



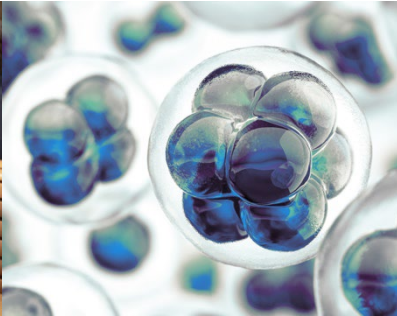
Europäisches
Patentamt

European
Patent Office

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Guidelines2day 2022

Outlook – EPC Guidelines 2023



Presenter



Heli Pihlajamaa

- Director
- Directorate Patent Law and Procedures
- Studied Law at Helsinki University and at Max Planck Institute in Munich
- Before joining the EPO, she worked in both the private and public sector
- Responsible for supporting the EPO policy by developing, strengthening and promoting the EPC, including proposals for legal changes and compliance of operations with patent law-related norms and case law
- Advises EPO higher management on policy issues and legal amendments



Presenter



Luigi Petrucci

- Head of Department
- Directorate Patent Law and Procedures
- Studied Aeronautics with specialisation in engines at the university of Rome
- Master in Business Administration at the university of Rotterdam
- Joined the EPO in 1999 as an examiner
- The last five years Luigi has been responsible for the Guidelines yearly review cycle.



Presenter



Monika Neumann

- Legal Expert, Filing and Euro-PCT
- Directorate Patent Law and Procedures
- Joined the EPO in 2001 as a Formalities Officer. Before worked as an assistant in a big patent attorney's office in Munich
- Since 2015 she supports Directorate Patent Law and Procedures as a legal expert with a focus on filing and Euro-PCT
- Coordinates the annual Guidelines revision cycle



Presenter



Laurence Brüning-Petit

- Head of Department
- Directorate Patent Law and Procedures
- Studied law at the universities of Lyon and Augsburg.
- PhD in Patent Law in 2006
- Before joining the EPO in 2004, she worked as a research assistant at CEIPI (Strasbourg) and freelancer for the Max Planck Institute for Intellectual Property, Competition and Tax Law (Munich)
- Responsible for all legal issues related to search, examination and fees



Presenter



Anna Maria Bach Pedrocchi

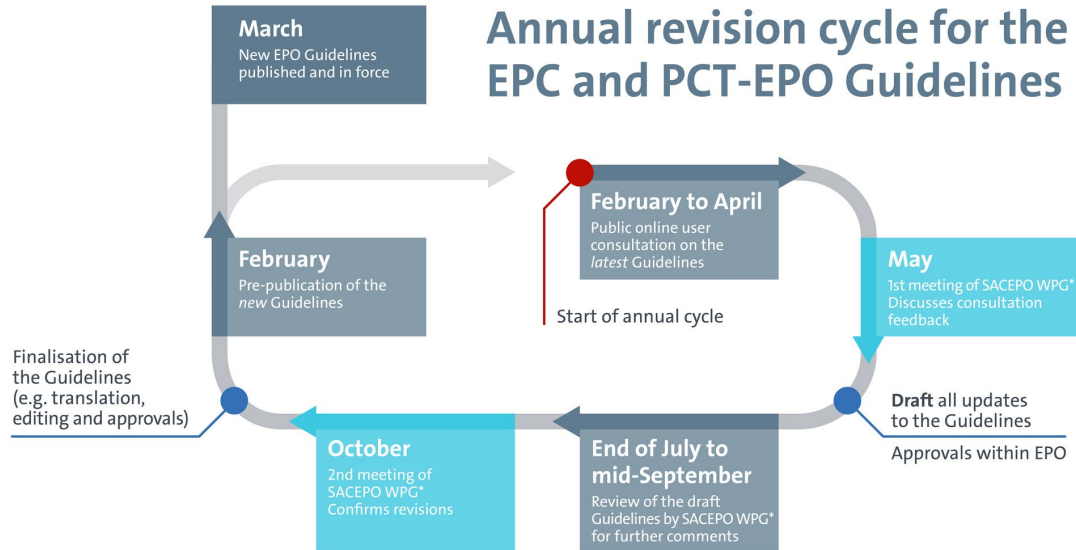
- Head of Department Revenue Controls, Directorate Treasury and Accounting
- Studied Economics at the University Pompeu Fabra in Barcelona
- Postgraduate studies in accounting and tax advising at ESADE (Barcelona), Bilanzbuchhalter certification in Austria
- Joined the EPO in 2005. Before, she worked for different companies in the areas of financial accounting, controlling and external audit.
- Responsible for EPO revenue accounting and all tasks related to patent fee payments, fee payment services and refund handling



Content

- Guidelines revision cycle
- Public user consultation
- Hot topics for the 2023 revision cycle
- Digital transformation
- Central Fee Payment
- Q & A

Guidelines revision cycle



* SACEPO Working Party on Guidelines

<https://www.epo.org/law-practice/legal-texts/guidelines-revision-cycle.html>

Public user consultation 2022

- Started in February with publication of the preview version of the Guidelines 2022
- Announced on epo.org, the EPO Newsletter and social media
- Open for comments until mid-April, open to everyone
- The contributions are discussed in the 1st meeting with the SACEPO Working Party on Guidelines (SACEPO WPG) on 19.05.2022
- The draft Guidelines 2023 will include
 - the user comments adopted by the SACEPO WPG
 - any other comments received from interested users during the year at patentlaw@epo.org
 - updates due to legal and procedural changes

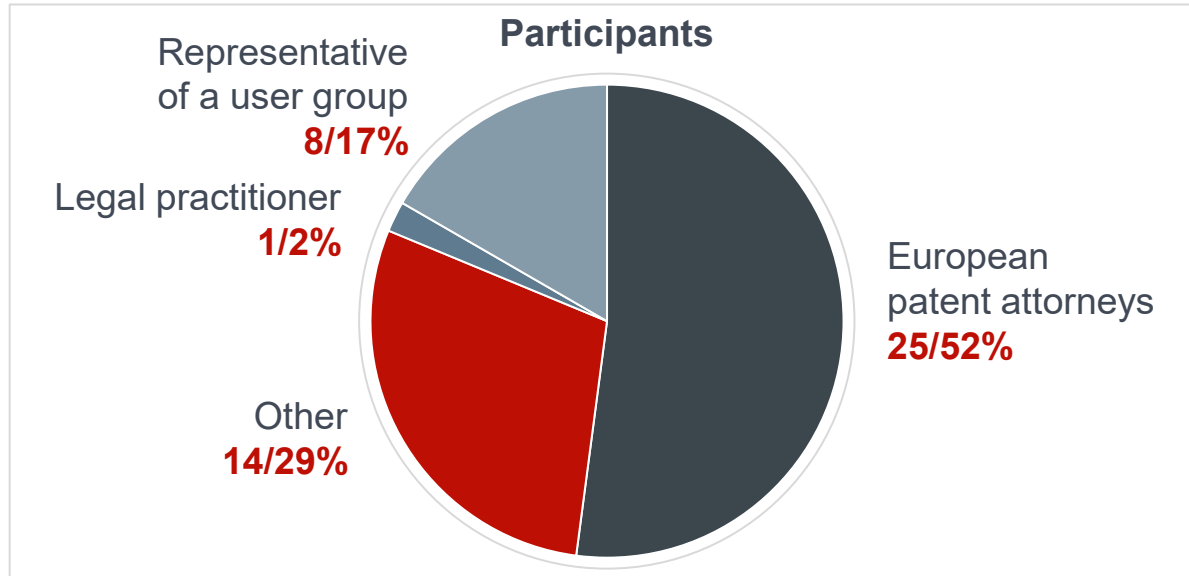
<https://www.epo.org/law-practice/consultation/completed.html>

<https://www.epo.org/law-practice/legal-texts/guidelines.html>

patentlaw@epo.org

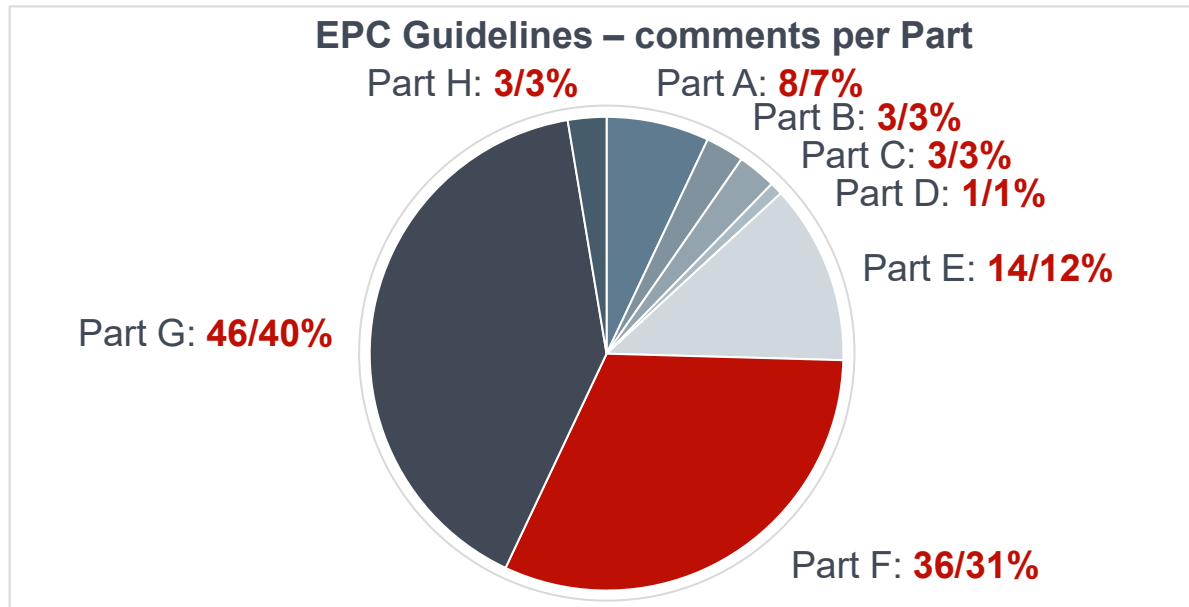
Public user consultation 2022

- Total of 114 comments received
- Majority of comments originate from European patent attorneys and "other" users



Public user consultation 2022

- Majority of comments (30) relate to the Office's practice regarding the requirement to adapt the description (Part F-IV, 4.3 and 4.4) and to Part G (46 comments).



Hot topics EPC Guidelines 2023

1. Forthcoming legal changes

- Sequence listing standard ST.26 (GL2DAY session 30.03.2022)
- New Rule 56a EPC (GL2DAY session 06.04.2022)
- Grant certificate – improved form and communication

[OJ EPO 2021, A96, A97](#)
[OJ EPO 2022, A3](#)
[OJ 2021, A94, A95](#)

Updates to Parts A, C, E, F, H

2. Foreseen legal changes – tbd

- Legal changes to support digital transformation in the PGP - tbd
- Rules 46, 49, 50, 57(i), 82, 65, 126, 127 and 131 EPC

3. Central Fee Payment

4. Decisions of the Enlarged Board of Appeal on referrals

5. Further clarifications and examples

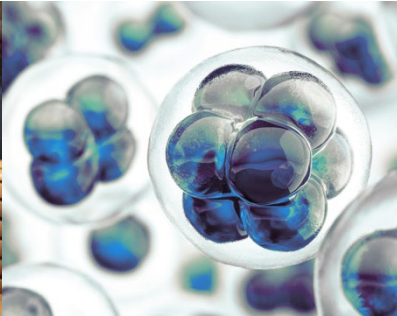
CII, AI, digital tools



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Guidelines2day 2022

Legal changes to support digital transformation



Laurence Brüning-Petit

Head of Department | Patent Law and Procedures

26 April 2022

Digital transformation - agenda

- **Background**
- **Steps towards digitalisation – Expansion of online services**
- **Milestones – Consultation**
- **Proposed amendments to the EPC Implementing Regulations**
 - Rules 46, 49, 50, 57 and 82 EPC: presentation requirements of application documents
 - Rule 65 EPC: transmittal of search reports
 - Rules 126, 127 and 131 EPC: notification and time-limit calculation

Background

- COVID-19 pandemic has accelerated transition to a digital patent grant process
- Internal workflows digitised
- Electronic filing and notification now standard
- However, certain legal provisions were drafted with paper-based processes in mind
- Legal changes enable future improvements
- Closer alignment with the PCT

Steps towards digitalisation – Expansion of online services

- Online services improved and expanded
 - Mailbox
 - Central Fee Payment
 - Online Filing 2.0
 - User area pilot project
- Electronic grant certificate since 01.04.2022
- Electronically certified priority documents: technical developments ongoing

<https://www.epo.org/applying/online-services/mailbox/updates.html>

[OJ EPO 2022, A25](#)

[OJ EPO 2021, A42](#)

[OJ EPO 2021, A64, A65](#)

[OJ EPO 2021, A94, A95](#)

Milestones - Consultation

- SACEPO Working Party on Rules, 14.10.2021
- Committee on Patent Law, 24.11.2021
- Meeting with Boards of Appeal, 10.12.2021
- SACEPO Working Party on Rules, 10.03.2022
- Meeting with Boards of Appeal, 16.03.2022

Presentation requirements of documents

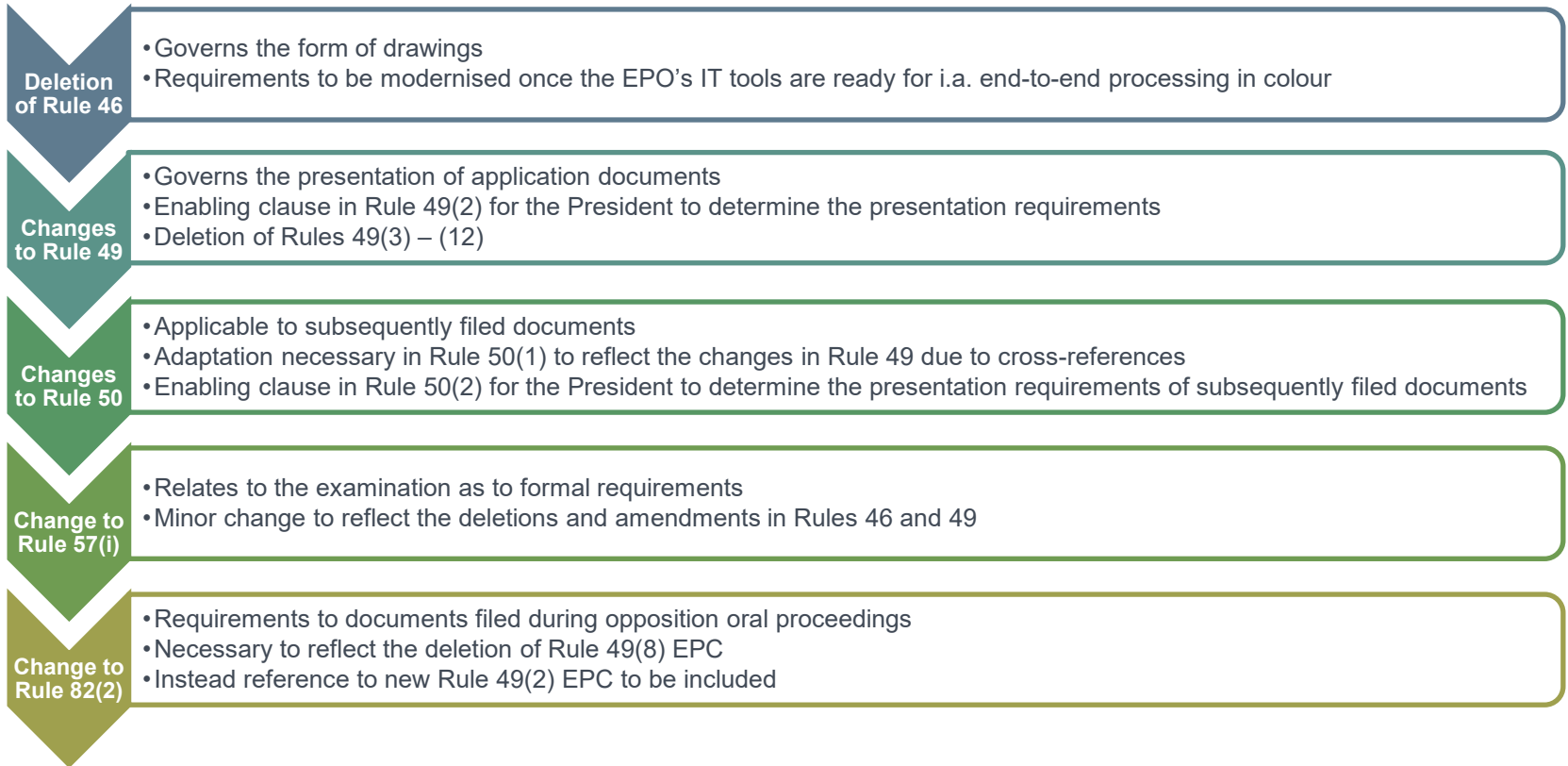
- Presentation requirements governed by Rules 46, 49 and 50 EPC; Rules 57 and 82(2) related to the examination of compliance with presentation requirements
- Current provisions reflect a paper-based procedure: need for modernisation
- More flexibility in the legislative process beneficial to adapt quickly to any future developments
- **Legal change**: presentation requirements to be defined in a decision of the President of the EPO instead of the Implementing Regulations
- The first decision of the President will re-state the current requirements
- **Entry into force**: 01.11.2022

[GL A-III, 3.2](#)
[GL A-VIII, 2.1, 2.2](#)
[GL A-IX](#)



Alignment with international requirements, in particular the PCT; consulting all stakeholders

Presentation requirements of documents – Series of changes



Transmittal of search reports

Rule 65 EPC: Transmittal of the search report including copies of any cited documents

[GL B-X, 11](#)
[GL B-X, 12](#)

- The EPO is to transmit to the applicant copies of any document cited in the search report.
- They are currently sent by post or via the Mailbox
 - Huge quantity of paper per year
 - Challenges to transmit non-conventional citations (e.g. video clips)
- **More user-friendly digital services under consideration:**
 - Downloading citations from a web-based platform, incl. videos cited
- **Legal change: Amendment of Rule 65 EPC to be ready for future digital developments**
 - Documents cited will be ‘made available’ instead of ‘transmitted’
- **Entry into force: 01.11.2022**

Notification and time limit calculation (1)

Rules 126, 127 and 131 EPC: The current ten-day fiction and time-time limit calculation rules

- Ten-day rule reflects notification by post (also in place for instantaneous electronic notification)
- Electronic notification has become a common and reliable notification method

[GL E-II, 2](#)
[GL E-VIII, 1](#)

Notification and time limit calculation (2)

- **Legal changes:** Amendments to Rules 126, 127 and 131 EPC to adapt the current legal framework to the today's reality and bring the EPC and PCT regimes closer
 - Ten-day fiction for postal and electronic notifications abandoned
 - Introduction of a new fiction under which a document is deemed notified on the date it bears (known from the PCT)
 - Time-limit calculation from new notification fiction (date of document)
 - Burden of proof on the part of the EPO in case of notification disputes
 - Dedicated safeguard if a document is received particularly late (known from the PCT)
- Postal notification continues to be available; both notification methods remain aligned

[Rule 80.6 PCT](#)

Notification and time limit calculation (3)

- **Safeguard:**

If the Office cannot show that a document has reached the addressee **within seven days of the date it bears**, the period for which the deemed receipt of that document is the relevant event for the purposes of time-limit calculation would be **extended by the number of days by which these seven days are exceeded**

- Postal notification continues to be available; both notification methods remain aligned
- Extension of periods under Rule 134 EPC applicable
- Indication of the final date for replying to an Office's action included in the new User Area;
- Indication of the final date for paying fee(s) with respect to European patent applications in the Central Fee Payment
- **Entry into force:** 01.02.2023

<https://www.epo.org/applying/online-services/improving/user-area-services.html>

[OJ EPO 2021, A64, A65](#)

Notification and time-limit calculation – Examples

Date of the communication = 1.04.2022
Delivery of the communication = 5.04.2022
Expiry of the 4-month period = **1.08.2022**

Date of the communication = 1.04.2022
Delivery of the communication = 12.04.2022
Expiry of the period = 1.08.2022
Safeguard = period extended to 5.08.2022

***Communication under
Art. 94(3) sent with 4-
month period***

Date of the communication = 1.07.2022
Delivery of the communication = 6.07.2022
Expiry of the 4-month period = 1.11.2022
Extension R. 134(1) = 2.11.2022

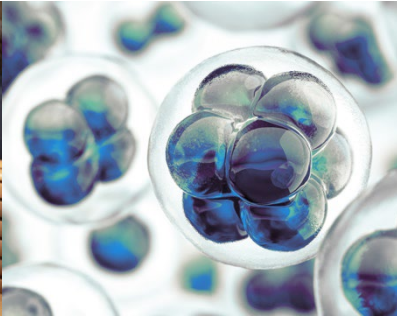
Date of the communication = 1.04.2022
Expiry of the period = 1.08.2022
Not delivered = **new notification**



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Guidelines2day 2022

Central Fee Payment



Anna Maria Bach Pedrocchi

Head of Department | Revenue Controls, Treasury and Accounting

26 April 2022

Single centralised payment service – goals



Starting situation

Multiple services to pay fees:

- Bank transfer
- Credit card via the Credit card and refund claim service on EPO website
- Deposit account - submission of debit order via Online Filing/CMS/Online Fee Payment

Single centralised payment service – goals



Target situation

Single centralised payment service using SAP e-commerce:

- All payment methods included
- Replacing existing services:
 - with improved functionalities
 - directly accessible via EPO website
 - accessible through the future filing services to file and pay in one go

Main new and improved functionalities of CFP



Apr 2022

release: [OJ 2022, A25](#)

Last release Central
Fee Payment
Service:

→ Sep 2022

→ Online Fee
Payment and
Multipay tool
decommission

New: Bank payment functionality

- One single reference for multiple fees/applications needed
- Downloadable payment confirmation available at CFP upon receipt of funds at EPO

New: Group of fees “Fees due”

- Display for a given application fees due and time limits
- Basis: data on file

New: Full transaction overview for all payment methods (Provided log-in is made with smartcard)

Improvements:

- New filtering options
- Self-service for accounts statements,
- CSV as additional upload and download formats
- Patent application link to the European Patent Register

Additional planned improvements (Sep 2022):

- Immediate booking of debit orders if funds available
- Revocation of deferred debit orders possible until effectively booked

**Increased
efficiency
and user
friendliness**

Questions



Now

via Q&A

Later

via e-mail to patentlaw@epo.org or finance@epo.org