, as well as of the other documents. These amendments may be made at the request of the party concerned or at the request of the EPO. The amendments may concern either clerical errors or more substantial changes.

Amendments to drawings are, in general, subject to the same rules as apply in respect of amendments to other application documents and therefore do not require further analysis here. Reference may be made to III, 14; V, 2; C-VI, 3.2, 4.6, 4.7 and 5; and E-II.

Art. 123(2) The general rule governing the admissibility of amendments, which the examiner must always bear in mind, is that they must not extend the content of the application as filed, i.e. they must not have the effect of introducing new material.

If drawings which depart substantially from the physical requirements laid down in the Rules are filed in order to establish a particular date of filing or retain a priority date, the Receiving Section will permit such drawings to be amended or replaced so as to provide drawings complying with the Rules, provided that it is clear that no new material is thereby introduced into the application. In view of this proviso, applicants should take care that any "informal" drawings which they file clearly show all the features necessary to illustrate the invention.

11. Graphic forms of presentation not considered as drawings

11.1 Chemical and mathematical formulae

Rule 35(10) Chemical or mathematical formulae may be written by hand or drawn if necessary, but it is recommended that appropriate aids such as stencils or transfers be used. For practical reasons, formulae may be grouped together on one or more sheets annexed to the description and paginated with it. It is recommended in such cases that each formula be designated by a reference sign and the description should contain references to these formulae whenever necessary.

Rule 35(13) The chemical or mathematical formulae must employ symbols in general use and must be drawn in such a way that they are completely unambiguous. Figures, letters and signs which are not typed must be legible and identical in form in the various formulae, irrespective of the document in which they appear.

Rule 35(10)
Rule 32(2)(g) Chemical or mathematical formulae appearing in the text of the application or patent must have symbols, the capital letters of which are at least 0.21 cm high. Where they appear on sheets of drawings, these symbols must be at least 0.32 cm high.

All mathematical symbols used in a formula which appears in a description, in an annex or on sheets of drawings must be explained in the description, unless their significance is clear from the context. In any case, the mathematical symbols used may be collated in a list.

11.2 Tables

11.2.1 Tables in the description

Rule 35(11) For the sake of convenience, the tables may also be grouped together in one or more sheets annexed to the description and paginated with it.

If two or more tables are necessary, each should be identified by a Roman number, independently of the pagination of the description or drawings or of the figure numbering, or by a capital letter, or by a title indicating its contents, or by some other means.

Each line or column in a table must begin with an entry explaining what it represents and, if necessary, the units used.

Rule 35(10)
Rule 35(6) It should be remembered that the characters must satisfy the requirements of Rule 35(10) and that Rule 35(6) regarding the maximum usable surface areas of sheets applies to tables as well.

11.2.2 Tables in the claims

The claims may include tables if this is desirable in view of the subject-matter involved. In this case, the tables must be included in the text of the relevant claim; they may not be annexed to the claims nor may reference be made to tables contained in or annexed to the description. Rule 29(6) stipulates that the claims may refer to other application documents only where this is absolutely necessary (see C-III, 4.10). The mere desire to eliminate the need to prepare further copies does not constitute absolute necessity.

Rule 35(11)

CHAPTER XI**FEES****1. General**

Various fees have to be paid for a European patent application, renewing a European patent and obtaining legal remedies. Fees may also need to be paid by third parties, such as for applications to inspect the files of European patent applications or European patents. Fees may be validly paid by any person (see Legal Advice No. 6/91 rev., OJ 11/1991, 573). The amounts of the fees, the ways in which they are to be paid and the date of payment are determined in the Rules relating to Fees (RFees). Guidance for the payment of fees, costs and prices with information about:

- the current version of the Rules relating to Fees and the schedule of fees;
- important implementing rules to the Rules relating to Fees;
- the payment and refund of fees and costs;
- other notices concerning fees and prices; and
- international applications, including Euro-PCT applications entering the European phase,

as well as the amounts of the principal fees for European and international applications and an extract from the Rules relating to Fees is published at regular intervals in the Official Journal. A list of bank and giro accounts opened in the name of the European Patent Organisation for payment appears each month on the inside back cover.

The EPC lays down the time limits for paying fees and the legal consequences of non-compliance with the time limits. The time limits for payment and the legal consequences of non-payment are dealt with in the Chapters of the Guidelines covering the respective stages of the procedure. The methods of payment, the date on which payment is considered to be made, due dates, particulars concerning the purpose of payments and reimbursement of fees are all dealt with below.

2. Methods of payment

Art. 5 RFees

Fees may be paid in the following ways:

- ⊞ (i) by payment or transfer to a bank or giro account held by the EPO;
- (ii) by delivery or remittance of cheques made payable to the EPO;
- (iii) by debiting a deposit account opened in the records of the EPO in Munich (see XI, 3.3 and 3.4);

Neither the PCT, nor the EPC allows for payment of any fee due by way of compensation (offset) with any fee to be refunded.

By way of exception, certain fees and costs at the Munich Information Office, namely for photocopies made by the EPO staff or by the requester in the course of file inspection or for purchases of patent information products, other copies of EPO documents and publications, may also be paid by credit card (Decision of the President of the EPO dated 21 January 2002, OJ 3/2002, 162).

2a. Currencies

Art. 5 RFees
Point 3 ADA

The fees due to the EPO shall be paid in euro. A debit order shall be in euro.

3. Date considered as date on which payment is made

3.1 Payment or transfer to a bank or giro account held by the European Patent Organisation

Art. 8(1)(a) RFees
Art. 8(3), (4) RFees

The date on which the amount is actually entered in the European Patent Organisation's bank account is considered as the date on which payment is made. It is therefore also possible for the day following the inpayment or transfer to be considered as the date on which payment is made or an even later date in the event of delays within the bank or in the post. However, payment may still be considered to have been made in due time, despite being paid late, if the inpayment or transfer has been effected before expiry of the time limit for payment in a Contracting State and, where appropriate, a surcharge has been paid (see XI, 6).

3.2 Delivery or remittance of a cheque made payable to the EPO

Art. 8(1)(b) RFees

The payment is considered to be made on the date of delivery, where the cheque is delivered to one of the filing offices of the EPO and on the day the cheque is received at the EPO where it is sent by post. Outside office hours the cheque may also be posted in the automated mail-box of the EPO in Munich or Berlin and the day on which it was posted in the automated mail-box is considered to be the date of payment (Notice from EPO, OJ 6/1992, 306).

The date of payment holds good only if the cheque is met.

3.3 Deposit accounts with the EPO

3.3.1 General remarks

Art. 8(2) RFees

The Arrangements for deposit accounts (hereinafter abbreviated to "ADA") and their annexes were published in Supplement No. 2 to OJ 1/2005. A distinction must be drawn, in connection with deposit accounts, between:

Point 4 ADA

(i) payments to replenish deposit accounts; and

Point 6 ADA

(ii) payments of fees or of costs for publications or services of the EPO by debiting the deposit account.

3.3.2 Inpayments to replenish a deposit account

Point 4 ADA
Point 3 ADA

Inpayments to replenish a deposit account are to be made in euro. Payments in a different currency will only be accepted if freely convertible. Payments can be made in any of the ways (i) and (ii) as referred to in XI, 2. However, the deposit account will always be credited in euro (the only currency in which these accounts are kept) after conversion at the current rate of exchange.

3.3.3 Debiting the deposit account

Point 6.3 ADA
Point 6.2 ADA

The debit order must contain particulars necessary to identify the purpose of the payment and must indicate the number of the account which is to be debited. The Boards of Appeal have decided that a debit order must be carried out notwithstanding incorrect information given in it if the intention

of the person giving the order is clear (see T 152/82, OJ 7/1984, 301). Debiting occurs on the basis of a written debit order signed by the account holder. Debit orders may also be filed online via My.epoline®, on diskette or by facsimile, in which case no written confirmation (or signature, in the case of online filing) is required.

3.3.4 Date of receipt of the debit order; insufficient funds

Provided that there is a sufficient amount in the deposit account, the date of receipt of the debit order by the EPO will be considered as the date on which the payment is made. This is also applicable where a debit order is filed together with an application under point 6.9 ADA with a competent national authority of a Contracting State. If the debit order is not received at the EPO until after expiry of the period allowed for payment of fees due on filing, that period is deemed to have been observed if evidence is available or presented to the EPO to show that the debit order was filed with the competent authority of the Contracting State at the same time as the application, provided that sufficient funds were available in the account at the time the period expired.

Point 6.3 ADA
Point 6.9 ADA
Point 6.10 ADA

If on the date of receipt of a debit order, there are insufficient funds in the deposit account for the payment of a fee (shortfall), this fact will be communicated to the account holder by the Treasury and Accounts Department of the EPO. By replenishing the account and paying an administrative fee, the holder can ensure that the date of receipt of the debit order is deemed to be the date on which payment was effected. The administrative fee is 30% of the shortfall. The Arrangements for deposit accounts further fix a maximum and a minimum amount for this administrative fee.

Point 6.4 ADA
Point 6.5 ADA
Point 6.6 ADA

3.4 Automatic debiting procedure

A deposit account may also be debited on the basis of an automatic debit order signed by the account holder (automatic debiting procedure). Such an order may only be filed on behalf of the applicant or the patent proprietor or his representative and extends to all types of fees covered by the automatic debiting procedure and payable by him in respect of the proceedings specified in the automatic debit order. As the proceedings progress, each such fee is automatically debited and treated as having been paid in due time. The automatic debit order may not be restricted to specific types of fees. The Arrangements for the automatic debiting procedure (abbreviated to "AAD") plus explanatory notes are published in Supplement No. 2 to OJ 1/2005.

Point 7 ADA

4. Due date for fees

4.1 General

4.1.1 Due date

In the EPC, the term "due date" has a special meaning, namely the first day on which payment of a fee may be validly effected, not the last day of a period for such payment (see XI, 6 "Payment in due time"). The due date for fees is generally laid down by provisions of the EPC or of the PCT. If no due date is specified, the fee is due on the date of receipt of the request for the service incurring the fee concerned. A fee may not be validly paid before the due date. The only exception to that principle is with renewal fees, which may be validly paid up to one year before the due date (see XI, 4.2.4).

Art. 4(1) RFees
Rule 37(1), 2nd
sentence

Payments made before the due date which are not valid may be refunded by the EPO. If payment is made shortly before the due date, it is possible that the EPO will not return the payment. In this case, however, payment only takes effect on the due date. See XI, 4.2.4 regarding renewal fees for a European patent application.

4.1.2 Amount of the fee

When the fees are increased, the date of payment is set as the relevant date for determining the amount of the fees (cf. Art. 2 of the Decision of the Administrative Council dated 5 June 1992, OJ 7/1992, 344). Setting the date of payment as the relevant date makes it unnecessary as a rule to ascertain the actual due date for determining the amount of the fee. Fees cannot validly be paid before the due date (with the exception of renewal fees – see XI, 4.1.1). Thus, for example, the fees for grant and printing cannot be validly paid in advance before notification of the communication under Rule 51(4).

4.2 Due date for specific fees

4.2.1 Filing fee, search fee, designation fee, claims fees

The filing fee, search fee, designation fees and any claims fees payable (for claims filed with the application) are due on the day the European patent application is filed.

4.2.2 Examination fee

The examination fee is due when the written request for examination is filed. Since the latter is contained in the prescribed form for the request for grant (Form 1001), the examination fee may be paid straight away on the date of filing of the European patent application if the application is filed with said prescribed Form 1001. It may be paid up to expiry of the period laid down in Art. 94(2).

4.2.3 Fees for grant and printing

The fees for grant and printing fall due on notification of the communication under Rule 51(4) requesting that these fees be paid. Under Rule 51(7), the same applies for claims fees, unless they were already paid under Rule 31(1) or 110(1) and (2).

4.2.4 Renewal fees

Rule 37(1)
Art. 86(2)
Rule 37(2)

Renewal fees for a European patent application in respect of the coming year are due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than one year before they fall due. Renewal fee payments which are not valid will be refunded by the EPO. If payment is made only shortly before the permissible prepayment period, the EPO may elect not to return the payment. In this case, however, payment only takes effect on the first day of the permissible prepayment period. If the renewal fee has not been paid on or before the due date, it may be validly paid within six months of the said date, provided that the additional fee is paid within this period. For the calculation of the additional period, see J 4/91, OJ 8/1992, 402. Whilst the applicant's attention is drawn to this possibility, he may not invoke the omission of such notification (see J 12/84, OJ 4/1985, 108, and J 1/89, OJ 1-2/1992, 17). See also Legal Advice No. 5/93 rev., OJ 4/1993, 229, for Euro-PCT applications

under Art. 39(1) PCT. For renewal fees for European divisional applications see IV, 1.4.3.

The obligation to pay renewal fees terminates with the payment of the renewal fee due in respect of the year in which the mention of the grant of the European patent is published (Art. 86(4); see OJ 6/1984, 272).

5. (deleted)

6. Payment in due time

6.1 Basic principle

A fee is considered to have been paid in due time if the date of payment (see XI, 3) fell on or before the last day of the relevant time limit – or the time limit extended pursuant to Rule 85.

6.2 Ten-day fail-safe arrangement

6.2.1 Requirements

If the payer provides evidence to the EPO that within the period in which the payment should have been made in an EPC Contracting State:

Art. 8(3), (4) RFees

- (i) he effected payment through a banking establishment or a post office; or
- (ii) he duly gave an order to a banking establishment or a post office to transfer the amount of the payment; or
- (iii) he despatched at a post office a letter bearing the address of one of the filing offices (see II, 1.1) of the EPO and containing a cheque made payable to the EPO, provided that the cheque is met; or
- (iv) he despatched at a post office a letter bearing the address of one of the filing offices (see II, 1.1) of the EPO containing the debit order, provided that there is a sufficient amount in the account on the date on which the time limit expires,

Point 6.8 ADA

then he is considered to have observed the period for payment, even if the payment is entered in the bank or giro account of the European Patent Organisation after the expiry of the period or if a cheque or debit order despatched to the EPO is received there after the expiry of the period.

However, if, in such a case, the payment has been effected later than 10 days before expiry of the period for payment, but still within that period, a surcharge of 10% on the relevant fee or fees, but not exceeding EUR 150, must be paid in order for the period for payment to be considered observed.

Art. 8(3)(b) RFees
Art. 8(4) RFees
Point 6.8(b) ADA

6.2.2 Application of the ten-day fail-safe arrangement to replenishment of deposit account

The ten-day fail-safe arrangement under Art. 8(1), 8(3) and (4) RFees applies mutatis mutandis to payments to replenish deposit accounts. If one of the steps referred to under XI, 6.2.1(i) to (iii) is carried out in order to replenish a deposit account and, where appropriate, the surcharge is paid, the account is considered to have been replenished at the latest on the tenth day after one of those steps was taken for the purpose of complying with time limits for payment by issuing debit orders.

Point 5.2 ADA

6.2.3 Debit orders

Point 6.10 ADA

For debit orders accompanying applications filed with a competent national authority, see XI, 3.3.4.

6.2.4 Payment of fee at the normal fee rate

Where a fee can either be paid within a normal period at the normal fee rate or within a period of grace with a surcharge if the normal period for payment is considered to have been observed when applying the ten-day fail-safe arrangement, the above-mentioned surcharge need not be paid.

6.2.5 Amount of fee payable

As noted in XI, 4.1.2, the amount of fee payable is always that applying on the date of payment (see also the transitional provisions in the Administrative Council decisions revising fees). The payer cannot therefore in this respect seek to rely on the ten-day fail-safe arrangement in order to benefit from an old amount, arguing that he gave instructions for payment before the entry into force of the new amount of fee (see J 18/85, OJ 8/1987, 356); Art. 8(3) and (4) RFees protects the applicant in the event of late payment from the legal consequences of expiry of the payment period, but not from the obligation to make up any differences resulting from an increase in the amount of fee in the meantime.

6.2.6 Noting of loss of rights

Rule 69

If an applicant who has been sent a communication under Rule 69(1) noting non-compliance with a time limit for payment claims that the payment was made in due time pursuant to Art. 8(1), (3) and (4) RFees and points 5.2, 6.5, 6.8 or 6.10 of the Arrangements for deposit accounts, he must apply for a decision pursuant to Rule 69(2) and submit the requisite evidence.

7. Purpose of payment

7.1 General

7.1.1 Condition for valid payment

An essential condition for a valid payment to the EPO in the case of payment or transfer to a bank or giro account held by the European Patent Organisation is that the amount is entered in that account. The payment is valid in respect of the amount entered. In the case of delivery or remittance of a cheque, the amount that enters the account of the EPO when the cheque is cashed is considered to be the amount paid. If an insufficient amount has been paid by mistake, it is not possible to rectify the error by having the shortfall paid subsequently deemed to be paid on the original date of payment. Payment is a matter of fact whereby a certain amount is transferred to and put at the disposal of the EPO. It is not, therefore, a procedural declaration which may be corrected pursuant to Rule 88. The same applies to debit orders (see T 170/83, OJ 12/1984, 605, reasons 8). Therefore, time limits for payment are in principle deemed to have been observed only if the full amount of the fee has been paid in due time. However, the EPO may, where this is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment (Art. 9(1) RFees).

7.1.2 Purpose of payment

A distinction must be drawn between these conditions for valid payment and the indication of the purpose of the payment. Indication of the purpose of the payment serves to identify the proceedings for which the fee is intended (e.g. for fee payments, the application number) and the specific type of fee. If the purpose of the payments cannot immediately be established, the person making the payment will be requested to communicate the purpose in writing within a specified period. If he complies with this request in due time, the payment and the original payment date remain valid. This is also the case when the clarification involves re-assigning the payment to another application. Otherwise the payment will be considered not to have been made. The Boards of Appeal have decided that if the purpose of the payment has evidently been given incorrectly, this deficiency is not prejudicial if the intended purpose can be established without difficulty from the remaining information. The inadvertent use of a fee by the EPO for a different purpose from that evidently intended by the person making the payment has no effect on the purpose intended by that person (see J 16/84, OJ 12/1985, 357). Similarly, a debit order must be carried out notwithstanding incorrect information given in it if the intention of the person giving the order is clear. Instructions to carry out the order must be given by the EPO department qualified to recognise what is clearly intended (see T 152/82, OJ 7/1984, 301).

Art. 7 RFees

In the case of changes to the purpose of payment not arising from Art. 7(2) RFees, the date of payment is the date of receipt of the request for the change.

7.2 Indication of the purpose of the payment in the case of designation fees

The designation fees are deemed paid for all Contracting States upon payment of seven times the amount of one designation fee. Such payments simply need to be marked "designation fees" in order for the purpose of the payment to be established. If fewer than seven designation fees are paid and the payment agrees with the declaration in Section 32.2b of the Request for Grant form (Form 1001), payment should once again simply be marked "designation fees". However, if the payment differs from the intended payment as stated in Section 32.2b, the Contracting States for which the payment is now intended should be indicated with the payment.

Art. 2, No. 3, RFees
Art. 7(1) RFees

If there is no such indication and the amount paid is insufficient to cover all the Contracting States mentioned in Section 32.2b, the procedure under III, 12.8 applies.

If an automatic debit order has been issued (Sections 43 and 32.3 of Form 1001), the applicant must inform the EPO prior to expiry of the basic period under Art. 79(2) if he wishes to pay designation fees for Contracting States other than those indicated in Section 32.2b. If not, an amount equal to seven times the amount of one designation fee or the designation fees for the Contracting States indicated in Section 32.2b is debited.

The same applies where Form 1200 is used for entry into the European phase of a Euro-PCT application.

7.3 Indication of the purpose of payment in the case of claims fees

7.3.1 Claims fees payable on filing the European patent application

Rule 31(1)

If the applicant pays the claims fees for all the claims incurring fees, the indication "claims fees" suffices to identify the purpose of the payment. If the amount paid is insufficient to cover all the claims fees, the procedure under III, 9 applies.

7.3.2 Claims fees payable before the grant of the European patent

Rule 51(7)

In the communication under Rule 51(7), the applicant may be requested to pay claims fees due before grant of the European patent. If the applicant fails to pay the fee for all the claims in due time, the application is deemed to be withdrawn (Rule 51(8)).

8. No deferred payment of fees, no legal aid, no discretion

The EPC makes no provision for deferring payment of fees (see J 2/78, OJ 6-7/1979, 283, reasons 3, German text only) or for granting legal aid. An indigent party still has the possibility of applying for legal aid from the competent national authority. However, the time limit for payment is not extended in such a case; a party claiming national legal aid must make the corresponding arrangements as early as possible so that he is in a position to pay the fee in due time. The EPO has also no discretion in waiving or refunding, without any legal basis, fees that have become due (see J 20/87, OJ 3/1989, 67).

9. Reduction of fees

9.1 General

The EPC provides in certain cases for the reduction of the filing fee, examination fee, opposition fee and fee for appeal. The reduction is fixed in the Rules relating to Fees as a percentage of the fee.

Where a fee is reduced – in contrast to cases of fee refunds – the reduced rate may be paid instead of the full fee. The factual conditions for a reduction of the fee must be met on or before the day the period for payment expires.

9.2 Reduction under the language arrangements

9.2.1 Conditions

Art. 14(2), (4)

The European patent application and documents which have to be filed within a time limit may also be filed in the official language of a Contracting State which is not an official language of the EPO (hereinafter "admissible non-EPO language") if the applicant has his residence or principal place of business within the territory of the Contracting State concerned or if the applicant is a national of that State. See VIII, 1.1 and 1.2.

Rule 6(3)
Art. 12(1) RFees

Subject to certain conditions, where an admissible non-EPO language is used, a reduction in fees (20%) is allowed. It serves to compensate the parties for the disadvantages that result from the fact that not all official languages of the Contracting States are official languages of the EPO. The conditions to be fulfilled for the grant of a reduction in fees vary for each procedural step for which a reduction is claimed (see G 6/91, OJ 9/1992, 491).

The reduction is only allowed if the translation into an EPO official language is filed in due time, that is to say at the earliest at the same time as when the European patent application or the document subject to a time limit is filed in the admissible non-EPO language (see G 6/91, OJ 9/1992, 491).

9.2.2 Reduction of the filing fee

The filing fee is reduced if the European patent application (i.e. at least the description and the claims (see J 4/88, OJ 12/1989, 483)) is filed in an admissible non-EPO language.

9.2.3 Reduction of the examination fee

The applicant will be allowed a reduction in the examination fee if the written request for examination is filed in an admissible non-EPO language and a translation of the written request for examination in an EPO official language is also filed. For the reduction to be allowed, the written request for examination in the admissible non-EPO language may already be filed as part of the request for grant (Form 1001), since the form already contains a pre-printed box for the written request for examination in the official languages of the EPO and the written request for examination in the admissible non-EPO language can be entered in the box provided for the request for examination. Alternatively, for the reduction to be allowed, the request for examination in the admissible non-EPO language and the translation of the request may be filed later, namely up to the date of payment of the examination fee, provided that the translation is filed no earlier than simultaneously with the request (see J 21/98, OJ 8-9/2000, 406, and G 6/91, OJ 9/1992, 491). In order to benefit from the reduction, it is not necessary to file subsequent additional documents for the examination proceedings in an admissible non-EPO language.

For the case where a reduction in the examination fee for the above reasons coincides with a reduced examination fee because the EPO drew up the international preliminary examination report, see XI, 9.3.2.

9.2.4 Reduction of the opposition fee

The opposition fee is reduced if the notice of opposition including the written reasoned statement of grounds is filed in an admissible non-EPO language as well as in an EPO official language in translation (see T 290/90, OJ 7/1992, 368). If, during the opposition procedure only, an opponent files a document that has to be filed within a time limit in an admissible non-EPO language, he is not given a reduction in the fees.

9.2.5 Reduction of the appeal fee

A reduction in the appeal fee is allowed if the notice of appeal is filed in an admissible non-EPO language as well as in an EPO official language in translation. The grant of a reduction does not depend on the subsequent filing of the statement setting out the grounds of appeal in an admissible non-EPO language.

9.3 Special reductions

9.3.1 Reduction of the search fee for a supplementary European search

The search fee for a supplementary European search report is reduced for PCT applications for which the Patent Office of the USA, Japan, China,

Art. 157(3)(b)

Australia, Russia or Korea was the International Searching Authority (see OJ 9/1979, 368; OJ 1/1981, 5; OJ 1-2/1994, 6; OJ 7/2000, 321).

The search fee for a supplementary European search report is also reduced for PCT applications filed on or after 1 April 2005 for which the Patent Office of Finland was the International Searching Authority and for PCT applications filed on or after 1 July 2005 for which the Patent Office of Austria, Spain or Sweden was the the International Searching Authority (cf. OJ 7/2005, 422).

9.3.2 Reduction of the examination fee where the international preliminary examination report is being drawn up by the EPO

Rule 107(2)
Art. 12(2) RFees

Where the EPO has drawn up the international preliminary examination report in respect of an international application, the examination fee is reduced by 50% if the EPO is the designated Office (elected Office). This reduction is not available if the EPO, as international preliminary examining authority, has made a refund under Art. 10d RFees of the fee paid for international preliminary examination.

If the conditions for a reduction under the language arrangements (see XI, 9.2.3) are also fulfilled, the examination fee is first reduced by 50%, then by a further 20%, ie the total reduction is 60% of the full fee.

9.3.3 Reduction of the fees for the international search and international preliminary examination of an international application

The fees for the international search and preliminary examination of an international application are reduced by 75% if the application is filed by a natural person who is a national and a resident of a state which is not an EPC Contracting State and which fulfils the requirements for the corresponding reduction of fees payable to the International Bureau of WIPO (decision of the PCT Assembly, 25 September to 3 October 1995; decision of the Administrative Council of 11 October 2000, OJ 10/2000, 446).

10. Refund of fees

10.1 General remarks

10.1.1 Fee payments lacking a legal basis

There are two conditions for a fee payment to be fully valid:

- (i) the payment must relate to proceedings that are pending; and
- (ii) the date of payment (see XI, 3) must be on or after the due date (see XI, 4.1.1).

If a payment does not relate to a pending European patent application (e.g. it relates to a patent application already deemed to have been withdrawn), there is no legal basis for the payment; the amount paid must be refunded.

If the payment is made before or on the due date and if, no later than that date, the legal basis ceases to exist (e.g. because the patent application is deemed to be withdrawn or is withdrawn), the amount paid is to be refunded. This also applies to renewal fees validly paid before the due date (Rule 37(1), second sentence).

10.1.2 Fee payments which are not valid

If fees have not been validly paid they must be refunded. Examples: filing fee, search fee, designation fees or examination fee paid late without the surcharge pursuant to Rule 85a or 85b. Fees paid on or after the due date are refunded only if there is a particular reason for a refund (see XI, 10.2).

10.1.3 Insignificant amounts

Where the sum paid is larger than the fee, the excess will not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. It has been decided that any amount up to EUR 10 constitutes an insignificant amount (Art. 1 of the Decision of the President of the EPO dated 6 September 2001, OJ 11/2001, 521).

Art. 10c RFees

10.2 Special refunds

10.2.1 Refund of the search fee

The search fee for a European or supplementary European search is refunded in the cases provided for in Art. 10 RFees and in the Decision of the President of the EPO dated 1 July 2005 (OJ 7/2005,431), which applies to European patent applications filed on or after 1 July 2005. Details on criteria for refund of search fees are given in the Notice from the President of the EPO dated 13 December 2001 (OJ 1/2002, 56) and for applications filed as of 1 July 2005 in the Notice of the President of the EPO dated 1 July 2005 (OJ 7/2005,433).

Art. 10 RFees

10.2.2 Refund of the further search fee

If an applicant, following a communication from the Search Division, has paid a further search fee but the Examining Division, at the applicant's request, has found that there was no justification for charging the further search fee, the latter will be repaid.

Rule 46(2)
Rule 112

10.2.3 Refund of the international search fee

The international search fee will be refunded in the cases specified in Rules 16.2, 16.3 and 41 PCT and in Annex C of the Agreement between the European Patent Organisation and the International Bureau of the World Intellectual Property Organization (WIPO) under the PCT (OJ 12/2001, 601).

Rule 16.2 PCT
Rule 16.3 PCT
Rule 41 PCT

For applications filed before 01.01.2004 any refund is based on the refund scheme set out in the Notice from the President of the EPO dated 13 December 2001 (OJ EPO 1/2002, 56). Following amendment of the provisions set out in Annex C, Part II(3) of the above mentioned agreement, any refund of the international search fee paid for an international application filed on or after 01.01.2004 will be granted to the extent set out in the Notice from the President of the EPO dated 30 November 2003 (OJ EPO 2003, 631). Pursuant to point 4 of this Notice the criteria determining the refund rate and the procedure are as laid down in points 2 and 3 of the Notice dated 13 December 2001.

10.2.4 Refund of the examination fee

The examination fee will be refunded in the situation described in Art. 10b RFees (see VI, 2.2, 3rd paragraph, and 2.5).

Art. 10b RFees

If an international application and a European application are consolidated in accordance with the conditions laid down by Legal Advice No. 10/92 rev., OJ 11/1992, 662, the examination fee paid in respect of the European patent application will be refunded in full if the request for consolidation was made before the Examining Division had taken responsibility for both applications or at a rate of 75% if the Examining Division had already taken responsibility for both applications but had not yet begun substantive examination of the second application when consolidation was requested. This also applies where there has been an international preliminary examination under Chapter II PCT.

10.2.5 Refund of the international preliminary examination fee

Art. 10d RFees

Two thirds of the international preliminary examination fee are refunded if the applicant, during international preliminary examination, has neither asked for a detailed preliminary examination nor filed any amendments under Article 19 or 34(2) PCT or arguments (see the Notice of the President of the EPO dated 2 November 2001, OJ 11/2001, 539) (see also E-IX, 4.1).

For international applications filed on or after 1 January 2004 the EPO has discontinued the rationalised international preliminary examination procedure (OJ EPO 2001, 539). Consequently, no request for "detailed" examination will be required, and the fee refund for the rationalised procedure is no longer available. The rationalised procedure will however still apply to international applications filed before 01.01.2004 even if the demand for preliminary examination is filed after that date (Notice from the EPO, OJ EPO 2004, 305).

10.2.6 Refund pursuant to Art. 77(5)

Art. 77(5)
Rule 31(2)

If a European patent application filed with a competent national authority is deemed to be withdrawn pursuant to Art. 77(5), the filing, search and designation fees and any claims fees paid will be refunded.

10.2.7 Refund of claims fees and of the fees for grant and printing

Art. 97(2)(b)
Rule 51(6)

The fees for grant and printing will be refunded if the European patent application is withdrawn before communication of the decision to grant. If it is withdrawn after communication of the decision to grant, the fee for printing cannot be refunded as the fee for printing is part of the fee for grant. If, following a communication under Rule 51(6), the application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing and any claims fees paid under Rule 51(7), are refunded.

10.3 Method of refund

Refunds will as a rule be made by means of a cheque. If the person to whom the refund is payable holds a deposit account with the EPO, the refund may take the form of crediting that deposit account. If the payer wishes any refund to be made to a deposit account, he can give the number of the account in the space provided in the Request for Grant form.

10.4 Person to whom refund is payable

Fees will be refunded to the party concerned. However, if the party's representative is authorised to receive payments, the refund will be made to the representative. A refund will not be made to a third party who paid the fee (see Legal Advice No. 6/91 rev., points 4 and 5, OJ 11/1991, 573).

10.5 Re-allocation instead of refund

If a party files a written request, the payment may be re-allocated instead of being refunded. The date of receipt of the re-allocation instructions is then considered to be the date of payment for the new purpose of payment.

CHAPTER XII**INSPECTION OF FILES; COMMUNICATION OF INFORMATION CONTAINED IN FILES; CONSULTATION OF THE REGISTER OF EUROPEAN PATENTS; ISSUANCE OF CERTIFIED COPIES****1. General**

Art. 128

Provision is made for inspection of files and communication to the public of information contained in files. This applies to the files of European patent applications and European patents.

For international (PCT) applications, see E-IX, 4.3, 5.8 and 6.5.

The provisions governing inspection of files are contained in Art. 128 and Rules 93 and 94, those for communication of information in Rule 95.

Rule 93, Rule 94
Rule 95

The fee for inspection of files and the fee for communication of information contained in files are laid down by the President pursuant to Art. 3(1) RFees and are regularly published in the Official Journal.

Art. 3(1) RFees

2. Inspection of files**2.1 Extent of file inspection**

Inspection of the files of European patent applications and of European patents is granted in respect of the original documents or of copies thereof or, if the files are stored on other media, in respect of these media. All parts of the file compiled when conducting the examination, opposition and appeal procedure with the parties are open for inspection. It also includes the search opinion if applicable.

Rule 94(1)
Rule 95a(2)

Observations by third parties (Art. 115) are an integral part of the files and as such are open to inspection in accordance with Art. 128. If a third party asks that his observations or a part thereof be treated confidentially, that request cannot be granted and the third party will be notified accordingly.

The parts of the file excluded from inspection are:

Art. 128(4)

- (i) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal;
- (ii) draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties;
- (iii) the designation of the inventor if he has waived his right to be mentioned as inventor under Rule 18(1);
- (iv) any other document excluded from inspection by the President of the EPO on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent. These documents include documents relating to file inspection and requests for accelerated search and accelerated examination under the "PACE" programme (if submitted using EPO Form 1005 or in a separate document) (see the Decision of the President of the EPO, OJ 10/2001, 458);

Rule 93(a)

Rule 93(b)

Rule 93(c)

Rule 93(d)

Art. 38(1) PCT
Rule 94 PCT

- (v) subject to Rules 94.2 and 94.3 PCT, the files of the international preliminary examination for a Euro-PCT application in respect of which the EPO is the international preliminary examining authority and for which an international preliminary examination report has not yet been established (see OJ 7/2003, 382; see also E-IX, 5.8 and 6.5).

The parts of the file excluded from inspection are kept separate in the files from those open to inspection.

2.2 Procedure for file inspection

Rule 94(2)

The President of the EPO determines all file inspection arrangements, including the circumstances in which an administrative fee is payable (see the Decisions of the President of the EPO dated 6 June 2003, OJ 7/2003, 370 and 371).

Files that are available in electronic form can be inspected free of charge online via the EPO website (www.european-patent-office.org) under *epoline*[®] (see also the Notice from the EPO dated 6 June 2003, OJ 7/2003, 373).

Other forms of file inspection, e.g. by furnishing paper copies, are available on request. No particular form is prescribed for the request, except that it must be filed in writing with the EPO at one of its filing offices. The EPO offers a form via its website on the Internet. The request should contain information about the payment of the fee. Requests filed by facsimile (see IX, 2.5) or submitted through the Internet will be processed without confirmation.

Rule 94(2)

A fee, if any, falls due when the request is received. The method of payment and date on which payment is deemed to have been made are dealt with in the Rules relating to Fees (see XI). Where the administrative fee has been duly paid, it will not be refunded.

2.3 Restrictions to file inspection

Art. 128(4)
Rule 95
Rule 94
Rule 93

Subsequent to the publication of the European patent application any person may inspect and obtain information from the files. Inspection of files and communication of information are subject to the restrictions laid down in Rule 93 (see XII, 2.1). If it is decided that certain papers marked "confidential" are not to be excluded from file inspection under Rule 93, they are returned to the sender (see T 516/89, OJ 8/1992, 436).

2.4 Confidentiality of the request

Correspondence from the proceedings relating to the inspection of files conducted between the EPO and the person requesting the inspection is filed in the non-public part of the file. The EPO does not provide the applicant with any information about the proceedings relating to the inspection of files (see, however, XII, 2.5, third paragraph).

2.5 File inspection before publication of the application

Art. 128(1)

Until such time as the European patent application is published, the files may be inspected only by the applicant or with his consent. Secure File Inspection, which is available via My.epoline[®] allows the applicant to inspect online the public part of the files relating to his own as yet unpublished application (see Notice from the EPO dated 9 December 2003, OJ 1/2004, 61). If a third party requests file inspection without at the

same time submitting the applicant's consent, the EPO will not release the files until the applicant's approval has been presented.

However, prior to publication of the European patent application, any person who can prove that the applicant has invoked his rights under the application against him may also inspect the files. The rights under a European patent application are also deemed to have been invoked where rights under a first filing in a Contracting State have been invoked and the subsequent European application is mentioned at the same time (see J 14/91, OJ 8/1993, 479). If such proof is not furnished together with the request, the EPO will invite the requester within a specified period to supply proof. If he fails to do so in due time, the request will be refused.

Art. 128(2)

In case of a request for inspection of the files under Art. 128(2), the applicant is entitled to notification of the identity of the person making the request. Professional representatives requesting inspection of the files on behalf of a third party pursuant to Art. 128(2) must accordingly give the third party's name and address and file an authorisation.

A decision on a request for inspection of the files pursuant to Art. 128(2) is only taken once the applicant has been heard. If the applicant objects and provides grounds for his belief that the requirements under Art. 128(2) are not met within the period set by the EPO, a decision will be delivered. This decision is subject to appeal.

Prior to publication of a European divisional application the file of this divisional application may only be inspected in the cases described in Art. 128(1) and (2). This also applies where the parent application has already been published. However, where a European divisional application or a new European patent application filed under Art. 61(1)(b) is published, the files of the earlier application may be inspected prior to the publication of that earlier application and without the consent of the relevant applicant.

Art. 128(3)

2.6 Publication of bibliographic data before publication of the application

The EPO has not hitherto availed itself of the power under Art. 128(5) to publish bibliographic data before the European patent application is published.

Art. 128(5)
Rule 96(1)

3. Communication of information from the files

Rule 95

Subject to the restrictions provided for in Art. 128(1) to (4) and Rule 93, the EPO may, upon request, communicate information concerning any file of a European patent application or European patent. This may be subject to the payment of an administrative fee.

However, the EPO may require the exercise of the option to obtain inspection of the file itself, should it deem this to be appropriate in view of the quantity of information to be supplied.

Correspondence from the proceedings relating to the communication of information conducted between the EPO and the person requesting the information is filed in the part of the file which is not accessible to the public. The EPO does not provide the applicant with any information about the proceedings relating to the communication of information.

4. Consultation of the Register of European Patents

Art. 127
Rule 92

The Register of European Patents, containing the particulars specified in Rule 92, may be consulted in order to ascertain the state of the proceedings and the legal status of patent rights. Entries are made in the Register of European Patents up to expiry of the period of opposition or the termination of opposition proceedings. The only exception is the correction of the designation of the inventor, which is made at any time. The Online European Patent Register via the Internet (www.epoline.org) can be accessed free of charge. Apart from the data entered in the Register of European Patents, the Online Register includes additional application and procedural data not published in the European Patent Bulletin. Register data may also be obtained by telephone from the Information Offices in Munich, The Hague, Berlin or Vienna.

5. Certified copies

The EPO will issue on request a certified copy of the European patent application or European patent specification, of other documents from the files of European applications and patents, provided that the conditions for file inspection (Art. 128(1) to (4)) are fulfilled and, where necessary, an administrative fee has been paid.

Costs incurred in preparing the copies certified will be charged to the requester.

If it is indicated, when the request is filed, that the cost should be debited from the requester's deposit account, the amount of the invoice will be charged to the deposit account.

6. Priority documents issued by the EPO

Rule 38a

Any priority document (i.e. the certified copy of the European application together with the certificate stating the date of filing thereof) will only be issued to the (original) applicant or his successor in title. In the case of applications filed under the provisions of Art. 14(2), the priority document relates to the application as originally filed, not to the translation in one of the official languages of the EPO.

The President of the EPO determines all necessary arrangements, including the form of the priority document and the circumstances in which an administrative fee is payable.