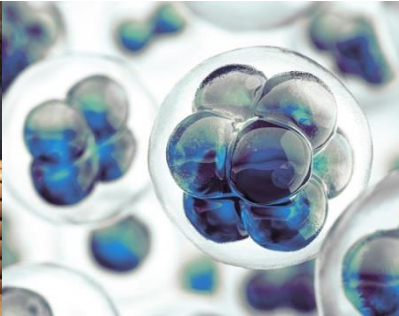




Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Guidelines 2019

Summary of main changes – formalities procedures



Updates to the Guidelines 2019



Change in practice



Clarification of the practice



**Incorporation of relevant
new case law**



Procedural changes

**EPO
Guidelines
2019**

Overview of updates relevant for formalities procedures

Part A

- Quality of application documents
- Filing of priority documents
- Prior search results
- Fees
 - Additional fee
 - Language based fee reduction
- Abolishing certain administrative fees
 - Acknowledgement of receipt by fax
 - File inspection, Register
- Amendments to the ADA
- Method of refund

Parts A and D

Part E

- Calculation of time limits upon resumption after stay (Rule 14(1) EPC)
- Requesting further processing in respect of the time limit under Rule 71(3) EPC
- Incorporation of the Euro-PCT Guide
 - Additional translation requirements
 - Review by the EPO as a designated/elected Office
- Updates in view of legal developments
 - Discontinuation of advices of delivery
 - Change of name of an applicant
- New chapter on the "Patent Prosecution Highway"

Part H

- Correction of the translations of the claims to be published with the B-publication

Quality of application documents

- A better quality of the application documents must not result in added subject-matter going beyond the content of the application as originally filed (Art. 123(2) EPC).
- If better quality application documents are likely to disclose more than the original pages, the Receiving Section should not invite the applicant to correct a deficiency.



Clarification

A-III, 3.2

J 4/09

Filing of priority documents

Further possibilities to submit priority documents:

- In electronic form via OLF or CMS, provided they comply with the format requirements of the EPO.
- Using the WIPO Digital Access Service (DAS):
 - Electronic exchange of priority documents among Offices participating in the WIPO-DAS service.
 - The EPO retrieves the certified priority document using the access code provided by the applicant.
 - The service is free of charge.



Updated procedure

A-III, 6.7

OJ EPO 2018, A93

OJ EPO 2018, A94

OJ EPO 2018, A78

OJ EPO 2019, A27

Prior search results – new exemption

- As from 1 August 2019 applicants claiming a **Swiss** priority are **exempted** from filing a copy of the prior search results.
- The EPO will include a copy of such prior search results, if available, into the file of the European patent application.



Updated procedure

A-III, 6.12

Rule 141(1) EPC
Rule 141(2) EPC
OJ EPO 2019, A55

Fees (1)

Page fee

- If **better quality application documents** filed in reply to a communication under Rule 58 EPC result in a higher number of pages making up the application, additional page fees must be paid within the time limit of the communication under Rule 58 EPC, if applicable.
- Any **claims amended under Art. 19 PCT** replace the claims as originally filed.
- **Re-formatted** application documents filed on entry of the European phase are ignored. The page fee is calculated on the basis of the international publication and any amendments specified on entry.



Clarification

A-III, 13.2

OJ EPO 2009, 118;
OJ EPO 2009, 338
OJ EPO 2017, A74
Art. 28 PCT
Art. 41 PCT

Fees (2)

Conditions for the language-related reduction

- If there **are multiple applicants**, each one must declare to be an entity or a natural person within the meaning of Rule 6(4) EPC.
- It is **sufficient** if only one applicant is entitled to file in an **admissible non-EPO language**.



Change in practice



Case law

A-X, 9.2.1

Rule 6 EPC

Art. 14(4) EPC

J 4/18

Abolishing certain administrative fees

Acknowledgement of receipt by fax

- Discontinuation of the service to fax an acknowledgement of receipt for documents filed on paper.

File inspection, extract from Register

- Discontinuation of the service to issue **uncertified** paper copies of files or extracts from the European Patent Register.
- **By way of exception**, uncertified copies are still sent upon substantiated request.

▶ Abolishment of corresponding fee codes 031, 026, 027



Updated procedure

A-II, 3.1
A-XI, 2.2
A-XI, 4

OJ EPO 2019, A15
OJ EPO 2019, A18

Amended Arrangements for Deposit Accounts (ADA)

- Expenses and prices can no longer be paid via deposit accounts; ADA, p. 1.
- Extension of the validation functionality for fees paid via Online Fee Payment (see next slide); ADA, p. 5.3.
- Order of priority for processing debit orders: In case of insufficient funds, no other debit order is processed until the account is replenished; ADA, p. 5.2.2, 5.2.3.



Updated procedure



Clarification

A-X, 4.2.1 **A-X, 4.2.3**
A-X, 4.2.4 **A-X, 5.1.1**
A-X, 5.2.4

OJ EPO 2019, A20

OJ EPO 2019, A21

OJ EPO 2019, A26

Suppl. publ. 4, OJ EPO 2019

Validation functionality

- Batch or individual debit orders made via the Online Fee Payment service are **automatically rejected** if they concern:
 - renewal fees and fees for the transfer of rights for applications that are definitively closed;
 - renewal fees for granted European patents;
 - renewal fees received before the earliest valid payment dates under Rule 51(1) EPC; and
 - double payments for fees that can be paid only once in the proceedings.
- Fees that are invalidly paid using OLF or CMS are **refunded**.



Updated procedure

A-X, 4.2.3

A-X, 5.1.1

A-X, 5.2.4

OJ EPO 2019, A20

ADA, p. 5.3

ADA, Annex A.3

Method of refund (1)

- Effecting refunds to deposit accounts (revised practice).
- Effecting refunds to a bank account (new).
- Refunds are not made to a credit card account.
- Refund instructions are to be kept up-to-date.



Change in practice



Clarification

A-X, 10.3

A-X, 10.3.1

A-X, 10.3.2

OJ EPO 2019, A26

OJ EPO 2017, A73

Method of refund (2)

Refund to a deposit account

- Refund instructions must be filed in an electronically processable format via one of the accepted means of filing.
- Refund to the deposit account of a third party possible.
- **Change of representative/transfer of rights:**
If no new refund instructions are given, the EPO *ex officio* deletes the deposit account of the former representative / applicant.



Updated procedure



Change in practice

A-X, 10.3

A-X, 10.3.1

OJ EPO 2019, A26
ADA, p. 8

Method of refund (3)

Refund to a bank account

- In the absence of information on a deposit account, the party to the proceedings is invited to claim the refund online.
- A refund code is sent to the party to the proceedings in a non-public communication.
- The refund to a bank account can be claimed on the dedicated EPO website by entering the application details, a bank account number and the refund code.



Updated procedure

A-X, 10.3

A-X, 10.3.2

OJ EPO 2019, A26

ADA, p. 8

Time limits interrupted by stay of proceedings

New examples illustrating the calculation of **interrupted time limits upon resumption** of the proceedings.

- The remaining period will continue to run **on the day** the proceedings are resumed and may not be less than two months.
- First, the remaining days are added, then the remaining months.
- Time limits do not expire on days where EPO is not open or no mail is received (Rule 134(1)).

▶ Staying the proceedings is the responsibility of the **Legal Division**.



Clarification

A-IV, 2.2.4

D-VII, 4.3

R. 14 EPC

R. 78 EPC

Further processing – omitted acts under Rule 71(3) EPC

- One single (flat) fee for requesting further processing into the time limit under Rule 71(3) EPC.
- One single fee (50% of unpaid fee) for requesting further processing into the time limit under Rule 71(4) EPC.

Omitted act	Fee for further processing
(1) Late payment of the fee for grant and publishing and/or late filing the translations of the claims (R. 71(3) EPC)	flat fee
(2) Late payment of any claims fees only (R. 71(4) EPC)	50% of the claims fees
(3) Late performance of the acts stated in (1) and late payment of the claims fees (R. 71(3) + R. 71(4) EPC)	Flat fee and 50% of the claims fees
(4) For EP applications filed before 1 April 2009, late payment of page fees only	flat fee



Clarification

E-VIII, 2

Rule 71(3) EPC
Rule 71(4) EPC

Art. 2(1), item 12, RFEEs

Euro-PCT – translation requirements

- **Before the EPO as designated Office:**
 - The claims amended under Art. 19 PCT.
- **Before the EPO as elected Office:**
 - All **annexes to the IPER**, i.e. replacement sheets, **irrespective** of whether they are to form the basis of further proceedings.
 - Any amendments under Art. 19 PCT if they are to form the basis of further proceedings and are not annexed to the IPER.
- **For enabling the examiner to understand the amendments under Art. 19 PCT or Art. 34 PCT on which the further proceedings are to be based:**
 - The accompanying letter under R. 46.5(b) PCT **or** R. 66.8(a) PCT, indicating the basis for the amendments in the application as filed.



Clarification

E-IX, 2.1.3

R. 49.5(a) PCT

R. 66.8 PCT

Art. 36(2)(b), (3)(b) PCT

R. 70.16 PCT

R. 74.1(a) PCT

R. 137(4) EPC

Review by the EPO as a designated/ elected Office (1)

Review under Art. 25 PCT

- An applicant may request the EPO to review the findings of the receiving Office (RO) that the international application
 - is not accorded an international filing date; or
 - is considered to be withdrawn.
- The request must be filed within 2 months from receiving the corresponding communication from the RO.
- The applicant must take the following minimum steps:
 - request the IB to send copies of any documents in the file to the EPO;
 - file a request under Art. 25 PCT
 - pay the filing fee;
 - file the translation of the international application if it is not in an official language of the EPO.



Clarification

E-IX, 2.9.1

R. 51.1 PCT

Art. 25(2)(a) PCT

R. 159(2) EPC

Review by the EPO as a designated/ elected Office (2)

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

- Pursuant to Art. 24(2) PCT, the EPO as designated/
elected Office may maintain the application as a European
application even if this is not required by virtue of
Art. 25(2) PCT.
- The applicant must fulfil the same requirements as for a
request for review under Art. 25(2) PCT.
- The two-month time limit under Rule 51.1 PCT does
not apply.
- The request may have to be combined with a request for
re-establishment of rights or further processing
(appropriate means of redress before the EPO).



Clarification



Case law

E-IX, 2.9.2

(new section)

J 19/16

R. 82bis PCT

Review by the EPO as a designated/ elected Office (3)

Rectification of errors made by the receiving Office or the International Bureau

- On applicant's request, the EPO as designated Office may correct any error by the RO concerning
 - the international filing date; or
 - the deletion of a priority claim.
- The error is rectified if the EPO finds that the error is such that the EPO would rectify it under the EPC.
- EPO as designated Office will review any international filing date accorded by the RO on the basis of incorporation by reference on its own motion.



Clarification

E-IX, 2.9.3

(new section)

R. 82*ter*.1 PCT

Updates in view of legal developments

- **Amended Rule 126(1) EPC** entering into force on 1 November 2019: Discontinuation of the **advice of delivery**. All notifications by postal services are sent by registered letter.
- Introduction of a section on the **Patent Prosecution Highway**.
- The **change of name** of an applicant (or proprietor) can be requested as long as the proceedings before the EPO are pending.
- This includes the time where a patent is pending in opposition proceedings.



Updated procedure



Clarification

E-II, 2.3

E-VIII, 4.3

E-XIV, 5

OJ EPO 2019, A57

Publication of corrected translations of the claims

- **Confirming the existing practice:** The translated claims filed in reply to the communication under Rule 71(3) EPC can be corrected before publication if received **before the termination of the technical preparations** for the B publication.
- If filed too late, the translation of the claims can only be corrected if:
 - the patent is maintained in amended form (Rule 82(2) EPC) after opposition proceedings; or
 - before a national authority (Art. 70(4) EPC)



Clarification

H-VI, 5

Art. 14(6) EPC
R. 71(3) EPC

Questions



Questions

now

via chat to "All Panelists"

later

via mail → patentlaw@epo.org

**Question & answer
session**