

Chapter II *The European Patent Organisation***Art. 5 Legal status**

Art. 5(1) The Organisation shall have legal personality.

Art. 5(2) In each of the Contracting States, the Organisation shall enjoy the most extensive legal capacity accorded to legal persons under the national law of that State; it may in particular acquire or dispose of movable and immovable property and may be a party to legal proceedings.

1 Legal capacity of the European Patent Organisation

The Organisation can take part in legal actions and in economic transactions because it has legal personality.

Art. 5(3) The President of the European Patent Office shall represent the Organisation.

1 Representation of the Organisation

The President may, according to this provision, represent the European Patent Organisation. This is one of his functions but not one of his powers. The President may only represent the Organisation by performing a legal act, such as the signing of an agreement, if he has the power to perform that act. His powers are governed by the EPC in articles other than Art.5(3), such as Art.10 and Art.33(4). (G5/88 hn.I, r.2.2-4, see also Art.10:1)

Art. 6 Headquarters

Art. 6(1) The Organisation shall have its headquarters in Munich.

Art. 6(2) The European Patent Office shall be located in Munich. It shall have a branch at The Hague.

1 Branch of the EPO in The Hague

The EPO has set up a branch at The Hague to avail itself of the search facilities of the Institut International des Brevets (IIB) in The Hague, which had an excellent search department (OJ 1978, 202). When the Netherlands started to provide protection for inventions in 1912, they could avoid the deficiencies of the search systems already set up in France and Germany. They devised a new system and had sufficient funds to copy the entire French and German patent documentation. Before the institution of the EPO, France already cooperated with the Netherlands in the IIB, because of the disorganized system in France. The IIB was incorporated into the EPO in 1978.

It should be noted that in 1973, at the time of drafting the Convention, the offices of the IIB that were to become the EPO branch were located in The Hague. When the EPO started its activities in 1978, the offices had been set up in Rijswijk, a city neighbouring The Hague. There has never been any EPO office in The Hague.

The revision of the EPC in 2000 did not change the location of the branch. The legislator held in an oral clarification that any geographical location in the EPC should be interpreted broadly, e.g. The Hague should mean the province of South Holland and Munich the country of Bavaria. Any geographical allocation would at some point restrict the reallocation of offices.

2 Sub-office of the EPO in Berlin

Under the Protocol on Centralisation, Section I(3)(a), a sub-office was created in Berlin in 1978 for searching European patent applications under the direction of The Hague (OJ 1978, 195, 245). The Protocol is part of the EPC according to Art.164(1). The Berlin sub-office was set up to give West Berlin, at that time an exclave in East Germany, more ties to West Germany. Although the ties are no longer necessary after the reunification of East and West Germany in 1990, the relatively small sub-office is maintained because of its low operational costs.

Since 1989 the Berlin sub-office is also a filing office in the sense of Art.75(1)(a) (Dec. of Pres., based on his power acc. to Art.10(2)(a), OJ 1989, 218).

3 Location of the EPO in Haar

On 09.10.2017 the Boards of Appeal Unit was relocated from the EPO headquarters in Munich to Haar, a municipality neighbouring Munich. The relocation is part of the reform of the boards of appeal to strengthen the perception of their independence (see R.12a:1). The office in Haar is not a filing office.

4 Filing with incorrect office

In Munich and Berlin the EPO and the German Patent Office are located in neighbouring buildings. The filing date of documents intended for the EPO but received by the German Patent Office and forwarded to the EPO will be the date of their actual receipt at the EPO (OJ 2005, 444).

Art. 7 Sub-offices of the European Patent Office

By decision of the Administrative Council, sub-offices of the European Patent Office may be created, if need be, for the purpose of information and liaison, in the Contracting States and with intergovernmental organisations in the field of industrial property, subject to the approval of the Contracting State or organisation concerned.

1 Sub-offices

Following a decision by the Administrative Council taken in 1992, a sub-office was opened in Brussels for liaison with the European Union to support industry and ensure competitiveness of the European economy (OJ 1993, 404; 2004, 88).

In 1990 the International Patent Documentation Centre (INPADOC) in Vienna was integrated into the EPO as a sub-office (Not. of Pres. OJ 1990, 492). The sub-office is in charge of the EPO's bibliographic data bases and has as its task to provide public access to patent information. Note that the Vienna sub-office is not a filing office of the EPO (Dec. Pres., Spec. Ed. 3 of OJ 2007, A.1 Art.1(2)).

Art. 8 Privileges and immunities

The Protocol on Privileges and Immunities annexed to this Convention shall define the conditions under which the Organisation, the members of the Administrative Council, the employees of the European Patent Office, and such other persons specified in that Protocol as take part in the work of the Organisation, shall enjoy, in each Contracting State, the privileges and immunities necessary for the performance of their duties.

1 Protocol on Privileges and Immunities

The Protocol on Privileges and Immunities is an integral part of the EPC (Art.164(1)). The Protocol defines the inviolability of the premises of the Organisation and the immunity of the people working in the Organisation. It ensures that the Organisation is not restricted in the execution of its tasks by national laws. The protocol also applies to members of the EPO having specific duties (OJ 2009, 28). The text of the Protocol has not been reproduced in this book.

Art. 9 Liability

Art. 9(1) The contractual liability of the Organisation shall be governed by the law applicable to the contract in question.

The will of the parties as laid down in contracts is, in principle, decisive.

Art. 9(2) The non-contractual liability of the Organisation in respect of any damage caused by it or by the employees of the European Patent Office in the performance of their duties shall be governed by the law of the Federal Republic of Germany. Where the damage is caused by the branch at The Hague or a sub-office or employees attached thereto, the law of the Contracting State in which such branch or sub-office is located shall apply.

1 Indemnities

The board of appeal is not competent to decide on indemnities for loss or damage allegedly caused by the EPO in the course of proceedings (J 14/87). A Board of Appeal has no power to make an order against the EPO to pay costs incurred by parties due to proceedings unjustifiably delayed by the EPO (T315/03 r.15.8; ten years to dispose of first instance opposition proceedings).

Employees of the EPO cannot be tried for neglect of duty (Art.14(a) Protocol on privileges and immunities); any claim must be made against the EPO.

Art. 9(3) The personal liability of the employees of the European Patent Office towards the Organisation shall be governed by their Service Regulations or conditions of employment.

1 Personal liability of employees of the EPO

The EPO can recover damages in whole or in part from an employee when such damages have been caused wilfully by him or her or result from serious negligence. No recovery is possible of damages caused by a decision of the board of appeal or the Enlarged Board of Appeal.

Art. 9(4) The courts with jurisdiction to settle disputes under paragraphs 1 and 2 shall be:

- (a) for disputes under paragraph 1, the courts of the Federal Republic of Germany, unless the contract concluded between the parties designates a court of another State;
- (b) for disputes under paragraph 2, the courts of the Federal Republic of Germany, or of the State in which the branch or sub-office is located.

Chapter III *The European Patent Office*

Chapter III deals with the management of the Office, the use of languages and the organisation of some departments. The EPO has approximately six thousand employees, who remain citizens of their contracting state of origin. An EPO salary is only subject to a low, internally levied tax.

Art. 10 Management**1 Powers of the President**

The President directs the EPO according to Art.10(1), which is to be interpreted in its context, in particular having regard to Art.10(2) and Art.5(3). Art.10(2) contains a list of functions and powers of the President essentially concerned with internal matters of the EPO. It is not clear to what extent the President can direct the EPO in any external activity not directly related to one of the powers and functions listed in Art.10(2) without the supervision of the Administrative Council. However, it is clear that concluding an agreement with another patent office which has no connection with the functioning of the EPO and merely serves to satisfy political interests of that office is not within the President's power. Such an agreement requires authorisation and approval from the Administrative Council under Art.33(4). Hence, an agreement of the President with the German patent office on mail intended for the EPO but erroneously addressed to the German patent office in Berlin at a time the EPO did not yet have a filing office in Berlin (OJ 1981, 381) was beyond the powers of the President. See also Art.23(1):2. (G5/88 hn.II, r.2, G7/88 and G8/88)

Art. 10(1) The European Patent Office shall be managed by the President, who shall be responsible for its activities to the Administrative Council.

Art. 10(2) To this end, the President shall have in particular the following functions and powers:

- (a) he shall take all necessary steps to ensure the functioning of the European Patent Office, including the adoption of internal administrative instructions and information to the public;
- (b) unless this Convention provides otherwise, he shall prescribe which acts are to be performed at the European Patent Office in Munich and its branch at The Hague respectively;
- (c) he may submit to the Administrative Council any proposal for amending this Convention, for general regulations, or for decisions which come within the competence of the Administrative Council;
- (d) he shall prepare and implement the budget and any amending or supplementary budget;
- (e) he shall submit a management report to the Administrative Council each year;
- (f) he shall exercise supervisory authority over the staff;
- (g) subject to Article 11, he shall appoint the employees and decide on their promotion;
- (h) he shall exercise disciplinary authority over the employees other than those referred to in Article 11, and may propose disciplinary action to the Administrative Council with regard to employees referred to in Article 11, paragraphs 2 and 3;
- (i) he may delegate his functions and powers.

1 Guidelines for Examination in the EPO (Art.10(2)(a))

The President has issued under sub-paragraph (a) the *Guidelines for Examination in the European Patent Office* to ensure a proper functioning of the EPO. The EPO has a policy of annually revising the Guidelines to keep them in line with legal and procedural developments.

The functions and powers specified in sub-paragraphs (b) to (i) are essentially concerned with the internal operations of the EPO (G5/88 r.1.2).

Art. 10(3) The President shall be assisted by a number of Vice-Presidents. If the President is absent or indisposed, one of the Vice-Presidents shall take his place in accordance with the procedure laid down by the Administrative Council.

1 Vice-Presidents

There are three Vice-Presidents, one for each Directorate-General. See the decision of the Administrative Council on deputisation for the President of the EPO (OJ 1978, 326).

Art. 11 Appointment of senior employees

This article sets out the appointment of the President and higher personnel and lays down the powers of the President in the latter.

Art. 11(1) The President of the European Patent Office shall be appointed by the Administrative Council.

Art. 11(2) The Vice-Presidents shall be appointed by the Administrative Council after the President of the European Patent Office has been consulted.

Art. 11(3) The members, including the Chairmen, of the Boards of Appeal and of the Enlarged Board of Appeal shall be appointed by the Administrative Council on a proposal from the President of the European Patent Office. They may be re-appointed by the Administrative Council after the President of the European Patent Office has been consulted.

1 Appointment of members of boards of appeal

The powers of the president of the EPO under Art.11(3) have been delegated to the president of the Boards of Appeal under R.12d(2). The persons to be appointed as members of boards of appeal are proposed by the president of the BoA on merit and appointed by the Administrative Council under Art.11(3). Once appointed, a member cannot be removed by a decision of the president of the BoA alone.

The board members are appointed for a term of five years according to Art.23(1), after which they may be re-appointed by the Administrative Council after consultation of the president of the BoA.

Art. 11(4) The Administrative Council shall exercise disciplinary authority over the employees referred to in paragraphs 1 to 3.

Art. 11(5) The Administrative Council, after consulting the President of the European Patent Office, may also appoint as members of the Enlarged Board of Appeal legally qualified members of the national courts or quasi-judicial authorities of the Contracting States, who may continue their judicial activities at the national level. They shall be appointed for a term of three years and may be re-appointed.

1 External legally and technically qualified members

The participation of external legally qualified members from the EPC contracting states in proceedings before the Enlarged Board of Appeal has proved to be a success. It is expected that the involvement of national judges will further the harmonisation of patent case law in Europe. (Spec. Ed. 4 of OJ 2007)

The EPC 2000 does no longer allow the appointment of external technically and legally qualified members for the technical and legal boards of appeal, because since the early days of the Office sufficient knowledge has become available in house. (Spec. Ed. 4 of OJ2007)

Art. 12 Duties of office

Employees of the European Patent Office shall be bound, even after the termination of their employment, neither to disclose nor to make use of information which by its nature is a professional secret.

Art. 13 Disputes between the Organisation and the employees of the European Patent Office

Art. 13(1) Employees and former employees of the European Patent Office or their successors in title may apply to the Administrative Tribunal of the International Labour Organization in the case of disputes with the European Patent Organisation, in accordance with the Statute of the Tribunal and within the limits and subject to the conditions laid down in the Service Regulations for permanent employees or the Pension Scheme Regulations or arising from the conditions of employment of other employees.

Art. 13(2) An appeal shall only be admissible if the person concerned has exhausted such other means of appeal as are available to him under the Service Regulations, the Pension Scheme Regulations or the conditions of employment.

Art. 14 Languages of the European Patent Office, European patent applications and other documents

See for the implementation:

R.3 Language in written proceedings

R.4 Language in oral proceedings

R.5 Certification of translations

R.6 Filing of translations and reduction of fees

R.7 Legal authenticity of the translation of the European patent application

R.36(2) Language of divisional application

1 Transitional provision EPC 2000

The revised Art.14(1) and (2) shall apply to European patent applications filed after entry into force of the EPC 2000 (Art.7(1) Revision Act, Spec. ED. no. 4, OJ 2007, p. 217). Hence, a filing date will be accorded for a European application filed in any language only if the application has a filing date on or after date of entry into force of the EPC 2000.

The revised Art.14(3) to (6) shall apply to European patent applications pending at the time of entry into force of the EPC 2000 and to European patents already granted at that time (Art.1(1) Dec. Adm. Council, Spec. Ed. no. 4, OJ 2007, page 219).

2 Language restrictions

The framework of language restrictions in the EPC is based on three categories of languages:

- 1 the three official languages of the EPO, i.e. English, French and German (Art.14(1), first sentence)
- 2 the official languages of the EPC contracting states other than English, French or German (Art.14(4), first sentence). These languages are also called 'admissible non-EPO languages'.
- 3 all other languages.

For the purpose of according a date of filing, a European patent application may be filed in any language (see R.40), thereby implementing Art.5(2) PLT. For the prosecution of an application by the EPO, the application must be available in one of the official EPO languages (Art.14(2), first sentence). If the application was initially filed in an another language, it must be translated into one of the official EPO languages (Art.14(2), first sentence), the choice of the official EPO language being at the option of the applicant. The official EPO language of filing or translation becomes the language of the proceedings (Art.14(3)). In all proceedings before the EPO a party must use the language of the proceedings. However, another official EPO language may be used in written and oral proceedings, provided a translation or interpretation is provided where required by R.3 and R.4.

R.6(3) provides a reduction of fees where an admissible non-EPO language is used for filing patent applications to compensate for the burden of providing a translation into an official EPO language. Art.14(4) and R.6(4) restrict the fee reduction to certain persons.

Art. 14(1) The official languages of the European Patent Office shall be English, French and German.

Art. 14(2) A European patent application shall be filed in one of the official languages or, if filed in any other language, translated into one of the official languages in accordance with the Implementing Regulations. Throughout the proceedings before the European Patent Office, such translation may be brought into conformity with the application as filed. If a required translation is not filed in due time, the application shall be deemed to be withdrawn.

1 Language of the patent application

The requirements for obtaining a date of filing for a European patent application in R.40(1) do not contain a restriction on language. Hence, the application may be filed in any language, such as Chinese, Dutch or Latin. This is supported by the words 'any other language' in Art.14(2). The documents of the application need not all be in the same language (A-VII,1.1; EPO practice changed in 2014, see Guidelines edition November 2014).

The content of a European prior right, i.e. a prior art document under Art.54(3), is determined by the original text as filed, not by any translation into an official EPO language (A-VII,7).

It is in principle possible to file a computer translation if there is not sufficient time to prepare a proper translation within the time limit of R.58 and to correct the translation subsequently. However, this may cause the search to be based on an incorrect translation or the issue of a declaration of an incomplete search, affecting the following proceedings. The EPO may ask a certificate of translation under R.5 if it has doubts as to the accuracy of the translation.

Art. 14(3) The official language of the European Patent Office in which the European patent application is filed or into which it is translated shall be used as the language of the proceedings in all proceedings before the European Patent Office, unless the Implementing Regulations provide otherwise.

1 Language of the proceedings

The official EPO language in which the application is filed or translated becomes the language of the proceedings. The language of the proceedings cannot be changed during the proceedings concerning an application or the resulting patent, because this is not provided for in the EPC.

The language of the proceedings must be used in all proceedings before the EPO (Art.14(3)). Hence, in written proceedings all documents should be filed in the language of the proceedings. Derogations for written proceedings are provided in R.3, which allows that documents may be filed in any official EPO language (R.3(1)), except for amendments of the application or patent, which must be in the language of the proceedings (R.3(2)). Documents to be filed within a time limit may also be submitted in an admissible non-EPO language and subsequently translated into an official EPO language (Art.14(4)). Documentary evidence may be filed in any language (R.3(3)).

In oral proceedings the default language is the language of the proceedings (Art.14(3)), but any official language of the EPO or a contracting state may be used, provided the provisions for interpretation in R.4 are observed.

Art. 14(4) Natural or legal persons having their residence or principal place of business within 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, may file documents which have to be filed within a time limit in an official language of that State. They shall, however, file a translation in an official language of the European Patent Office in accordance with the Implementing Regulations. If any document, other than those documents making up the European patent application, is not filed in the prescribed language, or if any required translation is not filed in due time, the document shall be deemed not to have been filed.

1 Language of further documents and translation

Further documents, i.e. documents other than those making up the European patent application, must be filed in the language of the proceedings (Art.14(3)). By way of exception, a further document may also be filed in another official EPO language (R.3(1)). When the document concerns amendments of the patent application, it must be filed in the language of the proceedings (R.3(2)).

Art.14(4), first sentence, allows a restricted class of persons to file further documents in an official language of an EPC contracting state. These documents must subsequently be translated into an official EPO language (Art.14(4), second sentence) in accordance with R.3: for most documents into any official EPO language (R.3(1)) and, where the documents concern amendments, into the language of the proceedings (R.3(2)).

Art.14(4) defines the persons that may file those further documents that have to be filed within a time limit in an official language of a contracting state. A translation in any official EPO language must normally be filed within one month of filing the document (R.6(2)).

Whereas a mistake in the translation of a patent application can be corrected using Art.14(2) second sentence, the translation of a further document can only be corrected as an error under R.139 (G6/91 r.10).

2 Admissible non-EPO language

The official languages of contracting states in which further documents in the meaning of Art.14(4) may be filed with the EPO are referred to in this book as 'admissible non-EPO languages', or 'admissible languages' if the latter does not cause confusion (see A-X,9.2.1(ii)). The terms 'authorised language' and 'allowed language' sometimes occur in case law.

The official languages of the contracting states are listed in NatLaw table 11, column 4. A few special cases of official languages:

Belgium	Dutch, French and German
Finland	Finnish and Swedish
Ireland	Irish and English
Liechtenstein	German
Luxembourg	French, German and Luxembourgish
Switzerland	German, French, and Italian.

Where a contracting state has several official languages, the choice of language is up to the party. A party who has several nationalities may choose between the official languages of the contracting states of which he is a national and the contracting state where he has his residence (Münchener Gemeinschaftskommentar, K. Haertel (Heymanns) Art. 14, p. 15, Randnummer 18 und 22). For example, a Swiss party may choose Italian as language for the fee reduction of R.6(3), even though his own language is German or French.

3 Entitled persons

Under Art.14(4), first sentence, a person is entitled to use an admissible non-EPO language if:

- he has his residence within the territory of the state,
- he has his place of business within the territory of the state, *or*
- he is a national of the state and is resident abroad, inside or outside a contracting state.

Neither the EPC nor the Guidelines indicate how to apply Art.14(4) in the case of several applicants or proprietors having different nationalities. On the ground of the liberal interpretation of the language provisions of the EPC use of an official language of a contracting state other than an official EPO language should be admissible if at least one of the applicants is entitled to use this language. (Münchener Gemeinschaftskommentar, K. Haertel (Heymanns) Art. 14, p. 15, Randnummer 23)

- (d) **Opposition Divisions;**
- (e) **a Legal Division;**
- (f) **Boards of Appeal;**
- (g) **an Enlarged Board of Appeal.**

See for the implementation:

Art.16 Receiving Section

Art.17 Search Divisions

Art.18 Examining Divisions

Art.19 Opposition Divisions

Art.20 Legal Division

Art.21 Boards of Appeal

Art.22 Enlarged Board of Appeal

Art.23 Independence of the members of the boards

Art.24 Exclusion and objection

R.9-13 Organisation of the European Patent Office

1 Reorganisations of the EPO

The departments of the EPO mentioned in Art.15 were grouped in Directorates-General (R.9(1)). Three reorganisations have changed the grouping from five Directorates-General to three and changed locations of the departments.

In 1990 the EPO started the BEST project (Bringing Examination and Search Together), which aims at improving quality and efficiency of search and examination. Before Best, the search and the examination were performed by two different persons, a searcher in the Hague and an examiner in Munich. Under BEST both the search and the examination are performed by the same examiner, who may be located in the Hague, Berlin or Munich (OJ 1990, 333 and EPO Annual Reports). The search examiner is also the primary examiner in the examining division (Not. Pres. OJ 2003, 206 §1; B-I,2). The BEST project was completed in 2006. The distinction between search divisions and examining divisions has not yet been removed from Art.15, because there was insufficient preparation time for the diplomatic conference to include such a change into the EPC 2000; it should be part of a next Diplomatic Conference.

In 2016 the departments of second instance, the Boards of Appeal and the Enlarged Board of Appeal, formerly Directorate-General 3, became part of the Boards of Appeal Unit as of 01.07.2016, a separate organisational unit to emphasise their perceived independence. The Boards of Appeal Unit has moved from the city of Munich to Haar. See R.12a and CA/43/16 Rev. 1.

In 2017 a further reorganisation combined the former Directorates-General DG1 (search, examination and opposition) and DG2 (patent administration) to have the entire patent granting process in one Directorate-General (CA/65/17). The proposed renumbering of DG4 and DG5 to DG2 and DG3 has not yet been implemented (situation 01.11.2018; see e.g. the vacancy notices for vice-presidents DG4 and DG5 in OJ 2018 A59 and A60).

2 Administrative structure of the EPO

Since 2017 the EPO is divided administratively into three Directorates-General, to which the departments of Art.15(a) - (e) are assigned (R.9(1)), and a Board of Appeal Unit to which the departments (f) and (g) are assigned.

The examiners, forming the search, examining and opposition divisions, are part of Directorate-General 1 (DG1), which is divided into three principal directorates according to technology. About the same number of examiners should be located in Munich and in the Hague (see the Protocol on the Staff Complement of the EPC 2000, reproduced in OJ 2001, Special Edition no. 1, p. 45). The examiners are assigned to a separate search division and examining division set up for each patent application filed; similarly, they are assigned to a separate opposition division set up for each patent for which a notice of opposition has been filed. The Receiving Section is also part of DG1.

Each principal directorate of DG1 includes formalities officers, which are responsible for examination on filing and examination as to formal requirements, tasks the EPC has allocated to the Receiving Section (Art.16 and R.10(1)).

Directorate-General 4 (DG4) is Corporate Services, comprising human resources, general administration, central procurement and finance.

Directorate-General 5 (DG5) comprises the Legal Division and legal and international affairs, located in Munich.

Departments (a) till (e) are departments of first instance, departments (f) and (g) departments of second instance.

Although the EPC distinguishes the Receiving Section, search divisions, examining divisions, opposition divisions and the Legal Division as departments of the EPO, they are no longer indicated as separate organisational units in the Organisational Structure of the EPO. To ensure greater flexibility in allocating specific tasks, the EPC 2000 has removed several references to the Receiving Section and search divisions and replaced wording such as 'the Receiving Section shall ...' by 'the EPO shall ...' (compare Art.90(1), 92, 93(1)).

A case is transferred from one department to another at the moment of receipt of the appropriate message and a possible payment, e.g. the request for examination (see e.g. R.10). The department to which the case is transferred becomes competent to handle the case.

Art. 16 Receiving Section

The Receiving Section shall be responsible for the examination on filing and the examination as to formal requirements of European patent applications.

See for the implementation:

R.10(1) Limitation in time of responsibility of Receiving Section

1 Responsibilities of the Receiving Section

According to Art.16 the Receiving Section is responsible for the examination on filing, i.e. whether a filed application can be accorded a filing date (Art.90(1), R.55) and the examination as to formal requirements (Art.90(3), R.56-60); according to A-VI,2.1, it also takes care of the publication of the application (Art.93, R.67-69). The Receiving Section is composed entirely of formalities officers (G1/02, r.6.1)

The Receiving Section is not competent to decide on a request for an amendment or correction of an application that requires a technical examination; the decision on such a matter must wait until the case has been transferred to the examining division, because the latter is competent in such matters (J4/85).

Art. 19 Opposition Divisions

Art. 19(1) The Opposition Divisions shall be responsible for the examination of oppositions against any European patent.

Art. 19(2) An Opposition Division shall consist of three technically qualified examiners, at least two of whom shall not have taken part in the proceedings for grant of the patent to which the opposition relates. An examiner who has taken part in the proceedings for the grant of the European patent may not be the Chairman. Before a decision is taken on the opposition, the Opposition Division may entrust the examination of the opposition to one of its members. Oral proceedings shall be before the Opposition Division itself. If the Opposition Division considers that the nature of the decision so requires, it shall be enlarged by the addition of a legally qualified examiner who shall not have taken part in the proceedings for grant of the patent. In the event of parity of votes, the vote of the Chairman of the Opposition Division shall be decisive.

1 Composition of opposition division

Art.19(2) establishes the collegiate nature of opposition divisions. The presence of one member who may have taken part in the grant proceedings is a compromise. On the one hand the purpose of an opposition is the examination of new facts and/or arguments added to the proceedings, for which examination there is no reason to deprive the opposition division of the available knowledge of the case, and on the other hand the members of the opposition division should be unbiassed as in appeal proceedings. The possibly biased member is always in a minority position. (Empel no. 465)

A composition of an opposition division not complying with Art.19(2) is a substantial procedural violation in the sense of R.103(1)(a) (T251/88; T382/92; G5/91 r.5).

The examiners must be impartial. If an examiner is suspected of partiality, he may be objected to as set out in Art.24:2.

Art. 20 Legal Division

Art. 20(1) The Legal Division shall be responsible for decisions in respect of entries in the Register of European Patents and in respect of registration on, and deletion from, the list of professional representatives.

1 Duties of Legal Division

The Legal Division has the sole responsibility for the following duties regarding the Register of Patents (Art.127): entitlement procedure (Art.61(1) and Art.99(4)), interruption of proceedings, registration of licences and other rights, registration of transfers of rights and changes of name, and rectification of the designation of the inventor (Dec. Pres. OJ 2013, 600).

The duty of registration of transfers of rights and changes of name and rectification of the designation of the inventor is entrusted to formalities officers of examining divisions and opposition divisions under R.11(3) if the request can be granted directly (Dec. Pres. OJ 2013, 601).

The Legal Division has also the sole responsibility for entries, registrations and deletions in the Register of Representatives (Art.134(1)) and for assessment of the legal incapacity of a professional representative (J901/86 hn3) (OJ 2013, 600).

Art. 20(2) Decisions of the Legal Division shall be taken by one legally qualified member.

1 Decisions of the Legal Division

Decisions of the Legal Division can be appealed before the Legal Board of Appeal (Art.106(1) and Art.21(2), see J1/78 as an example).

Art. 21 Boards of Appeal

See for the implementation:

R.12a Boards of Appeal Unit and President of Boards of Appeal

R.12b Presidium of the Boards of Appeal

R.12c Boards of Appeal Committee and Rules of Procedure

R.12d (Re-)appointment of members of boards

1 Competence of boards of appeal

Art.21 governs the competence of the boards of appeal. The boards are responsible for the examination of appeals from decisions of first instance departments and have jurisdiction to interpret the EPC. The boards have also jurisdiction to refuse enforcement of legislation which has been defectively enacted, for example if passed by an insufficient number of contracting states or delegations of the Administrative Council, or enforcement of a Rule which conflicts with an Article in the sense of Art.164(2) (T315/03 r.5.8).

A board of appeal has the status of an internationally recognized judicial authority, because its members are only bound by the EPC (Art.23(3)), they are appointed for a fixed term (Art.23(1)), their impartiality is safeguarded (Art.24), at least one of the members is legally qualified (Art.21), they have their own rules of procedure (R.12c(2)) and they issue written, reasoned decisions (R.102) (G1/97 r.5(c)).

Duties are allocated to the departments of second instance by the Presidium of R.12b(4), and not by the President. The Administrative Council can delegate disciplinary matters against a professional representative to an existing board of appeal (R.12b(6)). However, until now these matters have been dealt with by a separate board. The Rules of Procedure for the Boards of Appeal are adopted by the Boards of Appeal Committee (R.12c(2)).

Cases from examining divisions not handled by technical boards of appeal as specified in paragraphs (3a) and (3b) of Art.21 are normally handled by the Legal Board of Appeal (paragraph (3c)), e.g. a decision from an examining division consisting of fewer than four members and not relating to the refusal of a patent application, the grant, limitation or revocation of a patent, but for example to re-establishment (G2/90 r.3.2, adapted to the revised wording of Art.21(3)(a)). See Art.21(3):1.2 for an exception.

Art. 21(1) The Boards of Appeal shall be responsible for the examination of appeals from decisions of the Receiving Section, the Examining Divisions and Opposition Divisions, and the Legal Division.

1 Competence to examine appeals

The search division does not issue decisions. Hence, an opinion of the search division, e.g. on lack of unity of invention, cannot be appealed. There is also no possibility to appeal a decision of the President or a decision of a board of appeal, because these decisions are not comprised in the exhaustive list of Art.106(1).

caused by the introduction of new lines of attack by a new party. (G2/04, r.2.1.2, r.2.2.2, hn.Ia; see also G3/97, r.2.2)

The EPO has the duty to consider the opponent status at all stages. The validity of a transfer of opponent status may therefore be raised at all stages during the proceedings, even for the first time in appeal. If the alleged opponent files an appeal, his status as opponent is not protected by the prohibition on *reformatio in peius*. If the board denies the validity of the transfer, the opposition procedure has to be redone from the time of the transfer, this time with an entitled opponent. (T1178/04)

Examples of universal succession are succession from a deceased person and incorporation and merging of legal persons (T355/86; T349/86; T475/88). G4/88 also allowed the transfer of opponent status to a third party in a case where a company filed an opposition in the interest of a part of the company without legal personality and subsequently transferred the assets of that part to the third party. The opposition, which is an inseparable part of the assets, must be regarded as transferable when the assets are transferable in accordance with the principle that an accessory object follows the principal object. Hence, an opposition may be transferred as part of the opponent's assets together with the assets in the interest of which the opposition was filed. Case law has not extended the rationale of G4/88 to other situations. See also T670/95 and T711/99. In T74/00, it was held that, unlike a legal transfer of an opposition, a transfer arising from the death of the opponent need not be accompanied by any specific assets of the deceased. The new opponent gains its status purely from being the heir of the previous opponent.

G2/04 refused the transfer of opponent status to a third party where a company filed an opposition in the interest of one of its subsidiaries having legal personality and subsequently transferred the assets of the subsidiary to the third party. Since the company in G4/88 was the sole legal entity and could not file an opposition in the name of the part of the company, whereas the company in G2/04 could file an opposition in the name of its subsidiary, the Board concluded that the two cases are essentially different. The Board decided to interpret G4/88 restrictively and not to extend its rationale to other situations because there was no overriding interest of the parties or the public. (G2/04 r.2.2; see also T711/99, reaching the same conclusion based on G3/97)

The status of party may be transferred within the above bounds at any stage of the opposition and opposition appeal; the right to lodge an appeal may also be transferred (T563/89 r.1.1). The transfer must be substantiated (T670/95). The previous party retains its rights until the required proof has been provided (R.22(3); T870/92a). If a purported notice of appeal does not indicate how a transfer of status has taken place, it is not the duty of the Board of Appeal to investigate further (for example, by examination of appropriate trade registers) to substantiate the transfer (T428/08). A transfer may be to only one successor party to avoid other persons becoming party to the proceedings after expiry of the time limits and without payment of fees (T298/97 r.7.6).

The following precautions can be taken to avoid problems in a transfer.

- File the opposition or opposition appeal in the name of both the company and the subsidiary if the latter has legal personality; the company can withdraw from the opposition after the transfer (G2/04 r.2.1.2). See T960/08 r.3.1 for necessary conditions and T9/00 for a failed variant of this precaution.
- File the opposition or opposition appeal in the name of the company as a main request and in the name of the subsidiary as an auxiliary request (G2/04 r.3.2; see e.g. T1877/08 r.1).

- Ask the EPO for advice before filing the opposition or appeal, noting date and persons contacted for later proof. In case the EPO refuses the transfer, the principle of good faith may be invoked to correct the name of the opponent (see Art.125:2).
- File the opposition and opposition appeal through a straw man as legally accepted by G3/97, because any transfer of the straw man's principal need not be entered in the Register of the EPO.

1.5 WITHDRAWAL OF THE OPPOSITION

Withdrawal of an opposition does not directly end the opposition procedure, as the opposition division may continue the proceedings of its own motion in the public interest (Art.114(1) and R.84(2)). Moreover, the Division must take a decision to be entered in the Register (R.143(1)(r)). (T197/88)

The opposition proceedings are also continued if one or more common opponents withdraw from the opposition, since otherwise a single one of the common opponents, not being the common representative, could of its own motion end the opposition (G3/99 r.13). The common representative should notify the EPO of any withdrawal. A withdrawal of the common representative should also be communicated to the EPO; the new common representative must be appointed either by the remaining common opponents or by application of R.151. See also R.151(1):2.

See also R.84 for surrender of the patent, death of the opponent and withdrawal of the opposition during first instance proceedings and Art.108:1 for withdrawal in opposition appeal.

2 Filing

2.1 PERIOD FOR FILING

Opposition can only be raised against a granted patent within nine months from the publication of the mention of the grant under Art.97(3) (Art.99(1)), not from the publication of the patent specification under Art.98. An opposition filed before the mention of the publication of grant of the patent is not regarded as an opposition. In that case the opposition documents become part of the public file and the opposition fee is refunded (D-IV,1.1).

Since the nine-month period and the payment of the opposition fee are regarded as essential requirements, they are provided in the Convention and not in the Implementing Regulations.

2.2 FORMAL REQUIREMENTS

The notice of opposition must be in writing (R.76(1)) and signed (R.76(3), R.50(3), D-III,3.4). It must be filed with an EPO filing office using a method permitted under R.2(1). The notice may be filed e.g. by fax (R.2(1):6) or electronically (R.2(1):7), but not using Web-Form Filing (D-III,3.2).

The notice must be in one of the three languages of the EPO, not necessarily the language of the proceedings (R.3(1)). Since the notice is a document to be filed within a time limit, it may also be filed in an official language of a contracting state according to Art.14 if the opponent (not his representative, T149/85) has his residence or place of business in that state or is a national of that state. In that case a translation in one of the three EPO languages must be filed within the longer of one month from filing the notice and the end of the opposition period (R.6(2)). Failing the time limit for filing the translation cannot be corrected according to Art.121 or 122, because the opponent is not an applicant or proprietor (T702/89).

2.3 OPPOSITION FEE AND LATE FILING

The opposition will be deemed not to have been filed until the opposition fee has been paid (Art.99(1), second sentence). The amount of the opposition fee is fixed in Rfees2(1)10. A single opposition filed by two or more persons acting in common is admissible on payment of only one opposition fee (G3/99 r.10). A late filing of the notice of opposition or a late payment of the opposition fee cannot be remedied with Art.121, Art.122 or R.139, because an opponent is not an applicant or proprietor as required by Art.121 and 122 and the acts of late filing and payment are not errors or mistakes in documents as required by R.139. (T702/89 r.3, T323/87 r.5, T128/87 r.2)

3 Notice of opposition deemed (not) to have been filed

On receipt of the notice of opposition the EPO assesses whether the opposition is regarded as filed on the basis of the received documents (D-IV,1.2.1). Only after the notice is regarded as filed will the EPO assess the admissibility of the opposition under Art.101. All cases where a notice of opposition is regarded as not filed can be derived directly from the EPC. See T765/08, r.9-11 for the legal status of a document deemed not to have been received.

An opposition will be regarded as not filed if:

- The opposition fee is not paid in due time (Art.99(1)), causing the opposition being deemed not to have been filed.
- The notice has no signature (R.76(3) in conjunction with R.50(3)), or the signature has not been provided in time, causing the notice being deemed not to have been filed (D-IV,1.2.1(ii)). Further processing and re-establishment are not available for the opponent. If, after invitation by the formalities officer, it is provided in due time, the notice retains its date of filing (R.50(3)). The reproduction of the signature on a notice of opposition by fax will be accepted as signature (D-III,3.4).
- The notice has been sent by fax and no confirmation copy has been filed in due time after invitation, causing the notice being deemed not to have been received (R.2(1); OJ 2007 se3 p.7 Art.7(2)).
- When the opponent is represented and the authorisation has not been filed on invitation by the EPO within the time set (R.152(2)). The act of filing is deemed not to have been carried out (R.152(6)).
- The notice of opposition is not in an official language of the EPO according to R.3(1) nor in an admissible non-EPO language according to Art.14(4), e.g. in Japanese. The opposition will be regarded as not filed, unless the opposition is filed in an admissible language before the end of the opposition period (Art.14(4)). Beware, R.6(2) does not apply to an opposition filed in Japanese, because the filed opposition is not a translation relating to a document filed in an admissible non-EPO language according to Art.14(4).
- The notice of opposition is filed in an official language of a contracting state but the opponent is not entitled to use the language according to Art.14(4). Hence, a notice of opposition in Dutch of a German opponent is deemed not to have been filed, even if the opponent is represented by a Dutch representative (Art.14(4); T149/85).
- The notice is filed in an admissible non-EPO language but the translation of the notice required under Art.14(4) is not filed within the longer of one month after filing the notice or the end of the opposition period (R.6(2)). Hence, the notice is regarded as not received (this applies to all further documents entering the EPO) (Art.14(4)). (T193/87; D-IV,1.2.1(v))

4 Procedure after filing

An opposition division is the competent department of the EPO to assess the notice of opposition (Art.19(1)). It first assesses whether the notice of opposition is deemed to have been filed or not, next it examines the admissibility of the opposition (Art.101(1) and R.77) and finally it examines the allowability of the opposition, i.e. whether the invoked grounds for opposition prejudice the maintenance of the patent (Art.101(1)).

The following four cases may arise from filing an opposition:

- No opposition has been started, because the notice of opposition is deemed not to have been filed, e.g. due to late filing of the notice of opposition or late payment of the opposition fee. An already paid opposition fee will be refunded. See Art.101(1):1 and D-IV,1.4.1.
- An opposition has been started but not yet the procedure due to major errors in the notice of opposition. The errors must be remedied according to R.77(1) within the opposition time limit, otherwise the opposition is inadmissible. The fee paid for an inadmissible opposition is not refunded. See R.77(1):1 and D-IV,1.2.2.1.
- An opposition has been started and a procedure has been started conditionally, because of small errors in the notice of opposition. The errors must be corrected according to R.77(2) within a period to be set by the EPO (normally 2 months) (D-IV,1.3.2, 1.4.2), otherwise the notice is inadmissible. See R.77(2) and D-IV,1.2.2.2.
- An opposition and procedure have been started according to Art.101.

Art. 99(2) The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.

1 Territorial extent of opposition

The opposition is in respect of all designated states. An opposition filed in respect of only some of the designated states is treated as if it were filed in respect of all designated states (D-I,3). The outcome of the opposition proceedings also applies to the extension states and validation states, based on their national law (see Art.169:4 and e.g. OJ 2016 A5 §17 for Morocco)

The patent in opposition may have different claims, description and drawings for different designated states because of national prior rights (R.138), European prior rights under EPC 1973 (see Art.54(3):3), or a transfer of the patent to an entitled third party for some but not all designated states (R.18(2); R.78(2)).

Art. 99(3) Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.

1 Parties to opposition proceedings

In the formal examination by the formalities officer of the notice of opposition to assess whether the notice is deemed filed and admissible, the proprietor is not involved. This part of the examination is in fact *ex parte* (D-IV,3; Empel no. 472). The subsequent substantive examination is *inter partes*.

If an opposition is withdrawn or finally rejected as inadmissible, the opponent is no longer a party in the proceedings (D-I,6). An assumed infringer who intervenes according to Art.105 becomes party to the opposition proceedings. A third person who has filed an observation according to Art.115 is not a party to the proceedings.

Art. 99(4) Where a person provides evidence that in a Contracting State, following a final decision, he has been entered in the patent register of such State instead of the previous proprietor, such person shall, at his request, replace the previous proprietor in respect of such State. Notwithstanding Article 118, the previous proprietor and the person making the request shall not be regarded as joint proprietors unless both so request.

Art.118 Unity of patent

See for the implementation:

R.78 Procedure where the proprietor is not entitled

1 Opposition and entitlement procedure

If during the opposition period or the opposition procedure a third person provides proof to the EPO that he has started court proceedings seeking a judgement that he is entitled to the patent, the opposition procedure will be stayed, unless the third person consents to continuation of the opposition procedure (R.78(1)).

The Protocol on Recognition, according to which entitlement decisions of national courts must be recognized in all EPC Contracting States, applies only to patent applications and not to patents. Therefore, a national decision on entitlement to a patent is not recognized by the other states designated in the patent on the basis of the Protocol. However, such a decision can be recognised in the EU based on EU Regulation 1215/2012 and in most EFTA countries based on the Lugano Convention.

When the entitled person has replaced the first proprietor for some but not all designated states and the entitled person and first proprietor do not request to become joint proprietors, there will be two opposition procedures running at the same time before the same opposition division. This allows the new proprietor to defend independently the part of the patent right transferred to him against the opposition. In such a case, the outcome of the opposition can be different for the respective states (see R.78(2)).

Art. 100 Grounds for opposition

Opposition may only be filed on the grounds that:

- (a) the subject-matter of the European patent is not patentable under Articles 52 to 57;
- (b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed under Article 61, beyond the content of the earlier application as filed.

Art.52 Patentable inventions

Art.53 Exceptions to patentability

Art.54 Novelty

Art.55 Non-prejudicial disclosures

Art.56 Inventive step

Art.57 Industrial application

Art.61 Application filed by non-entitled person

1 Grounds for opposition

The list of grounds for opposition in Art.100 is exhaustive in view of the word 'only' in Art.100.

The grounds for opposition must, in principle, be set out in the notice of opposition. The EPO has restricted the possibilities for introducing new grounds during the opposition procedure, i.e. after expiry of the 9-month opposition period (see R.76(2)(c):3). See R.76(2):4.3.3 for a discussion what grounds are regarded as separate grounds.

1.1 PATENTABILITY (ART.100(A))

The ground of Art.100(a) applies if the subject-matter of the claims of the patent as granted is considered not to be an invention under Art.52, if it falls under one of the exceptions to patentability (Art.53), if it is not new (Art.54), if it does not involve an inventive step (Art.56) or if it is not susceptible to industrial application (Art.57). The opposition procedure is especially suitable for revealing unpatentability in view of oral disclosure or prior use.

A notice of opposition indicating only national prior rights is inadmissible, because these rights are not European prior rights within the meaning of Art.34(3) and are accordingly not comprised in the state of the art; they can therefore, not support the ground of Art.100(a) (D-III,5; T550/88 hn1 and hn2). Nevertheless, during the opposition proceedings the patent may be amended in view of national prior rights (R.138, H-II,3.3, see also R.80).

1.2 DISCLOSURE (ART.100(B))

Art.100(b) relates to not compliance with the requirement of sufficiency of disclosure of Art.83.

If an embodiment of the invention is not sufficiently disclosed, that embodiment should be deleted from the patent. If the proprietor does not remove it, the embodiment itself cannot be revoked, because the EPO can only decide on the patent in the text submitted or approved by the proprietor (Art.113(2)); in this case the entire patent has to be revoked.

1.3 EXTENSION (ART.100(C))

Art.100(c) corresponds to Art.123(2) and provides a sanction in case the claims of the patent lack basis in the application as filed, and for a patent granted on a divisional application also in case the claims as granted lack basis in the earlier application as filed (Art.76(1)).

If the application as filed is in a non-EPO language, the claims as granted must have a basis in the application as filed in the non-EPO language (Art.70(2)). The opposition division may assume that the translation of the application filed during the grant procedure is correct (R.7), unless evidence to the contrary is provided, for example by the opponent (D-V,6.1).

2 Invalid grounds for opposition

Other grounds than those of Art.100 cannot be used in the notice of opposition. Examples of invalid grounds:

- The claims do not comply with the unity requirement of Art.82 (T162/85 r.9; see Art.82:3).
- The claims are not clear and concise in the sense of Art.84 (see Art.84:4 and T409/91 for the relation between Art.83 and Art.84). Art.84 was not included as ground of opposition, because the other grounds for opposition were regarded adequate to deal with these issues and clarity objections would delay the opposition proceedings too much (Travaux Préparatoires EPC 1973, see G3/14 r.69).

3 Preparation of the examination

If the opposition is regarded as admissible, the formalities officer will start the preparation of the examination and will invite the parties to file observations regarding the opposition. The formalities officer will first invite the proprietor to file his observations and any amendments to the patent (R.79(1)). The amendments must comply with R.80. The EPO forwards the response of the proprietor to the opponent and invites him to reply, if considered expedient (R.79(3)). The dossier is subsequently forwarded to the opposition division. During the examination the EPO may invite parties to reply on specific issues (R.81(2), (3)).

The usual period for responding to communications under R.79 and 81 is four months for matters of substance and two months for other matters. This periods may be extended exceptionally on a reasoned request (see R.132(2);2; E-VIII,1.6).

4 Acceleration of the procedure

The total time needed for a decision in straightforward cases is 15 months from expiry of the opposition period (OJ 2016 A43).

The processing will be accelerated if an infringement action is pending before a national court of a contracting state and a party to the opposition proceedings files a reasoned request with the EPO or the national court informs the EPO. The EPO will make every effort to issue the next procedural step within three months from the request. The parties should cooperate in making their submission promptly and in full. Extension of periods above the normal four months will be granted only in exceptional, duly substantiated cases. (E-VIII,5)

Further reasons for acceleration are given in D-VII,1.2, e.g. where the opposition proceedings are of a considerably longer duration than usual. The PACE program is not applicable in opposition (OJ 2015 A94 §9).

5 Extent of substantive examination

The extent of the substantive examination is restricted by the extent of the opposition stated in the notice of opposition according to R.76(2)(c). The grounds given in the notice of opposition define the legal framework of the examination. Addition of grounds during the procedure is restricted as set out in R.76(2):4. Facts and evidence should be provided in the notice of opposition (R.76(2)(c)). If filed later, they may be disregarded (Art.114(2); R.76(2):4.3). Amendments of the patent made during the opposition procedure are open to all possible objections according to Art.101(3).

The opposition division is not obliged to consider all the grounds for opposition referred to in Art.100. The examination of grounds for opposition is guided by the following principles developed by the Enlarged Board. The opposition division is obliged to examine only those grounds for opposition listed in the opponent's statement under R.76(2)(c). In addition to this, the opposition division may in accordance with Art.114(1) examine of its own motion any ground for opposition under Art.100 not invoked by the opponent where said ground is relevant and prejudices the maintenance of the European patent. (G10/91 hn.2)

The practice of the office is to consider mainly the grounds set out in the notice of opposition, following G10/91 and laid down in Art.101(1) and R.81(1). However, the EPO will not be very strict in restricting the grounds to those of the notice of opposition; it will make an effort to consider as many grounds as possible as compliant with a fast procedure.

6 Substantive examination of the opposition

The substantive examination of the opposition must be carried out in accordance with R.81. Chapter D-V of the Guidelines gives details of the examination of the grounds of Art.100.

The patent may be amended only when the amendments are occasioned by grounds of Art.100 (R.80). The amendment may not extend the subject-matter of the patent beyond the original disclosure (Art.100(c)) nor extend the protection conferred (Art.123(3)). It is permissible to replace a granted single independent claim by two or more independent claims, if this is the most appropriate response to the grounds of opposition (T263/05). Subject matter in the description of the application which was deleted during prosecution as no longer relevant to the claimed invention will not generally be allowed to be reinstated during opposition (T684/02).

If parties in an opposition procedure take different views, the burden of proof is on the opponent (T219/83). If the opponent proves that the teaching of the patent does not lead to the claimed result and the opposition division shares this view, the proprietor must prove to the contrary (F-III,4).

According to Art.101(1) and R.79(1), the proprietor has a right to file observations on a notice of opposition. Any further observations of parties are only admissible if the opposition division deems them necessary and expedient. This is in the interest of the efficient conduct of the opposition proceedings. The parties must follow the guidance of the opposition division, and not proceed of their own motion. (T295/87)

The opposition division may invite parties to file further observations to clarify issues. All communications and replies thereto are communicated to all parties (R.81(2)). The proprietor will be invited, where appropriate, to file amendments to the patent (R.81(3)). To comply with the requirement of Art.113(1), any communication to the proprietor will contain a reasoned statement, covering all grounds against maintenance of the patent, where necessary (R.81(3)). Oral evidence may be taken (Art.117, R.117, D-VI,1; E-IV,1.2 and 1.4) or an additional search may be carried out, where necessary (D-VI,5).

The format of the documents sent to the EPO must comply with R.35-50 according to R.86; for example the documents must be signed (R.50(3)).

The period for filing the observations is normally fixed at four months (D-VI,3.1 & E-VIII,1.2(ii)), which may be extended on request to six months (E-VIII,1.6). No direct loss of rights occurs when failing the time limit fixed for filing observations in opposition proceedings (G1/90 r.8). The EPO regards submissions and requests from parties as received in time when they have been filed before closure of the proceedings (see G12/91 hn); however, facts and evidence may be disregarded under Art.114(2) when not filed in due time (E-VIII,1.8, similar to R.83, second sentence). To speed up the procedure, the EPO may send the proprietor a courtesy reminder if he has not filed observations in due time; if the proprietor does not respond to the reminder, the proceedings will be continued without his observations.

Oral proceedings are being held if requested by a party or considered expedient by the opposition division (Art.116(1)). The parties will be summoned in accordance with R.115(1) and their attention will be drawn to the points to be discussed (R.116). The conduct of oral proceedings has been set out in Art.116:3.

Art. 101(2) If the Opposition Division is of the opinion that at least one ground for opposition prejudices the maintenance of the European patent, it shall revoke the patent. Otherwise, it shall reject the opposition.

2 Revocation of the patent

The patent will still be revoked in spite of the Division's favourable opinion if:

- 1 The fee for publishing the new patent specification has not been paid in 3 months (R.82(2)), nor has the fee for publishing with surcharge been paid within 2 months of notification of the failure to pay (R.82(3)).
- 2 The translations of the amended claims in the other two languages of the EPO have not been filed in 3 months (R.82(2)), nor have they been filed with surcharge 2 months after notification (R.82(3)).
- 3 No new representative has been appointed within 2 months after an interruption of the proceedings because of death or legal incapacity of the representative (R.142(1)(c)), while representation is necessary according to Art.133(2). (R.142(3)(a))

The proprietor can remedy failure to meet the above time limits with re-establishment (Art.122). Further processing is not available because the periods do not relate to a patent application but to a patent.

Art. 102 (deleted)**Art. 103 Publication of a new specification of the European patent**

If the European patent is maintained as amended under Article 101, paragraph 3(a), the European Patent Office shall publish a new specification of the European patent as soon as possible after the mention of the opposition decision has been published in the European Patent Bulletin.

Art.101(3)(a) Maintenance of the patent in amended form

See for the implementation

R.87 Content and form of the new specification

1 Publication

The words 'as soon as possible' in the provision indicate that it is not always technically possible to publish the new specification on the same day as the mention of the opposition decision is published in the Bulletin (OJ 2007 se4 (EN) p.112). The new specification is published in electronic form (R.87 referring to R.73(2)).

Art. 104 Costs**1 General**

Each party to proceedings pays its own costs unless the opposition division orders a different apportionment of costs (Art.104(1)), where one party has to pay some or all of the costs incurred by another party. For example, the division may order an opponent to pay to the proprietor the costs incurred by the proprietor for attending oral proceedings. A cost apportionment is given where reasons of equity demand so, i.e. for reasons of fairness. Since the different apportionment is the only exception in the EPC to the principle that each party pays its own costs, there is no room for a practice that the losing party reimburses the costs of the winning party.

Art. 104(1) Each party to the opposition proceedings shall bear the costs it has incurred, unless the Opposition Division, for reasons of equity, orders, in accordance with the Implementing Regulations, a different apportionment of costs.

1 Reasons for apportionment

A decision to apportion costs differently requires special circumstances such as improper behaviour which make it equitable to award costs against one of the parties (T170/83). A cost apportionment can be given in case of conduct of a party which is not in keeping with the care required to assure the effective exercise of the rights involved or which stems from culpable actions of an irresponsible or even malicious nature (T765/89). Since apportionment of costs is a matter of equity, no absolute rules can be given for when a cost apportionment is justified or not. Costs may even be apportioned against the winning party; e.g. in case a prior art document is filed late by the opponent without justification and the revocation of the patent is based on that document, a cost apportionment may be given against the opponent.

Art.16(1) RPBA gives a few examples where a different apportionment of costs may be given in appeal: amendment of a party's case, extension of a period, acts or omissions prejudicing the timely and efficient conduct of oral proceedings, failure to comply with a direction of the board, abuse of procedure. Additionally, the requirement of equity of Art.104 must of course be complied with.

Examples from the Guidelines and case law:

- The proprietor requests revocation of the patent (see Art.99(3):1) just before the proceedings and it was already clear that the proprietor had no case when the summons were issued. The unnecessary costs for preparing oral proceedings incurred by the opponent may be charged to the proprietor. (see D-IX,1.4)
- Relevant facts and evidence, including prior art, are submitted at a late stage without a good reason (T117/86); the same applies for requests.
- Notification just prior to the oral proceedings that a party will not appear and the non-attendance renders the oral proceedings unnecessary (T937/04 r.5.2). A different apportionment may not be appropriate in cases as sudden serious illness. A party summoned to oral proceedings has the equitable obligation to inform the EPO as soon as he knows that he will not be attending (T212/07).
- Culpably making inaccurate or false statements, thereby requiring the other party to incur cost for gathering further evidence (T952/00).

Apportionment of costs cannot be based on withdrawal of an appeal, because such withdrawal is an absolute right. Based on the principle of free party disposition, this right may not be restricted, not even implicitly by the threat of cost apportionment (T490/05). The Board can decide on apportionment of costs even after withdrawal of the (sole) appeal (T765/89).

Art. 104(2) The procedure for fixing costs shall be laid down in the Implementing Regulations.

See for the implementation

R.88 Procedure for fixing cost

1 Procedure

The procedure for fixing costs has been set out below for the opposition division. Boards of appeal can also apportion costs according to Art.104(1) and also fix the costs under Art.104(2) directly in appeal (see e.g. T930/92 r.4.1 and T934/91 hn1). They derive such power from Art.111(1), second sentence. A decision of a board fixing the costs cannot be appealed (T934/91 hn2).

The procedure for apportioning and fixing costs involves the following three steps.

- 1 The first step in a cost apportionment is a decision taken by the opposition division under Art.104(1) which orders an apportionment of costs different from the one where each party pays its own costs (R.88(1)). The EPO may take such a decision of its own motion or on request of a party (D-IX,1.2). The decision states which costs are differently apportioned. See R.88(1) for the kind of costs that can be taken into consideration. The costs ordered to be paid may be all or part of the costs incurred by the party, e.g. 75% of the opponent's costs for attending oral proceedings. The actual amounts are determined in the second step.

A Board may express the costs ordered directly as a specific amount (Art.16(2) RPBA). The decision apportioning costs cannot be the sole subject of an appeal (R.97(1)).

- 2 In the second step at least one party requests the opposition division to fix the actual amount of the costs to be paid under the above decision apportioning them (R.88(2)). The request may only be filed after the decision apportioning the costs has become final (R.88(2)), i.e. after any appeal, or unavailed appeal period, and directly if the decision cannot be appealed under R.97(1). The request must be accompanied by a bill of costs and supporting evidence (R.88(2)). A formalities officer with specialist knowledge examines the credibility of the costs (R.88(2)), fixes the costs and notifies the parties (D-IX,2.1).
- 3 The third step provides the possibility for a review by the opposition division of the costs fixed by the formalities officer. The party desiring such a review must file a reasoned request for a decision by the opposition division and pay the prescribed fee within one month of the communication on the fixing of costs (R.88(3)). The opposition division takes its decision without oral proceedings (R.88(4)). The decision is appealable, but only if the amount of the costs exceeds the amount of the appeal fee (R.97(2)). It is not clear whether the amount of the costs relates to the total amount to be paid by a party or the amount which is in dispute.

Art. 104(3) Any final decision of the European Patent Office fixing the amount of costs shall be dealt with, for the purpose of enforcement in the Contracting States, in the same way as a final decision given by a civil court of the State in which enforcement is to take place. Verification of such decision shall be limited to its authenticity.

1 Enforcing payment

Art.104(3) provides means to enforce payment of the apportioned costs. Since the EPO cannot enforce payment from an unwilling party, the final decision by the EPO is given the same status as a national decision, allowing enforcement under national law. The decision referred to also covers the final fixing of the costs by the opposition division, according to D-IX,3. A party that wishes to enforce payment under national law should request a review of the fixing of the costs, because only such a review results in a decision that will have national effect.

Art. 105 Intervention of the assumed infringer**1 General**

The purpose of Art.105 is to safeguard an assumed infringer as far as possible against costly and time-consuming revocation proceedings before various national courts by relying on the centralised procedure before the EPO as long as it is within the competence of the EPO to deal with the question of validity of the patent concerned. Because the 9-month opposition period of Art.99(1) has often lapsed before infringement court proceedings are started, Art.105 gives the assumed infringer a period to intervene in a pending opposition procedure or pending opposition appeal procedure concerning the patent (G1/94); after a valid intervention the intervener is treated as an opponent. The intervention may be based on any ground for opposition under Art.100, even a new ground (G1/94). A new ground raised by an intervention during appeal proceedings may cause the case to be remitted to the first instance (G1/94 r.13). The intervenor cannot challenge any board of appeal decision taken in the opposition and which has become final at the time of the intervention (T694/01 hn).

Art. 105(2) Any third party may, in accordance with the Implementing Regulations, intervene in opposition proceedings after the opposition period has expired, if the third party proves that

- (a) proceedings for infringement of the same patent have been instituted against him, or
- (b) following a request of the proprietor of the patent to cease alleged infringement, the third party has instituted proceedings for a ruling that he is not infringing the patent.

See for the implementation:

R.89 Filing of notice of intervention

1 Person and time limit for intervention

An alleged infringer must file the notice of intervention within three months (R.89(1)) from the institution of the first action between him and the proprietor, and pay the opposition fee in the same period (R.89(2)). The first action is either proceedings for infringement instituted by the proprietor or proceedings for a ruling on non-infringement instituted by the alleged infringer (Art.105(1)(a) and (b); T296/93 hn). In the former case the serving of a writ under national law, making the alleged infringer aware of the proceedings, is regarded as the institution of the proceedings from which the three-month period runs (T694/01, r.2.3). Likewise, for an interim injunction granted in ex parte proceedings, i.e. without the alleged infringer being involved, the date the order is served on the intervener is regarded as the trigger for the period, on the basis that the intervener is not aware of the ex parte proceedings until service of the order (T452/05 r.1.2).

Under Art.105(1)(b), the intervener must show both that he has received a 'request' of the proprietor and that this demands the intervener to 'cease' infringement. A criminal complaint against the alleged infringer may also be accepted as a trigger (T1713/11 r.2). Mere warnings of infringement and threats of legal action are however insufficient (T887/04 r.2.1). National law determines whether the proceedings for a non-infringement ruling are to be instituted before a court or before another body (OJ 2007 se4 (EN) p.114).

1.1 INTERVENTION DURING OPPOSITION PROCEEDINGS

According to Art.105(1) a third party may intervene 'in opposition proceedings'; hence, opposition proceedings must be in existence at the time of filing the intervention (G4/91 hn1). The intervenor must pay the opposition fee (R.89(2)).

An intervention filed before expiry of the 9-month opposition period will be regarded as a normal opposition according to Art.99.

After the intervenor has complied with all requirements of Art.105, his status corresponds to that of an opponent under Art.99. In particular, he is entitled to file an appeal under Art.107, first sentence, or participate in an appeal as party as of right under Art.107, second sentence. A valid filing of the appeal requires that the intervenor pays the appeal fee as required under Art.108. (G3/04 r.4, 10, 11)

The above intervenor has an independent right to continue the proceedings in case all other oppositions are withdrawn. The intervenor who has filed an appeal also has the right to continue the appeal proceedings on his own when the other appellants have withdrawn their appeals. (G3/04 r.10)

1.2 INTERVENTION DURING TWO-MONTH APPEAL PERIOD

If the intervention is made after the decision terminating the opposition proceedings has been issued by the opposition division but before the expiry of the two-month appeal period, and the decision is not appealed, then the intervention is inadmissible because there are no pending proceedings as required by Art.105(1) (G4/91 hn.IV). The decision is regarded as issued in written proceedings on the day the decision is handed over to the EPO postal service (T631/94, G12/91, notes ante R.111). An intervention filed after the announcement of the decision of the Opposition Division in oral proceedings, but before the notification of the written decision, was held in T791/06 to be filed in the appeal proceedings, not in the opposition proceedings. If the decision is appealed, opposition proceedings are still pending and the intervention is admissible (G4/91 r.6; D-VII,6).

1.3 INTERVENTION DURING APPEAL PROCEEDINGS

An intervention filed during pending appeal proceedings is admissible, as the term 'opposition proceedings' in Art.105(1) also includes subsequent appeal proceedings (G1/94, following T338/89, overruling T390/59).

According to Art.107, the entitlement to appeal is restricted to parties to the first instance proceedings that led to the decision under appeal. A party that intervened during the appeal proceedings has not been party to the first instance proceedings, and, hence, has no right to appeal; he becomes party as of right. If the sole, or each, appeal are withdrawn, he may not continue the proceedings and the appeal proceedings are terminated for all parties as regard the substantive issues, including any new grounds raised by the intervenor. (G3/04 r.6, 10)

The question of the independent right to continue was also referred in G4/03, but the proceedings have been terminated because of the withdrawal of the remaining intervention in the referring decision (OJ 2004 p.542).

If the precise time of filing on the same day of the sole appellant's notice of withdrawal of appeal and a notice of intervention can be established, their chronological order must be taken into account (T517/97). Withdrawal of an appeal is a procedural act which has immediate effect; its effect is not postponed to midnight of the date of filing (T517/97 r.4).

Art. 105(2) An admissible intervention shall be treated as an opposition.

1 Formal requirements for notice of intervention

A valid intervention requires the filing of a notice of intervention including the proof of institution of the proceedings (Art.105(1)), an admissible, i.e. written and reasoned notice of opposition and payment of the opposition fee (R.89(2)), all before the end of the 3 month period (R.89(1)). Re-establishment after failing this period is not possible, because re-establishment is in principle only available for an applicant and proprietor, not for an intervenor.

When the intervention is filed during pending appeal proceedings, no appeal fee need be paid, because the EPC has no provisions requiring this (G3/04 r.11; overruling T1011/92 and T517/97 r.2). Note, that R.89(2) does require payment of the opposition fee in such a case (G3/04 r.5). The intervenor becomes party as of right in the appeal proceedings (G3/04 r.6).

Although the intervention is treated as an opposition, as an exception the opposition division may dispense with forwarding some communications and invitations to the intervenor (R.79(4), D-IV,5.6). The intervenor can obtain copies of these documents by file inspection.

Art. 105a Request for limitation or revocation**1 General**

Art.105a-c provide for a central limitation and revocation of European patents by an administrative procedure before the EPO. An important reason to introduce the limitation procedure in the EPC 2000 was the impossibility of a central review of the patent by the proprietor after self-opposition was prohibited by G9/93. The examining division is competent to take decisions in the limitation and revocation procedures (R.91).

Art.105a-c are applicable to European patents already granted at the time of EPC 2000 entry into force and to European patents granted in respect of European patent applications pending at, or filed on or after that time. (OJ 2007 se4 (EN) p.118)

The limitation procedure is designed to avoid costly national disputes over the validity of a European patent and to enhance legal certainty. The procedure may be useful where relevant prior art is discovered after grant of the patent, or the patent is granted with too broad a scope. A request for limitation must include amended claims that constitute a limitation vis-à-vis the claims as granted or amended in opposition or limitation proceedings (R.95(2)). The limitation may relate to a dependent claim only (D-X,4.3).

The amended claims may be tailored to products that have come on the market. It is not permissible to introduce non-limiting amendments in the description or in the claims that are not a consequence of the limitation of the claims, e.g. tidying up unclear claims, making amendments to improve the patent or cosmetic changes. Adding dependent claims is neither permissible if not directly caused by the limitation introduced in the claims. (D-X,4.3)

The provisions also create a centralised revocation procedure. The revocation has ex tunc effect. The revocation proceedings allow the proprietor to react immediately in the case of controversial patents in technologies that attract a good deal of public interest, thereby limiting damage to his reputation. Another reason for central revocation is to minimise the costs for proprietors without sufficient funds to defend their patents in numerous national proceedings.

Art. 105a(1) At the request of the proprietor, the European patent may be revoked or be limited by an amendment of the claims. The request shall be filed with the European Patent Office in accordance with the Implementing Regulations. It shall not be deemed to have been filed until the limitation or revocation fee has been paid.

See for the implementation:

R.90 Subject of proceedings

R.91 Competence of the examining division

R.92 Requirements of the request

Rfeesz(1)10a Limitation and revocation fee

1 Requirements of the request

Under Art.105a(1) a European patent may be revoked or limited (by an amendment of the claims) at the request of the proprietor, subject to payment of a fee. R.92 sets out the criteria for admissibility. In particular a request must be filed in writing (R.92(1)). Electronic filing is possible (see R.2(1):7).

The request must include details of the patent proprietor (R.92(2)(a)). Where a patent is held by different proprietors in different states, details of these proprietors and evidence that the requester is entitled to act on their behalf must also be included (R.92(2)(c)).

The patent number must be identified, and a list of contracting states in which the patent has effect given (R.92(2)(b)).

The amended claims, and where appropriate description and drawings must be given (R.92(2)(d)).

R.90 makes clear that only the patent as granted or amended by the EPO may be the subject of limitation or revocation proceedings. Amendments made before national courts or patent offices will not be taken into account, although the proprietor may of course request limitation before the EPO in order to bring the European patent into line with amendments made nationally.

The request is deemed not filed until the limitation or revocation fee has been paid (Art.105a(1)). The amount of the limitation and revocation fees is fixed in Rfeesz(1)10a.

A request for revocation or limitation may be withdrawn at any time (D-X,9).

Art. 105a(2) The request may not be filed while opposition proceedings in respect of the European patent are pending.

See for the implementation:

R.93 Precedence of opposition proceedings

1 Precedence of opposition proceedings

Art.105a(2) governs the relation between the limitation procedure and opposition proceedings. The priority it gives to opposition proceedings prevents limitation procedures occurring where opposition has already been lodged. In this case, the request is deemed not to be filed (R.93(1)). Where an opposition is filed while limitation proceedings are pending, the limitation proceedings terminate and the limitation fee is refunded (R.93(2)). If revocation proceedings are pending, the revocation continues.

The European limitation procedure does not however take precedence over national proceedings (revocation proceedings in particular). Where parallel cases do occur, the national proceedings can be stayed or continued in accordance with the provisions of the relevant national law. Where national proceedings resulting in limitation have already been concluded, the limitation can be extended to further contracting states via European limitation proceedings. It is also emphasised that limitation of a European patent in proceedings before the EPO does not preclude further limitation in national proceedings. (OJ 2007 se4 (EN) p.116)

Art. 105b Limitation or revocation of the European patent

Art. 105b(1) The European Patent Office shall examine whether the requirements laid down in the Implementing Regulations for limiting or revoking the European patent have been met.

See for the implementation:

R.94 Rejection of the request as inadmissible

1 Examination of the request

Under R.94 the requirements of R.92 are examined, and any deficiencies noted. The requester will be notified to correct any such deficiencies within a period to be fixed by the EPO. If they are not corrected, the request will be rejected as inadmissible. If admissible, the proceedings progress to the next stage.

The limitation procedure requires the EPO to examine whether the requirements laid down in R.95 for a requested limitation or revocation have been met. With limitation, this means in particular establishing whether the requested amendment of the claims actually limits the patent or is designed to protect something else, and whether the requirements of Art.84 are met. Here too, moreover, the EPO has to apply the Convention's relevant general rules of procedure, in particular Art.123(2) and (3) EPC. The EPO is not required to examine whether the aim of the limitation - e.g. delimitation with respect to a particular prior art - is achieved, or whether the subject matter of the limited patent is patentable under Art.52-57 EPC.

In the event that the requirements of R.95 are not met, the examining division will offer one opportunity to correct deficiencies and to offer further amendments to the claims (and description and drawings, if appropriate). The time limit is to be specified by the division (R.95(2)).

Art. 105b(2) If the European Patent Office considers that the request for limitation or revocation of the European patent meets these requirements, it shall decide to limit or revoke the European patent in accordance with the Implementing Regulations. Otherwise, it shall reject the request.

See for the implementation:

R.95 Decision on the request

If the deficiencies are not remedied within two months of notification of the invitation, no filing date will be accorded and the application will not be dealt with as a European patent application (Art.90(2), R.55). The Receiving Section informs the applicant by means of a R.112(1) communication; if the applicant regards the communication as inaccurate, he may ask for an appealable decision. Further information on the filing date requirements and correction can be found in the notes to R.40.

The two-month period of R.55 is not extendable under R.132, because it is not an office time limit. R.135(2) excludes the two-month period from further processing. Re-establishment (Art.122 and R.136) is possible. The established practice of the Receiving Section is to accord a date of filing corresponding to the last day of the two-month period of R.55 where re-establishment is granted.

Instead of applying for re-establishment, the applicant may file a corrected application, provided the date of filing is not critical. This remedy is cheaper than re-establishment and does not have the uncertainty of re-establishment. Any fees paid in respect of the earlier application will be refunded as lacking legal basis (A-II,4.1.4).

R. 56 Missing parts of the description or missing drawings

Implementation of: Art.90(4)
EPC 1973: R.41 + R.43

1 Correction of missing parts by later filing

The purpose of R.56 is to correct parts of the description or drawings that are missing in the filed applications, caused by e.g. faulty fax transmission or received only after midnight. It implements Art.5(6) PLT. The provision should be used for correcting true errors and not for amending the application after filing by incorporating specific parts from an earlier application, the priority of which may even have been added after the date of filing (H-IV,2.2; J27/10 hn.1).

If during the examination on filing the EPO finds that any parts of the description or drawings appear to be missing, it will invite the applicant under R.56(1) to file these parts within two months from invitation. The applicant may also file missing parts of his own motion within two months of the date of filing (R.56(2)). The application will be re-dated to the date of receipt of the missing parts (R.56(2)). The applicant may withdraw subsequently filed parts of the description or drawings in order to retain his original filing date (R.56(6)).

If the application claims priority and the missing part of the description or drawings was completely contained in the priority application, that missing part may be included in the application without loss of the original date of filing, provided the requirements of R.56(3) are met. (Spec. Ed. 1 of OJ 2003, p. 159)

R.56 refers only to missing parts of the description and missing drawings. Hence, inclusion of claims from a previous application using R.56 is not permitted. See A-IV,5.1 for a missing sequence listing. R.56 cannot be used to amend or replace originally filed documents; it can only be used to supplement missing parts of the description and missing drawings (J15/12 r.4). However, in a case where the drawings filed with the application were obviously incorrect, the applicant was allowed to file a new set of drawings, because there was no doubt that the drawings referred to in the description were missing; the drawings filed with the application remained part of the application, thereby avoiding the prohibited replacement of the drawings

(J2/12 r.10, 11). R.56 cannot be used to add drawings of proper quality, because the original low-quality drawings were not missing (J12/14 r.7).

The 'content of the application as filed' for the purpose of determining extension of subject-matter under Art.123(2) includes missing parts of the description and missing drawings allowed under R.56(3) (H-IV,2.2.2).

Where the applicant has filed missing parts, the publication under Art.93 contains the description, the claims and any drawings as filed (R.68(1)) and any late-filed missing parts of the description or drawings, provided that these were not subsequently withdrawn (A-VI,1.3).

2 Correction of missing drawings under R.139

Since R.56 does not exclude application of R.139 (J4/85), an applicant may try to insert a missing drawing or replace one or more erroneously filed drawings by way of a correction under R.139, second sentence, without re-dating the application. The applicant must prove that the skilled person would have derived the correction from the application at the date of filing ('obvious' in the sense of R.139) and that the application contained the matter of the correction already at the date of filing (no extension of subject-matter as required by Art.123(2), G3/89). The disclosure of the drawings in a priority document may not be used as evidence, making the proof difficult (G3/89 r.7, G11/91 r.7; H-IV,2.3.5). The description of the application may be useful as evidence, if it discloses a good portrait of the drawings. Since the correction may not add new subject-matter to the application, the usefulness of adding a drawing under R.139 is doubtful.

A request to add a drawing by way of correction under R.139 should be accompanied by an auxiliary request either to add the drawing and re-date the application or to delete the references to the missing drawings under R.56. In cases where the decision on the request for correction requires a technical examination, the Receiving Section must leave the decision to the examining division (J4/85). The publication of the application will not be delayed by this procedure (J4/85).

R. 56(1) If the examination under Article 90, paragraph 1, reveals that parts of the description, or drawings referred to in the description or in the claims, appear to be missing, the European Patent Office shall invite the applicant to file the missing parts within two months. The applicant may not invoke the omission of such a communication.

Art.90(1) Examination on filing

1 Nomenclature

R.56 refers to 'missing parts of the description' and 'missing drawings'.

A drawing means a single numbered figure. If part of a drawing is missing, the drawing will be regarded as completely missing for the purpose of R.56 and the EPO will invite the applicant to resubmit a complete drawing (A-II,5.3; CA/PL17/06). The EPO does not want to assemble a complete drawing by cutting and pasting.

A drawing of low visual quality is not considered a missing part and cannot be remedied under R.56 (J12/14).

The missing parts of the description and the missing drawings are referred to together as 'missing parts' or, once filed with the EPO, as 'late-filed parts' (A-II,5).

1.1 PRIORITY CLAIM (ITEM II)

The priority claim in question must have been in existence no later than the filing of the request in iii) above. Hence, the missing parts may also be based on a priority added after the original date of filing. The priority may not be added after the filing of the request in iii) above. An added priority claim must be filed within the period of R.52(2), i.e. sixteen months from the earliest priority date. (see also A-II,5.4.1)

R.56(3) uses the term 'earlier application' intentionally to ensure that the paragraph covers only the case of missing parts contained in priority applications and not in any previously filed application (CA/PL17/06).

1.2 COMPLETELY CONTAINED IN EARLIER APPLICATION (ITEM IV)

The requirement of R.56(3) that the missing part be 'completely contained in the earlier application' is met only if the parts of the earlier application identified according to R.56(3)(c) contain the same drawings, with the same annotations or, for missing parts of the description, contain the same text. The missing part must be inserted in the description in a manner that does not add technical content. (A-II,5.4.2)

If a translation of the earlier application is required under R.56(3)(b), the missing parts must be completely contained in the translation. (A-II,5.4.2)

The assessment of 'completely contained' is a formal matter that can be carried out by an examiner who is not technically qualified. The EPO may require photographic identity.

Lawyers in the EPO hold that an addition to the description of an application must be taken from the description of the priority application, not from the claims of the priority application.

1.3 COPY AND TRANSLATION OF EARLIER APPLICATION (ITEM III, VI)

If no copy of the priority application is available to the EPO under R.53(2), the applicant must furnish a copy (R.56(3)(a)), which need not be certified (A-II,5.4.2).

Where the priority application is not in English, French or German, the applicant must file a translation into one of these languages, unless such a translation is already available under R.53(3) (R.56(3)(b)). Instead of a translation, the applicant may file a declaration that the late-filed missing parts of the description, or drawings, are an exact translation of the identified parts of the priority application (A-II,5.4.4). See A-II,5.4.4 where the priority application and the application under examination are in two different EPO languages.

At this stage the language of the proceedings may not yet be known; hence, the EPO cannot require filing of the translation into the language of the proceedings and therefore requires a translation into one of the official languages. In the unlikely case that the applicant translates the priority application into another official language than the priority claiming application, the EPO will probably request a translation into the language of proceedings of only those parts of the priority document that correspond to the missing parts or a declaration that the late-filed missing parts are an exact translation of the corresponding parts of the priority document (A-II,5.4.4 last paragraph *mutatis mutandis*).

1.4 INDICATION OF MISSING PARTS (ITEM VII)

The indication facilitates the processing of the missing parts of the description and the missing drawings by the EPO (CA/PL17/06).

2 Effect of non-compliance

Where criterion i) is not complied with, i.e. the missing parts have been filed after expiry of either of the two-month periods of R.56(2), the missing parts are deemed not to have been filed and any references to these missing parts will be deemed deleted according to R.56(4)(a). The application will not be re-dated and the missing parts will not be introduced into the application.

Non-compliance with one or more of the criteria ii)-iv) leads to redating of the application to the date on which the missing parts were filed under R.56(2).

Non-compliance with one or more of the criteria (v)-(vii) results also in redating to the date on which the missing parts were filed, but in this case under R.56(5).

The EPO will inform the applicant of the non-compliance and the consequences under R.56(4)(a), (2) or (5), whichever applies.

3 Decision on late-filed missing parts

The Receiving Section will inform the applicant of its decision on late-filed parts, in particular the requirement that the missing parts are 'completely contained' in the priority document. The decision will be reviewed by the search division (B-XI,2.1) and the examining division (C-III,1), who may also check any translation of a priority application, which may result in a change of the date of filing. An opposition division is probably not allowed to change the date of filing, since this is not covered by Art.100, to which it is bound.

R. 56(4) If the applicant:

- (a) fails to file the missing parts of the description or the missing drawings within the period under paragraph 1 or 2, or
 - (b) withdraws under paragraph 6 any missing part of the description or missing drawing filed under paragraph 2,
- any references referred to in paragraph 1 shall be deemed to be deleted, and any filing of the missing parts of the description or missing drawings shall be deemed not to have been made. The European Patent Office shall inform the applicant accordingly.

1 Late filing or withdrawal of missing parts

The missing parts are deemed not to have been filed if the applicant files the missing parts after expiry of two months from invitation under R.56(1) or from the date of filing under R.56(2), or if he withdraws any missing part under R.56(6). In that case any references in the description or claims to these parts will be deemed to be deleted.

When a reference to a missing figure is deemed to be deleted, then reference signs referring to that figure are also deemed to be deleted. Technical information still meaningful without the reference will be retained. (A-II,5.5)

R. 56(5) If the applicant fails to comply with the requirements referred to in paragraph 3(a) to (c) within the period under paragraph 2, the application shall be re-dated to the date on which the missing parts of the description or missing drawings were filed. The European Patent Office shall inform the applicant accordingly.

1 Non-compliance with requirements of R.56(3)

R.56(5) provides for the sanctions applicable where the requirements referred to in paragraph (3)(a) to (c) are not complied with in due time. In such a case, the application will be re-dated to the date on which the missing parts of the description or missing drawings were filed. Alternatively, the applicant can withdraw the missing parts of the description or missing drawings under R.56(6) so as to avoid any modification of the filing date. (CA/PL17/06)

R. 56(6) Within one month of the notification referred to in paragraph 2 or 5, last sentence, the applicant may withdraw the missing parts of the description or the missing drawings filed, in which case the re-dating shall be deemed not to have been made. The European Patent Office shall inform the applicant accordingly.

1 Withdrawal of missing parts or missing drawings

Where an applicant files missing parts of the description or missing drawings under R.56(2) that are not based on a priority document, the EPO sends a communication informing him of the new date of filing. The applicant may reconsider the filing of the missing parts or missing drawings and withdraw the late-filed parts within one month of the notification of the communication. As a result, the re-dating is deemed not to have been made and all references to the missing parts of the description and missing drawings are deemed deleted under R.56(6). (A-II,5.5)

Where the late filed parts are based on a priority application and one or more of the criteria (i) to (vii) in the notes of R.56(3) are not met, the application will be re-dated. If the applicant prefers the original date of filing, he may withdraw the late-filed parts within one month of the communication informing the applicant of the re-dating. In such a case the re-dating will be deemed not to have been made (R.56(6)) and all references to the missing parts of the description and missing drawings will be deemed to be deleted under R.56(4)(b).

The examining division may review the finding of the Receiving Section concerning the added missing parts or drawings. If the examining division finds that the "completely contained"-criterion is not satisfied, it will inform the applicant accordingly and invite him to comment. The applicant can reply by withdrawing the added missing parts or drawings, or by arguing on why they are indeed "completely contained" in the priority application. If in the latter case the examining division is not convinced, it will inform the applicant of re-dating of the application. Thereafter, the applicant can still withdraw the added missing parts or drawings within two months from the communication. (C-III 1.1.1)

The publication under Art.93 will not contain any late-filed missing parts of the description or drawings if these were subsequently withdrawn under R.56(6) (A-VI,1.3). See R.56(3):3 for the taking of a decision on late-filed missing parts.

R. 57 Examination as to formal requirements

If the European patent application has been accorded a date of filing, the European Patent Office shall examine, in accordance with Article 90, paragraph 3, whether:

- (a) a translation of the application required under Article 14, paragraph 2, under Rule 36, paragraph 2, second sentence, or under Rule 40, paragraph 3, second sentence, has been filed in due time;
- (b) the request for grant of a European patent satisfies the requirements of Rule 41;
- (c) the application contains one or more claims in accordance with Article 78, paragraph 1(c), or a reference to a previously filed application in accordance with Rule 40, paragraphs 1(c), 2 and 3, indicating that it replaces also the claims;
- (d) the application contains an abstract in accordance with Article 78, paragraph 1(e);
- (e) the filing fee and the search fee have been paid in accordance with Rule 17, paragraph 2, Rule 36, paragraph 3, or Rule 38;
- (f) the designation of the inventor has been made in accordance with Rule 19, paragraph 1;
- (g) where appropriate, the requirements laid down in Rules 52 and 53 concerning the claim to priority have been satisfied;
- (h) where appropriate, the requirements of Article 133, paragraph 2, have been satisfied;
- (i) the application meets the requirements laid down in Rule 46 and Rule 49, paragraphs 1 to 9 and 12;
- (j) the application meets the requirements laid down in Rule 30.

Amended by decision of the Administrative Council of 21.10.2008, which entered into force on 01.04.2009. (OJ 2008, 513)

Amended by decision of the Administrative Council of 25.03.2009, which entered into force on 01.04.2010 (OJ 2009, 296)

Art.14(2) Application filed in non-EPO language

Art.78(1) Requirements for application

Art.90(3) Examination as to formal requirements

Art.133(2) Compulsory representation

R.17(2) Period for paying filing and search fee for new application

R.19(1) Content of designation of the inventor

R.30 Requirements of application relating to nucleotide and amino acid sequences

R.36(2) Language of divisional application

R.36(3) Period for paying filing and search fee for divisional application

R.38 Period for paying filing and search fee for application

R.40(1)(c) Replacement of application by previous application

R.40(2) Bibliographic data of previous application

R.40(3) Translation of previous application

R.41 Content of Request for Grant

R.46 Form of the drawings

R.49 General provisions governing the presentation of the application documents

R.52 Declaration of priority

R.53 Priority documents

Implementation of: Art.90(3)

EPC 1973: Art.91(1) + R.40

1 Formalities examination

Examination as to formal requirements under R.57 concerns the formalities examination to be conducted under Art.90(3) after a date of filing has been accorded.

In addition to the ten requirements listed in R.57, the Receiving Section also checks (A-III,1.2; A-III,8):

- i) clarity and conciseness of the title (R.41(2)(b)), preliminary check;
- ii) payment of claims fees under R.45(1) where appropriate;
- iii) the certificate of exhibition under R.25 where the invention has been displayed under Art.55(1)(b);
- iv) whether the information pursuant to R.31(1)(c) and (d) is complete where the application relates to biological material;
- v) check where required a sequence listing has been filed (R.30);
- vi) matter prohibited by R.48, preliminary check.

The check of payment of the designation fee and extension fees is part of the formalities examination. This examination can only be made after expiry of the period for payment of these fees, i.e. six months after publication of the search report.

The examination set out below applies to direct European patent applications, including divisional and new applications. Euro-PCT applications are examined on entry into the European phase according to R.159, rather than to R.57.

Where the EPO notices non-compliance with one of the requirements of R.57(a) to (d), (h) and (i), it will send an invitation under R.58 to correct the deficiency, the sanction on non-compliance being refusal of the application unless another sanction is provided (Art.90(5)). There are special provisions for an invitation to correct and a sanction for non-compliance with each one of the requirements of R.57(e) to (g), (j) and the above further requirements i to v, as set out in the sections below.

See Art.90(5):2 for the time a sanction takes effect.

2 Translation of application (R.57(a))

Where a filed application is not in one of the official EPO languages, a translation into such a language must be filed according to Art.14(2) within two months of filing the application (R.6(1)). Where a divisional application is filed in the language of the earlier application and this language is not an official EPO language, a translation must be provided within two months of filing the application (R.36(2)). Where the application is filed by reference to a previously filed application as allowed by R.40(1)(c) and the previous application is not in an official EPO language, a translation into one of these languages must be filed within two months of filing the application according to R.40(3).

The EPO will check under R.57(a) whether the translation has been filed at expiry of the two months; if not, it will invite the applicant to rectify the deficiency under R.58 within a further period of two months (A-III,14).

Non-compliance results in the application being deemed withdrawn under Art.14(2), last sentence. The EPO will notify the applicant of the loss of rights according to R.112(1). Where applicable, the applicant can prove within two months of the notification that he did file the translation in due time (R.112(2)) or request re-establishment under Art.122.

It should be noted that the Travaux Préparatoires of the EPC 2000 state that non-compliance with filing the translation of R.40(3) will result in the application being refused under Art.90(5) (Spec. ed. 5, OJ 2007, p.106). The EPO has admitted that this statement is not correct.

The periods of R.6(1), R.40(3) and R.58 are excluded from further processing by R.135(2). Re-establishment in the periods is possible under Art.122 and R.136. It is also possible to convert the European application to a national application under Art.135(1)(b).

See also A-III,16 and Art.14(2):3.

3 Request for grant (R.57(b))

The Receiving Section examines whether the Request for Grant form complies with the requirements of R.41, several of which are dealt with below (A-III,4.2).

Use of the appropriate Request for Grant form is mandatory (R.41(1)). The form already contains a preprinted petition for the grant of a European patent, which is required under R.41(2)(a).

The Request must contain the title of the invention (R.41(2)(b)). See the separate section below on examination of the title.

The Request must properly identify the name, address and nationality of the applicant (R.41(2)(c)), and, if a representative has been appointed, his name and address (R.41(2)(d), see also R.57(h)). When there are several applicants, the name, address and nationality of each of them must be given (A-III,4.2.1).

Where applicable, the Request must indicate that it relates to a divisional application and state the number of the earlier application (R.41(2)(e)). The same applies to a new application under Art.61(1)(b) (R.41(2)(f)).

The Request must be signed (R.41(2)(h)). The description, claims and drawings are not stated as requiring a signature; hence, they need not be signed separately. Other application documents requiring a signature are the separately filed designation of inventor (R.19(1)) and the authorisation (R.152). The documents, with the exception of the authorisation of a representative, may be signed by an appointed representative instead of the applicant. (A-VIII,3.2)

If there is more than one applicant, each applicant or his representative must sign the request for grant and, where applicable, the appointment of a common representative. This also applies if one of the applicants is considered common representative under R.151(1), first sentence. The common representative may sign the designation of inventor and all further documents. An authorisation on behalf of more than one applicant must be signed by all applicants. (A-VIII,3.4)

The Request must identify the documents annexed to the application (R.41(2)(i)).

The Request must contain the designation of the inventor where the applicant is the inventor (R.41(2)(j)). Otherwise, the designation must be filed in a separate document according to R.19(1). The inventor may renounce his title as inventor, in which case his name does not appear on the front page of the published application, and is not entered into the Register (R.20(1), R.143(1)(g)). The examination of the designation is provided in R.57(f).

If the Receiving Section notes that the Request for Grant form has not been filed or any error in the Request for Grant form (with the exception of designation of inventor (see R.57(f)), priority claim (see R.57(g)) and title (see section below)), it will invite the applicant under R.58 to remedy the deficiencies within two months of invitation. Further processing is excluded by R.135(2); however, re-establishment according to Art.122 and R.136 is available. Non-compliance will result in the application being refused under Art.90(5). An applicant may request correction of his own volition under R.139, first sentence.

4 Claims (R.57(c))

Since the presence of one or more claims in the application is not a prerequisite for accordance of a date of filing under the EPC 2000, the presence of claims is not examined on filing but in the subsequent formal examination (see A-III,15).

An applicant has three opportunities to file claims. On filing the application documents he may also file claims, either by supplying a set of claims or referring to claims in a previous document. If no claims are available on filing of the application, an applicant may file claims of his own volition up to the time the EPO invites him to do so under R.58. If he has not provided claims on the date of filing or later of his own volition, an invitation under R.58 will be issued for mandatory filing of claims. (A-III,15)

The applicant can use only one of the three opportunities for filing claims. A second filing of claims before receipt of the search report is not permitted under R.137(1). Claims can only be filed by reference to a previous document on the date of filing, later filing of claims by reference is not allowed (A-II,4.1.3.1).

Claims filed after the date of filing must have a basis in the application as filed in order not to extend subject-matter in the sense of Art.123(2) (A-III,15).

Late-filed claims are regarded as an amendment and must be filed in the language of the proceedings according to R.3(2).

During the formalities examination it is checked if at least one claim is present in the application, as required by Art.78(1)(c). If not, the EPO will invite the applicant under R.58 to remedy the deficiency within two months from invitation. Failure to do so will result in refusal of the application according to Art.90(5).

The EPO will notify the applicant of the decision under R.111. The two-month period of R.58 is excluded from further processing according to R.135(2). Re-establishment under Art.122 and R.136 is available.

5 Abstract (R.57(d))

Where the abstract, required under Art.78(1)(e), is missing or obviously inappropriate, the Receiving Section will invite the applicant to correct the deficiency under R.58 (A-III,10.2). If the application contains drawings, and the applicant has not indicated the drawing to accompany the abstract (R.47(4)), the search division will decide which figure to publish. (A-III,10.3).

Non-compliance will result in refusal of the application under Art.90(5) (A-III,16.2). No further processing is possible for the two-month period of R.58 (R.135(2)); however, re-establishment under Art.122 and R.136 is available.

The definitive content of the abstract is the responsibility of the search division (R.66) which checks compliance with all requirements of R.47.

6 Filing fee, page fee, divisional fee and search fee (R.57(e))

The Receiving Section checks whether payment of the filing and search fees as required by Art.78(2) has been made by expiry of one month of filing (R.38(1)). The filing fee may be reduced if an admissible non-EPO language is used (R.6(3)) (A-XI,9.2.2). See Rfees9 for refund of search fees.

For a divisional application under Art.76(1) or a new application under Art.61(1)(b) the filing and search fees must be paid within one month of filing the application (R.36(3) and R.17(2), respectively). For a divisional of second or higher generation the divisional fee must also be paid (R.38(4)).

A page fee as part of the filing fee must be paid within the later of one month of filing the application, the first set of claims or the certified copy of R.40(3) (R.38(3)).

The EPO does not issue an invitation to pay the filing, page, divisional and search fees. Note, that R.58 does not refer to R.57(e).

If any of these fees is not paid in due time, the application is deemed withdrawn according to Art.78(2). The EPO will notify the applicant of the loss of rights under R.112(1). Further processing according to Art.121 and R.135 may be requested for the one-month time limit within two months of the notification of the loss of rights. The further processing fee is equal to 50% of the missing fee (Rfees2(1)12).

7 Designation of inventor (R.57(f))

An application must designate the inventor according to Art.81. The EPO does not verify the accuracy of the designation (R.19(2)); it only checks whether the designation conforms to R.19(1). The EPO sends the filed designation for information to any inventor who is not an applicant (R.19(3)). According to Art.81 the designation must contain the entitlement to the application if the applicant is not the inventor. The entitlement is not verified (Art.60(3) & R.19(2)). However, when the inventor receives his designation under R.19(3), he can assess the entitlement and may request correction if necessary. The applicant can request correction of the designation under R.135 of his own volition during the proceedings before the EPO. A designation of an incorrect inventor may be corrected according to R.21(1). A rectification of an incorrect designation already entered in the Register will be published in the Bulletin (R.21(2)). See also A-III,5.

A deficient designation is no ground for opposition (Art.100) or revocation (Art.138).

If the designation on filing is missing or does not comply with R.19 (e.g. inventor's name or address or the signature of the applicant is missing), the EPO will follow the procedure under R.60.

8 Priority claim (R.57(g))

When claiming the priority of an earlier application, the Request for Grant must indicate so and state the date and state of filing of the earlier application (R.41(2)(g)). See Art.87, Art.88, R.52, R.53 and R.139 for requirements for claiming priority, addition and correction of a priority claim of the applicants own volition.

The Receiving Section need not examine the content of the priority document. However, where the document obviously relates to subject-matter different from the application, the applicant should be informed that the priority document appears not to be the relevant document. (A-III,6.4)

Where a priority right is lost because deficiencies have not been corrected in due time, the applicant is notified. Periods depending on the priority will take the new situation into account. The loss of priority right has no effect on a period which has already expired. (A-III,6.11)

8.1 DECLARATION OF PRIORITY

The declaration of priority is preferably made on filing the application (R.52(2)). The Receiving Section examines in the Request for Grant form under R.57(b) whether the declaration of priority of Art.88(1) contains the date and state of filing and the file number, as required by R.52(1). If the information is missing or obviously incorrect, the EPO will invite the applicant under R.58 to file a corrected Request for Grant form (implied by A-III,6.5). It will not send such an invitation for deficiencies in priority claims added or corrected after the Request for Grant form has been filed (A-III,6.5). The applicant will be given more time to correct the file number than to correct the date and state.

The date and state may be corrected voluntarily within the sixteen/four month time limit of R.52(3). If an incorrect priority claim has not been corrected by expiry of this period, the priority right is lost according to Art.90(5). The period of R.52(3) is excluded from further processing (R.135(2)), but re-establishment under Art.122 and R.136 is available. (A-III,6.5.3)

If a missing file number is not provided within the sixteen/four month time limit of R.52(3), the EPO will invite the applicant again to file it within a period to be specified (R.59). The period is between two and four months (R.132(2)). Non-observance of the period of R.59 results in the loss of the priority right under Art.90(5), last sentence. The period of R.59 is excluded from further processing according to R.135(2). Re-establishment under Art.122 and R.136 is available for this period. See also R.59:1; A-III, 6.5.3 and 16.2.

An incorrect file number may be corrected at any time under R.139 (A-III,6.5.3).

8.2 PRIORITY PERIOD

Where the date of filing of the application falls after expiry of the priority period, the EPO invites the applicant to correct the priority date within the sixteen/four month period of R.52(3) or the applicant may request re-establishment in the priority period within two months of the expiry of the priority period according to Art.122 and R.136(1). The omitted act is the establishment of a date of filing by filing the application documents within the same two-month period, claiming the appropriate priority. The priority period may be extended on account of R.133 or R.134. (A-III,6.6 and 6.9(i)(a), (b))

When the deficiency is not corrected in due time, the priority right is lost according to Art.90(5).

8.3 COPY OF PRIORITY DOCUMENT

Before expiry of sixteen months of the earliest priority date a copy of the priority document must be filed (R.53(1)), either on paper or on physical media other than paper, e.g. CD-R (A-III,6.7). The certificate of correctness of the document must be included. No copy need be filed if it is already available to the EPO, which will include a copy in the file free of charge (R.53(2)); see Dec. Pres. OJ 2012, 492 for conditions). The EPO participates as of 01.11.2018 in the WIPO's digital access system (DAS) for exchanging certified priority documents; for the time being DAS is available for EP applications and international applications entering the EP phase (Dec. Pres. OJ 2018 A78 Art.1; see R.53(2):1 for more details).

If no copy is filed within the sixteen-month period, the EPO will invite the applicant to file it within a two month period (R.59; A-III,6.7). Non-observance of the period results in loss of the priority right under Art.90(5), last sentence. The period of R.59 is excluded from further processing according to R.135(2), but can be extended under R.132(2). Re-establishment under Art.122 and R.136 is available for this period. See also R.59:1; A-III,6.7 and 16.2.

8.4 TRANSLATION OF PRIORITY DOCUMENT

The EPO will request a translation into an official EPO language of a priority document in a non-EPO language only where the validity of the priority claimed is relevant to the assessment of the patentability of the invention concerned (R.53(3)). This invitation may be sent during the examination or the opposition procedure. The applicant or proprietor may also send the translation of his own motion (A-III,6.8). Instead of a translation, the appli-

cant or proprietor may file a declaration that the application is a complete translation of the priority document (R.53(3)). The EPO will include a copy of the translation in the file where the translation is already available to the EPO (R.53(3), R.53(2)).

The translation must be filed within a period specified in the invitation (R.53(3); A-III,6.8). If no translation is provided before expiry of the period, the priority right is lost according to R.53(3), 4th sentence. During grant proceedings further processing under Art.121 and R.135 is available; during opposition proceedings only re-establishment under Art.122 and R.136 can be used as remedy.

9 Compulsory representation (R.57(h))

An applicant who does not have a residence or place of business in a contracting state must be represented according to Art.133(2). He may only file the application himself; subsequent acts must be carried out by a duly appointed representative (Art.133(2)). If there are several applicants, each one of them has to comply with Art.133(2). In such a case one applicant or representative must be appointed as common representative, either by the applicants in the Request for Grant form (R.41(3)) or by the EPO using R.151(1).

During the examination of formal requirements under Art.90(3) the Receiving Section checks whether the applicant has complied with the requirements of representation as set out in Art.133(2). If he is incorrectly not represented, the EPO will invite him according to Art.90(4) and R.58 to appoint a representative within two months of invitation (R.58). The first communication of the Receiving Section to the applicant should cover this deficiency, besides other obvious deficiencies (A-III,16.1).

In special cases the Receiving Section will also request the applicant to file a signed authorisation according to R.152(1) within the same period as for appointing a representative (R.152(3)). If the authorisation is not filed in time, all acts of the representative are void (R.152(6)). (A-VIII,1.7)

If the representative is not appointed within the two months of R.58, the application is refused (Art.90(5)). Further processing is excluded by R.135(2). Re-establishment under Art.122 and R.136 is available.

10 Physical requirements to be satisfied (R.57(i))

The Receiving Section checks under R.57(i) whether the application documents comply with the physical requirements of R.57(i), such as paper, layout, tables, formulae (R.49) and for drawings margins, scale, numbering, reference signs, text matter (R.46).

R.57(i) clarifies that the examination as to formal requirements does not encompass the question whether values are expressed in units conforming to international standards and, where appropriate in terms of the metric system using SI units (R.49(10)); also the consistence of the terminology and the signs used in the application (R.49(11)) is not examined in this stage of proceedings (CA/PL17/06). These matters are considered by the examining division, including the more physical requirements as listed in A-III,3.2.

Where the application is filed by reference to a previously filed application according to R.40(1)(c), the certified copy of the previous application must satisfy the physical requirements. However, if the previous application has to be translated under R.40(3), the translation must comply with the physical requirements instead. (A-III,3.2.2)

Late-filed application documents, such as late-filed claims (R.57(c)), inserted missing parts (R.56), replacement documents (R.50(1)) or translations (R.49(1)), must also comply with the physical requirements (A-III,3.2; A-VI-II,2.2).

16 Deposit of biological material

Where an application relates to biological material and the material has been deposited, the information pursuant to R.31(1)(c) (the depositary institution and the accession number of the deposit) and, where applicable, R.31(1)(d) (details of depositor other than the applicant) must be provided within the time limit of R.31(2). Where information pursuant to R.31(1)(c) is missing on the date of filing, the accession number must be traceable without ambiguity from the application as filed (see A-IV,4.2).

Where the application refers to a previous application under R.40(1)(c) and the previous application does not provide the information of R.31(1)(c), the deficiency must still be rectified in the time limit of R.31(2), even though the EPO can invite the applicant only after receipt of the copy of the previous application or its translation (A-IV,4.1.2).

The examining division assesses whether the available information sufficiently discloses the biological material to make it available to the public (F-III,6.2). If the information is insufficient, the biological material will not be considered disclosed pursuant to Art.83 (F-III,6.2).

17 Designation fee

The designation fee must be paid within six months of the mention of the publication of the search report (R.39(1)), i.e. within the same time limit in which the request for examination must be filed (R.70(1)).

See Art.79, R.39 and A-III,11 for particulars about the payment of the designation fee and the change on 01.04.2009 from a designation fee for each contracting states to a flat rate designation fee for all contracting states.

18 Extension fees

The extension fee must be paid within the same period as the designation fee. If not paid in due time, the request for extension is deemed withdrawn. A communication for loss of rights to extensions will only be issued if a communication for loss of rights to designations is issued. Only in this case further processing according to Art.121 and R.135 will be available for payment of the extension fees. A grace period of two months from expiry of the basic period is available in which an extension fee can be paid with 50% surcharge (OJ2009, 603). Re-establishment is not possible. (see Art.79(2):2.3; A-III,12.2)

R. 58 Correction of deficiencies in the application documents

If the European patent application does not comply with the requirements of Rule 57(a) to (d), (h) and (i), the European Patent Office shall inform the applicant accordingly and invite him to correct the deficiencies noted within two months. The description, claims and drawings may be amended only to an extent sufficient to remedy such deficiencies.

R.57 Examination as to formal requirements
Implementation of: Art.90(4)
EPC 1973: R.41(1)

1 Invitation to correct deficiencies in the application

Where the formalities examination under Art.90(3) reveals that the application does not comply with the requirement of R.57(a) to (d), (h) and (i), the EPO will invite the applicant to correct them within two months of notification of the invitation (R.58). See the notes to R.57 for the invitation in the cases where the requirements of R.57(e) to (g) and (j) are not complied with. R.135(2) excludes the non-extendable two-month period of R.58 from further processing. Hence, re-establishment according to Art.122 and R.136 is available.

The sanction on failure to meet the period of R.58 is refusal of the application unless another sanction is provided (Art.90(5)). The notes to R.57 mention the specific sanctions provided for not meeting the requirements and any remedies.

If the sanction is refusal, an appeal may be filed as remedy, correcting the deficiency on filing the appeal. J18/08 allowed correction of not appointing a representative in this manner. In contrast, if the sanction is deemed withdrawn and a decision under R.112(2) is requested, an appeal against a negative decision will merely be a re-examination of the loss of rights communication. The communication will only be regarded inaccurate if the act was performed in due time. Hence, in such a case an appeal cannot be used to correct a deficiency (J18/08 r.5).

Amendment of the application documents

Prior to the receipt of the search report the applicant may amend his application only if the Receiving Section has invited him under R.58 to remedy particular deficiencies (see R.137(1)).

After receipt of the search report and before the receipt of the first communication from the examining division the applicant may amend the application of his own volition (Art.123(1), last sentence and R.137(2) as valid before 01.04.2010), taking care not to extend the subject-matter (Art.123(2)) (A-V,2.1). When the search report is drawn up on or after 01.04.2010, a voluntary amendment is only allowed when filed together with the first substantive response (R.137(2) as valid from 01.04.2010).

An applicant may correct any errors in the application of his own volition by filing a request according to R.139 (A-V,3).

R. 59 Deficiencies in claiming priority

If the file number of the previous application under Rule 52, paragraph 1, or the copy of that application under Rule 53, paragraph 1, have not been filed in due time, the European Patent Office shall inform the applicant accordingly and invite him to file them within a period to be specified.

R.52(1) Content of declaration of priority
R.53(1) Priority document
Implementation of: Art.90(4)
EPC 1973: R.41(2), (3)

allow (ADA.5.2). The EPO informs the account holder of the shortfall by fax or email (ADA.5.2.4; AAD.7; OJ 2015 sp3, Annex B 3.6 and 3.7).

After the deposit account is duly replenished, the payment is considered to have been made on the date of replenishment, not on the date of receipt of the debit order or the decisive payment date in case of automatic debiting (ADA.5.2.4; AAD.8). The date of replenishment is the date the payment was actually entered in the EPO bank account (Rfees7(1)). A replenishment is considered to have been made in due time if the payment was effected not later than ten days before expiry of the relevant period for payment (ten-day fail-safe provision ADA.4.1; A-X,6.2.2). The option of Rfees7(3) to pay with 10% surcharge within the ten days is not available for replenishment payments (ADA.4.1). Hence, a shortfall will cause these debit orders to be processed usually after expiry of the relevant period for payment and remedies for late paid fees may have to be applied.

Further processing under Art.121 and R.135 is available for most late paid fees; the fee for further processing is usually 50% of the late paid fee (Rfees2(1)12). Some late paid fees, such as appeal fee, opposition fee, renewal fee plus additional fee, renewal fee for divisional, further search fees, and any fee paid in the further-processing period require re-establishment under Art.122 and R.136 as remedy; the fee for re-establishment (Rfees2(1)13) must be paid and all due care proved (Art.122(1):4). There is no remedy for fees paid late for re-establishment (Art.122(4)).

A shortfall can be avoided by checking the Fee Payment plan regularly (see the above section 2) and replenishing the account accordingly. For example, check twice weekly the total amount of the fees due for the next 20 days and replenish the account to the total amount, correcting for incidental extra payments. The EPO debits the account within two to three working days after the decisive payment date of a fee that must be debited automatically or on the date of receipt of the debit order for any other fee (ADA.5.2.2). Sometimes the debiting may take up to a few weeks because of high workload; such belated debits are included in the Fee Payment plan.

2.2 ANNUAL SUBSCRIPTIONS EPI

A professional representative can pay the annual subscription to the Institute of Professional Representatives before the European Patent Office (*epi*) by direct debiting of a deposit account held by the EPO on the basis of an agreement between the EPO and the *epi* (OJ 2017 sp5 p.83 Annex 3.1 and B2). The representative must thereto file a direct debiting mandate signed by the account holder with the *epi*, not with the EPO. The *epi* will transmit the debit orders to the EPO, upon which the EPO debits the accounts and pays the sum to the *epi*. (ADA.8)

3 Automatic debiting

An applicant or proprietor may file an automatic debit order according to the Arrangements for the Automatic Debiting procedure (AAD). The version of AAD valid as of 01.11.2017 has been published in consolidated form in OJ 2017 sp5 p.22 Annex A1 and explanations in Annex A2.

An automatic debit order authorises the EPO to debit a deposit account for all fees due for an application or patent automatically on the expiry date of the fee. An automatic debit order must be filed and revoked online (AAD.1 and 12).

Applicants and proprietors can use the automatic debiting in all procedures for European patent applications and patents, and for PCT applications in the international phase where the EPO is receiving Office, ISA or IPEA and for PCT applications before the EPO as designated or elected office. Note, that an automatic debit order filed for the international phase is not applicable in the regional EP phase; a separate automatic debit order must be filed for both proceedings (AAD.2). An opponent cannot pay the opposition fee using automatic debiting; further excluded fees are listed in AAD.4.

The automatic debit order must be filed online via a secure portal on the EPO website (AAD.1.2). The online Request for Grant form and the form for entry into the European phase include a section with a drop-down menu where automatic debiting can be selected (OJ 2017 sp5 p.72 Annex 2, notes to point 5). The procedure for filing the automatic debit order during pending proceedings is governed by AAD.10.

AAD.3 specifies the fees that are covered by the automatic debiting and AAD.4 the fees that are not. The date of payment under automatic debiting, i.e. the decisive payment date, is usually the last day of the period for paying a fee (AAD.6.1(a)). The fee for further processing is paid on the last day of the period for requesting further processing where the omitted act was a payment, and on the date of completion of the omitted act where the omitted act was the non-performance of a procedural act other than payment of a fee (AAD.6.1(h)). The fee for re-establishment, for limitation or revocation, for appeal and for petition for review is paid on the date of receipt of the request (AAD.6.1(i)).

Under the automatic debiting procedure all fees becoming due during the procedure will be paid automatically. Hence, the further search fees for all non-unitary inventions are automatically debited (Annex A2, notes to point 3); similarly, all claims fees are automatically debited (AAD.3.2(d)). If the applicant does not want to pay one or more of these fees, he must actively revoke the automatic debit order to stop all payments or inform the EPO that one or more fees are not to be paid (AAD.12). If a fee is paid by another means of payment and is received at least four days before the decisive payment date, the EPO will not carry out the automatic debit order in respect of that fee (AAD.11). Payment by another means can also be used to avoid a fee increase by paying early (Annex A2 notes to point 11).

The procedure automatic debiting in case of shortfall is set out in AAD.7-8.

4 Credit card

As from 01.12.2017 it is possible to pay by credit card in euros. The date of payment is the date in Central European Time on which the transaction is approved, which date is indicated in the confirmation made available to the payer. A transaction failed before it is approved is considered not to have been made, even if the failure was not attributable to the payer. If a failure causes the payment to have been made after expiry of the period for payment, the period will still be considered to have been observed on condition that evidence is provided to the EPO that the payer received a confirmation of approval within the period. (Dec. Pres. OJ 2017 A72)

Credit card payments can be made online using either Mastercard or Visa. The EPO will bear any transaction charges. Any refund will not be made into the credit card account but will be paid into a deposit account with the EPO or, if not available, by cheque (A-X,10.3). (OJ 2017 A73)

Rfees 6 Particulars concerning payments

Rfees6(1) Every payment must indicate the name of the person making the payment and must contain the necessary particulars to enable the Office to establish immediately the purpose of the payment.

1 Person making the payment

Since the Rules relating to Fees use the general term 'the person making the payment' instead of 'the party' as in the EPC, a payment can be made by any person; it is not restricted to parties or their representatives (A-X,1). No representative is required for applicants who must be represented under Art.133(2) (Legal Advice L6/91 rev. §1, OJ 1991 p.573; cancelled by Dec. Pres OJ 2012 p.446). However, any communication relating to the payment must be made by the party concerned or his representative. Any refund of a payment is made to the party or his representative, provided the latter is authorized to receive payments (A-X,10.4).

2 Particulars of payment

For the efficient processing of payments made by bank transfer, the payer must give the application number, the fee code(s) and the amount for each fee code, preferably in the payment-reference field of the (electronic) bank transfer (OJ 2017 A100). See Rfees6(2) for unclear or incomplete payment details.

3 Correction of payment

An omitted payment cannot be corrected under R.139, because an omitted payment is not covered by R.139, first sentence (J21/84 r.7,8; T170/83 r.8, last paragraph). A debit order for a deposit account can neither be corrected (however, see Rfees5(2):2.1.1).

Rfees6(2) If the purpose of the payment cannot immediately be established, the Office shall require the person making the payment to notify it in writing of this purpose within such period as it may specify. If he does not comply with this request in due time the payment shall be considered not to have been made.

1 Purpose of payment

When the purpose of the payment is obviously wrong, the error is not prejudicial if the EPO can derive the intended purpose from the remaining information (J16/84).

If the intended purpose can still not be established, the EPO must ask the payer (Rfees6(2)). If the EPO requests the payer to specify the purpose of a payment and the payer responds in due time, the payment and the original payment date remain valid (A-X,7.1.2).

If the payer does not reply to the request, the payment is considered not to have been made (Rfees6(2), last sentence).

The inadvertent use by the EPO of a payment for a different purpose from that evidently intended by the payer has no effect on the purpose intended by the payer. (J16/84)

Rfees 7 Date to be considered as the date on which payment is made

1 Date of payment

Rfees7 governs which date the EPO considers as the date on which a payment has been made. Rfees7(1) gives the general rule for payments into and transfers to the EPO bank account. Rule for other methods of payment are given by the President (Rfees7(2)). Rfees7(3) sets out the conditions under which a late payment may be regarded as having been made in due time; Rfees7(4) gives the corresponding procedure.

Rfees7(1) The date on which any payment shall be considered to have been made to the Office shall be the date on which the amount of the payment or of the transfer is actually entered in a bank account held by the Office.

Amended by decision of the Administrative Council of 25.10.2007 (OJ 2007 p.533).

1 Applicability of Rfees7(1)

Rfees7(1) applies not only to payments of fees but also to payments serving to replenish a deposit account (ADA.4.1).

2 Date of payment for payments into the EPO bank account

The date of payment is the date the amount paid is actually entered into the EPO account. The amount is not 'actually entered' on the value date of the bank transfer but on the date on which the bank statement is issued that shows the amount (OJ 1997, 217, point 7). In general, the two dates will be the same for daily issued statements, but the date of the bank statement has the advantage over the value date that the former cannot retroactively be changed by the payer. Rfees7(3) contains provisions for an effective date earlier than the actual date of payment. This is allowed by the word 'considered' in Rfees7(1), creating the possibility for a fictitious day of payment.

When a payment has still to be made on the last possible day, one should request the bank to make an urgent transfer on the same day. A deposit of the money with the bank where the EPO has its account is generally of no avail, because the money is often not entered into the account until the next day. It is safer to file a debit order online with EPO, or, in the absence of a deposit account with the EPO, ask a colleague to debit his account.

See Rfees7(2):1 for the date of payment where another method of payment than payment into the EPO bank account is used.

Rfees7(2) Where the President of the Office allows, in accordance with the provisions of Article 5, paragraph 2, other methods of paying fees than those set out in Article 5, paragraph 1, he shall also lay down the date on which such payments shall be considered to have been made.

1 Date of payment for debit order and automatic debiting

The date of receipt by the EPO of a debit order is considered as the date of payment, provided the account has sufficient funds (ADA.5.4.1). Under the automatic debiting procedure fees are in general debited from the deposit account on the last day of the relevant period (AAD.6.1(a)). See Rfees5(2):2.1.3 for the date of payment in case of shortfall of the account.

2 Date of payment for credit card payment

A payment by credit card is deemed to have been made on the date on which the transaction is approved. This date is indicated in the transaction confirmation made available to the payer (Dec. Pres. OJ 2017 A72, Art.3). Where, due to a failure in the transaction process, payment of a fee is not considered to have been made until after the expiry of the period, it shall be considered that this period has been observed if evidence is provided to the EPO that, within this period, the payer has received a confirmation that the transaction was approved (OJ 2017 A72, Art.4(2)).

Rfees7(3) Where, under the provisions of paragraphs 1 and 2, payment of a fee is not considered to have been made until after the expiry of the period in which it should have been made, it shall be considered that this period has been observed if evidence is provided to the Office that the person who made the payment

- (a) fulfilled one of the following conditions in a Contracting State within the period within which the payment should have been made:
 - (i) he effected the payment through a banking establishment;
 - (ii) he duly gave an order to a banking establishment to transfer the amount of the payment; and
- (b) paid a surcharge of 10% on the relevant fee or fees, but not exceeding EUR 150; no surcharge is payable if a condition according to sub-paragraph (a) has been fulfilled not later than ten days before the expiry of the period for payment.

Amended by decision of the Administrative Council of 25.10.2007 (OJ 2007 p.533).

1 Ten-day fail-safe provision

Rfees7(3) is called the 'ten-day fail-safe provision'. It creates the fiction of payment within a period where the actual payment is made after expiry of the period. All delays in the banking system will be at the risk of the EPO.

The ten-day fail-safe provision applies only to payments that have duly been initiated within the period for payment, i.e. in the way prescribed by **Rfees7(3)(a)**: effecting the payment through a bank or giving an order to a bank to transfer the payment. In addition, the payment must be initiated within a contracting state according to **Rfees7(3)(a)**. Hence, the arrangement does not apply to payments from outside the contracting states. Such payers should appoint a professional representative as soon as possible and effect payment through him.

Rfees7(3) distinguishes two cases where the payment is initiated before expiry of the period for payment but the payment is entered into the EPO account after the expiry. When the payment was duly initiated not later than ten days before expiry of the period for payment, the payment will be deemed to have been made in due time; no surcharge is payable (**Rfees7(3)(b)**). When the payment was duly initiated less than ten days before expiry of the period but before the expiry, the payment will only be deemed to have been made if a surcharge of 10% is paid. The ten-day fail-safe provision can also be used for payments replenishing a deposit account (**ADA.4.1**).

The extension of periods under **R.134** does not apply to the 10-day period, because the last day of that period does not end a period within which a procedural step must be taken. A change of fees between the day of initiating the payment and the day of actual payment under the 10-day rule necessitates the payment of the new fee, as the key date for the increase in fees is the date of actual payment and not the fictitious date of payment (**J18/85**).

The ten-day fail-safe provision must be applied for determining whether the normal period for payment was complied with or the payment was made in a further processing period following the normal period (**A-X,6.2.4**).

Since a payer in general arranges his payments to be effected in due time, there is no reason to pay the 10% surcharge of **Rfees7(3)(b)** in advance. **Rfees7(4)** provides for payment of the surcharge in arrears.

The term 'banking establishment' in **Rfees7(3)(a)** covers the banking services of post offices of contracting states for payment or transfer to a bank account held by the EPO.

See **R.134(5):1** for another remedy for a late payment caused by delay in the banking system.

Rfees7(4) The Office may request the person who made the payment to produce evidence as to the date on which a condition according to paragraph 3(a) was fulfilled and, where required, pay the surcharge referred to in paragraph 3(b), within a period to be specified by it. If he fails to comply with this request or if the evidence is insufficient, or if the required surcharge is not paid in due time, the period for payment shall be considered not to have been observed.

1 Provision of evidence and payment of surcharge

If a payment enters into the EPO bank account after expiry of the period for payment, the EPO will send a loss of rights communication to the applicant under **R.112(1)**. If the applicant claims that the payment was duly initiated according to **Rfees7(3)**, for direct payments to the EPO or **ADA.4.1, 5.1** and **5.5** or **5.6.2** for payment through a debit account, he must apply for a decision under **R.112(2)** and submit the requisite evidence for the claim. (**A-X,6.2.6**)

If the EPO accepts the evidence and the payment was initiated within the ten-day period, it will request the applicant to pay the 10% surcharge within a period to be specified (see e.g. **J20/00 r.6**). If the evidence is insufficient or the surcharge is not paid, the period for payment will be regarded as not observed. (**Rfees7(4)**)

Rfees 8 Insufficiency of the amount paid

A time limit for payment shall in principle be deemed to have been observed only if the full amount of the fee has been paid in due time. If the fee is not paid in full, the amount which has been paid shall be refunded after the period for payment has expired. The Office may, however, in so far as this is possible within the time remaining before the end of the period, give the person making the payment the opportunity to pay the amount lacking. It may also, where this is considered justified, overlook any small amounts lacking without prejudice to the rights of the person making the payment.

Amended by decision of the Administrative Council of 09.12.2008. (OJ 2009 p.7)

- A renewal fee is refunded if the application is not anymore pending on the due date (see Art.86(1):6).
- All fees are refunded if no date of filing is accorded (A-II,4.1.4).
- Validly paid extension fees are not refunded (Art.3(3) Extension Ordinance).
- An opposition fee is refunded if the notice of opposition is deemed not filed (see Art.101(1):1).
- An appeal fee is reimbursed if the notice of appeal is deemed not filed (see Art.108:5) and in the case of a substantial procedural violation or early withdrawal under R.103.
- An excess payment is refunded where the full amount of a fee has been paid and the applicant is entitled to a reduction under Rfees14.

Rfees9(1) The search fee paid for a European or supplementary European search shall be fully refunded if the European patent application is withdrawn or refused or deemed to be withdrawn at a time when the Office has not yet begun to draw up the search report.

1 Refund of search fee for non-pending application

According to Rfees9(1) the search fee will be fully refunded if the application is withdrawn, refused or deemed to be withdrawn before the start of the search (Not. EPO, OJ 2009, 99).

The drawing up of the search report begins on the date the examiner carries out the first search task, i.e. triggering a pre-search algorithm generating a list of documents to be inspected. This date is recorded in the public part of the file. For applications not yet published, this information can be accessed using the MyFiles service; the EPO will also provide the applicant with the relevant information upon request. (A-X,10.2.1)

Rfees9(2) Where the European search report is based on an earlier search report prepared by the Office on an application whose priority is claimed or an earlier application within the meaning of Article 76 of the Convention or of Rule 17 of the Convention, the Office shall refund to the applicant, in accordance with a decision of its President, an amount which shall depend on the type of earlier search and the extent to which the Office benefits from the earlier search report when carrying out the subsequent search.

Art.76 divisional application

R.17 new application filed by an entitled person

1 Conditions for refund of search fee

The search fee for a European search report or supplementary European search report will be refunded (Dec. Pres., OJ 2017 A94) if the search report can be based on an earlier search report prepared by the EPO for:

- an application whose priority is claimed, or
- an earlier application within the meaning of Art.76 (parent application of the present divisional application), or
- an original application within the meaning of R.17 (i.e. the present application is a new application under Art.61).

The earlier search report must have been prepared by the EPO (J8/81). That is the case e.g. for a (supplementary) European search report (Art.92; R.164(1)), for a (supplementary) international search report drawn up by the EPO as (S)ISA (Art.15 PCT), for a search made by EPO on behalf of a national office on a national application (see OJ 2017 A94 for the relevant Contracting States), and for an international-type search carried out by the EPO (Art.15(5)

PCT); and likely also for search results under R.164(2). An international-type search can be carried out by the EPO for a national application filed in an EPC Contracting State if the law of that state provides for an international-type search (OJ 1999 p.300). This is the case for CH, DK, FI, IS, NL, NO, and SE (PCT Applicant's Guide, Section B1). See OJ 2017 A94 for further details.

The search fees that can be refunded are the European search fee (Art.78(2)), the further search fee (R.64(1)) and the fee for the supplementary European search (Art.153(7)), and likely also the search fees under R.164(1) and R.164(2).

2 Amount of the refund

The amount of the refund is either a full refund or a partial refund of the search fee, depending on the extent to which the EPO can base its search report on the earlier search. The full refund is between 70% and 100% and the partial refund between 17,5% and 25%, depending on the type of earlier search (Dec. Pres. OJ 2017 A94).

The EPO informs the applicant of the amount of the refund together with the search report and will make the refund. In the event of disagreement, the applicant may request an appealable decision to be issued by the Receiving Section or examining division (A-X,10.2.1).

3 Criteria for applicable refund rate

The criteria for determining the applicable refund level are given in OJ 2009 p.99. A full refund of the search fee applies where the search report can be completely based on the earlier search (i.e. no search needs to be carried out). This is the case, in particular, where the claims of the earlier and later application are identical or where the claims of the later application are limited by deleting alternative features from an independent claim or by moving a limiting feature from a dependent claim to the independent claim it refers to in the earlier application.

A partial refund applies where the search report can be based partly on the earlier search. This applies, in particular, where the claims of the later application are a further generalisation of the invention searched in the earlier application, or the claims are limited by a feature not disclosed in the earlier application but relating to the same invention as the searched earlier application.

No refund will be made where the subject-matter of the claims represent an invention different from that searched in the earlier application, or the conditions in the first section above have not been met, for example the priority of the earlier application is not claimed.

Rfees 10 Refund of the fee for a technical opinion

An amount of 75% of the fee for a technical opinion under Article 25 of the Convention shall be refunded if the request for a technical opinion is withdrawn at a time when the Office has not yet begun to draw up the technical opinion.

Rfees 11 Refund of examination fee

The examination fee provided for in Article 94, paragraph 1, of the Convention shall be refunded:

- (a) in full if the European patent application is withdrawn, refused or deemed to be withdrawn before substantive examination has begun;
- (b) at a rate of 50% if the European patent application is withdrawn after substantive examination has begun and
 - before expiry of the time limit for replying to the first invitation under Article 94, paragraph 3, of the Convention issued by the Examining Division proper or,
 - if no such invitation has been issued by the Examining Division, before the date of the communication under Rule 71, paragraph 3, of the Convention.

Amended by decision of the Administrative Council of 29.06.2016, which entered into force on 01.07.2016. Amended Rfees11(a) applies to applications withdrawn, refused or deemed to be withdrawn on or after 01.06.2016. Amended Rfees11(b) applies to applications for which substantive examination starts on or after 01.11.2016. (OJ 2016 A48)

Art.94(1) request for examination

Art.94(3) invitation to file observations

R.71(3) communication of text to be granted

1 Refund of the examination fee

The EPO will refund the examination fee at a rate depending on the moment in time when the grant procedure terminates, either due to refusal by the EPO, being deemed withdrawn or active withdrawal by the applicant. A reason for the refund is that an applicant should not have to pay for a service the EPO does not deliver. Moreover, the refund provides an incentive for the applicant to withdraw an application they are no longer interested in pursuing; this frees examiner capacity which can be deployed to reduce the EPO's backlog in examination.

The withdrawal of an application can be made conditional on the (partial) refund of the examination fee. (OJ 1988 p.354; E-VIII,7.3)

The implementation of Rfees11 has been set out in OJ 2016 A49.

2 Full refund

If the procedure terminates before substantive examination has begun, the entire examination fee will be refunded (Rfees11(a)). The termination may be a withdrawal, refusal or deemed to be withdrawn.

The substantive examination begins on the date the examiner carries out his first task, i.e. identifying the European prior rights that were not yet available when the search was carried out. The date is recorded in Form 2095 in the public part of the file to ensure it is verifiable. For applications not yet published, the date will be visible only at the request of the applicant or his representative or by inspecting the file using the MyFiles service. (Not. EPO OJ 2013 p.153)

The EPO will inform the applicant at least two months before the start of the examination about the intended date of the start. The intended date does not bind the EPO; the examination may start later.

An applicant unsure whether substantive examination has begun and wanting to withdraw only if he receives the 100% refund may make the withdrawal contingent upon the refund (A-VI,2.5; conditional withdrawal).

3 Partial refund

If the application is actively withdrawn after the start of the examination but before expiry of the period for response to the first substantive communication of the examining division, 50% of the examination fee will be refunded (Rfees11(b)). There is no refund if the procedure terminates after this expiry. The termination must be an active withdrawal. A timely refusal or a deemed withdrawal does not give rise to a refund under Rfees11(b). A withdrawal causes a clear end of the procedure without the possibility of reinstating the procedure through common remedies such as further processing.

For most files the withdrawal must be submitted before the expiry of the period for responding to the first Art.94(3) communication. If the period for response is extended upon request under R.132(2), it should be possible to submit the withdrawal until expiry of the extended period. If the first Art.94(3) communication is a summons for oral proceedings, the withdrawal can be made up to the last date for submitting written submissions set therein under R.116 according to EPO practice.

A few communications that are not issued under Art.94(3), e.g. under R.137(4) or R.56(3), are nevertheless taken into account under Rfees11(b) and a few communications that are issued under Art.94(3), e.g. issued by formalities officers or under R.164(2)(a), are not taken into account. The provision endeavours to cover these deviating cases by the wording 'issued by the examining division proper', where the word 'proper' is not defined. The word intends to exclude communications sent by formalities officers working on behalf of the examining division. The deviating cases can only be found in the Notice in OJ 2016 A49, which, however, has no legal force.

In cases where the first communication of the examining division is a R.71(3) communication, the withdrawal must be submitted at the latest on the day before the date of the communication for a 50% refund (A-VI,2.5). Note, that an applicant has no advance information when the communication will be sent.

Rfees 12 Refund of insignificant amounts

Where too large a sum is paid to cover a fee, the excess shall not be refunded if the amount is insignificant and the party concerned has not expressly requested a refund. The President of the Office shall determine what constitutes an insignificant amount.

1 Insignificant amount

An insignificant amount is 15 Euro or less (OJ 2018 A37). Hence, an overpayment of more than 15 Euro is refunded without request, an overpayment of 15 Euro or less is refunded only on request. The request must be made before expiry of the period of Rfees13(2). (A-X,10.1.3)

Rfees 13 Termination of financial obligations

Amended by decision of the Administrative Council of 15.10.2007, which entered into force on 13.12.2007 (OJ 2007 p.533).

1 General

The provision takes care of the extinction of financial claims that have become out-of-date. It avoids the situation that parties will experience difficulties in providing evidence when rights are not executed for a long time.