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Handbook of quality procedures before the EPO

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March 2012

in co-operation with



Foreword

I am very proud to present to the global patent community a hallmark of successful co-operation between the EPO, epi and BusinessEurope.

The "Handbook of quality procedures before the EPO" is the result of an intensive and purposeful co-operation which aims to provide a guide to preferred practices endorsed by both the EPO and user representatives.

Its intention is to help to increase the quality of incoming applications, communications from examiners and submissions from parties, as well as to provide for an efficient prosecution. It may also serve as an orientation for attorneys who have less experience with the procedures at the European Patent Office and for candidates preparing for the European Qualifying Examination.

The Handbook represents in my view a very good illustration of a fruitful interaction between a patent office and a users community, each one bringing its expertise while keeping its role and responsibilities.

I am very grateful to epi and BusinessEurope for their valuable contribution.

A handwritten signature in black ink, appearing to read 'B. Battistelli', with a long horizontal stroke extending to the right.

Benoît Battistelli
President of the EPO

March 2012

Introduction

The Handbook addresses the following topics:

- the practice of applicants and representatives
- the practice of examiners, in particular how the examiner should best carry out examination so as to reach a decision in a reasonable time while dealing openly with parties to the proceedings;
- the practice of formalities officers, particularly focusing on interaction between formalities officers and applicants; and
- how complaints are dealt with at the EPO.

It must be kept in mind that the Handbook is meant to serve as complementary publication to the existing legal texts as it provides useful insight on the application of the law. It is not binding either on the EPO or on users and their representatives. Consequently, it should not be quoted in communications between the EPO and its users, and no procedural sanction or disciplinary measure applies for departing from efficient practice. Its strength lies in the benefits - in terms of greater quality and efficiency of the patenting process - that all parties stand to gain by following the practices described.

This document will also serve as a platform for further refining the quality of interaction between parties. Comments and suggestions are therefore welcome (info@epo.org) so that future versions can build upon the shared experience of the EPO and its users.

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1. Online Filing

It is possible to file documents at the EPO by post, by fax or online. *GL A-II*
However, filing documents using the EPO Online Filing software improves the efficiency of the procedure.

1.1 Online filing of applications

If an application is filed online at the EPO, the quality of documents is maintained and applicants are provided with an instant acknowledgment of receipt, with number and date of filing. A further advantage of online filing is that the applicant benefits from some fee reductions. *GL A-II, 1.3*

If an application is filed by post or fax, its filing is not acknowledged as quickly and, especially in the case of filing by fax, the quality of the documents may be reduced, leading to a requirement for the applicant to file replacement documents.

If an application is filed online and the filing is confirmed by fax or post, the applicant incurs extra cost for providing documents which are of no use to the EPO and delay processing of the application. The EPO therefore prefers that online filings are *not* confirmed.

The Online Filing software can be used both for filing Euro-direct applications (Form 1001E) and for entering the European phase (Form 1200E).

1.2 Online filing of further documents during examination

When documents filed in connection with all other procedural actions during prosecution are filed online, the EPO's electronic file is automatically updated and further prosecution can be expedited. Filing such documents by fax or post delays further prosecution, since they need to be scanned so that they can be placed on the EPO's electronic file. *GL A-VIII, 2.5*

In particular, it should be borne in mind that, with online filings, Form 1038E should be used:

- for the applicant to provide subsequently filed documents;
- for making payments (see Part 2 for more information on fee payment);
- for filing a request for limitation or revocation; and
- for filing non-public documents. Note that it is not possible to file a non-public document together with a public document or a payment.

1.3 Online filing of appeals

Form 1038E should also be used for filing an appeal, whether in examination or opposition proceedings, and any subsequent *GL A-II, 1.3*

documents relating to the appeal proceedings. In this case the form must be signed with an enhanced electronic signature (smart card signature) by a person authorised to act in the appeal proceedings.

GL D-III, 3.2

1.4 Online filing of oppositions

Use of the opposition plug-in for online filing of an opposition and any subsequent documents relating to the opposition proceedings (apart from an appeal) allows the EPO to handle the opposition proceedings more expeditiously. This applies to all parties to opposition proceedings. If Form 1038E is used, the EPO cannot process the opposition as quickly.

1.5 Online filing – general

Reference is made to the EPO Online Services webpage: <http://www.epo.org/applying/online-services.html>

In opposition proceedings, ticking the box 'following summons to oral proceedings' (if applicable) will ensure the highest priority in the EPO's internal treatment of filings.

If applicants select the right document type, if available, for their attachments, it facilitates and accelerates the EPO's internal treatment of their filings. If the right type is not available, applicants can use 'General enquiry' on Form 1038E or 'Other documents' on the other forms.

Three different types of signature can be applied with the EPO Online Filing software: facsimile signature, text string signature or enhanced electronic signature. Soft certificate signatures are not accepted by the EPO for Euro-direct filings.

If users set up the Live Update function, they will be working with the latest version of the EPO Online Filing software (including procedural and fee changes). All updates are also made available in the download centre of the EPO Online Services webpage.

2. Fees

Fees may be validly paid to the EPO by any person.

GL A-X, 1

GL A-X, 3

Payment must be made in euro. The payer should indicate the name of the person making the payment, the application/publication number for which the fees are being paid and any other relevant details, to enable the EPO to establish the purpose of the payment immediately. Indication of the fee codes facilitates direct allocation of the payment.

Fees are validly paid if the full amount has been paid in due time.

Information on changes affecting fee payments is published regularly on the EPO website and in the EPO's Official Journal.

2.1 Methods of payment

While best practice in fee payment depends upon the circumstances of the payer, payment by means of a deposit account held with the EPO is usually a convenient and efficient method of payment where the payer has a sufficiently large number of applications pending with the EPO to justify holding non-interest-bearing deposits with it.

GL A-X, 2

GL A-X, 4.2

GL A-X, 4.3

With a deposit account, any erroneous underpayments may, in general, be corrected without prejudice to the rights of the payer.

Deposit accounts can be drawn on by:

- a request in a letter;
- a deposit account order form;
- online; or
- automatically.

A request in a letter should be clear, indicating fees and amounts to be debited. A request in a letter or using a deposit account order form is liable to error. Payments online or by automatic debiting are generally more certain and are therefore recommended. They have the following features:

- *online* payments may be made either by using the EPO's Online Filing software and the appropriate EPO Forms (e.g. 1001E and 1200E for initial payments and 1038E for any subsequent payments) or through the Online Fee Payment portal via My.epoline. The major benefits of online payment are:
 - the fees are always up to date;
 - immediate confirmation of the payment is provided;

- an overview of pending orders (online debit orders not yet processed by the EPO) is provided;
- access to account statements is available at all times (back to 2002);
- the possibility of batch payment is available.
- *an automatic debit order* ensures that the correct amounts are debited in due time under the responsibility of the EPO.

If a payment is to be made *before* the end of a time limit, means of payment other than a request in a letter should be used.

If the applicant has an automatic debit order but does not intend to pay any or all of the fees, it is important to instruct the EPO before expiry of the relevant period **not** to automatically charge the fees.

Reference is made to the specific requirements mentioned in points 3(j) and (k) of Annex A.2 to the Arrangements for deposit accounts (ADA) for requests for further processing and re-establishment of rights.

Instant filing and revocation of requests for automatic debit orders are possible using the appropriate electronic forms in the Online Filing software and through the Online Fee Payment portal via My.epoline.

Circumstances where use of a deposit account may not be the most appropriate solution include:

- when the user cannot justify holding a deposit account;
- where a large payment is due at short notice beyond the amount held in a deposit account;
- where bank delays may mean that replenishment of a deposit account might be uncertain (particularly a problem for users in non-euro countries).

In such cases, payment to an EPO bank account may be more certain.

The EPO accepts credit card payments for some publications but not for procedural fees.

2.2 Date of payment

The use of payment by deposit account, either by individual debit orders (preferably via Online Fee Payment, where payment is possible up to the last moment) or using the automatic debiting procedure (with responsibility passing to the EPO), normally reduces

GL A-X, 4.2.3
GL A-X, 4.3

the risk of late payment and possible extra costs for the applicant, unless an alternative route is more certain.

2.3 Reduction of fees

Under certain conditions, applicants may benefit from fee reductions. *GL A-X, 9*
Where an applicant is entitled to a fee reduction, the reduced rate should be paid directly, instead of the full fee which would then require a refund.

2.4 Refund of fees

Applicants may request a refund only if a fee has been paid without a legal basis or if a refund is specifically provided for; otherwise, refund requests are normally rejected. *GL A-X, 10*

Opening a deposit account with the EPO facilitates and/or accelerates the refund of fees.

3. Filing patent applications with the EPO

3.1 Indications for filing

GL A-II, 2.1

GL A-II, 4.1

GL A-VIII, 1

GL A-VIII, 3.2

If a complete application, including claims, is submitted on the filing date, with all documents drafted in the appropriate font size and, where necessary, signed by the authorised person, it will not be necessary for the applicant to supply missing documents, and prosecution can commence immediately.

Filing by reference, although allowed, may make it necessary for the applicant to supply missing or replacement documents, for instance because the application to which reference is made may not be in the format required by the EPC. Applications filed without claims result in delay in the start of examination and can lead to problems under Art. 123(2).

Any available earlier search report(s) on the priority application(s) should be attached to the documents that make up the application as filed.

If a person who is not on the Register of European Patent Attorneys, such as a legal practitioner or an employee of applicants from a member state, files an application as a representative of the applicant and attaches a duly signed authorisation form to the application as filed, the application can be prosecuted quickly. Not filing such an authorisation with the application will delay prosecution because the EPO will have to request the filing of an authorisation and check that the requested authorisation is valid.

If the person filing the application has a general authorisation from the applicant, inserting a reference to that general authorisation on the application form will speed up prosecution.

To ensure that correspondence from the EPO is sent to the correct address, no separate postal address for the applicant should be given on the application form if a representative has been appointed.

If responsibility for the application is transferred to another representative, there will be no interruption of prosecution if the old representative informs the EPO of the name and address of the new representative. If the applicant decides to change representative without informing the old representative, he should either inform the EPO of the name and address of the new representative or provide the new representative with an authorisation in respect of the application. In this case the new representative should inform the EPO and file the authorisation as soon as possible.

3.1.1 Forms to be used on filing

GL A-II, 4.1.1

GL E-VIII, 2.1.1

Use of the forms listed below enables the data required for filing to be easily entered into the EPO's database. If the required data is supplied in a different format, the EPO will not be able to process the

application efficiently. Signing the forms before filing them ensures that neither the representative nor the EPO will need to take any further action in this respect.

- (i) EPO Form 1001E (Request for grant) when filing a direct European patent application
- (ii) EPO Form 1200E when entering the European phase for an international application. Here it is important in particular to fill in page 7 (Table for section 6 of Form 1200.3E) and clearly indicate the documents on which calculation of the additional fee should be based.

3.1.2 Filing by reference

For applications filed by reference to an earlier application, this should be duly indicated in box 26.1 of EPO Form 1001E by stating: *GL A-II, 4.1.3.1*

- the date of filing,
- the application's file number, and
- the state from which the earlier application originates.

The application can be processed rapidly and smoothly, without further requests from the EPO, if the following documents are provided on filing:

- a certified copy of the previous application (not applicable if the certified copy is to be prepared by the EPO)
- the abstract of the application
- a new set of claims if the reference does not extend to the claims of the previously filed application. (Conversely, if the reference does extend to the claims of the previously filed application, it is not possible to file a new set of claims in addition.)

3.1.3 Physical requirements of application documents

If the application documents fulfil the requirements of Rules 46 and 49 on filing, it will not be necessary for the EPO to request replacement documents before processing can commence. *GL A-III, 3*

Formal drawings meeting the EPC requirements are required for publication. If provisional drawings, colour photographs, screen shots or colour drawings are provided on filing, they will need to be replaced with formal drawings (unless the quality for reproduction does not suffer). This may lead to problems with unallowable amendments under Art. 123(2) and is likely to delay the search or examination procedure.

3.1.4 Translation

When filing a translation of an application filed in a non-EPO language, the applicant should pay great attention to the quality of the translation. Otherwise the content of the translated description might not be identical to that of the original description, and therefore its use as a basis for amendments will have to be postponed until a correct translation is received, which may involve additional expense for the applicant.

3.2 Form and content of the European application

3.2.1 Structure

The EPO prefers applications drafted in line with the Common Application Format developed by the Trilateral Offices. Use of this format will lead to savings in time and effort, as this template will more easily pass the formalities checks at the EPO. (See <http://www.trilateral.net/projects/pct/CAF.html>).

3.2.2 Description

The description is the backbone of the application. Therefore, great attention should be paid to its preparation.

The application must disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. If this is not used as a guiding principle for drawing up the description, the application is likely to encounter significant difficulties in prosecution.

Problems with Art. 123(2) can be more readily avoided if the description is drawn up so that it provides a clear basis for amending the claims.

After a section referring to the relevant prior art, it is particularly helpful to state the problem the invention seeks to solve, according to the problem-solution approach:

1. listing the features the closest prior art shares with the application in the light of the closest prior art known to the applicant;
2. listing the features of the invention that define a contribution that the claimed invention considered as a whole makes over the prior art; and
3. elaborating on the problem those features solve.

If the recitation of a feature of general applicability also includes a statement of why the feature is advantageous, this may be helpful in supporting arguments on inventive step.

Including a brief explanation of any drawings in the description will assist in making the application as a whole more understandable. Elements in the drawings should be numbered. When it is necessary to refer in the description to elements of the drawings, the name of the element should be referred to as well as its number. Such reference numbers should be consistent between the description, claims, abstract and drawings.

Well-accepted technical terms and consistent terminology and, where possible, SI units should be used, as this will assist in making the application as a whole more understandable.

There is no need to list all the prior art of which the applicant is aware. Citing only those documents that are really pertinent to the invention, e.g. documents that disclose the features recited in the preamble of the independent claim(s), will enable the examiner to carry out a more efficient search and examination.

Requests from the EPO to provide further information on prior art documents can be avoided by identifying documents cited in the application as clearly as possible, for instance by closely following WIPO Standard ST.14 (for patents or patent applications, the publication number and not the application number should be indicated).

If statements such as "incorporated by reference", "spirit of invention" or "all equivalents included" are used in the description of an application, the examiner is likely to request their deletion, as they lead to a lack of clarity. The same applies to claim-like clauses appended at the end of the description, which must be deleted prior to grant insofar as they are not in conformity with the claims proposed for grant, since they will otherwise lead to unclarity as to the actual scope of protection.

3.2.3 Claims

Bearing the following points in mind when drafting claims is likely to improve the quality and efficiency of the search and examination procedure:

GL F-IV

- Carefully draft claims that are clear and concise, provide proper fall-back positions and include all essential features of the invention.
- Review and, if necessary, adapt the claims to the requirements of the EPC before filing.
- Check that the claims meet the requirements as to unity of invention.
- Avoid multiple use of the expression "and/or", as it can introduce a lack of clarity when interpreting the claims.

- For applications containing multiple independent claims in the same category which do not comply with Rule 43(2), the EPO will often issue an invitation under Rule 62a (see 4.1.1). This may lead to the examiner searching only the first claim in each category, even if it is not the claim in which the applicant is most interested.
- It is of great assistance to examiners if the category (product, process, apparatus or use) and type (dependent or independent) of a claim are clear. If:
 - there is a mixing of claim categories within a single claim; or
 - there is a mixing of claim types (dependent/independent) within a single claim, for example: "Claim 2: subject-matter according to the preamble of claim 1 or to a part of claim 1",

the examiner is likely to raise an objection of lack of clarity.

- For international applications entering the European phase, an indication of the basis in the PCT application for amended claims in the EP application will allow the examiner to easily check whether the requirements of Art. 123(2) are met and thus avoid an objection under Rule 137(4).
- Use the two-part form, where appropriate, for the independent claims. In the "characterising portion" of such claims, state those technical features by which the invention differs from the known closest prior art.

Multiple dependencies

If a representative receives for filing at the EPO a set of claims drafted for a country where multiple claim dependencies are not allowed, the number of claims may be reduced on filing by use of multiple dependencies. Such amendment may reduce the risk of objection under Rule 62a.

This avoids unnecessary repetition of the same technical features in several dependent claims, helps to meet the requirement of conciseness and may enable the number of excess claims fees payable to be reduced.

In this context, it is important to check the consistency of the dependencies, because their adaptation at a later stage may not meet the requirements of Art. 123(2), since new combinations of claims may easily lead to problems with added subject-matter.

Reference numbers

- To the extent possible, every technical feature referred to in the claims should be shown in the drawings, if present.
- Reference numbers (in brackets) which have no limiting effect on the claim should be included in the claims on filing. If not, the examiner may insert them, which could result in added prosecution costs if the applicant disagrees.

3.2.4 Drawings

See 3.1.3.

GL F-II, 5

3.2.5 Abstract

The examiner has the task of determining whether the title and abstract supplied by the applicant constitute efficient instruments for searching, particularly online. A checklist can be found in General Guidelines for the Preparation of Abstracts of Patent Documents in WIPO Standard ST.12.

GL F-II, 2

The applicant should take care to draft the abstract in a concise and informative manner to assist the examiner in carrying out the search.

The examiner may alter the text of the abstract if the abstract:

- does not indicate the title of the invention or the technical field to which the invention pertains;
- does not contain a concise summary of the invention;
- contains statements on the alleged merits or value of the invention or its speculative application;
- contains more than 150 words.

If the abstract does not indicate the figure which should accompany it, the examiner will select a figure, if appropriate.

3.2.6 Sequence listings

If nucleotide or amino acid sequences are disclosed in a European patent application, the following conditions should be satisfied:

GL A-IV, 5
GL F-II, 6

- a sequence listing complying with WIPO Standard ST.25 and presented as a separate part of the description should be filed in electronic form;
- if the sequence listing is (optionally) also filed on paper, it should be accompanied by a statement by the applicant that the information it contains is identical to the sequence listing in electronic form.

It is recommended that these conditions should be satisfied on filing the application.

The EPO recommends the use of the BiSSAP software. Using the latest version of this software helps applicants to meet the formal requirements under Rule 30(1). The software can be downloaded free of charge from the EPO website.

As an exception, if sequences belonging to the prior art are identified in the description by means of an accession number (including the version number or database release number) in a publicly accessible database and

- (i) are not referred to in the claim(s),
- (ii) do not constitute essential features of the invention, and
- (iii) are not required for the prior art search,

then no sequence listing for those sequences is required.

Also, for applications for which the EPO acts as an ISA under the PCT and for applications entering the regional phase under the PCT, only an electronic version of the sequence listing is required (Rule 13ter.3 PCT).

Later filing of sequence listings should be avoided, as it incurs additional costs for the EPO and the applicant (i.e. a late-filing fee) and leads to the sequence listings not forming part of the description and not being published with the granted patent (Rule 30(2)). Moreover, later amendments can lead to problems under Art. 123(2).

3.2.7 Biological material

If the information referred to in Rule 31(1)(c) and (d) is filed at the EPO on the date of filing by submitting the deposit receipt issued by the recognised depositary institution as well as, where applicable, the depositor's declaration in the formulation recommended in the relevant EPO Notice, the EPO should not request the applicant to file it. If the accession number is not known to the applicant at the date of filing, the deposit should be identified by indicating the identification reference given by the depositor to the biological material, enabling the deposit to be related to the later-filed accession number.

3.3 Divisional applications

An applicant who decides to file a divisional application may do so whether or not an objection of lack of unity under Art. 82 has been raised, provided that the parent application is still pending and that the conditions set forth below are observed.

GL A-IV, 4
GL F-III, 6

3.3.1 Divisional applications (Rule 36(1)(b))

If the examiner has raised an objection under Art. 82, the applicant may file a divisional application under Art. 76 provided that it is filed within 24 months from notification of the communication in which the Art. 82 objection was raised for the first time.

GL A-IV, 1.1.1.3

The examiner should clearly indicate in the relevant communication when an objection under Art. 82 is raised for the first time. If he is maintaining an objection under Art. 82, he should indicate that it is not a new objection.

3.3.2 Divisional applications (Rule 36(1)(a))

If the examiner has *not* raised any objection under Art. 82, the applicant may file a divisional application under Art. 76 provided that it is filed within 24 months from notification of the examining division's first communication in respect of the earliest application for which a communication has been issued.

GL A-IV, 1.1.1.2

3.3.3 Subject-matter of divisional applications

If the claims filed for a divisional application are identical to those pursued in the parent application, no additional search will be carried out and, during examination, the examiner may reject the claims for the same reasons as he put forward in connection with the claims in the parent application.

If the applicant files claims for a divisional application which are different from those originally filed for the parent application, he should provide the basis for the claims in the divisional application, so that it is easy to verify that the content of the divisional application does not extend beyond the content of the parent application.

Using the description of the parent application as the description of the divisional application upon filing avoids conflict with Art. 76(1) and facilitates examination of this requirement.

4. EPO communications and replies

GL B-VIII, 3
GL B-VIII, 4

4.1 Invitations under Rule 62a and/or Rule 63

4.1.1 Content of an invitation under Rule 62a

GL B-VIII, 4.1

In an invitation under Rule 62a, the examiner should indicate the different categories and the independent claims for each category. On an attached form he may provide the reasons why the requirements of Rule 43(2) are not met. This helps the applicant to understand the grounds for the invitation.

4.1.2 Content of an invitation under Rule 63

GL B-VIII, 3.1

The examiner should issue an invitation under Rule 63 only if it is impossible for him to conduct a meaningful search for all or some of the claimed subject-matter. In such an invitation he should indicate the reasons why a meaningful search is not possible. Typical reasons include a fundamentally unclear specification, insufficient disclosure or claims lacking conciseness to the extent that it becomes unduly burdensome to determine the matter for which protection is sought.

4.1.3 Content of an invitation under both Rule 62a and Rule 63

GL B-VIII, 5

An invitation under *both* Rule 62a *and* Rule 63 is issued if the application contains more than one independent claim per category, whereby the claims as filed do not comply with Rule 43(2), *and* 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.

The examiner should indicate the different categories and the independent claims per category. In addition, he should provide reasons why a meaningful search is not possible for all or some of the subject-matter claimed and may also provide reasons why the requirements of Rule 43(2) are not fulfilled.

4.1.4 Content of an invitation in case of lack of unity

GL B-VIII, 3.4
GL B-VIII, 4.5

In cases where the examiner also considers that the claims under consideration lack unity, the applicant should be informed in the invitation under Rule 62a and/or Rule 63 of the reasons why the claims lack unity.

With respect to the first invention mentioned in the claims, the examiner should also provide reasons why he considers that a meaningful search is not possible and/or may provide reasons why the requirements of Rule 43(2) are not fulfilled.

4.2 Replies to an invitation under Rule 62a and/or Rule 63

GL B-VIII, 5

At this stage of the procedure *no amended claims* and no additional fees can be accepted by the EPO. If the opportunity to pay additional fees arises, a communication under Rule 64 will be issued. If the applicant wishes to expedite prosecution, he can file amended claims to illustrate to the examiner which claims he would like to have

examined. However, such amended claims have no legal effect unless they are re-filed after issue of the search report.

4.2.1 Reply to an invitation under Rule 62a

In reply to an invitation under Rule 62a, the applicant may react in four different ways: *GL B-VIII, 4.2*

- He does not wish to dispute the search examiner's opinion and indicates the independent claims that fulfil the requirements of Rule 43(2) and that he wishes to have searched.
- He finds that the objection is not justified and wishes to reply to the invitation: in this case he must provide reasons why the requirements of Rule 43(2) are fulfilled. Furthermore, he may file arguments against the findings in the invitation, requesting as a main request that the claims as filed be completely searched and as an auxiliary request, in case the examiner is not convinced, indicating specific subject-matter to be searched.
- He finds that the objection is only partly justified and wishes to indicate more than one independent claim per category: in this case too he must provide reasons why the claims he has indicated fulfil the requirements of Rule 43(2).
- He decides not to reply to the invitation: in this case the examiner decides what to search.

4.2.2 Reply to an invitation under Rule 63

In reply to an invitation under Rule 63, the applicant may react in three different ways: *GL B-VIII, 3.2*

- He indicates the subject-matter to be searched, which may be, for example, part of a claim, an embodiment falling within the scope of an independent claim or a dependent claim: he must explain why a meaningful search can be carried out for the indicated subject-matter.
- He disputes the findings of the examiner: in this case he must prepare a reasoned reply explaining why a meaningful search can be carried out for that subject-matter. Furthermore, he may file arguments against the findings in the invitation, requesting as a main request that the claims as filed be completely searched and as an auxiliary request, in case the examiner is not convinced, indicating specific subject-matter to be searched.
- He decides not to reply to the invitation: in this case the examiner decides what to search.

GL B-VIII, 5

4.2.3 Reply to an invitation under Rule 62a and Rule 63

In reply to an invitation under Rule 62a and Rule 63, the applicant may react in three different ways:

- He indicates the independent claims that fulfil the requirements of Rule 43(2) and that he wants to have searched: in addition, he must indicate the subject-matter to be searched (corresponding to said claims) and explain why a meaningful search can be carried out for the subject-matter of the application.
- He challenges the findings of the examiner: in this case he must prepare a reasoned reply as indicated above for the replies to invitations under Rule 62a or Rule 63.
- He decides not to reply to the invitation: in this case the examiner decides what to search.

4.2.4 Reply in case of lack of unity mentioned in an invitation under Rule 62a and/or Rule 63

GL B-VIII, 3.4,
GL B-VIII, 4.5

If a non-unity objection has been raised by the examiner in an invitation under Rule 62a and/or Rule 63, the applicant's reply may deal only with the first invention indicated by the examiner.

4.2.5 Telephone consultation to clarify the invitation

If the applicant requests a telephone consultation, the examiner should agree to such a consultation in order to clarify the content of the invitation and the course of action open to the applicant at this stage. The consultation should be limited to formal issues concerning the invitation. Minutes of the telephone consultation should be written by the examiner. The telephone consultation does not take the place of a reply. A written reply from the applicant to the invitation under Rule 62a and/or Rule 63 is still necessary within the time limit already set.

GL B-X, XI

4.3 Search reports and written opinions

GL B-XI

4.3.1 Content of the search opinion

The search should cover the subject-matter of both independent and dependent claims.

The search opinion should cover all objections to the application considered by the examiner to be applicable to the claims under consideration. If the examiner indicates any subject-matter in the application which he considers to meet the requirements for patentability, this may speed up prosecution of the application. A complete, well-structured and properly reasoned search opinion contributes to an efficient further examination procedure in that the applicant can then formulate a response and, if necessary, amend the claims and description to meet all the objections (see also 4.5).

4.3.2 Consistency between search report and search opinion

When issuing the search report and the accompanying opinion, the examiner should check that there are no discrepancies between the search report and the opinion. In particular, he should check that any document cited as "X" or "Y" in the search report has the correct category and, if so, indicate the corresponding objections regarding lack of novelty and/or inventive step in the accompanying opinion.

The findings of the search opinion should also be consistent with any other issues raised in the search report, such as lack of unity of invention or limitation of the search.

4.3.3 Unconditional request for examination

The applicant may file an unconditional request for examination before the search report is transmitted to him, whatever the result of the search may be. In such cases, the search report is not accompanied by a search opinion and the requirement in Rule 70a(1) for a mandatory reply does not apply.

GL C-II, 1

4.3.4 Positive search opinion

If a positive search opinion is issued at the search stage, the application may be able to proceed directly to grant without further examination. However, there may be a delay in the grant procedure due to the need for an additional top-up search for conflicting European applications according to Art. 54(3) before a grant can be proposed.

GL B-XI, 3.9

4.4 Replies to written opinions

GL B-XI, 8

GL C-II, 3

4.4.1 Substantive reply to written opinions

The ESOP, the WO-ISA, the SISR and the IPER will be collectively referred to in this chapter as "written opinions" from the EPO to which the applicant must reply under the conditions set out in Rule 70a or Rule 161.

If the reply to the written opinion is as complete as possible and addresses all the points which were raised, the examiner will not need to again raise points which have not been addressed by the applicant. This will speed up prosecution of the application and save time and expense for the applicant.

4.4.2 Reply without amendments

If only arguments are submitted and no amendments to the application documents are proposed, the reply should provide an explanation of the reasons why the applicant does not agree with the examiner's objections.

The objections raised should preferably be dealt with in the following order:

- objections under Art. 82 and Rule 43(2);
- major objections under Art. 84, since otherwise a proper assessment of novelty and inventive step cannot be made;
- objections under Art. 87, if relevant for discussing novelty or inventive step;
- novelty:
 - if the examiner has raised objections of lack of novelty on the basis of different documents, the novelty of the subject-matter of the claim is discussed for each of these documents;
 - when discussing novelty, one or more features of the claim not disclosed in each prior art document should be identified and the differences discussed clearly and precisely; if the response merely states that no prior art shows the combination of features of a claim, the examiner cannot readily check whether the applicant's argument is correct;
- inventive step:
 - even if the examiner has not raised an inventive step objection due to alleged lack of novelty, arguments in favour of inventive step over the cited prior art may still be provided for the amended claims, in order to speed up the procedure;
 - the problem-solution approach should be used;
 - if the applicant considers that the closest prior art document is different from the one identified by the examiner, he should supply reasons why;
 - all pertinent documents cited in the search report should be considered;
- minor objections under Art. 84.

4.4.3 Reply with amendments

If the response relies on amended claims and/or description, as well as providing arguments in favour of patentability (see 4.4.2), the reply should deal with the amendments made, and should in particular contain:

- an indication of what has been changed;
- an indication of where the basis in the original documents can be found;
- the reasons for changing the claims (e.g. why an amendment makes the claim novel/inventive).

If the claims have been amended, a long discussion about novelty may not be required. Providing arguments in support of inventive step with respect to the amended claims may speed up examination.

Details of how amended pages should be filed are set out in 4.6.1.

4.4.4 Reply in case of lack of unity

If an objection of lack of unity has been raised and the applicant does not contest the objection, he may reply to the written opinion:

GL C-III, 3
GL H-II, 7

- if no additional search fees have been paid, by deleting the claims relating to the inventions not searched; or
- if at least one additional fee has been paid, by amending the application to limit the claims to cover only a single searched invention on which prosecution of the application is to proceed.

If an objection of lack of unity has been raised and the applicant contests the objection, he may reply to the written opinion:

- by providing clear arguments in support of the unity of the claims; or
- by providing amended claims and clear arguments in support of the unity of the amended claims.

In replying, the applicant should bear the following in mind:

- If the claims are amended such that they comprise unsearched subject-matter, the examiner cannot allow the claims and examination will be delayed. For example: if no additional fees have been paid at the search stage and the applicant combines features from the claims which have not been searched with features of the "first invention", the examiner cannot allow the claims and examination will be delayed.

- If the applicant does not limit the claims in reply to the search opinion, the procedure will be delayed, since the non-unity objection will then have to be repeated in the first communication.

The reply should further deal with *all* objections raised in respect of the invention upon which further prosecution is based (see 4.4.2) as well as with any amendments made to the claims to overcome these objections (see 4.4.3).

4.4.5 Reply in case of an invitation under Rule 62a and/or Rule 63

GL H-II, 5

If an invitation under Rule 62a and/or Rule 63 has been sent and the applicant does not wish to contest the objections which led to an incomplete search, the set of claims should be amended to correspond to the subject-matter searched, which may entail deleting claims which were not searched. This will speed up prosecution.

If an invitation under Rule 62a and/or Rule 63 has been sent and the applicant contests the objections which led to an incomplete search, counter-arguments should be provided to the objections raised in the ESOP.

In both these cases, the reply should further deal with **all** objections raised in the ESOP in respect of the claims searched (see 4.4.2) as well as with any amendments made to the claims in order to overcome these objections (see 4.4.3).

If the applicant does not amend the claims or contest the objections, the procedure will be delayed, since the objection(s) will then have to be repeated in the first communication.

4.5 Communications of the examining division

GL C-III, 4

The applicant can readily determine whether to continue with the application and, if so, how to respond to all the objections if:

- communications cover *all* the objections to the application;
- reference is made to each claim being examined; and
- conditional inventive step objections are raised, even if the examiner considers that all the claims lack novelty.

Using the structure set out in 4.4.2 when drafting a communication is likely to increase procedural efficiency. Further:

- if a novelty objection is raised, the communication should clearly describe where all the features of a claim can be found in the prior art document cited against the claim; and

- when arguing on inventive step, the problem-and-solution approach should be used. Therefore, the closest prior art document should be identified and the reasons why that document is selected should be given. The objective problem based on that document should be identified and the reasons why the solution to that problem as set out in the claim is obvious should be given.

If the examiner considers that the application discloses patentable subject-matter, indicating this in the communication may help to make the grant proceedings more efficient.

The examiner will strive to issue further communications with the same timeliness as the applicants.

4.5.1 Further searches

In principle the search work should be done at the search stage. However, in exceptional circumstances the examiner is not barred from looking in examination for a relevant document which he knows of or which he believes to exist, if he can retrieve that document in a short time. This additional search should be carried out as early as possible in the proceedings.

GL C-IV, 7

The newly-retrieved document should then be:

- commented upon in the communication;
- annexed to the communication;
- scanned and uploaded into the electronic dossier. This applies only to non-patent literature, documents with handwritten markings or legal documents, as patent literature is available online anyway.

4.5.2 Non-unity

If the examiner raises an objection of lack of unity in a communication, he should:

GL C-III, 3

- provide the reasons for the objection;
- specify the different inventions;
- clearly indicate if the objection:
 - is being raised for the first time, triggering the 24-month period for filing an Art. 82 divisional application, or
 - has already been raised, thus not triggering that period again.

4.5.3 Requests for information from applicants

4.5.3.1 Translation of the priority document

GL F-VI, 3.4

If the applicant has filed the priority document in a non-official EPO language and the validity of the priority claim has to be checked (e.g. in view of an Art. 54(3) document), the examiner may seek the help of a colleague whose mother tongue is that of the document before inviting the applicant to file a translation. If this does not resolve the issue, the examiner should invite the applicant to file a translation of the priority document in an official EPO language. Such an invitation should contain an indication of the intermediate document(s) to which the priority date of the application is relevant.

In reply to the request, the applicant may either:

- send the translation;
- provide a declaration that the application is an exact translation of the priority document;
- argue, in a reasoned reply, that the validity of the priority is not a relevant issue; or
- amend the claims so that priority is no longer a relevant issue.

Where the applicant fails to reply to the invitation (or to provide a convincing reply or amended claims, in the case of the third and fourth bullet points above), the examiner can assume that the priority is not valid and that therefore the document(s) in question belong(s) to the prior art under Art. 54(2) or (3).

4.5.3.2 Information on prior art under Art. 124 and Rule 141

GL C-III, 5

When filing a European patent application claiming priority of a previous application, the applicant should submit a copy of any search results drawn up by the office of first filing. If the results are not yet available, he should submit them as soon as possible after they have been made available to him.

Where the results are not present in the file when examination is started, the examiner is still entitled to request information on such prior art, but should issue an invitation only in individual cases.

4.6 Replies to communications of the examining division

The considerations for replies to communications of the examining division are similar to those for replies to the written opinion (see 4.4).

If the applicant requests the complete reinstatement of claims which have already been objected to, even if objections under Art. 123(2) have been raised, the procedure will be delayed, unless the applicant also provides significant new arguments or evidence showing that reinstatement of the claims is justified.

4.6.1 Amended pages

4.6.1.1 Incoming documents

All amended pages or replacement pages filed with a response should meet the formal requirements of the EPC. Where the response clearly indicates the amendments made and the basis for them, the examiner will be able readily to determine whether the requirements of Art. 123(2) have been met.

GL H-III, 2

Filing two copies of any amended pages, with the amendments clearly indicated in one copy (for example by "track changes" or by clear manuscript amendments) while the other is a clean copy, further assists examination of the application.

Prosecution may be delayed if the applicant files only one copy of the amended pages and these contain handwritten amendments, because such pages cannot readily be set by the printer.

Where the claims are amended, the description should be amended accordingly. Amended description pages should be filed with the amended claims if it is clear from the communication that the amendments to the claims proposed by the applicant are likely to lead to grant.

Amendments may be necessary for:

- citation of relevant prior art;
- deletion of words such as "preferably" if not in line with amended claims;
- indication of embodiments which do not form part of the invention;
- deletion of "incorporated by reference"; and
- deletion of vague statements at the end of the description.

4.6.1.2 Handwritten amendments

Handwritten amendments are generally not suitable for printing and their use can delay grant. However, if amendments are required during oral proceedings or if the examiner wishes to make minor amendments to bring the application into order for grant, it is usually more efficient for such amendments to be handwritten.

GL H-III, 2.2

If handwritten amendments, whether introduced by the applicant or by the examining division, are not clearly readable or do not meet the formal requirements of the EPC, they cannot be transmitted to the printer for publication of the application or patent.

Printing is facilitated if margins are respected, vertical insertions are avoided and new paragraphs are inserted on a new page by way of a reference to them.

4.6.2 Auxiliary requests

GL H-III, 3

In reply to objections raised in the European search opinion or in a communication, the applicant may maintain either the claims as filed or a new set of claims as his main request and file alternative versions of claims as auxiliary requests. The examining division will not be required to conduct superfluous work if the applicant only files requests that he is likely to accept.

Examination of the application may be speeded up if:

- the main request and the auxiliary requests are listed in order of preference;
- the main request comprises the least limited claims and the lower-ranked requests comprise progressively more limited claims;
- the lower-ranked requests do not lead in a different direction to the higher-ranked requests; and
- a proliferation of auxiliary requests is avoided.

If the examining division considers a set of claims forming an auxiliary request to be patentable, it proposes this version for grant (possibly after having held oral proceedings) in a communication under Rule 71(3), stating why the higher-ranked sets of claims were considered to be non-allowable. If none of the requests is considered to be patentable, this is indicated in a reasoned communication.

If the applicant has no intention of proceeding further with the non-allowable requests, he should withdraw them, unless he wishes to obtain an appealable decision.

4.7 Time limit extension and accelerated procedure

4.7.1 Granting a request to extend a time limit

GL C-VI, 1

GL E-VII, 1 and 2

The time limit for replying to a communication is normally set at four months. While a two-month extension is generally granted, a further extension (for a total period of more than six months) is only exceptionally admissible if evidence (such as a medical certificate) is provided. If an applicant wishes to obtain a further extension, the request for the extension should be as detailed as possible and should be accompanied by any relevant evidence.

4.7.2 Difference between "enquiry" and "accelerated prosecution"

GL E-VII, 3

Sometimes an applicant asks to know when the search report or the first (or further) communication is to be expected. This is considered an "enquiry". The examiner should deal with this request as soon as possible, and should indicate a date for the next communication, of which the applicant will be informed.

An "enquiry" is thus *not* a request for accelerated prosecution, as provided for under the PACE programme. The PACE programme concerns both search and examination.

The EPO is unable to comply with a blanket request from an applicant for PACE on all his applications.

If PACE is requested for an individual application, the EPO will be more readily able to comply if the applicant:

- uses Form 1005E (available for download from the EPO website) for the request;
- provides complete application documents on filing (i.e. description, claims, abstract and, as necessary, translations, drawings, a sequence listing in the standardised format and deposit information for biological materials);
- does not ask for time limit extensions; and
- makes his submissions promptly and in full.

For Euro-PCT applications, if the applicant wishes to request entry into the European phase or to file a PACE request prior to 30 months from priority, he will need, in addition, to file a separate express request for early processing as well as explicitly waiving the right to the communication pursuant to Rules 161(1) or (2) and 162 so that the EPO can take up processing immediately (see OJ EPO 2011, 354).

4.8 Decision according to the state of the file

GL C-V, 15

Requesting an appealable decision using such wording as "on the file as it stands" or "according to the state of the file" means that the applicant wishes to close the exchanges with the examiner. A request for a decision on the state of the file should be filed only if at least one communication in examination has been sent. Such a request should not include new arguments or amendments. If the request is not clear, the examiner should solve the ambiguity with an enquiry to the applicant.

The examining division should then take a decision on the basis of the current state of the file. In such a case, the decision should be in a standard form, simply referring to the previous communication(s) for

its grounds and to the applicant's request for such a decision. The decision should not include any new objections.

The examiner should issue such a decision using the standard form only if:

- the earlier communication properly identifies the application documents on file and is well-reasoned and complete with respect to the grounds and the reasons for refusal of the current request;
- after the last communication no new arguments or amendments have been submitted by the applicant; and
- there is no outstanding request for oral proceedings.

4.9 Communication under Rule 71(3)

GL C-V

If both the examining division and the applicant have followed the above practice, the examining division will be able to issue the communication under Rule 71(3) after only a few communications.

If the examiner considers that he can propose amendments which will be clearly acceptable to the applicant and which will bring the application into order for grant, he should issue a Rule 71(3) communication where the amendments that he has proposed are shown on the "Druckexemplar". Any amendment, whether typed or handwritten, made in claims or in the description should meet the formal requirements of the EPC (see 4.6) and should be clearly indicated. The reasons and/or basis for amendments should be clearly and fully indicated.

The examiner should *not* issue a Rule 71(3) communication if major amendments are required to bring the application into order for acceptance. He should either (i) issue a further communication under Art. 94(3) and indicate in it the amendments he considers should be made or (ii) telephone the applicant to discuss the proposed amendments.

If in doubt whether an amendment is acceptable to the applicant, the examiner should contact him to discuss the matter. A telephone conversation between the examiner and the applicant can often speed up prosecution.

If the grant of a patent can be proposed only on the basis of an auxiliary request, for instance one proposed by the applicant at oral proceedings, the examining division shall provide complete reasoning why any higher-ranking requests do not fulfil the requirements of the EPC.

When preparing and despatching the communication under Rule 71(3), the formalities officer should make sure that:

- the application documents (e.g. description, claims, drawings, handwritten amendments) are complete, consistent and legible; and
- the bibliographical data listed on EPO Form 2056 annexed to the communication under Rule 71(3) are correct.

4.10 Reply to the communication under Rule 71(3)

In reply to the Rule 71(3) communication the applicant should pay the fee for grant and publishing and the claims fee, if applicable, and file translations of the claims in the two official languages of the EPO other than the language of proceedings, provided that he is able to accept the text proposed for grant.

GL C-V

He should carefully check the bibliographical data listed on EPO Form 2056E annexed to the Rule 71(3) communication to avoid errors in the publication of the patent. Corrections at a later stage involve further expense for the applicant and the EPO.

4.11 Consultation between the examiner or formalities officer and the applicant

There are instances where personal consultation, by telephone or interview, can be helpful in advancing the procedure. A telephone conversation can be held between the applicant and the formalities officer and/or the examiner, whereas an interview is held only between the applicant and the examiner. Personal consultations should be used wherever appropriate.

It is at the discretion of the formalities officer or examiner whether to hold a personal consultation on a specific issue. For certain formal issues, only written procedure is acceptable. Further, where substantial differences of opinion exist in examination, written procedure or oral proceedings are normally considered more appropriate.

A decision cannot be taken during a personal consultation with an examiner, as all decisions must be taken by the whole examining division.

4.11.1 Telephone consultations

4.11.1.1 Between formalities officer and applicant

When an applicant wishes to enquire about an application,¹ User Support should usually be the first point of contact. User Support should be contacted by telephone or by e-mail to support@epo.org (see also <http://www.epo.org/service-support/contact-us.html>). User Support normally deals with any enquiry within 24 hours. Enquiries are dealt with by experienced formalities officers, online product specialists or customer service representatives.

If an applicant has an urgent enquiry which cannot be dealt with by User Support in time, for instance regarding forthcoming oral proceedings, he should contact the examining division directly.

The formalities officer should contact the applicant by phone to deal with any minor or urgent issue. The formalities officer should take note of what was discussed and dispatch a summary to the applicant.

4.11.1.2 Between examiner and applicant

A personal consultation should be arranged if the examiner or applicant wishes to discuss an application with the other party. Generally, telephone consultations are preferred over interviews due to the difference in location and the time needed. However, if the applicant considers that an interview would be more appropriate, he should provide reasons for this when contacting the examiner to arrange the personal consultation.

Typical situations which could be suitable for a telephone consultation and where such consultations are encouraged are where:

- (i) the applicant wishes to make an enquiry about a procedural issue, such as how to proceed in particular circumstances (note however that the examiner is not normally in charge of formal issues, such as extensions of time limits and payment of fees);
- (ii) there appears to be an error in the communication/reply which makes it difficult for the applicant/examiner to prepare the next reply/communication (e.g. wrong document cited, communication based on wrong set of claims, new submissions referred to but not included);
- (iii) it appears that there is confusion about certain points in dispute, e.g. the applicant seems to have misunderstood the

¹ Enquiries relating to legal matters, such as the interpretation of the articles or rules of the EPC, should be sent to either patentlaw@epo.org or info@epo.org.

arguments of the examiner or vice versa, so that the written procedure does not lead anywhere;

- (iv) the application seems to be ready for grant except that the examiner needs to clarify some minor issues with the applicant or would like to discuss a proposal for amendments to overcome the objections raised;
- (v) amendments/corrections requested by the applicant after the Rule 71(3) communication have been sent but the examiner cannot agree to the request.

The following practice should be followed:

- the procedure set out in Guidelines C-VII, 2.1, when initiating a telephone consultation;
- if the person being called is unavailable and a message is left, e.g. on voice mail or via a secretary, the call is returned as soon as possible;
- if the person being called needs time, for example to retrieve the file and to study the issue or to consult others, a suitable time frame should be agreed upon and adhered to.

After the telephone consultation, the examiner should write minutes which are sent to the applicant, either for information only or with a time limit if the next action is to be taken by the applicant. If a telephone consultation leads to the issuance of a Rule 71(3) communication, separate minutes should normally not be written, but any amendments agreed are simply indicated in the communication.

4.11.2 Interviews

Telephone consultations should normally be preferred over an interview (see 4.11.1.2).

An interview may be appropriate if, for example, the applicant is visiting the EPO for some other reason and would like to take the opportunity to discuss the application personally with the examiner without incurring further travel costs. This particularly applies where:

- the representative is accompanied by an applicant or inventor
- the applicant would like to clarify certain technical details, e.g. by demonstrating a particular device or showing a presentation which cannot be included in a written response.

In such a case, an appointment must be arranged beforehand, preferably following the procedure set out in Guidelines C-VII, 2.1.

The examiner should decide whether an interview is appropriate. Depending on the objections on file and the time frame, he may suggest that holding oral proceedings would appear more appropriate. This is in particular the case where a negative decision is likely.

In some cases, e.g. when the inventor or an expert is attending the interview, the examiner should ensure that at least the chairman of the examining division also attends.

4.11.3 Use of e-mail

GL C-VII, 2.6

Currently, e-mail has no legal force in proceedings under the EPC and thus cannot be used validly to perform any procedural act and, in particular, to comply with time limits. However, in certain circumstances, e-mail can be used to increase the efficiency of the procedure.

4.11.3.1 Between formalities officer and applicant

If the information desk, User Support (see 4.11.1.1) or a formalities officer receives a procedural request via e-mail, the sender should be informed that the request has been forwarded to the relevant department and that procedural acts cannot be performed via e-mail. A standard communication asking the requester to file the request via fax should then be sent out.

Specific requests for file inspection (e.g. of colour copies or models) received by e-mail should be scanned into the electronic dossier and the formalities officer should be alerted by an internal electronic message to deal with the request.

If a general enquiry (relating for example to the progress of the file or when publication will take place) is received by e-mail, it should be replied to by e-mail or fax, and the request should be scanned together with the reply into the electronic dossier.

4.11.3.2 Between examiner and applicant

There is no obligation on either side to use e-mail, but use of e-mail may assist in shortening the proceedings, as it may allow for a more efficient exchange of ideas than repeated formal communications.

For non-published applications, confidentiality issues should be carefully considered and substantive matter (such as the details of the invention) should thus not form part of any e-mail correspondence concerning such applications unless the applicant consents.

New requests filed shortly before oral proceedings and sent only by e-mail are not considered validly filed and do not form part of the file. They do if they are sent by fax.

Typical examples where e-mail could nevertheless be useful are:

- for arranging a date for a telephone conversation, an interview or oral proceedings;
- when, during a telephone consultation, amendments to claims are being discussed and the applicant wishes to send amended documents to the examiner during the consultation to facilitate discussion;
- when agreed with the examiner over the phone that an electronic copy of amended claims should be sent, in addition to the official submission made, e.g. by fax, shortly before oral proceedings so that the examining division gets the documents in time for preparation of the oral proceedings. However, if documents or arguments are submitted late, even with advance notification by e-mail (see also the section on oral proceedings), the examining division has the discretion to refuse to admit them.

When e-mail is used, the examiner should annex a copy to the form used for indicating the result of a telephone conversation to ensure that it is included in the public part of the file.

5. Oral proceedings in examination

5.1 General principles

GL E-II, 2

The applicant may file a request for oral proceedings to ensure the application is not refused before they are held (conditional request). Clear and complete communications from the examining division and complete arguments and/or suitable amendments by the applicant should help to avoid oral proceedings.

However, when the written procedure has reached a stage where the examiner considers that no further progress can be made in a reasonable time, he should, after carefully considering the procedure so far, issue a summons to oral proceedings if such a request is pending.

If a request for oral proceedings is pending, the examiner must issue a summons to oral proceedings before any adverse decision is taken.

The examiner may issue a summons to oral proceedings of his own volition if they will help to clarify certain aspects and come to a final decision.

As a general rule, a summons to oral proceedings should be issued only if the examiner has already raised all the objections which he considers relevant and the applicant has replied to the objections in the written procedure, but the objections have not been overcome.

If the applicant is no longer interested in an application or wishes to receive an appealable decision on the state of the file, he should withdraw any existing request for oral proceedings.

If possible, all outstanding objections should be discussed during oral proceedings.

5.2 Preparation for oral proceedings

5.2.1 The summons

GL E-II, 6

The summons should be complete in the sense that all outstanding issues are listed and substantiated in its annex. If the applicant chooses not to attend the oral proceedings, the summons forms the basis for a decision (see 5.3 below).

The examiner should carefully consider on a case-by-case basis whether citing a new document would be appropriate. At an early stage in the procedure, he should consider sending a further communication before issuing any summons if a new document needs to be cited.

However, if the new document is cited merely to deal with an argument raised by the applicant, for instance as to the common

general knowledge or the meaning of a term used in the claims, it should be cited in the annex to the summons.

When setting the date for oral proceedings, the examining division should carefully consider any need of the applicant to file additional evidence, such as comparative data.

5.2.2 New submissions in reply to the summons

Submissions in reply to the summons should be filed within the time limit set with the summons. The examiner may exercise his discretion to exclude late-filed submissions from the proceedings.

If the applicant wishes to file auxiliary requests, the information given in section 4.6.2 should be taken into account.

New requests filed in reply to the summons should normally be discussed at the oral proceedings. As a rule there is no provision for detailed discussion before the oral proceedings. However, if the new requests are filed in good time and the examiner considers that a new request filed in the response to the summons is acceptable, he should contact the applicant to determine whether oral proceedings are still necessary.

Should the applicant wish to be accompanied at the oral proceedings by other persons, e.g. further attorneys, technical experts or assistants, he should inform the examiner in advance so that the examining division can be properly prepared and ensure that a room of suitable size is available.

The applicant should inform the examining division if he intends to make a special presentation during the oral proceedings (for example, using PowerPoint) so that the examining division can ensure that suitable equipment is present in the room. In addition, he should provide the presentation in advance, as for any other submission.

5.2.3 Examination of new requests before oral proceedings

The examining division should strive to review newly-filed requests in good time before oral proceedings so that the proceedings can be cancelled if necessary, in particular where a newly-filed main request is considered patentable.

If the examining division cannot find anything patentable at first sight in newly-filed requests, they should be discussed during the oral proceedings. In this case the examining division is not obliged to inform the applicant of the negative outcome in advance, but should do so at the oral proceedings.

The first member is not obliged to hold long or frequent telephone conversations shortly beforehand in order to avoid oral proceedings.

The latter, in the presence of the whole examining division, is the appropriate place for such discussions.

5.3 Non-attendance at oral proceedings

GL E-II, 8.3.3.3

If the applicant chooses not to attend oral proceedings, he should communicate this to the examining division as soon as possible.

The examining division then decides on a case-by-case basis whether oral proceedings should be held in the absence of the applicant or cancelled.

The examining division should take a final decision, if possible, even in the applicant's absence.

The examining division should normally hold oral proceedings in the absence of the applicant if new requests which necessitate further discussion in the division have been filed in response to the summons (see OJ EPO 2008, 471).

A decision can be taken on the basis of the objections, facts and arguments presented in writing or on the basis of new objections which the applicant could expect to be raised. Therefore, in his absence, the applicant should expect a decision to be taken on the basis of objections which might arise against any new requests.

5.4 Postponement of oral proceedings

GL E-II, 7

If, for good reason, the applicant requests postponement of the oral proceedings, the request should be made as early as possible.

The examining division should decide on any such request on the basis of the criteria set out in OJ EPO 2009, 68.

If the examining division wishes, for good reason (e.g. the first member is unavailable and no suitable replacement can be found), to postpone the oral proceedings of its own motion, it must consult the responsible director as early as possible before doing so.

5.5 Videoconferences

5.5.1 The request

GL E-II, 11.1.1

A request for a videoconference can be made either:

- in response to the first Art. 94(3) communication (see 5.5.2 below), or
- in reply to the summons, in which case it should be filed as soon as possible in order to increase the likelihood of room availability.

If the applicant requests a videoconference, he must have his own facilities available: the videoconference rooms of the EPO cannot be used by representatives.

5.5.2 Deciding on the request

The examining division should consider the request carefully and decide on it in accordance with the Notice in OJ EPO 2006, 585. *GL E-II, 11.1.1*

Exceptionally, if no rooms are available or if the case, due to its complexity, is considered unsuitable for a videoconference, the division should refuse the request.

If the request is made in response to the first Art. 94(3) communication and the examiner accedes to it, he should try to accommodate this wish when finding a suitable date. If the request cannot be granted, reasons should be indicated in the summons to oral proceedings.

5.5.3 Conduct of a videoconference

Participants in a videoconference should observe some practical details: *GL E-II, 11.2*

- the applicant has to make the connecting call at the beginning of the videoconference and thus bear the connection costs;
- as oral proceedings in examination are not public, the division needs to be able to identify all persons taking part in the videoconference: all participants should be able to identify themselves, e.g. by showing their ID cards using a document camera or by faxing a copy (preferably in advance);
- the representative should have available both a fax machine (for filing further submissions) and a document camera (for showing details of documents);
- if, exceptionally, there are serious technical problems which cannot be fixed rapidly, the videoconference will be ended and a new date set for normal oral proceedings;
- video or audio recording of the videoconference is not allowable;
- during discussions, care should be taken to wait for the sound to be transmitted so that information is not lost; thus all participants should exercise strict discipline during discussions;
- the camera should be oriented so that all participants in a room can be viewed at the same time.

5.6 Conduct of oral proceedings

Oral proceedings should be conducted in a fair, efficient and structured manner; they should reflect the points for discussion set out in the annex to the summons, at least to the extent that these are still applicable to any amended claims filed in response to the summons.

The *chairman* should ensure that:

- the discussion does not become unnecessarily digressive;
- only points of relevance to the decision to be reached are discussed;
- repetition of arguments already presented during written proceedings is avoided as much as possible.

Each side should:

- respect the opinion of the other side;
- not enter into lengthy and repetitive discussions with the mere aim of wearing down the other side;
- attend oral proceedings well prepared on all outstanding points, including being familiar with the written submissions, as well as with all relevant cited documents.

The *representative* should also have a clear mandate from the applicant as to the kind of amendments that can be made during the proceedings, if necessary.

5.6.1 Filing of new requests during oral proceedings

The applicant should submit a coherent set of clearly formulated requests in advance of the oral proceedings to facilitate their efficient conduct.

It is at the discretion of the examining division to allow the submission of new requests at oral proceedings. If the request is *prima facie* allowable, for instance because it follows from discussions which have taken place at the oral proceedings, the division should more readily exercise its discretion in favour of the applicant.

The examining division should normally take a constructive attitude at oral proceedings, but the applicant should not expect it to formulate allowable claims for him.

Any amended documents filed during oral proceedings must be clearly legible and suitable for reproduction (see 4.6.1.2). They must be dated and signed by the representative.

Where the grant of a patent is envisaged, the applicant should adapt the description and the dependent claims accordingly during the oral proceedings.

Where a grant is envisaged on the basis of an auxiliary request, see 4.6.2.

5.7 Procedure after oral proceedings

The minutes of the oral proceedings should contain:

GL E-II, 8.11

GL E-II, 10

- a list of all requests made during oral proceedings;
- a summary of the essentials of the oral proceedings;
- a summary of relevant statements made by the representative and the examining division;
- a summary of the main arguments relevant to the decision and not contained in the written submissions;
- as an annex, any documents submitted during oral proceedings.

If the content of the minutes is incorrect, the applicant may request that the minutes be corrected.

The minutes should preferably be sent within one month of the oral proceedings. If not, the applicant may enquire when the minutes will be sent.

The set of claims agreed for grant during oral proceedings should be changed, either by the examining division or by the applicant, only in exceptional circumstances, for instance where an obvious error, such as in the claim dependencies, was overlooked during oral proceedings.

Where the examining division has not issued the subsequent official action (normally either a Rule 71(3) communication or a decision to refuse the application) within a reasonable time, such as within three months of the oral proceedings, the applicant may enquire when it will be issued.

5.8 Third-party observations

5.8.1 Filing of third-party observations

A third party wishing to file observations on the patentability of an application, or of a patent during opposition proceedings, is encouraged to use the EPO's web-based interface provided via the European Patent Register, as this guides third parties through the possible objections that can be raised and gives valuable information on how to raise them. The use of this interface should ensure that all

GL E-V, 3

important issues can be dealt with appropriately and should facilitate the uploading of documents.

When filing his observations, the third party should ensure that:

- the European patent application or publication number is clearly identified;
- all documents are identified in a list and given a reference number in sequential order;
- any non-patent literature document cited against novelty and/or inventive step is annexed;
- the observations provide evidence in support of any objection under Art. 83;
- the observations clearly identify each document used to attack the novelty of a claim and where in each document every feature of that claim is disclosed (see 7.1.4); and
- the observations clearly identify the document considered as the closest prior art and provide arguments on the basis of the problem-solution approach (see 7.1.4).

This makes it easier for the examiner to consider the observations and determine whether they prejudice the patentability of the application.

The examiner cannot request further explanations on the submissions from third parties. Thus, the third party should ensure that the submissions are clear and unambiguous and that for any documents cited clear explanations as to their relevance are given.

Observations should not use offensive language. Offensive language would in any case be filtered out.

Although lack of novelty and/or inventive step are the most common objections, third-party observations can also be directed to other requirements of the EPC, i.e. clarity (Art. 84), sufficiency of disclosure (Art. 83), patentability (Art. 52(2), (3), 53 or 57) and unallowable amendments (Art. 76(1), 123(2)).

5.8.2 Handling of third-party observations

The receipt of third-party observations should be acknowledged by the formalities officer by means of notifications sent to the third party and to the applicant.

The examiner in charge of the file should first carefully study and then briefly comment on the observations in the subsequent Office action. This also applies where the documents provided by the third party do

not call into question the patentability of the subject-matter claimed or are less relevant than the prior art which is already present in the file; in such cases, the examiner should inform the applicant (and the public) accordingly by using a standard formulation.

If the observations are received:

- before the search report is issued, any relevant document should be included in the search report and commented on in any attached search opinion;
- during the examination stage, the information should be commented on in an Art. 94(3) or Rule 71(3) communication;
- during opposition proceedings, the information should be commented on in a communication to the parties or in the annex to the summons to oral proceedings.

6. Revocation and Limitation

6.1 Request for revocation

The handling of requests for revocation is easier if:

- the request is filed online;
- the fee is paid by debit order;
- the requester is clearly identified so that it is easy to establish whether the requester is the patent proprietor;
- evidence is provided that the requester is the successor in title, in cases where the requester is not identical to the patent proprietor as entered in the European Patent Register; and
- evidence is provided that the requester is entitled to act on behalf of the other proprietor(s), in cases where the requester is not the patent proprietor for all contracting states.

If the request for revocation covers all the points listed above and is admissible, the examining division should revoke the patent and communicate this to the patent proprietor shortly after the request is made.

6.2 Request for limitation

The handling of requests for limitation is easier if:

- the request is filed online;
- the fee is paid by debit order;
- the requester is clearly identified;
- the claims to be limited are clearly identified;
- the basis for the amendments to be made in the application as originally filed is given; and
- arguments are provided showing that the scope of protection is limited.

If the request for limitation covers all the points listed above and is allowable, the examining division should communicate this to the patent proprietor shortly after the request is made and ask him to pay the fee and file translations.

If the request for limitation is not allowable, shortly after the request is made the examining division should issue a communication covering all the objections and indicating that the patent proprietor has only one possibility to amend the claims.

GL D-X, 2
GL D-X, 3

GL D-X, 2
GL D-X, 4

If only arguments are submitted in reply to the communication and no amendments to the application documents are proposed, the reply should provide an explanation of the reasons why the applicant does not agree with the examiner's objections.

If the response to the communication relies on amended claims and/or description, as well as providing arguments in favour of Art. 84 and 123(2), the reply should deal with the amendments made, and should in particular contain:

- an indication of what has been changed;
- an indication of the basis in the application as originally filed;
- the reasons for changing the claims.

7. Opposition

7.1 Filing oppositions

GL D-III

Electronic filing (see part 1 of this document) of an opposition will ensure that the notice of opposition is complete with respect to the formal requirements of the EPC and that the opponent receives an automatic acknowledgment of receipt.

If electronic filing is not possible, oppositions should be filed using Form 2300E to facilitate processing by the EPO.

When filing an opposition:

- the opposition fee should be paid;
- the opponent should be clearly identified;
- the notice of opposition should be signed;
- the grounds for opposition raised should be fully substantiated;
- the extent to which the patent is opposed should be clearly indicated;
- all the documents cited in support of the argumentation should be filed within the opposition period in one of the EPO's official languages;
- where prior use is alleged, all the available information should be provided within the opposition period; and
- where a witness hearing is requested, the witness should be clearly identified, his address should be given, and it should be indicated why and for what purpose the witness is to give testimony.

This will allow the EPO to process the opposition efficiently, without needing to request further information or documents from the opponent, which could increase costs for the opponent.

7.1.1 Added matter

GL D-V, 6

The opponent should explain why the requirements of Art. 123(2) are not met and should clearly indicate the passages of the original application supporting the argumentation, so that the opposition division can fully understand the argumentation without requiring further explanation from the opponent.

7.1.2 Sufficiency

GL D-V, 4

The opponent should explain why the invention cannot be carried out by the skilled person and should indicate and explain the relevant

passages of any documents submitted in support of the argumentation.

7.1.3 Non-patentable subject-matter

Where it is alleged that the claims of the opposed patent cover non-patentable subject-matter, the opponent should explain why he considers this to be the case.

GL D-V, 3

7.1.4 Lack of novelty or inventive step

Where it is alleged that the claims of the opposed patent lack novelty or inventive step, the opponent should explain why he considers this to be the case. The relevant passages of the documents used in support of the argumentation should be indicated and explained.

GL D-V, 3

When raising a novelty objection, the opponent should clearly describe where all the features of a claim can be found in one prior art document.

When arguing inventive step, the problem-solution approach should be used. The closest prior art document should be identified and the reasons why that document is selected should be given. The opponent should clearly indicate which features of a claim can be found in the closest prior art document and what the distinguishing features are. The objective problem based on that document should be identified and the reasons why the solution to that problem as set out in the claim is obvious should be given. Where appropriate, other documents should be cited which identify common general knowledge or disclose features of the claim not disclosed in the closest prior art.

7.1.5 Prior use

When alleging prior use, the opponent should clearly explain what was made available to the public, where, when, how and by whom. To support such an allegation, all available evidence, such as delivery receipts, invoices, data sheets, bills, company manuals and technical specifications, should be filed. The opponent should explain how it can be inferred from this evidence that the invention was available to the public prior to the effective date (filing or priority date) and which features of the claim were contained in this prior disclosure.

GL G-IV, 7.2

7.2 Actions after opposition is filed

7.2.1 Patent proprietor's submissions

The patent proprietor should file his request for revocation of the patent, or his submissions in defence of the patent, online and within the four-month period to allow for efficient processing of the opposition.

GL D-IV, 5.3

Where the patent proprietor requests revocation of the patent, he should avoid ambiguities by using the following wording:

"I hereby request revocation of European patent No. X XXX XXX"

The proprietor's submissions, and any new claim requests or evidence which may accompany them, should deal with the objections raised by the opponent(s) in a structured manner (see also 4.4.2). This allows the opposition division to readily evaluate the opponents' objections.

The proprietor should clearly indicate the ranking of any new claim requests (see also 4.6.2).

Prosecution of the opposition is facilitated if the proprietor indicates, in respect of each new claim request:

- why the claim request overcomes a ground of opposition;
- where the basis for the amendment(s) is to be found in the original application;
- why the claim request does not extend the scope of protection; and
- why the claim request fulfils the other requirements of the EPC.

7.2.2 Further submissions by the opponent

Where the opponent submits further observations in reply to the patent proprietor's submissions and they, where applicable:

- provide substantiated arguments to explain why the proprietor's arguments are not convincing and/or why the objections made previously still apply to the new requests; and
- provide substantiated arguments to explain why the amendments made in any new request or auxiliary request give rise to new objections (for example under Art. 84 or Art. 123(2) or (3)),

this will aid the opposition division in defining the issues on which it needs to make a decision.

The opposition division should exercise its discretion as to whether to admit documents or grounds of opposition introduced by the opponent at this stage of the procedure.

7.3 Time limit extension and accelerated procedure

Time limits fixed by the EPO in opposition proceedings can be extended on request up to a total of six months. Full reasons for a request for a further extension should be provided so that the

GL E-VII, 1.6
GL E-VII, 4

opposition division can determine whether there are exceptional circumstances which justify the granting of such a request. The request should be refused if the reasons are insufficient.

Likewise, full reasons for a request for accelerated processing should be provided so that the Opposition Division can determine whether such a request is justified. The request should be refused if the reasoning is insufficient

The opposition division should accelerate the proceedings if a national court or a competent authority of a contracting state informs the EPO that an infringement action is pending with respect to the opposed patent.

If a request for accelerated processing is allowed, the opposition division should issue the next procedural action within three months of receipt of the request or of expiry of a set time limit.

The opposition division may exclude (under Art. 114(2)) a reply from the proceedings as being late-filed if it is not filed within the time limit set by the EPO.

7.4 Oral proceedings

7.4.1 Summons to oral proceedings

If any party to an opposition has requested oral proceedings and the opposition division considers that the issues to be decided are sufficiently clear, the opposition division should, as a first action after the patent proprietor's reply is filed, summon the parties to oral proceedings. In the preliminary, non-binding opinion accompanying the summons, it should indicate its opinion with respect to all the grounds raised by the opponent(s). It should clearly indicate the reasons why it has come to its preliminary opinion.

GL D-VI, 3.2
GL E-V, 2.2

If, after the patent proprietor's reply is filed, the opposition division needs to seek further clarification before issuing the summons, it may issue a communication if it believes that this might facilitate proceedings. The communication should deal with all the grounds of opposition raised and should invite the parties to present comments within four months.

7.4.2 Preparation of oral proceedings

The opposition division and the parties should consider and deal with the following points well before the oral proceedings to facilitate their conduct.

GL E-II, 8.5
GL E-II, 8.5.1
GL E-II, 8.5.1.1

If needed, authorisations should be filed.

- All the submissions in preparation for the oral proceedings should be submitted within the time limit set in the summons.

- New requests, documents, grounds for opposition and/or submissions filed after the time limit set in the summons risk not being admitted into the proceedings. If such material is filed late, the filer should send the material to the other parties to the opposition proceedings so that they have time to consider them in case the opposition division decides to admit them into the proceedings.
- A request by a party to have accompanying persons, such as technical experts, at the oral proceedings should be announced within said time limit, but preferably as early as possible, so that the opposition division can ensure that the room meets the need. If the request is made too late, the room may not be large enough to allow the accompanying persons to sit with the applicant.
- A request by a party wishing an accompanying person such as a technical expert, inventor or assistant to address the opposition division should be filed as soon as possible and should provide the relevant details of the person and the subjects he wishes to address. If this is not done and the other parties object, the opposition division should refuse to allow the person to address it.
- Requests for use of special equipment, such as a projector, during the oral proceedings should be made as soon as possible so that the EPO is able to provide such equipment.
- A party withdrawing a request for oral proceedings or announcing its non-attendance should communicate this well ahead of the date fixed to avoid costs being awarded against it.
- A party indicating to the opposition division at short notice that it will not attend the oral proceedings should inform all the other parties as well. The party concerned may have costs awarded against it.
- A party requesting the hearing of a witness should make the deposit or file the waiver signed by the witness well ahead of the oral proceedings in which the opposition division has decided to hear the witness. The same applies to indicating the language in which the witness will give his testimony. If this is not done, the opposition division should not hear the witness. It should exercise its discretion as to whether the parties may ask questions of the witness.

The opposition division should try to ensure that the room has all the required equipment, including electrical power outlets, and space.

A party to the proceedings wishing to use a laptop computer or other electronic device (e.g. smartphone) should assure the opposition

division that all recording functions on the computer are turned off and that it will take the computer with it during breaks in the oral proceedings. If asked, a party should ensure that accompanying persons have the recording functions of any device in their possession turned off and that such devices are taken out of the room at breaks in the oral proceedings.

7.4.3 Interpretation

A request for interpretation to and/or from the language of the proceedings into a different EPO official language is subject to the following requirements:

GL E-IV, 1

- It should be filed only if really necessary, as the costs involved in providing interpretation are high and are paid from procedural fees.
- It should be filed within the time limit set by the EPO, preferably at the earliest possible stage.
- After it has been filed, the EPO should be informed as soon as possible if it turns out that interpretation is no longer needed.
- Interpretation should also be requested for witnesses, if needed, but not for accompanying persons.

7.4.4 Conduct of oral proceedings

The opposition division should make sure that the hearing is fair and that every party has sufficient time to present its case. However, if a party appears to be making a lengthy repetition of the written case, the opposition division may request it to limit its presentation to the salient points identified by the division in the annex to the summons. A party wishing to introduce new documents or new claim requests during oral proceedings should provide cogent reasons for their admission, as generally they are admitted only in exceptional cases.

GL E-II, 8.2

The chairman should conduct the oral proceedings such that a decision can be taken at their end.

7.4.5 After the oral proceedings

Directly after the oral proceedings the public should be informed of their outcome (Form 2341E). If the patent is maintained on the basis of amendments filed during oral proceedings, the amendments should be annexed to the form.

GL E-IX, 1.1

GL E-IX, 4.1

GL E-IX, 5.2

Any party may enquire when issue of the minutes of the oral proceedings (and, where applicable, of the taking of evidence) and the written reasoned decision can be expected if they are not issued in reasonable time after the oral proceedings.

The case may be remitted to the opposition division after an appeal for purely formal reasons if the decision is not well reasoned, for

instance because it does not consider all the arguments presented by a losing party or explain why the opposition division does not agree with those arguments. This will prolong the proceedings considerably and will involve substantial additional costs for the parties and the Office.

8. Complaints

8.1 What to consider when making a complaint

8.1.1 The importance of making a complaint

Anyone dissatisfied with the services of the EPO, whether or not he is a party to the proceedings in question, is encouraged to make his dissatisfaction known to the Office. The EPO takes feedback seriously and strives to use it as a basis for continuous improvement. There will be no negative consequences for the complainant merely because he files a complaint.

The EPO will investigate all complaints. Problems are corrected where possible and lessons drawn for the future. However, this can only happen if the EPO knows that there is a problem.

The earlier a complaint is received, the more likely it is that the EPO will be able to correct any mistakes that have been made. Once a final decision has been taken or an application is withdrawn, it is too late: complaints are best made as early as possible.

8.1.2 Procedure for making a complaint

Complaints can be submitted to the EPO by any convenient means. Written complaints are easiest to deal with, especially if sent by e-mail direct to Directorate Quality Management Support (the department responsible for handling complaints) at *dqms@epo.org*.

If a complaint is contained in a response filed in connection with a particular application, the response must be filed by the official means, preferably online. In this case, the complaint will be investigated more quickly if a copy of the response is sent by e-mail to DQMS.

Should the complainant not identify the issues clearly, the EPO may not be able to respond to the complaint and will have to contact the complainant to clarify the outstanding points.

The application numbers of relevant cases should be provided, if possible, since this will help to make all the circumstances clear, allowing the EPO to identify and investigate the actual case or cases where the problem occurred.

The complaint should mention as many cases as possible where the problem occurred to assist the EPO in identifying the cause of the problem and finding an appropriate solution where a systematic error is suspected.

The complaint should make clear whether a mistake by the EPO has had (or is likely to have) serious consequences for the applicant or representative.

The EPO welcomes ideas for improvement from outside, even if they cannot always be translated directly and promptly into practice.

8.2 How the EPO handles complaints

All complaints are investigated and followed up internally within the EPO.

Directorate Quality Management Support (DQMS) is responsible for dealing with complaints. DQMS is a department outside the operational line. It looks into the case, together with the head of the department responsible for the case in question, to establish what has happened, whether the complaint is justified, and whether follow-up action such as a change in procedure is needed. It reports annually to the President of the EPO on complaints received.

8.2.1 Response time

DQMS aims to reply to complaints within 30 days. In the rare cases where it cannot manage this (e.g. because of extensive consultations), the complainant will be kept informed.

8.2.2 Limitations

The treatment of complaints takes place outside the scope of the normal patent procedure. Although DQMS investigates all complaints, it has no authority to influence or review the legal decisions taken by other EPO departments.

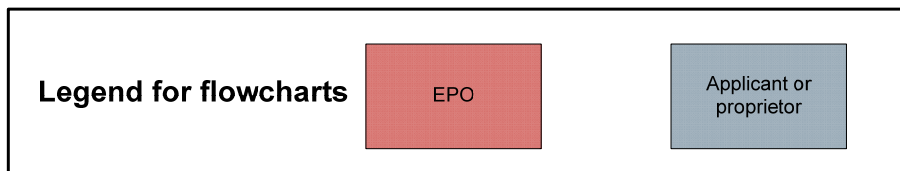
DQMS normally provides complainants with feedback on the results of its internal investigation. In a few situations, this may not be possible, for example if a binding decision has already been taken, or if other parties are involved.

In the interests of legal certainty, DQMS can advise other departments to issue corrections or refund fees only if there is a legal basis for them to do so. In particular, the valid payment of a fee has a legal effect, so a refund is usually not possible unless a mistake has been made.

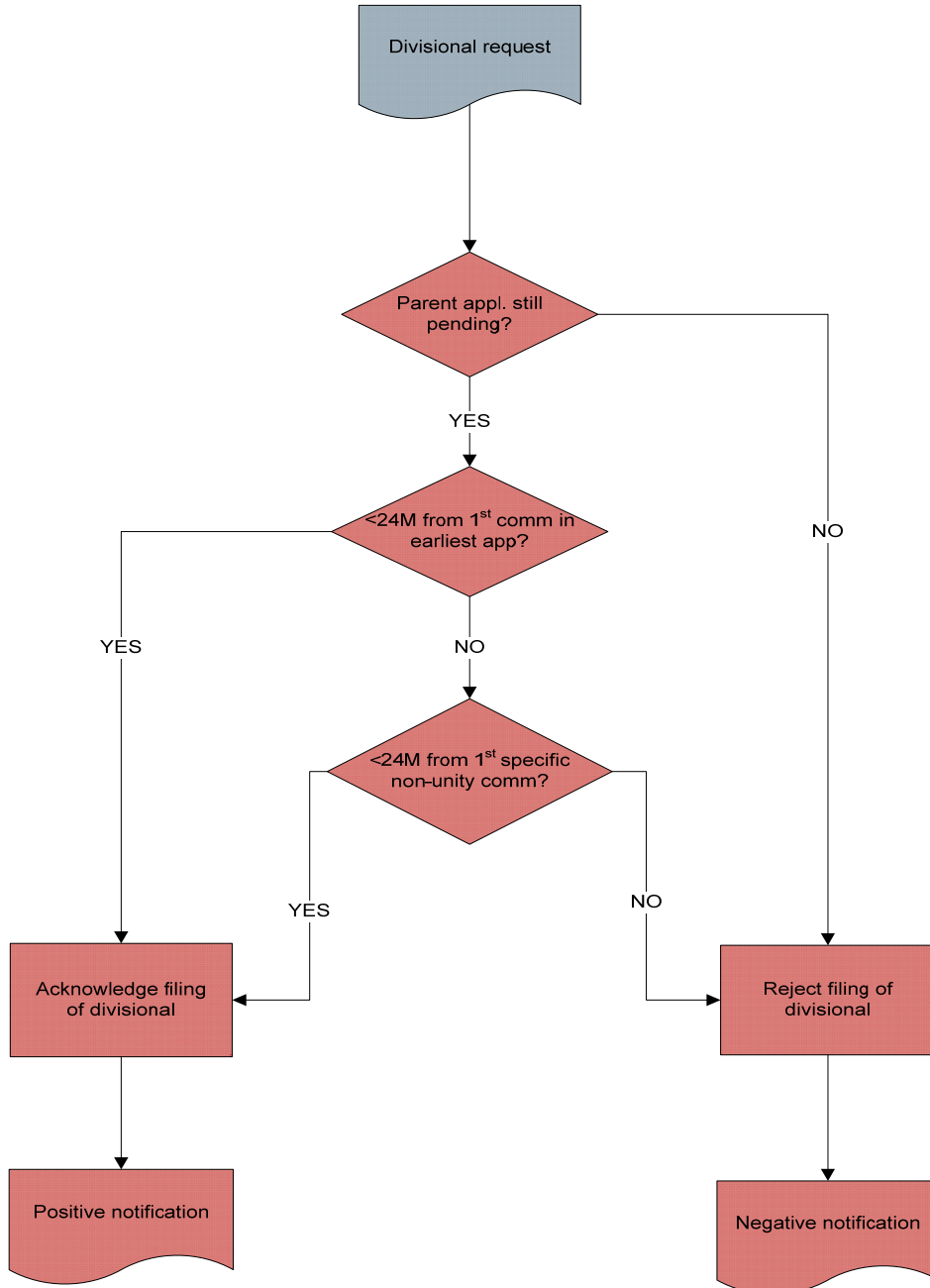
Making a complaint is not a substitute for available legal remedies: if the procedure provides for means of legal redress in a given situation, the complainant may consider following these in parallel with complaining to DQMS.

A complaint related to a specific application will be added to the electronic file. If it contains material which needs to be taken into account in the procedure, it will be placed in the public part of the file.

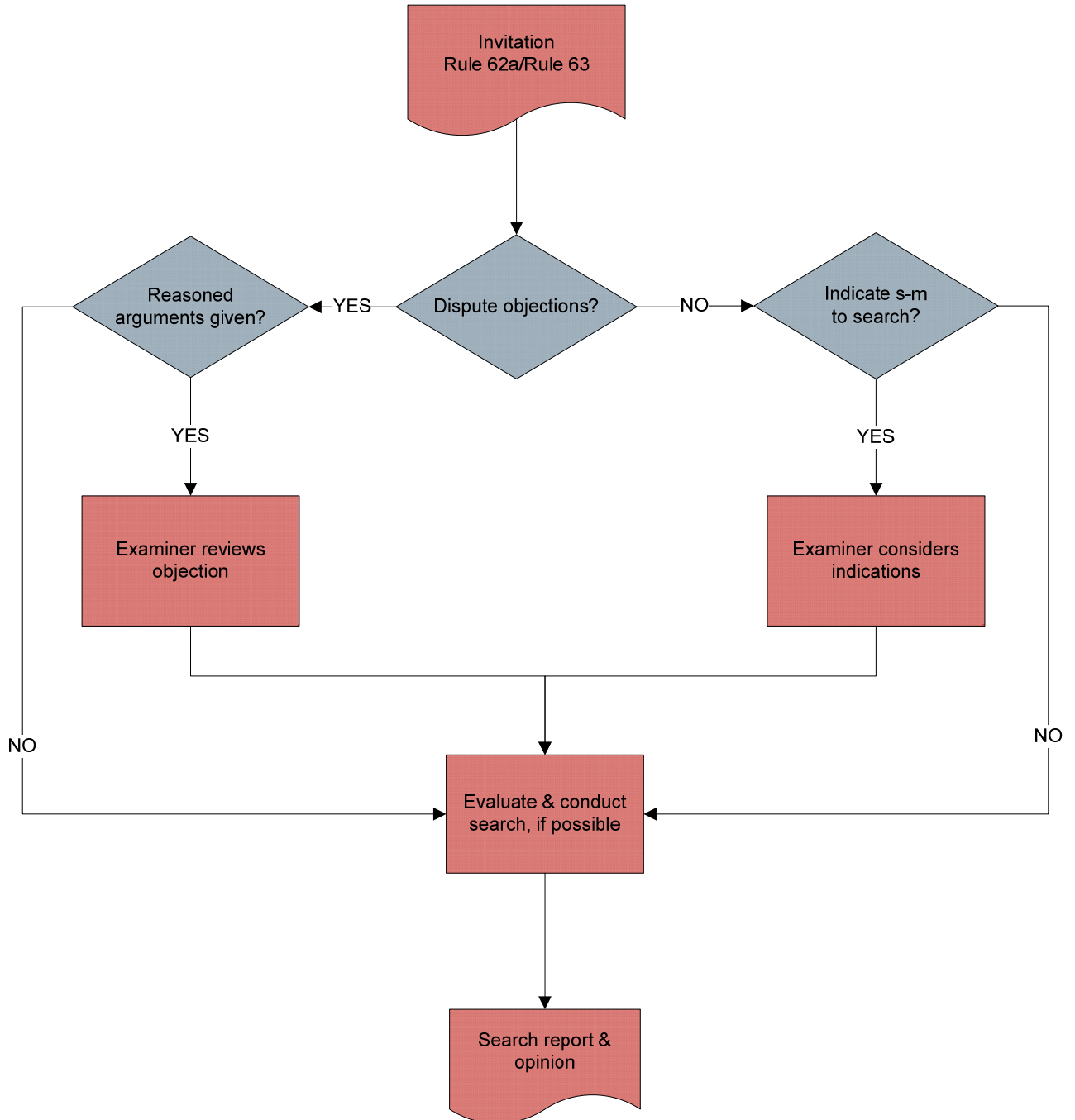
Annexes



Annex I
Filing of a divisional application

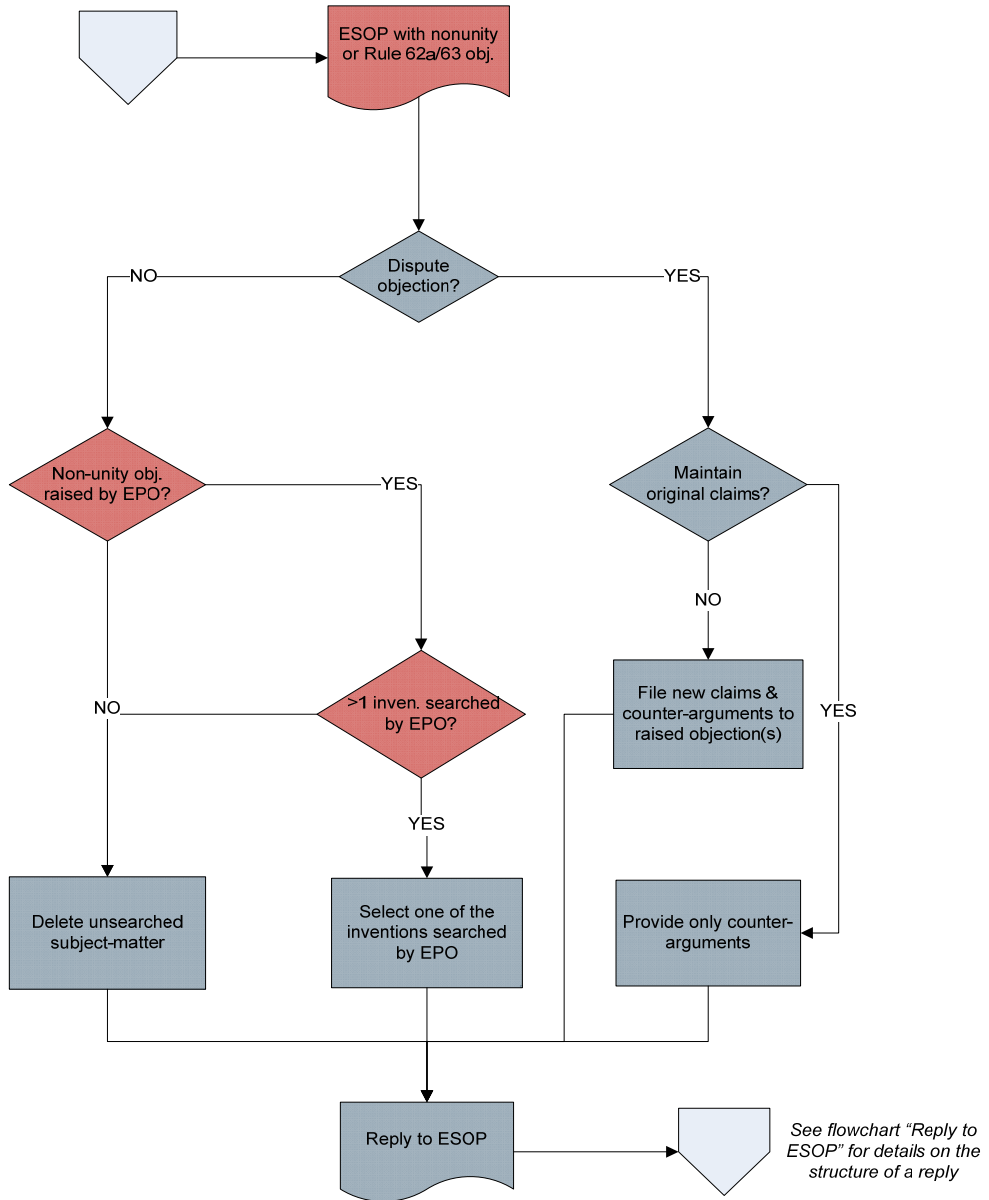


Annex II
Applicant's reply to Rule 62a/63 invitation



Annex III
 Non-unity or Rule 62a/63 in examination

Continued from flowchart
 "Reply to ESOP"

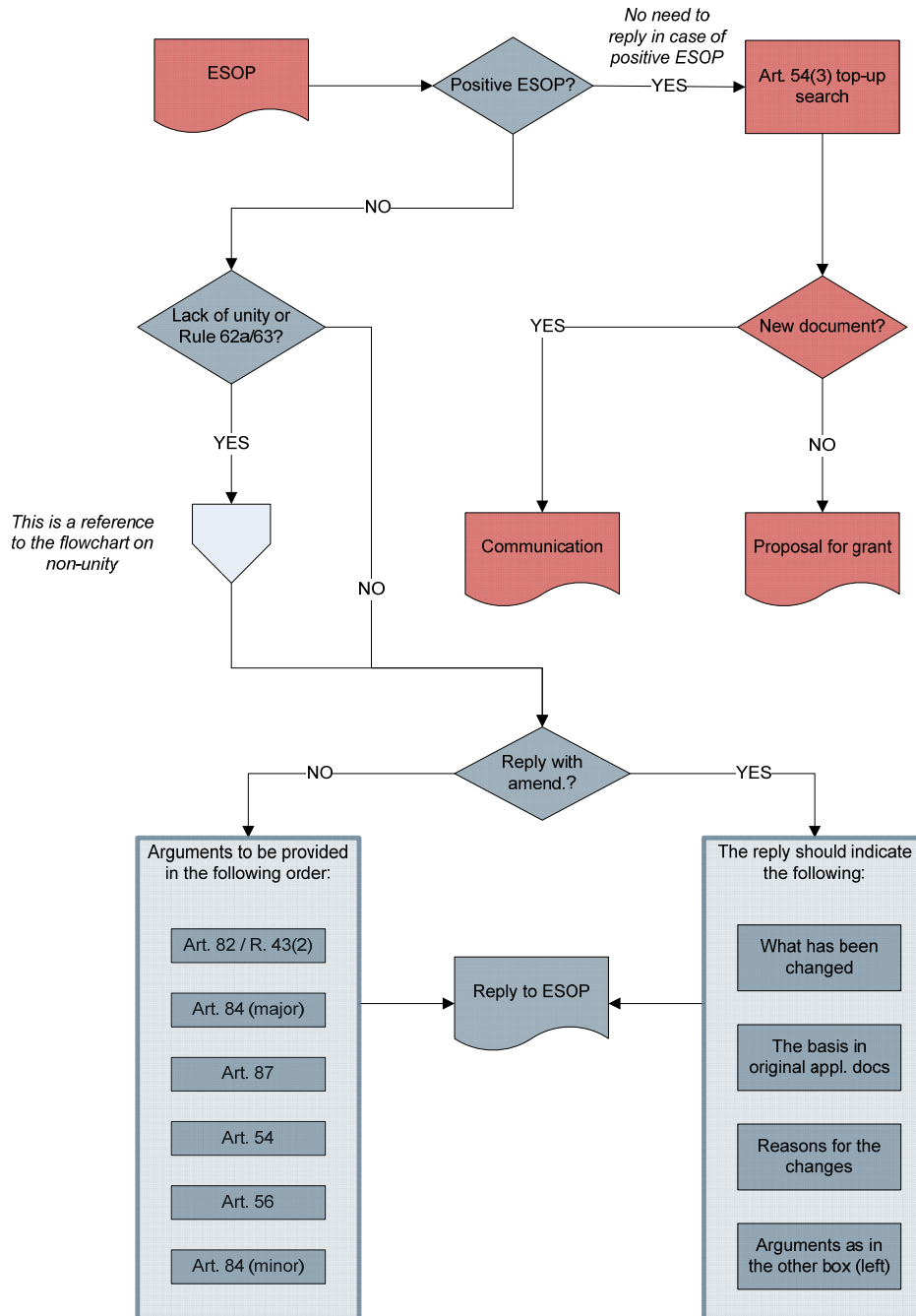


See flowchart "Reply to ESOP" for details on the structure of a reply

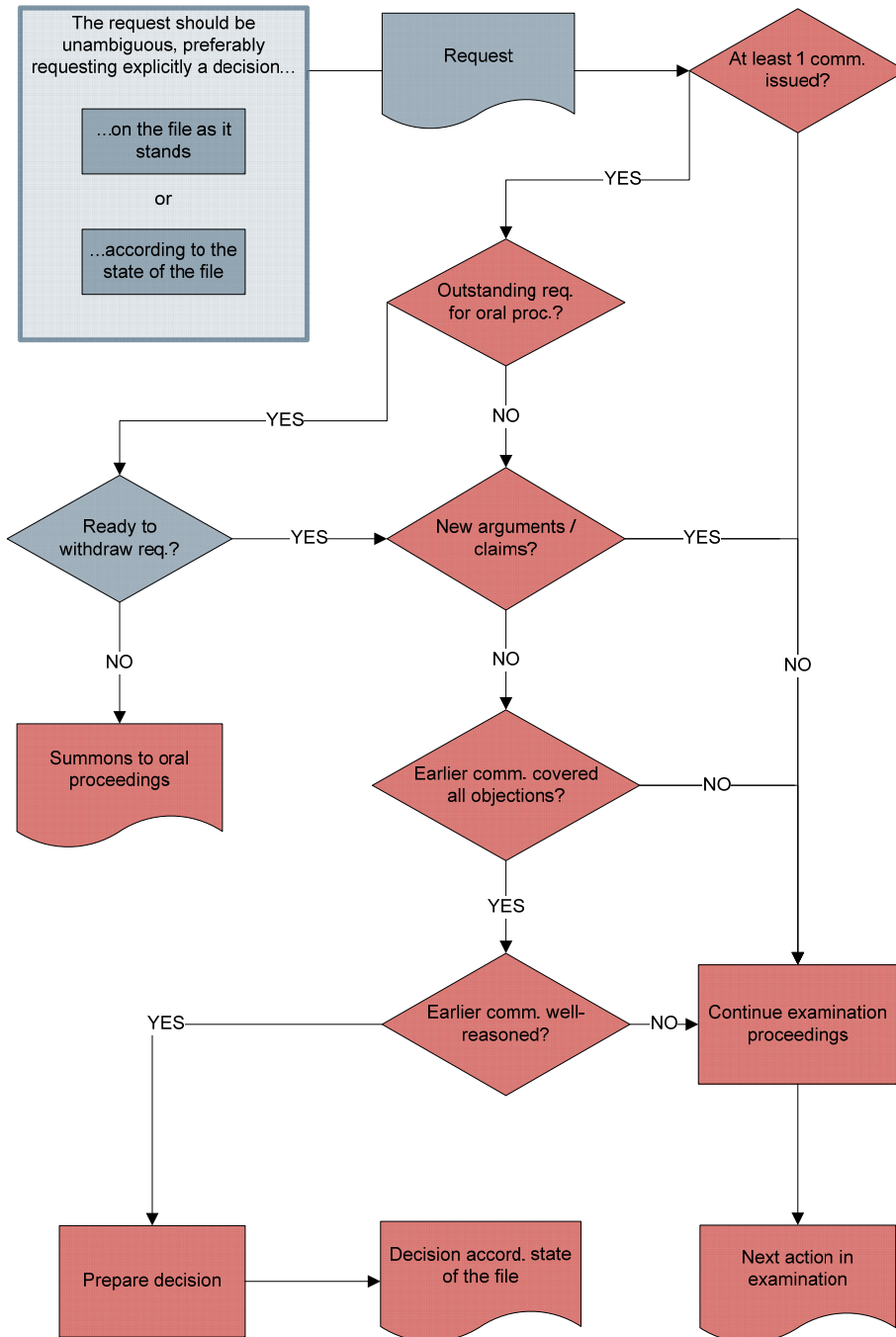
**In case of lack of unity raised at search with a request to pay additional search fees*

Annex IV

Reply to ESOP

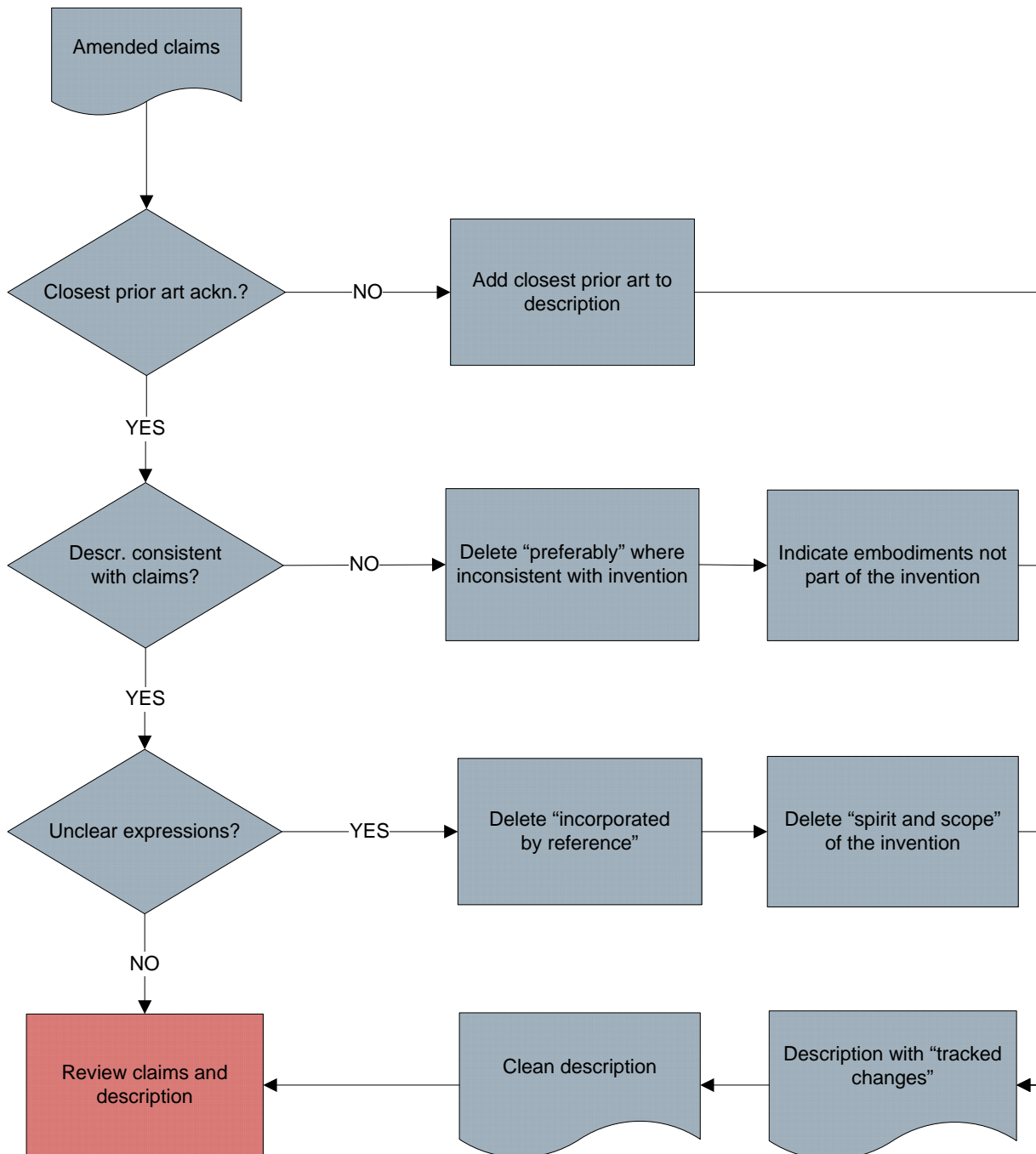


Annex V
Decision according to the state of the file

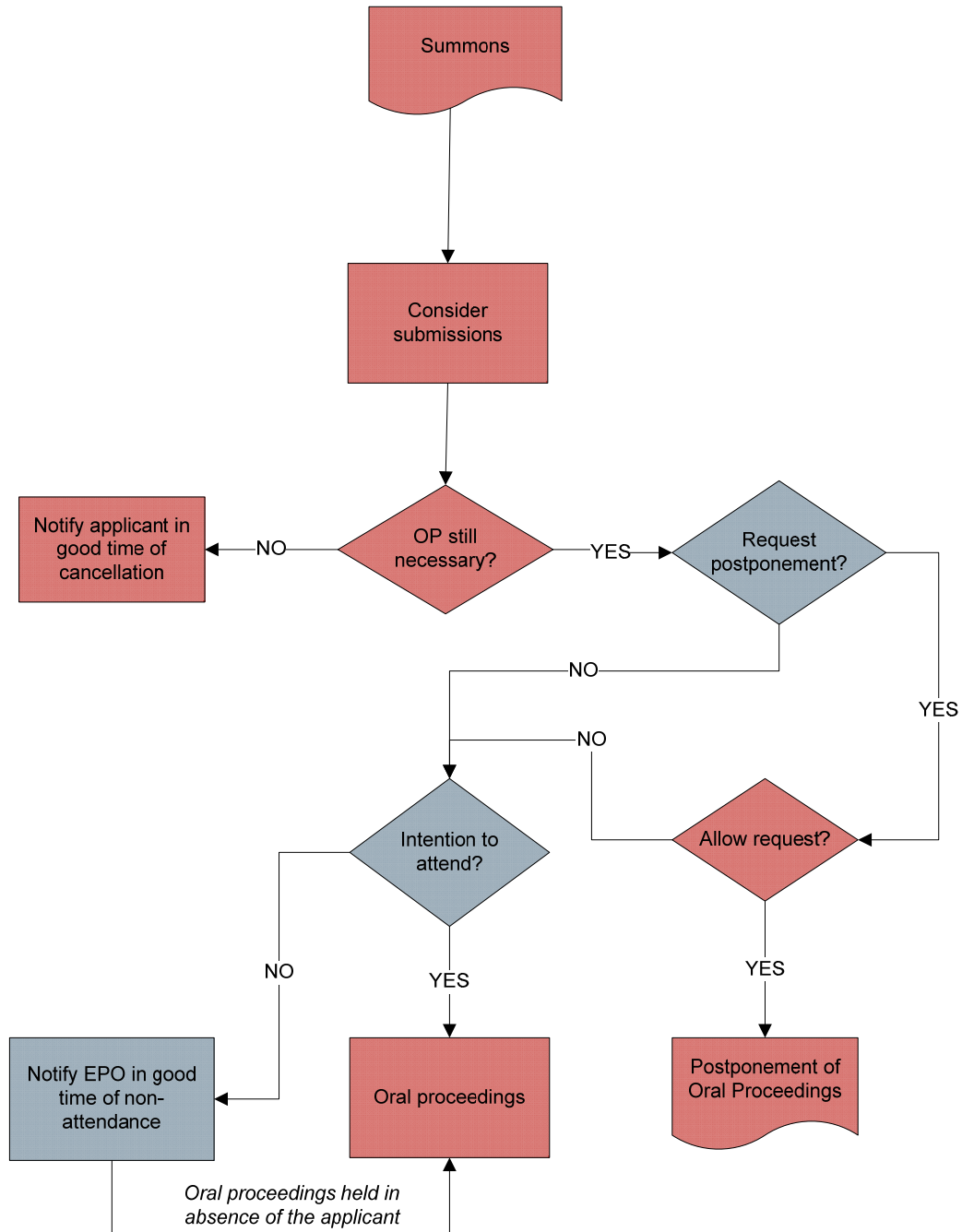


Annex VI

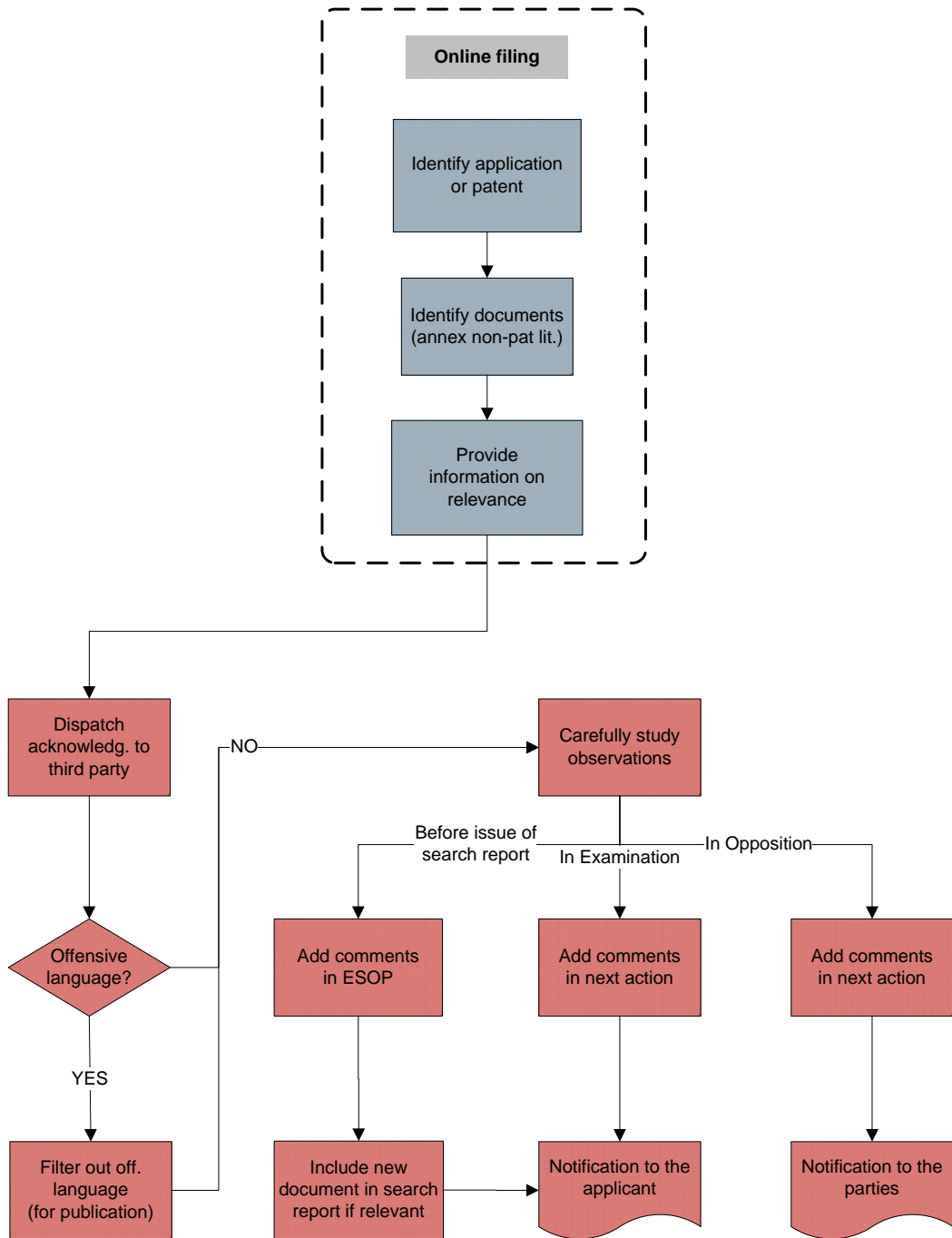
Amendment of description in view of amended claims



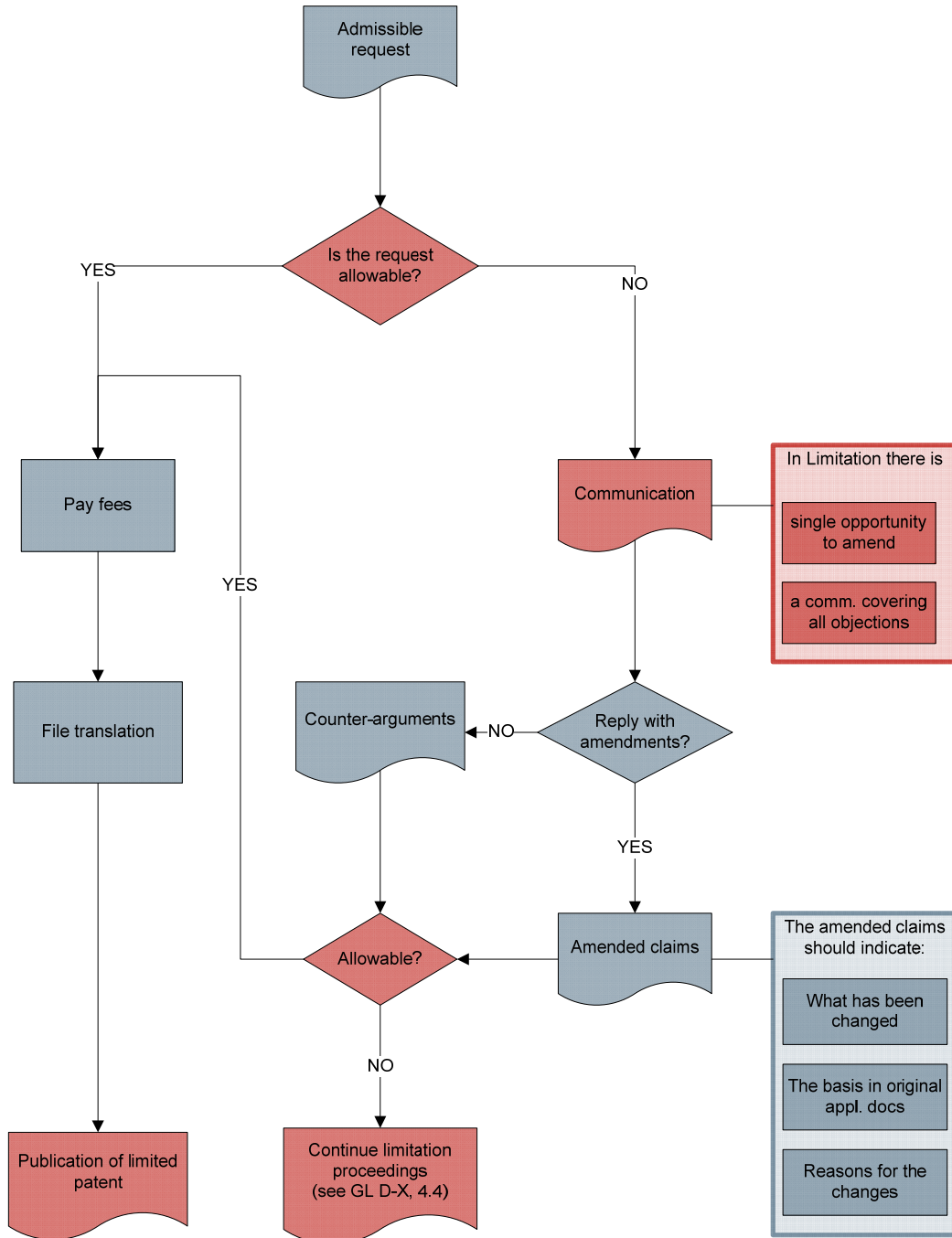
Annex VII
Preparation of oral proceedings in examination



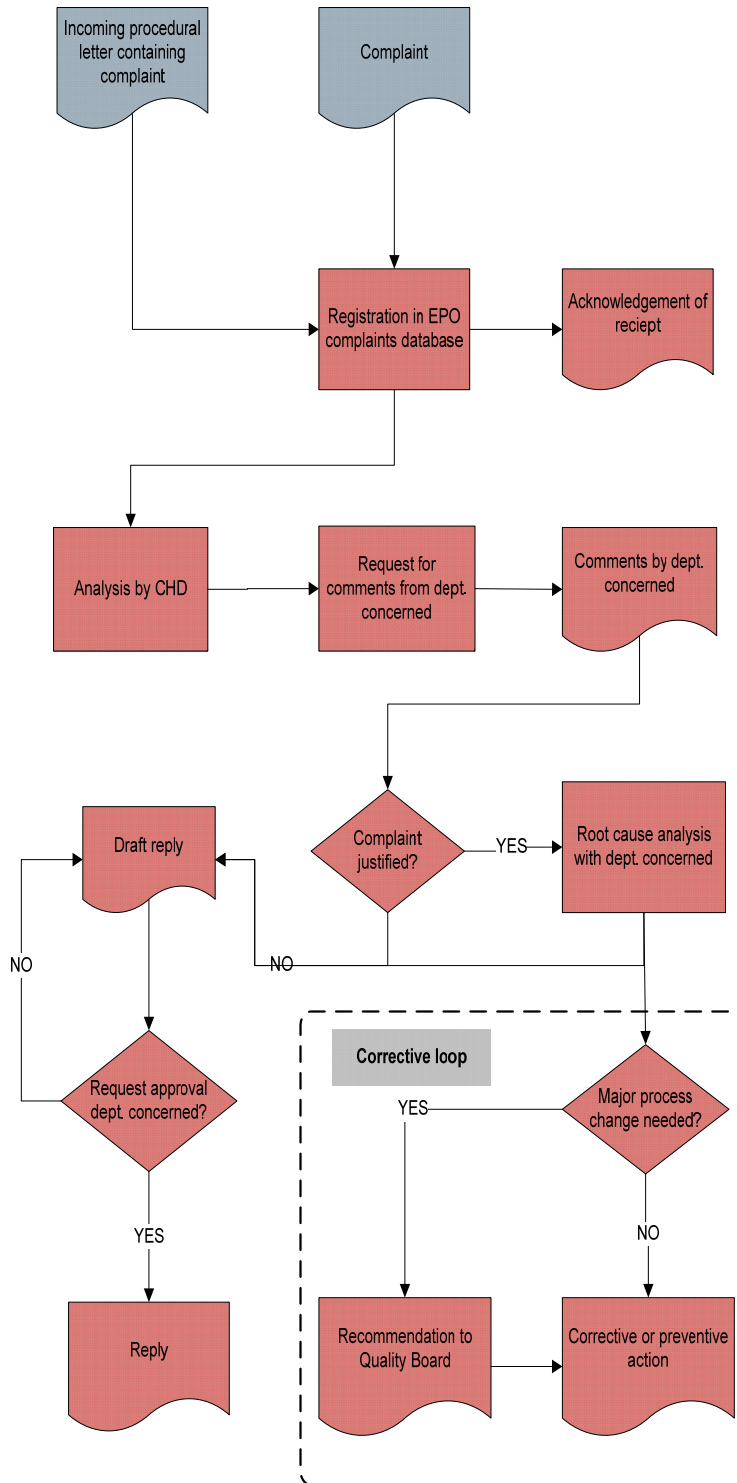
Annex VIII
Third party observations



Annex IX Limitation



Annex X Handling of complaints



*CHD is the Complaints Handling Department

Annex XI

Glossary

ADA - Arrangements for deposit accounts

Art. - Article

DQMS - Directorate Quality Management Support

Druckexemplar - Copy of the specifications destined to the printer

EPC - European Patent Convention

Euro-PCT application - an international application in the regional phase before the EPO

ESOP - European search opinion

GL - Guidelines for Examination in the EPO (edition 2012)

IPER - International preliminary report on patentability

ISA - International Searching Authority

OJ - Official Journal

PACE - Programme for accelerated prosecution of European patent applications

PCT - Patent Cooperation Treaty

SISR - Supplementary international search report

WO-ISA - Written opinion of the ISA

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Principal Directorate Quality Management

– Directorate Practice & Procedure