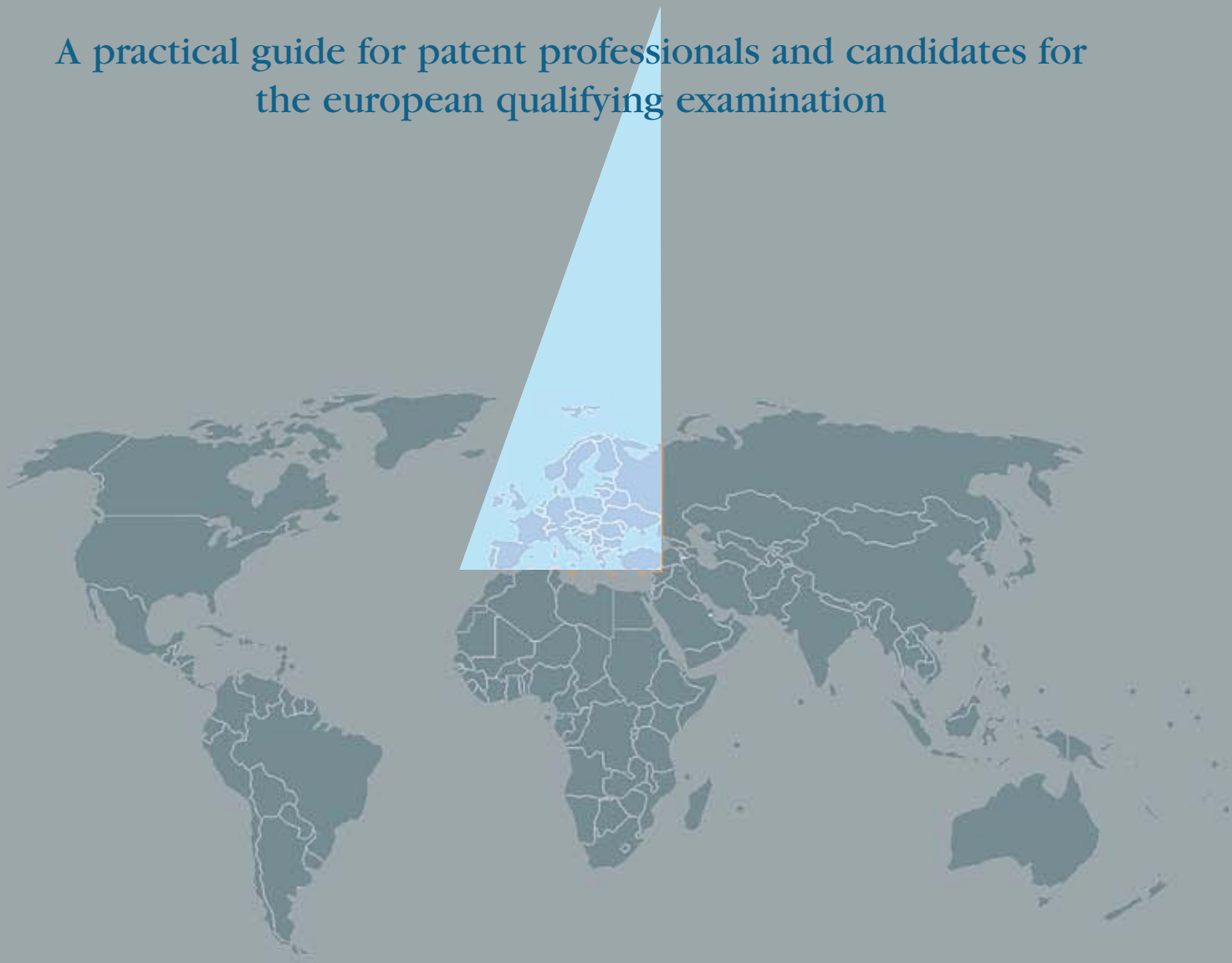


Andrea Veronese & Peter Watchorn

# Procedural law under the EPC-2000

3rd Edition 2013

A practical guide for patent professionals and candidates for  
the european qualifying examination



Kastner



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Peter Watchorn and Andrea Veronese also authored the Book "*PCT Procedures and Passage into the European Phase*", 2<sup>nd</sup> Edition, Kastner AG, March 2010.

## Foreword

This book is intended to be a reference work for patent professionals who work with the European Patent Convention. It is also intended to be used by candidates for the European Qualifying Examination, for studying the procedural law of the Convention and for learning how to navigate its legal provisions.

The book is organised into Chapters I-XXIII which cover, in chronological order, the different phases of the proceedings before the EPO: filing, formalities, search, publication, examination, opposition, limitation/revocation, appeal etc, with Chapter XXIV relating to provisions common to all procedures before the EPO and finally Chapter XXV, giving some basic information about passage into the European phase from the PCT. This structure generally reflects the structure of the EPC itself. Each chapter focuses on a particular topic, summarising the relevant provisions from the various legal sources: Articles, Rules, Guidelines, Case Law, Notices in the Official Journal. The legal basis for the procedures is always clearly given, since this allows the reader to become familiar with, and to personally consult the relevant legislation. Although repetitions sometimes occur, the authors' intention was to render each chapter self-contained and exhaustive, in as far as this is possible. This structure is meant to allow the reader to quickly and efficiently find answers to questions of the type:

- what should be done ?
- who should do it ?
- where should it be done ?
- when should it be done ?
- what sanctions apply if it is not done correctly ?
- how to avoid, mitigate or reverse those sanctions when they are applied ?

In order to render the text as compact as possible, frequent use is made of acronyms and abbreviations as well as a two column lay out. We hope that after getting accustomed to this format, readers will find this book a useful tool for study and daily work.

### Changes covered in this third edition

Since the coming into force of the EPC-2000 on 13 December 2007, the EPC has continued to develop both in terms of regulatory changes, case law and administrative decisions. In particular, since the publication of the second edition, the most noteworthy changes are as follows:

- changes to the grant procedure (R.71/R.71a in force as of 01.04.2012)
- new sanction for failure to translate the priority (R.53(3) in force as of 01.04.2013)
- new decisions of the Enlarged Board of Appeal
- the re-organisation of the EPC Guidelines, including:
  - incorporation of legal advices into the Guidelines
  - incorporation of internal instructions into the Guidelines
  - separation of issues of procedural law (Parts A-E) and substantive law (Parts F-H)

In particular, the incorporation of the legal advices into the EPC Guidelines meant that all legal advices from the EPO were cancelled as of 20.06.2012 (OJ 2012, 446). This has meant that most references to these legal advices have been replaced by references to those new sections of the EPO Guidelines where the legal advices have been incorporated. However, some of the more detailed information from the legal advices was not taken up and so the legal advices are still referred to in this 3<sup>rd</sup> edition.

Andrea Veronese and Peter Watchorn

## How to use this book

### Structure of the Table of Contents

A quick glance at the Table of Contents will immediately reveal the structure of this book, which is chronological in its arrangement of topics. The Chapters are given roman numerals I-XXV and each section number bears the Chapter number Roman numeral as the first number plus the main section number which is an Arabic numeral (e.g. section II.4 is the fourth main section in Chapter II). All further sub-divisions (sub-sections of the main headings) are indicated by further Arabic numerals (e.g. II.4.2 is a sub-section of main heading II.4). For example:

<b>II.4.</b>	<b>Where to file EP applications.....</b>	<b>25</b>
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The sections II.4.2.1 to II.4.2.2 are subsidiary sections relating to a very specific area of the more general section to which they belong (section II.4.2), which in turn is subsidiary to the main section II.4. The user must first find the relevant Chapter, then the relevant main section then follow the tree down to find the relevant sub-section.

### Quick reference tables

Two quick reference tables have also been prepared and annexed to this book, to summarise in a condensed, graphical form the most relevant provisions for filing and post-filing formalities of applications filed directly at the EPO and for the passage from the PCT into the European regional phase. The tables provide a general overview of these procedures in schematic form and focus the reader's attention on the chronological order of the most relevant events characterising these procedures. Where relevant, the tables refer to the appropriate sections of the book, in particular in Chapters II, III and XXV, where the same topics are dealt with in more detail.

### Sub-titles

The sections of the book also contain sub-titles in bold italics type. These are designed to help the reader find more specific information relating to the subject of the section more rapidly. For example, when looking for information on the loss of rights occurring when a required biological sequence listing is not provided on invitation from the EPO, the reader first looks up the relevant section "III.7.1.2 Invitation to file/correct sequence listings and pay late furnishing fee", and then looks for the appropriate sub-title "*Loss of rights*".

## Comments on the legislation

The book also contains explanations of the legislation, these are always in italics to distinguish them from the legislative provisions which they comment on.

## Standardised legal references and abbreviations

All references to legal provisions are in a standardised format and certain abbreviations have been used, see the following table (all references to "EPC" in this table relate to the revised text of EPC 2000, unless explicitly identified as relating to EPC 1973):

<i>EPC legal provision</i>	<i>Standard format</i>
EPC Article	Art.87(1)
EPC 1973 Article	Art.54(4) EPC 1973
EPC Protocol on Centralisation	Pr. Centr. I(2)
EPC Rule	R.56(3)
EPC 1973 Rule	R.87 EPC 1973
EPC Rules Relating to Fees	Rfees 6(2)
EPO Guide for Applicants, Part 1	EP-AG 1, 44
<i>EPC Secondary legal sources</i>	<i>Standard format</i>
Arrangements for Automatic Debiting	Point 6.2 AAD
Arrangements for Deposit Accounts	Point 3 ADA
Case law of EPO Enlarged Board of Appeal	G3/91
Case law of EPO Legal Board of Appeal	J4/94
Case law of EPO Technical Board of Appeal	T886/91
Guideline	A-IV, 1.1.1.1
Legal Advice from the EPO (now abandoned)	L6/91
Official Journal of the EPO	OJ 2010, 498
Rules of Procedure of the Board of Appeal	RPBOA Art.13
Rules of Procedure of the Enlarged Board of Appeal	RPEBOA Art.8
Special Edition of the Official Journal of the EPO, Presidential Decision Nr B.1	OJ S. 3/07, J.3 [Special Ed Nr 3 of 2007, Pres. decision J.3]
Supplement to the Official Journal of the EPO	OJ Suppl 10/2007
<i>PCT legal provision</i>	<i>Standard format</i>
PCT Article	Art.21(1)(a) PCT
PCT Rule	R.49.4 PCT

EPO Guide for Applicants, Part 2 (Euro-PCT Guide)	Euro-PCT Guide 620
WIPO Standard	ST.25
<b><i>Paris Convention</i></b>	<b><i>Standard format</i></b>
Paris Convention Article	Art.4 PC
<b><i>Budapest Treaty</i></b>	<b><i>Standard format</i></b>
Budapest Treaty Article	Art.4(1)(a)(ii) BT
Budapest Treaty Rule	R.6.2 BT
<b><i>Patent Law Treaty</i></b>	<b><i>Standard format</i></b>
PLT Article	Art.5(4)(b) PLT
PLT Rule	R.2(2) PLT
<b><i>TRIPS</i></b>	<b><i>Standard format</i></b>
TRIPS Article	Art.70(7) TRIPS
<b><i>Abbreviation</i></b>	<b><i>Meaning</i></b>
Appln	Application
EP	European [ <i>with reference to the EPO and EPC</i> ]
EESR	Extended European Search Report
ESOP	European Search Opinion
EPC	European Patent Convention, as amended at the Diplomatic Conference in Munich, Nov. 2000
EPC 1973	European Patent Convention, as adopted at the Diplomatic Conference in Munich, Oct. 1973
EPO	European Patent Office
IPEA	International Preliminary Examining Authority
IPER	International Preliminary Examination Report
ISA	International Searching Authority
Patentee	Patent Proprietor
WIPO	World Intellectual Property Organisation
WO-ISA	Written Opinion of the International Searching Authority



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This third edition of „Procedural Law under the EPC-2000“ takes account of all of the legal changes which have come into force since the publication of the second edition in 2011. It covers, in particular, the re-organisation of the EPO Guidelines and the changes to the examination procedure in amended R.71 and new R.71a.

As with the first and second editions, „Procedural Law under the EPC-2000“ is intended to be a reference work for patent professionals and candidates for the European Qualifying Examination, when working with or studying the European Patent Convention.

The current version of the Convention comprises over 170 articles and over 160 implementing regulations. In addition, reference has to be made to over 770 pages of Guidelines, more than 20,000 decisions of the Boards of Appeal and several hundred notices in the Official Journal of the European Patent Office. The European Patent Convention further interacts with other international treaties, including the Patent Law Treaty, Paris Convention, Budapest Treaty, TRIPS, and of course, the Patent Cooperation Treaty.

This legal forest, like forests the world over, has its fair share of wolves, bears, hunters and banshee inhabited cottages as well as innocent children. Before venturing into the forest, in order to avoid blundering into eternal perdition, it would be a good idea to be in possession of a map and a compass. This is where the book „Procedural Law under the EPC-2000“ comes in, being designed to guide the reader through the „thickets of the law“, and to help him or her to find all of the information needed to process an application, patent, opposition, appeal, or any other request before the EPO.

The book is written in a practical way. It deals thoroughly and systematically with the different topics but also fits all parts into “the bigger picture”. Therefore it is an essential tool for study and daily work.

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