

# Learning path for patent administrators

## The European patent granting procedure: EPAC - entry level

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## Introduction

This publication, "The European patent granting procedure, EPAC - entry level", is part of the "Learning path for patent administrators" series is edited and published by the European Patent Academy. The series is intended for patent administrators who are taking part in training and certifications organised by the European Patent Office (EPO). It is also freely available to the public for independent learning.

Topics covered include: general aspects of the patent system; the European patent system and the European patent granting procedure; the International Patent System (PCT) and the PCT procedure; European and international publications; filing a European patent application and filing an international application; the formalities during the European and during the international search; the formalities during the European examination and during the international preliminary examination; the formalities during the appeal procedure after refusal (EPC), during the opposition procedure (EPC); national validation (EPC); entry into national/regional phases and entry into the European phase (PCT).

Each chapter focuses on one topic at entry, intermediate or advanced level, as appropriate. The series will be revised annually to ensure it remains up to date.

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## 1. Learning objectives

Participants in this course will learn:

- the timeline for a European patent application
- the outline of the European patent granting procedure
- about the role of the formalities officer and the interaction with the representative
- the definition of EPC time limits
- which are the different means of redress
- about payment methods and effective payment dates

## 2. Timeline for a European patent application: EP direct

In principle, a patent expires after 20 years. However, supplementary protection certificates (SPCs) can be requested for specific pharmaceutical and plant protection products with a view to extending the patent right for a maximum of 5 years (and 6 months for medicinal products for children). The extension aims at compensating time lost for additional clinical trials and testing.

The principal timelines for a European patent application are listed below.

- priority claim ([Art. 87 EPC](#); [Art. 88 EPC](#)): a second filing should occur at the latest 12 months after filing of the priority application
- designation of inventor ([R. 60 EPC](#)): 16-month time limit
- publication ([Art. 93 EPC](#)): 18 months
- term of patent ([Art. 63\(1\) EPC](#)): 20 years
- renewal fees ([Art. 86\(1\) EPC](#)): first fee due in the third year = end of 24-month period
- prior art doc. [Art. 54\(3\) EPC](#)

For substantive examination, different time limits are in place:

- request for examination to be made in principle within 6 months of the publication of the search report or 6 months after notification of communication ([R. 70\(1\) EPC](#); [R. 161 EPC](#))
- reply to communication pursuant to [R. 71\(3\) EPC](#): 4 months
- reply to communication pursuant to [Art. 94\(3\) EPC](#): 4 months, extendable

Further details of the different steps during the life of a European patent application:

- search reports: search reports to be delivered within 6 months of receipt
- examination period: examination times to be reduced to just 12 months on average
- opposition period: oppositions to be completed in 15 months on average, while ensuring the parties are heard

### Legal references:

[Art. 54\(2\)](#), [\(3\)](#), [63\(1\)](#), [87\(1\)](#), [88](#), [89](#), [93 EPC](#)

[Rule 40](#), [60 EPC](#)

[GL A-III, 6](#); [GL F-VI](#)

## 3. Outline of the European patent granting procedure

[Article 15 EPC](#) governs the departments entrusted with each procedure. In order to carry out the procedures laid down in the EPC, the European Patent Office has set up a Receiving Section, search divisions, examining divisions, opposition divisions, a Legal Division, boards of appeal and an

Enlarged Board of Appeal. All these departments are entrusted with their functions under [Article 15 EPC](#).

A patent application is published 18 months after the date of filing or the earliest priority date. Publication informs the public of the application, provides provisional protection and enables third parties to submit observations.

Any granted patents are published after the examination procedure and are known as B publications. Publication of the patent informs the public of the exclusive rights that have been granted and triggers the 9-month period during which an opposition may be filed.

**Legal references:**

[Art. 15, 16-22, 143 EPC](#)

[Rule 8-13 EPC](#)

## 4. The role of formalities officers

Regarding the allocation of duties to the departments of first instance, [Rule 11\(3\) EPC](#) states that "The President of the European Patent Office may entrust to employees who are not technically or legally qualified examiners the execution of duties falling to the Search, Examining or Opposition Divisions and involving no technical or legal difficulties."

The formalities staff of the EPO, whether they be in The Hague, Munich or Berlin, are directed primarily to the Receiving Section, which is specifically responsible under the EPC for ensuring that the formal requirements for European patent applications are adhered to. Their main role is to be responsible for communicating between the applicant and the EPO.

Following receipt at the EPO, the so-called "intake" process involves receiving the application (physically or electronically), sorting the documents received, registering and acknowledging receipt of the application, preparing and converting data for uploading into the EPO legacy systems (for applications filed on paper, all documents are scanned and added to the electronic file for further treatment) and finally generating an electronic file. The previously mentioned process steps are the same regardless of whether the application was filed electronically or in paper form.

There are many starting points in the procedure, which means different interactions between the representative and/or the patent paralegal during different stages of the patent process. These include applications, amendments, further processing, clarification, etc.

**Legal references:**

[Art. 90 EPC](#)

[Rule 35\(2\), \(4\), 40\(1\)\(a\), \(b\) EPC](#)

## 5. EPC time limits

The EPC provides for 3 types of time limit:

- time limits computed from the actual or deemed date of filing or the date of priority
- time limits computed from an event other than the date of filing or priority
- time limits laid down by the EPO (and not by the EPC or the PCT)

A time limit is deemed to have been observed if a document that was received late was posted or delivered to a delivery service recognised by the President of the EPO (Chronopost, DHL, FedEx, Flexpress, TNT Express, SkyNet or UPS) at least 5 calendar days before the relevant period expired.

As already mentioned, some time limits are provided by the EPC or the PCT, not by the EPO itself. Some examples of these time limits are:

- filing of the application → within 12 months from the (earliest) priority date
- filing of the designation of inventor → within 16 months of the date of filing/priority or up to completion of technical preparations for publication
- filing of (all) priority document(s) → 16 months from the earliest priority date or 2 months from the invitation (divisional application)
- filing of the translation of the application → 2 months from the date of filing or from the invitation

### Examples

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### Legal references:

Art. 87, 88, 90, 120-122 EPC

Rule 53, 131-136 EPC

GL E-VIII

## 6. EPC remedies: extension of period, request for a decision, further processing

A time limit set by the EPO may also be extended, provided that a request for extension is submitted before that period expires.

Should a time limit be missed, legal sanctions are applied. These legal sanctions are the refusal of an application, the application being deemed to be withdrawn or a loss of rights (total or partial).

Rule 134(5) can be invoked by applicants/representatives when they are affected by exceptional circumstances beyond their control and are therefore unable to comply with the established time limit. It applies to late filing of documents and/or late payment of fees. Currently, sufficient explanation of how the party was prevented from complying with the time limit is needed, provided the mailing/transmission/payment took place within five days of the end of the dislocation or the exceptional circumstances.

Should the applicant affected by the loss of rights consider that the finding of the EPO is inaccurate, they may apply for a decision on the matter. This request must be made in writing within two months from notification of the loss of rights and include evidence of the inaccuracy. The request for a decision is free of charge. After careful consideration of the applicant's request, two possible scenarios are foreseen.

- The EPO informs the applicant that the loss of rights communication is set aside (positive result).

- The EPO issues a decision which can be appealed (negative result).

After expiry of a non-observed time limit, a request for further processing can be made (should this remedy be available for this particular loss of rights) according to [Art. 121 EPC](#) and [Rule 135 EPC](#). This request for further processing must be made within two months from notification of the communication of loss of rights. Together with the request, the omitted act (payment of a fee or filing of a document) must be completed and the fee paid for the request for further processing (depending on the particular omitted act).

**Legal references:**

[Art. 121, 122 EPC](#)

[Rule 112, 134\(5\)-136 EPC](#)

[GL E-VIII, 1.9.3](#)

## **7. EPC remedies: re-establishment of rights, appeal**

If the request for re-establishment of rights is granted, the applicant will be informed accordingly in writing and the legal consequences of the failure to observe the time limit are deemed not to have ensued.

If the request for re-establishment of rights is not granted, the applicant will be informed accordingly in writing pursuant to [Article 113 EPC](#) with an opportunity to reply. If no reply is received or if the reply does not remediate the EPO's finding, an appealable decision is issued.

An appeal may be filed against decisions taken by the Receiving Section, the examining divisions, the opposition divisions and the Legal Division according to [Art. 106\(1\) EPC](#). In order to file an appeal, a notice of appeal must be filed in writing (either on paper or electronically) together with the payment of the appeal fee (fee code 011). Both the notice and the appeal fee must be received within two months of notification of the decision. Within four months of notification of the decision, the grounds of appeal must be filed containing reasoned arguments (the content of the grounds must be substantiated under [Rule 99 EPC](#)). The time limit for filing an appeal against a decision cannot be extended.

### **Examples**

- Refusal of an application by the examining division pursuant to [Art. 97\(2\) EPC](#).

**Legal references:**

[Art. 90\(5\), 97\(1\), \(2\), 106\(1\), 112\(2\), 122 EPC](#)

[Rule 14/142, 136 EPC](#)

## **8. EPC fees**

EPC fees are governed by the [Rules relating to Fees](#) (RFees) and the Arrangements for deposit accounts (ADA). The latest updates on the schedule of fees and expenses can be found in the Official Journal of the EPO and on the EPO website.

Payment of a fee can be made by direct payment or transfer to a bank account held by the EPO in Germany according to Art. 5(1) RFees and as mentioned in the Notice of the EPO, OJ EPO 2017, A100.

Debit of a deposit account held with the EPO according to Art. 5(2) and 7(2) RFees is also possible when paying a fee. Arrangements for deposit accounts and their annexes are to be found in Supplementary publication 5, OJ EPO 2017).

As regards the fees and their payment, some changes have been introduced as from 1.4.2019 following the decision of the President, OJ EPO 2/2019.

**Legal references:**

Art. 5 and 7 RFees



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European Patent Office  
Munich  
Germany  
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Responsible for the content  
European Patent Academy  
[academy@epo.org](mailto:academy@epo.org)