

Contents

Foreword	VII
Preface	IX
About the author	XI
Detailed Contents	XV
Abbreviations used	XLI

PART A – STRATEGY

Chapter 1: Paper D Part I – Legal Questions	1
Chapter 2: Paper D Part II – Legal Opinion	83
Chapter 3: Pre-examination – Legal Questions	124

PART B – THE EPC

Chapter 4: The EPC and EPO	133
Chapter 5: The Invention	142
Chapter 6: The Application	158
Chapter 7: Filing a European Patent Application	173
Chapter 8: Examination on Filing	182
Chapter 9: The Search Report and Opinion	190
Chapter 10: Publication of the Application and Search Report	195
Chapter 11: Request for Examination, Designation Fee and Extension Fees	197
Chapter 12: Substantive Examination	201
Chapter 13: Allowance and Grant	205
Chapter 14: Opposition Proceedings	210
Chapter 15: Limitation and Revocation Proceedings	225
Chapter 16: Appeal Proceedings	229
Chapter 17: Proceedings before the Enlarged Board of Appeal	242
Chapter 18: The Application and Patent in the Contracting States	246
Chapter 19: Time Limits and Procedural Safeguards	253
Chapter 20: Amendment and Correction	262
Chapter 21: Inventorship, Ownership and Suspension of Proceedings	268
Chapter 22: Representation	272
Chapter 23: Languages	277
Chapter 24: Miscellaneous Common Provisions	281
Chapter 25: Information Made Available by the EPO	302
Chapter 26: Special Agreements under the EPC	306
Chapter 27: Rules Relating to Fees	308

PART C – THE PCT

Chapter 28: Institutional Aspects and Definitions	311
Chapter 29: The Application	314
Chapter 30: Filing an International Patent Application	330
Chapter 31: Procedure of the receiving Office	336
Chapter 32: Drawing up the International Search Report	348
Chapter 33: Supplementary International Searches	358
Chapter 34: Amendment of the Application under Article 19	364
Chapter 35: Publication of the Application and the Search Report	366
Chapter 36: Communications to National and Regional offices	370
Chapter 37: Entry into the National/Regional Phase	372

Chapter 38:	International Preliminary Examination	388
Chapter 39:	National Phase Aspects	408
Chapter 40:	The Calculation of Time Limits and Procedural Safeguards	419
Chapter 41:	Rectification of Mistakes	425
Chapter 42:	Representation	428
Chapter 43:	Miscellaneous Common Provisions	432
Chapter 44:	Information Made Available by the International Authorities and Designated/Elected Offices	438
Index		449

Detailed Contents

Foreword	VII
Preface	IX
About the author	XI
Contents	XIII
Abbreviations used	XLI

PART A – STRATEGY

Chapter 1: Paper D Part I – Legal Questions

1.1	General comments	1
1.2	How to tackle the questions	2
1.2.1	Time management – understanding the question	2
1.2.2	Finding the answer	3
1.2.3	Writing the answer	4
1.3	Calculating time limits	7
1.3.1	Calculating time limits under the EPC	7
1.3.2	Calculating time limits under the PCT	9
1.4	Preserving the rights of an applicant, proprietor or opponent that have apparently been lost under the EPC	10
1.4.1	Was notification sent to the correct address?	10
1.4.2	Can the time limit be extended?	10
1.4.3	Is a grace period available?	11
1.4.4	Can further processing be applied?	11
1.4.5	Can re-establishment be applied?	11
1.4.6	Can proceedings be interrupted?	11
1.4.7	Can the good faith principle be invoked?	12
1.4.8	Can an appeal be filed?	12
1.4.9	Is conversion of a European patent application possible?	12
1.4.10	Can the failure to pay a fee on time be excused?	12
1.4.11	Can the late arrival of a document posted in good time be excused? ..	12
1.4.12	Can a new application be filed?	13
1.5	Preserving the rights of an applicant that have apparently been lost under the PCT	13
1.5.1	Can the time limit be extended?	13
1.5.2	Is a grace period available?	13
1.5.3	Can the late arrival of a document posted in good time be excused? ..	13
1.5.4	Can a loss of rights be excused by a national/regional office?	14
1.5.5	Can the application be re-instated where the national phase is not entered on time?	14
1.6	Enlarged Board Decisions	14
1.7	Miscellaneous points of interest	39
1.7.1	Divisional applications	39
1.7.2	The prior art effects of a published European patent application	44
1.7.3	Renewal fees	49
1.7.4	Incorporation by reference	55
1.7.5	The filing of an application and its filing date	58
1.7.6	Filing of documents – Languages and fee reductions	59
1.7.7	Filing of documents – other considerations	63

1.7.8	The prohibition of reformatio in peius	66
1.8	Transitional provisions EPC1973/EPC2000	69
1.9	Worked examples – Paper D1 2012	73

Chapter 2: Paper D Part II – Legal Opinion

2.1	General comments	85
2.2	How to tackle each question	87
2.2.1	Preparing a time line	87
2.2.2	Analysing the paper by considering the patentability of each invention	88
2.2.3	Points to consider when an application for an invention has been filed	89
2.2.4	Points to consider where an application for an invention has not been filed	91
2.2.5	What national rights are therefore obtainable by the client and might be used to keep competitors off the market?	91
2.2.6	What national rights are therefore obtainable by any competitor which might limit your client's commercial freedom?	92
2.2.7	Answering the paper	92
2.3	Relevant timeline events for European and Euro-PCT applications ...	93
2.3.1	Regular European patent application	93
2.3.2	European patent application filed via the PCT	94
2.4	Aspects of US and Japanese patent law	94
2.5	Notes on claiming priority	96
2.5.1	Relevance of the Paris Convention to European and Euro-PCT applications	96
2.5.2	The importance of naming the correct applicant	96
2.5.3	The importance of the "first filing"	97
2.5.4	The limited circumstances in which priority may be claimed from a second or subsequent filing	97
2.5.5	Illustrative examples of how priority works in relation to the first filing	98
2.5.6	Examples of questions relating to the claiming of priority from a first filing in the EQE	101
2.6	Worked example – Paper D2 2012	102
2.6.1	First reading and initial thoughts	102
2.6.2	Generating a list of dates (Q1–3)	114
2.6.3	Chronological list of dates (Q1–3)	115
2.6.4	Expanded chronological list of dates (Q1–3)	115
2.6.5	Drawing up a timeline (Q1–3)	115
2.6.6	Analysis of patent rights (Q1–3)	117
2.6.7	Possible answer (Q1–3)	120
2.6.8	Possible answer (Q4)	123

Chapter 3: Pre-examination – Legal Questions

3.1	Overview	126
3.2	Worked examples	126

PART B – THE EPC

Chapter 4: The EPC and EPO

4.1	European patents	135
4.2	The European Patent Organisation	135
4.2.1	Foundation of the Organisation	135
4.2.2	Structure of the Organisation	135
4.2.3	Purpose of the Organisation	135
4.3	The European Patent Office and its employees	135
4.3.1	Location of the European Patent Office and its sub-offices	135
4.3.2	President of the European Patent Office and his duties	136
4.3.3	Appointment of senior EPO employees	136

4.3.4	Employees not to disclose or make use of confidential information ...	136
4.3.5	Disputes between the Organisation and the employees of the European Patent Office	137
4.4	The departments of the European Patent Office	137
4.4.1	The departments entrusted with the procedure	137
4.4.2	Administrative structure of the EPO	137
4.5	The Receiving Section	137
4.6	The Search Divisions	137
4.7	The Examining Divisions	138
4.8	The Opposition Divisions	139
4.9	The Legal Division	139
4.10	The Boards of Appeal and the Enlarged Board of Appeal	140
4.10.1	Composition of the Board of Appeal	140
4.10.2	Presidium of the Boards of Appeal	141
4.10.3	Enlarged Board of Appeal	141
4.10.4	Independence and exclusion of Board of Appeal members	141
4.10.5	Adoption of Rules of Procedure by the Boards of Appeal and the Enlarged Board	141
4.10.6	Exclusion and objection	142
4.10.7	Enlargement of a Board of Appeal	142
4.11	The Administrative Council	143

Chapter 5: The Invention

5.1	What is not an invention for the purposes of the EPC?	144
5.1.1	Requirement for technical subject matter	144
5.1.2	Discoveries	144
5.1.3	Scientific theories and mathematical methods	144
5.1.4	Aesthetic creations	145
5.1.5	Scheme, rule or method for performing a mental act	145
5.1.6	Scheme, rule or method for playing games	145
5.1.7	Scheme, rule or method for doing business	145
5.1.8	Computer programs	145
5.1.9	Presentation of information	146
5.2	What inventions are barred from patentability?	146
5.2.1	Morality exemption	146
5.2.2	Plant varieties	147
5.2.3	Animal varieties	147
5.2.4	Essentially biological processes	147
5.2.5	Method of treatment or diagnosis exclusion – general points	149
5.2.6	Method of treatment of the human or animal body by therapy	149
5.2.7	Method of treatment of the human or animal body by surgery	150
5.2.8	Diagnostic method practiced on the human or animal body	150
5.3	What is a patentable invention?	151
5.4	Which inventions are susceptible of industrial application?	151
5.5	Which inventions are new?	152
5.5.1	Definition of novelty	152
5.5.2	The state of the art includes earlier disclosures	152
5.5.3	The state of the art includes the contents of earlier European patent applications	152
5.5.4	Under what circumstances is something “made available to the public”?	153
5.5.5	Judging the content of what has been made available	154
5.5.6	Judging whether the content of what has been made available is prejudicial to novelty	154
5.5.7	First medical use	155
5.5.8	Second medical use	155
5.5.9	Second non-medical use	156
5.5.10	Abusive disclosure exemption	156
5.5.11	Exhibition exemption	157

5.5.12	Novelty of selection inventions	158
5.6	Which inventions involve an inventive step?	158
5.6.1	Definition of inventive step	158
5.6.2	Problem-solution approach	158
5.6.3	The skilled person and common general knowledge	159
5.6.4	Considerations when asking whether the invention is obvious	159
5.6.5	Inventive step based on an unexpected advantage	159
5.6.6	Further indicators of inventive step	160

Chapter 6: The Application

6.1	Elements of the application	161
6.2	General and physical requirements of the application	161
6.2.1	Prohibited matter	161
6.2.2	Physical requirements	161
6.3	Requirements relating to the request	161
6.3.1	Use of a specified form	161
6.3.2	Drawings not allowed	161
6.3.3	Petition for grant (Box 5)	161
6.3.4	Waiver of communication under r.70(2) (Box 5.1)	161
6.3.5	Details of the applicant (Boxes 7–14)	161
6.3.6	Details of any representative (Boxes 15–19)	162
6.3.7	Designation of the inventor (Boxes 22–23)	162
6.3.8	Title of the invention (Box 24)	162
6.3.9	Priority claim (Box 25)	162
6.3.10	Indication of divisional status (Box 27)	162
6.3.11	Indication that application is a replacement application (Box 28)	162
6.3.12	Figure of the drawings to be published with the abstract (Box 30)	162
6.3.13	List of documents accompanying the request (Box 44)	163
6.3.14	Signature (Box 46)	163
6.3.15	Correction of the request	163
6.4	Requirements relating to the description	163
6.4.1	Need for a sufficient disclosure	163
6.4.2	Content of the description	164
6.4.3	Order of presentation of the content of the description	164
6.4.4	Description not to contain drawings	164
6.5	Requirements relating to the claims	164
6.5.1	Requirement for clarity, conciseness and support	164
6.5.2	Claims to define matter the applicant seeks to protect	165
6.5.3	Situations in which two-part form is required	165
6.5.4	Number and type of claims allowed	165
6.5.5	Numbering of the claims	165
6.5.6	Omnibus claims generally not allowed	165
6.5.7	References in claims to reference signs in figures	166
6.5.8	Unity of invention	166
6.5.9	Allowability of disclaimers	166
6.5.10	Functional features	166
6.5.11	Claims not to contain drawings	166
6.6	Requirements relating to the abstract	166
6.7	Requirements relating to the drawings	167
6.8	Requirements relating to any priority claim	167
6.8.1	Relevance of the Paris Convention	167
6.8.2	Who may make a claim to priority?	167
6.8.3	Length of priority period	168
6.8.4	Priority claim to be in respect of the same invention	168
6.8.5	What kind of application may be used as a basis for claiming priority?	168
6.8.6	Procedure for claiming priority – declaration	169
6.8.7	Procedure for claiming priority – certified copy	170
6.8.8	Procedure for claiming priority – translation	171
6.8.9	Can one application claim more than one priority?	171

6.8.10	Can one priority be claimed in more than one application?	172
6.8.11	Effect of priority right	172
6.8.12	Obligation to file copies of search results when claiming priority	172
6.9	Requirements relating to the designation of the inventor	172
6.10	Language requirements of the application	172
6.10.1	Acceptable languages of filing	172
6.10.2	Requirement for a translation	173
6.10.3	Languages of filing under EPC1973	173
6.10.4	Languages accepted if filing at a national office	173
6.10.5	Language of a divisional application or a replacement application	173
6.11	Requirements relating to biotechnological inventions	174
6.11.1	Sequence listings	174
6.11.2	Deposit of biological material	174
6.12	Special requirements for divisional applications	174

Chapter 7: Filing a European Patent Application

7.1	Who is entitled to file a European patent application?	176
7.2	Where may a European patent application be filed?	176
7.2.1	Where to file a regular European patent application	176
7.2.2	Where to file a divisional application	176
7.2.3	Where to file a replacement application under Art. 61(1)(b)	176
7.2.4	Restrictions on the filing of European patent applications under national law	177
7.2.5	Procedure where the application is filed with a national office – time limit for forwarding to the EPO	177
7.3	Manner of filing the application	177
7.3.1	Filing in writing by post or by hand	177
7.3.2	Filing by fax	177
7.3.3	Filing electronically	178
7.3.4	Filing by other means	178
7.4	Filing a Divisional application	178
7.4.1	Up to what point in time can a divisional application be filed?	178
7.4.2	A divisional application may be filed in respect of any pending earlier European patent application	178
7.4.3	On what kind of application can a divisional be based?	179
7.4.4	Who is entitled to file a divisional application?	179
7.5	Filing a replacement application	180
7.6	Requirement to pay a filing fee, a search fee and claims fees	180
7.6.1	Filing fee	180
7.6.2	Reduction of the filing fee if using an official language of a contracting state	180
7.6.3	Search fee	181
7.6.4	Claims fees	181
7.6.5	Fees for divisional applications	182
7.6.6	Fees for replacement applications	182
7.7	Designation of Contracting States	182
7.8	Extension of a European patent	183
7.9	Validation of a European patent	184
7.10	Requirement to file copies of search results relating to a priority application	184

Chapter 8: Examination on Filing

8.1	Procedure on receipt of a new application	185
8.2	Examination as to whether a filing date can be accorded	185
8.2.1	Requirements for a filing date	185
8.2.2	Need for a certified copy of the previous application if filing by reference	185
8.2.3	Need for a translation of the previous application if filing by reference	186
8.2.4	Procedure where a filing date cannot be accorded	186

8.2.5	Filing date in the case of a divisional application or replacement application.....	187
8.3	Filing date where pages of the description and drawings are subsequently filed	187
8.4	Procedure where a filing date can be accorded – examination of formal requirements	188
8.4.1	Determination as to whether any necessary translation has been filed ..	188
8.4.2	Request, description, claims, drawings and abstract	189
8.4.3	Designation of the inventor	189
8.4.4	Priority claim	190
8.4.5	Representation and authorisation	190
8.4.6	Filing and search fees	191
8.4.7	Claims fees	191
8.4.8	Sequence listings	191
8.4.9	Other matters.....	192

Chapter 9: The Search Report and Opinion

9.1	The EPO must draw up a search report for each European patent application.....	193
9.2	Procedure where a plurality of independent claims exist	193
9.3	Procedure where a meaningful search is not possible	193
9.4	Procedure where the application lacks unity	194
9.5	Establishing of the definitive content of the abstract	194
9.6	Patent classification used by the EPO	194
9.7	Accelerated search	194
9.8	The European Search Report.....	195
9.8.1	Content of the search report	195
9.8.2	Language of the search report	195
9.8.3	Additional copies of citations	195
9.9	The extended European Search Report	195
9.10	Transmittal of the search report, search opinion and definitive content of the abstract	196
9.11	Requirement to file a response to the extended European search report	196
9.12	One chance for submission of voluntary amendments in response to extended European search report	196

Chapter 10: Publication of the Application and Search Report

10.1	Timing of publication	198
10.2	No publication to take place when the application is withdrawn or refused	198
10.3	Language and form of the publication	198
10.4	Contents of the publication	198
10.5	Matter excluded from the publication	199

Chapter 11: Request for Examination, Designation Fee, Extension Fees and Validation Fee

11.1	Communication to the applicant of the date on which the Bulletin mentions the publication of the search report.....	200
11.2	Payment of the designation fee	200
11.2.1	Designation fee for a regular European patent application	200
11.2.2	Designation fee for a divisional application	200
11.2.3	Designation fee for a replacement application	200
11.3	Payment of extension fees.....	201
11.4	Payment of validation fees	201
11.5	Request for examination	201
11.5.1	Examination must be requested	201
11.5.2	Time limit for requesting examination	202
11.5.3	Payment of an examination fee	202

11.5.4	Consequences of not requesting examination	202
11.5.5	Refund of the examination fee	202
11.5.6	Language of the request for examination – fee reduction	202
11.6	A request for examination filed before transmittal of the search report must usually be confirmed.....	203
11.7	Assumption of responsibility by the Examining Division	203

Chapter 12: Substantive Examination

12.1	Formal written procedure	205
12.2	Informal communications by telephone, interview or e-mail	205
12.3	Procedure of the Examining Division in the case of an incomplete search	206
12.4	Further searches	206
12.5	Auxiliary requests.....	207
12.6	Double patenting	207
12.7	Accelerated procedure	207
12.8	Request for information concerning prior art	207
12.9	Refusal of the application	208

Chapter 13: Allowance and Grant

13.1	Circumstances in which a patent is granted	209
13.2	Approval of the text for grant, payment of fees and the filing of claim translations	209
13.2.1	Communication from the Examining Division under r.71(3)	209
13.2.2	Consequences of not responding fully to the r.71(3) communication ..	210
13.2.3	Implicit approval of the text by payment of fees and filing of translations	210
13.2.4	Procedure where the proposed text is not acceptable to the applicant..	210
13.2.5	Refund of grant and publishing fee	211
13.3	Between approval of the text and a decision to grant	211
13.4	Decision to grant.....	211
13.5	The decision to grant takes effect on publication of the mention of grant in the Bulletin	212
13.6	No publication of the mention of grant until designation or renewal fees have been paid	212
13.7	Publication of the specification of the granted patent	212
13.8	Grant to different applicants	213
13.9	Issue of a certificate	213
13.10	Validation in contracting States	213
13.11	Registration of the granted patent	213
13.12	Validation in non-contracting States	213

Chapter 14: Opposition Proceedings

14.1	General considerations	214
14.2	Filing an opposition	214
14.2.1	Time limit for filing a notice of opposition.....	214
14.2.2	Where and how should the opposition be filed?.....	214
14.2.3	Who may file a notice of opposition?	215
14.2.4	Form and content of the notice of opposition.....	216
14.2.5	Grounds for opposition	216
14.2.6	Payment of the opposition fee	217
14.2.7	Language of the notice of opposition – fee reduction.....	217
14.2.8	Opposition may be filed even where a patent is surrendered or has lapsed	217
14.3	Examination of the opposition for admissibility and circumstances in which it is deemed not filed	217
14.3.1	An opposition must be admissible to be examined	217
14.3.2	A formalities officer can decide on admissibility in certain circumstances	218

14.3.3	Deficiencies that must be corrected before the opposition period expires	218
14.3.4	Deficiencies that may be corrected after the opposition period expires	218
14.3.5	Circumstances in which the opposition is deemed not to have been filed	218
14.3.6	Decision that opposition is inadmissible or deemed not filed is to be communicated to the proprietor	219
14.4	Intervening in an opposition	219
14.5	Opposition to apply to all designated States	220
14.6	Parties to the opposition and transfer of party status	220
14.6.1	Proprietor and opponents are parties	220
14.6.2	Replacement of party status as a result of entitlement proceedings	220
14.6.3	Transfer of the patent to a new proprietor during opposition proceedings	220
14.6.4	Transfer of the opposition during opposition proceedings	221
14.7	Procedure for examination of the opposition	221
14.7.1	Steps taken prior to examination of the opposition	221
14.7.2	Examination as to whether the grounds of opposition prejudice the patent	222
14.7.3	Permissible amendments of the patent during opposition	222
14.7.4	Requirements relating to documents filed during opposition proceedings	223
14.7.5	Continuation of the opposition by the EPO of its own motion in the event of the withdrawal of an opposition or the death of an opponent	223
14.7.6	Continuation of the opposition where the patent has been surrendered or has lapsed	223
14.7.7	Extent to which the Opposition Division may examine the patent beyond the stated extent of and grounds for the opposition	223
14.7.8	Acceleration of proceedings	224
14.7.9	Further searches	224
14.7.10	Stay in the case of entitlement proceedings	224
14.7.11	Different claims for different States when two proprietors are defending the patent	225
14.7.12	Revocation where no text is approved or patent is surrendered	225
14.7.13	Requirement to submit cited documents	225
14.8	Procedure if the opposition succeeds	225
14.9	Procedure if the opposition fails	225
14.10	Procedure if the opposition is partly successful	225
14.10.1	Notification of text which the Opposition Division proposes to maintain	225
14.10.2	Need for payment of printing fee/filing of claim translations	226
14.10.3	Publication of a new specification where the patent is amended – new patent certificate	226
14.11	Costs	227
14.11.1	Rules for the apportionment of costs	227
14.11.2	Opposition Division to fix amount of costs to be paid	227
14.11.3	Enforcement of decisions on costs in Contracting States	227
14.11.4	Restrictions on appealing an award of costs	227
14.11.5	Costs in opposition appeal proceedings	228

Chapter 15: Limitation and Revocation Proceedings

15.1	The right to limit a European patent or have it revoked	229
15.2	Where and how should a request for limitation or revocation be filed?	229
15.3	What language may a request for limitation or revocation be filed in? ..	230
15.4	What fees are due in respect of a request for limitation or revocation? ..	230
15.5	Content and form of the request for limitation or revocation	230
15.6	Opposition proceedings take precedence	230
15.7	Circumstances in which the request is deemed not to have been filed ..	231
15.8	Circumstances in which the request is rejected as inadmissible	231

15.9	Decision on a request for revocation.....	231
15.10	Decision on a request for limitation	231
15.11	Publication of an amended specification if the patent is limited.....	232

Chapter 16: Appeal Proceedings

16.1	The nature of appeal proceedings	233
16.2	Decisions which may be appealed	233
16.3	Suspensive effect of an appeal on the decision appealed	234
16.4	Who may appeal and who is a party to the appeal?.....	234
16.5	Notice of appeal	235
16.5.1	Time limit for filing a notice of appeal	235
16.5.2	Where and how may a notice of appeal be filed?	235
16.5.3	Who may file the notice of appeal?	235
16.5.4	Content and form of the notice of appeal	235
16.5.5	Appeal fee	236
16.5.6	Language of the notice of appeal – fee reduction	237
16.6	Grounds of appeal	237
16.6.1	Time limit.....	237
16.6.2	Where and how may grounds of appeal be filed?.....	237
16.6.3	Who may file the notice of appeal?	238
16.6.4	Content of the grounds of appeal	238
16.7	Examination of the appeal for admissibility	238
16.8	Interlocutory revision	239
16.9	Examination of the appeal	240
16.9.1	General procedure to be used	240
16.9.2	Extent to which the Appeal Board in opposition proceedings may introduce new grounds or examine new claims	240
16.9.3	Extent to which the Appeal Board in examination proceedings may introduce new grounds or examine new claims	242
16.9.4	Reformatio in peius	242
16.9.5	Intervention of an assumed infringer is possible in appeal proceedings	243
16.9.6	Discretion to hear accompanying persons	243
16.9.7	Amendment during appeal proceedings.....	243
16.9.8	Accelerated procedure	243
16.9.9	Consolidation of proceedings	243
16.9.10	EPO President’s right to comment	244
16.10	Decision on the appeal	244
16.10.1	Taking a decision – discretion of the Board to remit proceedings to the first instance.....	244
16.10.2	The binding effect of a decision on remittal	244
16.10.3	Form and content of the decision	244
16.11	Withdrawal of the appeal.....	245

Chapter 17: Proceedings before the Enlarged Board of Appeal

17.1	Interpretation of the law by the Enlarged Board of Appeal.....	246
17.2	Petition for review by the Enlarged Board of Appeal	246
17.2.1	Petition for review	246
17.2.2	Grounds on which a petition may be filed	246
17.2.3	Obligation to raise objections	247
17.2.4	A petition does not have suspensive effect	247
17.2.5	Filing a petition for review	247
17.2.6	Communication to the parties	248
17.2.7	Examination of the petition for review	248
17.2.8	Third-party rights.....	249
17.3	Procedure before the Enlarged Board of Appeal	249

Chapter 18: The Application and Patent in the Contracting States

18.1	The effect of a European patent application having a filing date	250
18.2	The effect of a published European patent application	250

18.3	The effect of a granted European patent	250
18.4	Effect of a granted European patent may be dependent on the filing of a translation	250
18.5	The London Agreement	251
18.6	Effect of revocation during opposition on rights pre- and post-grant ..	252
18.7	Extent of protection of a European application or patent	252
18.8	The term of a European patent	253
18.9	Conversion of a European patent application into a national patent application	253
18.9.1	Circumstances in which conversion is possible	253
18.9.2	Time limit for requesting conversion	253
18.9.3	Submission and transmission of the request	253
18.9.4	Formal requirements for conversion	254
18.9.5	Information available to the public in the event of conversion	254
18.10	Revocation of a European patent in Contracting States	254
18.10.1	Grounds for revocation	254
18.10.2	Partial revocation – right to amend	254
18.11	Collision of European and national patents and patent applications ...	255
18.12	National renewal fees for European patents	255
18.13	Provisions which apply to national utility models and utility certificates	255
18.14	Authentic text in national proceedings	255
18.15	Request by a national court for a technical opinion from an Examining Division	255

Chapter 19: Time Limits and Procedural Safeguards

19.1	Time limits	257
19.1.1	What is a “time limit”?	257
19.1.2	Computation of time limits	257
19.1.3	Units of time used	257
19.1.4	Day on which computation of time limit is to start	257
19.1.5	Expiry of time limits – years, months and weeks	257
19.1.6	Duration of time limits that are to be determined by the EPO	258
19.1.7	Extension of time limits determined by the EPO	258
19.2	Circumstances in which a missed time limit is excused where a document is sent in good time	258
19.3	Extension of time limits where the EPO or a national office is not open for business	259
19.4	Extension of time limits where there is a general interruption in mail delivery in a Contracting State	259
19.5	Extension of time limits where there is a war, revolution or similar event affecting the applicant or his representative	260
19.6	Further processing	260
19.7	Re-establishment of rights	261
19.7.1	Conditions necessary for re-establishment	261
19.7.2	Which parties to EPO proceedings can use re-establishment?	262
19.7.3	Grant or refusal – the effect of an allowable request	262
19.7.4	Exclusion of certain time limits from re-establishment	262
19.7.5	Procedure for applying for re-establishment – time limits	262
19.7.6	Grounds must be filed and fee paid	263
19.7.7	Department qualified to decide on the application for re-establishment	263
19.7.8	Third-party rights may be awarded	263
19.7.9	Contracting States may grant re-establishment for the EPC time limits that they have to administer	263
19.8	Interruption of proceedings	264
19.8.1	Circumstances under which proceedings may be interrupted	264
19.8.2	Resumption of the proceedings	264
19.8.3	Time limits on resumption	264

19.8.4	Department responsible for questions concerning interruption	265
19.9	Principle of good faith – protection of legitimate expectations	265
Chapter 20: Amendment and Correction		
20.1	Circumstances in which amendment is allowed	266
20.1.1	Amendment before receipt of the search report (direct filed European application)	266
20.1.2	Single chance for voluntary amendment (direct filed European application)	266
20.1.3	Further amendments require the consent of the Examining Division ..	266
20.1.4	Amendment during appeal	266
20.2	Requirement to identify amendments and the basis for them	266
20.3	Language and form of amendments	267
20.4	Amendment must not add subject matter	267
20.5	Circumstances in which amended claims may not to relate to unsearched subject matter	268
20.6	Amendment must not extend the protection conferred by a patent	268
20.7	Restrictions on amendment during opposition proceedings	269
20.8	Correction of errors in documents	269
20.8.1	What corrections are allowable?	269
20.8.2	Corrections to the description, claims and drawings are governed by Art. 123(2) EPC	270
20.8.3	Examples of allowable and non-allowable corrections	270
20.8.4	Correction is only possible where proceedings are pending	270
20.8.5	Competent body to decide on correction	271
20.9	Correction of errors in decisions	271
Chapter 21: Inventorship, Ownership and Suspension of Proceedings		
21.1	Right of the inventor to be mentioned	272
21.1.1	Right of the inventor to be mentioned	272
21.1.2	Designation of the inventor	272
21.1.3	Rectification of the designation of the inventor	272
21.1.4	Publication of mention of the inventor	272
21.2	Right to a European patent	272
21.3	Procedure where the applicant does not have the right to a European patent	272
21.3.1	Jurisdiction of the Contracting States	272
21.3.2	Stay of proceedings during examination	273
21.3.3	Calculation of time limits when proceedings are resumed	274
21.3.4	No withdrawal during stay of proceedings	274
21.3.5	Remedies following a final decision	274
21.3.6	Partial transfer of right by virtue of a final decision	275
21.3.7	EPO division responsible	275
21.3.8	Stay in opposition proceedings	275
Chapter 22: Representation		
22.1	Kinds of representation available	276
22.1.1	Choice of representation for a person having a residence or principal place of business within a Contracting State	276
22.1.2	Choice of representation for a person not having a residence or principal place of business within a Contracting State	276
22.1.3	Common representative for parties acting in common	276
22.2	Professional representation	277
22.2.1	Those who can act as a professional representative – right to set up in business	277
22.2.2	Right of a person acting as a professional representative to set up in business	277
22.2.3	Procedure for being entered on the list of professional representatives ..	277
22.2.4	The European Qualifying Exam	278

22.2.5	Institute of Professional Representatives before the EPO	278
22.2.6	Circumstances in which a representative may be deleted from the list	278
22.2.7	Re-entry on the list following deletion	279
22.2.8	Attorney-client evidentiary privilege	279
22.3	Authorisation	279
22.3.1	Requirement to file an authorisation	279
22.3.2	Form and content of an authorisation	280
22.3.3	Consequences of not filing an authorisation when requested	280
22.3.4	Withdrawal/termination of an authorisation	280
22.3.5	Where several representatives are appointed	280
22.3.6	The authorisation of an association	280

Chapter 23: Languages

23.1	Languages of the EPC—authentic text	282
23.2	Official languages of the EPO	282
23.3	Language in which an application can be filed	282
23.4	Language of filing determines the language of proceedings and the authentic text	282
23.5	Language of the proceedings to be used in all proceedings except where exceptions are provided for	282
23.6	Language to be used in written procedures – exceptions to the use of the language of the proceedings	282
23.7	Consequence of not using an admissible language or not filing a required translation in written proceedings	283
23.8	Language to be used in oral proceedings – exceptions to the use of the language of the proceedings	284
23.9	Certification of translated documents	284
23.10	Language of publication of applications, patents, the Bulletin, the Official Journal and entries in the Register	284
23.11	Languages of the Administrative Council	285

Chapter 24: Miscellaneous Common Provisions

24.1	Principles of interpretation relevant to the EPC	286
24.2	Rules relating to documents filed subsequently to the filing of the application	286
24.2.1	Where and how to file subsequent documents	286
24.2.2	Rules relating to content and form	287
24.2.3	Need for a signature	287
24.3	Withdrawal of applications, patents, designations, extensions, priority claims, oppositions, requests for limitation/revocation and appeals ...	287
24.3.1	Withdrawal of an application	287
24.3.2	Withdrawal of part of the subject matter of an application	288
24.3.3	Withdrawal of a designation	288
24.3.4	Withdrawal of a request for extension	288
24.3.5	Withdrawal of a priority claim	288
24.3.6	Withdrawal of an opposition	288
24.3.7	Withdrawal of an appeal	288
24.3.8	Withdrawal of a patent	288
24.3.9	Withdrawal of a request for limitation/revocation	288
24.4	Renewal fees	288
24.4.1	Requirement to pay renewal fees	288
24.4.2	Consequences of non-payment – grace period	289
24.4.3	Provisions in respect of divisional applications	289
24.4.4	Provisions in respect of applications which have been refused or deemed withdrawn	289
24.4.5	Renewal fees when the Enlarged Board of Appeal reopens proceedings before the Board of Appeal	290
24.4.6	Provisions in respect of replacement applications	290
24.4.7	Refund of a renewal fee	290

24.5	Assignment, licensing and other property transactions	290
24.5.1	Transfer and constitution of rights	290
24.5.2	Assignment	290
24.5.3	Contractual licensing	290
24.5.4	Law applicable	290
24.5.5	Registration of a transfer of an application or a patent	291
24.5.6	Registration of the grant or transfer of a licence and other transactions relating to a patent application	291
24.5.7	EPO department responsible	291
24.6	Observations by third parties	291
24.7	Notification by the EPO	292
24.7.1	Subject matter of notifications	292
24.7.2	Form of notification	292
24.7.3	Person to whom notification is made	292
24.7.4	Notification by post – deemed notification on the tenth day following posting	293
24.7.5	Notification by delivery by hand	293
24.7.6	Notification by public notice	293
24.7.7	Notification by technical means of communication	294
24.7.8	Notification through the central industrial property office of a Contracting State	294
24.7.9	Irregularities in notifications	294
24.7.10	Notification of loss of rights	294
24.7.11	Communications and notices to be signed and identify author	294
24.8	Decisions	295
24.8.1	Decisions only to be based on grounds/evidence on which the parties have had an opportunity to comment	295
24.8.2	Applicant or proprietor to submit or agree text decided on – auxiliary requests	295
24.8.3	Form of decisions	296
24.8.4	The finality of a decision	296
24.8.5	Obtaining a decision after the EPO has notified a loss of rights	296
24.8.6	Decisions to be signed and identify author	297
24.8.7	Notification of decisions	297
24.8.8	Correction of errors in decisions	297
24.8.9	Interlocutory decisions	297
24.9	Examination by the EPO of its own motion	297
24.10	Facts and evidence submitted late may be ignored	297
24.11	Oral proceedings	298
24.11.1	Extent of the right to oral proceedings	298
24.11.2	Summons to oral proceedings	298
24.11.3	Consequence of summoned party not turning up	299
24.11.4	Preparation for oral proceedings by the parties	299
24.11.5	Extent to which oral proceedings are open to the public	299
24.11.6	Procedure in oral proceedings	300
24.11.7	Minutes of oral proceedings	301
24.11.8	Fresh oral proceedings if the composition of a Board of Appeal changes	301
24.12	Taking of evidence	301
24.12.1	Forms of evidence available to the EPO	301
24.12.2	Principles to be applied when evaluating evidence	302
24.12.3	Decision to take evidence	302
24.12.4	Summons to give evidence before the EPO	302
24.12.5	Hearing of evidence before a competent court	303
24.12.6	Examination of evidence before the EPO	303
24.12.7	The opinion of experts	303
24.12.8	Costs of taking evidence	303
24.12.9	Conservation of evidence	303
24.12.10	Minutes of taking of evidence/inspection	304

24.13	Authentic text of a European patent or application	304
24.14	Unity of a European patent application or European Patent	305
24.15	Request for information concerning prior art	305
24.16	Reference to the procedural law of the Contracting States	306

Chapter 25: Information Made Available by the EPO

25.1	The Register of European patents	307
25.1.1	Content of the register	307
25.1.2	No entry in the register prior to publication of the application	308
25.1.3	Register to be open to the public	308
25.1.4	Language of the register	308
25.2	Inspection of files relating to applications	308
25.2.1	No inspection of files relating to unpublished application except where rights have been invoked	308
25.2.2	Inspection of files after publication of the application	308
25.2.3	Procedure for the inspection of files and communication of information in the files	309
25.2.4	Maintenance of the files	309
25.3	The Official Journal	310
25.4	The Bulletin	310
25.5	Exchanges of information between the EPO and national authorities/courts	310

Chapter 26: Special Agreements under the EPC

26.1	Unitary patents	311
26.1.1	Grant of a unitary patent by the EPO	311
26.1.2	Special department of the EPO	311
26.1.3	Representation before special departments	311
26.1.4	Select Committee of the Administrative Council	311
26.1.5	Cover for expenditure for carrying out special tasks	311
26.1.6	Payments in respect of renewal fees for unitary patents	311
26.1.7	The European patent application as an object of property	311
26.1.8	Joint designation	312
26.2	Other agreements between the Contracting States	312

Chapter 27: Rules Relating to Fees

27.1	The Administrative Council adopts the rules relating to fees	313
27.2	Purpose of the rules relating to fees	313
27.3	Fees, costs and prices laid down by the President	313
27.4	Amounts of fees to be published	313
27.5	Due date for fees where not specified	313
27.6	Currency to be used	313
27.7	Payment or transfer to an EPO bank account	313
27.8	Payment by other methods – deposit accounts	313
27.9	Safeguard in cases where payment is deemed not to have been made in time	314
27.10	The EPO must be able to establish what a payment is for	315
27.11	Who may make payments? To whom will refunds be paid?	315
27.12	Procedure where the amount paid is insufficient	315
27.13	Refund of insignificant amounts	315
27.14	Refund in other cases	315

PART C – THE PCT

Chapter 28: Institutional Aspects and Definitions

28.1	Establishment of a Union	317
28.2	Parts of the Union	317
28.2.1	The Assembly	317
28.2.2	The International Bureau	317

28.3	Regulations and Administrative Instructions	317
28.3.1	Regulations under the PCT	317
28.3.2	Administrative Instructions	317
28.4	The Gazette	317
28.5	Definitions/Interpretations	318

Chapter 29: The Application

29.1	Elements of the application	320
29.2	General and physical requirements of the application	320
29.2.1	Prohibited matter	320
29.2.2	Number of copies to be filed	320
29.2.3	Terminology and signs	320
29.2.4	Physical requirements	320
29.3	Requirements relating to the request	320
29.3.1	Use of a specified form	320
29.3.2	Petition	321
29.3.3	Title	321
29.3.4	Details of the applicant	321
29.3.5	Details of the inventor	321
29.3.6	Details of any agent	321
29.3.7	Details of any common representative	322
29.3.8	Requirements for providing names and addresses	322
29.3.9	Address for correspondence	322
29.3.10	Designation of Contracting States	322
29.3.11	Designation of the EPO	323
29.3.12	Kind of protection sought	323
29.3.13	Priority claim	323
29.3.14	Restoration of the right of priority	324
29.3.15	Transmittal of certified copy	324
29.3.16	Statement of incorporation by reference	324
29.3.17	Choice of international searching authority	324
29.3.18	Use of the results of earlier search, reference to that search	324
29.3.19	Standardised declarations	325
29.3.20	Check list	325
29.3.21	Signature of the applicant	326
29.3.22	Reference to a parent application or patent	326
29.3.23	No further content of the request is allowed	326
29.4	Requirements Relating to the Description	326
29.4.1	Need for a sufficient disclosure	326
29.4.2	Content of the description	326
29.4.3	Order of presentation of the content of the description	327
29.5	Requirements relating to the claims	327
29.5.1	Requirement for clarity, conciseness and support	327
29.5.2	Claims to define matter the applicant seeks to protect	327
29.5.3	Situations in which two-part form is required	327
29.5.4	Number and type of claims allowed	327
29.5.5	Numbering of the claims	328
29.5.6	Omnibus claims generally not allowed	328
29.5.7	References in claims to reference signs in figures	328
29.5.8	Manner of claiming in respect of an application for a utility model ...	328
29.5.9	Unity of invention	328
29.6	Requirements relating to the abstract	329
29.7	Requirements relating to the drawings	329
29.8	Requirements relating to any priority claim	329
29.8.1	Relevance of the Paris Convention	329
29.8.2	Who may make a claim to priority?	330
29.8.3	Length of the priority period	330
29.8.4	Restoration of a right to priority by the receiving Office where the time limit is missed	330

29.8.5	The whole content of the previous application can support a priority right	331
29.8.6	What kind of application may be used as a basis for claiming priority?	331
29.8.7	Priority claims originating in World Trade Organisation countries do not apply in respect of the EPO if the priority-claiming application was filed before the coming into force of EPC2000	331
29.8.8	Procedure for claiming priority – declaration	332
29.8.9	Procedure for claiming priority – certified copy	332
29.8.10	Procedure for claiming priority – translation	333
29.8.11	Can one application claim more than one priority?	333
29.8.12	Effect of the claim to priority in the international phase	333
29.8.13	Effect of designating a State in which the priority application was filed	333
29.9	Language requirements of the application	333
29.9.1	Acceptable languages of filing	333
29.9.2	Languages the receiving Office must accept	334
29.9.3	Circumstances in which the applicant must provide a translation for international search	334
29.9.4	Circumstances in which the applicant must provide a translation for international publication	334
29.9.5	Procedure where the request is not in a language of publication	335
29.9.6	Procedure where language of filing is not accepted by the receiving Office	335
29.10	Requirements relating to biotechnological inventions	335
29.10.1	Sequence listings	335
29.10.2	Deposit of biological material	335

Chapter 30: Filing an International Patent Application

30.1	Who is entitled to file an international patent application?	336
30.2	Where may an international patent application be filed?	336
30.3	Procedure when the application is filed in the wrong place	337
30.4	The receiving Office can apply national law relating to representation	337
30.5	Those entitled to use the EPO as a receiving Office	337
30.6	Filing an international application with the EPO	337
30.7	Manner of filing the application	338
30.7.1	The use of paper	338
30.7.2	The use of telegraph, teleprinter, or facsimile	338
30.7.3	Filing in electronic form	339
30.8	Payment of Fees	339
30.8.1	Transmittal fee	339
30.8.2	Transmittal fee where the EPO is the receiving Office	339
30.8.3	International filing fee	339
30.8.4	Search fee	340
30.8.5	Late payment of fees	340
30.8.6	Consequences of not paying fees	341

Chapter 31: Procedure of the receiving Office

31.1	Examination as to whether a filing date can be accorded	342
31.1.1	Incorporation of the description and claims by reference – reservations	342
31.1.2	Requirements for a filing date	343
31.1.3	Procedure where a filing date can be accorded	343
31.1.4	Procedure where a filing date cannot be accorded	344
31.1.5	Procedure where parts of the application are missing	345
31.1.6	Review of the decision to award a filing date	346
31.1.7	Supply to the applicant of certified copies of the application as filed ..	347
31.2	Copying and transmittal of the international application by the receiving Office	347
31.2.1	National security provisions	347

31.2.2	Number of copies of the application required – responsibility for their provision	347
31.2.3	Retention of the home copy by the receiving Office	347
31.2.4	Transmittal by the receiving Office of the record copy to the International Bureau	347
31.2.5	An international application is considered withdrawn if the International Bureau does not receive the record copy in time	348
31.2.6	Procedure where the International Bureau receives the record copy in time – notification of receipt	348
31.2.7	Transmittal by the receiving Office of a translation of the international application to the International Bureau	349
31.2.8	Transmittal by the receiving Office of the search copy and any sequence listing in electronic form to the International Searching Authority	349
31.2.9	Procedure of the International Searching Authority on receipt of the search copy	349
31.3	Examination of formal requirements under Art. 14(1)(a)	349
31.3.1	Was the application signed properly?	349
31.3.2	Are the correct indications concerning the applicant present?	349
31.3.3	Does the application contain a title?	349
31.3.4	Does the application contain an abstract?	350
31.3.5	Are certain of the physical requirements met?	350
31.3.6	Invitation to correct defects where formal requirements of Art. 14(1)(a) are not met	350
31.3.7	Format of any correction offered to the receiving Office	351
31.4	Examination of other formal requirements	351
31.4.1	Are the abstract, request and text matter of the drawings in the correct language?	351
31.4.2	Has any priority claim been made correctly?	351
31.4.3	Is any declaration under r.4.17 correctly made?	352
31.4.4	Requirements relating to the submission of a translation	352
31.4.5	The role of the International Bureau and International Searching Authority in identifying defects	353
31.4.6	Procedure when the receiving Office declares that the application is considered withdrawn	353

Chapter 32: Drawing up the International Search Report

32.1	Authorities competent to carry out international search	354
32.1.1	What is an International Searching Authority?	354
32.1.2	Requirements that must be met by an International Searching Authority	354
32.1.3	Appointment of International Searching Authorities	354
32.1.4	Receiving Offices specify the competent International Searching Authority or Authorities	354
32.1.5	Limitations set by the EPO on its competence as International Searching Authority	355
32.2	The nature of an international search	355
32.2.1	The purpose of an international search	355
32.2.2	Basis of the international search	355
32.2.3	Definition of relevant prior art	355
32.2.4	Fields to be covered	355
32.2.5	Minimum documentation	356
32.3	The nature of an international-type search	356
32.4	Procedure for conducting the search	356
32.4.1	General aspects	356
32.4.2	Check that title and abstract are present and appropriate	356
32.4.3	Check whether sequence listings have been provided properly	357
32.4.4	Determination as to whether a search is possible	357

32.4.5	Check for unity of invention	358
32.4.6	Lack of unity where the EPO is the International Searching Authority	358
32.4.7	Taking into account results of an earlier search	359
32.4.8	Taking into account the rectifications of obvious mistakes	360
32.5	The International Search Report, the written opinion and the International Preliminary Report on Patentability	360
32.5.1	Time limit for establishing the search report	360
32.5.2	Form of the search report	360
32.5.3	Written opinion of the International Searching Authority	361
32.5.4	Transmittal of the search report and written opinion to the applicant and the International Bureau	362
32.5.5	Preparation by the International Bureau of an International Preliminary Report on Patentability (IPRP) and transmission to the applicant	362
32.5.6	Translation of the search report by the International Bureau	362
32.5.7	Translation of the written opinion or Preliminary Report on Patentability by the International Bureau and communication of the report and its translation to designated Offices	362
32.5.8	Requests by a receiving Office or the applicant for copies of cited documents	363
32.5.9	Publication of the search report	363
Chapter 33: Supplementary International Searches		
33.1	Filing a request for a supplementary international search	364
33.1.1	Time limit	364
33.1.2	Where must the request be filed?	364
33.1.3	Can more than one request be filed?	364
33.1.4	Competent International Searching Authority	364
33.1.5	Content of the request	364
33.1.6	Requirement to pay fees	365
33.1.7	Situations under which the request is considered not to have been submitted	365
33.2	Processing of the request for supplementary international search by the International Bureau	366
33.2.1	Checking of the supplementary search request	366
33.2.2	Correction of defects and late payment of fees	366
33.2.3	Transmittal to International Searching Authority	366
33.3	Procedure for carrying out the supplementary international search ..	367
33.3.1	Start date for the search	367
33.3.2	Basis for the search	367
33.3.3	General procedure	367
33.3.4	Procedure in the case of a lack of unity	367
33.4	The supplementary International Search Report	368
33.4.1	Drawing up the supplementary International Search Report	368
33.4.2	Transmittal and effect of the supplementary International Search Report	369
Chapter 34: Amendment of the Application under Article 19		
34.1	Amendment of claims before the International Bureau	370
34.1.1	When can the applicant amend the claims?	370
34.1.2	Where should any amendments be filed?	370
34.1.3	Language of the amendments	370
34.1.4	Form of any amendments	370
34.1.5	Statement accompanying the amendments	370
34.1.6	Prohibition on added subject matter	371
34.2	Notification of amendments to the International Preliminary Examining Authority when a demand has been filed	371

Chapter 35: Publication of the Application and the Search Report

35.1	Responsibility for international publication.....	372
35.2	Timing of international publication.....	372
35.3	Circumstances where no publication takes place.....	372
35.4	Language and form of the publication.....	372
35.4.1	Where the language of filing is used.....	372
35.4.2	Where the language of a translation is used.....	373
35.4.3	Translation of parts of the pamphlet into English where English is not the language of publication.....	373
35.4.4	Form of the publication.....	373
35.5	Contents of the publication.....	373
35.5.1	A standardised front page (r.48.2(a)(i)).....	373
35.5.2	The description (r.48.2(a)(ii)).....	374
35.5.3	The claims (r.48.2(a)(iii)).....	374
35.5.4	Any drawings (r.48.2(a)(iv)).....	374
35.5.5	The International Search Report or Art. 17(2)(a) declaration (r.48.2(a)(v)).....	374
35.5.6	Any statement filed under Art. 19(1) (r.48.2(a)(vi)).....	374
35.5.7	Any request for rectification (r.48.2(i)).....	374
35.5.8	Indications relating to biological material (r.48.2(viii)).....	375
35.5.9	Information concerning a priority claim (r.48.2(ix)).....	375
35.5.10	Any declaration (r.48.2(x)).....	375
35.5.11	Request for restoration of the priority right (r.48.2(xi)).....	375
35.6	Matter excluded from the publication.....	375
35.7	Notice of publication in the Gazette.....	375
35.8	Publication of a notice that the application is considered withdrawn where withdrawal is received too late to stop publication.....	375

Chapter 36: Communications to National and Regional offices

36.1	Communication of the application (Art. 20) to designated States by the International Bureau.....	376
36.1.1	In what circumstances does the communication occur?.....	376
36.1.2	Normal timing of the communication and procedure where early national processing has been requested.....	376
36.1.3	Content of the communication.....	376
36.1.4	Responsibility for making copies.....	376
36.1.5	Language of the communication.....	376
36.1.6	Notification of the Art. 20 communication to the applicant.....	376
36.1.7	Designated Offices must accept the r.47.1(c) notification as evidence that the Art. 20 communication has occurred or is not necessary.....	377
36.2	Other information that is communicated to designated States by the International Bureau on request.....	377
36.2.1	Fact and date of receipt of the record copy and priority document....	377
36.2.2	Transmission of the application to a designated Office other than the Art. 20 communication.....	377

Chapter 37: Entry into the National/Regional Phase

37.1	Overview.....	378
37.2	Timing of national phase entry under Art. 22.....	378
37.2.1	Standard 30 month time limit.....	378
37.2.2	Specification of a later time limit than 30 months by a designated Office.....	378
37.3	Supply of a copy of the international application.....	379
37.4	Supply of a translation of the international application.....	379
37.4.1	Requirements of the translation.....	379
37.4.2	Consequences of certain defects in the translation.....	380
37.4.3	Where requirements regarding the translation change.....	380
37.5	Payment of the national fee.....	381

37.6	Supply of indications concerning the inventor	381
37.7	Use of a national form	381
37.8	Procedure where applicant has performed the Art. 22 acts and the designated Office has not been informed that the International Bureau has received the record copy	381
37.9	Indications as to protection sought for the purposes of national processing	381
37.10	Consequences of not performing the Art. 22 acts	382
37.11	National and regional phase entry under Art. 39.....	382
37.11.1	Effect of election prior to 19 months on the application of Art. 22	382
37.11.2	Necessary acts to enter the national phase under Art. 39 and the relevant time limit	382
37.11.3	Consequences of missing the Art. 39 time limit.....	382
37.11.4	Application of certain rules to national phase entry under Art. 39.....	382
37.11.5	Time limit for supplying a translation of the priority document to an elected State	383
37.12	Procedure before the EPO as a designated or elected Office	383
37.12.1	Entry into the EPO regional phase	383
37.12.2	Supply of a translation	384
37.12.3	Specification of documents on which the grant procedure is to be based	384
37.12.4	Filing fee	385
37.12.5	Designation fee	385
37.12.6	Extension fees	386
37.12.7	Validation fee	386
37.12.8	Supplementary European search and fee.....	386
37.12.9	Request for examination	388
37.12.10	Renewal fee.....	389
37.12.11	Certificate of exhibition.....	389
37.12.12	Amendment of the application and invitation to correct deficiencies ..	389
37.12.13	Claims fees	390
37.12.14	Designation of the inventor	390
37.12.15	Requirements relating to a priority claim.....	391
37.12.16	Provision of a sequence listing	391
37.12.17	Details relating to the applicant	392
37.12.18	Representation.....	392
37.12.19	Circumstances in which international publication takes the place of European publication	392
37.12.20	Opportunity to have a search report drawn up in respect of an invention not searched by the EPO in the international phase when no supplementary European search is necessary	393

Chapter 38: International Preliminary Examination

38.1	Which designated States does Chapter II apply to?	394
38.2	Who may apply for international preliminary examination and which States may be elected	394
38.3	Authority competent to conduct international preliminary examination	394
38.3.1	Receiving Offices specify the competent International Preliminary Examining Authority or Authorities	394
38.3.2	Limitations set by the EPO on its competence as International Preliminary Examining Authority.....	395
38.4	How to apply for international preliminary examination – the demand	395
38.4.1	Demand	395
38.4.2	Time limit	396
38.4.3	Where to apply	396
38.4.4	Use of a form	396
38.4.5	Content of the demand	396

38.4.6	Filing the demand constitutes the election of all eligible States	397
38.4.7	The EPO as an elected Office	397
38.4.8	Fees due	397
38.4.9	Acceptable languages of the demand	398
38.4.10	Acceptable languages of the application	399
38.4.11	Acceptable languages of amendments	399
38.4.12	Languages before the EPO	400
38.5	Later election of States	400
38.6	Procedure where there are defects in the demand	400
38.6.1	Applicant not entitled to make a demand	400
38.6.2	Invitation by the International Preliminary Examining Authority to correct formal defects	400
38.6.3	Procedure where a statement concerning amendments is omitted or is misleading	400
38.6.4	Defects noticed by the International Bureau	401
38.7	Procedural steps taken by the international authorities on receipt of the demand	401
38.7.1	Procedure of the International Preliminary Examining Authority on receipt of the demand – notification to the International Bureau and the applicant	401
38.7.2	Notification to elected States of their election by the International Bureau and other related actions	401
38.7.3	Notification of the written opinion and any Art. 19 amendments to the International Preliminary Examining Authority by the International Bureau	401
38.8	The objective of international preliminary examination	402
38.8.1	Aspects of patentability examined	402
38.8.2	Definitions of novelty, inventive step and industrial applicability	402
38.8.3	Definition of prior art	402
38.8.4	Documents to be taken into consideration	402
38.9	Procedure before the International Preliminary Examining Authority	403
38.9.1	When international preliminary examination starts and finishes	403
38.9.2	General provisions governing procedure	403
38.9.3	Right of the applicant to communicate with the International Preliminary Examining Authority	403
38.9.4	Documents on which the examination is based	404
38.9.5	Applicant's right to amend	404
38.9.6	Situations where the International Preliminary Examining Authority is not obliged to examine part of or the whole of an application	405
38.9.7	The written opinion of the International Preliminary Examining Authority and responses thereto	405
38.9.8	Circumstances in which the written opinion established by the International Searching Authority is considered to be a written opinion of the International Preliminary Examining Authority	406
38.9.9	Situation where amendments and arguments may be ignored	407
38.9.10	Procedure where the International Preliminary Examining Authority needs a copy of the priority document	407
38.9.11	Procedure where unity is in dispute	407
38.9.12	Lack of unity where the EPO is International Preliminary Examining Authority	408
38.9.13	Procedure where a sequence listing is absent or in the wrong format ..	408
38.9.14	Top-up search	408
38.10	The International Preliminary Examination Report (IPER)	409
38.10.1	Time limit for establishing the International Preliminary Examination Report	409
38.10.2	Requirements as to form	409
38.10.3	Language of the report (and any annexes)	409
38.10.4	Documents on which the report is based	409
38.10.5	Information on the first page	409

38.10.6	Comments on amendments and the correction of mistakes	410
38.10.7	Comments on priority	410
38.10.8	Comments on the non-establishment of an opinion	410
38.10.9	Comments on lack of unity	410
38.10.10	Statement regarding patentability under Art. 35(2)	410
38.10.11	Certain documents cited	411
38.10.12	Certain defects in the application.....	411
38.10.13	Certain observations on the application	411
38.10.14	Annexes to the report	411
38.10.15	Comment on top-up search	412
38.11	Translation and communication of the International Preliminary Examination Report and its annexes.....	412
38.11.1	Transmission of International Preliminary Examination Report to the International Bureau and the applicant by the International Preliminary Examining Authority	412
38.11.2	Translation by the International Bureau of the International Preliminary Examination Report and its transmission to the elected Offices and the applicant.....	412
38.11.3	Translation and transmission of the written opinion prepared under r.43bis.1 where the International Preliminary Examination Report is not available and the applicant has requested early processing in an elected Office.....	413
38.11.4	Translation of the annexes of the International Preliminary Examination Report by the applicant and transmission of the translation to the elected Offices	413
38.11.5	Supply of documents cited in the International Preliminary Examination Report to the applicant and elected Offices by the International Preliminary Examining Authority	413

Chapter 39: National Phase Aspects

39.1	The effect of an international patent application having a filing date ..	414
39.1.1	Nature of the effect	414
39.1.2	Circumstances in which the effect is lost	414
39.1.3	Exceptions to the effect – the prior art effect of an international application in a designated State.....	414
39.1.4	Definition of a Euro-PCT application	414
39.1.5	Extension of the effect to successor states	415
39.2	The effect of a published international patent application	415
39.2.1	Provisions of the PCT	415
39.2.2	Provisions of the EPC–publication of the translation	416
39.3	Examination by national Offices	416
39.3.1	When national processing may begin	416
39.3.2	Right to amend when entering the national phase under Chapter I....	416
39.3.3	Right to amend when entering the national phase under Chapter II...	416
39.3.4	Right to amend on entering the EPO regional phase	417
39.3.5	Procedure where unity has been impugned in the international phase .	417
39.3.6	Consideration of unity by the EPO	417
39.3.7	Effect on a designated Office of a decision by the receiving Office to base a filing date on documents incorporated by reference in the case where reservations have been filed or errors made	418
39.3.8	Requirements relating to form or contents additional to those in the PCT may not be imposed by national Offices	418
39.3.9	Requirements relating to the submission of certain documents (e.g. as evidence) that may be imposed by national Offices.....	419
39.3.10	Requirements relating to the certification/verification of the Art. 22 translation that may be imposed by national Offices	420
39.3.11	Consequences of submitting or not submitting a copy of the priority document in the international phase – how a designated Office obtains a copy	420

39.3.12	Requirement to submit a translation of the priority document	420
39.3.13	The effect on designated Offices of a decision by the receiving Office to restore a right of priority	421
39.3.14	The effect on designated Offices of a decision by the receiving Office to refuse restoration of a right of priority	422
39.3.15	Request by the applicant for a designated Office to restore a right to priority	422
39.3.16	Substantive conditions of patentability that may be imposed by Contracting States.....	423
39.3.17	Requirement by Contracting States that the inventor(s) must be the applicant(s)–procedure when not abided by.....	423
39.3.18	Requirements relating to representation that may be imposed by Contracting States.....	423
39.3.19	Removal of reference signs in claims for publication	423
39.3.20	Submission of a sequence listing	423
39.3.21	Special provisions relating to utility models.....	423
39.3.22	Any requirement to supply the results of examination in other States is not allowed if an International Preliminary Examination Report has been received.....	424
39.4	Consequences of an incorrect translation on the scope of a patent obtained	424

Chapter 40: The Calculation of Time Limits and Procedural Safeguards

40.1	Expression of dates.....	425
40.2	Time limits to be calculated from date of mailing	425
40.3	Computation of time limits	425
40.4	Extension of time limits where a national Office or intergovernmental organisation is not open for business	425
40.5	Extension of time limits where mail is not delivered in a relevant locality on the last day of a time limit.....	426
40.6	Circumstances in which a missed time limit is excused where a document is sent in good time	426
40.7	Excuse of the delay in meeting a time limit in the case of war etc	427
40.8	Extension of a time limit where a letter is received more than seven days after posting	427
40.9	Chance for the applicant to escape a negative determination made in the international phase	427
40.9.1	Overview	427
40.9.2	Duty of the International Bureau to supply documents to designated States when the International Bureau or receiving Office has made a negative determination	427
40.9.3	Assessment by the designated Office as to whether the applicant or the International Bureau/receiving Office is at fault according to the PCT	428
40.9.4	Right of any designated State to maintain the effect of an international application in that State when it does not have to	428
40.9.5	The duty of Contracting States to excuse missed time limits under provisions of national law	428
40.10	Opportunity to correct an application where allowed under national law	429
40.11	Rectification of errors made by the receiving Office or the International Bureau concerning filing date and priority claim	429
40.12	Reinstatement of rights after failure to enter the national phase within the time limit	429

Chapter 41: Rectification of Mistakes

41.1	Mistakes that may be rectified	431
41.2	Mistakes that may not be rectified	431
41.3	Authority responsible for authorising rectification.....	431

41.4	Either the applicant or an international authority may initiate rectification	432
41.5	Procedure for requesting rectification – time limit	432
41.6	Decision on the authorisation of a rectification	432
41.7	Language of the correction	433

Chapter 42: Representation

42.1	Requirements relating to representation that may be imposed by the receiving Office	434
42.2	Requirements relating to representation that may be imposed by Contracting States	434
42.3	Right to practice before international authorities	434
42.4	Agents and common representatives	434
42.4.1	Appointment of an agent	434
42.4.2	Representative where there are two or more applicants	435
42.4.3	Effects of acts carried out by representatives and agents	435
42.4.4	Manner of appointment of an agent or common representative	435
42.4.5	Manner of renunciation of an agent or common representative	436

Chapter 43: Miscellaneous Common Provisions

43.1	Relationship between the PCT and the EPC	438
43.2	Rules relating to documents filed subsequently to the filing of the application	438
43.2.1	Need for papers to be accompanied by a signed letter	438
43.2.2	Language of letters and documents	438
43.2.3	Form of subsequently filed documents	438
43.2.4	The use of telegraph, teleprinter, facsimile to transmit subsequently filed documents	439
43.2.5	The use of electronic means to transmit subsequently filed documents	439
43.3	Withdrawal of an international application, a designation, an election, a demand or a priority claim	440
43.3.1	Withdrawal of an international application	440
43.3.2	Withdrawal of a designation	441
43.3.3	Withdrawal of a priority claim	441
43.3.4	Withdrawal of a supplementary search request	441
43.3.5	Withdrawal of the demand or of elections	442
43.4	Recordal of changes concerning an applicant, inventor, agent or common representative by the International Bureau	443
43.5	Notification by national Offices and intergovernmental organisations	443
43.6	Schedule of Fees	443
43.7	Third party observations	443

Chapter 44: Information Made Available by the International Authorities and Designated/Elected Offices

44.1	Confidential nature of the international application before its publication	444
44.2	Confidential nature of the written opinion of the International Searching Authority and related documents	444
44.3	Confidential nature of international preliminary examination	445
44.4	Records and files – keeping them and allowing access to them	445
44.4.1	Obligation for international authorities to keep files	445
44.4.2	Access allowed to files (applications filed on or after July 1, 1998)	445
44.4.3	Access allowed to files (applications filed before July 1, 1998)	446
44.4.4	Access to the international preliminary examination report given by the International Bureau on behalf of an elected office (all applications)	446
44.4.5	Availability of the priority document from the International Bureau (all applications)	447

44.4.6	Availability of translations required by national Offices (all applications)	447
44.4.7	Availability of citations in the International Search Report from the International Searching Authority (all applications)	447
44.4.8	Availability of citations in the International Preliminary Examination Report from the International Preliminary Examining Authority (all applications)	447
Index	449