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Day 1

Priority in the international phase

Where an IA has an int. filing date which is later than the date on which the priority period expired but within a period of 2 months from that date, the priority claim concerned will not be declared void for the purposes of the int. phase of the PCT procedure, irrespective of whether the restoration of the right of priority is requested, or whether such a request is accepted or refused by the RO. Where the priority claim in question is the only or the earliest priority claim in the IA, it will continue to serve as the basis to calculate all time limits during the int. phase. (AG-IP 5.062)

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Day 2

Changing claim category during opposition

During opposition, changing claim category is only permitted:

- if the amendment is necessitated by a ground of opposition - R.80, GL H-V, 7, and
- if the amended claim does not extend beyond the application as filed - Art.123(2) EPC, and
- if it does not extend the scope of protection - Art.123(3) EPC.

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Day 3

Top-up search

The top-up search is an additional search during the EP process for any conflicting Art.54(3) prior right applications unless this was already covered by the search report. This search should be extended so as to cover all European applications published up to 18 months after the filing of the application. This means that the earliest date a Rule 71(3) communication can be sent is filing date + 18 months (exceptionally priority date +18m, if priority is valid for the whole content of the application). GL C-IV, 7.1

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Day 4

FP and RE for a Euro-PCT application

In short: for missing the request for examination & exam. fee: 2 FP fees but only 1 RE fee.

Longer version: If the applicant submits the request for examination and pays the exam. fee after expiry of the 31-month period, the fee for further processing (FP) comprises the (flat) fee for the late-filed request and 50% of the late-paid exam. fee. - Euro-PCT guide 5.19.003

If the applicant, having failed to file the request for examination and pay the exam. fee on time, then fails to request FP on time, only one fee for re-establishment of rights is due in respect of the request for examination and the exam. fee. - Euro-PCT guide 5.19.004

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Day 5

Not part of a European patent application

Not part of the application:

- abstract - Art. 85, G3/89, T 246/86
- priority document - G3/89, T 260/85, GL G-IV, 5.1
- embodiments that are not enabled - GL G-VI 4
- (and T 26/85, T 206/83 and T 491/99)
- expressly abandoned subject-matter - T 61/85 r.11

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Day 6

Acceleration of a Euro-PCT application

You cannot blindly apply all of these for every case, always check the details in the question!

- Entering early, explicitly requesting early-processing;
- Waiving the R.161/162 communications (but, if response to the opinion is needed, it has to be taken care of and any claims fees must also be paid!)
- Waiving the R.70(2) communication (if EPO was not (S)ISA),
- Filing **PACE** request for examination (after search). →



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Day 7

Debit order cannot be filed by fax

The debit order must be filed in an electronically processable format (xml) via one of the following:

- EPO Online Filing using EPO Forms 1001E, 1200E, 2300E or 1038E, or Online Filing 2.0 using EPO Forms 1001E, 1200E or 1038E;
- EPO Online Filing or ePCT using the PCT fee calculation and payment feature, or Online Filing 2.0 using the PCT fee calculator and payment feature with Forms PCT/RO/101 and PCT/IPEA/401;
- Central Fee Payment.

ADA 2022, 7.1.2 (Supplementary publication 3, OJ EPO 2022, 11)



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Day 8

Languages when filing at the EPO (EPC vs PCT)

EPC: You can file in any languages (but then you will have to file a translation within 2 months). - Art.14(2) EPC

PCT: EPO is only competent rO if you file in EN/DE/FR. - R.157(2) EPC
When you file a PCT application with the EPO in a language other than EN/DE/FR, it will be transmitted to the IB under R.19.4(a)(ii) PCT.

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Day 9

Consequences of an opposition being deemed not filed

1. Any opposition fees which have been paid are refunded.
2. Documents submitted with a notice of opposition which is deemed not to have been filed will form part of the file and will thus be available for inspection in accordance with Art. 128(4). They will be regarded as observations by third parties under Art. 115.

GL D-IV, 1.4.1



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Day 10

Third party observations before/during grant

1. Observations by third parties received in examination after dispatch of a Rule 71(3) communication but before the decision to grant has been handed over to the EPO postal service will be considered by the examining division. If they are relevant, the examining division will resume examination.

2. Observations by third parties received after the grant decision has been handed over to the EPO postal service will be included in the file without taking note of their content.

3. Observations by third parties received once proceedings are no longer pending (e.g. after publication of the mention of the grant) will be neither taken into account nor made available for file inspection. They will however be made available for file inspection upon the start of opposition proceedings.
EPO GL E-VI, 3

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Day 11

Time limit for the request for unitary effect

Earliest time: The request for unitary effect can be filed already **after the issuance of the decision to grant** the European patent (EPO Form 2006A). - Supplementary publication 3, OJ EPO 2023, 5

Latest time: The request for unitary effect shall be filed with the EPO no later than **1 month after publication of the mention of grant** of the European patent in the European Patent Bulletin.
- Rule 6(1) of the Rules relating to Unitary Patent Protection (UPR)



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Day 12

Translation to be filed with the request for unitary effect

During a transitional period, a translation of the European patent must be filed with the request.

Language of translation:

- Either English - where the language of the proceedings is French or German; or
- Any other official language of the European Union - where the language of the proceedings is English.

- Rule 6(2)(d) of the Rules relating to Unitary Patent Protection (UPR), Regulation (EU) No 1260/2012

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Day 13

Payment of renewal fees for European patents with unitary effect

Due date: the last day of the month containing the anniversary of the date of filing.

Earliest payment: renewal fees may not be validly paid more than three months before they fall due.

Where to pay: directly to the EPO.

Late payment with additional fee: the fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period.

- Rule 13 of the Rules relating to Unitary Patent Protection (UPR)



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Day 14

Legal remedy when not filing the request for unitary effect in time

Re-establishment, but only if all due care can be proven. - Rule 22(1)
Time limit: Within 2 months of expiry the period for filing the request for unitary effect. - Rule 22(2)

The request shall state the grounds on which it is based and shall set out the facts on which it relies. The omitted act shall be completed within the relevant period for filing the request. - Rule 22(3)
Rule 22 of the Rules relating to Unitary Patent Protection (UPR)



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Day 15

**Meaning of "unitary effect"
(Regulation (EU) No 1257/2012)**

Art.3(2): A Unitary Patent has unitary character, meaning it provides uniform protection and has equal effect in all the participating Member States. It may only be limited, transferred or revoked, or lapse, in respect of all the participating Member States. It may be licensed in respect of the whole or part of the territories of the participating Member States.

Art.3(1): A European patent granted with different sets of claims for different participating Member States shall not benefit from unitary effect.

Art.4(2): It is not allowed to have both Unitary Patent and national EP validation in force for a given country.



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Day 16

**R.133(1) EPC
"Deemed to be received in due time"**

R.133(1) EPC has 3 conditions:

- Mailing the document at least 5 days before the expiry of the time limit
- EPO receives said document within 3 months of the expiry of the time limit
- Document was sent by a postal service recognised by the President of the EPO*

Using R.133(1) successfully means that the document received later will be deemed to have been received in due time. **BUT!** "Despite this legal fiction that the time limit has been observed, the filing date of the document remains the day on which it was actually received." GL E-VIII 1.7



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Day 17

Limited scope of Web-form filing

OJ EPO 2023, A48, Art. 3:

1. **Authorisations**, documents in respect of **opposition**, limitation and revocation proceedings (Articles 99 to 105c EPC), documents in respect of **appeal** proceedings (Articles 106 to 112 EPC) or documents in respect of proceedings for review by the Enlarged Board of Appeal of decisions of the Boards of Appeal (Article 112a EPC) must not be filed using web-form filing.

2. Documents filed in contravention of paragraph 1 will be deemed not to have been received. The sender, if identifiable, will be notified without delay.



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Day 18

Fee reductions

- filing fee by 30% for Art.14(4) and R.6(4) persons, if all conditions are fulfilled for the language based reduction under R.6(3)-(7) EPC - Rfees 14(1)
- reduced filing fee (€135 instead of €285) when filing online - Rfees2(1) item 1
- examination fee by 30% for Art.14(4) and R.6(4) persons, if all conditions are fulfilled for the language based reduction under R.6(3)-(7) EPC - Rfees 14(1)
- examination fee of Euro-PCT applications by 75% where EPO was IPEA - Rfees 14(2)*
- supplementary European search fee for Euro-PCT applications by a fixed amount of €1245 in cases when the (S)ISR was drawn up by a European ISA, i.e. the Austrian Patent Office, the Finnish Patent and Registration Office, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the Swedish Intellectual Property Office, the Turkish Patent and Trademark Office or the Visegrad Patent Institute. - EPC 5.9.01A, GL/EPO A-X, 9.3.1**
- reduced appeal fee (€2015 instead of €2925) for natural persons and entities referred to in Rule 6(4), (5) EPC - Rfees2(1) item 11***



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Day 19

Early publication

In EPC:

Request for early publication is possible under Art.93(1)(b), but there are 2 conditions:

- the filing and search fees have been validly paid, and
- there are no formal deficiencies in the application documents. - GL A-VI, 1.1

Request for early publication blocks the following actions:

- making or correcting a declaration of priority, R. 52(4)
- submitting information on deposit of biological material, R. 31(2)(b)

In PCT:

Request for early publication is possible under Article 21(2)(b) and Rule 48.4 PCT.

Special fee: If the applicant asks for early publication and the international search report, or the declaration referred to in Article 17(2)(a), is not available for publication with the international application, a special fee is payable to the International Bureau.



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Day 20

Late publication

In EPC: Deferral of publication is possible by abandonment of priority. - GL A-VI 1.1 and E-VIII, 1.5

GL A-VI 1.1: "If the applicant abandons the priority date, then the publication is deferred provided that the notification of the abandonment is received by the EPO before the termination of the technical preparations for publication.

These preparations are considered terminated at the end of the day five weeks before the end of the eighteenth month from the date of priority, if priority is claimed, or from the date of filing, if the priority is abandoned or if no priority is claimed (see the decision of the President of the EPO dated 12 July 2007, Special edition No. 3, OJ EPO 2007, D.1).

In PCT: International publication may be postponed by withdrawing the priority claim as outlined in Rule 90bis.3 PCT, AG-IP 9.023A, 11.056 and 11.057.

The notice of withdrawal of the priority claim should be received by the International Bureau (IB) before the completion of technical preparations for international publication, that is, before 15 days prior to the date of publication.



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Day 21

No publication

In EPC:

GL A-VI 1.2: "The application is not published if it has been finally refused or deemed withdrawn or withdrawn before the termination of the technical preparations for publication."

- The application may be withdrawn by means of a signed declaration, which should be unqualified and unambiguous (see J 11/80).
- The withdrawal may be conditional. - GL A-VI 1.2
- Publication can often be prevented if the declaration of withdrawal is received 2 weeks before the scheduled date of publication. - OJ 2006, 406
- In case of withdrawal by mistake, R.139 may be applicable (J 4/97).

In PCT:

The applicant may prevent international publication by withdrawing the IA, provided that the applicant submits a notice of withdrawal and that the notice of withdrawal reaches the IB before the completion of technical preparations for that publication. It is strongly recommended to send the notice of withdrawal directly to the IB through ePCT. - Article 21(5), Rule 90bis.1(c)PCT, AG-IP 9.023A



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Day 22

Legal effects of publication (EPC)

- Application becomes state of the art, Art. 54 EPC
- Start of provisional protection, Art. 67, Art. 69(2) EPC
- Third-party observations possible, Art. 115 EPC
- Files accessible via the register, Art. 127 EPC
- File inspection possible, Art. 128 EPC
- Publication of the mention of the inventor, Art. 81, R. 20 EPC
- Deposited biological material available to the public, R. 31, R. 33 EPC
- Stay of proceedings possible, Art. 61, R. 14 EPC



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Day 23

Possible invitations during search

Consultations with the search division can only take place after the application has entered the examination stage, with the exception of cases indicated in GL B-VIII, 3.2.2 and 4.2.2.

1. **Multiple independent claims** -> R.62a invitation (time limit: 2 months)
2. **No meaningful search** -> R.63 invitation (time limit: 2 months)
3. **Lack of unity** -> R.64 invitation (time limit: 2 months)

In exceptional cases an invitation to pay additional search fees under Rule 64(1), Rule 164(1) or Rule 164(2) may be combined with an invitation to restrict the scope of the search under Rule 62a(1) and/or Rule 63(1). - GL C-III 3.2.3



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Day 24

Filing at the wrong office (EPC vs PCT)

In EPC: Filing date becomes the later date!

OJ 2017, A11 Article 1(2): "The EPO's sub-office in Vienna is not a filing office for the purposes of Article 75(1)(a) EPC and Rule 35(1) EPC. Patent applications filed with the Vienna sub-office are forwarded to one of the filing offices and **will only be accorded a filing date on receipt by the latter.**"

In PCT: Filing date becomes the date of receipt by the wrong office!

Rule 19.4(b) PCT: The international application so transmitted shall be considered to have been received by the IB as RO under Rule 19.1(a)(iii) **on the date of receipt of the international application by that national Office.**

