



Notes

on the Request for Grant of a **European** patent (EPA/EPO/OEB Form 1001)

These Notes explain how to complete EPA/EPO/OEB Form 1001. For filing **international** applications under the Patent Cooperation Treaty (PCT) Form PCT/RO/101 should be used. For entry of international applications into the regional phase (Euro-PCT) it is recommended that EPA/EPO/OEB Form 1200 be used.

The basis for the Request for Grant of a European patent is the European Patent Convention (EPC) and its Implementing Regulations. Further details are given in the information brochure "**How to get a European patent - Guide for applicants**", available free of charge from the European Patent Office (EPO), preferably from Vienna, but also from Munich, The Hague and Berlin.

For applicants wanting a rapid search or examination of their applications, the programme for accelerated prosecution of European patent applications – "PACE" – (OJ EPO 1996, 520) offers effective options for shortening the processing time.

I. General instructions

Unless otherwise indicated, the Articles and Rules referred to are those of the EPC.

Use of EPA/EPO/OEB Form 1001 is prescribed by Rule 26. The Request for Grant of a European patent must be typed or printed (Rule 35(10)), and crosses placed in the boxes as applicable. Only the right-hand section of the pages is to be completed. Areas enclosed in thick black lines are for official use only.

The form's layout with its uniform line spacing and tabulator markings facilitates completion by typewriter. It can also be filled in using a word processor.

The "Space for applicant's reference" at the bottom right of each page of the form is designed to show which pages relate to one and the same application and to help prevent confusion; applicants are recommended to use it, particularly when filing more than one application at a time.

If the space available is insufficient for the information to be given applicants should file a **signed additional sheet** indicating the relevant section number and heading (e. g. "14 Additional applicant(s)", "19 Additional representative(s)", "25 Declaration of priority", "32 Different applicants for different Contracting States") for each part of the form continued in this way.

The **receipt for documents** is integrated in the Request for Grant form (page 6). Applicants are requested to file **three copies** of this page with the address to which the acknowledgement of receipt should be sent indicated in the space provided; when filing with a competent national authority of an EPC Contracting State **four copies** are required.

Only the **originals of pages 1 to 5** need be filed. However, the **description, claims, drawings** and **abstract** are required **in triplicate**.

If a European patent application is filed by **facsimile** the hard-copy application documents complying with the Rules and the properly signed Request for Grant should be forwarded

simultaneously. In such a case, to prevent duplication of files, the applicants are asked to mark a cross in the box at the top of the first page of this form and to indicate the facsimile date and the name of the authority with which the facsimile was filed.

II. Instructions for completing the form (The numbering below is that of the various sections of the Request for Grant form)

5 Request for examination

See "Request for examination" in the Guide for applicants. Persons having their residence or principal place of business within the territory of an EPC Contracting State with an official language other than English, French or German, and nationals of that State who are resident abroad, may file the application and documents subject to a time limit in an official language of that State (admissible non-EPO language) (Art. 14(2) and (4)).

The **filing fee** is reduced by 20 % if the translation into the language of the proceedings is filed within the time limit laid down in Rule 6(1), i.e. at the earliest at the same time as the European patent application in the admissible non-EPO language. The **examination fee** is reduced if the written request for examination is filed in the admissible non-EPO language and a translation in the language of the proceedings is also filed. **For the reduction to be allowed, the written request for examination in the admissible non-EPO language must be filed at the same time as the Request for Grant** since the form already contains a pre-printed box (Section 5, left-hand column) for the written request for examination in the official languages of the EPO; the written request for examination in the admissible non-EPO language should be entered in the right-hand column of Section 5 (Rule 6(3) EPC, Art. 12(1) Rules relating to Fees and Notice from the EPO dated 3 July 1992, OJ EPO 1992, 467). The request for examination may be worded as follows:

- (a) in Italian: "Si richiede di esaminare la domanda ai sensi dell'art. 94."
- (b) in Swedish: "Härmed begärs prövning av patentansökan enligt art. 94."
- (c) in Dutch: "Verzocht wordt om onderzoek van de aanvraag als bedoeld in Art. 94."
- (d) in Luxembourgish: "Et gët heimat Préifung vun der Umeldung nom Art. 94 ugefrot."
- (e) in Spanish: "Se solicita el examen de la solicitud según el artículo 94."
- (f) in Greek: "Simfona me tis diataxis tou arthrou 94 zitite i exetasis tis etiseos."
- (g) in Danish: "Hermed begæres prøvning af ansøgningen i henhold til Art. 94."
- (h) in Portuguese: "Solicita-se o exame do pedido segundo o artigo 94º."
- (i) in Irish: "Iarrtar leis seo scrúdú an iarratais de bhun Airteagal 94."
- (j) in Finnish: "Täten pyydetään hakemuksen tutkimista artiklan 94 mukaisesti."

7 Applicant (Name)

The applicant's family name should precede his first name(s). Legal persons or bodies equivalent to legal

persons must be designated with their exact official style.

9 Applicant (Address for correspondence)

An address for correspondence may be given only by applicants **with no representative** and having several different business addresses. The address must be the applicant's own and will not appear in either the Register of European Patents or EPO publications (cf. OJ EPO 1980, 397 - 398).

14 Applicant (Additional applicant(s))

Multiple applicants may jointly appoint a single professional representative.

If no common representative is named in Section 15 of the Request for Grant, the applicant first named in the request (Sections 7 and 8) is considered to be the common representative. However, if one of the applicants is obliged to appoint a professional representative that representative will be considered the common representative unless the first-named applicant has appointed a representative (Rule 100(1)). Only, however, if the Request for Grant has been duly signed by **all the applicants** or their representatives is the common representative entitled to act for them all. If all the applicants have their residence or principal place of business in an EPC Contracting State, they may jointly name an applicant other than the first-named as their common representative. This should be done on a signed additional sheet.

15 Representative (Name)

Sections 15 to 19 should be completed by an applicant appointing a professional representative or a legal practitioner entitled to act as such (Art. 134(1) and (7)), but not by an applicant having his residence or principal place of business in an EPC Contracting State and acting through an employee who is not a professional representative or a legal practitioner entitled to act as such (Art. 133(3), first sentence), even if a joint applicant is appointed as common representative (cf. Instructions for completing Section 14). An applicant may name only **one** representative in Section 15, and if he does so it is that representative to whom the EPO will address notifications (Rule 81) and whose name will be entered in the Register of European Patents. If an applicant appoints as his representative an association registered with the EPO (Rule 101(9), OJ EPO 1979, 92) he must indicate the association's registered name and registration number.

16 Representative (Address of place of business)

This address may contain the name of the company or firm in which the representative is employed.

19 Representative (Additional representative(s))

If **more than one** representative is appointed, those not named in Section 15 must be indicated on a signed additional sheet.

20 Authorisation

21 Professional representatives who identify themselves as such are required under Rule 101(1), in conjunction with the Decision of the President of the EPO of 19 July 1991, to file a signed authorisation only in particular cases (see OJ EPO 1991, 421 and 489). However, a legal practitioner entitled to act as professional representative in accordance with Article 134(7), or an employee acting for an applicant in accordance with Article 133(3), first sentence, but who is not a professional representative, must file a signed authorisation. If the filing of an authorisation is necessary, the use of EPA/

EPO/OEB Form 1003 (OJ EPO 1989, 228) is recommended for individual authorisations and EPA/EPO/OEB Form 1004 (OJ EPO 1989, 230, and 1985, 42) for general authorisations. Both forms are available free of charge from the EPO (preferably from Vienna, but also from Munich, The Hague and Berlin) or the central industrial property offices of the Contracting States.

22 Inventor

23 If the applicant is neither the inventor nor the sole inventor, the designation of the inventor must be submitted as a separate document. It must contain a statement indicating the origin of the right to the European patent (Rule 17(1)).

Applicants are recommended to use for this purpose EPA/EPO/OEB Form 1002 (OJ EPO 1989, 237), available free of charge from the EPO (preferably from Vienna, but also from Munich, The Hague and Berlin) or the central industrial property offices of the Contracting States.

24 Title of the invention

This must be a clear and concise technical designation of the invention. All fancy names are excluded. As Art. 14(8) and (9) prescribes that matter published in the European Patent Bulletin and entries in the Register of European Patents must appear in all three EPO official languages, applicants are requested to indicate in Section 24 of the Request for Grant the title of the invention in the other two official languages.

25 Declaration of priority

The declaration of the date of the previous filing and the State in or for which it was made must be provided **on filing** the European patent application (Rule 38(2)). The file number of the previous application and the priority document may be filed later (Rule 38(2) and (3)). If the previous application is a European patent application or a PCT application filed with the EPO, the EPO will include free of charge a copy of the previous application in the file of the European patent application (Rule 38(3), OJ EPO 1995, 408). See also "Claim to priority" in the Guide for applicants.

26 Biological material

-30b These sections relate solely to biological material deposited pursuant to Rule 28 (in the version valid as of 1 October 1996, OJ EPO 1996, 390). See Notice published by the EPO in OJ EPO 1986, 269, and "Applications relating to biotechnology" in the Guide for applicants.

26 Rule 28 requires that micro-organisms be deposited with a recognised depositary institution **not later than the date of filing** of the application (Rule 28(1)(a)). Recognised depositary institutions are the international depositary authorities under the Budapest Treaty and the institutions with which the EPO has concluded bilateral agreements. The deposit must also have been effected **in accordance with the provisions of the Budapest Treaty or the bilateral agreement**. If originally effected in accordance with other provisions the deposit must have been **converted** into a deposit under the Budapest Treaty or the bilateral agreement **not later than the date of filing** of the European patent application. The relevant information on the characteristics of the biological material must be given in the application as filed (Rule 28(1)(b)).

27 Applicants must state the depositary institution and the file number of the deposit (information required by **27a** Rule 28(1)(c)) within the period specified in Rule 28(2).

28 Applicants are **strongly recommended** to submit the receipt for the deposit issued by the depositary institution, preferably when filing their European patent application but no later than the date of expiry of the period under Rule 28(2), as this enables the EPO to check compliance with Rule 28(1) and (2).

29 Waiver under Rule 28(3)

The applicant may waive his right under Rule 28(3) to an undertaking from the requester to issue a sample of the biological material provided that he is the depositor of the biological material concerned. This waiver must be expressly declared to the EPO in the form of a separate, signed statement. The waiver must specify the biological material concerned (depository institution and accession number or applicant's/representative's reference number as shown in the application documents). The waiver may also be submitted at any time after the application has been filed.

30 Authorisation by the depositor under Rule 28(1)(d)

-30b Where the biological material has been deposited by a person other than the applicant, the name and address of the depositor should be stated in the application in accordance with Rule 28(1)(d); a statement of authorisation signed by the depositor must likewise be submitted. These items, including the statement of authorisation, may also be furnished within the period laid down in Rule 28(2). The statement of authorisation may be worded as follows:

"The undersigned, ... [name and full address of the depositor], has deposited with ... [name of recognised depositary institution] under accession number ... biological material in accordance with the Budapest Treaty [or, where applicable, the bilateral agreement between the EPO and the depositary institution concerned]. The undersigned depositor hereby authorises ... [name of applicant] to refer to the aforementioned deposited biological material in European patent application No. ... [where this is not available, applicant's/representative's reference number] and gives his unreserved and irrevocable consent to the deposited material being made available to the public in accordance with Rule 28 EPC."

Expert option

Applicants wishing to avail themselves of Rule 28(4) are requested to make a declaration to that effect on a signed additional sheet, reading approximately as follows: "I hereby inform you under Rule 28(4) EPC that the biological material referred to in Sections 26 to 27 may be made available only by the issue of a sample to an expert."

31 Nucleotide and amino acid sequences

If nucleotide or amino acid sequences are disclosed in the European patent application the description must 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. The European patent application must be accompanied by a machine-readable data carrier and a statement that the information recorded on the data carrier is identical to the written sequence listing. See in this connection Rule 27a, the Decision of the President of the EPO dated 11 December 1992 and the Notice from the EPO dated 11 December 1992 (Supplement 2 to OJ EPO 12/1992).

32 Designation of the Contracting States and associated declarations

The designation of Contracting States must be made in the Request for grant (Art. 79(1)). The accession of new States is announced in the Official Journal of the EPO. Switzerland and Liechtenstein can only be jointly designated (OJ EPO 1980, 407); a single joint designation fee is payable for this designation.

The designation of all Contracting States already crossed under No. 1 of Section 32 allows the applicant to determine finally the States for which he wishes to obtain a European patent up to the expiry of the relevant periods for the payment of the designation fees (Art. 79(2), Rules 15(2), 25(2), 85a). Under Article 91(4) the designation of States, for which no designation fee has been paid up to the expiry of the periods of grace under Rule 85a, is deemed to be withdrawn.

Under No. 2 of Section 32 the applicant should mark with a cross the States for which he intends to pay designation fees. This simplifies the further procedure for both applicant and EPO since on the basis of the further declaration under No. 2 of section 32 the communications under Rule 85a(1) and Rule 69(1) are notified to the applicant only where, contrary to his originally declared intention, he has failed to pay designation fees for States marked with a cross under No. 2 of Section 32.

For applicants making use of the **automatic debiting procedure** (Section 43), an already crossed declaration restricts the procedure, which would otherwise cover designation fees for all Contracting States, to those States marked with a cross under No. 2 of Section 32.

34 Extension of the European patent

A European patent application and a European patent granted in respect of it are extended, at the applicant's request, to any State which is not a Contracting State to the EPC and with which an "extension agreement" exists on the date on which the application is filed (as at 1 July 1997: Albania, Latvia, Lithuania, Romania and Slovenia).

The request for extension is automatically deemed to be made for any European patent application filed on or after the commencement date (entry into force of the extension agreement). It is deemed withdrawn if the extension fee is not paid to the EPO within the time limits laid down in the EPC for the payment of designation fees (Art. 79(2) in conjunction with Art. 78(2) and Rule 85a(2) EPC). No communication equivalent to Rule 85a(1) or Rule 69 EPC is issued. **When extension fees are paid, the States for which they are intended must be specified.**

The relevant amount of the extension fee and of its equivalents in other currencies of the EPC Contracting States is given in the "Guidance for the payment of fees, costs and prices", which is published regularly in the Official Journal of the EPO.

Detailed information about the extension system is published in OJ EPO 1994, 75.

35 Divisional application

A European divisional application may be filed up until the time when the applicant in respect of the earlier European patent application indicates his approval pursuant to Rule 51(4) of the text in which the European patent is to be granted (Rule 25(1)). The divisional application must be filed directly with the EPO (Art. 76(1)). This application, or in the case referred to in Art. 14(2) its translation, must be filed in the language of the proceedings for the earlier European patent application (Rule 4). Divisional applications require a separate designation of inventor and if necessary a separate

authorisation. See also "Divisional applications" in the Guide for applicants.

36 **Art. 61(1)(b) application**

Section 36 covers the special case where it has been adjudged by a final decision that the inventor or his successor in title is entitled to the grant of a European patent.

37 **Claims**

Any European patent application comprising more than ten claims at the time of filing incurs a claims fee in respect of each claim over and above that number (Rule 31(1)).

Separate claims on grounds of prior European rights (Rule 87) or prior national rights (see Legal Advice No. 9/81, OJ EPO 1981, 68) may not be submitted until proceedings before the Examining Division are under way.

39 **Figure proposed for publication with the abstract**

Rule 33(4) stipulates that if the European patent application contains drawings, the applicant must indicate the figure or, exceptionally, the figures of the drawings which he suggests should accompany the abstract when the abstract is published. Each main feature mentioned in the abstract and illustrated by a drawing must be followed by a reference sign, placed between parentheses.

40 **Additional copies of documents cited in the European search report**

Art. 92(2) stipulates that immediately after it has been drawn up the European search report must be transmitted to the applicant together with copies of any documents cited. If requested, additional copies will be sent provided the appropriate flat-rate fee has been paid. For the amount of this fee see the "Guidance for the payment of fees, costs and prices" published in each issue of the Official Journal of the EPO.

41 **Request for refund of the search fee**

See Legal Advice No. 14/83, OJ EPO 1983, 189 - 198.

43 **Automatic debit order**

See Arrangements for the automatic debiting procedure and Information from the EPO concerning the automatic debiting procedure (Supplement to OJ EPO No. 6/1994).

44 **Deposit account**

If an applicant pays fees in Deutsche Mark and has a deposit account with the EPO (OJ EPO 1982, 15), any refunds due to him may be credited to that account. If he wishes this to be done the applicant must indicate in Section 44 the account number and the account holder's name. Where a **representative's** deposit account is to be indicated, refer to point 5 of Legal Advice No. 6/91 rev., OJ EPO 1991, 573.

45 **List of enclosed documents**

Section 45 refers applicants to the prepared receipt on page 6 (Sections 47 to 49) of the Request for Grant form, in which the enclosed documents must be specified. Filing this prepared receipt constitutes compliance with the requirement pursuant to Rule 26(2)(j) that the applicant file a separate list of enclosed documents.

46 **Signature**

If the applicant is a legal person other than an individual and the Request for Grant is not signed by the representative it must be signed:

(a) either by a person entitled to sign under the law or the applicant's statute, articles of association or the like, with an indication of the capacity of the person doing so, e.g. Geschäftsführer, Prokurist, Handlungsbevollmächtigter; chairman, director, company secretary; directeur, fondé de pouvoir (Art. 133(1)), in which case no authorisation need be filed;

(b) or by another employee of the applicant, provided the latter's principal place of business is in a Contracting State (Art. 133(3), first sentence, Rule 101(1)), in which case an authorisation must be filed (see also instructions relating to Sections 20 and 21).

47 **Application documents**

Description, claims, drawings and abstract must be filed in triplicate. The number of pages comprising each, and the total number of figures in a set of drawings, must also be indicated. Attention is drawn to Rules 32 to 35.

48 **Voucher for the settlement of fees / cheque**

Applicants must **not enclose cheques** with European patent applications filed under Art. 75(1)(b) with the central industrial property office or other competent authority of an EPC Contracting State. They may on the other hand enclose debit orders. Whatever method of payment they select, applicants are recommended when supplying particulars concerning payments (Art. 7 Rules relating to Fees) always to use EPA/EPO/OEB Form 1010 available free of charge from the EPO (preferably from Vienna, but also from Munich, The Hague and Berlin) and from the central industrial property offices of the Contracting States.

49 **Receipt for documents**

The **receipt for documents** is to be supplied **in triplicate** when filing the application with the EPO and **in four copies** when filing with a central industrial property office **or** other competent authority of an EPC Contracting State. This means that in addition to the original, two or three copies of the receipt are to be enclosed.