Revision of the European Patent Convention (EPC 2000)
Synoptic presentation EPC 1973/2000 –
Part II: The Implementing Regulations
Edition spéciale 5 ı 2007
Convention sur le brevet européen révisé (CBE 2000)
Présentation synoptique CBE 1973/2000 –
Partie II : Règlement d’exécution
Foreword

The revision of the Articles of the EPC by the Conference of the Contracting States held in November 2000 entailed a complete overhaul of the EPC Implementing Regulations. This overhaul has been carried out in two stages:

- In the wake of the November 2000 Conference, new Implementing Regulations to the EPC 2000 were adopted by the Administrative Council on 12.12.2002*
  * See Special edition n° 1 of the OJ EPO 2003, pages 74-158

- Considering that amendments of the Implementing Regulations to the EPC 2000 were necessary and useful in the light of more recent developments, the Administrative Council amended the Implementing Regulations to the EPC 2000 on 7.12.2006**
  ** See Special edition n° 1 of the OJ EPO 2007, pages 103-195

This latter version of the Implementing Regulations is the one which enters into force together with the EPC 2000, on 13.12.2007.

The present publication compares the Implementing Regulations to the EPC 1973 with the Implementing Regulations to the EPC 2000, giving an overview of the extent of the changes.

In addition, consolidated explanatory remarks have been included. They are based on the following documents which date from the years 2002 and 2006 respectively:

- CA/PL 5/02 Rev. 1 Add. 1; CA/PL PV 19
- CA/PL 11/06, CA/PL 17/06, CA/PL 29/06 Add. 1; CA/PL PV 29, CA/PL PV 30, CA/PL PV 31


The two-stage revision process of the Rules (2002 and 2006) has of necessity entailed some redundancy in the explanatory remarks. For the present purpose, the explanatory remarks have been shortened and cautiously updated, especially in the instances where changes made in 2002 were undone or otherwise adapted in 2006.

The present document is intended for study purposes only and does not form part of the Travaux préparatoires to the EPC 2000
Guidance for the reader

In the synoptic comparison between the Rules of the EPC 1973 and the Rules of the EPC 2000, the font features **bold** and [...] have been used in the right-hand column to indicate changes as compared to the Rules of the EPC 1973.

Example

<table>
<thead>
<tr>
<th>Rule 6</th>
<th>[...] Filing of translations and reduction of fees</th>
</tr>
</thead>
<tbody>
<tr>
<td>Rule 6 EPC 1973</td>
<td>Rule 6 EPC 2000</td>
</tr>
<tr>
<td>(1) The translation referred to in Article 14, paragraph 2, must be filed within three months after the filing of the European patent application, but no later than thirteen months after the date of priority.</td>
<td>(1) A translation <strong>under</strong> Article 14, paragraph 2, <strong>shall</strong> be filed within two months of [...] filing [...] the European patent application [...].</td>
</tr>
<tr>
<td>(2) The translation referred to in Article 14, paragraph 4, must be filed within one month of the filing of the document. Where the document is a notice of opposition or an appeal, this period shall be extended where appropriate to the end of the opposition period or appeal period.</td>
<td>(2) A translation <strong>under</strong> Article 14, paragraph 4, <strong>shall</strong> be filed within one month of [...] filing [...] the document. <strong>This shall also apply to requests under Article 105a.</strong> Where the document is a notice of opposition or [...] appeal, or a statement of grounds of appeal, or a petition for review, the translation may be filed within the period for filing such a notice or statement or petition, if that period expires later.</td>
</tr>
</tbody>
</table>

Abbreviations and references

**EPC 1973** refers to the Articles of the EPC and the Implementing Regulations in force until the entry into force of the EPC 2000, that is
- the Implementing regulations to the European Patent Convention of 5 October 1973, as last amended by Decision of the Administrative Council of 9 December 2004

**EPC 2000** refers to
- the Articles of the EPC 2000 adopted by the Diplomatic Conference by the Revision Act of 29 November 2000*, in the text drawn up by the Administrative Council by Decision of 28 June 2001**
- the Implementing Regulations to the EPC 2000 as amended by Decision of the Administrative Council of 7 December 2006***
  * see Special edition n° 4 of the OJ EPO 2001, pages 3-51
  ** see Special edition n° 4 of the OJ EPO 2001, pages 54-133
  *** see Special edition n° 1 of the OJ EPO 2007, pages 103-195

**Transitional provisions** were adopted by Decision of the Administrative Council of 28 June 2001*

* see Special edition n° 1 of the OJ EPO 2007, pages 196-198

Synoptic presentation
of the Implementing Regulations to the EPC 1973 and the Implementing Regulations
to the EPC 2000,
including explanatory remarks

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PART I

CHAPTER I

RULE 1

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1)

New Rule 1 EPC 2000 has been inserted to adapt the Implementing Regulations to the possibility of electronic filing. It specifies what documents fulfil the requirement to use the written form.


Discussion on the implications of the proposal to use the terms "on paper or on screen" (in particular as regards three dimensional pictures) in Rule 1 EPC 2000.

RULE 2 EPC

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1)

New Rule 2 EPC 2000 gives the option of electronic filing an explicit place in the Implementing Regulations.

Under Rule 2(1), second sentence, EPC 2000, the President of the EPO is responsible for deciding through what route and in what form, and in particular by what technical means, documents may be filed which fulfil the requirement to use the written form.

Rule 2(2) EPC 2000 deals with the signature of documents.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the filing of patent applications and other documents by facsimile, Special edition No. 3, OJ EPO 2007, 7, A.3

Decision dated 12 July 2007 concerning the electronic filing of patent applications and other documents, Special edition No. 3, OJ EPO 2007, 12, A.4

Decision dated 12 July 2007 concerning the electronic signatures, data carriers and software to be used for the electronic filing of patent applications and other documents, Special edition No. 3, OJ EPO 2007, 17, A.5
## Part I  Implementing Regulation to Part I of the Convention

### Chapter I  General provisions

#### Rule 1  Written proceedings

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 1 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>In written proceedings before the European Patent Office, the requirement to use the written form shall be satisfied if the content of the documents can be reproduced in a legible form on paper.</td>
</tr>
</tbody>
</table>

#### Rule 2  Filing of and formal requirements for documents

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 2 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>(1) In proceedings before the European Patent Office, documents may be filed by delivery by hand, by post or by technical means of communication. The President of the European Patent Office shall lay down the details and conditions and, where appropriate, any special formal or technical requirements for the filing of documents. In particular, he may specify that confirmation must be supplied. If such confirmation is not supplied in due time, the European patent application shall be refused; documents filed subsequently shall be deemed not to have been received.</td>
</tr>
</tbody>
</table>

(2) Where the Convention provides that a document must be signed, the authenticity of the document may be confirmed by handwritten signature or other appropriate means the use of which has been permitted by the President of the European Patent Office. A document authenticated by such other means shall be deemed to meet the legal requirements of signature in the same way as a document bearing a handwritten signature which has been filed in paper form.
RULE 3 EPC 2000

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; discussion in the Patent Law Committee: CA/PL PV 19, point 8)

Rule 1 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 3 EPC 2000.

The EPO shall specify in the individual case the "period to be specified" referred to in Rule 3(3), second sentence, EPC 2000 (new Rule 132(2) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).

(See also Explanatory remarks 2006: CA/PL 17/06; discussion in the Patent Law Committee 2006: CA/PL PV 30, points 74-79, and CA/PL PV 31, points 5-9)

Discussion on the terms "Documentary evidence" in Rule 3(3) EPC 2000 and "Documents" in Rule 1(3) EPC 1973: the term "documents" is used in Rule 1 EPC 2000, and this use is consistent throughout the EPC.
### Rule 3  Language in written proceedings

<table>
<thead>
<tr>
<th>Rule 1 EPC 1973</th>
<th>Rule 3 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) In written proceedings before the European Patent Office any party may use</td>
<td>(1) In written proceedings before the European Patent Office, any party may use</td>
</tr>
<tr>
<td>to in Article 14, paragraph 4, may be filed in any official language of the</td>
<td>to in Article 14, paragraph 4, may be filed in any official language of the</td>
</tr>
<tr>
<td>(2) Amendments to a European patent application or European patent must be</td>
<td>(2) Amendments to a European patent application or European patent shall be</td>
</tr>
<tr>
<td>filed in the language of the proceedings.</td>
<td>filed in the language of the proceedings.</td>
</tr>
<tr>
<td>(3) Documents to be used for purposes of evidence before the European Patent</td>
<td>(3) Documentary [...] evidence [...] and, in particular, publications may be</td>
</tr>
<tr>
<td>Office, and particularly publications, may be filed in any language. The</td>
<td>filed in any language. The European Patent Office may, however, require that</td>
</tr>
<tr>
<td>European Patent Office may, however, require that a translation be filed,</td>
<td>a translation in one of its official languages be filed, within a period to be</td>
</tr>
<tr>
<td>within a given time limit of not less than one month, in one of its official</td>
<td>specified [...]. If a required translation is not filed in due time, the</td>
</tr>
<tr>
<td>languages.</td>
<td>European Patent Office may disregard the document in question.</td>
</tr>
</tbody>
</table>
RULE 4 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1, CA/PL PV 19, point 19)

Rule 2 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 4 EPC 2000.
## Rule 4 Language in oral proceedings

### Rule 2 EPC 1973

(1) Any party to oral proceedings before the European Patent Office may, in lieu of the language of the proceedings, use one of the other official languages of the European Patent Office, on condition either that such party gives notice to the European Patent Office at least one month before the date laid down for such oral proceedings or makes provision for interpreting into the language of the proceedings. Any party may likewise use one of the official languages of the Contracting States, on condition that he makes provision for interpretation into the language of the proceedings. The European Patent Office may permit derogations from the provisions of this paragraph.

(2) In the course of oral proceedings, the employees of the European Patent Office may, in lieu of the language of the proceedings, use one of the other official languages of the European Patent Office.

(3) In the case of taking of evidence, any party to be heard, witness or expert who is unable to express himself adequately in one of the official languages of the European Patent Office or the Contracting States may use another language. Should the taking of evidence be decided upon following a request by a party to the proceedings, parties to be heard, witnesses or experts who express themselves in languages other than the official languages of the European Patent Office may be heard only if the party who made the request makes provision for interpretation into the language of the proceedings; the European Patent Office may, however, authorise interpretation into one of its other official languages.

(4) If the parties and the European Patent Office agree, any language may be used in oral proceedings.

(5) The European Patent Office shall, if necessary, make provision at its own expense for interpretation into the language of the proceedings, or, where appropriate, into its other official languages, unless this interpretation is the responsibility of one of the parties to the proceedings.

### Rule 4 EPC 2000

(1) Any party to oral proceedings before the European Patent Office may [...] use an official language of the European Patent Office other than the language of the proceedings, if such party gives notice to the European Patent Office at least one month before the date of such oral proceedings or provides for interpretation into the language of the proceedings. Any party may use an official language of a Contracting State, if he provides for interpretation into the language of the proceedings. The European Patent Office may permit derogations from these provisions.

(2) In the course of oral proceedings, employees of the European Patent Office may [...] use an official language of the European Patent Office other than the language of the proceedings.

(3) Where evidence is taken, any party, witness or expert to be heard who is unable to express himself adequately in an official language of the European Patent Office or of a Contracting State may use another language. Where evidence is taken [...] upon request of a party, parties, witnesses or experts [...] expressing themselves in a language other than an official language of the European Patent Office shall be heard only if [...] that party [...] provides for interpretation into the language of the proceedings. The European Patent Office may, however, permit interpretation into one of its other official languages.

(4) If the parties and the European Patent Office agree, any language may be used in oral proceedings.

(5) The European Patent Office shall, if necessary, provide at its own expense interpretation into the language of the proceedings, or, where appropriate, into its other official languages, unless such interpretation is the responsibility of one of the parties.
Rule 4 EPC 1973 "Language of a European divisional application" has been deleted
– its substance has been moved to Rule 36(2) EPC 2000.
Rule 4  **Language in oral proceedings**

(6) Statements by employees of the European Patent Office, by parties to the proceedings and by witnesses and experts, made in one of the official languages of the European Patent Office during oral proceedings shall be entered in the minutes in the language employed. Statements made in any other language shall be entered in the official language into which they are translated. Amendments to the text of the description or claims of a European patent application or European patent shall be entered in the minutes in the language of the proceedings.
RULE 5 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 5 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.

The EPO shall specify in the individual case the "period to be specified" referred to in Rule 5 EPC 2000 (new Rule 132(2) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).

The expression "unless otherwise provided" means unless otherwise provided in the Convention or in the Implementing Regulations.

RULE 6 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1, CA/PL PV 19, point 10)

Rule 6 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.

Under Article 6(3) of the Patent Law Treaty of 1 June 2000 (PLT), the EPO may require a translation if the application is not filed in one of the official languages of the EPO. The PLT does not set a time limit for filing the translation, but provides that the applicant must be notified if no translation is filed, giving him the opportunity to supply the translation within a period of at least two months from the date of notification (Article 6(7) PLT in conjunction with Rule 6(1) PLT). Such notification is provided for in Rule 58 EPC 2000. This, together with the two month period specified in Rule 6(1) EPC 2000, means that the applicant will always have a minimum of four months, from the date of filing the application, to file the translation.

(Explanatory remarks 2006: CA/PL 29/06 Add.1, CA/PL PV 30, points 80-81)

The period for filing the translation in Rule 6(1) EPC 2000 has been reduced to two months. As in the case of Rule 40(3) EPC 2000 (filing of certified copy or translation of previously filed application), the applicant thus has at least four months, including the period under Rule 58 EPC 2000, to file the translation.

Rule 6(2), second sentence, EPC 2000 provides that a request for revocation or limitation under Article 105a EPC which is filed in an admissible non-EPO language – and which is not itself subject to any time limit – must also be translated into an official language of the EPO within one month.

Rule 6(2), third sentence, EPC 2000 also refers to petitions for review under Article 112a EPC.

Rule 6(3) EPC 2000 provides that the fee reductions also apply to requests for limitation or revocation under Article 105a EPC and to petitions for review under Article 112a EPC.
### Rule 5 Certification of translations

<table>
<thead>
<tr>
<th>Rule 5 EPC 1973</th>
<th>Rule 5 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>When a translation of any document must be filed, the European Patent Office may require the filing of a certificate that the translation corresponds to the original text within a period to be determined by it. Failure to file the certificate in due time shall lead to the document being deemed not to have been received unless the Convention provides otherwise.</td>
<td>Where the translation of a document is required, the European Patent Office may require [...] that a certificate that the translation corresponds to the original text be filed within a period to be specified. If the certificate is not filed in due time, such document shall be deemed not to have been filed, unless [...] otherwise provided.</td>
</tr>
</tbody>
</table>

### Rule 6 Filing of translations and reduction of fees

<table>
<thead>
<tr>
<th>Rule 6 EPC 1973</th>
<th>Rule 6 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) The translation referred to in Article 14, paragraph 2, must be filed within three months after the filing of the European patent application, but no later than thirteen months after the date of priority. Nevertheless, if the translation concerns a European divisional application or a new European patent application under Article 61, paragraph 1(b), the translation may be filed at any time within one month of the filing of such application.</td>
<td>(1) A translation under Article 14, paragraph 2, shall be filed within two months of [...] filing [...] the European patent application [...]</td>
</tr>
</tbody>
</table>
RULE 7 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 7 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.
<table>
<thead>
<tr>
<th>Rule 7</th>
<th>Legal authenticity of the translation of the European patent application</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>Rule 7 EPC 1973</th>
<th>Rule 7 EPC 2000</th>
</tr>
</thead>
</table>

Saving proof to the contrary, the European Patent Office may, for the purposes of determining whether the subject-matter of the European patent application or European patent extends beyond the content of the European patent application as filed, assume that the translation referred to in Article 14, paragraph 2, is in conformity with the original text of the application.

Unless evidence is provided to the contrary, the European Patent Office shall assume, for the purpose of determining whether the subject-matter of the European patent application or European patent extends beyond the content of the [...] application as filed, that the translation filed under Article 14, paragraph 2, or Rule 40, paragraph 3, is in conformity with the original text of the application.
CHAPTER II

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The provisions in Chapter II of Part I of the Implementing Regulations mainly concern the organisation of the EPO. To reflect the distinction between the departments of first and second instance, Chapter II is divided into two sections:

Section 1 deals with "General matters" (Rules 8, 9, 10 and 11 EPC 2000)
Section 2 deals with the "Organisation of the Boards of Appeal and the Enlarged Board of Appeal" (Rules 12 and 13 EPC 2000).

SECTION 1

RULE 8 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The European Convention on the International Classification of Patents for Invention of 19 December 1954, referred to in Rule 8 EPC 1973, has never been applied at the EPO, as the Strasbourg Agreement entered into force on 7 October 1975, before the setting-up of the EPO on 1 November 1977. This reference can therefore be deleted.

RULE 9 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

New Rule 9 EPC 2000 incorporates parts of the content of Rule 12(2) and (3) EPC 1973. These provisions apply to the EPO as a whole and are therefore included in Section 1 which deals with "General matters".

The key provision of Rule 12(1) EPC 1973 – that the number of directorates in which the Examining Divisions and Opposition Divisions are grouped together is to be decided by the President – is already implied by the President's general power of decision. This part of Rule 12 EPC 1973 has therefore been deleted. The administrative grouping of Examining and Opposition Divisions is addressed in modified form in new Rule 9(1) EPC 2000.

In Rule 9(1) EPC 2000, the list of departments in proceedings before the EPO has been replaced by a general reference to Article 15 EPC 2000.

The deletion of Rule 12(2), second sentence, EPC 1973 takes account of Articles 16 and 17 EPC 2000.
### Chapter II  Organisation of the European Patent Office

### Section 1  General matters

#### Rule 8  Patent classification

<table>
<thead>
<tr>
<th>Rule 8 EPC 1973</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) The European Patent Office shall use:</td>
</tr>
<tr>
<td>(a) the classification referred to in Article 1 of the European Convention on the International Classification of Patents for Invention of 19 December 1954 until the entry into force of the Strasbourg Agreement concerning the International Patent Classification of 24 March 1971;</td>
</tr>
<tr>
<td>(b) the classification referred to in Article 1 of the aforementioned Strasbourg Agreement, after the entry into force of that Agreement.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Rule 8 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The European Patent Office shall use [...] the classification referred to in Article 1 of the [...] Strasbourg Agreement concerning the International Patent Classification of 24 March 1971 [...], hereinafter referred to as the international classification.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Rule 9  Administrative structure of the European Patent Office</th>
</tr>
</thead>
</table>

#### Rule 12 EPC 1973

<table>
<thead>
<tr>
<th>Rule 12 EPC 2000</th>
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<tbody>
<tr>
<td>Deleted</td>
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</table>

<table>
<thead>
<tr>
<th>Rule 9 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) The European Patent Office shall be divided administratively into Directorates-General, to which the departments specified in Article 15, and the services set up to deal with legal matters and the internal administration of the Office, shall be assigned. [...]</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Rule 9 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(2) Each Directorate-General shall be directed by a Vice-President. The appointment of a Vice-President to a Directorate-General shall be decided upon by the Administrative Council, after the President of the European Patent Office has been consulted.</td>
</tr>
</tbody>
</table>
RULE 10 EPC

(Explanatory remarks 2006: CA/PL 17/06)

New Rule 10 EPC 2000 delimits the period of the Receiving Section's responsibility for examination on filing and as to formal requirements and lays down the rules on the transition of responsibility to the Examining Divisions.

To avoid parallel responsibility, Rule 10(1) EPC 2000 provides that the Receiving Section ceases to be responsible when the Examining Division's responsibility begins.

Under Article 94(1) EPC 2000, the EPO examines, on request and in accordance with the Implementing Regulations, whether the European patent application and the invention to which it relates meet the requirements of the EPC. The request is not deemed to have been filed until the examination fee has been paid. Therefore, under Rule 10(2) EPC 2000, the Examining Division becomes responsible, subject to Rule 10(3) and (4) EPC 2000, once a request for examination has been filed.

In the event that the request for examination is filed before the applicant has received the European search report, Rule 10(3) EPC 2000 provides that the Examining Division is not responsible until the indication under Rule 70(2) EPC 2000 has been received.

Rule 10(4) EPC 2000 is a separate provision governing cases in which the applicant has waived the right under Rule 70(2) EPC 2000. In such cases, the transition of competence is instantaneous, so that in fact the first communication from the Examining Division can be sent together with or within the same day as the search report. The new responsibility provisions are thus entirely consistent with existing practice.
Rule 10  Responsibility of the Receiving Section and the Examining Division

EPC 1973

The EPC 1973 did not contain an equivalent provision.

Rule 10 EPC 2000

(1) The Receiving Section shall be responsible for the examination on filing and the examination as to formal requirements of a European patent application up to the time when the Examining Division becomes responsible for the examination of the European patent application under Article 94, paragraph 1.

(2) Subject to paragraphs 3 and 4, the Examining Division shall be responsible for the examination of a European patent application under Article 94, paragraph 1, from the time when a request for examination is filed.

(3) If a request for examination is filed before the European search report has been transmitted to the applicant, the Examining Division shall, subject to paragraph 4, be responsible from the time when the European Patent Office receives the indication under Rule 70, paragraph 2.

(4) If a request for examination is filed before the European search report has been transmitted to the applicant, and if the applicant has waived the right under Rule 70, paragraph 2, the Examining Division shall be responsible from the time when the search report is transmitted to the applicant.
RULE 11 EPC

(Explanatory remarks 2002: CA/P L 5/02 Rev. 1 Add. 1)

New Rule 11(1) EPC 2000 reflects the administrative grouping into directorates of the departments involved in the grant procedure – i.e., the Search Divisions, Examining Divisions and Opposition Divisions, made up of technically qualified examiners.

The powers of the President laid down in Rule 9(2) and (3) EPC 1973 are retained in Rule 11(2) and (3) EPC 2000.

Rule 9(4) EPC 1973 is deleted. No registry of an Opposition Division has ever been set up. The tasks in question are performed by "employees" within the meaning of Rule 11(3) EPC 2000. The President's general power of decision already enables him to entrust the fixing of costs to formalities officers with specialist knowledge.

(Explanatory remarks 2006: CA/P L 29/06 Add.1, CA/P L PV 30, point 85)

The Search Divisions are included in the list of departments in Rule 11(3) EPC 2000: the President may thus entrust the duties specified in Rule 11(3) EPC 2000 to employees who are not technically or legally qualified. This brings Rule 11(3) EPC 2000 into line with Rule 11(1) and (2) EPC 2000.

(In the Patent Law Committee 2006: CA/P L PV 31, point 4)

It has been long-standing practice to entrust to formalities officers the formal aspects of an application in the Search, Examining and Opposition Divisions. Rule 11(3) EPC 2000 simply gives a formal legal basis to this practice.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the responsibilities of the Legal Division, Special edition No. 3, OJ EPO 2007, 113, G.1

Decision dated 12 July 2007 concerning the entrustment to non-examining staff of certain duties normally the responsibility of the examining or opposition divisions, Special edition No. 3, OJ EPO 2007, 106, F.2
<table>
<thead>
<tr>
<th>Rule 11</th>
<th>Allocation of duties to the departments of [...] first instance</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 9 EPC 1973</strong></td>
<td><strong>Rule 11 EPC 2000</strong></td>
</tr>
<tr>
<td>(1) The President of the European Patent Office shall determine the number of Search Divisions, Examining Divisions and Opposition Divisions. He shall allocate duties to these departments by reference to the international classification and shall decide where necessary on the classification of a European patent application or a European patent in accordance with that classification.</td>
<td>(1) Technically qualified examiners acting as members of Search, Examining or Opposition Divisions shall be assigned to Directorates. The President of the European Patent Office shall allocate duties to these Directorates by reference to the international classification. [...]</td>
</tr>
<tr>
<td>(2) In addition to the responsibilities vested in them under the Convention, the President of the European Patent Office may allocate further duties to the Receiving Section, Search Divisions, Examining Divisions, Opposition Divisions and the Legal Division.</td>
<td>(2) [...] The President of the European Patent Office may allocate further duties to the Receiving Section, the Search [...], Examining [...] and Opposition Divisions, and the Legal Division, in addition to the responsibilities vested in them under the Convention.</td>
</tr>
<tr>
<td>(3) The President of the European Patent Office may entrust to employees who are not technically or legally qualified examiners the execution of individual duties falling to the Examining Divisions or Opposition Divisions and involving no technical or legal difficulties.</td>
<td>(3) 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.</td>
</tr>
<tr>
<td>(4) The President of the European Patent Office may grant exclusive responsibilities to one of the registries of the Opposition Divisions for fixing the amount of costs as provided for in Article 104, paragraph 2.</td>
<td><strong>Deleted</strong></td>
</tr>
</tbody>
</table>
SECTION 2

To reflect the distinction between the departments of first and second instance, a new Section 2 deals with the "Organisation of the Boards of Appeal and the Enlarged Board of Appeal" (Rules 12 and 13 EPC 2000).

RULE 12 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The reference to Article 134 EPC in Rule 12(6) EPC 2000 has been modified, in the light of the EPC 2000.

(Explanatory remarks 2006: CA/PL 17/06)

Regarding the period of "two working years" referred to in Rule 12(2) EPC 2000: When the new structure of the Presidium of the Boards of Appeal was introduced by an amendment of Rule 10 EPC in 2001, it was provided that the members of the Presidium were elected for one year. This was in line with the previous Rule 10 EPC as in force before 2001 which provided that the then three elected members of the Presidium be elected for one working year.

The period for which the members of the Presidium of the Boards of Appeal are elected has been extended to two working years. This is in the interest of efficiency and, by the same token, still guarantees that the voters' will is appropriately represented.

(In the Patent Law Committee 2006: CA/PL PV 30, points 86)

The time period set out in Rule 12(2) EPC 2000 does not affect the time periods set out in Rules 12(4) and 13(1) EPC 2000.
Section 2  Organisation of the Boards of Appeal and the Enlarged Board of Appeal

Rule 12  Presidium of the Boards of Appeal

Rule 10 EPC 1973

(1) The autonomous authority within the organisational unit comprising the Boards of Appeal (the "Presidium of the Boards of Appeal") shall consist of the Vice-President in charge of the Boards of Appeal, who shall act as chairman, and twelve members of the Boards of Appeal, six being Chairmen and six being other members.

(2) All members of the Presidium shall be elected by the Chairmen and members of the Boards of Appeal for one working year. If the full composition of the Presidium cannot be reached, the vacancies shall be filled by designating the most senior Chairmen and members.

(3) The Presidium shall adopt the Rules of Procedure of the Boards of Appeal and the Rules of Procedure for the election and designation of its members. The Presidium shall further advise the Vice-President in charge of the Boards of Appeal with regard to matters concerning the functioning of the Boards of Appeal in general.

(4) Before the beginning of each working year the Presidium, extended to include all Chairmen, shall allocate duties to the Boards of Appeal. In the same composition, it shall decide on conflicts regarding the allocation of duties between two or more Boards of Appeal. The extended Presidium shall designate the regular and alternate members of the various Boards of Appeal. Any member of a Board of Appeal may be designated as a member of more than one Board of Appeal. These measures may, where necessary, be amended during the course of the working year in question.

Rule 12 EPC 2000

(1) Unchanged

(2) All members of the Presidium shall be elected by the Chairmen and members of the Boards of Appeal for two working years. If the full composition of the Presidium cannot be reached, the vacancies shall be filled by designating the most senior Chairmen and members.

(3) Unchanged

(4) Unchanged
RULE 13 EPC

Rule 13 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

In Rule 13(1) and (2) EPC 2000, references to Article 11(3) EPC 2000 replace the references to Article 160 EPC 1973 which has been deleted.

In Rule 13(1) and (2) EPC 2000, the emphasis has been made positive instead of negative, as in Rule 11 EPC 1973.

(Explanatory remarks 2006: CA/PL 17/06; and discussion in the Patent Law Committee: CA/PL PV 30, point 87)

In view of the new procedure under Article 112a EPC, it may be that more members of the Enlarged Board of Appeal must regularly work on petitions for review. Thus, it appears appropriate to designate,
- on the one hand, regular and alternate members for proceedings under Article 22(1)(a) and (b) EPC, and,
- on the other hand, regular and alternate members of the Enlarged Board of Appeal for proceedings under Article 22(1)(c) EPC, i.e. for petitions for review.

Rule 13(1) EPC 2000 is clarified in this respect, by providing for specific designation of Enlarged Board of Appeal members for these two different types of proceedings.
### Rule 12  Presidium of the Boards of Appeal

(5) The Presidium may only take a decision if at least five of its members are present; these must include the Vice-President in charge of the Boards of Appeal or his deputy, and the Chairmen of two Boards of Appeal. Where the tasks mentioned in paragraph 4 are concerned, nine members must be present, including the Vice-President in charge of the Boards of Appeal or his deputy, and the Chairmen of three Boards of Appeal. Decisions shall be taken by a majority vote; in the event of parity of votes, the Chairman or his deputy shall have the casting vote. Abstentions shall not be considered as votes.

(6) The Administrative Council may allocate duties under Article 134, paragraph 8(c), to the Boards of Appeal.

(5) Unchanged

### Rule 13  Business distribution scheme for the Enlarged Board of Appeal and adoption of its Rules of Procedure

#### Rule 11 EPC 1973

(1) Before the beginning of each working year, the members of the Enlarged Board of Appeal who have not been appointed under Article 160, paragraph 2, shall designate the regular and alternate members of the Enlarged Board of Appeal.

(2) The members of the Enlarged Board of Appeal who have not been appointed under Article 160, paragraph 2, shall adopt the Rules of Procedure of the Enlarged Board of Appeal.

(3) Decisions on matters mentioned in paragraphs 1 and 2 may only be taken if at least five members are present, including the Chairman of the Enlarged Board of Appeal or his deputy; in the event of parity of votes, the Chairman or his deputy shall have the casting vote. Abstentions shall not be considered as votes.

#### Rule 13 EPC 2000

(1) Before the beginning of each working year, the members of the Enlarged Board of Appeal [...] appointed under Article 11, paragraph 3, shall designate the regular and alternate members of the Enlarged Board of Appeal in proceedings under Article 22, paragraph 1(a) and (b), and the regular and alternate members in proceedings under Article 22, paragraph 1(c).

(2) The members of the Enlarged Board of Appeal [...] appointed under Article 11, paragraph 3, shall adopt the Rules of Procedure of the Enlarged Board of Appeal.

(3) Unchanged
PART II

CHAPTER I

To make the structure of the Implementing Regulations clearer, the Rules concerning an applicant who is not entitled are separated from the provisions applying to a patent proprietor who is not entitled.

Accordingly, the substance of Rules 13(4) and 16(3) EPC 1973 has been moved to Part V of the Implementing Regulations, governing the opposition procedure, and inserted in new Rule 78 EPC 2000. The title of Chapter I of Part II of the Implementing Regulations is modified accordingly.

RULE 14 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; and discussion in the Patent Law Committee: CA/PL PV 19, point 9)

Rule 13 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 14 EPC 2000.

The substance of Rule 13(4) EPC 1973 was been moved to new Rule 78(2) EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the responsibilities of the Legal Division, Special edition No. 3, OJ EPO 2007, 113, G.1
PART II IMPLEMENTING REGULATIONS TO PART II OF THE CONVENTION

Chapter I Procedure where the applicant [...] is not entitled

Rule 14 Stay of proceedings

<table>
<thead>
<tr>
<th>Rule 13 EPC 1973</th>
<th>Rule 14 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) If a third party provides proof to the European Patent Office that he has opened proceedings against the applicant for the purpose of seeking a judgment that he is entitled to the grant of the European patent, the European Patent Office shall stay the proceedings for grant unless the third party consents to the continuation of such proceedings. Such consent must be communicated in writing to the European Patent Office; it shall be irrevocable. However, proceedings for grant may not be stayed before the publication of the European patent application.</td>
<td></td>
</tr>
<tr>
<td>(1) If a third party provides evidence [...] that he has instituted proceedings against the applicant [...] seeking a decision within the meaning of Article 61, paragraph 1, the [...] proceedings for grant shall be stayed unless the third party communicates to the European Patent Office in writing his consent [...] to the continuation of such proceedings. Such consent [...] shall be irrevocable. However, proceedings for grant shall not be stayed before the publication of the European patent application.</td>
<td></td>
</tr>
<tr>
<td>(2) Where proof is provided to the European Patent Office that a decision which has become final has been given in the proceedings concerning entitlement to the grant of the European patent, the European Patent Office shall communicate to the applicant and any other party that the proceedings for grant shall be resumed as from the date stated in the communication unless a new European patent application pursuant to Article 61, paragraph 1(b), has been filed for all the designated Contracting States. If the decision is in favour of the third party, the proceedings may only be resumed after a period of three months of that decision becoming final unless the third party requests the resumption of the proceedings for grant.</td>
<td></td>
</tr>
<tr>
<td>(2) Where evidence is provided [...] that a final decision within the meaning of Article 61, paragraph 1, has been taken, the European Patent Office shall inform the applicant and any other party that the proceedings for grant shall be resumed as from the date stated in the communication, unless a new European patent application under Article 61, paragraph 1(b), has been filed for all the designated Contracting States. If the decision is in favour of the third party, the proceedings may not be resumed earlier than three months after the decision has become final, unless the third party requests the resumption [...].</td>
<td></td>
</tr>
<tr>
<td>(3) When giving a decision on the suspension of proceedings or thereafter the European Patent Office may set a date on which it intends to continue the proceedings pending before it regardless of the stage reached in the proceedings referred to in paragraph 1 opened against the applicant. The date is to be communicated to the third party, the applicant and any other party. If no proof has been provided by that date that a decision which has become final has been given, the European Patent Office may continue proceedings.</td>
<td></td>
</tr>
<tr>
<td>(3) Upon staying the proceedings for grant, or thereafter, the European Patent Office may set a date on which it intends to resume the proceedings for grant, regardless of the stage reached in the national proceedings instituted under paragraph 1. It shall communicate this date [...] to the third party, the applicant and any other party. If no evidence has been provided by that date that a final decision [...] has been taken, the European Patent Office may resume proceedings.</td>
<td></td>
</tr>
<tr>
<td>(5) The time limits in force at the date of suspension other than time limits for payment of renewal fees shall be interrupted by such suspension. The time which has not yet elapsed shall begin to run as from the date on which proceedings are resumed; however, the time still to run after the resumption of the proceedings shall not be less than two months.</td>
<td></td>
</tr>
<tr>
<td>(4) All periods [...] other than those for the payment of renewal fees, running at the date of the stay of proceedings, shall be interrupted by such stay. The time which has not yet elapsed shall begin to run [...] from the date on which proceedings are resumed. However, the time still to run after such resumption [...] shall not be less than two months.</td>
<td></td>
</tr>
</tbody>
</table>
RULE 15 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The title of Rule 14 EPC 1973 has been amended. The former title was misleading, since it referred only to the withdrawal of the European patent application itself, whereas Rule 15 EPC 2000 also governs the withdrawal of a designation.

(In the Patent Law Committee 2002: CA/PL PV 19, point 12)

The reference to "proceedings concerning entitlement" is replaced by the more explicit "proceedings under Rule 14, paragraph 1".

RULE 16 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The requirements for a third party to invoke the remedies provided for in Article 61(1) EPC 1973 have been transferred to the Implementing Regulations and are now contained in new Rule 16 EPC 2000.
### Rule 15  Limitation [...] on withdrawals

**Rule 14 EPC 1973**

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

**Rule 15 EPC 2000**

 [...] From the date on which a third party provides evidence that he has instituted national proceedings under Rule 14, paragraph 1, and up to the date on which [...] the proceedings for grant are resumed, neither the European patent application nor the designation of any Contracting State may be withdrawn.

### Rule 16  Procedure under Article 61, paragraph 1

**EPC 1973**

[See Article 61(1) EPC 1973:
... that person may, within a period of three months after the decision has become final,

... provided that the European patent has not yet been granted,

... in respect of those Contracting States designated in the European patent application in which the decision has been taken or recognised, or has to be recognised on the basis of the Protocol on Recognition annexed to this Convention ...]

**Rule 16 EPC 2000**

(1) A person entitled to the grant of a European patent may only avail himself of the remedies under Article 61, paragraph 1, if:

(a) he does so no later than three months after the decision recognising his entitlement has become final, and

(b) the European patent has not yet been granted.

(2) Such remedies shall only apply in respect of Contracting States designated in the European patent application in which the decision has been taken or recognised or must be recognised on the basis of the Protocol on Recognition.
RULE 17 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 15 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 17 EPC 2000.

For clarity's sake, Rule 15(2) EPC 1973 has been subdivided into two paragraphs:
- Rule 17(2) EPC 2000 concerns the time period for payment of filing and search fees,
- Rule 17/3) EPC 2000 concerns the period for payment of designation fees.

In conformity with Article 51(3) EPC 2000, the legal consequences of failure to pay such fees in due time are also laid down in Rule 17(2) and (3) EPC 2000.

Rule 15(3) EPC 1973 has been deleted, as a new application under Article 61 EPC 2000 must always be filed directly with the EPO (see Articles 61(2) and 76(1) EPC 2000). There appears to be no need in the Contracting States to keep such applications secret after the conclusion of entitlement proceedings, since the earlier application has already been published by this date.

(In the Patent Law Committee 2002: CA/PL PV 19, points 13-15)

The inclusion in Rule 17(1) EPC 2000 of decisions to be recognised on the basis of the Protocol on Recognition serves to close a gap in the wording of Rule 15(1) EPC 1973.

Article 78(2) EPC 2000 lays down the legal consequence of non-payment of filing and search fees (deemed withdrawal). The further mention of this in Rule 17(2) EPC 2000 is merely to clarify that the consequence also applies in the case of a new application under Article 61(1)(b) EPC 2000.

The legal consequence of non-payment of the designation fees referred to in Rule 17(3) EPC 2000, on the other hand, is only dealt with in the Implementing Regulations (deemed withdrawal, see Rule 39(2) and (3) EPC 2000).

RULE 18 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 16 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 18 EPC 2000.

The inclusion in Rule 18(2) EPC 2000 of decisions which "must be recognised" on the basis of the Protocol on Recognition serves to close a gap in the wording of Rule 16(2) EPC 1973.

The substance of Rule 16(3) EPC 1973 was been moved to new Rule 78(2) EPC 2000.
### Rule 17  Filing of a new European patent application by the entitled person [...]

**Rule 15 EPC 1973**

1. Where the person adjudged by a final decision to be entitled to the grant of the European patent files a new European patent application pursuant to Article 61, paragraph 1(b), the original European patent application shall be deemed to be withdrawn on the date of filing of the new application for the Contracting States designated therein in which the decision has been taken or recognised.

2. The filing fee and search fee shall be payable in respect of the new European patent application within one month after the filing thereof.

The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the new European patent application.

3. The time limits for forwarding European patent applications provided for in Article 77, paragraphs 3 and 5, shall, for the new European patent application, be four months as from the actual filing date of that application.

**Rule 17 EPC 2000**

1. Where the person adjudged by a final decision to be entitled to the grant of the European patent files a new European patent application under Article 61, paragraph 1(b), the original [... ] application shall be deemed to be withdrawn on the date of filing [... ] the new application for the Contracting States designated therein in which the decision has been taken or recognised or must be recognised on the basis of the Protocol on Recognition.

2. The filing fee and search fee shall be paid within one month of filing the new [... ] application. If the filing fee or search fee is not paid in due time, the application shall be deemed to be withdrawn.

3. The designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the new [... ] application. Rule 39, paragraphs 2 and 3, shall apply.

**Deleted**

### Rule 18  Partial transfer of the right [...] to the European patent

**Rule 16 EPC 1973**

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

2. Where appropriate, the original European patent application shall contain, for the designated Contracting States in which the decision was taken or recognised, claims, a description and drawings which are different from those for the other designated Contracting States.

**Rule 18 EPC 2000**

1. If [...] a final decision determines that a third party is entitled to the grant of a European patent in respect of only part of the subject-matter disclosed in the original European patent application, Article 61 and Rules 16 and 17 shall apply [...] to such part.

2. Where appropriate, the original European patent application shall contain, for the designated Contracting States in which the decision was taken or recognised or must be recognised on the basis of the Protocol on Recognition, claims, a description and drawings which are different from those for the other designated Contracting States.
CHAPTER II

RULE 19 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 17 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 19 EPC 2000.

The list of data previously contained in Article 128(5) EPC 1973 has been incorporated in Rule 19(3) EPC 2000.

(In the Patent Law Committee 2002: CA/PL PV 19, points 16-17)

Rule 19(3) EPC 2000 provides for certain information in the application to be communicated to a third party, i.e. the inventor. This is justified by the close relationship between applicant and inventor.
### Rule 19 EPC 1973

(1) The designation of the inventor shall be filed in the request for the grant of a European patent. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document; the designation must state the family name, given names and full address of the inventor and the statement referred to in Article 81 and shall bear the signature of the applicant or his representative.

(2) The European Patent Office shall not verify the accuracy of the designation of the inventor.

(3) If the applicant is not the inventor or is not the sole inventor, the European Patent Office shall inform the designated inventor of the data in the document designating him and the further data mentioned in Article 128, paragraph 5.

[See Article 128(5) EPC 1973:
(a) the number of the European patent application;
(b) the date of filing of the European patent application and, where the priority of a previous application is claimed, the date, State and file number of the previous application;
(c) the name of the applicant;
(d) the title of the invention;
(e) the Contracting States designated.]

(4) The applicant and the inventor may invoke neither the omission of the notification under paragraph 3 nor any errors contained therein.

### Rule 19 EPC 2000

(1) The request for grant of a European patent shall contain the designation of the inventor. However, if the applicant is not the inventor or is not the sole inventor, the designation shall be filed in a separate document. The designation shall state the family name, given names and full address of the inventor, contain the statement referred to in Article 81 and [..] bear the signature of the applicant or his representative.

(2) Unchanged

(3) If the applicant is not the inventor or is not the sole inventor, the European Patent Office shall communicate to the designated inventor the information in the document designating him and the following data:

(a) the number of the European patent application;
(b) the date of filing of the European patent application and, if priority has been claimed, the date, State and file number of the previous application;
(c) the name of the applicant;
(d) the title of the invention;
(e) the Contracting States designated.

(4) The applicant and the inventor may invoke neither the omission of the communication under paragraph 3 nor any errors contained therein.
RULE 20 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 18 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 20 EPC 2000.

RULE 21 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 19 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 21 EPC 2000.
<table>
<thead>
<tr>
<th>Rule 20</th>
<th>Publication of the mention of the inventor</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 18 EPC 1973</strong></td>
<td></td>
</tr>
<tr>
<td>(1) The person designated as the inventor shall be mentioned as such in the published European patent application and the European patent specification, unless the said person informs the European Patent Office in writing that he waives his right to be thus mentioned.</td>
<td></td>
</tr>
<tr>
<td>(2) In the event of a third party filing with the European Patent Office a final decision whereby the applicant for or proprietor of a patent is required to designate him as the inventor, the provisions of paragraph 1 shall apply.</td>
<td></td>
</tr>
<tr>
<td><strong>Rule 20 EPC 2000</strong></td>
<td></td>
</tr>
<tr>
<td>(1) The [...] designated [...] inventor shall be mentioned [...] in the published European patent application and the European patent specification, unless he informs the European Patent Office in writing that he has waived his right to be thus mentioned.</td>
<td></td>
</tr>
<tr>
<td>(2) Paragraph 1 shall apply where a third party files with the European Patent Office a final decision determining that the applicant for or proprietor of a European patent is required to designate him as an inventor [...].</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Rule 21</th>
<th>Rectification of the designation of an inventor</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 19 EPC 1973</strong></td>
<td></td>
</tr>
<tr>
<td>(1) An incorrect designation of an inventor may not be rectified save upon request, accompanied by the consent of the wrongly designated person and, in the event of such request not being filed by the applicant for or proprietor of the European patent, by the consent of that party. The provisions of Rule 17 shall apply mutatis mutandis.</td>
<td></td>
</tr>
<tr>
<td>(2) In the event of an incorrect mention of the inventor having been entered in the Register of European Patents or published in the European Patent Bulletin such entry or publication shall be corrected.</td>
<td></td>
</tr>
<tr>
<td>(3) Paragraph 2 shall apply mutatis mutandis to the cancellation of an incorrect designation of the inventor.</td>
<td></td>
</tr>
<tr>
<td><strong>Rule 21 EPC 2000</strong></td>
<td></td>
</tr>
<tr>
<td>(1) An incorrect designation of an inventor shall be rectified upon request [...] and only with the consent of the wrongly designated person and, where such a request is filed by a third party, the consent of the applicant for or proprietor of the patent [...] [...] Rule 19 shall apply mutatis mutandis.</td>
<td></td>
</tr>
<tr>
<td>(2) Where an incorrect designation of the inventor has been recorded in the European Patent Register or published in the European Patent Bulletin, its rectification or cancellation shall also be recorded or published therein.</td>
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</tbody>
</table>

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CHAPTER III

RULE 22 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1, CA/PL PV 19, points 18-20)

Rule 20 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 22 EPC 2000.

The new wording of Rule 22(1) EPC 2000 does not imply any change of practice with respect to the standard of evidence required for transfers to be registered.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the responsibilities of the Legal Division, Special edition No. 3, OJ EPO 2007, 113, G.1

RULE 23 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 21 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 23 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the responsibilities of the Legal Division, Special edition No. 3, OJ EPO 2007, 113, G.1
## Chapter III  Registration of transfers, licences and other rights

### Rule 22  Registration of transfers

<table>
<thead>
<tr>
<th>Rule 20 EPC 1973</th>
<th>Rule 22 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) A transfer of a European patent application shall be recorded in the Register of European Patents at the request of an interested party and on production of documents satisfying the European Patent Office that the transfer has taken place.</td>
<td>(1) The transfer of a European patent application shall be recorded in the European Patent Register at the request of an interested party, upon production of documents providing evidence of such transfer [...].</td>
</tr>
<tr>
<td>(2) The request shall not be deemed to have been filed until such time as an administrative fee has been paid. It may be rejected only in the event of failure to comply with the conditions laid down in paragraph 1.</td>
<td>(2) The request shall not be deemed to have been filed until [... ] an administrative fee has been paid. It may be rejected only if paragraph 1 has not been complied with.</td>
</tr>
<tr>
<td>(3) A transfer shall have effect vis-à-vis the European Patent Office only when and to the extent that the documents referred to in paragraph 1 have been produced.</td>
<td>(3) A transfer shall have effect vis-à-vis the European Patent Office only at the date when and to the extent that the documents referred to in paragraph 1 have been produced.</td>
</tr>
</tbody>
</table>

### Rule 23  Registration of licences and other rights

<table>
<thead>
<tr>
<th>Rule 21 EPC 1973</th>
<th>Rule 23 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Rule 20, paragraphs 1 and 2, shall apply mutatis mutandis to the registration of the grant or transfer of a licence, the establishment or transfer of a right in rem in respect of a European patent application and any legal means of execution of such an application.</td>
<td>(1) Rule 22, paragraphs 1 and 2, shall apply mutatis mutandis to the registration of the grant or transfer of a licence, the establishment or transfer of a right in rem in respect of a European patent application and any legal means of execution affecting such an application.</td>
</tr>
<tr>
<td>(2) The registration referred to in paragraph 1 shall be cancelled upon request, which shall not be deemed to have been filed until an administrative fee has been paid. Such request shall be supported either by documents establishing that the right has lapsed, or by a declaration whereby the proprietor of the right consents to the cancellation of the registration; it may be rejected only if these conditions are not fulfilled.</td>
<td>(2) A registration under paragraph 1 shall be cancelled upon request, [... ] supported by documents providing evidence that the right has lapsed, or by the written consent of the proprietor of the right [... ] to the cancellation of the registration. Rule 22, paragraph 2, shall apply mutatis mutandis.</td>
</tr>
</tbody>
</table>
RULE 24 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 22 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 24 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the responsibilities of the Legal Division, Special edition No. 3, OJ EPO 2007, 113, G.1

CHAPTER IV

RULE 25 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 23 EPC 1973 has been reorganised for the sake of clarity, and divided into sub-paragraphs (a) to (d). It is renumbered as Rule 25 EPC 2000.

Chapter V “Prior European applications” of Part II of the Implementing Regulations and Rule 23a EPC 1973 “Prior application as state of the art” have been deleted following the deletion of Article 54(4) EPC 1973 (see explanatory remarks to Article 54 EPC).
### Rule 24  Special entries for licence registrations

#### Rule 22 EPC 1973

(1) A licence in respect of a European patent application shall be recorded in the Register of European Patents as an exclusive licence if the applicant and the licensee so require.

(2) A licence in respect of a European patent application shall be recorded in the Register of European Patents as a sub-licence where it is granted by a licensee whose licence is recorded in the said Register.

#### Rule 24 EPC 2000

A licence in respect of a European patent application shall be recorded [...] as an exclusive licence if the applicant and the licensee so request;

(b) as a sub-licence where it is granted by a licensee whose licence is recorded in the European Patent Register.

### Chapter IV  Certificate of exhibition

#### Rule 25  Certificate of exhibition

**Rule 23 EPC 1973**

The applicant must, within four months of the filing of the European patent application, file the certificate referred to in Article 55, paragraph 2, issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition, and stating that the invention was in fact exhibited there. This certificate shall also state the opening date of the exhibition and, where the first disclosure of the invention did not coincide with the opening date of the exhibition, the date of the first disclosure. This certificate must be accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.

**Rule 25 EPC 2000**

*Within* four months of filing the European patent application, the applicant shall file the certificate referred to in Article 55, paragraph 2, which:

(a) is issued at the exhibition by the authority responsible for the protection of industrial property at that exhibition;

(b) states that the invention was in fact displayed there;

(c) states the opening date of the exhibition and, where [...] the invention was disclosed later than on that date, the date on which the invention was first disclosed; and

(d) is accompanied by an identification of the invention, duly authenticated by the above-mentioned authority.
CHAPTER V

Chapter VI of the Implementing Regulations to the EPC 1973, concerning biotechnological inventions, becomes Chapter V.

RULE 26 EPC

Rule 26 EPC 2000 is unchanged as against Rule 23b EPC 1973.

RULE 27 EPC

Rule 27 EPC 2000 is unchanged as against Rule 23c EPC 1973.
Chapter V  Biotechnological inventions

Rule 26  General and definitions

(1) For European patent applications and patents concerning biotechnological inventions, the relevant provisions of the Convention shall be applied and interpreted in accordance with the provisions of this Chapter. Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions shall be used as a supplementary means of interpretation.

(2) "Biotechnological inventions" are inventions which concern a product consisting of or containing biological material or a process by means of which biological material is produced, processed or used.

(3) "Biological material" means any material containing genetic information and capable of reproducing itself or being reproduced in a biological system.

(4) "Plant variety" means any plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety right are fully met, can be:
   (a) defined by the expression of the characteristics that results from a given genotype or combination of genotypes,
   (b) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and
   (c) considered as a unit with regard to its suitability for being propagated unchanged.

(5) A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.

(6) "Microbiological process" means any process involving or performed upon or resulting in microbiological material.

Rule 27  Patentable biotechnological inventions

Biotechnological inventions shall also be patentable if they concern:

(a) biological material which is isolated from its natural environment or produced by means of a technical process even if it previously occurred in nature;

(b) plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety;

(c) a microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety.
RULE 28 EPC


RULE 29 EPC

Rule 29 EPC 2000 is unchanged as against Rule 23e EPC 1973.
Rule 28  Exceptions to patentability

Under Article 53(a), European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following:

(a) processes for cloning human beings;
(b) processes for modifying the germ line genetic identity of human beings;
(c) uses of human embryos for industrial or commercial purposes;
(d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

Rule 29  The human body and its elements

(1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.

(2) An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.

(3) The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.
RULE 30 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

For the sake of clarity and consistency, the content of Rule 27a(1) and (4) EPC 1973 has been inserted in Chapter V, dealing with biotechnological inventions, and becomes **Rule 30(1) and (2) EPC 2000**.

(Explanatory remarks 2006: CA/PL 17/06)

Rule 27a(2) and (3) EPC 1973 are deleted. Rule 2 EPC 2000 in conjunction with **Rule 30(1) EPC 2000** constitute a sufficient legal basis for the President of the EPO to determine the filing requirements as to the sequence listing part of the application. This will also enable the EPO to require that the sequence listing part be filed on an electronic medium only or, when the application is filed on-line, that only an ASCII version of the sequence listing instead of both a PDF and an ASCII version are filed. Both the statements under Rule 27a(2) and (3) EPC 1973 are explicitly provided for by WIPO Standard ST.25, points 40 and 37 respectively. WIPO Standard ST.25 is annexed to the decision of the President of the EPO dated 12 July 2007 concerning filing of sequence listings (see Special edition No. 3, OJ EPO 2007, 29, C.1.1.1). This constitutes a sufficient legal basis for requesting both statements.

The late furnishing fee already in force for PCT applications (see Rule 13ter PCT) is implemented into the EPC in **new Rule 30(3) EPC 2000**. The late furnishing of sequence listings causes significant extra effort and delay in the preparation of the European search report. It is thus necessary both to cover the additional administrative cost involved and to provide an incentive for applicants to furnish sequence listings complying with the relevant standard at the earliest time possible. For the sake of clarity and legal certainty, the legal consequence of non-payment (refusal of the application) is expressly mentioned in **new Rule 30(3), second sentence, EPC 2000**, since the late furnishing fee does not strictly speaking constitute a formal deficiency in the application in the sense of Article 90(4) EPC 2000 in conjunction with Rule 57(j) EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 30, points 88-93)

Discussion on legal consequence in **Rule 30(3) EPC 2000**.

(In the Patent Law Committee 2006: CA/PL PV 31, points 21-23)

**New Rule 30(3) EPC 2000** is equivalent to Rules 13ter and 5(2) PCT. Full and timely sequence listings is needed for an appropriate and timely European search report. An application can be amended once the search report has been issued. It is recommended not to include in the disclosure those sequence listings which are not needed. Further processing is available.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the filing of sequence listings, Special edition No. 3, OJ EPO 2007, 26, C.1 (including the Annexes C.1.1.1 WIPO Standard ST.25 for the presentation of nucleotide and amino acid sequence listings in patent applications; and C.1.1.2 Annex C - Standard for the presentation of nucleotide and amino acid sequence listings in international patent applications under the PCT)

Notice dated 12 July 2007 concerning the filing of sequence listings, Special edition No. 3, OJ EPO 2007, 84, C.2 (including Appendix C.2.1)
<table>
<thead>
<tr>
<th>Rule 30</th>
<th>Requirements of European patent applications relating to nucleotide and amino acid sequences</th>
</tr>
</thead>
</table>

<table>
<thead>
<tr>
<th>Rule 27a EPC 1973</th>
<th>Rule 30 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) If nucleotide or amino acid sequences are disclosed in the European patent application, the description shall contain a sequence listing conforming to the rules laid down by the President of the European Patent Office for the standardised representation of nucleotide and amino acid sequences.</td>
<td>(1) If nucleotide or amino acid sequences are disclosed in the European patent application, the description shall contain a sequence listing conforming to the rules laid down by the President of the European Patent Office for the standardised representation of nucleotide and amino acid sequences. Deleted</td>
</tr>
<tr>
<td>(2) The President of the European Patent Office may require that, in addition to the written application documents, a sequence listing in accordance with paragraph 1 be submitted on a data carrier prescribed by him accompanied by a statement that the information recorded on the data carrier is identical to the written sequence listing.</td>
<td>Deleted</td>
</tr>
<tr>
<td>(3) If a sequence listing is filed or corrected after the date of filing, the applicant shall submit a statement that the sequence listing so filed or corrected does not include matter which goes beyond the content of the application as filed.</td>
<td>(3) Where the applicant has not filed a sequence listing complying with the requirements under paragraph 1 at the date of filing, the European Patent Office shall invite the applicant to furnish such a sequence listing and pay the late furnishing fee. If the applicant does not furnish the required sequence listing and pay the required late furnishing fee within a period of two months after such an invitation, the application shall be refused.</td>
</tr>
<tr>
<td>(4) A sequence listing filed after the date of filing shall not form part of the description.</td>
<td></td>
</tr>
</tbody>
</table>

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RULES 31 to 33 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 28 EPC 1973, headed "Deposit of biological material", was very long and difficult to read. It lumped the deposit of biological material together with the questions of availability, the issue of a sample and the expert solution, and a number of purely formal provisions.

For the sake of clarity and consistency, the content of Rule 28 EPC 1973 has therefore been restructured as follows:

Rule 31 EPC 2000    Deposit of biological material
Rule 32 EPC 2000    Expert solution
Rule 33 EPC 2000    Availability of biological material, issue of samples, relevant arrangements

The new Rules are inserted in Chapter V dealing with biotechnological inventions.

RULE 31 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 28(1) and (2) EPC 1973 form the new Rule 31 EPC 2000, dealing with the deposit of biological material. The new Rule has been streamlined and its wording aligned with the style of the EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 31, point 12)

As the first reference to "a depositary institution" occurs in Rule 31(1)(a) EPC 2000, a reference to the Budapest Treaty on the International Recognition of the Deposit of Microorganisms is required. Alignment with Article 14(1) of Directive 98/44/EC on the legal protection of biotechnological inventions.
### Rule 28(1) and (2) EPC 1973

1. If an invention involves the use of or concerns biological material which is not available to the public and which cannot be described in the European patent application in such a manner as to enable the invention to be carried out by a person skilled in the art, the invention shall only be regarded as being disclosed as prescribed in Article 83 if:

   a. a sample of the biological material has been deposited with a recognised depositary institution not later than the date of filing of the application;

   b. the application as filed gives such relevant information as is available to the applicant on the characteristics of the biological material;

   c. the depositary institution and the accession number of the deposited biological material are stated in the application, and

   d. where the biological material has been deposited by a person other than the applicant, the name and address of the depositor are stated in the application and a document is submitted satisfying the European Patent Office that the latter has authorised the applicant to refer to the deposited biological material in the application and has given his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with this Rule.

2. The information referred to in paragraph 1(c) and, where applicable, (d) may be submitted:

   a. within a period of sixteen months after the date of filing of the application or, if priority is claimed, after the priority date, this time limit being deemed to have been met if the information is communicated before completion of the technical preparations for publication of the European patent application;

   b. up to the date of submission of a request for early publication of the application;

### Rule 31 EPC 2000

1. A sample of the biological material has been deposited with a recognised depositary institution on the same terms as those laid down in the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977 not later than the date of filing of the application;

2. The information referred to in paragraph 1(c) and [...] (d) may be submitted:

   a. within sixteen months after the date of filing of the application or, if priority has been claimed, after the priority date, this period being deemed to have been observed if the information is communicated before completion of the technical preparations for publication of the European patent application;

   b. up to the date of submission of a request under Article 93, paragraph 1(b);
RULE 32 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 28(4) and (5) EPC 1973 form the **new Rule 32 EPC 2000**, headed "Expert solution". The new Rule has been streamlined and its wording aligned with the style of the EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO.

Rule 32(1) EPC 2000: Notice of the President of the EPO dated 28.07.1981 concerning the procedure for informing the EPO that the expert option has been chosen, and the publication of that fact (OJ EPO 1981, 358).

Rule 31  Deposit of biological material

(c) within one month after the European Patent Office has communicated to the applicant that a right to inspect the files pursuant to Article 128, paragraph 2, exists. The ruling period shall be the one which is the first to expire. The communication of this information shall be considered as constituting the unreserved and irrevocable consent of the applicant to the deposited biological material being made available to the public in accordance with this Rule.

(c) within one month after the European Patent Office has communicated to the applicant that the right to inspect the files under Article 128, paragraph 2, exists. The ruling period shall be the one which is the first to expire. The communication of this information shall be considered as constituting the unreserved and irrevocable consent of the applicant to the deposited biological material being made available to the public in accordance with Rule 33.

Rule 32  Expert solution

Rule 28(4) and (5) EPC 1973

(4) Until completion of the technical preparations for publication of the application, the applicant may inform the European Patent Office that

(a) until the publication of the mention of the grant of the European patent or, where applicable,

(b) for twenty years from the date of filing if the application has been refused or withdrawn or deemed to be withdrawn,

the availability referred to in paragraph 3 shall be effected only by the issue of a sample to an expert nominated by the requester.

(5) The following may be nominated as an expert:

(a) any natural person provided that the requester furnishes evidence, when filing the request, that the nomination has the approval of the applicant;

(b) any natural person recognised as an expert by the President of the European Patent Office.

The nomination shall be accompanied by a declaration from the expert vis-à-vis the applicant in which he enters into the undertaking given pursuant to paragraph 3 until either the date on which the patent expires in all the designated States or, where the application has been refused, withdrawn or deemed to be withdrawn, until the date referred to in paragraph 4(b), the requester being regarded as a third party.

Rule 32 EPC 2000

(1) Until completion of the technical preparations for publication of the European patent application, the applicant may inform the European Patent Office that,

(a) until the publication of the mention of the grant of the European patent or, where applicable,

(b) for twenty years from the date of filing, if the application is refused or withdrawn or deemed to be withdrawn,

the availability referred to in Rule 33 shall be effected only by the issue of a sample to an expert nominated by the requester.

(2) The following may be nominated as an expert:

(a) any natural person, provided that the requester furnishes evidence, when filing the request, that the nomination has the approval of the applicant;

(b) any natural person recognised as an expert by the President of the European Patent Office.

The nomination shall be accompanied by a declaration from the expert vis-à-vis the applicant in which he enters into the undertaking given under Rule 33 until either the date on which the patent expires in all the designated States or, where the application is refused, withdrawn or deemed to be withdrawn, the date referred to in paragraph 1(b), the requester being regarded as a third party.
RULE 33 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 28(3), (6), (7), (8) and (9) EPC 1973 form the new Rule 33 EPC 2000, headed "Availability of biological material". The new Rule has been streamlined and its wording aligned with the style of the EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 31, point 10 and Annex 2, page 27)

A reference to Rule 34 EPC 2000 has been included in Rule 33(6) EPC 2000.
Rule 33

Availability of biological material

Rule 28(3), (6), (7), (8) and (9) EPC 1973

(3) The deposited biological material shall be available upon request to any person from the date of publication of the European patent application and to any person having the right to inspect the files pursuant to Article 128, paragraph 2, prior to that date. Subject to paragraph 4, such availability shall be effected by the issue of a sample of the biological material to the person making the request (hereinafter referred to as “the requester”).

Said issue shall be made only if the requester has undertaken vis-à-vis the applicant for or proprietor of the patent not to make the biological material or any biological material derived therefrom available to any third party and to use that material for experimental purposes only, until such time as the patent application is refused or withdrawn or deemed to be withdrawn, or before the expiry of the patent in the designated State in which it last expires, unless the applicant for or proprietor of the patent expressly waives such an undertaking.

The undertaking to use the biological material for experimental purposes only shall not apply in so far as the requester is using that material under a compulsory licence. The term “compulsory licence” shall be construed as including ex officio licences and the right to use patented inventions in the public interest.

(6) For the purposes of paragraph 3, derived biological material shall mean any material which still exhibits those characteristics of the deposited material which are essential to carrying out the invention. The undertaking referred to in paragraph 3 shall not impede any deposit of derived biological material necessary for the purpose of patent procedure.

Rule 33 EPC 2000

(1) […] Biological material deposited in accordance with Rule 31 shall be available upon request to any person from the date of publication of the European patent application and to any person having the right to inspect the files under Article 128, paragraph 2, prior to that date. Subject to Rule 32, such availability shall be effected by the issue of a sample of the biological material to the person making the request (hereinafter referred to as “the requester”).

(2) Said issue shall be made only if the requester has undertaken vis-à-vis the applicant for or proprietor of the patent not to make the biological material or any biological material derived therefrom available to any third party and to use that material for experimental purposes only, until such time as the patent application is refused or withdrawn or deemed to be withdrawn, or before the European patent has expired in all the designated States […] unless the applicant for or proprietor of the patent expressly waives such an undertaking.

The undertaking to use the biological material for experimental purposes only shall not apply in so far as the requester is using that material under a compulsory licence. The term “compulsory licence” shall be construed as including ex officio licences and the right to use patented inventions in the public interest.

(3) For the purposes of paragraph 2, derived biological material shall mean any material which still exhibits those characteristics of the deposited material which are essential to carrying out the invention. The undertaking under paragraph 2 shall not impede any deposit of derived biological material necessary for the purpose of patent procedure.
Rule 33  **Availability of biological material**

(7) The request provided for in paragraph 3 shall be submitted to the European Patent Office on a form recognised by that Office. The European Patent Office shall certify on the form that a European patent application referring to the deposit of the biological material has been filed, and that the requester or the expert nominated by him is entitled to the issue of a sample of that material. After grant of the European patent, the request shall also be submitted to the European Patent Office.

(8) The European Patent Office shall transmit a copy of the request, with the certification provided for in paragraph 7, to the depositary institution as well as to the applicant for or the proprietor of the patent.

(9) The President of the European Patent Office shall publish in the Official Journal of the European Patent Office the list of depositary institutions and experts recognised for the purpose of this Rule.

(4) The request referred to in paragraph 1 shall be submitted to the European Patent Office on a form recognised by that Office. The European Patent Office shall certify on the form that a European patent application referring to the deposit of the biological material has been filed, and that the requester or the expert nominated by him under Rule 32 is entitled to the issue of a sample of that material. After grant of the European patent, the request shall also be submitted to the European Patent Office.

(5) The European Patent Office shall transmit a copy of the request, with the certification provided for in paragraph 4, to the depositary institution and to the applicant for or the proprietor of the patent.

(6) The [...] European Patent Office shall publish in its Official Journal [...] the list of depositary institutions and experts recognised for the purpose of [...] Rules 31 to 34.
Rule 28a EPC 1973 – dealing with "New deposit of biological material" – was largely modelled on Article 4 of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977:
- Rule 28a(1) EPC 1973, with the exception of the second requirement for the continuing availability of biological material (copy of the receipt of the deposit forwarded to the EPO), corresponds to Article 4(1)(a) and (d) and 4(2) of the Budapest Treaty.
- Rule 28a(2) EPC 1973 corresponds to Article 4(1)(b)(i) of the Budapest Treaty.
- Rule 28a(3) EPC 1973 corresponds to Article 4(1)(b)(i) and (e) of the Budapest Treaty.
- Rule 28a(4) EPC 1973 corresponds to Article 4(1)(c) of the Budapest Treaty.

Like Rule 28 EPC 1973, Rule 28a EPC 1973 was difficult to read. The revised and shortened Rule 34 EPC 2000 follows the example of Article 14 of Directive 98/44/EC on the legal protection of biotechnological inventions. It furthermore includes an express reference to the Budapest Treaty.

As indicated above, Rule 28a EPC 1973 included an additional requirement for the continuing availability of biological material, i.e. that a copy of the receipt of the deposit be forwarded within four months from the date of the new deposit. This requirement has also been included in Rule 34 EPC 2000.

The details of the procedure for making the new deposit are set out in the Guidelines for Examination (A-IV, 4.1.1).

Finally, Rule 28a EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.


Wording aligned with Article 14(1) of Directive 98/44/EC.
### Rule 34  New deposit of biological material

<table>
<thead>
<tr>
<th><strong>Rule 28a EPC 1973</strong></th>
<th><strong>Rule 34 EPC 2000</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) If biological material deposited in accordance with Rule 28, paragraph 1, ceases to be available from the institution with which it was deposited because:</td>
<td>[... ] If biological material deposited in accordance with Rule 31 ceases to be available from the recognised depositary institution, an interruption in availability shall be deemed not to have occurred if a new deposit of that material is made with a recognised depositary institution on the same terms as those laid down in the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977, and if a copy of the receipt of the new deposit issued by the depositary institution is forwarded to the European Patent Office within four months of the date of the new deposit, stating the number of the European patent application or of the European patent.</td>
</tr>
<tr>
<td>(a) the biological material is no longer viable, or</td>
<td>Deleted</td>
</tr>
<tr>
<td>(b) for any other reason the depositary institution is unable to supply samples, and if no sample of the biological material has been transferred to another depositary institution recognised for the purposes of Rule 28, from which it continues to be available, an interruption in availability shall be deemed not to have occurred if a new deposit of the biological material originally deposited is made within a period of three months from the date on which the depositor was notified of the interruption by the depositary institution and if a copy of the receipt of the deposit issued by the institution is forwarded to the European Patent Office within four months from the date of the new deposit stating the number of the application or of the European patent.</td>
<td>Deleted</td>
</tr>
<tr>
<td>(2) In the case provided for in paragraph 1(a), the new deposit shall be made with the depositary institution with which the original deposit was made; in the cases provided for in paragraph 1(b), it may be made with another depositary institution recognised for the purposes of Rule 28.</td>
<td>Deleted</td>
</tr>
<tr>
<td>(3) Where the institution with which the original deposit was made ceases to be recognised for the purposes of Rule 28, either entirely or for the kind of biological material to which the deposited sample belongs, or where that institution discontinues, temporarily or definitively, the performance of its functions as regards deposited biological material, and the notification referred to in paragraph 1 from the depositary institution is not received within six months from the date of such event, the three-month period referred to in paragraph 1 shall begin on the date on which this event is announced in the Official Journal of the European Patent Office.</td>
<td>Deleted</td>
</tr>
<tr>
<td>(4) Any new deposit shall be accompanied by a statement signed by the depositor certifying that the newly deposited biological material is the same as that originally deposited.</td>
<td>Deleted</td>
</tr>
<tr>
<td>(5) If the new deposit has been made under the provisions of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure of 28 April 1977, the provisions of that Treaty shall prevail.</td>
<td>Deleted</td>
</tr>
</tbody>
</table>
PART III

CHAPTER I

RULE 35 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; discussion in the Patent Law Committee 2002: CA/PL PV 19, points 24-25)

The geographical indications in Article 75(1)(a) EPC 1973 have been moved to Rule 35(1) EPC 2000.

In addition, Rule 24 EPC 1973 has been restructured for increased clarity and aligned with the wording of the EPC 2000.

(Explanatory remarks 2006: CA/PL 17/06)

Rule 24(1), second and third sentences, EPC 1973 are deleted since this subject is covered by new Rule 2 EPC 2000.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, points 94-96)

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the filing of patent applications and other documents by facsimile, Special edition No. 3, OJ EPO 2007, 7, A.3

Decision dated 12 July 2007 concerning the electronic filing of patent applications and other documents, Special edition No. 3, OJ EPO 2007, 12, A.4

Decision dated 12 July 2007 concerning the electronic signatures, data carriers and software to be used for the electronic filing of patent applications and other documents, Special edition No. 3, OJ EPO 2007, 17, A.5
# IMPLEMENTING REGULATIONS TO PART III OF THE CONVENTION

## Chapter I  Filing of the European patent application

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<th>Rule 35</th>
<th>General provisions</th>
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</thead>
<tbody>
<tr>
<td><strong>Rule 24 EPC 1973</strong></td>
<td><strong>Rule 35 EPC 2000</strong></td>
</tr>
<tr>
<td>(1) European patent applications may be filed in writing with the authorities referred to in Article 75 either directly or by post. The President of the European Patent Office may permit European patent applications to be filed by other means of communication and lay down conditions governing their use. He may, in particular, require that within such period as the European Patent Office shall specify written confirmation be supplied reproducing the contents of applications so filed and complying with the requirements of these Implementing Regulations.</td>
<td>(1) European patent applications may be filed in writing with the European Patent Office in Munich, The Hague or Berlin, or the authorities referred to in Article 75, paragraph 1(b) [...].</td>
</tr>
<tr>
<td>(2) The authority with which the European patent application is filed shall mark the documents making up the application with the date of their receipt. It shall issue without delay a receipt to the applicant which shall include at least the application number, the nature and number of the documents and the date of their receipt.</td>
<td>(2) The authority with which the European patent application is filed shall mark the documents making up the application with the date of their receipt, and issue without delay a receipt to the applicant including at least the application number and the nature, number and date of receipt of the documents.</td>
</tr>
<tr>
<td>(3) If the European patent application is filed with an authority mentioned in Article 75, paragraph 1(b), it shall without delay inform the European Patent Office of receipt of the documents making up the application. It shall inform the European Patent Office of the nature and date of receipt of the documents, the application number and any priority date claimed.</td>
<td>(3) If the European patent application is filed with an authority referred to in Article 75, paragraph 1(b), such authority shall without delay inform the European Patent Office of the receipt of the [... application, and, in particular, of the nature and date of receipt of the documents, the application number and any priority date claimed.</td>
</tr>
<tr>
<td>(4) When the European Patent Office has received a European patent application which has been forwarded by a central industrial property office of a Contracting State, it shall inform the applicant accordingly, indicating the date of its receipt at the European Patent Office.</td>
<td>(4) Upon receipt of a European patent application [...] forwarded by the central industrial property office of a Contracting State, the European Patent Office shall inform the applicant accordingly, indicating the date of its receipt [...].</td>
</tr>
</tbody>
</table>
RULE 36 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Like Rule 4 EPC 1973, Rule 36(2) EPC 2000 provides that divisional applications are to be filed in the language of the proceedings for the earlier application. In addition, it is made clear that divisional applications shall be filed in Munich, The Hague or Berlin (see Article 76(1), first sentence, EPC 1973).

Moreover, pursuant to Article 51(3) EPC 2000, new Rule 36(3) and (4) EPC 2000 not only specify the fees to be paid, with their time limits, but also refer to the legal consequences of failure to pay in due time. Rule 25(2) EPC 1973 has thus been subdivided into Rule 36(3) and (4) EPC 2000 for ease of reference.

(In the Patent Law Committee 2002: CA/PL PV 19, points 26-27)

In view of the wording of Rule 35(1) EPC 2000, the word "directly" (see Article 76(1) EPC 1973) is not included in the English version of Rule 36(2) EPC 2000 in order to avoid any misinterpretation.

Specifying the language in which a divisional application is to be filed (Rule 36(2) EPC 2000) represents a change in legal terms, but not a change to current practice. Article 14(2) EPC 2000 does not exclude a clarification of this nature.
<table>
<thead>
<tr>
<th>Rule 36</th>
<th>European divisional applications</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 25 EPC 1973</strong></td>
<td><strong>Rule 36 EPC 2000</strong></td>
</tr>
<tr>
<td>(1) The applicant may file a divisional application relating to any pending earlier European patent application.</td>
<td>(1) Unchanged</td>
</tr>
<tr>
<td><strong>Rule 4 EPC 1973</strong></td>
<td><strong>Rule 36 EPC 2000</strong></td>
</tr>
<tr>
<td>European divisional applications or, in the case referred to in Article 14, paragraph 2, the translations thereof, must be filed in the language of the proceedings for the earlier European patent application.</td>
<td>(2) A [...] divisional application [...] shall be in the language of the proceedings for the earlier application and shall be filed with the European Patent Office in Munich, The Hague or Berlin.</td>
</tr>
<tr>
<td>[See Article 76 EPC 1973: (1) A European divisional application must be filed directly with the European Patent Office at Munich or its branch at The Hague.]</td>
<td></td>
</tr>
<tr>
<td><strong>Rule 25 EPC 1973</strong></td>
<td>(3) The filing fee and search fee shall be paid within one month of filing the divisional application. If the filing fee or search fee is not paid in due time, the application shall be deemed to be withdrawn.</td>
</tr>
<tr>
<td>(2) The filing fee and search fee shall be payable in respect of a European divisional application within one month after the filing thereof. The designation fees shall be payable within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the European divisional application.</td>
<td>(4) The designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report drawn up in respect of the [...] divisional application. Rule 39, paragraphs 2 and 3, shall apply.</td>
</tr>
</tbody>
</table>
**RULE 37 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; discussion in the Patent Law Committee 2002: CA/PL PV 19, points 28-29)

Details regarding the forwarding of European patent applications from the central industrial property offices of the Contracting States to the EPO, previously contained in Article 77(1) and (5) EPC 1973, as well as the substance of Article 77(2) and (3) EPC 1973, have been transferred to the new **Rule 37 EPC 2000**.

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.)

The wording of Rule 37(2), last sentence, EPC 2000 implies that all fees for a European patent application filed with a national office are refunded if the EPO does not receive the application within fourteen months of the filing or priority date. The term “fees” includes any additional fees or surcharges which may have been paid.

Rule 39(4) EPC 2000 makes it clear that the principle whereby designation fees are not refunded does not apply in the special case referred to in Rule 37(2) EPC 2000.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, points 97-100)

**RULE 38 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The period for payment of the filing fee and the search fee under Article 78(2) EPC 1973 has been transferred to the new **Rule 38 EPC 2000**. The legal consequence of failure to pay these fees in due time is already established in the new Article 78(2) EPC 2000, so there is no need to repeat it in Rule 38 EPC 2000.
### Rule 37  Forwarding of European patent applications

#### EPC 1973

[See Article 77 EPC 1973:

1. ... in the shortest time compatible with the application of national law concerning the secrecy of inventions in the interests of the State ...

2. The Contracting States shall take all appropriate steps to ensure that European patent applications, the subject of which is obviously not liable to secrecy by virtue of the law referred to in paragraph 1, shall be forwarded to the European Patent Office within six weeks after filing.

3. European patent applications which require further examination as to their liability to secrecy shall be forwarded in such manner as to reach the European Patent Office within four months after filing, or, where priority has been claimed, fourteen months after the date of priority.

5. ... before the end of the fourteenth month after filing or, if priority has been claimed, after the date of priority ... The filing, search and designation fees shall be refunded.]

#### Rule 37 EPC 2000

1. The central industrial property office of a Contracting State shall forward European patent applications to the European Patent Office in the shortest time compatible with its national law relating to the secrecy of inventions in the interests of the State, and shall take all appropriate steps to ensure such forwarding within:

   - six weeks of filing, where the subject of the application is evidently not liable to secrecy under the national law; or
   - four months of filing or, if priority has been claimed, fourteen months of the date of priority, where the application requires further examination as to its liability to secrecy.

2. A European patent application not received by the European Patent Office within fourteen months of filing or, if priority has been claimed, of the date of priority, shall be deemed to be withdrawn. Any fees paid in respect of this application shall be refunded.

### Rule 38  Filing fee and search fee

#### EPC 1973

[See Article 78 EPC 1973:

2. A European patent application shall be subject to the payment of the filing fee and the search fee within one month after the filing of the application.]

#### Rule 38 EPC 2000

The filing fee and search fee shall be paid within one month of filing the European patent application.
RULE 39 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

New Rule 39 EPC 2000 includes
- the period for payment of the designation fees (see Article 79(2) EPC 1973),
- the legal consequence of failure to pay a designation fee in due time (see Article 91(4) EPC 1973),
- the legal consequence in cases where no designation fee is paid or all designations are withdrawn (see Article 79(3) EPC 1973), and
- the principle that designation fees are not refundable (see Article 79(3), last sentence, EPC 1973).

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1; discussion in the Patent Law Committee 2006: CA/PL PV 30, points 101-102)

Insertion of "Without prejudice to Rule 37, paragraph 2, second sentence" in Rule 39(4) EPC 2000.
- the rule that designation fees are not refunded does not apply in the special case referred to in Rule 37(2) EPC 2000
- Rule 39(4) EPC 2000 relates to cases where the application has reached the EPO, while Rule 37(2) EPC 2000 deals with cases where it has not.
<table>
<thead>
<tr>
<th>Rule 39</th>
<th>Designation fees</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>EPC 1973</strong></td>
<td></td>
</tr>
</tbody>
</table>
| [See Article 79 EPC 1973:](#)  
(2) ... Designation fees shall be paid within 6 months of the date on which the European Patent Bulletin mentions the publication of the European search report.]  |

[See Article 91 EPC 1973:  
(4) Where, in the case referred to in paragraph 1 (e), the designation fee has not been paid in due time in respect of any designated State, the designation of that State shall be deemed to be withdrawn.]  

[See Article 79 EPC 1973:  
(3) Withdrawal of the designation of all the Contracting States shall be deemed to be a withdrawal of the European patent application. ...  
Designation fees shall not be refunded.]  |

<table>
<thead>
<tr>
<th>Rule 39 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Designation fees shall be paid within six months of the date on which the European Patent Bulletin mentions the publication of the European search report.</td>
</tr>
</tbody>
</table>

(2) Where the designation fee is not paid in due time in respect of any Contracting State, the designation of that State shall be deemed to be withdrawn. |

(3) Where no designation fee is paid in due time or the designations of all the Contracting States are withdrawn, the European patent application shall be deemed to be withdrawn. |

(4) Without prejudice to Rule 37, paragraph 2, second sentence, designation fees shall not be refunded. |
RULE 40 EPC

Article 80 EPC 1973 provided that the date of filing of a European patent application was the date on which documents filed by the applicant contained:
(a) an indication that a European patent was sought;
(b) the designation of at least one Contracting State;
(c) information identifying the applicant;
(d) a description and one or more claims in one of the languages referred to in Article 14(1) and (2) EPC.

Under Article 80 EPC 2000, the Implementing Regulations shall specify the requirements for the accordance of a date of filing.

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The wording of the new Rule 40(1) EPC 2000 follows the model of Article 5(1) and (7) of the Patent Law Treaty of 1 June 2000 (PLT).

Under Article 5(7) and Rule 2(5)(a) PLT, Contracting Parties are obliged to accept a reference to a single, previously filed application instead of a description and any drawings, provided that the previously filed application is properly identified. These requirements are inserted in new Rule 40(2) EPC 2000.

In such a case, Contracting Parties to the PLT may request the filing of:
- a copy of the previously filed application (Rule 2(5)(b) PLT) (unless such a copy is already available to the Contracting Party (Rule 4(3) PLT)), and,
- where appropriate, a translation of that application.

The requirements relating to this are grouped under new Rule 40(3) EPC 2000.

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1)

The applicant must file a certified copy rather than a normal copy, since the previously filed application is not necessarily published or is the application from which priority is claimed and from which a priority document is available.

A period of two months is laid down in Rule 40(3) EPC 2000, in line with Rule 6(1) EPC 2000. If either the copy of the previous application or the translation is not filed within the two month period, the applicant will receive a communication setting him a time period of two months under Rule 55 EPC 2000 (for the filing of the copy) or under Rule 58 EPC 2000 (for the filing of the translation). The applicant thus has the four months prescribed in Rule 2(5)(b)(ii) PLT.

Apart from streamlining time periods, the EPO has an interest in receiving the copy of the previous application and, where applicable, the translation as early as possible for the purpose of publishing the application, in particular if the European patent application is filed towards the end of the priority period.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, points 103-104)
<table>
<thead>
<tr>
<th>Rule 40</th>
<th>Date of filing</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>EPC 1973</strong></td>
<td><strong>Rule 40 EPC 2000</strong></td>
</tr>
<tr>
<td><a href="#">See Article 80 EPC 1973: The date of filing of a European patent application shall be the date on which documents filed by the applicant contain:</a></td>
<td>(1) The date of filing of a European patent application shall be the date on which the documents filed by the applicant contain:</td>
</tr>
<tr>
<td>(a) an indication that a European patent is sought; ...</td>
<td>(a) an indication that a European patent is sought;</td>
</tr>
<tr>
<td>(c) information identifying the applicant;</td>
<td>(b) information identifying the applicant or allowing the applicant to be contacted; and</td>
</tr>
<tr>
<td>(d) a description]</td>
<td>(c) a description or reference to a previously filed application.</td>
</tr>
<tr>
<td>(2) A reference to a previously filed application under paragraph 1(c) shall state the filing date and number of that application and the Office with which it was filed. Such reference shall indicate that it replaces the description and any drawings.</td>
<td>(2) A reference to a previously filed application under paragraph 1(c) shall state the filing date and number of that application and the Office with which it was filed. Such reference shall indicate that it replaces the description and any drawings.</td>
</tr>
<tr>
<td>(3) Where the application contains a reference under paragraph 2, a certified copy of the previously filed application shall be filed within two months of filing the application. Where the previously filed application is not in an official language of the European Patent Office, a translation thereof in one of these languages shall be filed within the same period. Rule 53, paragraph 2, shall apply mutatis mutandis.</td>
<td>(3) Where the application contains a reference under paragraph 2, a certified copy of the previously filed application shall be filed within two months of filing the application. Where the previously filed application is not in an official language of the European Patent Office, a translation thereof in one of these languages shall be filed within the same period. Rule 53, paragraph 2, shall apply mutatis mutandis.</td>
</tr>
</tbody>
</table>
CHAPTER II

RULE 41 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 26 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 41 EPC 2000.

The second sentence of Rule 26(1) EPC 1973 is deleted as superfluous. It goes without saying that forms are made available free of charge by the EPO and the national authorities.

The contact information referred to in Rule 41(2)(c) EPC 2000 is updated and brought into line with the current EPO Request for grant form. In particular, Rule 41(2)(c) EPC 2000 recommends that the applicant indicate his fax number instead of his telegraphic or telex address.

Rule 26(2)(h) EPC 1973 is deleted to reflect new Article 79(1) EPC 2000 which provides that all the Contracting States at the time of filing shall be deemed to be designated.
<table>
<thead>
<tr>
<th>Rule 41</th>
<th>Request for grant</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 26 EPC 1973</strong></td>
<td><strong>Rule 41 EPC 2000</strong></td>
</tr>
</tbody>
</table>

(1) The request for the grant of a European patent shall be filed on a form drawn up by the European Patent Office. Printed forms shall be made available to applicants free of charge by the authorities referred to in Article 75, paragraph 1.

(2) The request shall contain:

(a) a petition for the grant of a European patent;

(b) the title of the invention, which shall clearly and concisely state the technical designation of the invention and shall exclude all fancy names;

(c) the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Names of natural persons shall be indicated by the person's family name and given name(s), the family name being indicated before the given name(s). Names of legal entities, as well as companies considered to be legal entities by reason of the legislation to which they are subject, shall be indicated by their official designations. Addresses shall be indicated in such a way as to satisfy the customary requirements for prompt postal delivery at the indicated address. They shall in any case comprise all the relevant administrative units, including the house number, if any. It is recommended that the telegraphic and telex address and telephone number be indicated;

(d) if the applicant has appointed a representative, his name and the address of his place of business under the conditions contained in sub-paragraph (c);

(e) where appropriate, indication that the application constitutes a European divisional application and the number of the earlier European patent application;

(f) in cases covered by Article 61, paragraph 1(b), the number of the original European patent application;

(1) The request for [...] grant of a European patent shall be filed on a form drawn up by the European Patent Office. [...]

(2) The request shall contain:

(a) Unchanged

(b) Unchanged

(c) the name, address and nationality of the applicant and the State in which his residence or principal place of business is located. Names of natural persons shall be indicated by the person's family name, followed by his given names. Names of legal persons, as well as [...] of bodies equivalent to legal persons under the law governing them, shall be indicated by their official designations. Addresses shall be indicated in accordance with applicable customary requirements for prompt postal delivery and shall comprise all the relevant administrative units, including the house number, if any. It is recommended that the [...] fax and telephone numbers be indicated;

(d) if the applicant has appointed a representative, his name and the address of his place of business [...] as prescribed in sub-paragraph (c);

(e) where appropriate, an indication that the application constitutes a divisional application and the number of the earlier European patent application;

(f) Unchanged
### Rule 41 Request for grant

<table>
<thead>
<tr>
<th>(g) where applicable, a declaration claiming the priority of an earlier application and indicating the date on which and the country in or for which the earlier application was filed;</th>
<th>(g) Unchanged</th>
</tr>
</thead>
<tbody>
<tr>
<td>(h) designation of the Contracting State or States in which protection of the invention is desired;</td>
<td>Deleted</td>
</tr>
<tr>
<td>(i) the signature of the applicant or his representative;</td>
<td>(i) Becomes (h) - wording unchanged</td>
</tr>
<tr>
<td>(j) a list of the documents accompanying the request. This list shall also indicate the number of sheets of the description, claims, drawings and abstract filed with the request;</td>
<td>(j) Becomes (i) - wording unchanged</td>
</tr>
<tr>
<td>(k) the designation of the inventor where the applicant is the inventor.</td>
<td>(k) Becomes (j) - wording unchanged</td>
</tr>
<tr>
<td>(3) If there is more than one applicant, the request shall preferably contain the appointment of one applicant or representative as common representative.</td>
<td>(3) Unchanged</td>
</tr>
</tbody>
</table>
RULE 42 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 27 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 42 EPC 2000.
### Rule 42 EPC 2000

#### Rule 27 EPC 1973

1. The description shall:

   a. specify the technical field to which the invention relates;

   b. indicate the background art which, as far as is known to the applicant, can be regarded as useful to understand the invention, draw up the European search report and examine the European patent application, and, preferably, cite the documents reflecting such art;

   c. disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;

   d. briefly describe the figures in the drawings, if any;

   e. describe in detail at least one way of carrying out the invention claimed using examples where appropriate and referring to the drawings, if any;

   f. indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is capable of exploitation in industry.

2. The description shall be presented in the manner and order specified in paragraph 1, unless because of the nature of the invention, a different manner or a different order would afford a better understanding and a more economic presentation.

#### Rule 27 EPC 1973

1. The description shall:

   a. Unchanged

   b. indicate the background art which, as far as is known to the applicant, can be regarded as useful for understanding the invention, for drawing up the European search report and for the examination, and, preferably, cite the documents reflecting such art;

   c. disclose the invention, as claimed, in such terms that the technical problem (even if not expressly stated as such) and its solution can be understood, and state any advantageous effects of the invention with reference to the background art;

   d. Unchanged

   e. Unchanged

   f. indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable.

2. The description shall be presented in the manner and order specified in paragraph 1, unless, owing to the nature of the invention, a different presentation [...] would afford a better understanding or be more concise.
RULE 43 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 29 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as **Rule 43 EPC 2000**.

(See also discussion in the Patent Law Committee 2002: CA/PL PV 19, points 30-32)
Rule 43  Form and content of claims

Rule 29 EPC 1973

(1) The claims shall define the matter for which protection is sought in terms of the technical features of the invention. Wherever appropriate claims shall contain:

(a) a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, are part of the prior art;

(b) a characterising portion - preceded by the expression "characterised in that" or "characterised by" - stating the technical features which, in combination with the features stated in sub-paragraph (a), it is desired to protect.

(2) Without prejudice to Article 82, a European patent application may contain more than one independent claim in the same category (product, process, apparatus or use) only if the subject-matter of the application involves one of the following:

(a) a plurality of inter-related products;

(b) different uses of a product or apparatus;

(c) alternative solutions to a particular problem, where it is not appropriate to cover these alternatives by a single claim.

(3) Any claim stating the essential features of an invention may be followed by one or more claims concerning particular embodiments of that invention.

Rule 43 EPC 2000

(1) The claims shall define the matter for which protection is sought in terms of the technical features of the invention. Wherever appropriate, claims shall contain:

(a) a statement indicating the designation of the subject-matter of the invention and those technical features which are necessary for the definition of the claimed subject-matter but which, in combination, form part of the prior art;

(b) a characterising portion, beginning with the expression "characterised in that" or "characterised by" and specifying the technical features for which, in combination with the features stated under sub-paragraph (a), protection is sought.

(2) Unchanged

(a) Unchanged

(b) Unchanged

(c) alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

(3) Unchanged
Rule 43  Form and content of claims

(4) Any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features which it is desired to protect. A dependent claim shall also be admissible where the claim it directly refers to is itself a dependent claim. All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most appropriate way possible.

(5) The number of the claims shall be reasonable in consideration of the nature of the invention claimed. If there are several claims, they shall be numbered consecutively in Arabic numerals.

(6) Claims shall not, except where absolutely necessary, rely, in respect of the technical features of the invention, on references to the description or drawings. In particular, they shall not rely on such references as: "as described in part ... of the description", or "as illustrated in figure ... of the drawings".

(7) If the European patent application contains drawings, the technical features mentioned in the claims shall preferably, if the intelligibility of the claim can thereby be increased, be followed by reference signs relating to these features and placed between parentheses. These reference signs shall not be construed as limiting the claim.

(4) Any claim which includes all the features of any other claim (dependent claim) shall contain, if possible at the beginning, a reference to the other claim and then state the additional features [...]. A dependent claim [...] directly referring to another [...] dependent claim shall also be admissible. All dependent claims referring back to a single previous claim, and all dependent claims referring back to several previous claims, shall be grouped together to the extent and in the most appropriate way possible.

(5) The number of claims shall be reasonable with regard to the nature of the invention claimed. [...] The claims shall be numbered consecutively in Arabic numerals.

(6) Except where absolutely necessary, claims shall not rely [...] on references to the description or drawings in specifying the technical features of the invention. In particular, they shall not contain such expressions as "as described in part ... of the description", or "as illustrated in figure ... of the drawings".

(7) Where the European patent application contains drawings including reference signs, the technical features specified in the claims shall preferably [...] be followed by such reference signs relating to these features, placed in parentheses, if the intelligibility of the claim can thereby be increased. These reference signs shall not be construed as limiting the claim.
RULE 44 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 30(1) EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. The Rule is renumbered as Rule 44 EPC 2000.

RULE 45 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The wording of Rule 45(1) EPC 2000 has been aligned with Article 2, item 15, of the Rules relating to Fees dealing with the claims fee for the eleventh and each subsequent claim.

The substance of Rule 31(1), second and third sentences, EPC 1973 has been incorporated into new Rule 45(2) EPC 2000, for reasons of clarity. As claims are no longer required for the accordance of a filing date, Rule 45(2) EPC 2000 refers to the filing of the first set of claims.

Rule 31(2), second sentence, EPC 1973 has been deleted, its substance being now covered by Rule 37(2) EPC 2000.

Finally, Rule 31 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.

(See also Explanatory remarks 2006: CA/PL 11/06, page 4; discussion in the Patent Law Committee: CA/PL PV 29, points 10-16)

Concerning the word "abandoned" in Rule 45(3) EPC 2000.
### Rule 44 Unity of invention

**Rule 30 EPC 1973**

1. Where a group of inventions is claimed in one and the same European patent application, the requirement of unity of invention referred to in Article 82 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.

2. The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

**Rule 44 EPC 2000**

1. Where a group of inventions is claimed in [...] a European patent application, the requirement of unity of invention under Article 82 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those features which define a contribution which each of the claimed inventions considered as a whole makes over the prior art.

2. Unchanged

### Rule 45 Claims incurring fees

**Rule 31 EPC 1973**

1. Any European patent application comprising more than ten claims at the time of filing shall, in respect of each claim over and above that number, incur payment of a claims fee.

The claims fee shall be payable within one month after the filing of the application. If the claims fees have not been paid in due time they may still be validly paid within a period of grace of one month of notification of a communication pointing out the failure to observe the time limit.

2. If a claims fee is not paid within the period referred to in paragraph 1, the claim concerned shall be deemed to be abandoned. Any claims fee duly paid shall be refunded only in the case referred to in Article 77, paragraph 5.

**Rule 45 EPC 2000**

1. Any European patent application comprising more than ten claims [...] shall, in respect of the eleventh and each subsequent claim [...], incur payment of a claims fee.

(2) The claims fees shall be paid within one month of filing the first set of claims. If the claims fees have not been paid in due time, they may still be [...] paid within [...] one month of a communication [...] concerning the failure to observe the time limit.

(3) If a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned. [...]
RULE 46 EPC

(Explanatory remarks 2002: CA/P/L 5/02 Rev. 1 Add. 1)

Rule 32 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 46 EPC 2000.

In addition, some redundant wording has been removed from Rule 32(2)(j) EPC 1973. In this context, the terms "keywords" and "catchwords" have equivalent meanings. Moreover, "electric circuits" and "block schematic diagrams" are diagrams, and since these, by virtue of Rule 46(3) EPC 2000, are deemed to be drawings, Rule 46(2)(j) EPC 2000 has been simplified by referring to drawings only.
### Rule 46  Form of the drawings

#### Rule 32 EPC 1973

(1) On sheets containing drawings, the usable surface area shall not exceed 26.2 cm x 17 cm. These sheets shall not contain frames round the usable or used surface. The minimum margins shall be as follows:

<table>
<thead>
<tr>
<th>Margin</th>
<th>Distance</th>
</tr>
</thead>
<tbody>
<tr>
<td>top</td>
<td>2.5 cm</td>
</tr>
<tr>
<td>left side</td>
<td>2.5 cm</td>
</tr>
<tr>
<td>right side</td>
<td>1.5 cm</td>
</tr>
<tr>
<td>bottom</td>
<td>1 cm</td>
</tr>
</tbody>
</table>

(2) Drawings shall be executed as follows:

(a) Drawings shall be executed in durable, black, sufficiently dense and dark, uniformly thick and well-defined, lines and strokes without colourings.

(b) Cross-sections shall be indicated by hatching which should not impede the clear reading of the reference signs and leading lines.

(c) The scale of the drawings and the distinctness of their graphical execution shall be such that reproduction, obtained electronically or photographically, with a linear reduction in size to two-thirds would enable all details to be distinguished without difficulty. If, as an exception, the scale is given on a drawing, it shall be represented graphically.

(d) All numbers, letters, and reference signs, appearing on the drawings, shall be simple and clear. Brackets, circles or inverted commas shall not be used in association with numbers and letters.

(e) All lines in the drawings shall, ordinarily, be drawn with the aid of drafting instruments.

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

(g) The height of the numbers and letters shall not be less than 0.32 cm. For the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used.

#### Rule 46 EPC 2000

(1) On sheets containing drawings, the usable surface area shall not exceed 26.2 cm x 17 cm. The usable or used surface shall not be surrounded by frames. The minimum margins shall be as follows:

<table>
<thead>
<tr>
<th>Margin</th>
<th>Distance</th>
</tr>
</thead>
<tbody>
<tr>
<td>top</td>
<td>2.5 cm</td>
</tr>
<tr>
<td>left side</td>
<td>2.5 cm</td>
</tr>
<tr>
<td>right side</td>
<td>1.5 cm</td>
</tr>
<tr>
<td>bottom</td>
<td>1 cm</td>
</tr>
</tbody>
</table>

(2) Drawings shall be executed as follows:

(a) Drawings shall be executed without colourings in durable, black, sufficiently dense and dark, uniformly thick and well-defined lines and strokes.

(b) Unchanged

(c) The scale of the drawings and [...] their graphical execution shall be such that electronic or photographic reproduction [...] with a linear reduction in size to two-thirds will allow all details to be distinguished without difficulty. If, exceptionally, the scale is given on a drawing, it shall be represented graphically.

(d) Unchanged

(e) Generally, all lines in the drawings shall [...] be drawn with the aid of drafting instruments.

(f) Elements of the same figure shall be proportional to one another, unless a difference in proportion is indispensable for the clarity of the figure.

(g) Unchanged
Rule 46  Form of the drawings

(h) The same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form one whole figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet. The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.

(i) Reference signs not mentioned in the description and claims shall not appear in the drawings, and vice versa. The same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs.

(j) The drawings shall not contain text matter, except, when absolutely indispensable, a single word or words such as "water", "steam", "open", "closed", "section on AB", and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords indispensable for understanding. Any such words shall be placed in such a way that, if required, they can be replaced by their translations without interfering with any lines of the drawings.

(3) Flow sheets and diagrams are considered drawings.

(h) The same sheet of drawings may contain several figures. Where figures drawn on two or more sheets are intended to form a single figure, the figures on the several sheets shall be so arranged that the whole figure can be assembled without concealing any part of the partial figures. The different figures shall be arranged without wasting space, preferably in an upright position, clearly separated from one another. Where the figures are not arranged in an upright position, they shall be presented sideways with the top of the figures at the left side of the sheet. The different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets.

(i) Reference signs not mentioned in the description and claims shall not appear in the drawings, and vice versa. […] Reference signs to features shall be consistent throughout the application […].

(j) The drawings shall not contain text matter. Where […] indispensable to understand the drawings, a few short keywords, such as "water", "steam", "open", "closed" or "section on AB", may be included. Any such keywords shall be placed in such a way that, if required, they can be replaced by their translations without interfering with any lines of the drawings.

(3) Flow sheets and diagrams shall be deemed to be drawings.
Rule 33 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 47 EPC 2000.
### Rule 47 — Form and content of the abstract

<table>
<thead>
<tr>
<th>Rule 33 EPC 1973</th>
<th>Rule 47 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) The abstract shall indicate the title of the invention.</td>
<td>(1) Unchanged</td>
</tr>
<tr>
<td>(2) The abstract shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings; the summary shall indicate the technical field to which the invention pertains and shall be drafted in a way which allows the clear understanding of the technical problem, the gist of the solution of that problem through the invention and the principal use or uses of the invention. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterises the invention. It shall not contain statements on the alleged merits or value of the invention or on its speculative application.</td>
<td>(2) The abstract shall contain a concise summary of the disclosure as contained in the description, the claims and any drawings. The summary shall indicate the technical field to which the invention pertains, and shall be drafted in a manner allowing the clear understanding of the technical problem, the gist of the solution of that problem through the invention, and the principal use or uses of the invention. The abstract shall, where applicable, contain the chemical formula which, among those contained in the application, best characterises the invention. It shall not contain statements on the alleged merits or value of the invention or on [...] speculative applications thereof.</td>
</tr>
<tr>
<td>(3) The abstract shall preferably not contain more than one hundred and fifty words.</td>
<td>(3) Unchanged</td>
</tr>
<tr>
<td>(4) If the European patent application contains drawings, the applicant shall indicate the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when the abstract is published. The European Patent Office may decide to publish one or more other figures if it considers that they better characterise the invention. Each main feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign, placed between parentheses.</td>
<td>(4) If the European patent application contains drawings, the applicant shall indicate the figure or, exceptionally, the figures of the drawings which [...] should be published with the abstract. The European Patent Office may decide to publish one or more other figures if it considers that they better characterise the invention. Each essential feature mentioned in the abstract and illustrated by a drawing shall be followed by a reference sign placed in parentheses.</td>
</tr>
<tr>
<td>(5) The abstract shall be so drafted that it constitutes an efficient instrument for purposes of searching in the particular technical field particularly by making it possible to assess whether there is a need for consulting the European patent application itself.</td>
<td>(5) The abstract shall be drafted in such a manner as to constitute an efficient instrument for the purpose of searching in the particular technical field [...]. In particular, it shall make it possible to assess whether consultation of the European patent application itself is necessary.</td>
</tr>
</tbody>
</table>
RULE 48 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 34 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as **Rule 48 EPC 2000**.
Rule 48  Prohibited matter

**Rule 34 EPC 1973**

1. The European patent application shall not contain:

   a) statements or other matter contrary to "ordre public" or morality;

   b) statements disparaging the products or processes of any particular person other than the applicant, or the merits or validity of applications or patents of any such person. Mere comparisons with the prior art shall not be considered disparaging per se;

   c) any statement or other matter obviously irrelevant or unnecessary under the circumstances.

2. If a European patent application contains prohibited matter within the meaning of paragraph 1(a), the European Patent Office shall omit it when publishing the application, indicating the place and number of words or drawings omitted.

3. If a European patent application contains statements within the meaning of paragraph 1(b), the European Patent Office may omit them when publishing the application. It shall indicate the place and number of words omitted, and shall furnish, upon request, a copy of the passages omitted.

**Rule 48 EPC 2000**

1. The European patent application shall not contain:

   a) Unchanged

   b) statements disparaging the products or processes of any third party [...] or the merits or validity of the applications or patents of any such party. Mere comparisons with the prior art shall not be considered disparaging per se;

   c) Unchanged

2. If the [...] application contains matter prohibited under paragraph 1(a), the European Patent Office may omit such matter from the application as published, indicating the place and number of words or drawings omitted.

3. If the application contains statements referred to in paragraph 1(b), the European Patent Office may omit them from the application as published, indicating the place and number of words omitted. Upon request, the European Patent Office shall furnish a copy of the passages omitted.
RULE 49 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 35 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 49 EPC 2000.

In Rule 49(10) EPC 2000, the single principle at issue – that applicants must use the nomenclature and signs generally accepted in the technical field in question – is stated in a general form.

(Explanatory remarks 2006: CA/PL 17/06)

The requirement to file three copies of the documents making up the European patent application – provided for in Rule 35(2) EPC 1973 – is no longer necessary as files are kept electronically. Rule 35(2) EPC 1973 can thus be deleted (see also Rule 36(4) EPC 1973).

Rule 35(7) EPC 1973 is deleted, as in practice text in margins – e.g. reference numbers or imprints by the fax machine – is not objected to.
### General provisions governing the presentation of the application documents

#### Rule 35 EPC 1973

(1) Translations mentioned in Article 14, paragraph 2, shall be considered to be included in the term "documents making up the European patent application".

(2) The documents making up the European patent application shall be filed in three copies. The President of the European Patent Office may, however, determine that the documents shall be filed in fewer than three copies.

(3) The documents making up the European patent application shall be so presented as to admit of electronic as well as of direct reproduction, in particular by scanning, photography, electrostatic processes, photo offset and microfilming, in an unlimited number of copies. All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used.

(4) The documents making up the European patent application shall be on A 4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable. Subject to the provisions of Rule 32, paragraph 2(h), and paragraph 11 of this Rule, each sheet shall be used with its short sides at the top and bottom (upright position).

(5) Each of the documents making up the European patent application (request, description, claims, drawings and abstract) shall commence on a new sheet. The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.

(6) Subject to Rule 32, paragraph 1, the minimum margins shall be as follows:

<table>
<thead>
<tr>
<th>Margin</th>
<th>Requirement</th>
</tr>
</thead>
<tbody>
<tr>
<td>top</td>
<td>2 cm</td>
</tr>
<tr>
<td>left side</td>
<td>2.5 cm</td>
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<tr>
<td>right side</td>
<td>2 cm</td>
</tr>
<tr>
<td>bottom</td>
<td>2 cm</td>
</tr>
</tbody>
</table>

The recommended maximum for the margins quoted above is as follows:

<table>
<thead>
<tr>
<th>Margin</th>
<th>Requirement</th>
</tr>
</thead>
<tbody>
<tr>
<td>top</td>
<td>4 cm</td>
</tr>
<tr>
<td>left side</td>
<td>4 cm</td>
</tr>
<tr>
<td>right side</td>
<td>3 cm</td>
</tr>
<tr>
<td>bottom</td>
<td>3 cm</td>
</tr>
</tbody>
</table>

(7) The margins of the documents making up the European patent application, when submitted, must be completely blank.

#### Rule 49 EPC 2000

(1) Any translation filed under Article 14, paragraph 2, or Rule 40, paragraph 3, shall be deemed to be a [...] document making up the European patent application.

(2) The documents making up the application shall be [...] presented so as to allow electronic and direct reproduction, in particular by scanning, photography, electrostatic processes, photo offset and microfilming, in an unlimited number of copies. All sheets shall be free from cracks, creases and folds. Only one side of the sheet shall be used.

(3) The documents making up the [...] application shall be on A4 paper (29.7 cm x 21 cm) which shall be pliable, strong, white, smooth, matt and durable. Subject to paragraph 10 and Rule 46, paragraph 2(h), each sheet shall be used with its short sides at the top and bottom (upright position).

(4) Each of the documents making up the [...] application (request, description, claims, drawings and abstract) shall commence on a new sheet. The sheets shall be connected in such a way that they can easily be turned over, separated and joined together again.

(5) Subject to Rule 46, paragraph 1, the minimum margins shall be as follows:

<table>
<thead>
<tr>
<th>Margin</th>
<th>Requirement</th>
</tr>
</thead>
<tbody>
<tr>
<td>top</td>
<td>2 cm</td>
</tr>
<tr>
<td>left side</td>
<td>2.5 cm</td>
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<td>2 cm</td>
</tr>
<tr>
<td>bottom</td>
<td>2 cm</td>
</tr>
</tbody>
</table>

The recommended maximum for the margins quoted above is as follows:

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<tbody>
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<td>4 cm</td>
</tr>
<tr>
<td>right side</td>
<td>3 cm</td>
</tr>
<tr>
<td>bottom</td>
<td>3 cm</td>
</tr>
</tbody>
</table>
(8) All the sheets contained in the European patent application shall be numbered in consecutive Arabic numerals. These shall be placed at the top of the sheet, in the middle, but not in the top margin.

(9) The lines of each sheet of the description and of the claims shall preferably be numbered in sets of five, the numbers appearing on the left side, to the right of the margin.

(10) The request for the grant of a European patent, the description, the claims and the abstract shall be typed or printed. Only graphic symbols and characters and chemical or mathematical formulae may, if necessary, be written by hand or drawn. The typing shall be 1 ½ spaced. All text matter shall be in characters, the capital letters of which are not less than 0.21 cm high, and shall be in a dark, indelible colour.

(11) The request for the grant of a European patent, the description, the claims and the abstract shall not contain drawings. The description, the claims and the abstract may contain chemical or mathematical formulae. The description and the abstract may contain tables. The claims may contain tables only if their subject-matter makes the use of tables desirable. Tables and chemical or mathematical formulae may be placed sideways on the sheet if they cannot be presented satisfactorily in an upright position thereon; sheets on which tables or chemical or mathematical formulae are presented sideways shall be so presented that the tops of the tables or formulae are at the left side of the sheet.

(12) Physical values shall be expressed in the units recognised in international practice, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement must also be expressed in the units recognised in international practice. For mathematical formulae the symbols in general use shall be employed. For chemical formulae the symbols, atomic weights and molecular formulae in general use shall be employed. In general, use should be made of the technical terms, signs and symbols generally accepted in the field in question.

(13) The terminology and the signs shall be consistent throughout the European patent application.

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

(6) All the sheets contained in the [...] application shall be numbered in consecutive Arabic numerals. These shall be centred at the top of the sheet, [...] but not placed in the top margin.

(9) Becomes (7) - wording unchanged.

(8) The request for grant of a European patent, the description, the claims and the abstract shall be typed or printed. Only graphic symbols and characters and chemical or mathematical formulae may, if necessary, be drawn or written by hand. The typing shall be 1 ½ spaced. All text matter shall be in characters, the capital letters of which are not less than 0.21 cm high, and shall be in a dark, indelible colour.

(10) [...] Values shall be expressed in units [...] conforming to international standards, wherever appropriate in terms of the metric system using SI units. Any data not meeting this requirement shall also be expressed in units conforming to international standards. [...] Use should be made of the technical terms, conventions, formulae, signs and symbols generally accepted in the field in question.

(13) Becomes (11) - wording unchanged.

(12) Each sheet shall be reasonably free from erasures and shall be free from alterations [...]. Non-compliance with this rule may be authorised if the authenticity of the content is not impugned and the requirements for good reproduction are not thereby jeopardised.
RULE 50 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 36 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 50 EPC 2000.

(Explanatory remarks 2006: CA/PL 17/06)

The requirement to file several copies of documents – provided for in Rule 36(4) EPC 1973 – is no longer necessary as files are kept electronically. Rule 36(4) EPC 1973 can thus be deleted.

Rule 36(5) EPC 1973 is deleted since this subject is now covered by new Rule 2 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Notice from the EPO dated 12 July 2007 concerning the availability of the EPO filing offices, Special edition No. 3, OJ EPO 2007, 5, A.2

Decision dated 12 July 2007 concerning the filing of patent applications and other documents by facsimile, Special edition No. 3, OJ EPO 2007, 7, A.3
**Rule 50** Documents filed subsequently

<table>
<thead>
<tr>
<th>Rule 36 EPC 1973</th>
<th>Rule 50 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Rules 27, 29 and 32 to 35 shall apply to documents replacing documents making up the European patent application. Rule 35, paragraphs 2 to 14, shall also apply to the translation of the claims referred to in Rule 51.</td>
<td>(1) Rules 42, 43 and 46 to 49 shall apply to documents replacing documents making up the European patent application. Rule 49, paragraphs 2 to 12, shall also apply to the translation of the claims referred to in Rule 71.</td>
</tr>
<tr>
<td>(2) All documents other than those referred to in the first sentence of paragraph 1 shall normally be typewritten or printed. There must be a margin of about 2.5 cm on the left-hand side of each page.</td>
<td>(2) All documents other than those making up the application shall generally be typewritten or printed. There shall be a margin of about 2.5 cm on the left-hand side of each page.</td>
</tr>
<tr>
<td>(3) All documents, with the exception of annexed documents, filed after filing of the European patent application must be signed. If a document has not been signed, the European Patent Office shall invite the party concerned to do so within a time limit to be laid down by that Office. If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been received.</td>
<td>(3) [...] Documents [...] filed after filing the [...] application shall be signed, with the exception of annexed documents. If a document has not been signed, the European Patent Office shall invite the party concerned to do so within a time limit to be specified. If signed in due time, the document shall retain its original date of receipt; otherwise it shall be deemed not to have been filed.</td>
</tr>
<tr>
<td>(4) Such documents as must be communicated to other persons or as relate to two or more European patent applications or European patents, must be filed in a sufficient number of copies. If the party concerned does not comply with this obligation in spite of a request by the European Patent Office, the missing copies shall be provided at the expense of the party concerned.</td>
<td>Deleted</td>
</tr>
<tr>
<td>(5) Notwithstanding paragraphs 2 to 4 the President of the European Patent Office may permit documents filed after filing of the European patent application to be transmitted to the European Patent Office by other means of communication and lay down conditions governing their use. He may, in particular, require that within a period laid down by him written confirmation be supplied reproducing the contents of documents so filed and complying with the requirements of these Implementing Regulations; if such confirmation is not supplied in due time, the documents shall be deemed not to have been received.</td>
<td>Deleted</td>
</tr>
</tbody>
</table>
CHAPTER III

RULE 51 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 37(1) and (3) EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.
It is renumbered as Rule 51 EPC 2000.

The substance of Article 86(2) EPC 1973 has been moved to new Rule 51(2) EPC 2000. The consequences of non payment of a renewal fee are laid down in Article 86(1) EPC 2000 and are therefore not repeated in the Implementing Regulations.

(Explanatory remarks 2006: CA/PL 17/06)

New Rule 51(4) EPC 2000 provides that, after a successful request for re-establishment of rights under Article 122 EPC, those renewal fees which, because of the retrospective effect of the re-establishment decision, would have become due in the time between the date on which the loss of rights has occurred and the decision re-establishing the rights of the applicant shall become due only on the date of the notification of that decision. These renewal fees can still be paid without surcharge within a period of four months after that date. If not paid within this period, Rule 51(2) EPC 2000 shall apply, i.e. the fees can still be paid with a surcharge up to the expiry of a period of six months after that date.

The new Rule 51(4) EPC 2000 changes the former practice according to which, after a first loss of rights, the renewal fees still had to be paid at the regular dates in order to avoid a second loss of rights which could occur under Article 86(3), first sentence, EPC 1973, due to the retrospective effect of the re-establishment decision.

An analogous situation exists where a petition for review is successful. New Rule 51(5) EPC 2000 likewise provides that the renewal fees, which would be due retrospectively by the effect of the decision of the Enlarged Board of Appeal, shall become due only on the date of the notification of the decision of the Enlarged Board ordering re-opening of proceedings.

(Explanatory remarks 2006: CA/PL 29/06 Add.1)

In contrast to the practice under the EPC 1973, Rule 51(4) EPC 2000 provides for the later payment of renewal fees if a European patent application is revived retroactively as a result of re-establishment of rights under Article 122 EPC. As the context will show, this provision is applicable only if the whole application has been refused or deemed to be withdrawn because the time limit was not observed. It would not be appropriate in the case of so-called partial losses of rights, since a European patent application, for which renewal fees have to be paid at regular intervals, continues to be in force even if, for example, a priority right or the designation of a State is lost. The introductory passage in Rule 51(4) EPC 2000 explicitly defines the provision's scope of application.

(In the Patent Law Committee 2006: CA/PL PV 30, points 108-110)

epi observed that Rule 51(4) and (5) EPC 2000 only apply to pending European patent applications, while re-establishment of rights under Article 122 EPC or re-opening of proceedings before the Board of Appeal under Article 112a(5) EPC can also apply to granted patents. In the absence of national legislation, problems will occur. In view of the EPO, this issue should be dealt with by national law.
Chapter III  Renewal fees

Rule 51  Payment of renewal fees

Rule 37 EPC 1973

(1) Renewal fees for the European patent application in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than one year before they fall due.

[See Article 86 EPC 1973:
(2) When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of the said date, provided that the additional fee is paid at the same time.]

(2) An additional fee shall be deemed to have been paid at the same time as the renewal fee within the meaning of Article 86, paragraph 2, if it is paid within the period laid down in that provision.

(3) Renewal fees already due in respect of an earlier application up to the date on which a European divisional application is filed must also be paid for the divisional application and fall due when the latter is filed. These fees and any renewal fee falling due within a period of four months from the filing of the divisional application may be paid without an additional fee within that period. If payment is not made in due time, the renewal fees may still be validly paid within six months of the due date, provided that the additional fee under Article 86, paragraph 2, is paid at the same time.

The EPC 1973 did not contain an equivalent provision.

Rule 51 EPC 2000

(1) A renewal fee for the European patent application in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application. Renewal fees may not be validly paid more than one year before they fall due.

(2) If a renewal fee is not paid in due time, the fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period.

(3) Renewal fees already due in respect of an earlier application at the date on which a divisional application is filed shall also be paid for the divisional application and shall be due on its filing. These fees and any renewal fee due within four months of filing the divisional application may be paid within that period without an additional fee. Paragraph 2 shall apply. [...] 

(4) If a European patent application has been refused or deemed to be withdrawn as a result of non-observance of a time limit, and if the applicant's rights are re-established under Article 122, a renewal fee

(a) which would have fallen due under paragraph 1 in the period starting on the date on which the loss of rights occurred, up to and including the date of the notification of the decision re-establishing the rights shall be due on that latter date.

This fee and any renewal fee due within four months from that latter date may still be paid within four months of that latter date without an additional fee. Paragraph 2 shall apply.
Rule 51  Payment of renewal fees

(b) which, on the date on which the loss of rights has occurred, was already due but the period provided for in paragraph 2 has not yet expired, may still be paid within six months from the date of the notification of the decision re-establishing the rights, provided that the additional fee pursuant to paragraph 2 is also paid within that period.

The EPC 1973 did not contain an equivalent provision.

(5) If the Enlarged Board of Appeal re-opens proceedings before the Board of Appeal under Article 112a, paragraph 5, second sentence, a renewal fee

(a) which would have fallen due under paragraph 1 in the period starting on the date when the decision of the Board of Appeal subject to the petition for review was taken, up to and including the date of the notification of the decision of the Enlarged Board of Appeal re-opening proceedings before the Board of Appeal, shall be due on that latter date.

This fee and any renewal fee due within four months from that latter date may still be paid within four months of that latter date without an additional fee. Paragraph 2 shall apply.

(b) which, on the day on which the decision of the Board of Appeal was taken, was already due but the period provided for in paragraph 2 has not yet expired, may still be paid within six months from the date of the notification of the decision of the Enlarged Board of Appeal re-opening proceedings before the Board of Appeal, provided that the additional fee pursuant to paragraph 2 is also paid within that period.

(4) Renewal fees shall not be payable for a new European patent application filed pursuant to Article 61, paragraph 1(b), in respect of the year in which it was actually filed and any preceding year.

(6) A renewal fee shall not be payable for a new European patent application filed under Article 61, paragraph 1(b), in respect of the year in which it was filed [...] and any preceding year.
CHAPTER IV

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rules 52 and 53 EPC 2000 set out the requirements to be met when claiming priority under Article 88(1) EPC. Rule 52 EPC 2000 deals with the declaration of priority; Rule 53 EPC 2000 concerns the priority documents.

RULE 52 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; discussion in the Patent Law Committee 2002: CA/PL PV 19, points 33)

Rule 52(1) EPC 2000 refers to a first filing in a Member of the World Trade Organization, to reflect Article 87(1) EPC 2000.

Rule 52(2) EPC 2000 provides that the complete declaration of priority – including the file number of the previous application – shall, preferably, be made on filing the application. However, in accordance with Article 13(1) and Rule 14(1) and (3) of the Patent Law Treaty of 1 June 2000 (PLT) as well as Rule 26bis PCT, a declaration of priority may also be made later, i.e. within 16 months from the priority date claimed, or, where the applicant has requested early publication of the application, until the filing of such a request. Declarations made on filing may be corrected within that period.

The new system is thus based on the principle that the declaration of priority should be made on filing the application, while allowing late claiming of priority or correction of the priority declaration within the above-mentioned 16 month period. This is a significant relaxation of the requirements as compared to Rule 38(2) EPC 1973, under which at least the date and the State of the previous application had to be indicated on filing. For the time being, it is not intended to make use of Article 13(4) PLT and prescribe that a fee be paid if priority is claimed late or a correction of the priority declaration is made.

(See also Explanatory remarks 2006: CA/PL 11/06, page 6 = CA/PL 17/06)

Rule 52(1), first sentence, EPC 2000 makes clear that the previous filing must have been made in of for a State party to the Paris Convention or Member of the World Trade Organization.

Rule 52(1), second sentence, EPC 2000 makes it clear that information as required in the first sentence is also to be given in cases where the priority claim is based on an application filed with an industrial property authority which is not subject to the Paris Convention or to the Agreement establishing the World Trade Organization but which recognises, according to a communication issued by the President of the EPO, that a first filing made with the EPO gives rise to a right of priority under conditions and with effects equivalent to those laid down in the Paris Convention.

Rule 52(2) and (3) EPC 2000 apply the time periods laid down in Rule 26bis.1(a) PCT for the addition or correction of priority claims to Euro-direct applications, with the necessary terminological adjustments, in order to avoid treating Euro-PCT and Euro-direct applications differently. For clarity’s sake, the addition of further priority claims and the correction of existing ones are dealt with separately.

(In the Patent Law Committee 2006: CA/PL PV 29, points 17-22, CA/PL PV 30, points 111-113)
Chapter IV  Priority

<table>
<thead>
<tr>
<th>Rule 52  Declaration of priority [...]</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 38(1), (2) and (6) EPC 1973</strong></td>
</tr>
<tr>
<td>(1) The declaration of priority referred to in Article 88, paragraph 1, shall state the date of the previous filing and the State in or for which it was made and shall indicate the file number.</td>
</tr>
<tr>
<td>(2) The date and State of the previous filing must be stated on filing the European patent application; the file number shall be indicated before the end of the sixteenth month after the date of priority.</td>
</tr>
<tr>
<td>(6) The particulars stated in the declaration of priority shall appear in the published European patent application and also on the European patent specification.</td>
</tr>
<tr>
<td><strong>Rule 52 EPC 2000</strong></td>
</tr>
<tr>
<td>(1) The declaration of priority referred to in Article 88, paragraph 1, shall indicate the date of the previous filing, the State party to the Paris Convention or Member of the World Trade Organization in or for which it was made and [...] the file number. In the case referred to in Article 87, paragraph 5, the first sentence shall apply mutatis mutandis.</td>
</tr>
<tr>
<td>(2) The declaration of priority shall preferably be made on filing the European patent application. It may still be made within sixteen months from the earliest priority date claimed.</td>
</tr>
<tr>
<td>(3) The applicant may correct the declaration of priority within sixteen months from the earliest priority date claimed, or, where the correction would cause a change in the earliest priority date claimed, within sixteen months from the corrected earliest priority date, whichever sixteen-month period expires first, provided that such a correction may be submitted until the expiry of four months from the date of filing accorded to the European patent application.</td>
</tr>
<tr>
<td>(4) However, a declaration of priority may not be made or corrected after a request under Article 93, paragraph 1(b), has been filed.</td>
</tr>
<tr>
<td>(5) The particulars [...] of the declaration of priority shall appear in the published European patent application and [...] the European patent specification.</td>
</tr>
</tbody>
</table>
**RULE 53 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 38(3) to (5) EPC 1973 has been brought into line with the Patent Law Treaty of 1 June 2000 (PLT) and streamlined. It is renumbered as Rule 53 EPC 2000.

**Rule 53(3) EPC 2000** reflects the requirements of Rule 4(4) PLT, to the effect that a translation of a previous application which was not filed in an official language of the EPO will no longer be required as a matter of course; instead, the applicant or, as the case may be, the patent proprietor will be invited by the EPO to file such translation only where the validity of the priority claim is relevant to determining whether the invention is patentable.

The EPO shall specify in the individual case the "period to be specified" referred to in **Rule 53(3) EPC 2000** (new Rule 132(2) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).

(In the Patent Law Committee 2002: CA/PL PV 19, points 34-36)

Discussion on the importance of priority documents in infringement proceedings: need for a provision enabling the EPO to require a translation of the priority document at the instigation of a third party?

The EPO pointed out that the intention and purpose of Rule 53 EPC 2000 was to enable the EPO to implement the patent grant procedure. In other words, priority documents are only taken into account if they are required for the purposes of assessing the patentability of an invention. This is particularly so in cases where there is relevant prior art from the priority interval. The provision cannot affect the post-grant phase, which is subject to national legislation.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 on the filing of priority documents, Special edition No. 3, OJ EPO 2007, 22, B.1

Decision dated 12 July 2007 concerning the filing of priority documents for European divisional applications and for new European patent applications under Article 61(1)(b) EPC, Special edition No. 3, OJ EPO 2007, 24, B.2

**RULE 54 EPC**

Rule 38a EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 54 EPC 2000.
### Rule 53  Priority documents

**Rule 38(3), (4) and (5) EPC 1973**

(3) The copy of the previous application must be filed before the end of the sixteenth month after the date of priority. The copy must be certified as an exact copy of the previous application by the authority which received the previous application and must be accompanied by a certificate issued by that authority stating the date of filing of the previous application.

(4) The copy of the previous application shall be deemed duly filed if a copy of that application available to the European Patent Office is to be included in the file of the European patent application under the conditions laid down by the President of the European Patent Office.

[See Article 88 EPC 1973:

(1) ... if the language of the latter [previous application] is not one of the official languages of the European Patent Office, a translation into one of such official languages.]

(5) The translation of the previous application required under Article 88, paragraph 1, must be filed within a time limit to be set by the European Patent Office, but at the latest within the time limit under Rule 51, paragraph 4. Alternatively, a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 4 shall apply mutatis mutandis.

**Rule 53 EPC 2000**

(1) An applicant claiming priority shall file a copy of the previous application within sixteen months of the earliest [...] priority date claimed. [...] This copy and the date of filing of the previous application shall be certified as correct by the authority with which that application was filed.

(2) The copy of the previous application shall be deemed to be duly filed if a copy of that application available to the European Patent Office is to be included in the file of the European patent application under the conditions determined by the President of the European Patent Office.

(3) Where the previous application is not in an official language of the European Patent Office and the validity of the priority claim is relevant to the determination of the patentability of the invention concerned, the European Patent Office shall invite the applicant for or proprietor of the European patent to file a translation of that application into one of the official languages within a period to be specified. [...] Alternatively, a declaration may be submitted that the European patent application is a complete translation of the previous application. Paragraph 2 shall apply mutatis mutandis.

### Rule 54  Issuing priority documents

**Rule 38a EPC 1973**

On request, the European Patent Office shall issue a certified copy of the European patent application (priority document) to the applicant. The President of the European Patent Office shall determine all necessary arrangements, including the form of the priority document and the circumstances in which an administrative fee is payable.

**Rule 54 EPC 2000**

On request, the European Patent Office shall issue to the applicant a certified copy of the European patent application (priority document), under the conditions determined by the President of the European Patent Office [...], including the form of the priority document and the circumstances under which an administrative fee shall be paid.
PART IV

CHAPTER I

RULE 55 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 55 EPC 2000 deals with the examination under Article 90(1) EPC 2000. The EPO has to examine whether the requirements for the accordance of a date of filing are fulfilled, and if necessary must give the applicant an opportunity to correct deficiencies pursuant to Article 90(4) EPC 2000. The two month period provided is consistent with Article 5(3) and Rule 2(1) of the Patent Law Treaty of 1 June 2000 (PLT).

(See also the discussion in the Patent Law Committee 2006: CA/PL PV 30, points 114-115)

As regards the starting point of the time period, reference is made to the general explanatory remark reproduced in Appendix 1, n° 4: "Where the Rules specify a period to be observed following an invitation or communication from the EPO, the period always starts with the notification of such communication ..."
PART IV IMPLEMENTING REGULATIONS TO PART IV OF THE CONVENTION

Chapter I Examination by the Receiving Section

Rule 55 Examination on filing

Rule 39 EPC 1973

If the European patent application fails to meet the requirements laid down in Article 80, the Receiving Section shall communicate the disclosed deficiencies to the applicant and inform him that the application will not be dealt with as a European patent application unless he remedies the disclosed deficiencies within one month. If he does so, he shall be informed of the date of filing.

Rule 55 EPC 2000

If the examination under Article 90, paragraph 1, reveals that the application fails to meet the requirements laid down in Rule 40, paragraph 1(a) or (c), paragraph 2 or paragraph 3, first sentence, the European Patent Office shall inform the applicant of any deficiencies and advise him that the application will not be dealt with as a European patent application unless such deficiencies are remedied within two months. If the applicant does this, he shall be informed of the date of filing accorded by the Office.
RULE 56 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Under Article 5(5) of the Patent Law Treaty of 1 June 2000 (PLT), the applicant must be informed if a part of the description or any drawings appear to be missing.

New Rule 56 EPC 2000 corresponds to the provisions of Article 5(6) PLT. If the applicant, either after an invitation under Rule 55 EPC 2000 or of his own motion, files a missing part of the description or drawings within two months from the filing date or the communication under Rule 56(1) EPC 2000, the application will be re-dated (Rule 56(2) EPC 2000, Rule 2(3) PLT).

If the application claims priority, and the missing part of the description or any missing drawings was contained in the priority application, that missing part of the description or drawings may, if the requirements of Rule 56(3) EPC 2000 are met, be included in the application without loss of the original date of filing (Article 5(6)(b) and Rule 2(4) PLT).

(In the Patent Law Committee 2002: CA/PL PV 19, points 37-39)

Discussion on Rule 56(1), second sentence, EPC 2000. "The applicant may not invoke the omission of such a communication". The EPO pointed out that the documents making up the application are checked for completeness, as prescribed in the PLT. However, the EPO cannot check individual applications for missing parts of the description as part of the examination on filing. This is part of the substantive examination.

(Explanatory remarks 2006: CA/PL 17/06)

Rule 56(1) EPC 2000 does not apply to parts of the drawings. If the Receiving Section notes that a part of a drawing is missing, it will treat the application, for the purpose of Rule 56 EPC 2000, as if the complete drawing were missing, and will invite the applicant to re-submit the complete drawing.

Rule 56(3) EPC 2000 contains the requirement that – for the missing parts of the description or the missing drawings to be processed under that paragraph – the applicant must indicate where those parts of the description or those missing drawings are contained in the earlier application and, where applicable, in the translation thereof. This facilitates the processing of the missing parts of the description and the missing drawings. A similar requirement is provided for in the corresponding provisions of the Regulations under the PCT (see Rule 20.6(a)(iv) PCT). In addition, the words "earlier application" is consistently used in Rule 56(3) EPC 2000 to ensure that only the case of missing parts contained in priority applications – and not in any previously filed application – is covered.
<table>
<thead>
<tr>
<th>Rule 43 EPC 1973</th>
<th>Rule 56 EPC 2000</th>
</tr>
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<tr>
<td>(1) If the examination provided for in Article 91, paragraph 1(g), reveals that the drawings were filed later than the date of filing of the European patent application, the Receiving Section shall inform the applicant that the drawings and the references to the drawings in the European patent application shall be deemed to be deleted unless the applicant requests within a period of one month that the application be re-dated to the date on which the drawings were filed.</td>
<td>(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.</td>
</tr>
<tr>
<td>(2) If the examination reveals that the drawings were not filed, the Receiving Section shall invite him to file them within one month and inform him that the application will be re-dated to the date on which they are filed, or, if they are not filed in due time, any reference to them in the application shall be deemed to be deleted.</td>
<td>(2) If missing parts of the description or missing drawings are filed later than the date of filing, but within two months of the date of filing or, if a communication is issued under paragraph 1, within two months of that communication, 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.</td>
</tr>
<tr>
<td>(3) The applicant shall be informed of any new date of filing of the application.</td>
<td>(3) If the missing parts of the description or missing drawings are filed within the period under paragraph 2, and the application claims priority of an earlier application, the date of filing shall, provided that the missing parts of the description or the missing drawings are completely contained in the earlier application, remain the date on which the requirements laid down in Rule 40, paragraph 1, were fulfilled, where the applicant so requests and files, within the period under paragraph 2:</td>
</tr>
<tr>
<td></td>
<td>(a) a copy of the earlier application, unless such copy is available to the European Patent Office under Rule 53, paragraph 2;</td>
</tr>
<tr>
<td></td>
<td>(b) where the earlier application is not in an official language of the European Patent Office, a translation thereof in one of these languages, unless such copy is available to the European Patent Office under Rule 53, paragraph 3; and</td>
</tr>
<tr>
<td></td>
<td>(c) an indication as to where the missing parts of the description or the missing drawings are completely contained in the earlier application and, where applicable, in the translation thereof.</td>
</tr>
</tbody>
</table>
In Rule 56(4) EPC 2000, it has been clarified that the period referred to in the first sentence is the period under Rule 56(1) or (2) EPC 2000. In addition, Rule 56(4) EPC 2000 lays down the legal consequence where missing parts of the description or missing drawings are not filed within the applicable period, or where the applicant has withdrawn the missing parts of the description or the missing drawings: in such cases, any references to, or the filing of, such parts or drawings shall be deemed not to have been made.

Rule 56(5) EPC 2000 lays down the legal consequences where the requirements referred to in Rule 56(3)(a) to (c) are not complied with, or where any of the said requirements is complied with but after the applicable period: in such a case, the application is re-dated to the date on which the missing parts of the description or missing drawings are filed. However, the applicant may withdraw subsequently filed parts of the description or drawings in order to retain his original filing date (Rule 56(6) EPC 2000).

(In the Patent Law Committee 2006: CA/PL PV 31, points 24-26)

Discussion on case where the description contains a reference to part of a drawing and such part is missing in the drawing: will the whole drawing be deemed not to have been filed?

The EPO pointed out that the wording "missing parts of drawings" has deliberately been avoided in Rule 56(1) EPC 2000 as the EPO does not wish to have an obligation to check whether drawings filed are complete. Such wording has not been included in other paragraphs of Rule 56 EPC 2000 either; applicants cannot file parts of drawings late as missing parts, but always have to file the complete drawing. If an application contains a reference to a complete drawing and such drawing has not been filed, then the reference will be deleted. However, this will normally not be the case with partially filed drawings, references to which will usually be allowed to remain in the document.

(See also epi's comments in CA/PL 30/06)
Rule 56  **Missing parts of the description or missing drawings**

(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.

(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.

(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.
RULE 57 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

New Rule 57 EPC 2000 concerns the formalities examination to be conducted under Article 90(3) EPC 2000 after a date of filing has been accorded. The provision incorporates the substance of Article 91(1) EPC 1973.

Claims have been introduced in Rule 57(c) EPC 2000, as these are no longer a prerequisite for the accordance of a date of filing.

(Explanatory remarks 2006: CA/PL 17/06)

Rule 57(a) EPC 2000 includes a reference to Rule 40(3), second sentence, EPC 2000 (which deals with the translation of the previously filed application). Whereas Rule 55 EPC 2000 foresees a further period of two months if the copy of the earlier application is not filed within the period under Rule 40(3), first sentence, EPC 2000, there is no provision for a late filing of the translation mentioned in Rule 40(3), second sentence, EPC 2000. If the translation is not filed, the applicant will receive an invitation under Rule 58 EPC 2000, setting a period of two months. Non-compliance will be qualified as a formal deficiency, leading to a refusal of the application under Article 90(5) EPC.

Rule 57(c) EPC 2000 equally relates to the "reference filing" under Rule 40(2) and (3) EPC 2000. In contrast to the PCT procedure, under the EPC 2000, it is no longer necessary to file claims for a date of filing to be accorded. Whether the application contains one or more claims on which the European search can be based is established in the course of the examination as to formal requirements under Article 90(3) and Rule 57 EPC 2000.

Rule 57(c) EPC 2000 makes clear that a reference to a previously filed application in accordance with Rule 40(1)(c), (2) and (3) EPC can also replace the claims. It must be emphasized that – whilst claims may be filed at a later date within the period specified in Rule 58 EPC – if they can be regarded as having been filed on the date of filing on account of the reference, there will be no need to examine whether they meet the requirement of Article 123(2) EPC.

Rule 57(i) EPC 2000 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; also the consistency of the terminology and the signs used in the application is not examined at this stage of the proceedings. (See also Explanatory remarks 2006: CA/PL 29/06 Add.1).

Rule 57(j) EPC 2000 addresses the late filing of sequence listings. Under the EPC 1973, further processing was available for the late filing of sequence listings. The availability of further processing in respect of the time periods under Rule 30(3) and 163(3) EPC 2000 is maintained by inserting new Rule 57(j) EPC 2000 specifically concerning the examination whether the requirements under Rules 30 or 163(3) EPC 2000 are fulfilled. Rule 58 EPC 2000 and the exclusion of the time period under this Rule from further processing (see Rule 135(2) EPC 2000) thus does not apply to new Rule 57(j) EPC 2000; the matter will be governed only by Rules 30 and 163(3) EPC 2000.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, points 121-122)
Rule 57  Examination as to formal requirements

EPC 1973

[See Article 91 EPC 1973:
(1) If a European patent application has been accorded a date of filing, and is not deemed to be withdrawn by virtue of Article 90, paragraph 3, the Receiving Section shall examine whether:

(d) the request for the grant of a European patent satisfies the mandatory provisions of the Implementing Regulations concerning its content and, where appropriate, whether the requirements of this Convention concerning the claim to priority have been satisfied;

(c) the abstract has been filed;

(f) the designation of the inventor has been made in accordance with Article 81;

(g) the drawings referred to in Article 78, paragraph 1(d), were filed on the date of filing of the application.

(a) the requirements of Article 133, paragraph 2, have been satisfied;]

Rule 40 EPC 1973

The physical requirements which a European patent application must satisfy pursuant to Article 91, paragraph 1(b), shall be those prescribed in Rule 27a, paragraphs 1 to 3, Rule 32, paragraphs 1 and 2, Rule 35, paragraphs 2 to 11 and 14, and Rule 36, paragraphs 2 and 4.

Rule 57 EPC 2000

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, 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 or Rule 163, paragraph 3.
RULE 58 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 58 EPC 2000 implements Article 90(4) EPC 2000, according to which the applicant must be given an opportunity to correct deficiencies of his application. With regard to deficiencies in claiming priority, a new Rule 59 EPC 2000 has been introduced.

RULE 59 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Under new Rule 59 EPC 2000, the applicant will be invited to indicate the file number of the previous application or to file a copy thereof if this has not already been done within the 16 month period under Rules 52(2) and 53(1) EPC 2000. The EPO shall specify in the individual case the "period to be specified" referred to in Rule 59 EPC 2000 (new Rule 132(2) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).

In accordance with Article 90(5) EPC 2000, the right of priority will be lost if the deficiencies noted in the invitation are not corrected within the period specified. Re-establishment of rights will be available as a legal remedy in such cases.

In the case of other deficiencies of the priority claim – e.g. no indication of the date or State of the previous application – no invitation will be issued. This corresponds to the situation under Rule 38(2) EPC 1973 in conjunction with Rule 41(2) EPC 1973 and is necessary because this information is needed for publication of the application. Thus, where the date or State of the previous application are not indicated within 16 months from the priority date, the right of priority will be lost. However, as above, re-establishment of rights will be available.
Rule 58  **Correction** of deficiencies in the application documents

**Rule 41 EPC 1973**

1. If the examination provided for in Article 91, paragraph 1(a) to (d), reveals deficiencies in the European patent application, the Receiving Section shall inform the applicant accordingly and invite him to remedy the deficiencies within such period as it shall specify. The description, claims and drawings may be amended only to an extent sufficient to remedy the disclosed deficiencies in accordance with the observations of the Receiving Section.

2. Paragraph 1 shall not apply where the applicant, while claiming priority, has omitted to indicate on filing the European patent application the date or State of first filing.

3. Paragraph 1 shall not apply where the examination reveals that the date of the first filing given on filing the European patent application precedes the date of filing of the European patent application by more than one year. In this event the Receiving Section shall inform the applicant that there will be no right of priority for the application unless, within one month, the applicant indicates a corrected date, lying within the year preceding the date of filing of the European patent application.

**Rule 58 EPC 2000**

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 [...].

**Deleted**

**Deleted**

**Rule 59  Deficiencies in claiming priority**

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 59 EPC 2000**

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.
RULE 60 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The time period in Article 91(5) EPC 1973 is taken over in Rule 60(1) EPC 2000. Instead of being deemed withdrawn, the application will be refused if no designation of the inventor is filed in due time (see Article 90(5) EPC 2000).

Rule 60(2) EPC 2000 clarifies that, also in divisional applications and applications under Article 61(1)(b) EPC, the designation of the inventor is due on filing. If the designation is not made on filing the application, the EPO will invite the applicant to make it within a period to be specified (see Rule 132 EPC 2000).

(Explanatory remarks 2006: CA/PL 17/06)

The new last part of Rule 60(1) EPC 2000 serves to give the applicant more time to provide the necessary information – provided the publication of the European patent application is not delayed.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, points 123-127)
Rule 60 Subsequent designation of the inventor

Rule 42 EPC 1973

(1) If the examination provided for in Article 91, paragraph 1(f), reveals that the inventor has not been identified in accordance with the provisions of Rule 17, the Receiving Section shall inform the applicant that the European patent application shall be deemed to be withdrawn unless this deficiency is corrected within the period prescribed by Article 91, paragraph 5.

[See Article 91 EPC 1973:
(5) Where ... the omission of the designation of the inventor is not ... corrected within 16 months after the date of filing of the European patent application or, if priority is claimed, after the date of priority, the application shall be deemed to be withdrawn.]

(2) In the case of a European divisional application or a new European patent application filed pursuant to Article 61, paragraph 1(b), the time limit for identifying the inventor may in no case expire before two months after the communication referred to in paragraph 1, which shall state the time limit.

Rule 60 EPC 2000

(1) If [...] the designation of the inventor has not been made in accordance with [...] Rule 19, the European Patent Office shall inform the applicant that the European patent application will be refused unless the designation is made within sixteen months of the date of filing of the application or, if priority is claimed, of the date of priority, this period being deemed to have been observed if the information is communicated before completion of the technical preparations for the publication of the European patent application.

(2) Where, in a [...] divisional application or a new [...] application under Article 61, paragraph 1(b), the designation of the inventor has not been made in accordance with Rule 19, the European Patent Office shall invite the applicant to make the designation within a period to be specified.
CHAPTER II

RULE 61 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The list in brackets in Rule 44(2), second sentence, EPC 1973 – containing examples of how relevant parts of the documents cited were to be identified and referred to the claims – is deleted since it is not exhaustive and there are other possibilities of identifying documents.

RULE 62 EPC

(Explanatory remarks 2006: CA/PL 11/06, page 10, CA/PL 17/06)

For European patent applications and international applications entering the European phase filed on or after 1 July 2005, the EPO draws up an extended European search report (EESR) as provided for in Rule 44a EPC 1973 which was inserted in the Implementing Regulations by Decision of the Administrative Council of 9 December 2004 (see OJ EPO 2005, 5). See also documents CA/PL 22/04 Rev. 1 and CA/138/04.

Rule 44a EPC 1973 is renumbered as Rule 62 EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 29, points 23-25)

The EPO confirmed that in the case of lack of unity, the partial search report, sent with an invitation to pay the additional fees, does not contain an opinion. If an additional fee is not paid, the partial search report is converted into the search report and is accompanied by an opinion.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, points 128-132)
Chapter II European search report

Rule 61 Content of the European search report

**Rule 44 EPC 1973**

(1) The European search report shall mention those documents, available to the European Patent Office at the time of drawing up the report, which may be taken into consideration in deciding whether the invention to which the European patent application relates is new and involves an inventive step.

(2) Each citation shall be referred to the claims to which it relates. If necessary, the relevant parts of the documents cited shall be identified (for example, by indicating the page, column and lines or the diagrams).

(3) The European search report shall distinguish between cited documents published before the date of priority claimed, between such date of priority and the date of filing, and on or after the date of filing.

(4) Any document which refers to an oral disclosure, a use or any other means of disclosure which took place prior to the date of filing of the European patent application shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.

(5) The European search report shall be drawn up in the language of the proceedings.

(6) The European search report shall contain the classification of the subject-matter of the European patent application in accordance with the international classification.

**Rule 61 EPC 2000**

(1) Unchanged

(2) Each citation shall be referred to the claims to which it relates. **Where appropriate**, relevant parts of the documents cited shall be identified [...].

(3) Unchanged

(4) Any document which refers to an oral disclosure, a use or any other means of disclosure which took place before the date of filing of the European patent application shall be mentioned in the European search report, together with an indication of the date of publication, if any, of the document and the date of the non-written disclosure.

(5) Unchanged

(6) Unchanged

Rule 62 Extended European search report

**Rule 44a EPC 1973**

(1) The European search report shall be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of this Convention, unless a communication under Rule 51, paragraph 2 or paragraph 4, can be issued.

(2) The opinion under paragraph 1 shall not be published together with the search report.

**Rule 62 EPC 2000**

(1) The European search report shall be accompanied by an opinion on whether the application and the invention to which it relates seem to meet the requirements of this Convention, unless a communication under Rule 71, paragraph 1 or 3, can be issued.

(2) Unchanged
RULE 63 EPC

Rule 45 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 63 EPC 2000.

RULE 64 EPC

Rule 46 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 64 EPC 2000.
Rule 63 Incomplete search

**Rule 45 EPC 1973**

If the Search Division considers that the European patent application does not comply with the provisions of the Convention to such an extent that it is not possible to carry out a meaningful search into the state of the art on the basis of all or some of the claims, it shall either declare that search is not possible or shall, so far as is practicable, draw up a partial European search report. The declaration and the partial report referred to shall be considered, for the purposes of subsequent proceedings, as the European search report.

**Rule 63 EPC 2000**

If the European Patent Office considers that the European patent application does not comply with this Convention to such an extent that it is impossible to carry out a meaningful search into the state of the art on the basis of all or some of the subject-matter claimed, it shall either issue a reasoned declaration to that effect or, as far as is practicable, draw up a partial search report. The declaration or the partial report [...] shall be considered, for the purposes of subsequent proceedings, as the European search report.

Rule 64 European search report where the invention lacks unity

**Rule 46 EPC 1973**

(1) If the Search Division considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial European search report on those parts of the European patent application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that if the European search report is to cover the other inventions, a further search fee must be paid, for each invention involved, within a period to be fixed by the Search Division which must not be shorter than two weeks and must not exceed six weeks. The Search Division shall draw up the European search report for those parts of the European patent application which relate to inventions in respect of which search fees have been paid.

(2) Any fee which has been paid under paragraph 1 shall be refunded if, during the examination of the European patent application by the Examining Division, the applicant requests a refund and the Examining Division finds that the communication referred to in the said paragraph was not justified.

**Rule 64 EPC 2000**

(1) If the European Patent Office considers that the European patent application does not comply with the requirement of unity of invention, it shall draw up a partial [...] search report on those parts of the [...] application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims. It shall inform the applicant that for the European search report to cover the other inventions, a further search fee must be paid, in respect of each invention involved, within [...] a period to be specified, which shall neither be shorter than two weeks nor exceed six weeks. The [...] European search report shall be drawn up for the parts of the [...] application relating to inventions in respect of which search fees have been paid.

(2) Any fee paid under paragraph 1 shall be refunded if, during the examination of the European patent application [...], the applicant requests a refund and the Examining Division finds that the communication under paragraph 1 was not justified.
RULE 65 EPC

(Explanatory remarks 2002: CA/P L 5/02 Rev. 1 Add. 1)

The wording of Article 92(2) EPC 1973 is incorporated in new Rule 65 EPC 2000.

RULE 66 EPC

Rule 47 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.
It is renumbered as Rule 66 EPC 2000.

CHAPTER III

RULE 67 EPC

Rule 48 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.
It is renumbered as Rule 67 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the completion of technical preparations for the publication of European patent applications, Special edition No. 3, OJ EPO 2007, 94, D.1
Rule 65  Transmittal of the European search report

EPC 1973

[See Article 92 EPC 1973:
(2) Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.]

Rule 65 EPC 2000

Immediately after it has been drawn up, the European search report shall be transmitted to the applicant together with copies of any cited documents.

Rule 66  Definitive content of the abstract

Rule 47 EPC 1973

(1) At the same time as drawing up the European search report, the Search Division shall determine the definitive content of the abstract.

(2) The definitive content of the abstract shall be transmitted to the applicant together with the European search report.

Rule 66 EPC 2000

[...] Upon drawing up the European search report, the European Patent Office shall determine the definitive content of the abstract and transmit it to the applicant together with the search report.

Chapter III  Publication of the European patent application

Rule 67  Technical preparations for publication

Rule 48 EPC 1973

(1) The President of the European Patent Office shall determine when the technical preparations for publication of the European patent application are to be deemed to have been completed.

(2) The European patent application shall not be published if it has been finally refused or withdrawn or deemed to be withdrawn before the termination of the technical preparations for publication.

Rule 67 EPC 2000

(1) The President of the European Patent Office shall determine when the technical preparations for publication of the European patent application are deemed to have been completed.

(2) The [...] application shall not be published if it has been finally refused or withdrawn or is deemed to be withdrawn before the termination of the technical preparations for publication.
The substance of Article 93(2) EPC 1973 is incorporated in Rule 68(1) EPC 2000, which makes it clear that the abstract is always included in the published application.

Rule 68(1) EPC 2000 provides that the publication of the European patent application shall contain the description, the claims and any drawings "as filed". To avoid any discrepancy with Article 70(2) EPC – which provides that the application in its original (non-EPO) language shall be "the application as filed" – Rule 68(1), first sentence, EPC 2000 also makes it clear that a translation of the application in the language of the proceedings is published when the documents making up the application were not filed in an official language of the EPO. This also implements Article 14(5) EPC 2000 which provides that European patent applications shall be published in the language of the proceedings.

Rule 68(4), first sentence, EPC 2000 concerns cases where a European patent application is accorded a date of filing in accordance with Rule 40(1) EPC 2000, but the claims are only filed later. Since this later filing of claims may result in extensions within the meaning of Article 123(2) EPC, the fact that the claims were only filed after the date of filing is indicated when the application is published.

The words "as filed" in Rule 68(1) EPC 2000 do not take into account possible amendments in the application documents under Rule 58 EPC 2000, missing parts added under Rule 56(3) EPC 2000 and claims added under Rule 58 EPC 2000 in combination with Rule 57(c) EPC 2000.

Late-filed missing parts are deemed part of the application as filed and will be published. It will be considered whether notice of missing parts should be given in the publication of the application.
Rule 68  Form of the publication of European patent applications and European search reports

EPC 1973

[See Article 93 EPC 1973:
(2) The publication shall contain the description, the claims and any drawings as filed and, in an annex, the European search report and the abstract, in so far as the latter are available before the termination of the technical preparations for publication. If the European search report and the abstract have not been published at the same time as the application, they shall be published separately.]

Rule 49 EPC 1973

(1) The President of the European Patent Office shall prescribe the form of the publication of the European patent application and the data which are to be included. The same shall apply where the European search report and the abstract are published separately. The President of the European Patent Office may lay down special conditions for the publication of the abstract.

(2) The designated Contracting States shall be specified in the published European patent application.

(3) If, before the termination of the technical preparations for publication of the European patent application, the claims have been amended pursuant to Rule 86, paragraph 2, the new or amended claims shall be included in the publication in addition to the original claims.

Rule 68 EPC 2000

(1) The publication of the European patent application shall contain the description, the claims and any drawings as filed, and the abstract, or, if these documents making up the application were not filed in an official language of the European Patent Office, a translation in the language of the proceedings, and, in an annex, the European search report, where it is available before the termination of the technical preparations for publication. If the search report or the abstract is not published at the same time as the application, it shall be published separately.

(2) The President of the European Patent Office shall determine the form of the publication of the application and the data [...] to be included. The same shall apply where the European search report and the abstract are published separately. [...] 

(3) The designated Contracting States shall be indicated in the published [...] application.

(4) If the patent claims were not filed on the date of filing of the application, this shall be indicated when the application is published. If, before the termination of the technical preparations for publication of the [...] application, the claims have been amended under Rule 137, paragraph 2, the new or amended claims shall be included in the publication in addition to the [...] claims as filed.
RULE 69 EPC

Rule 50 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as **Rule 69 EPC 2000**.

RULE 70 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

**Rule 70(1) EPC 2000** contains the details relating to the request for examination under Article 94(2) EPC 2000.

The substance of Article 96(1) and (3) and Rule 51(1) EPC 1973 is incorporated in **Rule 70(2) and (3) EPC 2000**.

As regards the "period to be specified" referred to in **Rule 70(2) EPC 2000**, see new Rule 132 EPC 2000.
Rule 69 Information about publication

**Rule 50 EPC 1973**

(1) The European Patent Office shall communicate to the applicant the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention in this communication to the provisions of Article 94, paragraphs 2 and 3.

(2) The applicant may not invoke the omission of the communication provided for in paragraph 1. If a later date than the date of the mention of the publication is specified in the communication, the later date shall be the decisive date as regards the time limit for filing the request for examination unless the error is apparent.

**Rule 69 EPC 2000**

(1) The European Patent Office shall inform the applicant of the date on which the European Patent Bulletin mentions the publication of the European search report and shall draw his attention [...] to Rule 70, paragraph 1, and Article 94, paragraph 2 [...] .

(2) The applicant may not invoke the omission of the communication under paragraph 1. If a later date [...] of publication is specified in the communication, that later date shall be the decisive date as regards the period for filing the request for examination, unless the error is obvious.

**Rule 70 Request for examination**

**EPC 1973**

[See Article 94 EPC 1973:](#) (2) A request for examination may be filed by the applicant up to the end of six months after the date on which the European Patent Bulletin mentions the publication of the European search report ... The request may not be withdrawn.

[See Article 96 EPC 1973:](#) (1) If the applicant for a European patent has filed the request for examination before the European search report has been transmitted to him, the European Patent Office shall invite him after the transmission of the report to indicate, within a period to be determined, whether he desires to proceed further with the European patent application.

**Rule 51 EPC 1973**

(1) In the communication under Article 96, paragraph 1, the European Patent Office shall give the applicant an opportunity to comment on the European search report and to amend, where appropriate, the description, claims and drawings.

[See Article 96 EPC 1973:](#) (3) If the applicant fails to reply in due time to any invitation under paragraph 1 ..., the application shall be deemed to be withdrawn.

**Rule 70 EPC 2000**

(1) The applicant may request examination of the European patent application up to six months after the date on which the European Patent Bulletin mentions the publication of the European search report. The request may not be withdrawn.

(2) If the request for examination has been filed before the European search report has been transmitted to the applicant, the European Patent Office shall invite the applicant to indicate, within a period to be specified, whether he wishes to proceed further with the application, and shall give him the opportunity to comment on the search report and to amend, where appropriate, the description, claims and drawings.

(3) If the applicant fails to reply in due time to the invitation under paragraph 2, the application shall be deemed to be withdrawn.
CHAPTER IV

RULE 71 EPC

(Explanatory remarks 2006: CA/PL 11/06, page 6 = CA/PL 17/06)

Rule 71(3) EPC 2000 follows the decision of the Administrative Council of 9 December 2004 (OJ EPO 2005, 8), according to which the period for paying the fees for grant and printing, as well as for filing a translation of the claims, is not extendable (see also documents CA/PL 23/04 and CA/139/04). The period – 4 months – is laid down in Rule 71(3) EPC 2000.

If in response to a communication under Rule 51(5) EPC 1973, new claims were submitted and their number exceeded the number previously on file, a legal basis for requesting additional claims fees was missing in the EPC 1973. Rule 71(6) EPC 2000 now provides a legal basis for requesting additional claims fees if, in response to a communication under Rule 71(5) EPC 2000, new claims are submitted and their number exceeds the number previously on file.

The EPO shall specify in the individual case the "period to be specified" referred to in Rule 71(1) and (5) EPC 2000. New Rule 132(1) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months.

(In the Patent Law Committee 2006: CA/PL PV 29, points 26-30; CA/PL PV 30, points 137-139)

Rule 51(4) EPC 1973, which entered into force on 1 April 2005, shortened the granting procedure. During the Rule 51(4)-phase, the examiner has been encouraged not to make substantial amendments. The recently introduced practice should be followed until more experience has been gained by both the EPO and the users. At a later stage Rule 71 EPC 2000 can be reviewed again.
Chapter IV Examination by the Examining Division

Rule 71 Examination procedure

<table>
<thead>
<tr>
<th>Rule 51 EPC 1973</th>
<th>Rule 71 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) In the communication under Article 96, paragraph 1, the European Patent Office shall give the applicant an opportunity to comment on the European search report and to amend, where appropriate, the description, claims and drawings.</td>
<td>Transferred to Rule 70(2) EPC 2000</td>
</tr>
<tr>
<td>(2) In any communication under Article 96, paragraph 2, the Examining Division shall, where appropriate, invite the applicant to correct the deficiencies noted and to amend the description, claims and drawings.</td>
<td>(1) In any communication under Article 94, paragraph 3, the Examining Division shall, where appropriate, invite the applicant to correct any deficiencies noted and to amend the description, claims and drawings within a period to be specified.</td>
</tr>
<tr>
<td>(3) Any communication under Article 96, paragraph 2, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.</td>
<td>(2) Any communication under Article 94, paragraph 3, shall contain a reasoned statement covering, where appropriate, all the grounds against the grant of the European patent.</td>
</tr>
<tr>
<td>(4) Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a non-extendable period to be specified, which may not be less than two months or more than four months. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the text intended for grant.</td>
<td>(3) Before the Examining Division decides to grant the European patent, it shall inform the applicant of the text in which it intends to grant it, and shall invite him to pay the fees for grant and printing and to file a translation of the claims in the two official languages of the European Patent Office other than the language of the proceedings within a period [... of four months. [... If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the text intended for grant.</td>
</tr>
<tr>
<td>(5) If the applicant, within the period laid down in paragraph 4, requests amendments under Rule 86, paragraph 3, or the correction of errors under Rule 88, he shall, where the claims are amended or corrected, file a translation of the claims as amended or corrected. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the grant of the patent as amended or corrected.</td>
<td>(4) If the applicant, within the period laid down in paragraph 3, requests amendments under Rule 137, paragraph 3, or the correction of errors under Rule 139, he shall, where the claims are amended or corrected, file a translation of the claims as amended or corrected. If the applicant pays the fees and files the translation within this period, he shall be deemed to have approved the grant of the patent as amended or corrected.</td>
</tr>
</tbody>
</table>
(6) If the Examining Division does not consent to an amendment or correction requested under paragraph 5, it shall, before taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the Examining Division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing, and any claims fees paid under paragraph 7, shall be refunded.

(7) If the European patent application in the text in which the Examining Division intends to grant the European patent comprises more than ten claims, the Examining Division shall invite the applicant to pay claims fees in respect of each additional claim within the period laid down in paragraph 6 unless the said fees have already been paid in accordance with Rule 31, paragraph 1.

(8) If the fees for grant and printing or the claims fees are not paid in due time or if the translation is not filed in due time, the European patent application shall be deemed to be withdrawn.

(8a) If the designation fees become due after the communication under paragraph 4 has been notified, the mention of the grant of the European patent shall not be published until the designation fees have been paid. The applicant shall be informed accordingly.

(9) If a renewal fee becomes due after the communication under paragraph 4 has been notified and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(10) The communication under paragraph 4 shall indicate the designated Contracting States which require a translation pursuant to Article 65, paragraph 1.

(11) The decision to grant the European patent shall state which text of the European patent application forms the basis for the grant of the European patent.

(5) If the Examining Division does not consent to an amendment or correction requested under paragraph 4, it shall, before taking a decision, give the applicant an opportunity to submit, within a period to be specified, his observations and any amendments considered necessary by the Examining Division, and, where the claims are amended, a translation of the claims as amended. If the applicant submits such amendments, he shall be deemed to have approved the grant of the patent as amended. If the European patent application is refused, withdrawn or deemed to be withdrawn, the fees for grant and printing, and any claims fees paid under paragraph 6, shall be refunded.

(6) If the European patent application in the text intended for grant comprises more than ten claims, the Examining Division shall invite the applicant to pay claims fees in respect of each additional claim within the period [... under paragraph 3, and, where applicable, paragraph 5, unless the said fees have already been paid under Rule 45 or Rule 162.]

(8) Becomes (7) - wording unchanged

(8) If the designation fees become due after the communication under paragraph 3 [...] the mention of the grant of the European patent shall not be published until the designation fees have been paid. The applicant shall be informed accordingly.

(9) If a renewal fee becomes due after the communication under paragraph 3 [...] and before the next possible date for publication of the mention of the grant of the European patent, the mention shall not be published until the renewal fee has been paid. The applicant shall be informed accordingly.

(10) The communication under paragraph 3 shall indicate the designated Contracting States which require a translation under Article 65, paragraph 1.

(11) The decision to grant the European patent shall state which text of the European patent application forms the basis for the decision.
RULE 72 EPC

Rule 52 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 72 EPC 2000.

CHAPTER V

RULE 73 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Instead of referring to Rules 48 and 49 EPC 1973, which were only partly applicable to the publication of the specification of the European patent, new Rule 73 EPC 2000 deals with all aspects of the publication of the specification, including its content. See also Article 98 EPC 1973.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the form of publication of European patent applications, European search reports and European patent specifications, Special edition No. 3, OJ EPO 2007, 97, D.3

Decision dated 12 July 2007 on the summary listing of references cited by the applicant in European patent applications and European patent specifications, Special edition No. 3, OJ EPO 2007, 99, D.4

RULE 74 EPC

(Explanatory remarks 2006: CA/PL 17/06)

Rule 54 EPC 1973 was amended by Decision of the Administrative Council of 9 December 2004 (OJ EPO 2005, 11), authorising the President of the EPO to prescribe the content, form and means of communication of the certificate and to determine the circumstances in which an administrative fee is payable (see also documents CA/141/04 and CA/PL 26/04 Rev. 1). The Rule is unchanged but has been renumbered as Rule 74 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the content, form and means of communication of the certificate for a European patent, Special edition No. 3, OJ EPO 2007, 95, D.2
**Rule 72** Grant of the European patent to different applicants

**Rule 52 EPC 1973**

Where different persons are entered in the Register of European Patents as applicants in respect of different Contracting States, the Examining Division shall grant the European patent for each Contracting State to the applicant or applicants registered in respect of that State.

**Rule 72 EPC 2000**

Where different persons are recorded in the European Patent Register as applicants in respect of different Contracting States, the European Patent Office shall grant the European patent for each Contracting State accordingly [...].

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**Chapter V** The European patent specification

**Rule 73** [...] Content and form of the specification [...]

**Rule 53 EPC 1973**

Rules 48 and 49, paragraphs 1 and 2, shall apply mutatis mutandis to the specification of the European patent. The specification shall also contain an indication of the time limit for opposing the European patent.

[See Article 98 EPC 1973: At the same time as it publishes the mention of the grant of the European patent, the European Patent Office shall publish a specification of the European patent containing the description, the claims and any drawings.]

**Rule 73 EPC 2000**

(1) The specification of the European patent shall include the description, the claims and any drawings. It shall also indicate the period for opposing the European patent.

(2) The President of the European Patent Office shall determine the form of the publication of the specification and the data to be included.

(3) The designated Contracting States shall be indicated in the specification.

---

**Rule 74** Certificate for a European patent

**Rule 54 EPC 1973**

As soon as the specification of the European patent has been published, the European Patent Office shall issue to the proprietor of the patent a certificate for a European patent. The President of the European Patent Office shall prescribe the content, form and means of communication of the certificate and determine the circumstances in which an administrative fee is payable.

**Rule 74 EPC 2000**

Unchanged
PART V

CHAPTER I

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Provisions dealing with limitation proceedings have been incorporated in Part V of the Implementing Regulations which has been divided into two chapters:

Chapter I is dealing with the opposition procedure.

Chapter II is dealing with the limitation procedure.

The new Rules have been streamlined and brought into line with the EPC 2000.

RULE 75 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

New Rule 75 EPC 2000 is taken over from Article 99(3) EPC 1973. The original wording "for all the designated States" would be appropriate if, for example, a centralised procedure existed for surrendering European patents. The amended wording "in all the designated States" is more in keeping with the idea of the European "bundle" patent.

Rule 76 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 76(1) EPC 2000 incorporates Article 99(1), second sentence, EPC 1973. The heading is amended accordingly.

(In the Patent Law Committee 2002: CA/PL PV 19, points 42-43)

The term "written" in Rule 76(1) EPC 2000 excludes the filing of oppositions orally – but not electronic filing.

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1; discussion in the Patent Law Committee 2006: CA/PL PV 30, points 140-142)

The reference in Rule 76(3) EPC 2000 to Part III of the Implementing Regulations (which relates to the European patent application) clarifies that Part III shall apply mutatis mutandis to formal requirements concerning the notice of opposition. Indeed, several provisions in Part III of the Implementing Regulations can play an important role in opposition proceedings. Ample references would be needed to ensure comprehensive coverage.
PART V  IMPLEMENTING REGULATIONS TO PART V OF THE CONVENTION

Chapter I  Opposition procedure

Rule 75  Surrender or lapse of the patent

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 75 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>[See Article 99 EPC 1973: (3) An opposition may be filed even if the European patent has been surrendered or has lapsed for all the designated States.]</td>
<td>An opposition may be filed even if the European patent has been surrendered in all the designated Contracting States or has lapsed in all those States.</td>
</tr>
</tbody>
</table>

Rule 76  Form and content of the [... ] opposition

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 76 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>[See Article 99 EPC 1973: (1) ... Notice of opposition shall be filed in a written reasoned statement.]</td>
<td>(1) Notice of opposition shall be filed in a written reasoned statement.</td>
</tr>
</tbody>
</table>

Rule 55 EPC 1973

The notice of opposition shall contain:

(a) the name and address of the opponent and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 26, paragraph 2(c);

(b) the number of the European patent against which opposition is filed, and the name of the proprietor and title of the invention;

(c) a statement of the extent to which the European patent is opposed and of the grounds on which the opposition is based as well as an indication of the facts, evidence and arguments presented in support of these grounds;

(d) if the opponent has appointed a representative, his name and the address of his place of business, in accordance with the provisions of Rule 26, paragraph 2(c).

(3) Part III of the Implementing Regulations shall apply mutatis mutandis to the notice of opposition.
RULE 77 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 56 EPC 1973 has been brought into line with the style of the EPC 2000. It is renumbered as Rule 77 EPC 2000.

The EPO shall specify in the individual case the "period to be specified" referred to in Rule 77(2) EPC 2000. New Rule 132(1) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months.

The reference to Rule 1(1) EPC 1973 in Rule 56(1) EPC 1973 has been deleted, as it was incorrect: if a notice of opposition was filed in a language other than an official language of the EPO and the required translation (Rule 1(1) EPC 1973) was not filed in due time, the notice of opposition was deemed not to have been filed (Article 14(4) EPC 2000). See also Rule 101(1) EPC 2000 dealing with the rejection of the appeal as inadmissible.
### Rule 77 Rejection of the [...] opposition as inadmissible

#### Rule 56 EPC 1973

1. If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 99, paragraph 1, Rule 1, paragraph 1, and Rule 55, sub-paragraph (c), or does not provide sufficient identification of the patent against which opposition has been filed, it shall reject the notice of opposition as inadmissible unless these deficiencies have been remedied before expiry of the opposition period.

2. If the Opposition Division notes that the notice of opposition does not comply with provisions other than those mentioned in paragraph 1, it shall communicate this to the opponent and shall invite him to remedy the deficiencies noted within such period as it may specify. If the notice of opposition is not corrected in good time the Opposition Division shall reject it as inadmissible.

3. Any decision to reject a notice of opposition as inadmissible shall be communicated to the proprietor of the patent, together with a copy of the notice.

#### Rule 77 EPC 2000

1. If the Opposition Division notes that the notice of opposition does not comply with the provisions of Article 99, paragraph 1, [...] or Rule 76, paragraph 2(c), or does not sufficiently identify the patent against which opposition has been filed, it shall reject the [...] opposition as inadmissible, unless these deficiencies have been remedied before expiry of the opposition period.

2. If the Opposition Division notes that the notice of opposition does not comply with provisions other than those referred to in paragraph 1, it shall communicate this to the opponent and shall invite him to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Opposition Division shall reject the opposition as inadmissible.

3. The decision to reject an opposition as inadmissible shall be communicated to the proprietor of the patent, together with a copy of the notice of opposition.
RULE 78 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rules 13(4) and 16(3) EPC 1973 – originally included in Part II, Chapter I of the Implementing Regulations – dealt with the procedure to be followed where either the applicant or the proprietor of a patent was not entitled to file the application or obtain the patent.

The remedies under Article 61(1) EPC 1973 – where the applicant is a non-entitled person – are subject to the requirement that the patent has not yet been granted. This condition has been moved from Article 61(1) EPC 1973 to the new Rule 16(1)(b) EPC 2000.

On the other hand, Rule 13(4) EPC 1973 provided for a stay of proceedings during the opposition procedure where a third party provided evidence that he was challenging the patent proprietor’s entitlement before a national court. Likewise, Rule 16(3) EPC 1973 applied to the partial transfer of the right to a patent by virtue of a final decision.

To make the structure of the Implementing Regulations clearer, the provision concerning an applicant who is not entitled is separated from the provision applying to a patent proprietor who is not entitled. Accordingly, the substance of Rules 13(4) and 16(3) EPC 1973 has been moved to new Rule 78 EPC 2000 inserted in Part V of the Implementing Regulations which governs the opposition procedure.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, points 143, CA/PL PV 31, point 13 and Annex 2, page 29)

Reference to Rule 14(4) EPC 2000 which concerns time periods interrupted by a stay of proceedings. The change details the legal consequences of a stay of opposition proceedings.
### Rule 78  Procedure where the proprietor of the patent is not entitled

#### Rule 13 EPC 1973

(4) If a third party provides proof to the European Patent Office during opposition proceedings or during the opposition period that he has opened proceedings against the proprietor of the European patent for the purpose of seeking a judgment that he is entitled to the European patent, the European Patent Office shall stay the opposition proceedings unless the third party consents to the continuation of such proceedings. Such comment must be communicated in writing to the European Patent Office; it shall be irrevocable. However, the suspension of the proceedings may not be ordered until the Opposition Division has deemed the opposition admissible. Paragraphs 2 and 3 shall apply mutatis mutandis.

#### Rule 16 EPC 1973

(3) Where a third party has, in accordance with Article 99, paragraph 5, replaced the previous proprietor for one or some of the designated Contracting States, the patent as maintained in opposition proceedings may contain for these States claims, a description and drawings which are different from those for the other designated Contracting States.

#### Rule 78 EPC 2000

(1) If a third party provides evidence, during opposition proceedings or during the opposition period, that he has instituted proceedings against the proprietor of the European patent [...] seeking a decision within the meaning of Article 61, paragraph 1, [...] opposition proceedings shall be stayed unless the third party communicates to the European Patent Office in writing his consent to the continuation of such proceedings. Such consent [...] shall be irrevocable. However, [...] proceedings shall not be stayed until the Opposition Division has deemed the opposition admissible. Rule 14, paragraphs 2 to 4, shall apply mutatis mutandis.

(2) Where a third party has, in accordance with Article 99, paragraph 4, replaced the previous proprietor for one or some of the designated Contracting States, the patent as maintained in opposition proceedings may, for these States, contain claims, a description and drawings [...] different from those for the other designated [...] States.
RULE 79 EPC

(Explanatory remarks 2002: CA/P L 5/02 Rev. 1 Add. 1)

Rule 57 EPC 1973 has been brought into line with the style of the EPC 2000. It is renumbered as Rule 79 EPC 2000.

The EPO shall specify in the individual case the "period to be specified" referred to in Rule 79(2) and (3) EPC 2000. New Rule 132(1) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months.

RULE 80 EPC

(Explanatory remarks 2002: CA/P L 5/02 Rev. 1 Add. 1)

Rule 57a EPC 1973 has been brought into line with the style of the EPC 2000. It is renumbered as Rule 80 EPC 2000.
Rule 79  Preparation of the examination of the opposition

Rule 57 EPC 1973

(1) The Opposition Division shall communicate the opposition to the proprietor of the patent and shall invite him to file his observations and to file amendments, where appropriate, to the description, claims and drawings within a period to be fixed by the Opposition Division.

(2) If several notices of opposition have been filed, the Opposition Division shall communicate them to the other opponents at the same time as the communication provided for under paragraph 1.

(3) The observations and any amendments filed by the proprietor of the patent shall be communicated to the other parties concerned who shall be invited by the Opposition Division, if it considers it expedient, to reply within a period to be fixed by the Opposition Division.

(4) In the case of a notice of intervention in opposition proceedings the Opposition Division may dispense with the application of paragraphs 1 to 3.

Rule 79 EPC 2000

(1) The Opposition Division shall communicate the notice of opposition to the proprietor of the patent and shall give him the opportunity to file his observations and to [...] amend, where appropriate, the description, claims and drawings within a period to be specified [...].

(2) If several notices of opposition have been filed, the Opposition Division shall communicate them to the other opponents at the same time as the communication [...] under paragraph 1.

(3) The Opposition Division shall communicate any observations and [...] amendments filed by the proprietor of the patent [...] to the other parties [...] and shall invite them, if it considers this expedient, to reply within a period to be specified [...].

(4) In the case of an [...] intervention under Article 105, the Opposition Division may dispense with the application of paragraphs 1 to 3.

Rule 80  Amendment of the European patent

Rule 57a EPC 1973

Without prejudice to Rule 87, the description, claims and drawings may be amended, provided that the amendments are occasioned by grounds for opposition specified in Article 100, even if the respective ground has not been invoked by the opponent.

Rule 80 EPC 2000

Without prejudice to Rule 138, the description, claims and drawings may be amended, provided that the amendments are occasioned by a ground for opposition under Article 100, even if that ground has not been invoked by the opponent.
RULE 81 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 81(1) EPC 2000 incorporates the principles established by the Enlarged Board of Appeal regarding the examination of grounds for opposition by the Opposition Division (see G10/91, OJ EPO 1993, 420).

Rule 58(1) to (3) EPC 1973 have been brought into line with the style of the EPC 2000 and incorporated in Rule 81(2) and (3) EPC 2000.

(See also discussion in the Patent Law Committee 2002: CA/PL PV 19, points 44-45)

(Explanatory remarks 2006: CA/PL 17/06)

Rule 81(2), second sentence, EPC 2000 has been inserted to be consistent with Rule 79(1) and (3) EPC 2000 which provide for invitations to reply "within a period to be specified". The EPO shall specify the period in the individual case (new Rule 132(1) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).
<table>
<thead>
<tr>
<th>Rule 81 Examination of opposition</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>EPC 1973</strong></td>
</tr>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
</tr>
</tbody>
</table>

**Rule 58(1) to (3) EPC 1973**

(1) All communications issued pursuant to Article 101, paragraph 2, and all replies thereto shall be communicated to all parties.

(2) In any communication to the proprietor of the European patent pursuant to Article 101, paragraph 2, he shall, where appropriate, be invited to file, where necessary, the description, claims and drawings in amended form.

(3) Where necessary, any communication to the proprietor of the European patent pursuant to Article 101, paragraph 2, shall contain a reasoned statement. Where appropriate, this statement shall cover all the grounds against the maintenance of the European patent.

**Rule 81 EPC 2000**

(1) The Opposition Division shall examine those grounds for opposition which are invoked in the opponent's statement under Rule 76, paragraph 2(c). Grounds for opposition not invoked by the opponent may be examined by the Opposition Division of its own motion if they would prejudice the maintenance of the European patent.

(2) In any communication under Article 101, paragraph 1, second sentence, and all replies thereto shall be sent to all parties. If the Opposition Division considers this expedient, it shall invite the parties to reply within a period to be specified.

(3) In any communication under Article 101, paragraph 1, second sentence, the proprietor of the European patent shall, where necessary, be given the opportunity to amend, where appropriate, the description, claims and drawings [...]. Where necessary, the communication shall contain a reasoned statement covering [... the grounds against the maintenance of the European patent.}
RULE 82 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 58(4) to (8) EPC 1973 has been transferred to **new Rule 82 EPC 2000**, which concerns only the maintenance of the European patent in amended form.

The legal consequences of failure to pay the fee or file the translation in due time are set out in **Rule 82(3) EPC 2000**. The amounts of the fee and surcharge are laid down in Article 2, items 8 and 9, of the Rules relating to Fees (EUR 55 and 100 EUR).

(Explanatory remarks 2006: CA/PL 17/06)

**Rule 82(2), second sentence, EPC 2000** specifies that the applicant has three months to pay the printing fee and to file the translation of the amended claims. The legal situation under Rule 58(5) EPC 1973 is thus maintained.

**Under Rule 82(3) EPC 2000**, if the applicant does not perform these acts in due time, they may still be validly performed within two months of a communication pointing out the failure to observe this time limit.

RULE 83 EPC

(Explanatory remarks 2006: CA/PL 29/06 Add.1)

In opposition proceedings, it will no longer be necessary or desirable that documents be filed in two copies, since duplicate filings merely inflate the electronic dossier. The EPO makes the required number of copies for all the parties.
### Rule 82  
**Maintenance of the European patent in amended form**

#### Rule 58(4) to (8) EPC 1973

(4) Before the Opposition Division decides on the maintenance of the European patent in the amended form, it shall inform the parties that it intends to maintain the patent as amended and shall invite them to state their observations within a period of two months if they disapprove of the text in which it is intended to maintain the patent.

(5) If disapproval of the text communicated by the Opposition Division is expressed, examination of the opposition may be continued; otherwise, the Opposition Division shall, on expiry of the period referred to in paragraph 4, request the proprietor of the patent to pay, within three months, the fee for the printing of a new specification of the European patent and to file a translation of any amended claims in the two official languages of the European Patent Office other than the language of the proceedings.

(7) The communication of the Opposition Division under paragraph 5 shall indicate the designated Contracting States which require a translation pursuant to Article 65, paragraph 1.

(6) If the acts requested under paragraph 5 are not performed in due time they may still be validly performed within two months of notification of the failure to observe the time limit, provided that within this two-month period a surcharge equal to twice the fee for printing a new specification of the European patent is paid.

(8) The decision to maintain the European patent as amended shall state which text of the European patent forms the basis for the maintenance thereof.

#### Rule 82 EPC 2000

(1) Before the Opposition Division decides to maintain the European patent as [...] amended [...], it shall inform the parties of the text in which it intends to maintain the patent [...], and shall invite them to file their observations within two months if they disapprove of that text [...].

(2) If a party disapproves of the text communicated by the Opposition Division [...], examination of the opposition may be continued. Otherwise, the Opposition Division shall, on expiry of the period under paragraph 1, invite the proprietor of the patent to pay the prescribed fee [...] and to file a translation of any amended claims in the [...] official languages of the European Patent Office other than the language of the proceedings, within a period of three months. This invitation [...] shall indicate the designated Contracting States which require a translation under Article 65, paragraph 1.

(3) If the acts required under paragraph 2 are not performed in due time, they may still be [...] performed within two months of [...] a communication concerning the failure to observe the time limit [...], provided that a surcharge [...] is paid within this [...] period. Otherwise, the patent shall be revoked.

(4) The decision to maintain the European patent as amended shall state which text of the [...] patent forms the basis for the decision.

### Rule 83  
**Request for documents**

#### Rule 59 EPC 1973

Documents referred to by a party to opposition proceedings shall be filed together with the notice of opposition or the written submissions in two copies. If such documents are neither enclosed nor filed in due time upon invitation by the European Patent Office, it may decide not to take into account any arguments based on them.

#### Rule 83 EPC 2000

Documents referred to by a party to opposition proceedings shall be filed together with the notice of opposition or the written submissions [...]. If such documents are neither enclosed nor filed in due time upon invitation by the European Patent Office, it may decide not to take into account any arguments based on them.
RULE 84 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 60(1) EPC 1973 has been brought into line with the style of the EPC 2000. The Rule is renumbered as Rule 84 EPC 2000.

RULE 85 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 61 EPC 1973 has been brought into line with the style of the EPC 2000. It is renumbered as Rule 85 EPC 2000.

RULE 86 EPC

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1; discussion in the Patent Law Committee 2006: CA/PL PV 30, points 140-142)

The reference in Rule 86 EPC 2000 has been broadened.

The provisions in Part III of the Implementing Regulations (which relates to the European patent application) are to be applied mutatis mutandis to formal requirements relating to documents filed in opposition, limitation, revocation, appeal and review proceedings. Indeed, several provisions in Part III can play an important role in these proceedings. Ample references would be needed to ensure comprehensive coverage.
### Rule 84  Continuation of the opposition proceedings by the European Patent Office of its own motion

**Rule 60 EPC 1973**

(1) If the European patent has been surrendered or has lapsed for all the designated States, the opposition proceedings may be continued at the request of the opponent filed within two months as from a notification by the European Patent Office of the surrender or lapse.

(2) In the event of the death or legal incapacity of an opponent, the opposition proceedings may be continued by the European Patent Office of its own motion, even without the participation of the heirs or legal representatives. The same shall apply when the opposition is withdrawn.

**Rule 84 EPC 2000**

(1) If the European patent has been surrendered in all the designated Contracting States or has lapsed in all those States, the opposition proceedings may be continued at the request of the opponent filed within two months of a communication from the European Patent Office informing him of the surrender or lapse.

(2) Unchanged

### Rule 85  Transfer of the European patent

**Rule 61 EPC 1973**

Rule 20 shall apply mutatis mutandis to any transfer of the European patent made during the opposition period or during opposition proceedings.

**Rule 85 EPC 2000**

Rule 22 shall apply [... ] to any transfer of the European patent made during the opposition period or during opposition proceedings.

### Rule 86  Documents in opposition proceedings

**Rule 61a EPC 1973**

Part III, Chapter II, of the Implementing Regulations shall apply mutatis mutandis to documents filed in opposition proceedings.

**Rule 86 EPC 2000**

Part III [... ] of the Implementing Regulations shall apply mutatis mutandis to documents filed in opposition proceedings.
RULE 87 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 62 EPC 1973 has been redrafted to correspond to Rule 73(1) EPC 2000. It is renumbered as Rule 87 EPC 2000.

A reference to Rule 74 EPC 2000 is included so as to make Rule 62a EPC 1973 (which related to the new certificate for a European patent) redundant. The latter provision is deleted.

RULE 88 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The details of decisions on the apportionment of costs and the procedure for fixing costs are grouped together in Rule 88 EPC 2000.

Rule 88(1) and (2) EPC 2000 are unchanged in substance as compared to Rule 63(1) and (4) EPC 1973.

Rule 88(2), first sentence, EPC 2000 is taken from Article 104(2), first sentence, EPC 1973, and incorporates, as before, the principle that costs may only be fixed on the basis of a final decision apportioning them.


RULE 89 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)


The insertion in Rule 89(2) EPC 2000 of the reference to Rule 76 EPC 2000 makes it clear that, on filing the notice of intervention, particulars corresponding to those in the notice of opposition must be given.

(Explanatory remarks 2006: CA/PL 17/06)

According to Article 105(2) EPC 2000, an admissible intervention shall be treated as an opposition. For the admissibility of the intervention, the Rules governing opposition – in particular Rules 76 and 77 EPC 2000 – shall equally apply to interventions.

Rule 89(2) EPC 2000 therefore refers also to Rule 77 EPC 2000 in order to expressly refer to the legal consequence of non-admissibility of the intervention.

**Rule 62a EPC 1973** "New certificate for a European patent" has been deleted in view of the references in Rule 87, second sentence, EPC 2000.
Rule 87  **Content and form of the new specification of the European patent [...]**

**Rule 62 EPC 1973**
Rule 49, paragraphs 1 and 2, shall apply mutatis mutandis to the new specification of the European patent.

**Rule 87 EPC 2000**
The new specification of the European patent shall include the description, claims and drawings as amended. Rule 73, paragraphs 2 and 3, and Rule 74 shall apply.

Rule 88  **Costs**

**Rule 63 EPC 1973**
(1) Apportionment of costs shall be dealt with in the decision on the opposition. Such apportionment shall only take into consideration the expenses necessary to assure proper protection of the rights involved. The costs shall include the remuneration of the representatives of the parties.

(2) A bill of costs, with supporting evidence, shall be attached to the request for the fixing of costs. The request shall only be admissible if the decision in respect of which the fixing of costs is required has become final. Costs may be fixed once their credibility is established.

(3) The request for a decision by the Opposition Division on the awarding of costs by the registry, stating the reasons on which it is based, must be filed in writing to the European Patent Office within one month after the date of notification of the awarding of costs. It shall not be deemed to be filed until the fee for the awarding of costs has been paid.

(4) The Opposition Division shall take a decision on the request referred to in paragraph 3 without oral proceedings.

**Rule 88 EPC 2000**
(1) The apportionment of costs shall be dealt with in the decision on the opposition. Such apportionment shall only take into consideration the expenses necessary to assure proper protection of the rights involved. The costs shall include the remuneration of the representatives of the parties.

(2) The Opposition Division shall, on request, fix the amount of costs to be paid under a final decision apportioning them. A bill of costs, with supporting evidence, shall be attached to the request [...]. Costs may be fixed once their credibility is established.

(3) A request for a decision by the Opposition Division may be filed [...] within one month [...] of the communication on the fixing of costs under paragraph 2. The request shall be filed in writing [...] and state the grounds on which it is based. It shall not be deemed to be filed until the prescribed fee [...] has been paid.

(4) The Opposition Division shall decide on the request under paragraph 3 without oral proceedings.

Rule 89  **Intervention of the assumed infringer**

**EPC 1973**
[See Article 105 EPC 1973:]
(1) ... if he gives notice of intervention within three months of the date on which the infringement proceedings were instituted. ...

(2) Notice of intervention shall be filed in a written reasoned statement. It shall not be deemed to have been filed until the opposition fee has been paid. ...

**Rule 89 EPC 2000**
(1) Notice of intervention shall be filed within three months of the date on which proceedings referred to in Article 105 are instituted.

(2) Notice of intervention shall be filed in a written reasoned statement; Rules 76 and 77 shall apply mutatis mutandis. The notice of intervention shall not be deemed to have been filed until the opposition fee has been paid.
CHAPTER II

Limitation procedure

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rules 90 to 96 EPC 2000, in the new Chapter II of Part V of the Implementing Regulations, contain the provisions governing the details of the limitation procedure (Articles 105a, 105b and 105c EPC 2000). As indicated in the explanatory remarks to these Articles, the limitation procedure is designed as an ex parte procedure which does not provide for the participation of third parties. However, third parties may present observations under Article 115 EPC 2000.

Rule 90 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 90 EPC 2000 defines the subject of the centralised limitation or revocation procedure before the EPO. The provision makes it explicit that only the European patent as granted or amended by the EPO is to be the subject of such proceedings.

Rule 91 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 91 EPC 2000 assigns the new tasks to the Examining Divisions. This is expedient because of the nature of the issues, i.e. amendment of the claims, in an ex parte procedure which essentially involves assessing technical questions concerning the drafting of the claims. As regards the composition and work of the Examining Division in limitation proceedings, Article 18(2) EPC 2000 is to apply mutatis mutandis.

Responsibility needs to be assigned expressly to the Examining Divisions, because such responsibility is only implied indirectly in Article 21(3)(a) EPC 2000. For reasons of legal coherence and transparency, it is better to establish the competence of the Examining Divisions in the Implementing Regulations than to allocate such duties by decision of the President under Rule 11(2) EPC 2000.

(In the Patent Law Committee 2002: CA/PL PV 19, points 48-49)

Should the same examiners deal with limitation proceedings in the case where a European patent has been the subject of opposition proceedings (for reasons of efficiency)? No, limitation proceedings are ex parte proceedings and may take place long time after grant of the European patent.
## Chapter II  Procedure for limitation or revocation

### Rule 90  Subject of proceedings

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 90 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>The subject of limitation or revocation proceedings under Article 105a shall be the European patent as granted or as amended in opposition or limitation proceedings before the European Patent Office.</td>
</tr>
</tbody>
</table>

### Rule 91  Responsibility for proceedings

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 91 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>Decisions on requests for limitation or revocation of the European patent under Article 105a shall be taken by the Examining Division. Article 18, paragraph 2, shall apply mutatis mutandis.</td>
</tr>
</tbody>
</table>
RULE 92 EPC

(Explanatory remarks 2002: CA/P L 5/02 Rev. 1 Add. 1; discussion in the Patent Law Committee 2002: CA/P L PV 19, points 50-51)

Rule 92 EPC 2000 sets out the details of the requirements to be met by a request for limitation or revocation of a European patent.

Rule 92(1) EPC 2000 provides that the request shall be filed in writing. The request must indicate whether limitation or revocation is sought. Under Article 105a(1) EPC 2000, the request is only deemed to be filed when the limitation or revocation fee has been paid. The amounts of the fees are laid down in Article 2, item 10a, of the Rules relating to Fees (request for limitation: EUR 1000; request for revocation: EUR 450). The request does not have to be accompanied by a statement of reasons, but this can be expedient where, for example, the requester's entitlement or the limiting effect of the requested amendment of the claims are not unambiguously apparent from the request documents.

Rule 92(2) EPC 2000 specifies the information and the documents which the request must contain. Sub-paragraphs (a), (b) and (e) deal with the identification of the requester and, where appropriate, the representative, as well as the patent to which the request relates (see the corresponding provisions in Rule 76 EPC 2000 which relates to the notice of opposition).

Rule 92(2)(c) EPC 2000 refers to the cases in which the requester is not the patent proprietor for all the Contracting States in which the European patent has become valid (i.e. granted, validated and not revoked). In these cases, he must indicate the further patent proprietors concerned and show that he is entitled to act on their behalf in the limitation or revocation proceedings. In view of the ab initio-effect of limitation and revocation under Article 68 EPC 2000, this requirement also applies to patent proprietors in States where the European patent has already expired.

Limitation of the European patent under Article 105a(1) EPC 2000 is only possible by an amendment of the claims. Rule 92(2)(d) EPC 2000 prescribes accordingly that the request must contain the complete text of the amended claims. A separate set of claims for a particular Contracting State may also be presented under Rule 138 EPC 2000 which deals with different claims, description and drawings for different States.

The filing of a description modified in accordance with the amended text of the claims is not prescribed, since the text granted will normally support the claims as amended. If the requester nevertheless wishes to amend the description, he may do so, appending the amended version to his request. The same applies in respect of the drawings.

In accordance with Rule 3(2) EPC 2000, the text of the amended claims and, where appropriate, of the description must be filed in the language of the proceedings in which the patent was granted.

(Explanatory remarks 2006: CA/P L 17/06)

Rule 92(1), second sentence, EPC 2000 clarifies that also in limitation and revocation proceedings the provisions of Part III of the Implementing Regulations (which relate to the European patent application) shall apply mutatis mutandis (see also explanatory remarks to Rules 76(3) and 86 EPC 2000).
## Rule 92  Requirements of the request

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 92 EPC 2000**

1. The request for limitation or revocation of a European patent shall be filed in writing. Part III of the Implementing Regulations shall apply mutatis mutandis to documents filed in limitation or revocation proceedings.

2. The request shall contain:
   
   a. particulars of the proprietor of the European patent making the request (the requester) as provided in Rule 41, paragraph 2(c), and an indication of the Contracting States for which the requester is the proprietor of the patent;
   
   b. the number of the patent whose limitation or revocation is requested, and a list of the Contracting States in which the patent has taken effect;
   
   c. where appropriate, the names and addresses of the proprietors of the patent for those Contracting States in which the requester is not the proprietor of the patent, and evidence that the requester is entitled to act on their behalf in the proceedings;
   
   d. where limitation of the patent is requested, the complete version of the amended claims and, as the case may be, of the amended description and drawings;
   
   e. where the requester has appointed a representative, particulars as provided in Rule 41, paragraph 2(d).
RULE 93 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 93 EPC 2000 deals with the relationship between limitation and opposition proceedings.

Rule 93(1) EPC 2000 governs the situation where, at the time of filing the request for limitation or revocation, opposition proceedings relating to the patent are pending (Article 105a(2) EPC 2000). In such a case, the request will be deemed not to have been filed and reimbursement of the fee for limitation or revocation will be ordered.

Rule 93(2) EPC 2000 provides that limitation proceedings already pending at the time of filing an opposition to the European patent for which limitation is requested are to be terminated by the EPO of its own motion. Reimbursement of the limitation fee will be ordered in such cases.

This complies with the principle of the precedence of opposition proceedings, as laid down in Article 105a(2) EPC 2000, and takes account of the fact that the requester in these cases has the option of resorting to the opposition procedure for prosecuting his interests.

(In the Patent Law Committee 2002: CA/PL PV 19, points 52-53)

Rule 93(2) EPC 2000 does not apply if revocation of the patent has been requested. Opposition proceedings only take precedence when the patent proprietor is seeking to limit the patent. Should the patent proprietor wish to abandon the patent completely, precedence is given to the simpler proceedings – which will lead to revocation of the patent.

(Explanatory remarks 2006: CA/PL 17/06)

Rule 93(2), first sentence, EPC 2000 explicitly refers to the reimbursement of the limitation fee. If however, at the time of the termination of the limitation proceedings, the fee referred to in Rule 95(3), first sentence, EPC 2000, has already been paid, Rule 93(2), second sentence, EPC 2000 provides for its reimbursement.

RULE 94 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 94 EPC 2000 concerns the examination as to admissibility of requests under Article 105a EPC 2000. The question of admissibility is only to be considered where the request for revocation or limitation is not to be dealt with under Rule 93 EPC 2000 and where it has been validly filed, i.e. when the relevant fee under Article 105a(1) EPC 2000 has been paid and the general requirements for the validity of procedural acts before the EPO have been fulfilled (e.g. Rules 3(1) and 50(3) EPC 2000). If this is not the case, the formalities officer will inform the requester that a valid request has not been filed, and state why this is so.

The provision is modelled on Rule 77 EPC 2000, applying to opposition proceedings, and provides that requests for limitation or revocation of the European patent are to be rejected as inadmissible if the requirements of Rule 92 EPC 2000 are not fulfilled, or are not fulfilled within the period specified in the invitation to remedy the deficiencies.

Examination and decisions as to admissibility are the responsibility of the formalities officer. The details of this are laid down on the basis of Rule 11(3) EPC 2000, authorising the President to entrust duties to employees who are not technically or legally qualified examiners.
Rule 93  **Precedence of opposition proceedings**

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 93 EPC 2000**

(1) The request for limitation or revocation shall be deemed not to have been filed if opposition proceedings in respect of the patent are pending at the time of filing the request.

(2) If, at the time of filing an opposition to a European patent, limitation proceedings in respect of that patent are pending, the Examining Division shall terminate the limitation proceedings and order the reimbursement of the limitation fee. The reimbursement shall also be ordered in respect of the fee referred to in Rule 95, paragraph 3, first sentence, if the requester has already paid this fee.

Rule 94  **Rejection of the request as inadmissible**

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 94 EPC 2000**

If the Examining Division finds that the request for limitation or revocation fails to comply with the requirements of Rule 92, it shall invite the requester to correct the deficiencies noted, within a period to be specified. If the deficiencies are not corrected in due time, the Examining Division shall reject the request as inadmissible.
**RULE 95 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; discussion in the Patent Law Committee 2002: CA/PL PV 19, points 54-55; Explanatory remarks 2006: CA/PL 17/06)

**Rule 95 EPC 2000** concerns the examination of, and decision on, requests for limitation or revocation which have been found to be admissible.

**Rule 95(1) EPC 2000** deals with the request for revocation and provides that the European patent is to be revoked where the request is admissible. The requester must be informed of the revocation and told when the decision will be published in the European Patent Bulletin.

**Rule 95(2) EPC 2000** concerns the examination for compliance with the substantive requirements for limitation of the European patent. It must be established
- whether the requested amendment of the claims actually constitutes a limitation (which is not the case e.g. where amendments are made purely for the purposes of clarification or claiming an aliud),
- whether the requirements of Articles 84 and 123(2) and (3) EPC have been met, and,
- where appropriate, whether amendments to the description and drawings are in line with these requirements.

This examination is carried out on the basis of the amended claims and, as the case may be, the amended description and drawings, as submitted by the requester in accordance with Rule 92(2)(d) EPC 2000.

If the request does not comply with the requirements set out above, the Examining Division will give the requester one opportunity to correct any deficiencies and to amend the claims, description and drawings within a period to be specified. Errors of transcription or obvious mistakes can be rectified on request or by the EPO of its own motion (Rule 139 EPC 2000). Since the request can be filed again at any time, depriving the requester of the possibility of making further amendments does not seem unreasonably harsh. There will be no examination as to whether the subject-matter of the limited patent is still patentable under Articles 52 to 57 EPC or whether the supposed aim of the limitation – e.g. delimitation with respect to particular prior art – is actually achieved by the requested amendment of the claims.

**Rule 95(3) EPC 2000**, if a request for limitation of the European patent is to be allowed, the requester has to file a translation of the amended claims and pay the fee for printing the amended patent specification before the limitation can be decided. He has three months to pay the printing fee and file the translation (aligned with Rule 82(2), second sentence, EPC 2000). A reference to Rule 82(3) EPC 2000 ensures that a period of grace – along the lines of the additional two month period provided for in opposition proceedings – is available.

**Rule 95(4) EPC 2000**, the request for limitation of the European patent is rejected if the requester does not respond to the communication under Rule 95(2) EPC 2000, or if it cannot be allowed. This also applies if the requester fails to perform the acts required under Rule 95(3) EPC 2000 in due time.

Under Rule 138 EPC 2000, different sets of claims are allowed for different Contracting States.

Limitation proceedings will be announced in the European Patent Register but not in the Bulletin. Third parties will be able to find out about the content of a request by inspecting the files. It is planned to inform the national patent offices of the Contracting States about pending limitation proceedings within the framework of the general exchange of data.

The EPO does not inform licensees about pending limitation proceedings or any other proceedings initiated in respect of a European patent.

**RULE 96 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; discussion in the Patent Law Committee 2002: CA/PL PV 19, points 56-57)

**Rule 96 EPC 2000** corresponds to Rule 87 EPC 2000 (dealing with the content and form of the new specification of the European patent).
### Rule 95  Decision on the request

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 95 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>(1) If a request for revocation is admissible, the Examining Division shall revoke the patent and communicate this to the requester.</td>
</tr>
<tr>
<td></td>
<td>(2) If a request for limitation is admissible, the Examining Division shall examine whether the amended claims constitute a limitation vis-à-vis the claims as granted or amended in opposition or limitation proceedings and comply with Article 84 and Article 123, paragraphs 2 and 3. If the request does not comply with these requirements, the Examining Division shall give the requester one opportunity to correct any deficiencies noted, and to amend the claims and, where appropriate, the description and drawings, within a period to be specified.</td>
</tr>
<tr>
<td></td>
<td>(3) If a request for limitation is allowable under paragraph 2, the Examining Division shall communicate this to the requester and invite him to pay the prescribed fee and to file a translation of the amended claims in the official languages of the European Patent Office other than the language of the proceedings, within a period of three months; Rule 82, paragraph 3, first sentence, shall apply mutatis mutandis. If the requester performs these acts in due time, the Examining Division shall limit the patent.</td>
</tr>
<tr>
<td></td>
<td>(4) If the requester does not respond in due time to the communication issued under paragraph 2, or if the request for limitation is not allowable, or if the requester fails to perform the acts required under paragraph 3 in due time, the Examining Division shall reject the request.</td>
</tr>
</tbody>
</table>

### Rule 96  Content and form of the amended European patent specification

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 96 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>The amended European patent specification shall include the description, claims and drawings as amended. Rule 73, paragraphs 2 and 3, and Rule 74 shall apply.</td>
</tr>
</tbody>
</table>
PART VI

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The transfer of provisions from Part VI of the Convention dealing with the "Appeals procedure" – in particular from Articles 106 and 110 EPC 1973 – and the new Article 112a EPC 2000 have made it necessary to extend Part VI of the Implementing Regulations and divide the material into two chapters:
- Chapter I concerns the appeal procedure (Articles 106 to 112 EPC).
- Chapter II contains the rules for petitions for review (Article 112a EPC).

CHAPTER I

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Chapter I of Part VI of the Implementing Regulations comprises the Rules governing the procedural provisions applicable in appeal proceedings, the admissibility of the appeal and the examination of the appeal as to admissibility and allowability (see in particular Articles 106, 108 and 110 EPC).

RULE 97 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

On the basis of Article 106(3) EPC 2000, the substance of Article 106(4) and (5) EPC 1973 is transferred to the new Rule 97 EPC 2000.

RULE 98 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 98 EPC 2000 contains the substance of Article 106(2) EPC 1973. The original wording "for all the designated States" would be appropriate if, for example, a centralised procedure existed for surrendering European patents. The amended wording "in all the designated States" is more in keeping with the idea of the European "bundle" patent.
PART VI IMPLEMENTING REGULATIONS TO PART VI OF THE CONVENTION

Chapter I Appeals procedure

Rule 97 Appeal against apportionment and fixing of costs

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 97 EPC 2000</th>
</tr>
</thead>
</table>
| [See Article 106 EPC 1973:]
| (4) The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. |
| (5) A decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount is in excess of that laid down in the Rules relating to Fees.] |

<table>
<thead>
<tr>
<th>Rule 98 Surrender or lapse of the patent</th>
</tr>
</thead>
</table>
| [See Article 106 EPC 1973:]
| (2) An appeal may be filed against the decision of the Opposition Division even if the European patent has been surrendered or has lapsed for all the designated States.]
| (1) The apportionment of costs of opposition proceedings cannot be the sole subject of an appeal. |
| (2) A decision fixing the amount of costs of opposition proceedings cannot be appealed unless the amount exceeds that of the fee for appeal. |

<table>
<thead>
<tr>
<th>Rule 98 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The decision of an Opposition Division may be appealed even if the European patent has been surrendered in all the designated Contracting States or has lapsed in all those States.</td>
</tr>
</tbody>
</table>
RULE 99 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

**Rule 99(1) EPC 2000** defines the content of the notice of appeal to be filed within the period specified in Article 108, first sentence, EPC 2000, taking up the requirements mentioned in Rule 64(a) and (b) EPC 1973, namely the name and address of the appellant and an indication of the decision impugned.

However, under the Rule 64(b) EPC 1973, already in the notice of appeal the appellant had to include a statement identifying the extent to which amendment of the impugned decision was requested. This rarely presented a problem in appeals filed by an opponent; as a rule, an opponent would request that the decision impugned be set aside and the patent be revoked (partially or in its entirety). However, where the appellant is the patent proprietor, the amended claims are nearly always filed with the statement of grounds for appeal, and it is only then that the precise nature of the requested amendment of the decision impugned becomes apparent. Consequently, this requirement is moved to **Rule 99(2) EPC 2000** which defines the content of the statement of grounds of appeal; up to now, this had been left to Board of Appeal case law under Article 108, third sentence, EPC.

The requirement of Rule 99(1)(c) EPC 2000 takes into account that the appellant's initial request – according to the case law of the Enlarged Board of Appeal (see G 9/92 and G 4/93, OJ EPO 1994, 875, and G 1/99, OJ EPO 2001, 381) – defines the subject of the appeal and thereby the framework of the appeal proceedings. As a rule, the notice of appeal should already clarify whether the decision under appeal is contested as a whole or only partially, and define the extent of the issues raised in the appeal proceedings.

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1)

**New Rule 99(3) EPC 2000** clarifies that the provisions of Part III of the Implementing Regulations shall apply mutatis mutandis to formal requirements concerning the notice of appeal, the statement of grounds and the documents filed in appeal proceedings. See explanatory remarks to Rules 76(3) and 86 EPC 2000.
<table>
<thead>
<tr>
<th>Rule 99</th>
<th>Content of the notice of appeal and the statement of grounds</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 64 EPC 1973</strong></td>
<td><strong>Rule 99 EPC 2000</strong></td>
</tr>
</tbody>
</table>
| The notice of appeal shall contain: | The notice of appeal shall contain:
| (a) the name and address of the appellant in accordance with the provisions of Rule 26, paragraph 2(c); | (a) the name and the address of the appellant as provided in Rule 41, paragraph 2(c); |
| (b) a statement identifying the decision which is impugned and the extent to which amendment or cancellation of the decision is requested. | (b) [...] an indication of the decision [...] impugned; and |
| (c) a request defining the subject of the appeal. | (c) a request defining the subject of the appeal. |
| (2) In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based. | (2) In the statement of grounds of appeal the appellant shall indicate the reasons for setting aside the decision impugned, or the extent to which it is to be amended, and the facts and evidence on which the appeal is based. |
| (3) Part III of the Implementing Regulations shall apply mutatis mutandis to the notice of appeal, the statement of grounds and the documents filed in appeal proceedings. | (3) Part III of the Implementing Regulations shall apply mutatis mutandis to the notice of appeal, the statement of grounds and the documents filed in appeal proceedings. |
**RULE 100 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

**Rule 100(1) EPC 2000** is taken from Rule 66(1) EPC 1973. The expression "unless otherwise provided" means unless otherwise provided in the Convention or the Implementing Regulations.

**Rule 100(2) and (3) EPC 2000**, transferred from Article 110(2) and (3) EPC 1973, now clearly cover examination for admissibility and for allowability.

The Board of Appeal will invite the parties "as often as necessary" to file observations on communications from the Board or submissions by the other party. It shall specify in the individual case the "period to be specified" referred to in **Rule 100(2) EPC 2000** (new Rule 132(1) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).

(In the Patent Law Committee 2002: CA/PL PV 19, points 58-59)

Discussion on the legal consequence set out in **Rule 100(3) EPC 2000** (deemed withdrawal of the application). Alternative: withdrawal of the appeal? The EPO pointed out that this provision is mostly used in proceedings before the Technical Boards of Appeal in which the appeal is against the refusal of an application. If a fictional withdrawal of the appeal were provided for, applicants would be deprived of the legal remedy of further processing. The unfortunate consequence of this for the applicant would be that the decision of the first instance to refuse the application would become final. For this reason, the legal consequence of deemed withdrawal of the application is more favourable to the applicant, with the exception of those few cases in which an appeal was based on the clarification of a point of detail.

**RULE 101 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

**Rule 101 EPC 2000** sets out the provisions to be observed in examining for admissibility.

The reference to Rule 1(1) EPC 1973 in Rule 65(1) EPC 1973 has been **deleted**, as it was incorrect: if an appeal was filed in a language other than an official language of the EPO and the required translation (Rule 1(1) EPC 1973) was not filed in due time, the appeal was deemed not to have been filed (Article 14(4) EPC 2000). See also Rule 77 EPC 2000 dealing with the rejection of the opposition as inadmissible.
Rule 100  Examination of appeals

Rule 66(1) EPC 1973

(1) Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings mutatis mutandis.

[See Article 110 EPC 1973:

(2) In the examination of the appeal, which shall be conducted in accordance with the provisions of the Implementing Regulations, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from another party or issued by itself.

(3) If the applicant fails to reply in due time to an invitation under paragraph 2, the European patent application shall be deemed to be withdrawn, unless the decision under appeal was taken by the Legal Division.]

Rule 100 EPC 2000

(1) Unless otherwise provided, the provisions relating to proceedings before the department which has taken the decision impugned shall apply to appeal proceedings [...].

(2) In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be specified, on communications issued by itself or observations submitted by another party.

(3) If the applicant fails to reply in due time to an invitation under paragraph 2, the European patent application shall be deemed to be withdrawn, unless the decision impugned was taken by the Legal Division.

Rule 101  Rejection of the appeal as inadmissible

Rule 65 EPC 1973

(1) If the appeal does not comply with Articles 106 to 108 and with Rule 1, paragraph 1, and Rule 64, sub-paragraph (b), the Board of Appeal shall reject it as inadmissible, unless each deficiency has been remedied before the relevant time limit laid down in Article 108 has expired.

(2) If the Board of Appeal notes that the appeal does not comply with the provisions of Rule 64, sub-paragraph (a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within such period as it may specify. If the appeal is not corrected in good time, the Board of Appeal shall reject it as inadmissible.

Rule 101 EPC 2000

(1) If the appeal does not comply with Articles 106 to 108, Rule 97 or Rule 99, paragraph 1(b) or (c) or paragraph 2, the Board of Appeal shall reject it as inadmissible, unless any deficiency has been remedied before the relevant period under Article 108 has expired.

(2) If the Board of Appeal notes that the appeal does not comply with [...] Rule 99, paragraph 1(a), it shall communicate this to the appellant and shall invite him to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Board of Appeal shall reject the appeal as inadmissible.
RULE 102 EPC

(Explanatory remarks 2002: CA/P/L 5/02 Rev. 1 Add. 1)

### Rule 102  Form of decision of the Board of Appeal

<table>
<thead>
<tr>
<th>Rule 66 EPC 1973</th>
<th>Rule 102 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Unless otherwise provided, the provisions relating to proceedings before the department which has made the decision from which the appeal is brought shall be applicable to appeal proceedings mutatis mutandis.</td>
<td>Transferred to Rule 100(1) EPC 2000</td>
</tr>
</tbody>
</table>

(2) The decision shall be authenticated by the Chairman of the Board of Appeal and by the competent employee of the registry of the Board of Appeal, either by their signature or by any other appropriate means. The decision shall contain:

- (a) a statement that it is delivered by the Board of Appeal;
- (b) the date when the decision was taken;
- (c) the names of the Chairman and of the other members of the Board of Appeal taking part;
- (d) the names of the parties and their representatives;
- (e) a statement of the issues to be decided;
- (f) a summary of the facts;
- (g) the reasons;
- (h) the order of the Board of Appeal, including, where appropriate, a decision on costs.

[...] The decision shall be authenticated by the Chairman of the Board of Appeal and by the competent employee of the registry of the Board of Appeal, either by their signature or by any other appropriate means. The decision shall contain:

- (a) a statement that it was delivered by the Board of Appeal;
- (b) Unchanged
- (c) Unchanged
- (d) Unchanged
- (e) the request of the parties;
- (f) Unchanged
- (g) Unchanged
- (h) Unchanged
**RULE 103 EPC**

(Explanatory remarks 2002: CA/P L 5/02 Rev. 1 Add. 1)

**Rule 103(1)(a) EPC 2000** takes up the text of Rule 67 EPC 1973.

**Rule 103(1)(b) EPC 2000** goes some way towards compensating for the lack of a cross-appeal facility. Appeals filed as a precaution – for the case the other party appeals – can be withdrawn if the other party does not file an appeal, at an early stage of the proceedings, during the period between the expiry of the respective periods for filing the notice of appeal and filing the statement of grounds of appeal, i.e. before any great expense or effort by the parties or the EPO.

**Rule 103(2) EPC 2000** codifies the case law of the Legal Board of Appeal (J 32/95, OJ EPO 1999, 713).
Rule 103 Reimbursement of appeal fees

<table>
<thead>
<tr>
<th>Rule 67 EPC 1973</th>
<th>Rule 103 EPC 2000</th>
</tr>
</thead>
</table>
| The reimbursement of appeal fees shall be ordered in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation. In the event of interlocutory revision, reimbursement shall be ordered by the department whose decision has been impugned and, in other cases, by the Board of Appeal. | (1) The appeal fee shall be reimbursed
(a) in the event of interlocutory revision or where the Board of Appeal deems an appeal to be allowable, if such reimbursement is equitable by reason of a substantial procedural violation, or
(b) if the appeal is withdrawn before the filing of the statement of grounds of appeal and before the period for filing that statement has expired.
(2) The department whose decision is impugned shall order the reimbursement if it revises its decision and considers reimbursement equitable by reason of a substantial procedural violation. In all other cases, matters of reimbursement shall be decided by the Board of Appeal. |
CHAPTER II

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

New Rules 104 to 110 EPC 2000 implement Article 112a EPC 2000 on petitions for review. The new Rules are grouped together in a new Chapter II of Part VI of the Implementing Regulations.

RULE 104 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 104 EPC 2000 implements Article 112a(2)(d) EPC.

The right to oral proceedings, addressed in Rule 104(a) EPC 2000, is an important aspect of the right to be heard. Ignoring a request for oral proceedings may therefore constitute a fundamental procedural defect, which merits the same treatment as the cases covered by Article 112a(2)(a) to (c) EPC 2000. It is up to the Enlarged Board of Appeal to assess the seriousness of the procedural defect. Only the non-appointment of oral proceedings which contravenes Article 116 EPC will be a reason for re-opening appeal proceedings.

The seriousness of the fundamental procedural defect addressed in Rule 104(b) EPC 2000 is also to be assessed by the Enlarged Board of Appeal, which must interpret the terms "fundamental" and "relevant" to this end. The assumption is that only requests submitted in writing or requests which the party had recorded in the minutes of the oral proceedings will fall within the ambit of that provision. Furthermore, the wording of Rule 104(b) EPC 2000 implies that the fundamental procedural defect must have occurred with respect to the appeal. Therefore, requests relating to the apportionment of costs, the reimbursement of the appeal fee or other requests concerning collateral issues are not addressed in the provision. A partial re-opening of appeal proceedings with respect to collateral issues only is not desirable.

(In the Patent Law Committee 2002: CA/PL PV 19, points 60-64)

General discussion on the need to include further grounds for petition for review in the Implementing Regulations, in addition to those included in Article 112a(2)(a) to (c) EPC 2000. The EPO pointed out that Article 112a(2)(d) EPC 2000 covered the provision of additional grounds for review in the Implementing Regulations.

Discussion on a more restrictive wording in Rule 104(b) EPC 2000 ("... on a clearly stated request ..."), The EPO pointed out that it should be left to case law to interpret the term "relevant request" in Rule 104(b) EPC 2000.

RULE 105 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 105 EPC provides that only a criminal act finally established by a competent court or authority can serve as the basis for proceedings under Article 112a(2)(e) EPC 2000. The act may be "finally established" in any of the following ways:
- by a final judgment under (criminal) law;
- by another final decision of a competent court,
- by a final decision of a competent authority (e.g. under administrative criminal law, to the extent that such a breach of law can be liable to influence the decision of the Board of Appeal).

The operative criterion is not whether the (criminal) court or authority has passed sentence, as this would leave out cases where, for example, the perpetrator dies before sentence can be pronounced, or where a finding of diminished capacity makes sentencing impossible. Instead, the crucial issue is whether an act constituting a criminal offence has actually occurred, and whether the fact of its having occurred has been definitely established by a competent court or authority.
### Chapter II  
**Petitions for review by the Enlarged Board of Appeal**

#### Rule 104  
**Further fundamental procedural defects**

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 104 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>A fundamental procedural defect under Article 112a, paragraph 2(d), may have occurred where the Board of Appeal,</td>
</tr>
<tr>
<td></td>
<td>(a) contrary to Article 116, failed to arrange for the holding of oral proceedings requested by the petitioner, or</td>
</tr>
<tr>
<td></td>
<td>(b) decided on the appeal without deciding on a request relevant to that decision.</td>
</tr>
</tbody>
</table>

#### Rule 105  
**Criminal acts**

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 105 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>A petition for review may be based on Article 112a, paragraph 2(e), if a competent court or authority has finally established that the criminal act occurred; a conviction is not necessary.</td>
</tr>
</tbody>
</table>
RULE 106 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 106 EPC 2000 establishes the obligation to raise any procedural objections already during the appeal proceedings, in so far as the party adversely affected by the defect is – or should be – aware of it. It will be up to the Enlarged Board of Appeal to interpret the term "impossible" and to develop an appropriate standard for assessing whether or not it was "impossible" to object against the procedural defect during appeal proceedings.

(In the Patent Law Committee 2002: CA/PL PV 19, points 64-65)

General discussion on the need to include the obligation to raise objections. The EPO pointed out that a provision like Rule 106 EPC 2000 was designed to prevent the new extraordinary means of redress from being abused by endless dragging out of proceedings.

RULE 107 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 107 EPC 2000 implements Article 112a(4), first sentence, EPC 2000, particularly in respect of the petitioner's duty to substantiate his allegations. The "reasoned statement" prescribed in Article 112a(4), first sentence, EPC 2000 has to be filed within the time periods laid down in Article 112a(4), second and third sentences, EPC 2000. Its content must meet the requirements laid down in Rule 107 EPC 2000.

(Explanatory remarks 2006: CA/PL 17/06, CA/PL 29/06 Add.1)

Under Rule 107(1)(a) EPC 2000, only those particulars of the petitioner are required which are necessary for his identification, i.e. his name and his address.

### Rule 106  **Obligation to raise objections**

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 106 EPC 2000**

A petition under Article 112a, paragraph 2(a) to (d), is only admissible where an objection in respect of the procedural defect was raised during the appeal proceedings and dismissed by the Board of Appeal, except where such objection could not be raised during the appeal proceedings.

### Rule 107  **Contents of the petition for review**

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 107 EPC 2000**

(1) The petition shall contain:

(a) the name and the address of the petitioner as provided in Rule 41, paragraph 2(c);

(b) an indication of the decision to be reviewed.

(2) The petition shall indicate the reasons for setting aside the decision of the Board of Appeal, and the facts and evidence on which the petition is based.

(3) Part III of the Implementing Regulations shall apply mutatis mutandis to the petition for review and the documents filed in the proceedings.
RULE 108 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1; explanatory remarks 2006: CA/PL 17/06)

Rule 108(1) EPC 2000 lists the admissibility requirements to be met by petitions for review.

Rule 108(2) EPC 2000 is drafted on the model of Rule 101(2) EPC 2000 which applies to appeal proceedings and provides that the Board shall invite the appellant to remedy deficiencies in the particulars required under Rule 99(1)(a) EPC 2000 within a specified time period if it notes that the appeal does not comply with the said rule. Petitioners for review should not be barred from a similar possibility to remedy deficiencies. Even though the required particulars are limited to "the name and the address" (see Rule 107(1)(a) EPC 2000), it would be an unnecessary hardship if any missing element in name and address would lead automatically to the inadmissibility of a petition.

The "period to be specified" referred to in Rule 108(2) EPC 2000 shall be specified in the individual case (new Rule 132(1) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).

Rule 108(3) EPC 2000 concerns the decision of the Enlarged Board of Appeal if the petition is allowable. In accordance with the legal character of the petition as a special remedy, the Enlarged Board will set aside the decision of the Board of Appeal (by "cassatory" decision or iudicium rescindens) and order that the proceedings be re-opened. The proceedings are re-opened before the Board of Appeal responsible under the business distribution scheme enacted under Rule 12(4) EPC 2000; however, the Enlarged Board of Appeal may order that members of the board be replaced.

RULE 109 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 109(1), first sentence, EPC 2000 is the parallel provision to Rule 100(1) EPC 2000. The provisions relating to appeal proceedings apply in particular to proceedings before the Enlarged Board of Appeal in the five-member composition under Rule 109(2)(b) EPC 2000. The unanimity requirement in Rule 109(2)(a) EPC 2000 applies only to the Enlarged Board of Appeal in the three-member composition.

The expression "unless otherwise provided" means unless otherwise provided in the Convention or the Implementing Regulations.

(Explanatory remarks 2002 and 2006: CA/PL 5/02 Rev. 1 Add. 1, CA/PL 17/06; discussion in the Patent Law Committee 2002 and 2006: CA/PL PV 19, point 70, CA/PL PV 30, points 146-147)

In the interest of procedural efficiency, the Enlarged Board of Appeal may shorten the following periods, under Rule 109(1), second sentence, EPC 2000:
- the minimum period of two months for the summons to oral proceedings (see Rule 115(1), second sentence, EPC 2000),
- the minimum period of two months for periods specified by the EPO (see Rule 132(2) EPC 2000),
- the period for a notice of summons to give evidence issued to a party, witness or expert (see Rule 118(2), first sentence, EPC 2000).

Finally, in the interest of efficient and streamlined proceedings under Article 112a EPC, it should also be possible to abridge the period for requesting interpretation in the language of proceedings. The Enlarged Board may thus, under Rule 109(1), third sentence, EPC 2000, specify a period deviating from Rule 4(1), first sentence, EPC 2000.
**Rule 108  Examination of the petition**

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 108 EPC 2000**

(1) If the petition does not comply with Article 112a, paragraphs 1, 2 or 4, Rule 106 or Rule 107, paragraph 1(b) or 2, the Enlarged Board of Appeal shall reject it as inadmissible, unless any defect has been remedied before the relevant period under Article 112a, paragraph 4, expires.

(2) If the Enlarged Board of Appeal notes that the petition does not comply with Rule 107, paragraph 1(a), it shall communicate this to the petitioner and shall invite him to remedy the deficiencies noted within a period to be specified. If the deficiencies are not remedied in due time, the Enlarged Board of Appeal shall reject the petition as inadmissible.

(3) If the petition is allowable, the Enlarged Board of Appeal shall set aside the decision of the Board of Appeal and order the re-opening of the proceedings before the Board of Appeal responsible under Rule 12, paragraph 4. The Enlarged Board of Appeal may order that members of the Board of Appeal who participated in taking the decision set aside shall be replaced.

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**Rule 109  Procedure in dealing with petitions for review**

**EPC 1973**

The EPC 1973 did not contain an equivalent provision.

**Rule 109 EPC 2000**

(1) In proceedings under Article 112a, the provisions relating to proceedings before the Boards of Appeal shall apply, unless otherwise provided. Rule 115, paragraph 1, second sentence, Rule 118, paragraph 2, first sentence, and Rule 132, paragraph 2, shall not apply. The Enlarged Board of Appeal may specify a period deviating from Rule 4, paragraph 1, first sentence.
Rule 109(2) EPC 2000 implements Article 22(2), second sentence, EPC 2000.

Proceedings concerning a petition for review are conducted in their initial phase in accordance with Rule 109(3) EPC 2000. In the interests of legal certainty, review proceedings which clearly have no chance of succeeding must be ended swiftly. Proceedings under Rule 109(3) EPC 2000 will therefore be conducted in writing, without involving the other parties. The involvement of other parties is not necessary at this stage, since full proceedings will in any case be instituted if the petition is not rejected as clearly inadmissible or unallowable. If the petition is rejected as clearly inadmissible or unallowable, the other parties are not adversely affected, as proceedings on the petition for review are terminated and the legal situation remains as stated by the Board of Appeal.

In proceedings under Rule 109(3) EPC 2000, the petitioner will be invited to attend oral proceedings if he has so requested, or if the Enlarged Board of Appeal considers this expedient, in which case it will issue an invitation of its own motion. If necessary, the period to be observed for issuing the invitation may be shortened. At the end of the oral proceedings, the Enlarged Board will either reject the petition for review as inadmissible or unallowable, or continue the proceedings in the five-member composition under Rule 109(2)(b) EPC 2000, with the involvement of the other parties. The case will be decided "on the basis of the petition as filed", i.e. on the basis of the reasons submitted, within the period laid down in Article 112a(4) EPC, and supported by facts and evidence for setting aside the decision.

The decisions of the Enlarged Board of Appeal must be reasoned, in accordance with general principles (see also CA/PL PV 19, point 66). From Articles 106 and 112a EPC, it follows that there is no right of further appeal against a decision of the Enlarged Board of Appeal concerning a petition for review.

Rule 110 EPC

Rule 110 EPC 2000 deals with reimbursement of the fee for a petition for review. Reimbursement will be ordered if proceedings before the Boards of Appeal are re-opened.
Rule 109  **Procedure in dealing with petitions for review**

The EPC 1973 did not contain an equivalent provision.

(2) The Enlarged Board of Appeal

(a) consisting of two legally qualified members and one technically qualified member shall examine all petitions for review and shall reject those which are clearly inadmissible or unallowable; such decision shall require unanimity;

(b) consisting of four legally qualified members and one technically qualified member shall decide on any petition not rejected under sub-paragraph (a).

(3) The Enlarged Board of Appeal composed according to paragraph 2(a) shall decide without the involvement of other parties and on the basis of the petition.

Rule 110  **Reimbursement of the fee for petitions for review**

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 110 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>The Enlarged Board of Appeal shall order the reimbursement of the fee for a petition for review if the proceedings before the Boards of Appeal are reopened.</td>
</tr>
</tbody>
</table>
PART VII

CHAPTER I

RULE 111 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 68 EPC 1973 has been brought into line with the style of the EPC 2000. It is renumbered as Rule 111 EPC 2000.

RULE 112 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 69 EPC 1973 has been brought into line with the style of the EPC 2000. It is renumbered as Rule 112 EPC 2000.

(In the Patent Law Committee 2002: CA/PL PV 19, points 72-73)

Concerning the deletion from Rule 69(1) EPC 1973 of the reference to Article 119 EPC, the EPO pointed out that Article 119 EPC 2000 applies to the notification of all the EPO’s communications and decisions, making this separate reference unnecessary.
PART VII  IMPLEMENTING REGULATIONS TO PART VII OF THE CONVENTION

Chapter I  Decisions and communications of the European Patent Office

<table>
<thead>
<tr>
<th>Rule 111  Form of decisions</th>
<th>Rule 112  Noting of loss of rights</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 68 EPC 1973</strong></td>
<td><strong>Rule 111 EPC 2000</strong></td>
</tr>
<tr>
<td>(1) Where oral proceedings are held before the European Patent Office, the decision may be given orally. Subsequently the decision in writing shall be notified to the parties.</td>
<td>(1) Where oral proceedings are held before the European Patent Office, the decision may be given orally. [...] The decision shall subsequently be put in writing and notified to the parties.</td>
</tr>
<tr>
<td>(2) Decisions of the European Patent Office which are open to appeal shall be reasoned and shall be accompanied by a written communication of the possibility of appeal. The communication shall also draw the attention of the parties to the provisions laid down in Articles 106 to 108, the text of which shall be attached. The parties may not invoke the omission of the communication.</td>
<td>(2) Decisions of the European Patent Office which are open to appeal shall be reasoned and shall be accompanied by a [...] communication pointing out the possibility of appeal and drawing [...] the attention of the parties to [...] Articles 106 to 108, the text of which shall be attached. The parties may not invoke the omission of the communication.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Rule 69 EPC 1973</th>
<th>Rule 112 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) If the European Patent Office notes that the loss of any right results from the Convention, without any decision concerning the refusal of the European patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence, it shall communicate this to the person concerned in accordance with the provisions of Article 119.</td>
<td>(1) If the European Patent Office notes that a loss of rights has occurred, without any decision concerning the refusal of the European patent application or the grant, revocation or maintenance of the European patent, or the taking of evidence, it shall communicate this to the party concerned. [...]</td>
</tr>
<tr>
<td>(2) If the person concerned considers that the finding of the European Patent Office is inaccurate, he may, within two months after notification of the communication referred to in paragraph 1, apply for a decision on the matter by the European Patent Office. Such decision shall be given only if the European Patent Office does not share the opinion of the person requesting it; otherwise the European Patent Office shall inform the person requesting the decision.</td>
<td>(2) If the party concerned considers that the finding of the European Patent Office is inaccurate, it may, within two months of [...] the communication under paragraph 1, apply for a decision on the matter [...] The European Patent Office shall take such decision only if it does not share the opinion of the party requesting it; otherwise, it shall inform that party [...].</td>
</tr>
</tbody>
</table>
RULE 113 EPC 2000

Rule 70 EPC 1973 has been brought into line with the style of the EPC 2000. It is renumbered as Rule 113 EPC 2000.

CHAPTER II

A new Chapter II, headed "Observations by third parties," is included in Part VIII of the Implementing Regulations. The subsequent Chapters are renumbered accordingly.

RULE 114 EPC

Article 115(1), second sentence, and (2) EPC 1973 has been deleted and its substance transferred to new Rule 114 EPC 2000.

Rule 114(1) EPC 2000 provides that any observations by a third party in accordance with Article 115 EPC must be filed in an official language of the EPO. However, the reference to Rule 3(3) EPC 2000 makes it clear that the third party can file documentary evidence and, in particular, publications in any language. Under Rule 3(3), second sentence, EPC 2000, the EPO may request that such party supply a translation into one of its official languages later. The EPO may disregard the document if the translation is not filed in due time.
Rule 113  Signature, name, seal

<table>
<thead>
<tr>
<th>Rule 70 EPC 1973</th>
<th>Rule 113 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Any decision, communication and notice from the European Patent Office is to be signed by and to state the name of the employee responsible.</td>
<td>(1) Any decisions, summonses, notices and communications [...] from the European Patent Office shall be signed by, and state the name of, the employee responsible.</td>
</tr>
</tbody>
</table>

(2) Where the documents mentioned in paragraph 1 are produced by the employee responsible using a computer, a seal may replace the signature. Where the documents are produced automatically by a computer the employee’s name may also be dispensed with. The same applies to pre-printed notices and communications.

(2) Where a document referred to in paragraph 1 is produced by the employee responsible using a computer, a seal may replace the signature. Where the document is produced automatically by a computer, the employee’s name may also be dispensed with. The same shall apply to pre-printed notices and communications.

Chapter II  Observations by third parties

Rule 114  Observations by third parties

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 114 EPC 2000</th>
</tr>
</thead>
</table>
| [See Article 115 EPC 1973:  
(1) ... Such observations must be filed in writing and must include a statement of the grounds on which they are based. ...  

(2) The observations referred to in paragraph 1 shall be communicated to the applicant for or proprietor of the patent who may comment on them.] | (1) Any observations by a third party shall be filed in writing in an official language of the European Patent Office and state the grounds on which they are based. Rule 3, paragraph 3, shall apply. |

(2) Any such observations shall be communicated to the applicant for or proprietor of the patent, who may comment on them.
CHAPTER III

RULE 115 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 71 EPC 1973 which is renumbered as Rule 115 EPC 2000.

RULE 116 EPC

(Explanatory remarks 2006: CA/PL 17/06)

In Rule 116(1) EPC 2000, the only change relates to the reference to Rule 132 EPC 2000.
Chapter III  Oral proceedings and taking of evidence

Rule 115  Summons to oral proceedings

Rule 71 EPC 1973

(1) The parties shall be summoned to oral proceedings provided for in Article 116 and their attention shall be drawn to paragraph 2 of this Rule. At least two months' notice of the summons shall be given unless the parties agree to a shorter period.

(2) If a party who has been duly summoned to oral proceedings before the European Patent Office does not appear as summoned, the proceedings may continue without him.

Rule 115 EPC 2000

(1) The parties shall be summoned to oral proceedings under Article 116, drawing their attention [...] to paragraph 2 of this Rule. At least two months' notice of the summons shall be given, unless the parties agree to a shorter period.

(2) If a party [...] duly summoned to oral proceedings before the European Patent Office does not appear as summoned, the proceedings may continue without that party.

Rule 116  Preparation of oral proceedings

Rule 71a EPC 1973

(1) When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed. Rule 84 shall not apply. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed.

(2) If the applicant or patent proprietor has been notified of the grounds prejudicing the grant or maintenance of the patent, he may be invited to submit, by the date specified in paragraph 1, second sentence, documents which meet the requirements of the Convention. Paragraph 1, third and fourth sentences, shall apply mutatis mutandis.

Rule 116 EPC 2000

(1) When issuing the summons, the European Patent Office shall draw attention to the points which in its opinion need to be discussed for the purposes of the decision to be taken. At the same time a final date for making written submissions in preparation for the oral proceedings shall be fixed. Rule 132 shall not apply. New facts and evidence presented after that date need not be considered, unless admitted on the grounds that the subject of the proceedings has changed.

(2) Unchanged
RULE 117 EPC

(Editorial amendments have been made to Rule 72(1) EPC 1973 which is renumbered as Rule 117 EPC 2000.)

(In the Patent Law Committee 2002: CA/PL PV 19, points 74)

At the epi's suggestion, the EPO agreed to give separate consideration to the length of minutes taken at oral proceedings, in particular the transcripts of witness and expert testimonies.
### Rule 117  **Decision on taking of evidence**

#### Rule 72(1) EPC 1973

(1) Where the European Patent Office considers it necessary to hear the oral evidence of parties, witnesses or experts or to carry out an inspection, it shall make a decision to this end, setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation. If oral evidence of witnesses and experts is requested by a party, the decision of the European Patent Office shall determine the period of time within which the party filing the request must make known to the European Patent Office the names and addresses of the witnesses and experts whom it wishes to be heard.

#### Rule 117 EPC 2000

[...] Where the European Patent Office considers it necessary to hear a party, witness or expert, or to carry out an inspection, it shall take a decision to this end, setting out the investigation which it intends to carry out, relevant facts to be proved and the date, time and place of the investigation. If the hearing of a witness or expert is requested by a party, the decision [...] shall specify the period [...] within which the requester must make known [...] the name and address of any witness or expert concerned.
RULES 118, 119 and 120 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

These Rules deal with the taking of evidence and largely correspond to Rule 72 EPC 1973, but also incorporate contents from Article 117(2) to (6) EPC 1973.

For the sake of clarity and legibility, the provisions have been divided into three separate Rules and drafted in the style of the EPC 2000.
Rule 118  **Summons to give evidence before the European Patent Office**

**EPC 1973**

[See Article 117 EPC 1973:

(3) If the European Patent Office considers it necessary for a party, witness or expert to give evidence orally, it shall either:

(a) issue a summons to the person concerned to appear before it ...]

**Rule 72(2) EPC 1973**

(2) At least two months' notice of a summons issued to a party, witness or expert to give evidence shall be given unless they agree to a shorter period. The summons shall contain:

(a) an extract from the decision mentioned in paragraph 1, indicating in particular the date, time and place of the investigation ordered and stating the facts regarding which parties, witnesses and experts are to be heard;

(b) the names of the parties to the proceedings and particulars of the rights which the witnesses or experts may invoke under the provisions of Rule 74, paragraphs 2 to 4;

(c) an indication that the party, witness or expert may request to be heard by the competent court of his country of residence and a requirement that he inform the European Patent Office within a time limit to be fixed by the Office whether he is prepared to appear before it.]

**Rule 118 EPC 2000**

(1) A summons to give evidence before the European Patent Office shall be issued to the parties, witnesses or experts concerned.

(2) At least two months' notice of a summons issued to a party, witness or expert to **testify** shall be given, unless they agree to a shorter period. The summons shall contain:

(a) an extract from the decision under Rule 117, indicating [...] the date, time and place of the investigation ordered and stating the facts in respect of which parties, witnesses or experts are to be heard;

(b) the names of the parties [...] and particulars of the rights which the witnesses or experts may invoke under [...] Rule 122, paragraphs 2 to 4;

(c) an indication that the party, witness or expert may request to be heard by a competent court of his country of residence under Rule 120, and an invitation to inform the European Patent Office, within a period to be specified, whether he is prepared to appear before it.
RULES 118, 119 and 120 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

These Rules deal with the taking of evidence and largely correspond to Rule 72 EPC 1973, but also incorporate contents from Article 117(2) to (6) EPC 1973.

For the sake of clarity and legibility, the provisions have been divided into three separate Rules and drafted in the style of the EPC 2000.
### Rule 119  Examination of evidence before the European Patent Office

#### EPC 1973

[See Article 117 EPC 1973:

(2) The Examining Division, Opposition Division or Board of Appeal may commission one of its members to examine the evidence adduced.]

#### Rule 72(3) and (4) EPC 1973

(3) Before a party, witness or expert may be heard, he shall be informed that the European Patent Office may request the competent court in the country of residence of the person concerned to re-examine his evidence on oath or in an equally binding form.

(4) The parties may attend an investigation and may put relevant questions to the testifying parties, witnesses and experts.

#### Rule 119 EPC 2000

(1) The Examining Division, Opposition Division or Board of Appeal may commission one of its members to examine the evidence adduced.

(2) Before a party, witness or expert may be heard, he shall be informed that the European Patent Office may request the competent court in the country of residence of the person concerned to re-examine his testimony under oath or in an equally binding form.

(3) The parties may attend an investigation and may put relevant questions to the testifying party, witness or expert.

### Rule 120  Hearing by a competent national court

#### EPC 1973

[See Article 117 EPC 1973:

(4) A party, witness or expert who is summoned before the European Patent Office may request the latter to allow his evidence to be heard by a competent court in his country of residence. On receipt of such a request, or if there has been no reply to the summons by the expiry of a period fixed by the European Patent Office in the summons, the European Patent Office may, in accordance with the provisions of Article 131, paragraph 2, request the competent court to hear the person concerned.

(5) If a party, witness or expert gives evidence before the European Patent Office, the latter may, if it considers it advisable for the evidence to be given on oath or in an equally binding form, request the competent court in the country of residence of the person concerned to re-examine his evidence under such conditions.

(6) When the European Patent Office requests a competent court to take evidence, it may request the court to take the evidence on oath or in an equally binding form and to permit a member of the department concerned to attend the hearing and question the party, witness or expert either through the intermediary of the court or directly.]

#### Rule 120 EPC 2000

(1) A party, witness or expert who is summoned before the European Patent Office may request the latter to allow him to be heard by a competent court in his country of residence. If this is requested, or if no reply is received within the period specified in the summons, the European Patent Office may, in accordance with Article 131, paragraph 2, request the competent court to hear the person concerned.

(2) If a party, witness or expert has been heard by the European Patent Office, the latter may, if it considers it advisable for the testimony to be given under oath or in an equally binding form, issue a request under Article 131, paragraph 2, to the competent court in the country of residence of the person concerned to re-examine his testimony under such conditions.

(3) When the European Patent Office requests a competent court to take evidence, it may request the court to take the evidence under oath or in an equally binding form and to permit a member of the department concerned to attend the hearing and question the party, witness or expert, either through the intermediary of the court or directly.
RULE 121 EPC

(Explanatory remarks 2002: CA/P L 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 73 EPC 1973 which is renumbered as Rule 121 EPC 2000.
### Rule 121 Commissioning of experts

#### Rule 73 EPC 1973

1. The European Patent Office shall decide in what form the report made by an expert whom it appoints shall be submitted.

2. The terms of reference of the expert shall include:
   
   a. a precise description of his task;
   
   b. the time limit laid down for the submission of the expert report;
   
   c. the names of the parties to the proceedings;
   
   d. particulars of the rights which he may invoke under the provisions of Rule 74, paragraphs 2 to 4.

3. A copy of any written report shall be submitted to the parties.

4. The parties may object to an expert. The department of the European Patent Office concerned shall decide on the objection.

#### Rule 121 EPC 2000

1. The European Patent Office shall decide in what form the **opinion of** an expert whom it appoints shall be submitted.

2. The terms of reference of the expert shall include:
   
   a. a precise description of his task;
   
   b. the period specified for the submission of his **opinion**;
   
   c. the names of the parties to the proceedings;
   
   d. particulars of the rights which he may invoke under Rule 122, paragraphs 2 to 4.

3. A copy of any written **opinion** shall be submitted to the parties.

4. Unchanged
RULE 122 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 74 EPC 1973 which is renumbered as Rule 122 EPC 2000.
### Rule 122 Costs of taking of evidence

#### Rule 74 EPC 1973

(1) The taking of evidence by the European Patent Office may be made conditional upon deposit with it, by the party who requested the evidence to be taken, of a sum the amount of which shall be fixed by reference to an estimate of the costs.

(2) Witnesses and experts who are summoned by and appear before the European Patent Office shall be entitled to appropriate reimbursement of expenses for travel and subsistence. An advance for these expenses may be granted to them. The first sentence shall apply to witnesses and experts who appear before the European Patent Office without being summoned by it and are heard as witnesses or experts.

(3) Witnesses entitled to reimbursement under paragraph 2 shall also be entitled to appropriate compensation for loss of earnings, and experts to fees for their work. These payments shall be made to the witnesses and experts after they have fulfilled their duties or tasks.

(4) The Administrative Council shall lay down the details governing the implementation of the provisions of paragraphs 2 and 3. Payment of amounts due pursuant to these paragraphs shall be made by the European Patent Office.

#### Rule 122 EPC 2000

(1) The taking of evidence by the European Patent Office may be made conditional upon deposit with it, by the party [...] requesting the evidence to be taken, of an amount to be fixed by reference to an estimate of the costs.

(2) Witnesses or experts who are summoned by and appear before the European Patent Office shall be entitled to appropriate reimbursement of expenses for travel and subsistence. An advance for these expenses may be granted to them. This [...] shall also apply to persons who appear before the European Patent Office without being summoned by it and are heard as witnesses or experts.

(3) Unchanged

(4) The Administrative Council shall lay down the details implementing [...] paragraphs 2 and 3. Any [...] amounts due under these provisions shall be paid by the European Patent Office.


RULE 123 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 75 EPC 1973 which is renumbered as Rule 123 EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 31, points 16-20)

In Rule 123(1), first sentence, EPC 2000, "take measures" replaces "hear oral evidence or conduct inspections" (alignment with French and German versions).
Rule 123 Conservation of evidence

**Rule 75 EPC 1973**

(1) On request, the European Patent Office may, without delay, hear oral evidence or conduct inspections, with a view to conserving evidence of facts liable to affect a decision which it may be called upon to take with regard to an existing European patent application or a European patent, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. The date on which the measures are to be taken shall be communicated to the applicant for or proprietor of the patent in sufficient time to allow him to attend. He may ask relevant questions.

(2) The request shall contain:

(a) the name and address of the person filing the request and the State in which his residence or principal place of business is located, in accordance with the provisions of Rule 26, paragraph 2(c);

(b) sufficient identification of the European patent application or European patent in question;

(c) the designation of the facts in respect of which evidence is to be taken;

(d) particulars of the way in which evidence is to be taken;

(e) a statement establishing a prima facie case for fearing that it might subsequently become more difficult or impossible to take evidence.

(3) The request shall not be deemed to have been filed until the fee for conservation of evidence has been paid.

(4) The decision on the request and any resulting taking of evidence shall be incumbent upon the department of the European Patent Office required to take the decision liable to be affected by the facts to be established. The provisions of the Convention with regard to the taking of evidence in proceedings before the European Patent Office shall be applicable.

**Rule 123 EPC 2000**

(1) On request, the European Patent Office may, without delay, take measures [...] to conserve evidence of facts liable to affect a decision which it may be called upon to take with regard to a [...] European patent application or a European patent, where there is reason to fear that it might subsequently become more difficult or even impossible to take evidence. The date on which the measures are to be taken shall be communicated to the applicant for or proprietor of the patent in sufficient time to allow him to attend. He may ask relevant questions.

(2) The request shall contain:

(a) particulars of the requester [...] as provided in Rule 41, paragraph 2(c);

(b) sufficient identification of the European patent application or European patent in question;

(c) an indication of the facts in respect of which evidence is to be taken;

(d) particulars of the means of giving or obtaining evidence;

(e) a statement establishing a prima facie case for fearing that it might subsequently become more difficult or impossible to take evidence.

(3) The request shall not be deemed to have been filed until the prescribed fee [...] has been paid.

(4) The decision on the request and any resulting taking of evidence shall be incumbent upon the department of the European Patent Office which would have to take the decision liable to be affected by the facts to be established. The provisions [...] with regard to the taking of evidence in proceedings before the European Patent Office shall apply.
RULE 124 EPC

(Explanatory remarks 2006: CA/PL 17/06)

According to the practice under the EPC 1973, the evidence of the person testifying was as a rule summarised section by section by the legal member and dictated in this form onto a dictaphone. The person being examined had the opportunity to raise objections immediately to the dictated text, so that it could be corrected at once. Normally the person testifying waived his right to have the whole of the testimony played back to him afterwards. This possibility of waiver has been inserted in Rule 124(2), first sentence, EPC 2000.

In order to enhance the authenticity of the minutes and to simplify and accelerate the taking of evidence, it could in certain cases make sense to produce the minutes verbatim using technical means. This, however, would be impractical if the requirements of Rule 76(2), first and second sentences, EPC 1973 have to be complied with. New Rule 124(2), last sentence, EPC 2000 makes it clear that these requirements need not be complied with under these circumstances.

Rule 124(3) EPC 2000 has been adjusted to new Rules 2(2) and 124(2) EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 30, points 149-150)

Minutes of oral proceedings before the Boards of Appeal are minutes within the meaning of Rule 124 EPC 2000, which is flexible enough to allow various forms of minute taking. The Boards of Appeal are considering whether to review minute taking practices in the light of the EPC 2000.)
### Rule 124: Minutes of oral proceedings and of taking of evidence

<table>
<thead>
<tr>
<th>Rule 76 EPC 1973</th>
<th>Rule 124 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>(1)</strong> Minutes of oral proceedings and of the taking of evidence shall be drawn up containing the essentials of the oral proceedings or of the taking of evidence, the relevant statements made by the parties, the testimony of the parties, witnesses or experts and the result of any inspection.</td>
<td><strong>(1)</strong> Unchanged</td>
</tr>
<tr>
<td><strong>(2)</strong> The minutes of the testimony of a witness, expert or party shall be read out or submitted to him so that he may examine them. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. If his approval is not given, his objections shall be noted.</td>
<td><strong>(2)</strong> The minutes of the testimony of a witness, expert or party shall be read out, [...] submitted to him, so that he may examine them or, where they are recorded by technical means, played back to him, unless he waives this right. It shall be noted in the minutes that this formality has been carried out and that the person who gave the testimony approved the minutes. If his approval is not given, his objections shall be noted. It is not necessary to play back the minutes or to obtain approval of them if the testimony has been recorded verbatim and directly using technical means.</td>
</tr>
<tr>
<td><strong>(3)</strong> The minutes shall be authenticated by the employee who drew them up and by the employee who conducted the oral proceedings or taking of evidence, either by their signature or by any other appropriate means.</td>
<td><strong>(3)</strong> The minutes shall be signed by the employee responsible for drawing them up and by the employee who conducted the oral proceedings or taking of evidence [...].</td>
</tr>
<tr>
<td><strong>(4)</strong> The parties shall be provided with a copy of the minutes.</td>
<td><strong>(4)</strong> Unchanged</td>
</tr>
</tbody>
</table>
CHAPTER IV

RULE 125 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

A number of editorial amendments have been made to Rule 77 EPC 1973 which is renumbered as Rule 125 EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 30, points 149-150)

In order to emphasize that the possibility of electronic notification (which will be available in future) is an equivalent to the other means of notification, the notification by electronic means is mentioned in Rule 125(2)(b) EPC 2000.

In addition, the content of Rule 82 EPC 1973 dealing with irregularities in the notification has been moved to new Rule 125(4) EPC 2000 since the assumption in Rule 82 EPC 1973 applies irrespective of the means of notification.
<table>
<thead>
<tr>
<th>Rule 77 EPC 1973</th>
<th>Rule 125 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) In proceedings before the European Patent Office, any notification to be made shall take the form either of the original document, a copy thereof certified by, or bearing the seal of, the European Patent Office or a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.</td>
<td>(1) In proceedings before the European Patent Office, any notification to be made shall take the form [...] of the original document, a copy thereof certified by or bearing the seal of the European Patent Office, or a computer print-out bearing such seal. Copies of documents emanating from the parties themselves shall not require such certification.</td>
</tr>
<tr>
<td>(2) Notification shall be made:</td>
<td>(2) Notification shall be made:</td>
</tr>
<tr>
<td>(a) by post in accordance with Rule 78;</td>
<td>(a) by post in accordance with Rule 126;</td>
</tr>
<tr>
<td>(b) by delivery on the premises of the European Patent Office in accordance with Rule 79;</td>
<td>(b) by technical means of communication in accordance with Rule 127;</td>
</tr>
<tr>
<td>(c) by public notice in accordance with Rule 80, or</td>
<td>(c) by delivery on the premises of the European Patent Office in accordance with Rule 128; or</td>
</tr>
<tr>
<td>(d) by such technical means of communication as determined by the President of the European Patent Office and under the conditions laid down by him governing their use.</td>
<td>(d) by public notice in accordance with Rule 129 [...].</td>
</tr>
<tr>
<td>(3) Notification through the central industrial property office of a Contracting State shall be made in accordance with the provisions applicable to the said office in national proceedings.</td>
<td>(3) Notification through the central industrial property office of a Contracting State shall be made in accordance with the law applicable to that office in national proceedings.</td>
</tr>
</tbody>
</table>

**Rule 82 EPC 1973**

Where a document has reached the addressee, if the European Patent Office is unable to prove that it has been duly notified, or if provisions relating to its notification have not been observed, the document shall be deemed to have been notified on the date established by the European Patent Office as the date of receipt.

**Deleted** - substance moved to Rules 125(2)(b) and 127 EPC 2000

(4) Unchanged
RULE 126 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 78 EPC 1973 which is renumbered as Rule 126 EPC 2000.

RULE 127 EPC

(Explanatory remarks 2006: CA/PL 17/06)

The new Rule 127 EPC 2000 has been inserted to emphasize that electronic notification (which will be available in future) is an equivalent to the other means of notification.
**Rule 126 Notification by post**

<table>
<thead>
<tr>
<th>Rule 78 EPC 1973</th>
<th>Rule 126 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Decisions incurring a time limit for appeal, summonses and other documents as decided on by the President of the European Patent Office shall be notified by registered letter with advice of delivery. All other notifications by post shall be by registered letter.</td>
<td>(1) Decisions incurring a [...] period for appeal or a petition for review, summonses and other such documents as determined by the President of the European Patent Office shall be notified by registered letter with advice of delivery. All other notifications by post shall be by registered letter.</td>
</tr>
<tr>
<td>(2) Where notification is effected by registered letter, whether or not with advice of delivery, this shall be deemed to be delivered to the addressee on the tenth day following its posting, unless the letter has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.</td>
<td>(2) Where notification is effected by registered letter, whether or not with advice of delivery, such letter shall be deemed to be delivered to the addressee on the tenth day following its posting, unless it has failed to reach the addressee or has reached him at a later date; in the event of any dispute, it shall be incumbent on the European Patent Office to establish that the letter has reached its destination or to establish the date on which the letter was delivered to the addressee, as the case may be.</td>
</tr>
<tr>
<td>(3) Notification by registered letter, whether or not with advice of delivery, shall be deemed to have been effected even if acceptance of the letter has been refused.</td>
<td>(3) Unchanged</td>
</tr>
<tr>
<td>(4) To the extent that notification by post is not covered by paragraphs 1 to 3, the law of the State on the territory of which the notification is made shall apply.</td>
<td>(4) To the extent that notification by post is not covered by paragraphs 1 to 3, the law of the State [...] in which the notification is made shall apply.</td>
</tr>
</tbody>
</table>

**Rule 127 Notification by technical means of communication**

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 127 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
<td>Notification may be effected by such technical means of communication as are determined by the President of the European Patent Office and under the conditions laid down by him.</td>
</tr>
</tbody>
</table>
RULE 128 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 79 EPC 1973 which is renumbered as Rule 128 EPC 2000.

RULE 129 EPC

(Explanatory remarks 2006: CA/PL 17/06)

Rule 80 EPC 1973 is unchanged in substance. It is renumbered as Rule 129 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO


RULE 130 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 75(2) and (3) EPC 1973 and the Rule is renumbered as Rule 130 EPC 2000.

Rule 82 EPC 1973 "Irregularities in the notification" has been deleted – its substance has been moved to Rule 125(4) EPC 2000.
### Rule 128 Notification by delivery by hand

<table>
<thead>
<tr>
<th>Rule 79 EPC 1973</th>
<th>Rule 128 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>Notification may be effected on the premises of the European Patent Office by delivery by hand of the document to the addressee, who shall on delivery acknowledge its receipt. Notification shall be deemed to have taken place even if the addressee refuses to accept the document or to acknowledge receipt thereof.</td>
<td>Notification may be effected on the premises of the European Patent Office by delivery by hand of the document to the addressee, who shall on delivery acknowledge its receipt. Notification shall be deemed to have been effected even if the addressee refuses to accept the document or to acknowledge receipt thereof.</td>
</tr>
</tbody>
</table>

### Rule 129 Public notification

<table>
<thead>
<tr>
<th>Rule 80 EPC 1973</th>
<th>Rule 129 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) If the address of the addressee cannot be established, or if notification in accordance with Rule 78, paragraph 1, has proved to be impossible even after a second attempt by the European Patent Office, notification shall be effected by public notice.</td>
<td>(1) If the address of the addressee cannot be established, or if notification in accordance with Rule 126, paragraph 1, has proved to be impossible even after a second attempt […] notification shall be effected by public notice.</td>
</tr>
<tr>
<td>(2) The President of the European Patent Office shall determine how the public notice is to be given and the beginning of the period of one month on the expiry of which the document shall be deemed to have been notified.</td>
<td>(2) Unchanged</td>
</tr>
</tbody>
</table>

### Rule 130 Notification to representatives

<table>
<thead>
<tr>
<th>Rule 81 EPC 1973</th>
<th>Rule 130 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) If a representative has been appointed, notifications shall be addressed to him.</td>
<td>(1) Unchanged</td>
</tr>
<tr>
<td>(2) If several such representatives have been appointed for a single interested party, notification to any one of them shall be sufficient.</td>
<td>(2) If several […] representatives have been appointed for a single […] party, notification to any one of them shall be sufficient.</td>
</tr>
<tr>
<td>(3) If several interested parties have a common representative, notification of a single document to the common representative shall be sufficient.</td>
<td>(3) If several […] parties have a common representative, notification […] to the common representative shall be sufficient.</td>
</tr>
</tbody>
</table>
 CHAPTER V

RULE 131 EPC

Slight drafting changes have been made to Rule 83 EPC 1973 which is renumbered as Rule 131 EPC 2000.
Chapter V  Time limits

<table>
<thead>
<tr>
<th>Rule 131</th>
<th>Calculation of <strong>periods</strong></th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 83 EPC 1973</strong></td>
<td><strong>Rule 131 EPC 2000</strong></td>
</tr>
<tr>
<td>(1) Periods shall be laid down in terms of full years, months, weeks or days.</td>
<td>(1) Unchanged</td>
</tr>
<tr>
<td>(2) Computation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where the procedural step is a notification, the event considered shall be the receipt of the document notified, unless otherwise provided.</td>
<td>(2) Computation shall start on the day following the day on which the relevant event occurred, the event being either a procedural step or the expiry of another period. Where the procedural step is a notification, the <strong>relevant</strong> event [...], shall be the receipt of the document notified, unless otherwise provided.</td>
</tr>
<tr>
<td>(3) When a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.</td>
<td>(3) When a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred; [...] if the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month.</td>
</tr>
<tr>
<td>(4) When a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred, provided that if the relevant subsequent month has no day with the same number the period shall expire on the last day of that month.</td>
<td>(4) When a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred; [...] if the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month.</td>
</tr>
<tr>
<td>(5) When a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred.</td>
<td>(5) Unchanged</td>
</tr>
</tbody>
</table>
RULE 132 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

New Rule 132(1) EPC 2000 makes clear what is meant by a "period to be specified": where a Rule refers to "a period to be specified", this means a period specified by the EPO in the individual case. See for instance Rules 3(3), 5, 53(3), 59, 60(2), 64(1), 70(2), 71(1) and (5), 77(2), 79(1) and (3), 81(2), 94, 95(2), 100(2), 101(2), 108(2), 118(2)(c), 141, 151 and 152 EPC 2000.

The expression "unless otherwise provided" in Rule 132(2) EPC 2000 means unless otherwise provided in the Convention or the Implementing Regulations.

The other amendments are purely editorial.

RULE 133 EPC

The wording of Rule 84a EPC 1973 has been aligned with the style of the EPC 2000. The provision has been renumbered as Rule 133 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 14 July 2007 concerning the application of Rule 133 EPC on the late receipt of documents, Special edition No. 3, OJ EPO 2007, 119, I.1
### Rule 132  Periods specified by the European Patent Office

**Rule 84 EPC 1973**

Where the Convention or these Implementing Regulations specify a period to be determined by the European Patent Office, such period shall be not less than two months nor more than four months; in certain special circumstances it may be up to six months. In certain special cases, the period may be extended upon request, presented before the expiry of such period.

**Rule 132 EPC 2000**

1. Where the Convention or these Implementing Regulations refer to "a period to be specified", this period shall be specified by the European Patent Office.

2. Unless otherwise provided, a period specified by the European Patent Office [...] shall be neither less than two months nor more than four months; in certain [...] circumstances it may be up to six months. In [...] special cases, the period may be extended upon request, presented before the expiry of such period.

### Rule 133  Late receipt of documents

**Rule 84a EPC 1973**

1. A document received late at the European Patent Office shall be deemed to have been received in due time if it was posted, or delivered to a recognised delivery service, in due time before the expiry of the time limit in accordance with the conditions laid down by the President of the European Patent Office, unless the document was received later than three months after expiry of the time limit.

2. Paragraph 1 shall apply mutatis mutandis to the time limits provided for in the Convention where transactions are carried out with the competent authority in accordance with Article 75, paragraph 1(b) or paragraph 2(b).

**Rule 133 EPC 2000**

1. A document received late at the European Patent Office shall be deemed to have been received in due time if it was posted, or delivered to a recognised delivery service, in due time before [...] expiry of the period in accordance with the conditions laid down by the President of the European Patent Office, unless the document was received later than three months after expiry of the period.

2. Paragraph 1 shall apply mutatis mutandis to any period [...] where transactions are carried out with the competent authority in accordance with Article 75, paragraphs 1(b) or [...] 2(b).
EDITORIAL AMENDMENTS TO RULE 85 EPC

Editorial amendments have been made to Rule 85 EPC 1973 which is renumbered as Rule 134 EPC 2000.

Rule 85 EPC 1973 regulated the situation where a period expires on a day on which one of the filing offices of the EPO is not open for receipt of documents, or mail cannot be delivered. This Rule has generally been used in respect of those days when the EPO was closed, such as Saturdays, Sundays and holidays. Although the wording of Rule 85(1) EPC 1973 solely refers to situations where the EPO is closed or mail cannot be delivered, this provision has by analogy served as the legal basis for an extension of periods in a case in which the incoming fax and telephone lines have been largely out of order (cf. Notice from the President of the EPO dated 5 September 2003 concerning the extension of time limits, OJ EPO 2003, 507).

In order to clarify this point, Rule 134(1) EPC 2000 includes a new second sentence which removes any doubts that Rule 134(1) EPC 2000 can apply mutatis mutandis in situations where the EPO, due to reasons laying within its responsibility, is not able to receive incoming faxes or where e.g. the epoline® Online Filing server is not able to receive documents.

Over time, the meaning of "ordinary mail" in Rule 85(1) EPC 1973 has become unclear. If the expression means "mail delivered by post", it would seem restrictive and ill-adapted to contemporary developments in mail delivery methods. In Rule 134(1), first sentence, EPC 2000, the term has therefore been widened by referring simply to "mail".

Whereas Rule 134(1) EPC 2000 concerns internal obstacles to the receipt of documents, Rule 134(2) EPC 2000 relates to external dislocations of mail delivery or transmission. In this context, mail transmission shall cover the filing of documents using the technical means of communication permitted by the President of the EPO.

In Rule 85(2) EPC 1973, the meaning of "interruption" and "dislocation" has given cause for reflection. It might be wiser to stick to a single term. An interruption inevitably entails a dislocation, but a dislocation does not necessarily involve an interruption. With modern means of communication, a complete interruption of mail delivery has become improbable, whereas a dislocation of delivery is always possible. Therefore, the term "dislocation" alone is used in Rule 134(2) and (4) EPC 2000.

Rule 85(4) EPC 1973 was introduced in 1985 in order to avoid losses of rights which could occur if the EPO was not in a position to inform the applicant in time about the expiry of a time period and the imminent expiry of the grace period. Such a provision was necessary, in particular with regard to Rule 85a and 85b EPC 1973 as in force until 30 March 1989. After that date, the grace periods started to run on the notification of a communication pointing out the failure to observe the basic time period. Therefore, this provision has become redundant and can be deleted.
Rule 134  Extension of periods

Rule 85 EPC 1973

(1) If a time limit expires on a day on which one of the filing offices of the European Patent Office in the sense of Article 75, paragraph 1(a) is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, ordinary mail is not delivered there, the time limit shall extend until the first day thereafter on which all the filing offices are open for receipt of documents and on which ordinary mail is delivered.

(2) If a time limit expires on a day on which there is a general interruption or subsequent dislocation in the delivery of mail in a Contracting State or between a Contracting State and the European Patent Office, the time limit shall extend to the first day following the end of the period of interruption or dislocation for parties resident in the State concerned or who have appointed representatives with a place of business in that State. The first sentence shall apply mutatis mutandis if documents filed by one of the technical means of communication permitted by the President of the European Patent Office under Rule 2, paragraph 1, cannot be received.

Rule 134 EPC 2000

(1) If a period expires on a day on which one of the filing offices of the European Patent Office under Rule 35, paragraph 1, is not open for receipt of documents or on which, for reasons other than those referred to in paragraph 2, mail is not delivered there, the period shall extend to the first day thereafter on which all the filing offices are open for receipt of documents and on which mail is delivered. The first sentence shall apply mutatis mutandis if documents filed by one of the technical means of communication permitted by the President of the European Patent Office under Rule 2, paragraph 1, cannot be received.

(2) If a period expires on a day on which there is a general [...] dislocation in the delivery or transmission of mail in a Contracting State [...], the period shall extend to the first day following the end of the interval of dislocation for parties which are resident in the State concerned or [...] have appointed representatives with a place of business in that State. [...] Where the State concerned is the State in which the European Patent Office is located, this provision shall apply to all parties and their representatives. This paragraph shall apply mutatis mutandis to the period referred to in Rule 37, paragraph 2. [...]

(3) Paragraphs 1 and 2 shall apply mutatis mutandis to the time limits provided for in the Convention in the case of transactions carried out with the competent authority in accordance with Article 75, paragraph 1(b) or paragraph 2(b).

(4) If an exceptional occurrence such as a natural disaster or strike interrupts or dislocates the proper functioning of the European Patent Office so that any communication from the Office to parties concerning the expiry of a time limit is delayed, acts to be completed within such a time limit may still be validly completed within one month after the notification of the delayed communication. The date of commencement and the end of any such interruption or dislocation shall be as stated by the President of the European Patent Office.

Deleted
The extension of periods under Rule 134(1) to (3) EPC 2000 occurs automatically by operation of law if the requirements are fulfilled. For reasons of clarity and in line with the current practice of the EPO, new Rule 134(4) EPC 2000 expressly provides that the EPO publishes a notice informing on the commencement and the end of the dislocation.

Rule 134(5) EPC 2000 has been redrafted. It is now applicable not only to dislocation of mail delivery but also to the transmission of mail by technical means of communication.

(In the Patent Law Committee 2006: CA/PL PV 29, points 32-40)

In practice, the EPO has applied a liberal practice seeing interruption as equivalent with dislocations. Thus, if one means of transmission is interrupted, the EPO has accepted this as a dislocation and applied Rule 85 EPC 1973. It is hardly conceivable that all means of communication fail at the same time. On the other hand, one has to consider that forcing an applicant to use alternative means of communication might imply higher fees for the applicant.

**Rule 85a EPC 1973** "Period of grace for payment of fees" and **Rule 85b EPC 1973** "Period of grace for the filing of the request of examination" have been deleted in view of the extended scope of application of further processing under Article 121 EPC 2000 (see explanatory remarks to new Rule 135 EPC 2000).
Rule 134  Extension of periods

(4) The date of commencement and the end of any dislocation under paragraph 2 shall be published by the European Patent Office.

(5) Without prejudice to paragraphs 1 to 4, a party concerned may produce evidence that on any of the ten days preceding the day of expiry of a period the delivery or transmission of mail was dislocated due to an exceptional occurrence such as a natural disaster, war, civil disorder, a general breakdown in any of the technical means of communication permitted by the President of the European Patent Office under Rule 2, paragraph 1, or other like reasons affecting the locality where the party or his representative resides or has his place of business [...]. If the evidence produced satisfies the European Patent Office, a document received late shall be deemed to have been received in due time, provided that the mailing or the transmission was effected at the latest on the fifth day after the end of the dislocation.
RULE 135 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1) and 2006 (CA/PL 17/06)


Rule 135(1) EPC 2000 lays down the requirements (period, fee, completion of omitted act) to be met for the EPO to allow further processing under Article 121(2) EPC 2000. The content of the new Rule largely corresponds to Article 121(2) EPC 1973. However, in view of the broadened scope of application of further processing, the period is no longer triggered by notification of the loss of the European patent application but by notification of either the failure to observe a time limit or of a loss of rights. With regard to the extension of further processing to periods for payment of fees, the former requirement that a request for further processing be made in writing has been waived. Under the new system, the request is to be made simply by payment of the prescribed fee. The amounts of the fees for the various cases are laid down in Article 2, item 12, of the Rules relating to Fees (in the event of late payment of a fee: 50% of the relevant fee; in the event of late performance of the acts required under Rule 71(3) EPC 2000: EUR 210; in other cases: EUR 210).

Article 121(3) EPC 1973 regarding competence for deciding on requests for further processing is transferred to Rule 135(3) EPC 2000.

On the basis of Article 121(4), second sentence, EPC 2000, Rule 135(2) EPC 2000 excludes a number of periods from further processing. Generally, the approach under the EPC 2000 is that there should be no cumulation of legal remedies: e.g., where a means of legal redress already exists for dealing with the non-observance of a time limit, allowing further processing would create a two-tier system for rectifying the error at the first-instance stage which is not desirable.

Rule 6(1) EPC 2000: The two month period for filing a translation under Article 14(2) EPC 2000 has been excluded because the failure to meet this time limit may be remedied under Rule 58 EPC 2000.

Rule 16(1)(a) EPC 2000: The three month period for seeking remedies under Article 61 EPC has been excluded because it is not monitored by the EPO and no communication can be issued if it is missed. The exclusion implicitly recognises that, in principle, the entitled person under Article 61(1) EPC has access to the remedies provided by the EPC to deal with failure to observe periods. Therefore, if he misses this period, he can apply for re-establishment of rights.

Rule 31(2) EPC 2000 laying down periods for subsequent communication of information on deposit of biological material. Where these periods are not complied with, the requirements of Rules 31(1)(c) or (d) and 31(2) EPC 2000 are not fulfilled and the invention cannot be regarded as disclosed under Rule 31 EPC 2000 in connection with Article 83 EPC. For reasons of legal certainty, the legislator has fixed mandatory periods in order to guarantee that the necessary information is available in due time before publication of the patent application or in due time after a right to inspect the files has become known. Due to dual nature of these time periods (formal and substantive) and to the fact that the provisions of Rule 31 EPC 2000 are subordinate to the requirements of Article 83 EPC, further processing is excluded.

Rule 40(3) EPC 2000: The two month periods in connection with a reference to a previously filed application have been excluded because the failure to meet them may be remedied under Rule 58 EPC 2000.

Rule 51(2) EPC 2000: The six month period for payment of renewal fees has been excluded because it is a period of grace (see Article 5bis of the Paris Convention - period of grace for payment of fees), i.e. a remedy whose effect corresponds to further processing. By contrast, re-establishment of rights is possible in respect of the period under Rule 51(2) EPC 2000.
[See Article 121 EPC 1973:
(2) The request shall be filed in writing within two months of the date on which either the decision to refuse the application or the communication that the application is deemed to be withdrawn was notified. The omitted act must be completed within this time limit. The request shall not be deemed to have been filed until the fee for further processing has been paid.

(3) The department competent to decide on the omitted act shall decide on the request.]
Rule 51(3) EPC 2000 laying down periods relating to the payment of renewal fees for divisional applications. If the four month period provided for in Rule 51(3) EPC 2000 for the payment of renewal fees without a surcharge expires and the renewal fees have not been paid, the remedy is already provided for in Rule 51(3), last sentence, EPC 2000, namely the payment with surcharge within six months as of filing the divisional application. The reference in Rule 135(2) EPC 2000 to the whole paragraph 3 of Rule 51 EPC 2000 clarifies that also the six month period of Rule 51(3) EPC 2000 is excluded from further processing like the period under Rule 51(2) EPC 2000.

Rule 51(4) and (5) EPC 2000: Also the periods under Rule 51(4) and (5) EPC 2000 are excluded.

Rule 52(2) and (3) EPC 2000 laying down the 16 month period for filing the declaration of priority or a correction thereof. In view of the publication of the application, the new time period for late declaration or correction of priority under Rule 52(2) EPC 2000 does not permit further processing.

Rule 55 EPC 2000: The period in connection with examination on filing has been excluded because the procedure under this Rule already constitutes a form of legal remedy.

Rule 56 EPC 2000: The period for subsequent filing of missing parts of the description or drawings has been excluded because the procedure under this Rule already constitutes a form of legal remedy.

Rules 58 and 59 EPC 2000: The periods in connection with correction of deficiencies after formalities examination have been excluded because the procedures under these Rules constitute a form of legal remedy.

Rule 64 EPC 2000 laying down the period for paying additional search fees when there is a lack of unity of invention. This preserves the legal situation under the EPC 1973 and avoids complex procedural problems in a case where the EPO is not aware of any real need for further processing.

Rule 112(2) EPC 2000: The two month period in connection with the request for an appealable decision has been excluded because this provision allows for an administrative review of any loss of rights resulting from the EPC. If the time limit for requesting such a review is missed, the loss of rights becomes final without any further decision or communication being issued by the EPO. Thus the necessary procedural starting point for further processing is lacking. However, further processing also has to be ruled out on substantive grounds, as the procedure under Rule 112(2) EPC 2000 already has a remedial character.

(In the Patent Law Committee 2002: CA/PL PV 19, point 76-79)

Following requests to lift some of the exclusions in Rule 135(2) EPC 2000, the EPO emphasized that under the EPC 2000 further processing will be the standard legal remedy in the grant procedure. This means that there will be no choice between legal remedies, and no cumulation of legal remedies (e.g., further processing and re-establishment of rights). In practice, further processing will be a procedural means of getting a retrospective extension by paying a fee. This has been taken into account when ruling out further processing in respect of certain time periods. The approach in the EPC 2000 is based on the idea that in the case of non-observance of time periods, there should always be one opportunity for rectification.

Specifically, on the exclusion of the periods under Rules 55, 56, 58 and 59 EPC 2000, the EPO explained that, as means of legal redress already existed for dealing with the non-observance of time periods set for examination on filing and formalities examination, allowing further processing would create a two-tier system for rectifying errors at the first-instance stage. This would go against the efforts to streamline the patent grant procedure.

(See also Explanatory remarks 2006: CA/PL 29/06 Add.1; discussion in the Patent Law Committee 2006: CA/PL PV 30, points 151-158)
RULE 136 EPC


Rule 136(1) EPC 2000, based on Article 122(2) and (3) EPC 1973, lays down the various periods for filing a request for re-establishment. The words "but at the latest" bring the English version into line with the German version ("spätestens jedoch"). Rule 136(1), last sentence, EPC 2000 establishes the requirement for payment of a fee (see Article 2, item 13, of the Rules relating to Fees: EUR 550).

Concerning re-establishment of rights in respect of the time period for payment of renewal fees
To simplify the structure and in view of the relevant provisions of the Patent Law Treaty of 1 June 2000 (PLT) (Article 12(1)(ii) and Rule 13(2)(ii) PLT), the six month period of grace under the new Rule 51(2) EPC 2000 is not to be deducted from the period of one year for requesting re-establishment of rights. The latter period now begins on expiry of the six month period for payment of renewal fees, instead of on the date when payment falls due. Under Rule 112 EPC 2000, a (computer-generated) communication is automatically sent to the applicant within two months of the expiry of the period; in practice, therefore, the period for requesting re-establishment of rights in such cases will seldom be invoked, and the de facto extension of this period under the EPC 2000 does not put third parties at an unreasonable disadvantage.

Concerning re-establishment of rights in respect of the priority period
Under the EPC 2000, re-establishment of rights is also possible in respect of the priority period under Article 87(1) EPC. However, in view of the central importance of the date of filing and/or priority for the valid claiming of priority, Rule 136(1), second sentence, EPC 2000 lays down a time period specifically for such cases where there is an urgent need for clarity. Any request for re-establishment of rights in respect of the priority period must be filed within two months of the expiry of that period (see also Article 13(2) and Rule 14(4) PLT).

Concerning re-establishment of rights in respect of the time period for filing a petition for review
Likewise, the maximum period for requesting re-establishment of rights in respect of the time period for filing a petition for review under Article 112a EPC has been abridged from the normal period of one year to two months from expiry of the two month periods referred to in Article 112a(4) EPC. The reason is that, in virtually all appeal cases, the unrestricted possibility of re-establishment of rights in respect of the time periods under Article 112a(4) EPC would entail an additional one year period of uncertainty as to whether the decision of the Board of Appeal has final legal force. This uncertainty would affect the parties, the public at large and the first instance (e.g. in cases of remittal). In the context of the special procedure under Article 112a EPC, the balancing of advantages and disadvantages of re-establishment of rights (justice in an individual case versus burdening the entire system with continued uncertainty as to the legal effect of decisions) requires an appropriate approach. The overriding need for legal certainty in this late procedural stage is met by providing for a maximum period of two months for requests for re-establishment in respect of the time period for filing a petition for review.

Rule 136(2) EPC 2000 incorporates the provisions of Article 122(2) and (3) EPC 1973 concerning the statement of grounds and facts and the completion of the omitted act.

Rule 136(3) EPC 2000, based on Article 122(4), second sentence, EPC 2000, rules out the re-establishment of rights in respect of any periods for which further processing is available. Under the new system, either further processing or re-establishment of rights may be requested if a specific period has been missed. During the grant procedure, only further processing will normally be available – re-establishment of rights thus only comes into play where further processing is excluded with regard to a specific period (see, in particular, Rule 135(2) EPC 2000). The limitation of the possibility of re-establishment of rights during the grant procedure is, however, offset to some extent by the fact that re-establishment of rights in respect of the period for further processing will continue to be possible.

Rule 136(4) EPC 2000 incorporates Article 122(4) EPC 1973 regarding competence for decisions on requests for re-establishment of rights.

(See discussion in the Patent Law Committee 2006: CA/PL PV 30, points 159-160)
Rule 136  Re-establishment of rights

**EPC 1973**

[See Article 122 EPC 1973:

(2) The application must be filed in writing within two months from the removal of the cause of non-compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit. In the case of non-payment of a renewal fee, the period specified in Article 86, paragraph 2, shall be deducted from the period of one year.

(3) The application must state the grounds on which it is based, and must set out the facts on which it relies. It shall not be deemed to be filed until after the fee for re-establishment of rights has been paid.

(4) The department competent to decide on the omitted act shall decide upon the application.]

**Rule 136 EPC 2000**

(1) Any request for re-establishment of rights under Article 122, paragraph 1, shall be filed in writing within two months of the removal of the cause of non-compliance with the period, but at the latest within one year of expiry of the unobserved time limit. However, a request for re-establishment of rights in respect of any of the periods specified in Article 87, paragraph 1, and in Article 112a, paragraph 4, shall be filed within two months of expiry of that period. The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid.

(2) The request shall state the grounds on which it is based and shall set out the facts on which it relies. The omitted act shall be completed within the relevant period for filing the request according to paragraph 1.

(3) Re-establishment of rights shall be ruled out in respect of any period for which further processing under Article 121 is available and in respect of the period for requesting re-establishment of rights.

(4) The department competent to decide on the omitted act shall decide on the request for re-establishment of rights.
CHAPTER VI

RULE 137 EPC

Slight drafting changes have been made to Rule 86 EPC 1973 which is renumbered as Rule 137 EPC 2000.

The expression "unless otherwise provided" in Rule 137(1) EPC 2000 means unless otherwise provided in the Convention or the Implementing Regulations.

RULE 138 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 138 EPC 2000 takes account of the revised Article 54 EPC 2000.
### Chapter VI Amendments and corrections

**Rule 137 Amendment of the European patent application**

<table>
<thead>
<tr>
<th>Rule 86 EPC 1973</th>
<th>Rule 137 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application except where otherwise provided.</td>
<td>(1) Before receiving the European search report, the applicant may not amend the description, claims or drawings of a European patent application unless otherwise provided.</td>
</tr>
<tr>
<td>(2) After receiving the European search report and before receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend the description, claims and drawings.</td>
<td>(2) After receipt of the European search report, the applicant may, of his own volition, amend the description, claims and drawings.</td>
</tr>
<tr>
<td>(3) After receipt of the first communication from the Examining Division, the applicant may, of his own volition, amend once the description, claims and drawings provided that the amendment is filed at the same time as the reply to the communication. No further amendment may be made without the consent of the Examining Division.</td>
<td>(3) Unchanged</td>
</tr>
<tr>
<td>(4) Amended claims may not relate to unsearched subject-matter which does not combine with the originally claimed invention or group of inventions to form a single general inventive concept.</td>
<td>(4) Unchanged</td>
</tr>
</tbody>
</table>

**Rule 138 Different claims, description and drawings for different States**

<table>
<thead>
<tr>
<th>Rule 87 EPC 1973</th>
<th>Rule 138 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>If the European Patent Office notes that, in respect of one or some of the designated Contracting States, the content of an earlier European patent application forms part of the state of the art pursuant to Article 54, paragraphs 3 and 4, or if it is informed of the existence of a prior right under Article 139, paragraph 2, the European patent application or European patent may contain for such State or States claims and, if the European Patent Office considers it necessary, a description and drawings which are different from those for the other designated Contracting States.</td>
<td>If the European Patent Office [...] is informed of the existence of a prior right under Article 139, paragraph 2, the European patent application or European patent may, [...] for such State or States, contain claims and, where [...] necessary, a description and drawings which are different from those for the other designated States.</td>
</tr>
</tbody>
</table>
RULE 139 EPC

A slight drafting change has been made to Rule 88 EPC 1973. It has been renumbered as **Rule 139 EPC 2000**.

RULE 140 EPC

Rule 89 EPC 1973 is unchanged but renumbered as **Rule 140 EPC 2000**.

CHAPTER VII

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The **new Chapter VII**, headed "Information on prior art", contains the new Rule 141 EPC 2000, which takes account of Article 124(1) EPC 2000.

RULE 141 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Under the **new Rule 141 EPC 2000**, the EPO may require from the applicant in particular information on prior art relied upon in the examination of similar applications in respect of an invention to which the European patent application relates.

The EPO shall specify in the individual case the "period to be specified" referred to in **Rule 141 EPC 2000** (new Rule 132(2) EPC 2000 provides that, as a general rule, the period shall be neither less than two months nor more than four months).

(See also discussion in the Patent Law Committee 2002: CA/PL PV 19, points 82-85)
### Rule 139  Correction of errors in documents filed with the European Patent Office

<table>
<thead>
<tr>
<th>Rule 88 EPC 1973</th>
<th>Rule 139 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns a description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.</td>
<td>Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns the description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.</td>
</tr>
</tbody>
</table>

### Rule 140  Correction of errors in decisions

<table>
<thead>
<tr>
<th>Rule 89 EPC 1973</th>
<th>Rule 140 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>In decisions of the European Patent Office, only linguistic errors, errors of transcription and obvious mistakes may be corrected.</td>
<td>Unchanged</td>
</tr>
</tbody>
</table>

### Chapter VII  Information on prior art

<table>
<thead>
<tr>
<th>Rule 141  Information on prior art</th>
</tr>
</thead>
<tbody>
<tr>
<td>EPC 1973</td>
</tr>
<tr>
<td>The EPC 1973 did not contain an equivalent provision.</td>
</tr>
</tbody>
</table>
CHAPTER VIII

RULE 142 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 90 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 142 EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning the responsibilities of the Legal Division, Special edition No. 3, OJ EPO 2007, 113, G.1
### Chapter VIII  Interruption of proceedings

#### Rule 142  Interruption of proceedings

<table>
<thead>
<tr>
<th>Rule 90 EPC 1973</th>
<th>Rule 142 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>(1)</strong> Proceedings before the European Patent Office shall be interrupted:</td>
<td><strong>(1)</strong> Proceedings before the European Patent Office shall be interrupted:</td>
</tr>
<tr>
<td>(a) in the event of the death or legal incapacity of the applicant for or proprietor of a European patent or of the person authorised by national law to act on his behalf. To the extent that the above events do not affect the authorisation of a representative appointed under Article 134, proceedings shall be interrupted only on application by such representative;</td>
<td>(a) Unchanged</td>
</tr>
<tr>
<td>(b) in the event of the applicant for or proprietor of a European patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings before the European Patent Office;</td>
<td>(b) in the event of the applicant for or proprietor of a […] patent, as a result of some action taken against his property, being prevented by legal reasons from continuing the proceedings […].</td>
</tr>
<tr>
<td>(c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a European patent or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings before the European Patent Office.</td>
<td>(c) in the event of the death or legal incapacity of the representative of an applicant for or proprietor of a […] patent, or of his being prevented for legal reasons resulting from action taken against his property from continuing the proceedings […].</td>
</tr>
<tr>
<td><strong>(2)</strong> When, in the cases referred to in paragraph 1 (a) and (b), the European Patent Office has been informed of the identity of the person authorised to continue the proceedings before the European Patent Office, the European Patent Office shall communicate to such person and to any interested third party that the proceedings shall be resumed as from a date to be fixed by the European Patent Office.</td>
<td><strong>(2)</strong> When, in the cases referred to in paragraph 1(a) or (b), the European Patent Office has been informed of the identity of the person authorised to continue the proceedings […], it shall notify such person and, where applicable, […] any […] third party, that the proceedings will be resumed as from a specified date […].</td>
</tr>
<tr>
<td><strong>(3)</strong> In the case referred to in paragraph 1(c), the proceedings shall be resumed when the European Patent Office has been informed of the appointment of a new representative of the applicant or when the European Patent Office has notified to the other parties the communication of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the European Patent Office has not been informed of the appointment of a new representative, it shall communicate to the applicant for or proprietor of the patent:</td>
<td><strong>(3)</strong> In the case referred to in paragraph 1(c), the proceedings shall be resumed when the European Patent Office has been informed of the appointment of a new representative of the applicant or when the […] Office has informed the other parties […] of the appointment of a new representative of the proprietor of the patent. If, three months after the beginning of the interruption of the proceedings, the European Patent Office has not been informed of the appointment of a new representative, it shall communicate to the applicant for or proprietor of the patent:</td>
</tr>
</tbody>
</table>
Rule 91 EPC 1973  “Waiving of enforced recovery procedures” has been deleted – its substance has been transferred to Article 13(4) of the Rules relating to Fees.
**Rule 142  Interruption of proceedings**

(a) where Article 133, paragraph 2, is applicable, that the European patent application will be deemed to be withdrawn or the European patent will be revoked if the information is not submitted within two months after this communication is notified, or

(b) where Article 133, paragraph 2, is not applicable, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the date on which this communication is notified.

(4) The time limits, other than the time limit for making a request for examination and the time limit for paying the renewal fees, in force as regards the applicant for or proprietor of the patent at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed. If such date is less than two months before the end of the period within which the request for examination must be filed, such a request may be filed up to the end of two months after such date.

(a) Unchanged

(b) otherwise, that the proceedings will be resumed with the applicant for or proprietor of the patent as from the notification of this communication.

(4) Any periods, other than those for requesting examination and paying renewal fees, in force at the date of interruption of the proceedings, shall begin again as from the day on which the proceedings are resumed. If such date is less than two months before the end of the period within which the request for examination must be filed, such a request may be filed within two months of such date.
CHAPTER IX

RULE 143 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1 and 2006: CA/PL 11/06, CA/PL 17/06)

The EPC 2000 introduces two new procedures which have to be mentioned in the European Patent Register:
- the request for limitation or revocation of a European patent (Articles 105a to 105c EPC) and
- the petition for review by the Enlarged Board of Appeal (Article 112a EPC).

Rule 143(1) EPC 2000, concerning entries in the European Patent Register, therefore includes
- a new sub-paragraph (x) for the date and purport of the decision on a request for limitation or revocation,
- a new sub-paragraph (y) for the date and purport of a decision of the Enlarged Board of Appeal on the petition for review.

In addition, several editorial amendments have been made to Rule 92 EPC 1973 and cross-references have been updated.

Finally, Rule 92(3) EPC 1973 has been deleted, as there is no need for a legal basis in the Implementing Regulations for the delivery of extracts from the European Patent Register.

Relevant decisions from the President of the EPO and notices from the EPO

Rule 143(2) EPC 2000: Decision dated 12 July 2007 concerning the information given in the European Patent Register, Special edition No. 3, OJ EPO 2007, 100, E.1
### Rule 143 Entries in the European Patent Register

#### Rule 92 EPC 1973

(1) The Register of European Patents shall contain the following entries:

(a) number of the European patent application;

(b) date of filing of the European patent application;

(c) title of the invention;

(d) classification code given to the European patent application;

(e) the Contracting States designated;

(f) family name, given names, address and the State in which the residence or principal place of business of the applicant for or proprietor of the European patent is located;

(g) family name, given names and address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 18, paragraph 1;

(h) family name, given names and address of the representative of the applicant for or proprietor of the patent referred to in Article 134; in the case of several representatives only the family name, given names and address of the place of business of the representative first named, followed by the words "and others", shall be entered; however, in the case of an association referred to in Rule 101, paragraph 9, only the name and address of the association shall be entered;

(i) priority data (date, State and file number of the previous application);

(j) in the event of a division of the European patent application, the numbers of the European divisional applications;

(k) in the case of European divisional applications and a new European patent application under Article 61, paragraph 1(b), the information referred to under sub-paragraphs (a), (b) and (i) with regard to the earlier European patent application;

#### Rule 143 EPC 2000

(1) The European Patent Register shall contain the following entries:

(a) Unchanged

(b) date of filing of the [...] application;

(c) Unchanged

(d) classification symbols assigned to the [...] application;

(e) Unchanged

(f) particulars of the applicant for or proprietor of the [...] patent [...] as provided in Rule 41, paragraph 2(c);

(g) family name, given names and address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20, paragraph 1;

(h) particulars of the representative of the applicant for or proprietor of the patent as provided in Rule 41, paragraph 2(d); in the case of several representatives only the particulars of the representative first named, followed by the words "and others" [...] and, in the case of an association referred to in Rule 152, paragraph 11, only the name and address of the association [...];

(i) Unchanged

(j) in the event of a division of the [...] application, the numbers of all the [...] divisional applications;

(k) in the case of a divisional application [...] or a new [...] application under Article 61, paragraph 1(b), the information referred to in sub-paragraphs (a), (b) and (i) with regard to the earlier [...] application;
Rule 143  Entries in the **European Patent Register**

(1) date of publication of the European patent application and where appropriate date of the separate publication of the European search report;

(2) The President of the European Patent Office may decide that entries other than those referred to in paragraph 1 shall be made in the Register of European Patents.

(3) Excerpts from the Register of European Patents shall be delivered on request on payment of an administrative fee.

(2) The President of the European Patent Office may decide that entries other than those referred to in paragraph 1 shall be made in the Register of European Patents.

Deleted
**RULE 144 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 93 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as **Rule 144 EPC 2000**.

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning documents excluded from file inspection, Special edition No. 3, OJ EPO 2007, 125, J.3

**RULE 145 EPC**

Rule 94 EPC 1973 is unchanged but has been renumbered as **Rule 145 EPC 2000**.

Relevant decisions from the President of the EPO and notices from the EPO

### Rule 144  Parts of the file excluded from inspection

#### Rule 93 EPC 1973

The parts of the file which shall be excluded from inspection pursuant to Article 128, paragraph 4, shall be:

(a) the documents relating to the exclusion of or objections to members of the Boards of Appeal or of the Enlarged Board of Appeal;

(b) draft decisions and opinions, and all other documents, used for the preparation of decisions and opinions, which are not communicated to the parties;

(c) the designation of the inventor, if he has waived his right to be mentioned under Rule 18, paragraph 1;

(d) any other document excluded from inspection by the President of the European Patent Office on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the resulting patent.

#### Rule 144 EPC 2000

The parts of the file [... excluded from inspection under Article 128, paragraph 4, shall be:

(a) Unchanged

(b) draft decisions and notices, and all other documents, used for the preparation of decisions and notices, which are not communicated to the parties;

(c) the designation of the inventor, if he has waived his right to be mentioned under Rule 20, paragraph 1;

(d) any other document excluded from inspection by the President of the European Patent Office on the ground that such inspection would not serve the purpose of informing the public about the European patent application or the [... European patent.

### Rule 145  Procedures for the inspection of files

#### Rule 94 EPC 1973

(1) Inspection of the files of European patent applications and patents shall either be of the original document, or of copies thereof, or of technical means of storage if the files are stored in this way.

(2) The President of the European Patent Office shall determine all file-inspection arrangements, including the circumstances in which an administrative fee is payable.

#### Rule 145 EPC 2000

(1) Unchanged

(2) Unchanged
RULE 146 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 95 EPC 1973 which is renumbered as Rule 146 EPC 2000.

(In the Patent Law Committee 2006: CA/PL PV 31, points 39-40)

RULE 147 EPC

(In the Patent Law Committee 2002: CA/PL PV 19, points 86-88)

Discussion on preservation of files where patents are revoked or claims limited in limitation proceedings (Rule 147(4) EPC 2000).

Relevant decisions from the President of the EPO and notices from the EPO

Decision dated 12 July 2007 concerning use of the PHOENIX electronic file system for the creation, maintenance and preservation of files, Special edition No. 3, OJ EPO 2007, 121, J.1

Rule 96 EPC 1973 “Additional publications by the European Patent Office” has been deleted.
The substance of Article 128(5)(a) to (e) EPC 1973 has been incorporated in Rule 19(3) EPC 2000.
### Rule 146 Communication of information contained in the files

#### Rule 95 EPC 1973

Subject to the restrictions provided for in Article 128, paragraphs 1 to 4, and in Rule 93, the European Patent Office may, upon request, communicate information concerning any file of a European patent application or European patent subject to the payment of an administrative fee. However, the European Patent Office may require the exercise of the option to obtain inspection of the file itself should it deem this to be appropriate in view of the quantity of information to be supplied.

#### Rule 146 EPC 2000

Subject to the restrictions laid down in Article 128, paragraphs 1 to 4, and in Rule 144, the European Patent Office may, upon request, communicate information concerning any file relating to a European patent application or European patent, subject to the payment of an administrative fee. However, the European Patent Office may refer to the option of file inspection where it deems this to be appropriate in view of the quantity of information to be supplied.

### Rule 147 Constitution, maintenance and preservation of files

#### Rule 95a EPC 1973

1. The European Patent Office shall constitute, maintain and preserve files relating to all European patent applications and patents.

2. The President of the European Patent Office shall determine the form in which the files relating to European patent applications and patents shall be constituted, maintained and preserved.

3. Documents incorporated in an electronic file shall be considered to be originals.

4. Files relating to European patent applications and patents shall be preserved for at least five years from the end of the year in which:

   a. the application is refused or withdrawn or is deemed to be withdrawn;
   
   b. the patent is revoked pursuant to opposition proceedings; or
   
   c. the patent or the extended term or corresponding protection under Article 63, paragraph 2, lapses in the last of the designated States.

5. Without prejudice to paragraph 4, files relating to European patent applications which have given rise to divisional applications under Article 76 or new applications under Article 61, paragraph 1(b), shall be preserved for at least the same period as the files relating to any one of these last applications. The same shall apply to files relating to any resulting European patents.

#### Rule 147 EPC 2000

1. Unchanged

2. The President of the European Patent Office shall determine the form in which these files [...] shall be constituted, maintained and preserved.

3. Unchanged

4. Any files [...] shall be preserved for at least five years from the end of the year in which:

   a. the application is refused or withdrawn or is deemed to be withdrawn;
   
   b. the patent is revoked [...] by the European Patent Office; or
   
   c. the patent or the [...] corresponding protection under Article 63, paragraph 2, lapses in the last of the designated States.

5. Without prejudice to paragraph 4, files relating to [...] applications which have given rise to divisional applications under Article 76 or new applications under Article 61, paragraph 1(b), shall be preserved for at least the same period as the files relating to any one of these last applications. The same shall apply to files relating to any resulting European patents.
CHAPTER X

RULE 148 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 97 EPC 1973 which is renumbered as Rule 148 EPC 2000.

RULE 149 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 98 EPC 1973 which is renumbered as Rule 149 EPC 2000.
## Chapter X  Legal and administrative co-operation

<table>
<thead>
<tr>
<th>Rule 148</th>
<th>Communications between the European Patent Office and the authorities of the Contracting States</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 97 EPC 1973</strong></td>
<td>(1) Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of the Convention shall be effected directly between these authorities. Communications between the European Patent Office and the courts or other authorities of the Contracting States may be effected through the intermediary of the above central industrial property offices.</td>
</tr>
<tr>
<td><strong>Rule 148 EPC 2000</strong></td>
<td>(1) Communications between the European Patent Office and the central industrial property offices of the Contracting States which arise out of the application of this Convention shall be effected directly between these authorities. Communications between the European Patent Office and the courts or other authorities of the Contracting States may be effected through the intermediary of the said central industrial property offices.</td>
</tr>
<tr>
<td>(2) Expenditure in respect of communications under paragraph 1 shall be chargeable to the authority making the communications, which shall be exempt from fees.</td>
<td></td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Rule 149</th>
<th>Inspection of files by or via courts or authorities of the Contracting States</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Rule 98 EPC 1973</strong></td>
<td>(1) Inspection of the files of European patent applications or of European patents by courts or authorities of the Contracting States shall be of the original documents or of copies thereof; Rule 94 shall not apply.</td>
</tr>
<tr>
<td><strong>Rule 149 EPC 2000</strong></td>
<td>(1) Inspection of the files of European patent applications or of European patents by courts or authorities of the Contracting States shall be of the original documents or of copies thereof; Rule 145 shall not apply.</td>
</tr>
<tr>
<td>(2) Courts or Public Prosecutors’ Offices of the Contracting States may, in the course of their proceedings, communicate to third parties files or copies thereof transmitted to them by the European Patent Office. Such communications shall be effected in accordance with the conditions laid down in Article 128; they shall not incur the payment of the administrative fee.</td>
<td></td>
</tr>
<tr>
<td>(2) Courts or Public Prosecutors’ offices of the Contracting States may, in the course of their proceedings, communicate to third parties files or copies thereof transmitted to them by the European Patent Office. Such communications shall be effected in accordance with [...] Article 128 and shall not be subject to any fee.</td>
<td></td>
</tr>
<tr>
<td>(3) The European Patent Office shall, at the time of transmission of the files or copies thereof to the courts or Public Prosecutors’ Offices of the Contracting States, indicate such restrictions as may, under Article 128, paragraphs 1 and 4, be applicable to the communication to third parties of files concerning a European patent application or a European patent.</td>
<td></td>
</tr>
<tr>
<td>(3) The European Patent Office shall, when transmitting the files [...] draw attention to the restrictions which may, under Article 128, paragraphs 1 and 4, apply to file inspection by third parties [...] .</td>
<td></td>
</tr>
</tbody>
</table>
RULE 150 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Editorial amendments have been made to Rule 99 EPC 1973 which is renumbered as Rule 150 EPC 2000.
## Rule 150 Procedure for letters rogatory

### Rule 99 EPC 1973

1. Each Contracting State shall designate a central authority which will undertake to receive letters rogatory issued by the European Patent Office and to transmit them to the authority competent to execute them.

2. The European Patent Office shall draw up letters rogatory in the language of the competent authority or shall attach to such letters rogatory a translation into the language of that authority.

3. Subject to the provisions of paragraphs 5 and 6, the competent authority shall apply its own law as to the procedures to be followed in executing such requests. In particular, it shall apply appropriate measures of compulsion in accordance with its own law.

4. If the authority to which the letters rogatory are transmitted is not competent to execute them, the letters rogatory shall be sent forthwith to the central authority referred to in paragraph 1. That authority shall transmit the letters rogatory either to the competent authority in that State, or to the European Patent Office where no authority is competent in that State.

5. The European Patent Office shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place and shall inform the parties, witnesses and experts concerned.

6. If so requested by the European Patent Office, the competent authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent authority.

### Rule 150 EPC 2000

1. Each Contracting State shall designate a court or authority competent to execute them.

2. The European Patent Office shall draw up letters rogatory in the language of the competent court or authority or shall attach to such letters rogatory a translation into the language of that authority.

3. Subject to [...] paragraphs 5 and 6, the competent court or authority shall apply national law as to the procedures to be followed in executing such requests and, in particular, as to the appropriate measures of compulsion [...].

4. If the court or authority to which the letters rogatory are transmitted is not competent to execute them, the letters rogatory shall be sent forthwith to the central authority referred to in paragraph 1. That authority shall transmit the letters rogatory either to the competent court or authority in that State, or to the European Patent Office where no court or authority is competent in that State.

5. Unchanged

6. If so requested by the European Patent Office, the competent court or authority shall permit the attendance of members of the department concerned and allow them to question any person giving evidence either directly or through the competent court or authority.
Rule 150  Procedure for letters rogatory

(7) The execution of letters rogatory shall not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the Organisation to reimburse any fees paid to experts and interpreters and the costs incurred by the procedure of paragraph 6.

(8) If the law applied by the competent authority obliges the parties to secure evidence and the authority is not able itself to execute the letters rogatory, that authority may, with the consent of the European Patent Office, appoint a suitable person to do so. When seeking the consent of the European Patent Office, the competent authority shall indicate the approximate costs which would result from this procedure. If the European Patent Office gives its consent, the Organisation shall reimburse any costs incurred; without such consent, the Organisation shall not be liable for such costs.

(7) The execution of letters rogatory shall not give rise to any reimbursement of fees or costs of any nature. Nevertheless, the State in which letters rogatory are executed has the right to require the Organisation to reimburse any fees paid to experts or interpreters and the costs arising from the procedure under paragraph 6.

(8) If the law applied by the competent court or authority obliges the parties to secure evidence and the competent court or authority is not able itself to execute the letters rogatory, that court or authority may, with the consent of the European Patent Office, appoint a suitable person to do so. When seeking such consent, the competent court or authority shall indicate the approximate costs which would result from this procedure. If the European Patent Office gives its consent, the Organisation shall reimburse any costs incurred; otherwise, the Organisation shall not be liable for such costs.
CHAPTER XI

RULE 151 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 100 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000. It is renumbered as Rule 151 EPC 2000.
### Representation

#### Rule 151 Appointment of a common representative

<table>
<thead>
<tr>
<th>Rule 100 EPC 1973</th>
<th>Rule 151 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) If there is more than one applicant and the request for the grant of a</td>
<td>(1) If there is more than one applicant and the request for the grant of a</td>
</tr>
<tr>
<td>European patent does not name a common representative, the applicant first</td>
<td>European patent does not name a common representative, the applicant first</td>
</tr>
<tr>
<td>named in the request shall be considered to be the common representative.</td>
<td>named in the request shall be <strong>deemed</strong> to be the common representative.</td>
</tr>
<tr>
<td>However, if one of the applicants is obliged to appoint a professional</td>
<td>However, if one of the applicants is obliged to appoint a professional</td>
</tr>
<tr>
<td>representative this representative shall be considered to be the common</td>
<td>representative this representative shall be <strong>deemed</strong> to be the common</td>
</tr>
<tr>
<td>representative unless the first named applicant has appointed a professional</td>
<td>representative, unless the [...] applicant first named has appointed a</td>
</tr>
<tr>
<td>representative. The same shall apply <strong>mutatis mutandis</strong> to third parties acting</td>
<td>professional representative. The same shall apply <strong>mutatis mutandis</strong> to third</td>
</tr>
<tr>
<td>in filing notice of opposition or intervention and to joint proprietors of a</td>
<td>parties acting in common in filing a notice of opposition or intervention and to</td>
</tr>
<tr>
<td>European patent.</td>
<td>joint proprietors of a European patent.</td>
</tr>
<tr>
<td>(2) If, during the course of proceedings, transfer is made to more than one</td>
<td>(2) <strong>If the European patent application is transferred</strong> to more than one person,</td>
</tr>
<tr>
<td>person, and such persons have not appointed a common representative, paragraph 1</td>
<td>and such persons have not appointed a common representative, paragraph 1 shall</td>
</tr>
<tr>
<td>shall apply. If such application is not possible, the European Patent Office</td>
<td>apply <strong>mutatis mutandis</strong>. If such application is not possible, the European</td>
</tr>
<tr>
<td>shall require such persons to appoint a common representative within two months.</td>
<td>Patent Office shall <strong>invite</strong> such persons to appoint a common representative</td>
</tr>
<tr>
<td>If this request is not complied with, the European Patent Office shall appoint the</td>
<td>within a <strong>period to be specified</strong>. If this <strong>invitation</strong> is not complied with,</td>
</tr>
<tr>
<td>common representative.</td>
<td>the European Patent Office shall appoint the common representative.</td>
</tr>
</tbody>
</table>
RULE 152 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 101(1) EPC 1973 is somewhat misleading in that the first sentence implies that in principle, unless requested to do so, representatives need not file a signed authorisation, when in fact, in the cases laid down by the President, representatives are to file an authorisation and will receive an invitation should they fail to do so. For the sake of clarity, Rule 101(1) EPC 1973 has therefore been redrafted and subdivided into Rule 152(1) to (3) EPC 2000.

In addition, Rule 101 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.

Relevant decisions from the President of the EPO and notices from the EPO

Rule 152 Authorisations

**Rule 101 EPC 1973**

(1) Representatives acting before the European Patent Office shall upon request file a signed authorisation within a period to be specified by the European Patent Office. The President of the European Patent Office shall determine the cases where an authorisation is to be filed.

The authorisation may cover one or more European patent applications or European patents and shall be filed in the corresponding number of copies.

Where the requirements of Article 133, paragraph 2, have not been satisfied, the same period shall be specified for the notification of the appointment of a representative and for the filing of the authorisation.

(2) A general authorisation enabling a representative to act in respect of all the patent transactions of the party making the authorisation may be filed. A single copy shall be sufficient.

(3) The President of the European Patent Office may determine and publish in the Official Journal of the European Patent Office the form and content of:

(a) an authorisation in so far as it relates to the representation of persons as defined in Article 133, paragraph 2;

(b) a general authorisation.

(4) If the authorisation is not filed in due time, any procedural steps taken by the representative other than the filing of a European patent application shall, without prejudice to any other legal consequences provided for in the Convention, be deemed not to have been taken.

(5) The provisions of paragraphs 1 and 2 shall apply mutatis mutandis to a document withdrawing an authorisation.

**Rule 152 EPC 2000**

(1) [...] The President of the European Patent Office shall determine the cases in which a signed authorisation shall be filed by representatives acting before the European Patent Office.

(2) Where a representative fails to file such an authorisation, the European Patent Office shall invite him to do so within a period to be specified [...]. The authorisation may cover one or more European patent applications or European patents and shall be filed in the corresponding number of copies.

(3) Where the requirements of Article 133, paragraph 2, have not been satisfied, the same period shall be specified for the [...] appointment of a representative and the filing of the authorisation.

(4) A general authorisation may be filed enabling a representative to act in respect of all the patent transactions of a party [...]. A single copy shall suffice.

(5) The President of the European Patent Office may determine [...] the form and content of:

(a) an authorisation relating to the representation of persons under Article 133, paragraph 2;

(b) Unchanged

(6) If a required authorisation is not filed in due time, any procedural steps taken by the representative, other than the filing of a European patent application, shall be deemed not to have been taken, without prejudice to any other legal consequences provided for by this Convention [...].

(7) Paragraphs 2 and 4 shall apply to the withdrawal of an authorisation.
Rule 152  Authorisations

(6) Any representative who has ceased to be authorised shall continue to be regarded as the representative until the termination of his authorization has been communicated to the European Patent Office.

(7) Subject to any provisions to the contrary contained therein, an authorisation shall not terminate vis-à-vis the European Patent Office upon the death of the person who gave it.

(8) If several representatives are appointed by a party, they may, notwithstanding any provisions to the contrary in the notification of their appointment or in the authorisation, act either jointly or singly.

(9) The authorisation of an association of representatives shall be deemed to be authorisation of any representative who can establish that he practises within that association.

(10) If a party appoints several representatives, they may act either jointly or singly, notwithstanding any provisions to the contrary in the communication of their appointment or in the authorisation [...].

(11) The authorisation of an association of representatives shall be deemed to be an authorisation of any representative who can provide evidence that he practises within that association.

(8) A representative [...] shall be deemed to be authorised [...] until the termination of his authorisation has been communicated to the European Patent Office.

(9) Unless it expressly provides otherwise, an authorisation shall not terminate vis-à-vis the European Patent Office upon the death of the person who gave it.
The new Article 134a(1)(d) EPC 2000 bestows competence on the Administrative Council to adopt provisions governing the obligation of confidentiality of professional representatives and the privilege from disclosure in proceedings before the EPO in respect of communications between a professional representative and his client or any other person.

The obligation of confidentiality binding professional representatives is provided for by Article 2 of the Regulation on discipline for professional representatives. As some legal systems distinguish between this obligation of confidentiality and an evidentiary privilege protecting the confidentiality of attorney-client communications, a new Rule has been included which entrenches such an evidentiary privilege for communications between professional representatives and their clients which are subject to the representative’s professional obligation of confidentiality. Rule 153(1) EPC 2000 draws its language from the definition of the evidentiary privilege in US law as cited from Wigmore’s Evidence in the Bristol-Myers Squibb v. Rhône Poulenc Rorer case (Southern District of New York, 21 April 1999).

It is clear that the word "client" in new Rule 153(1) EPC 2000 encompasses any person for whom the representative may be acting, whether an individual or a corporation, the representative's employer, the associated or subsidiary company of the employer, etc.

The reference to Article 2 of the Regulation on discipline aligns the provision with the US requirement that such communications should be of a confidential nature. It is thus made clear that only such communications subject to the representatives' obligation of secrecy are covered by the evidentiary privilege.

Article 2 of the Regulation on discipline reads:
"Professional secrecy
A professional representative shall be bound not to disclose information accepted by him in confidence in the exercise of his duties, unless he is released from this obligation."

(In the Patent Law Committee 2002: CA/PL PV 19, points 89-93)

The EPO emphasized that the provision has been drafted with US case law in mind to cover as many cases as possible in which attorney evidentiary privilege was recognised.
**Rule 153**  
**Attorney evidentiary privilege**

The EPC 1973 did not contain an equivalent provision.

<table>
<thead>
<tr>
<th>Rule 153 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) Where advice is sought from a professional representative in his capacity as such, all communications between the professional representative and his client or any other person, relating to that purpose and falling under Article 2 of the Regulation on discipline for professional representatives, are permanently privileged from disclosure in proceedings before the European Patent Office, unless such privilege is expressly waived by the client.</td>
</tr>
<tr>
<td>(2) Such privilege from disclosure shall apply, in particular, to any communication or document relating to:</td>
</tr>
<tr>
<td>(a) the assessment of the patentability of an invention;</td>
</tr>
<tr>
<td>(b) the preparation or prosecution of a European patent application;</td>
</tr>
<tr>
<td>(c) any opinion relating to the validity, scope of protection or infringement of a European patent or a European patent application.</td>
</tr>
</tbody>
</table>
**RULE 154 EPC**

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Article 163 EPC 1973 dealt with the conditions under which national representatives in a State having newly acceded to the EPC could be entered on the list of professional representatives during a transitional period. With the expiry of the initial transitional period (on 7.10.1981), Article 163 EPC has lost its relevance and has therefore been deleted.

However, the substance of the so-called "grandfather clause" in Article 163 EPC 1973 was inserted into Article 134 EPC 2000 as a permanent feature, in order to deal with the integration of national representatives of countries acceding to the EPC in the future.

**Rule 154(2) and (2)(b) EPC 2000** no longer includes any reference to the initial transitional period.

**Rule 154(3) EPC 2000** is expanded to make it clear that professional representatives entered on the list under the grandfather clause and subsequently deleted are entitled to re-enter the list without being required to pass the European qualifying examination.

Finally, Rule 102 EPC 1973 has been streamlined and its wording aligned with the style of the EPC 2000.

(Explanatory remarks 2006: CA/PL 22/06)

Rule 102(1) EPC 1973 foresees two alternatives for deletion from the list of professional representatives: the entry of a professional representative shall be deleted from the list
- on request (first alternative) or
- if, despite repeated reminders, he fails to pay the annual subscription to the Institute of Professional Representatives (epi) before the EPO before the end of the year for which the subscription is due (second alternative).

The procedure which leads to the deletion of a professional representative according to this second alternative brings, however, some disadvantages to the epi and to the EPO.

In the last eight years, 1 653 persons did not pay the annual subscription to the epi so that the Legal Division of the EPO had to start the deletion procedure according to Rule 102(1), second alternative, EPC 1973. The procedure comprised a communication, a decision open to appeal and the deletion from the list.

Out of the above 1653 persons,
- 587 (35%) paid their annual subscription to the epi before the end of the year for which the subscription was due, thus ending the deletion procedure;
- further 158 persons (10%) were deleted before the end of the year for which the subscription was due;
- the remaining 908 persons (55%) were deleted ex officio at the end of the deletion procedure.

Under the EPC 1973, the Legal Division of the EPO can proceed to the deletion from the list only when the decision open to appeal has become final. This normally occurs three to four months after the start of the deletion procedure. Therefore the deletion can only be performed in March or April of the following year. In the meantime those 908 persons were considered as being active members of the epi. Consequently, they had to be reminded to pay the annual subscription for the following year, too.

The term for payment of the annual subscription under **Rule 154(1), second alternative, EPC 2000** has been set at the end of September of the year for which the subscription is due, instead of the end of the year. This will allow the Legal Division to start the deletion procedure three months earlier. Thus it will be possible to delete the persons concerned before the end of December so that epi will not be obliged to send invoices for the next year to those persons. Both epi and the EPO will save time and money.

(See also discussion in the Patent Law Committee 2006: CA/PL PV 30, point 165)
### Rule 154  Amendment of the list of professional representatives

<table>
<thead>
<tr>
<th>Rule 102 EPC 1973</th>
<th>Rule 154 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>1</strong></td>
<td>The entry of a professional representative shall be deleted from the list of professional representatives if he requests or if, despite repeated reminders, he fails to pay the annual subscription to the Institute of Professional Representatives before the European Patent Office before the end of the year for which the subscription is due.</td>
</tr>
<tr>
<td><strong>2</strong></td>
<td>After the expiry of the transitional period provided for in Article 163, paragraph 1, and without prejudice to any disciplinary measures taken under Article 134, paragraph 8(c), the entry of any professional representative may be deleted automatically in the following cases only:</td>
</tr>
<tr>
<td>(a)</td>
<td>in the event of the death or legal incapacity of the professional representative;</td>
</tr>
<tr>
<td>(b)</td>
<td>in the event of the professional representative no longer being a national of one of the Contracting States, unless he was entered on the list during the transitional period or was granted exemption by the President of the European Patent Office in accordance with Article 134, paragraph 6;</td>
</tr>
<tr>
<td>(c)</td>
<td>in the event of the professional representative no longer having his place of business or employment within the territory of one of the Contracting States.</td>
</tr>
<tr>
<td><strong>3</strong></td>
<td>A person whose entry has been deleted shall, upon request, be re-entered in the list of professional representatives if the conditions for deletion no longer exist.</td>
</tr>
</tbody>
</table>
PART VIII

RULE 155 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The following elements have been deleted from Articles 135 and 136 EPC 1973 and transferred to Rule 155 EPC 2000:
- period for filing the request for conversion;
- lapse of the effect of the European patent application under Article 66 EPC if the request for conversion is not submitted in due time;
- obligation on the national Office or the EPO to attach to the request for conversion a copy of the European patent application or the European patent;
- period for transmitting the request for conversion.

Despite the reference to Article 66 EPC in Article 135(4) EPC 2000, the same reference is also necessary in Rule 155(1), second sentence, EPC 2000 since the effect referred to in Article 66 EPC can lapse not only in the case of failure to transmit the request for conversion (Article 135(4) EPC 2000), but also if the request is not submitted in due time.

RULE 156 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The amendments to Rule 103 EPC 1973 take account of the deletion of Article 136 EPC 1973, the substance of which is reflected partly in Article 135 EPC 2000 and partly in the new Rule 155(2) and (3) EPC 2000.
### PART VIII IMPLEMENTING REGULATIONS TO PART VIII OF THE CONVENTION

#### Rule 155 Filing and transmission of the request for conversion

**EPC 1973**

[See Article 135 EPC 1973:
(2) The request for conversion shall be filed within three months after the European patent application has been withdrawn or after notification has been made that the application is deemed to be withdrawn, or after a decision has been notified refusing the application or revoking the European patent. The effect referred to in Article 66 shall lapse if the request is not filed in due time.]

**Rule 155 EPC 2000**

(1) The request for conversion referred to in Article 135, paragraph 1(a) or (b), shall be filed within three months of the withdrawal of the European patent application, or of the communication that the application is deemed to be withdrawn, or of the decision refusing the application or revoking the European patent. The effect of the European patent application under Article 66 shall lapse if the request is not filed in due time.

(2) When transmitting the request for conversion to the central industrial property offices of the Contracting States specified in the request, the central industrial property office concerned or the European Patent Office shall attach to the request a copy of the file relating to the European patent application or European patent.

(3) Article 135, paragraph 4, shall apply if the request for conversion referred to in Article 135, paragraphs 1(a) or (2), is not transmitted before the expiry of a period of twenty months from the date of filing or, if priority has been claimed, the date of priority.

#### Rule 156 Information to the public in the event of conversion

**Rule 103 EPC 1973**

(1) The documents which, in accordance with Article 136, accompany the request for conversion shall be communicated to the public by the central industrial property office under the same conditions and to the same extent as documents relating to national proceedings.

(2) The printed specifications of the national patent resulting from the conversion of a European patent application must mention that application.

**Rule 156 EPC 2000**

(1) The documents accompanying the request for conversion under Rule 155, paragraph 2, shall be made available to the public by the central industrial property office under the same conditions and to the same extent as documents relating to national proceedings.

(2) The printed specification of the national patent resulting from the conversion of a European patent application shall mention that application.
PART IX

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The procedural details deleted from Articles 150 to 157 EPC 1973 have been transferred, where necessary, to the Implementing Regulations.

The wording of Rules 104 to 112 EPC 1973 has been streamlined and brought into line with the EPC 2000.

RULE 157 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The amendments result from the consolidation of Articles 151 and 152 EPC 1973 in Article 151 EPC 2000. Some details omitted from the latter have also been transferred to the Implementing Regulations.

New Rule 157(1) EPC 2000 incorporates the conditions – deleted from Article 151(1) EPC 1973 – under which the EPO acts as receiving Office.

Rule 157(1), second sentence, EPC 2000 sets out the principle, originally enshrined in Article 152(1) EPC 1973, that an international application must be filed directly with the EPO if the latter has been chosen as a receiving Office. The exception – application of Article 75(2) EPC – is already provided for in Article 151 EPC 2000 and is reiterated in Rule 157(1) EPC 2000 for the sake of clarity.

Rule 157(2), first sentence, EPC 2000 comes from Rule 104(1), first sentence, EPC 1973. The second and third sentences of Rule 104(1) EPC 1973, which concern the number of copies to be filed, have been deleted (similarly, for Euro-direct applications, Rule 35(2) EPC 1973 has been deleted, see explanatory remarks to Rule 49 EPC 2000). Rule 157(2), second sentence, EPC 2000 introduces a precautionary provision authorising the President to require more than one copy.

Rule 104(2) EPC 1973 is redundant in view of the deletion of Rule 104(1), second and third sentences, EPC 1973. It has therefore been deleted.

Rule 14 PCT already authorises the receiving Office to require payment of a remittal fee. New Rule 157(4) EPC 2000 merely re-states this for the sake of clarity.
PART IX  IMPLEMENTING REGULATIONS TO PART X OF THE CONVENTION

Rule 157  The European Patent Office as a receiving Office

<table>
<thead>
<tr>
<th>EPC 1973</th>
<th>Rule 157 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) The European Patent Office may act as a receiving Office within the</td>
<td>(1) The European Patent Office shall be competent to act as a receiving Office</td>
</tr>
<tr>
<td>meaning of Article 2(xv) of the Cooperation Treaty if the applicant is</td>
<td>within the meaning of the PCT if the applicant is a resident or national of a</td>
</tr>
<tr>
<td>a resident or national of a Contracting State to this Convention in</td>
<td>Contracting State to this Convention and to the PCT. Without prejudice to</td>
</tr>
<tr>
<td>respect of which the Cooperation Treaty has entered into force.]</td>
<td>paragraph 3, if the applicant chooses the European Patent Office as a receiving</td>
</tr>
<tr>
<td></td>
<td>Office, the international application shall be filed directly with the European</td>
</tr>
<tr>
<td></td>
<td>Patent Office. Article 75, paragraph 2, shall apply mutatis mutandis.]</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Rule 104 EPC 1973</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) When the European Patent Office acts as a receiving Office under the</td>
</tr>
<tr>
<td>Cooperation Treaty, the international application shall be filed in English,</td>
</tr>
<tr>
<td>French or German. It shall be filed in three copies; the same applies to any</td>
</tr>
<tr>
<td>of the documents referred to in the check list provided for in Rule 3.3(a)(ii)</td>
</tr>
<tr>
<td>of the Regulations under the Cooperation Treaty except the receipt for the</td>
</tr>
<tr>
<td>fees paid or the cheque for the payment of fees. The President of the</td>
</tr>
<tr>
<td>European Patent Office may, however, decide that the international application</td>
</tr>
<tr>
<td>and any related item shall be filed in fewer than three copies.</td>
</tr>
<tr>
<td>(2) If the provisions of paragraph 1, second sentence, are not complied with,</td>
</tr>
<tr>
<td>the missing copies shall be prepared by the European Patent Office at the</td>
</tr>
<tr>
<td>expense of the applicant.</td>
</tr>
<tr>
<td>(3) If an international application is filed with an authority of a</td>
</tr>
<tr>
<td>Contracting State for transmittal to the European Patent Office as the</td>
</tr>
<tr>
<td>receiving Office, the Contracting State must ensure that the application</td>
</tr>
<tr>
<td>reaches the European Patent Office not later than two weeks before the end</td>
</tr>
<tr>
<td>of the thirteenth month after filing or, if priority is claimed, after the</td>
</tr>
<tr>
<td>date of priority.</td>
</tr>
<tr>
<td>[See Article 152 EPC 1973:</td>
</tr>
<tr>
<td>(3) Each international application shall be subject to the payment of the</td>
</tr>
<tr>
<td>transmittal fee, which shall be payable within one month after receipt of</td>
</tr>
<tr>
<td>the application.]</td>
</tr>
</tbody>
</table>
RULE 158 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

The two-tiered review system for the PCT protest procedure under Article 154(3) and 155(3) EPC 1973 in conjunction with Rule 105 EPC 1973 is no longer provided for under Article 152 EPC 2000.

**Rule 158(3) EPC 2000** now provides for a simplified protest procedure in accordance with Rules 40.2(c) to (e) and 68.3(c) to (e) PCT which continues to guarantee legal certainty.

(In the Patent Law Committee 2002: CA/PL PV 19, points 94-95)

The November 2000 revision of the EPC did away with the legal basis for EPO Board of Appeal involvement. Board of Appeal members are therefore legally prohibited from taking part in the work of other legal tribunals. They should not even be given the task of ruling on the legitimacy of an additional fee under Rule 158(3) EPC 2000.

The new one-step review procedure is in keeping with the PCT. Applicants do not face loss of rights in the protest procedure and further examination of unity of invention can take place in the national phase. Attempts by certain applicants to make non-unitary inventions part of the subject-matter of applications ("complex applications") should be resisted.

(Explanatory remarks 2006: CA/PL 17/06)

The new protest procedure under the PCT (see Rules 40.2 and 68.3 PCT, as in force since 1 April 2005) simplifies the procedure where an applicant, invited to pay additional search or preliminary examination fees, wishes to do so "under protest". There is no longer any requirement for a prior review of the justification for the invitation nor for the protest to be dealt with by a three-member board. The deletion of Articles 154(3) and 155(3) EPC 1973 means that the Boards of Appeal no longer play any role in these cases.

The amendments in **Rule 158(3) EPC 2000** are consequential upon the deletion of Article 154(3) EPC 1973 and the adoption of revised Rules 40.2 and 68.3 PCT. The protest will be examined finally by a body akin the current "review panel". Further details concerning the procedure have been determined by the President of the EPO in

- Decision dated 24 June 2007 providing for review panels for the implementation of the protest procedure under the PCT, Special edition No. 3, OJ EPO 2007, 140, N.1
- Notice from the EPO dated 24 June 2007 concerning the protest procedure under the PCT, Special edition No. 3, OJ EPO 2007, 146, N.2

In the Patent Law Committee 2002 and 2006: CA/PL PV 19, points 94; CA/PL PV 30, point 161

Comments on the impartiality and independence of the review board.

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**Rule 106 EPC 1973** "The national fee" has been **deleted** in view of the deletion of Article 158(2) EPC 1973 as well as Article 54(4) and Rule 23a EPC 1973. The filing fee (i.e. the equivalent of the national fee under Articles 22 and 39 PCT) and the designation fees are clearly referred to in Rule 159(1)(c) and (d) EPC 2000.
**Rule 158** The European Patent Office as an International Searching Authority or International Preliminary Examining Authority

<table>
<thead>
<tr>
<th>Rule 105 EPC 1973</th>
<th>Rule 158 EPC 2000</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>(1)</strong> In the case of Article 17, paragraph 3(a), of the Cooperation Treaty, an additional fee equal to the amount of the search fee shall be payable for each further invention for which an international search is to be carried out.</td>
<td><strong>(1)</strong> In the case of Article 17, paragraph 3(a) PCT, an additional international [...] search fee shall be paid for each further invention for which an international search is to be carried out.</td>
</tr>
<tr>
<td><strong>(2)</strong> In the case of Article 34, paragraph 3(a), of the Cooperation Treaty, an additional fee equal to the amount of the preliminary examination fee shall be payable for each further invention for which the international preliminary examination is to be carried out.</td>
<td><strong>(2)</strong> In the case of Article 34, paragraph 3(a) PCT, an additional fee [...] for international preliminary examination shall be paid for each further invention for which the international preliminary examination is to be carried out.</td>
</tr>
<tr>
<td><strong>(3)</strong> Without prejudice to Rules 40.2(e) and 68.3(e) of the Regulations under the Cooperation Treaty, where an additional fee has been paid under protest, the European Patent Office shall review whether the invitation to pay the additional fee was justified and, if it does not so find, shall refund the additional fee. If the European Patent Office after such a review considers the invitation to be justified, it shall inform the applicant accordingly and shall invite him to pay a fee for the examination of the protest (&quot;protest fee&quot;). If the protest fee is paid in due time, the protest shall be referred to the Board of Appeal for a decision.</td>
<td><strong>(3)</strong> [...] Where an additional fee has been paid under protest, the European Patent Office shall examine the protest in accordance with Rule 40.2(c) to (e) or Rule 68.3(c) to (e) PCT, subject to payment of the prescribed protest fee. Further details concerning the procedure shall be determined by the President of the European Patent Office.</td>
</tr>
</tbody>
</table>
 RULE 159 EPC  

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

In Rule 159(1)(e) EPC 2000, the reference to Article 157(2)(b) EPC 1973 has been deleted, taking into account the deletion of the relevant fee provision from Article 153 EPC 2000. All fees falling due on entry into the European phase, together with the provisions on the legal consequences of non-payment, have been transferred to the Implementing Regulations (see also Rules 160 and 162 EPC 2000).

New Rule 159(3) EPC 2000 incorporates Article 153(2) EPC 1973 governing competence for review under Article 25 PCT.

(Explanatory remarks 2006: CA/PL 17/06)

Rule 107(2) EPC 1973 has been deleted. A similar provision has been incorporated in Article 14(2) of the Rules relating to Fees.
<table>
<thead>
<tr>
<th>Rule 159</th>
<th>The European Patent Office as a designated or elected Office – Requirements for entry into the European phase</th>
</tr>
</thead>
</table>

**Rule 107 EPC 1973**

(1) In the case of an international application as referred to in Article 150, paragraph 3, the applicant must perform the following acts within a period of thirty-one months from the date of filing of the application or, if priority has been claimed, from the priority date:

(a) supply, where applicable, the translation of the international application required under Article 158, paragraph 2;

(b) specify the application documents, as originally filed or in amended form, on which the European grant procedure is to be based;

(c) pay the national basic fee provided for in Rule 106(a);

(d) pay the designation fees if the time limit specified in Article 79, paragraph 2, has expired earlier;

(e) pay the search fee provided for in Article 157, paragraph 2(b), where a supplementary European search report has to be drawn up;

(f) file the request for examination provided for in Article 94, if the time limit specified in Article 94, paragraph 2, has expired earlier;

(g) pay the renewal fee in respect of the third year provided for in Article 86, paragraph 1, if the fee has fallen due earlier under Rule 37, paragraph 1;

(h) file, where applicable, the certificate of exhibition referred to in Article 55, paragraph 2, and Rule 23.

(2) Where the European Patent Office has drawn up an international preliminary examination report the examination fee shall be reduced as laid down in the Rules relating to Fees. If the report was established on certain parts of the international application in accordance with Article 34, paragraph 3(c), of the Cooperation Treaty, the reduction shall be allowed only if examination is to be performed on the subject-matter covered by the report.

[See Article 153 EPC 1973:

(2) When the European Patent Office acts as a designated Office, the Examining Division shall be competent to take decisions which are required under Article 25, paragraph 2(a), of the Cooperation Treaty.]

**Rule 159 EPC 2000**

(1) In respect of an international application under Article 153, [...] the applicant shall perform the following acts within [...] thirty-one months from the date of filing of the application or, if priority has been claimed, from the priority date:

(a) supply, where applicable, the translation of the international application required under Article 153, paragraph 4;

(b) specify the application documents, as originally filed or as amended [...], on which the European grant procedure is to be based;

(c) pay the filing fee provided for in Article 78, paragraph 2;

(d) pay the designation fees if the period under Rule 39 has expired earlier;

(e) pay the search fee [...] where a supplementary European search report has to be drawn up;

(f) file the request for examination provided for in Article 94, if the period under Rule 70, paragraph 1, has expired earlier;

(g) pay the renewal fee in respect of the third year provided for in Article 86, paragraph 1, if the fee has fallen due earlier under Rule 51, paragraph 1;

(h) file, where applicable, the certificate of exhibition referred to in Article 55, paragraph 2, and Rule 25.

**Deleted** – incorporated in Article 14(2) Rules relating to Fees

(2) The Examining Division shall be competent to take decisions of the European Patent Office under Article 25, paragraph 2(a) PCT.
RULE 160 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Rule 108(3), third sentence, and (4) EPC 1973 are deleted, in view of the legal remedy established by Article 121 EPC 2000 (see Rule 135 EPC 2000).

RULE 161 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Amendments are purely editorial or consequential to other amendments made elsewhere.
### Rule 160  Consequences of non-fulfilment of certain requirements

#### Rule 108 EPC 1973

1. If either the translation of the international application or the request for examination is not filed in due time, or if the national basic fee or the search fee is not paid in due time, or if no designation fee is paid in due time, the European patent application shall be deemed to be withdrawn.

2. The designation of any Contracting State in respect of which the designation fee has not been paid in due time shall be deemed to be withdrawn.

3. If the European Patent Office notes that the application or the designation of a Contracting State is deemed to be withdrawn under paragraph 1 or 2, it shall communicate this to the applicant. Rule 69, paragraph 2, shall apply mutatis mutandis. The loss of rights shall be deemed not to have occurred if, within two months of notification of the communication under sentence 1, the omitted act is completed and a surcharge is paid.

4. Designation fees in respect of which the applicant has dispensed with notification of the communication under paragraph 3 may still be validly paid within two months of expiry of the applicable time limit, provided that within this period a surcharge is paid.

#### Rule 160 EPC 2000

1. If either the translation of the international application or the request for examination is not filed in due time, or if the filing fee or the search fee is not paid in due time, or if no designation fee is paid in due time, the European patent application shall be deemed to be withdrawn.

2. Unchanged

3. If the European Patent Office notes that the application or the designation of a Contracting State is deemed to be withdrawn under paragraph 1 or 2, it shall communicate this to the applicant. Rule 112, paragraph 2, shall apply mutatis mutandis. [...] \[Deleted\]

### Rule 161  Amendment of the application

#### Rule 109 EPC 1973

Without prejudice to Rule 86, paragraphs 2 to 4, the application may be amended once, within a non-extendable period of one month as from notification of a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under Article 157, paragraph 2.

#### Rule 161 EPC 2000

Without prejudice to Rule 137, paragraphs 2 to 4, the application may be amended once, within [...] one month [...] from [...] a communication informing the applicant accordingly. The application as amended shall serve as the basis for any supplementary search which has to be performed under Article 153, paragraph 7.
RULE 162 EPC

(Explanatory remarks 2002: CA/PL 5/02 Rev. 1 Add. 1)

Amendments are purely editorial or consequential to other amendments made elsewhere.
### Rule 162 Claims incurring fees [...]

#### Rule 110 EPC 1973

(1) If the application documents on which the European grant procedure is to be based comprise more than ten claims, a claims fee shall be payable for the eleventh and each subsequent claim within the period provided for in Rule 107, paragraph 1.

(2) Any claims fees not paid in due time may still be validly paid within a non-extendable period of grace of one month as from notification of a communication pointing out the failure to pay. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims.

(3) Any claims fees paid within the period provided for in paragraph 1 and which are in excess of those due under paragraph 2, second sentence, shall be refunded.

(4) Where a claims fee is not paid in due time, the claim concerned shall be deemed to be abandoned.

#### Rule 162 EPC 2000

(1) If the application documents on which the European grant procedure is to be based comprise more than ten claims, a claims fee shall be paid for the eleventh and each subsequent claim within the period under Rule 159, paragraph 1.

(2) If the claims fees are not paid in due time, they may still [...] be paid within [...] one month from [...] a communication concerning the failure to observe the time limit. If within this period amended claims are filed, the claims fees due shall be computed on the basis of such amended claims.

(3) Any claims fees paid within the period under paragraph 1 and [...] in excess of those due under paragraph 2, second sentence, shall be refunded.

(4) Unchanged
**RULE 163 EPC**

(Explanatory remarks 2006: CA/PL 17/06)

In Rule 111(1), (2) and (3) EPC 1973, the terms "within such a period as it shall specify" have been replaced by "within two months", in order to align Rule 163 EPC 2000 with Rule 58 EPC 2000.

**Rule 163(3) EPC 2000** clarifies that, if no sequence listing has been provided in the international phase complying with the PCT Administrative Instructions, a sequence listing complying with rules to be specified by the President of the EPO (who may e.g. prescribe a particular data carrier) has to be filed upon entry into the European phase. It follows from the reference to Rule 30(3) EPC 2000 that, if an invitation is to be issued, the applicant has to pay the late furnishing fee as well, and that the application is refused if the applicant does not perform the prescribed acts.

**Rule 163(4) EPC 2000** is based on Rule 51bis.1(a)(vii) PCT.

**Rule 163(5) EPC 2000** fills a hiatus.

**Rule 163(6) EPC 2000** is introduced as the legal consequences of non-correction of the deficiencies were not clear under the EPC 1973. The wording is in line with Article 90(5) EPC 2000. It contains no reference to Rule 163(3) EPC 2000, as the legal consequences are covered by the reference to Rule 30(3) EPC 2000 in that paragraph.

(In the Patent Law Committee 2006: CA/PL PV 30, points 162-163)
Rule 163 Examination of certain formal requirements by the European Patent Office

Rule 111 EPC 1973

(1) If the data concerning the inventor prescribed in Rule 17, paragraph 1, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the data within such period as it shall specify.

(2) Where the priority of an earlier application is claimed and the file number or copy provided for in Article 88, paragraph 1, and Rule 38, paragraphs 1 to 3, have not yet been submitted at the expiry of the period provided for in Rule 107, paragraph 1, the European Patent Office shall invite the applicant to furnish the number or copy of the earlier application within such period as it shall specify. Rule 38, paragraph 4, shall apply.

(3) If at the expiry of the period provided for in Rule 107, paragraph 1, a sequence listing as prescribed in Rule 5.2 of the Regulations under the Cooperation Treaty is not available to the European Patent Office, or does not conform to the prescribed standard, or has not been filed on the prescribed data carrier, the applicant shall be invited to file a sequence listing conforming to the prescribed standard or on the prescribed data carrier within such period as the European Patent Office shall specify.

Rule 163 EPC 2000

(1) Where the [...] designation of the inventor under Rule 19, paragraph 1, has not yet been made within the period under Rule 159, paragraph 1, the European Patent Office shall invite the applicant to [...] make the designation within two months.

(2) Where the priority of an earlier application is claimed and the file number of the previous application or the copy thereof provided for in Rule 52, paragraph 1, [...] and Rule 53 have not yet been submitted [...] within the period under Rule 159, paragraph 1, the European Patent Office shall invite the applicant to furnish that number or copy [...] within two months. Rule 53, paragraphs 2 and 3, shall apply.

(3) Where, at the expiry of the period under Rule 159, paragraph 1, a sequence listing complying with the standard provided for in the Administrative Instructions under the PCT is not available to the European Patent Office [...], the applicant shall be invited to file a sequence listing complying with the rules laid down by the President of the European Patent Office within two months. Rule 30, paragraphs 2 and 3, shall apply mutatis mutandis.

(4) Where, at the expiry of the period under Rule 159, paragraph 1, the address, the nationality or the State in which his residence or principal place of business is located is missing in respect of any applicant, the European Patent Office shall invite the applicant to furnish these indications within two months.

(5) Where, at the expiry of the period under Rule 159, paragraph 1, the requirements of Article 133, paragraph 2, have not been satisfied, the European Patent Office shall invite the applicant to appoint a professional representative within two months.

(6) If the deficiencies noted under paragraphs 1, 4 or 5 are not corrected in due time, the European patent application shall be refused. If the deficiency noted under paragraph 2 is not corrected in due time, the right of priority shall be lost for the application.
RULE 164 EPC

(Explanatory remarks 2006: CA/P/L 17/06)

Many practical problems have arisen within the framework of Rule 112 EPC 1973. The Rule did not address all possible scenarios, e.g. not the situation where non-unity was only introduced by amendments filed on entry into the European phase. Also the case where, after amendment on entry into the European phase, the application was unitary but nevertheless related to an invention not searched, was not covered. Especially in the situation where there was no supplementary search and Rule 112 EPC 1973 had to be applied by the Examining Division, there was no straightforward procedure. Applicants considered a Rule 112-communication as a first communication by the Examining Division and responded by e.g. contesting the findings or filing further amendments. This has caused considerable delays.

The EPO believes that the principle should be that examination should only be carried out on inventions covered either by the international search report or by the supplementary search report, in line with Enlarged Board of Appeal decision G2/92 (OJ EPO 1993, 591). New Rule 164 EPC 2000 simplifies the procedure, and the opportunity to have multiple inventions searched within the framework of one application will be limited to the international phase. On entry into the European phase, non-unitary subject matter should be deleted.

The new provision does not involve any loss of rights for the applicant. The result is just that the applicant will have to use the appropriate way of having any further inventions searched and examined by filing divisional applications. This will bring the Euro-PCT procedure in line with the Euro-direct procedure.

RULE 165 EPC

(Explanatory remarks 2006: CA/P/L 17/06)

Article 153(5) EPC 2000 states that a Euro-PCT application shall be considered as comprised in the state of the art under Article 54(3) EPC 2000 if the conditions laid down in Article 153(3) or (4) EPC 2000 "and in the Implementing Regulations" are fulfilled. The only relevant provision in the Implementing Regulations to the EPC 2000 is Rule 159 EPC 2000, which would involve that all conditions for entry into the European phase must be fulfilled before an application is considered to be an Article 54(3)-application.

This would mean a departure from the procedure under the EPC 1973. Under Article 158(2) EPC 1973, it was sufficient that a translation was filed (where necessary) and the national fee paid. It would be a burden for examiners if they would need to check that all conditions are fulfilled in the conflicting application and would have to delay examination until this is the case. Applicants would be left in uncertainty likewise.

Rule 165 EPC 2000 specifically states that once the filing fee is paid for the conflicting application, it is considered to be an Article 54(3)-application. The new Rule safeguards continuity in the well-established EPO practice.
### Rule 164 Consideration of unity by the European Patent Office

#### Rule 112 EPC 1973

If only a part of the international application has been searched by the International Searching Authority because that Authority considered that the application did not comply with the requirement of unity of invention, and the applicant did not pay all additional fees according to Article 17, paragraph 3(a), of the Cooperation Treaty within the prescribed time limit, the European Patent Office shall consider whether the application complies with the requirement of unity of invention. If the European Patent Office considers that this is not the case, it shall inform the applicant that a European search report can be obtained in respect of those parts of the international application which have not been searched if a search fee is paid for each invention involved within a period specified by the European Patent Office which may not be shorter than two weeks and may not exceed six weeks. The Search Division shall draw up a European search report for those parts of the international application which relate to inventions in respect of which search fees have been paid. Rule 46, paragraph 2, shall apply mutatis mutandis.

#### Rule 164 EPC 2000

1. Where the European Patent Office considers that the application documents which are to serve as the basis for the supplementary search do not meet the requirements of unity of invention, a supplementary search report shall be drawn up on those parts of the application which relate to the invention, or the group of inventions within the meaning of Article 82, first mentioned in the claims.

2. Where the examining division finds that the application documents on which the European grant procedure is to be based do not meet the requirements of unity of invention, or protection is sought for an invention not covered by the international search report or, as the case may be, by the supplementary search report, it shall invite the applicant to limit the application to one invention covered by the international search report or the supplementary search report.

### Rule 165 The Euro-PCT application as conflicting application under Article 54, paragraph 3

#### EPC 1973

The EPC 1973 did not contain an equivalent provision.

#### Rule 165 EPC 2000

A Euro-PCT application shall be considered as comprised in the state of the art under Article 54, paragraph 3, if in addition to the conditions laid down in Article 153, paragraph 3 or 4, the filing fee under Rule 159, paragraph 1(c) has been paid.
Appendix 1: Explanatory remarks - General points

The Introductory Part of document CA/PL 5/02 Rev. 1 Add. 1* – which contains the explanatory remarks to the 2002 revision of the Implementing Regulations – includes a few general points which are of relevance throughout the Implementing Regulations:

- The English text of the Implementing Regulations uses two different terms for the same notion, i.e. "time limit" or "period". Wherever possible, for the sake of consistency, "time limit" has been replaced by "period".

- Where a Rule refers to "a period to be specified", this means a period specified by the EPO in the individual case. New Rule 132(1) EPC 2000 makes this clear.

- Where the Rules contain the expression "unless otherwise provided", this means unless otherwise provided in the Convention or the Implementing Regulations.

- Where the Rules specify a period to be observed following an invitation or communication from the EPO, the period always starts with the notification of such communication, since all decisions, notices and communications have to be notified to the parties (Article 119 EPC 2000, Rules 125-131 EPC 2000). Therefore, the provisions concerned need not expressly refer to the requirement of notification (see e.g. Rules 55, 56, 58 EPC 2000).

In addition, in the introduction to document CA/PL 11/06, point 4, the following general point is made:

- The amendments to the Implementing Regulations take into account the harmonisation of the PCT Regulations with the Patent Law Treaty. Therefore, where appropriate, the new text of the Implementing Regulations to the EPC 2000 also reflects the amendments of the Regulations under the PCT as adopted by the Assembly of the PCT Union on 5 October 2005 (see Report of the Assembly, PCT/A/34/6).

* See Special edition n° 1 of the OJ EPO 2003, pages 159-200.
Appendix 2: Transitional provisions for the Implementing Regulations to the EPC 2000

Article 2 of the Decision* of the Administrative Council of 7.12.2006 amending the Implementing Regulations to the EPC 2000 reads as follows:

"The Implementing Regulations to the EPC 2000 shall apply to all European patent applications, European patents, decisions of departments of the European Patent Office and international applications, in so far as the foregoing are subject to the provisions of the EPC 2000. However, Rule 62 shall only apply to European patent applications and international applications entering the European phase filed on or after 1 July 2005."

It follows that, with one exception (relating to Rule 62 EPC 2000), there are no separate transitional provisions governing the Implementing Regulations to the EPC 2000. The applicability of the Rules depends on the transitional provisions for the EPC Articles on which the Rules are based.

* See also Special edition n° 1 of the OJ EPO 2007, page 89.
Appendix 3: Cross-reference index

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Appendix 4: Rules deleted from the Implementing Regulations

Rule 4 EPC 1973 "Language of a European divisional application" has been deleted – its substance has been moved to Rule 36(2) EPC 2000.

Rule 12 EPC 1973 "Administrative structure of the European Patent Office" has been deleted – its substance has been moved to Rule 9 EPC 2000.

Chapter V "Prior European applications" of Part II of the Implementing Regulations and Rule 23a EPC 1973 "Prior application as state of the art" have been deleted following the deletion of Article 54(4) EPC 1973.

Rule 27a(2) and (3) EPC 1973 "Requirements of European patent applications relating to nucleotide and amino acid sequences" has been deleted in view of Rules 2 and 30(1) EPC 2000.

Rule 28 EPC 1973 "Deposit of biological material" has been deleted – its substance has been moved to Rules 31 to 33 EPC 2000.

Rule 28a EPC 1973 "New deposit of biological material" has been deleted – its substance has been moved to Rule 31 EPC 2000.

Rule 62a EPC 1973 "New certificate for a European patent" has been deleted in view of the references in Rule 87, second sentence, EPC 2000.

Rule 82 EPC 1973 "Irregularities in the notification" has been deleted – its substance has been moved to Rule 125(4) EPC 2000.

Rule 85a EPC 1973 "Period of grace for payment of fees" and Rule 85b EPC 1973 "Period of grace for the filing of the request of examination" have been deleted in view of the extended scope of application of further processing under Article 121 EPC 2000 (see also the explanatory remarks to new Rule 135 EPC 2000).

Rule 91 EPC 1973 "Waiving of enforced recovery procedures" has been deleted – its substance has been transferred to Article 13(4) of the Rules relating to Fees.

Rule 96 EPC 1973 "Additional publications by the European Patent Office" has been deleted. The substance of sub-paragraphs (a) to (e) of Article 128(5) EPC 1973 has been incorporated in Rule 19(3) EPC 2000.

Rule 106 EPC 1973 "The national fee" has been deleted, as it is no longer necessary, since Article 158(2) as well as Article 54(4) and Rule 23a EPC 1973 have been deleted. The filing fee (i.e. the equivalent of the national fee under Articles 22 and 39 PCT) and the designation fees are clearly referred to in Rule 159(1)(c) and (d) EPC 2000.