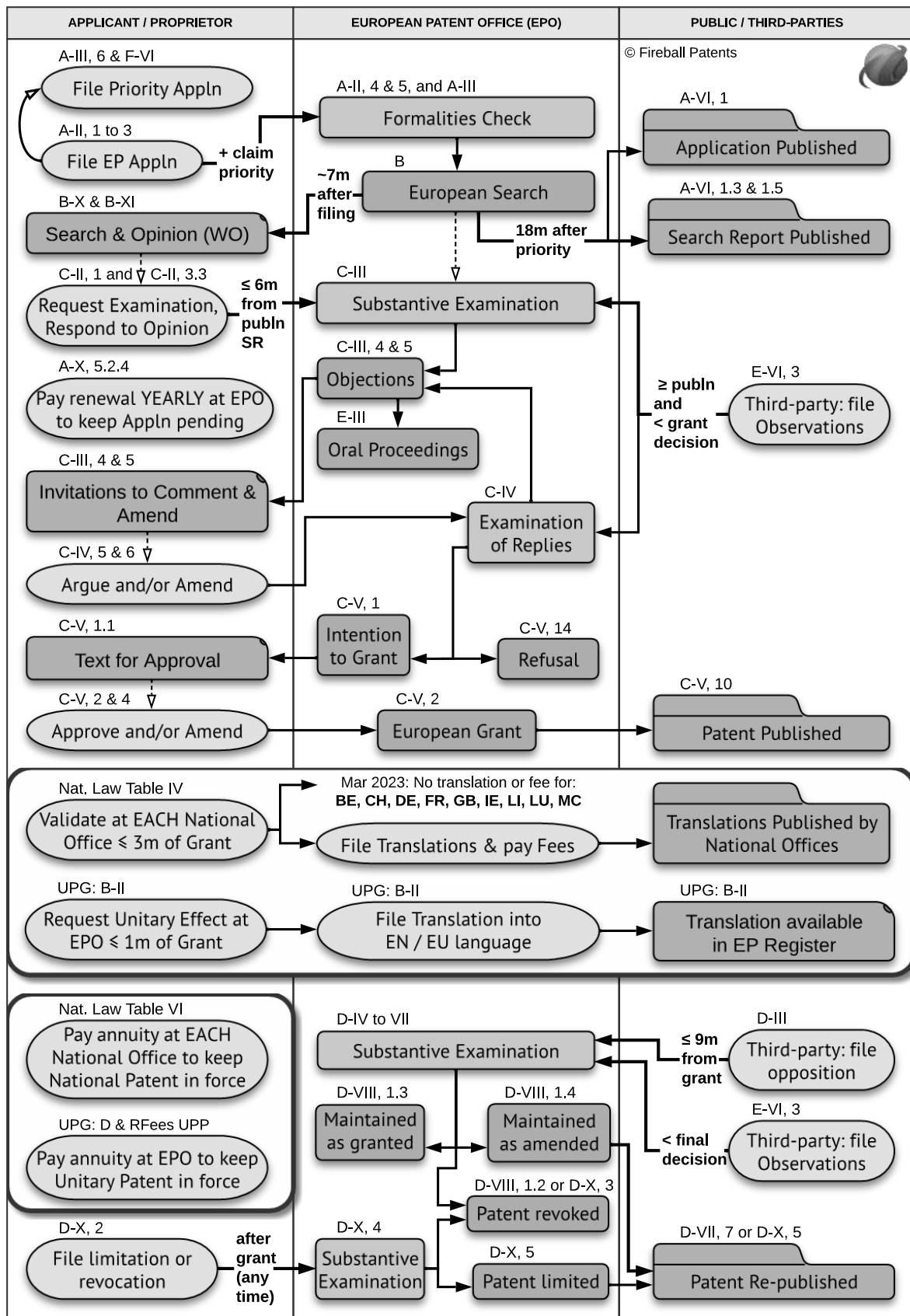


# Indexed EPO-EPC Guidelines (Mar 2023) and Unitary Patent Guide (Apr 2022)



Compiled by Pete Pollard & Ignacio Lobato  
(includes official texts from [www.epo.org](http://www.epo.org))

Fireball Patents publishes legal references & study materials - [fireballpatents.com/study-materials](https://fireballpatents.com/study-materials):

- Many are based on official digital references which are modified and reformatted to make them more complete and easier to use. We print using the smallest paper sizes that can still be comfortably read. Most books are sold as a Portable Edition, using thin 50g paper, to reduce thickness and weight. Selected books are also sold as a Study Edition, with a slightly thicker paper which is more suitable for intensive tabbing, annotating and highlighting.
- Nothing in our training or study materials is to be considered as legal advice - these resources are intended for educational and informational purposes only. IP law is highly complex and continuously changing, so always double-check the status with the latest official resources. Consult an authorised professional or legal counsel before relying on the information presented.

We modify official digital references by:

- providing our own Detailed Tables of Contents:
  - the entries are based on the official Tables of Contents from the digital references, but re-organised in one list together at the front of each reference. We abbreviate the entries to allow quick scanning. Page numbers are added to speed up getting to the correct page. Sections with significant changes in the last 3 years are also indicated.
- making the digital references printable:
  - we include the complete official reference, and just modify the formatting. The underlining of legal citations and references is retained to make them easy to spot. Legal references from the margins have been moved to the end of the paragraphs. The original page format has been completely changed to better fill each page, which reduces the number of pages to about half, and gives the reader a good overview of neighbouring sections.

This Edition includes:

- a) EPC Procedural Overview with EPO-EPC Guidelines references
  - in colour (on front) and black/white (on inside cover)
- b) Detailed Table of Contents – EPO-EPC Guidelines
- c) EPO-EPC Guidelines for Patent Examination – **Mar 2023** edition (available at [www.epo.org](http://www.epo.org))
  - complete EPO-EPC Guidelines, including the official Computer-Implemented Inventions (CII) Index, List of Sections Amended, and Alphabetical Keyword Index
- d) Detailed Table of Contents – EPO Unitary Patent Guide
- e) EPO Unitary Patent Guide – **Apr 2022** edition (available at [www.epo.org](http://www.epo.org))
  - complete EPO Unitary Patent Guide, which entered into force on 1 June 2023

For Exam Candidates, such as European Qualifying Exam (EQE):

- The EPO-EPC Guidelines entered into force on 1 March 2023, and is the official versions for EQE 2024 Main Exam & Pre-Exam. It is not yet known to what degree Unitary Patent will be tested.
- Note that most changes in the Mar 2024 version will be based on Case Law, notices and practice changes already known in 2023. If using this edition for more than one year, download the official 2024 "track changes" version, and update as needed - it is more efficient than transferring notes.

The Authors:

- Ignacio comes from Spain and now works in Germany as an IP counsel in industry. He was a candidate in the EQE main exams of 2022.
- Pete is originally from UK, and now lives in The Netherlands. He has been training EPC & PCT law for more than 13 years. He currently teaches patent attorneys through **EQELIBRIUM**, formalities officers in English through **Forum Institut**. He is the author of the legal reference **PCT.App**, available in print or as a self-editable printable reference: [www.pctapp.net](http://www.pctapp.net).
- Pete founded **Fireball Patents** in Eindhoven to better serve start-ups – the firm is virtual, using automation and external specialists to limit overhead. He is also part of **IP.DESIGN**, a German-Swiss IP boutique, offering one-stop solutions to innovative SMEs.
- Contact via: [web@fbpats.com](mailto:web@fbpats.com) or [www.linkedin.com/in/petepollard](https://www.linkedin.com/in/petepollard)

**The authors and Fireball Patents do not accept liability for the accuracy of this information or for any printing errors.**



# EPO-EPC Guidelines for Examination (Mar 23)

Major changes

2021  
2022  
2023

			Page
<b>GENERAL PART</b>			<b>41</b>
	1	Preliminary remarks	41
	2	Explanatory notes	41
	2.1	Overview	41
	2.2	Abbreviations	42
	3	General remarks	42
	4	Work at EPO	43
	5	Summary of processing of applns & patents at EPO	43
#	6	Contracting states to EPC	44
#	7	Extension & validation in states not party to EPC	44
<b>A: FORMALITIES EXAMINATION</b>			<b>45</b>
	<b>A-I</b>	<b>Introduction</b>	<b>45</b>
	1	Overview	45
	2	Responsibility for formalities examination	45
	3	Purpose of Part A	45
	4	Other Parts relating to formalities	45
	<b>A-II</b>	<b>Filing of applns and examination on filing</b>	<b>45</b>
	1	Where & how applns may be filed	45
	1.1	Filing of applns by delivery by hand or by postal services	45
	1.2	Filing of applns by means of electronic communication	45
	1.2.1	Filing of applns by fax	46
	1.2.2	Filing of applns in electronic form	46
	1.3	Filing of applns by other means	46
	1.4	Subsequent filing of documents	46
	1.5	Debit orders for deposit accounts held with EPO	46
	1.6	Forwarding of applns	46
	1.7	Appln numbering systems	47
	1.7.1	Applns filed before 1 Jan 2002	47
	1.7.2	Applns filed on or after 1 Jan 2002	47
	2	Persons entitled to file an appln	47
	3	Procedure on filing	47
#	3.1	Receipt; confirmation	47
	3.2	Filing with a competent national authority	47
	4	Examination on filing	48
	4.1	Minimum requirements for according a date of filing	48
	4.1.1	Indication that EP patent is sought	48
	4.1.2	Information concerning applicant	48
	4.1.3	Description	48
	4.1.3.1	Reference to previously filed appln	48
#	4.1.4	Deficiencies	49
	4.1.5	Date of filing	50
#	5	Late filing of missing dwgs or missing parts of description	50
#	5.1	Late filing of missing dwgs or missing parts - on invitation	50
#	5.2	Late filing of missing dwgs or missing parts - without invitation	50
	5.3	The filing date changes	50
#	5.4	Missing parts based on priority, no change in filing date	51
#	5.4.1	Late-filed missing parts when priority is claimed	51
#	5.4.2	Missing parts are completely contained in priority appln	51
	5.4.3	Copy of priority appln	51
	5.4.4	Translation of priority appln	52

Major changes

2021  
2022  
2023

		Page
	<b>C-IV Examination of replies and further stages of examination (cont.)</b>	
	4 Later stages of examination	171
	5 Examination of amendments	171
	6 Admissibility of amendments made by applicant	171
	7 Search-related issues in examination	171
	7.1 Search for conflicting EP applns	171
#	7.2 National prior rights	171
#	7.3 Additional searches during examination	171
	7.4 Search at examination stage	172
	7.5 Citing documents not mentioned in Search Report (SR)	172
	8 New submissions in reply to summons	172
	<b>C-V Final stage of examination</b>	172
	1 Communication under R.71(3)	172
	1.1 Text for approval	172
	1.2 Grant & publishing fee	173
	1.3 Translations of claims	173
	1.4 Claims fees due in response to R.71(3) communication	173
	1.5 Other information in communication under R.71(3)	174
#	2 Approval of proposed text - grant of a patent	174
	3 No reply in time - appln deemed withdrawn	175
#	4 Request for amendments or corrections in reply to R.71(3) comm.	175
#	4.1 No payment of fees or filing of translations necessary	175
	4.2 Crediting of fees paid voluntarily	175
	4.3 Amendments or corrections should be reasoned	176
	4.4 Admissibility of amendments	176
	4.5 Adaptation of description	176
#	4.6 Amendments/corrections admitted and allowable - 2nd R.71(3) communication sent	176
	4.6.1 2nd R.71(3) comm. reversing amendments proposed by exam. div. in 1st R.71(3) comm.	176
	4.6.2 2nd R.71(3) invitation based on higher request initially rejected in 1st R.71(3) comm.	176
	4.6.3 Exam. div. proposes amendments in 2nd R.71(3) communication	176
#	4.7 Amendments not admitted and/or not allowable, examination resumed	176
	4.7.1 Communications/oral proceedings after resumption	177
	4.7.1.1 Higher-ranking request not admissible and/or not allowable	177
	4.7.2 Agreement reached on a text - 2nd R.71(3) communication	177
	4.7.3 No agreement reached on a text - refusal	177
	4.8 Fees to be paid within 2nd R.71(3) period	177
	4.8.1 Claims fees	178
	4.8.2 Fee for grant & publishing	178
	4.9 Reply explicitly disapproving proposed text without indicating alternative	178
#	4.10 Amendments/corrections filed in 2nd R.71(3) period	178
	5 Further requests for amendment after approval	179
	6 Exam. div. resume examination after approval of text	179
	6.1 When does exam. div. resume examination after approval of text?	179
	6.2 A further communication under R.71(3)	179
	6.3 Crediting of fees under R.71a(5)	179
	7 Correction of errors in decision to grant	179
	8 Further processing (FP)	179
	9 Refund of fee for grant & publishing	179
	10 Publication of patent specification	179
	11 Withdrawal before publication of patent specification	180
	12 Certificate	180

Major changes

2021	2022	2023		Page
			<b>E-III Oral proceedings</b>	220
#	#		1 General	221
			1.1 Introduction	221
#			1.2 Format of oral proceedings	221
#			1.3 Request for oral proceedings to be held on EPO premises	221
#			1.4 Request to hold on-site oral proceedings at a particular site	221
			2 Oral proceedings at request of party	221
			2.1 Request for oral proc. by opponent whose opposition is inadmissible or deemed not filed	222
			3 Request for further oral proceedings	222
			4 Oral proceedings at instance of EPO	222
			5 Preparation of oral proceedings	222
			5.1 When can summons to oral proc. be issued in substantive examination?	223
#			6 Summons to oral proceedings	223
			7 Change of date, cancellation or maintenance of oral proceedings	223
			7.1 Changing date of oral proceedings	224
			7.1.1 Requests to change date of oral proceedings	224
			7.1.2 Change of date of oral proceedings at instigation of Division	224
			7.1.3 Change of date of oral proceedings - defined notice period	224
			7.2 Cancellation or maintenance of oral proceedings	224
			7.2.1 General	224
#			7.2.2 Withdrawal of request for oral proceedings	224
			8 Conduct of oral proceedings	225
			8.1 Admission of public to proceedings	225
#	#		8.2 Conduct of oral proceedings	225
#	#		8.2.1 Participation of parties and their representatives from different locations	225
#	#		8.2.2 Participation of members of the division from different locations	225
#	#		8.2.3 Technical problems	225
#	#		8.2.4 Recording	226
#			8.3 Opening of oral proceedings: non-appearance of a party	226
#	#		8.3.1 Checking identity & authorisations of participants at oral proceedings	226
			8.3.2 Opening oral proceedings	227
			8.3.3 Late arrival, non-appearance and failure to connect	227
#			8.3.3.1 General	227
			8.3.3.2 Procedure in opposition proceedings	227
			8.3.3.3 Procedure in examination proceedings	227
			8.4 Opening of substantive part of proceedings	228
			8.5 Submissions by parties	228
#			8.5.1 Use of computer-generated slideshows in oral proceedings	228
			8.5.1.1 Opposition proceedings (inter partes)	228
			8.5.1.2 Examination proceedings (ex parte)	229
#	#		8.5.2 Written submissions during oral proceedings by videoconference	229
#			8.6 Facts, evidence or amendments introduced at a late stage	230
			8.7 Handwritten amendments in oral proceedings	230
#			8.7.1 General principles	230
#			8.7.2 Procedure in examination proceedings	230
#			8.7.3 Procedure in opposition proceedings	230
			8.8 Use of R.137(4) for amendments filed during oral proc. in examination	231
			8.9 Discussion of facts and of legal position	231
			8.10 Right of other members of division to put questions	231
#			8.11 Closure of oral proceedings	231
			8.11.1 Requesting postponement during oral proceedings	232
#			8.11.2 Adjournment of oral proceedings due to lack of time	232
			9 Delivery of decision	232
			10 Minutes of oral proceedings	232
#			10.1 Formal requirements	233
			10.2 Language	233
			10.3 Subject-matter of minutes	233
#			10.4 Request for correction of minutes	234

Major changes

2021	2022	2023		Page
			<b>G-VII Inventive step (cont.)</b>	
			5 Problem-solution approach	382
#			5.1 Determination of closest prior art	382
#			5.2 Formulation of objective technical problem	383
			5.3 Could-would approach	383
#			5.4 Claims comprising technical & non-technical features	384
#			5.4.1 Formulation of objective technical problem with technical & non-technical features	385
#			5.4.2 Examples of applying COMVIK approach	385
			5.4.2.1 Example 1	385
			5.4.2.2 Example 2	386
			5.4.2.3 Example 3	387
#			5.4.2.4 Example 4	388
#	#		5.4.2.5 Example 5	389
			6 Combining pieces of prior art	390
			7 Combination vs. juxtaposition or aggregation	391
			8 "Ex post facto" analysis	391
			9 Origin of an invention	391
			10 Secondary indicators	392
			10.1 Predictable disadvantage; non-functional modification; arbitrary choice	392
			10.2 Unexpected technical effect; bonus effect	392
			10.3 Long-felt need; commercial success	392
			11 Arguments & evidence submitted by applicant	392
			12 Selection inventions	392
			13 Inventive step assessment in biotechnology	393
			14 Dependent claims; claims in different categories	393
			15 Examples	393
			Ann Examples relating to requirement of inventive step – indicators	393
			Ann 1 Application of known measures?	393
			Ann 1.1 ... in an obvious way and an inventive step is therefore to be ruled out	393
			Ann 1.2 ... in a non-obvious way and an inventive step is therefore to be recognised	394
			Ann 2 Obvious combination of features?	394
			Ann 2.1 Obvious and consequently non-inventive combination	394
			Ann 2.2 Not obvious and consequently inventive combination	394
			Ann 3 Obvious selection?	394
			Ann 3.1 Obvious and consequently non-inventive selection among a number of known possibilities	394
			Ann 3.2 Not obvious and consequently inventive selection among a number of known possibilities	395
			Ann 4 Overcoming a technical prejudice?	395

**H: AMENDMENTS AND CORRECTIONS** 397

			<b>H-I Right to amend</b>	397
			<b>H-II Admissibility of amendments – general rules</b>	397
			1 Introduction	397
			2 Admissibility in examination procedure	397
			2.1 Before receipt of SR under R.137(1)	397
			2.2 After receipt of SR under R.137(2)	397
			2.3 After receipt of 1st communication under R.137(3)	397
			2.3.1 Examples of exercise of discretion under R.137(3)	398
#			2.3.1.1 R.137(3) in conjunction with A.83	398
			2.3.1.2 R.137(3) in conjunction with A.123(2)	398
			2.3.1.3 R.137(3) in conjunction with A.84 - missing essential feature	398
			2.3.1.4 R.137(3) in conjunction with auxiliary requests	399

# A FORMALITIES EXAMINATION

## A-I Introduction

### A-I 1 Overview

This **Part A of the Guidelines** deals with the following:

- (i) the requirements and procedure relevant to the examination as to formalities of European patent applications (Chapters **A-II** to **VI**);
- (ii) formalities matters of a more general nature which can arise during the application procedure or the post-grant stage (Chapters **A-VII** and **VIII**),
- (iii) the presentation and execution of drawings and figurative representations accompanying a European patent application (Chapter **A-IX**);
- (iv) fee questions (Chapter **A-X**);
- (v) inspection of files, communication of information contained in files, consultation of the Register of European Patents and issuance of certified copies (Chapter **A-XI**).

### A-I 2 Responsibility for formalities examination

The matters covered by this **Part A** are directed to the formalities staff of the EPO whether they be in The Hague, Munich or Berlin. They are directed primarily to the Receiving Section which is specifically responsible under the EPC for ensuring that the formal requirements for European patent applications are adhered to. Once the application is transferred to the examining division, the latter accepts responsibility for the formalities of the application, although it should be understood that reference to the examining division is intended to cover the formalities officer to whom this work is entrusted (see the Decision of the President of the EPO dated 12 December 2013, **OJ EPO 2014, A6**, the Decision of the President of the EPO dated 23 November 2015, **OJ EPO 2015, A104**, and the Decision of the President of the EPO dated 14 June 2020, **OJ EPO 2020, A80**). **Rule 10 Rule 11(3)**

### A-I 3 Purpose of Part A

The formalities staff should note that this **Part A of the Guidelines** is intended to provide them with the knowledge and background which it is felt will assist them in carrying out their functions in a uniform and expeditious manner. It does not, however, provide authority for ignoring the provisions of the EPC and in that regard specific attention is directed to **paragraph 3 of the General Part of the Guidelines**.

### A-I 4 Other Parts relating to formalities

It is not the intention that the formalities staff should concern themselves with only this **Part A of the Guidelines**. It is expected that they will have to refer frequently to the other Parts and in particular **Part E**.

## A-II Filing of applications and examination on filing

### A-II 1 Where and how applications may be filed

European patent applications must be filed in writing. They may be filed by delivery by hand, by postal services (see **A-II, 1.1**) or by means of electronic communication (see **A-II, 1.2**). **Rule 1 Rule 2(1)**

#### A-II 1.1 Filing of applications by delivery by hand or by postal services

European patent applications may be filed by delivery by hand or by postal services at the EPO's filing offices in Munich, The Hague or Berlin. The EPO's sub-office in Vienna is not a filing office, nor is the Brussels Bureau. **Art. 75(1) Rule 35(1)**

The opening hours of the filing offices of the EPO were published in the Notice from the EPO dated 14 February 2018, **OJ EPO 2018, A18**. Dates on which at least one of them is not open to receive documents are likewise announced at regular intervals in the Official Journal of the EPO (see also **E-VIII, 1.4**). The filing offices of the EPO may remain open during public holidays observed in the contracting states in which they are located. Since mail is not delivered on these days (see also **E-VIII, 1.4**), applications may be filed by delivery by hand or using other permitted means of filing (see **A-II, 1.2; A-II, 1.3**).

The EPO filing offices in Berlin and Munich (only the PschorrHöfe building, see the Decision of the President of the EPO dated 3 January 2017, **OJ EPO 2017, A11**) are equipped with automated mailboxes, which may be used at any time. The automated mailbox facility is currently not available at the filing offices at Munich's Isar building and The Hague. Outside office hours documents may be handed in to the porter.

European patent applications (with the exception of divisional applications, see **A-IV, 1.3.1** and applications according to **Art. 61(1)(b)**, see **A-IV, 2.5**) may also be filed at the central industrial property office or other competent authority of a contracting state if the national law of that state so allows (see **A-II, 1.6**).

#### A-II 1.2 Filing of applications by means of electronic communication

With regard to Euro-PCT applications (type (iii)), see [E-IX, 2.1.4](#).

For the reduction of the filing fee under the language arrangements, see [A-X, 9.2.1](#) and [9.2.2](#). [Rule 6\(3\)](#) to [\(7\)](#)

### A-III 13.2 Additional fee (if application documents comprise more than thirty-five pages)

This section relates only to applications filed and international applications entering the European phase on or after 1 April 2009 (see also the notice from the EPO dated 26 January 2009, OJ EPO 2009, 118, and the supplement thereto, OJ EPO 2009, 338). [Rule 38\(2\)](#) and [\(3\)](#) [Art. 2\(1\), item 1a, Rfees](#) [Rule 49](#)

#### *EP-direct applications*

An additional fee is payable as part of the filing fee for European patent applications which are filed on or after 1 April 2009 and comprise more than thirty-five pages. The amount of the fee is calculated according to the number of pages over thirty-five. The language reduction under [Rule 6\(3\)](#) applies if the requirements of [Rule 6\(4\)](#), [\(6\)](#) and [\(7\)](#) have been met (see [A-X, 9.2.1](#) and [A-X, 9.2.2](#)). The additional fee is payable within one month of the filing date of the application or of the date of receipt of a European divisional application or a European application according to [Art. 61\(1\)\(b\)](#). If the application is filed without claims or by reference to a previously filed application, the additional fee is payable within one month of filing the first set of claims or one month of filing the certified copy of the application referred to in [Rule 40\(3\)](#), whichever expires later. The additional fee is calculated on the basis of the pages of the description, claims, any drawings and one page for the abstract, in the language of filing. Where formal deficiencies in the documents making up the European patent application need to be corrected, the number of pages complying with the physical requirements (see [A-III, 3](#) and [A-IX](#)) is taken as the basis for calculation. In particular those deficiencies relating to the minimum margins, the start on a new sheet of each document making up the application, line-spacing and character size as well as the scale of drawings potentially have an impact on the number of pages (see the decision of the President of the EPO dated 25 November 2022). Where this is the case, any additional fee due for the higher number of pages may be paid within two months of the invitation pursuant to [Rule 58](#) drawing the applicant's attention to this requirement.

The pages of the request for grant (EPO Form 1001) and those forming part of a sequence listing within the meaning of [Rule 30\(1\)](#) are not counted, provided the sequence listing contained in the description is filed in XML format, in compliance with WIPO Standard ST.26 (see [OJ EPO 2021, A97](#)). If the application is filed by reference to a previously filed application, the pages of the certified copy, excluding those for the certification and for bibliographic data, are taken as the basis for the calculation. If the application is filed without claims, the additional fee takes account of the pages of the first set of claims filed.

Where missing parts are filed under [Rule 56](#) (see [A-II, 5](#)) or correct application documents are filed under [Rule 56a](#) (see [A-II, 6](#)), the additional fee is calculated on the basis of the documents present at expiry of the time limit under [Rule 38\(3\)](#).

#### *Euro-PCT applications*

For international (Euro-PCT) applications entering the European phase on or after 1 April 2009, the additional fee is payable as part of the filing fee within the 31-month period of [Rule 159\(1\)](#). It is calculated on the basis of the international application as published (even if published in a non-EPO language), any amended claims under [Art. 19 PCT](#), which replace the claims as originally filed unless specified to the contrary (see [OJ EPO 2017, A74](#)), and one page for the abstract. If there is more than one page of bibliographic data, the further pages are not counted. The pages of the latest set of any amended documents ([Art. 34 PCT](#), amendments filed upon entry) on which European phase processing is to be based ([Rule 159\(1\)\(b\)](#)) will also be taken into account where available to the EPO by the date of payment of the additional fee within the thirty-one months. Any amended pages are added to the calculation of the page fee unless the applicant clearly specifies, at the latest by the date of payment, the amended pages which are to replace the corresponding pages of the application as published (see also [E-IX, 2.1.1](#)). This information should preferably be given in the relevant section of the form for entry into the European phase, and in particular in the related table (see notes on EPO Form 1200). If the applicant explicitly states that application documents filed on entry into the European phase have merely been reformatted (so as to reduce the number of pages subject to payment of an additional fee) rather than substantively amended, the EPO disregards these reformatted application documents and does not accept them as the basis for calculation of the additional fee (see the notice from the EPO dated 26 January 2009, OJ EPO 2009, 118, and the supplement thereto, OJ EPO 2009, 338).

Any replacement pages must be filed in an official language of the EPO. Where the international application has not been published in an official language of the EPO, the additional fee for any amended description or drawings will be based on the translation of the international application filed on entry into the European phase (see [E-IX, 2.1.4](#)). Where claims are replaced, they must be submitted as an entire new set of claims. The additional fee is then calculated on the basis of the amended claims set in the EPO language (OJ EPO 2009, 338).

EPO Form 1200 is disregarded in the calculation of the additional fee.

The pages of any WIPO Standard ST.25-compliant sequence listing in TXT format filed as part of the description are disregarded when calculating the additional fee for Euro-PCT applications with an international filing date prior to 1 July 2022. If the international filing date is on or after 1 July 2022, the pages of a WIPO Standard ST.26-compliant sequence listing in XML format are disregarded.

In application of the general principles described above, for international applications comprising both erroneously filed application documents and correct application documents incorporated by reference ([Rule 20.6 PCT](#) in conjunction with [Rule 20.5bis\(d\) PCT](#)), irrespective of their date of filing (see [OJ EPO 2020, A81](#) and [OJ EPO 2022, A71](#); see also [C-III, 1.3](#)),



Unlike the time limit for other cases as described above, a request for re-establishment in respect of the priority period (**Art. 87(1)**) or the period for filing a petition for review by the Enlarged Board of Appeal (**Art. 112a(4)**) must be filed within two months of expiry of the relevant period.

A request for re-establishment is not deemed to be filed until after the fee for the re-establishment of rights has been paid.

The principles regarding unitary and independent procedural acts described in **E-VIII, 2**, apply *mutatis mutandis* to establishing the number of requests for re-establishment of rights, in particular for establishing the relevant fees to be paid. Where one unitary procedural act is omitted by not performing one or more actions forming that act, only one fee for re-establishment is due. Where several independent procedural acts are omitted, each resulting in the application being deemed withdrawn, a fee for re-establishment is due for each omitted act.

These principles also apply to cases where re-establishment of rights must be requested in respect of the time limit(s) for requesting further processing (see **Rule 136(3)**). In such cases, the number of unobserved time limits, each resulting in the application being deemed withdrawn and requiring a request for further processing, determines the number of requests for re-establishment and the corresponding number of fees for re-establishment.

*Example:*

An international application comprises more than 35 pages and was published in a language other than an official language of the EPO. The acts required for entry into the European phase upon expiry of the 31-month period under **Rule 159(1)** were omitted. Due to their different legal nature, the individual acts required under **Rule 159(1)** do not form a unitary procedural step but are legally independent and subject to independent time limits. The table below provides a schematic illustration regarding further processing and re-establishment of rights (for information on the remedies available for non-observance of the time limits under **Rule 159(1)**, see the individual sections under **E-IX, 2**).

Box I of the table lists the number of independent unobserved time limits. Box II indicates the fee for further processing corresponding to each unobserved time limit. Box III provides the fee for re-establishment corresponding to each unobserved time limit.

In the example, for a request for further processing to be allowed, completion of the omitted acts (i.e. all acts that were to be performed within the 31-month period) and payment of five fees for further processing (two of which comprise two fees) are required within the two-month period under **Rule 135(1)**. If that period is missed, the applicant may request re-establishment of rights in respect of the period. The request requires completion of the omitted acts and payment of the corresponding number of fees for re-establishment of rights within the period under **Rule 136(1)**. The omitted acts are those that were to be performed within the 31-month period and payment of the corresponding five fees for further processing. Payment of five fees for re-establishment of rights corresponds to the number of five independent fees for further processing.

Omitted acts	Time limits missed (box I)	Number of fees for further processing (box II)	Number of fees for re-establishment (box III)
Filing of the translation	1	1	1
Payment of the filing fee	1 (unitary)	1 (comprising 50% of the filing fee and 50% of the additional fee)	1
Payment of the additional fee for an application comprising more than 35 pages			
Payment of the designation fee	1	1	1
Payment of the search fee	1	1	1
Filing of the request for examination	1 (unitary)	1 (comprising a flat fee and 50% of the examination fee)	1
Payment of the examination fee			
Resulting number of fees to be paid	5 non-observed time limits	5 fees for further processing, 2 of them comprising 2 fees	5 fees for re-establishment

#### E-VIII 3.1.4 Substantiation of the request

The request must state the grounds on which it is based, and must set out the facts on which it relies. Thus, it must set forth the precise cause of non-compliance with the time limit concerned (i.e. the fact or obstacle preventing the required action within the time limit), specify at what time and under which circumstances the cause occurred and was removed, and present the core facts making it possible to consider whether all due care required by the circumstances had been taken in order to comply with the time limit concerned (see **J 15/10**). General statements with no indication of the concrete facts or events that caused the time limit to be missed do not satisfy the requirement for a duly substantiated request under **Rule 136(2)**.

Once the time limit for filing the request for re-establishment has expired, the requester may clarify or supplement the alleged facts and, where appropriate, submit further evidence. However, the requester cannot alter the factual basis on which the original request for re-establishment had been based (see **J 5/94**). Any new facts introduced at this stage are not admissible and are, therefore, not taken into consideration by the deciding instance.

#### E-VIII 3.2 Merit of the request

**F-II 1.3 Prefixes and their symbols used to designate certain decimal multiples and submultiples**

Factor	Prefix	Symbol	Factor	Prefix	Symbol
10 <sup>24</sup>	yotta	Y	10 <sup>-1</sup>	deci	d
10 <sup>21</sup>	zetta	Z	10 <sup>-2</sup>	centi	c
10 <sup>18</sup>	exa	E	10 <sup>-3</sup>	milli	m
10 <sup>15</sup>	peta	P	10 <sup>-6</sup>	micro	μ
10 <sup>12</sup>	tera	T	10 <sup>-9</sup>	nano	n
10 <sup>9</sup>	giga	G	10 <sup>-12</sup>	pico	p
10 <sup>6</sup>	mega	M	10 <sup>-15</sup>	femto	f
10 <sup>3</sup>	kilo	k	10 <sup>-18</sup>	atto	a
10 <sup>2</sup>	hecto	h	10 <sup>-21</sup>	zepto	z
10 <sup>1</sup>	deca	da	10 <sup>-24</sup>	yocto	y

The names and symbols of the decimal multiples and submultiples of the unit of mass are formed by attaching prefixes to the word "gram" and their symbols to the symbol "g".

Where a derived unit is expressed as a fraction, its decimal multiples and submultiples may be designated by attaching a prefix to units in the numerator or the denominator, or in both these parts.

Compound prefixes, that is to say prefixes formed by the juxtaposition of several of the above prefixes, may not be used.

**F-II 1.4 Special authorised names and symbols of decimal multiples and submultiples of SI units**

Quantity	Unit		
	Name	Symbol	Value
Volume	litre	l or L <sup>(1)</sup>	1 l = 1 dm <sup>3</sup> = 10 <sup>-3</sup> m <sup>3</sup>
Mass	tonne	t	1 t = 1 Mg = 10 <sup>3</sup> kg
Pressure, stress	bar	bar	1 bar = 10 <sup>5</sup> Pa
Length	Ångström	Å	1 Å = 10 <sup>-10</sup> m

(1) The two symbols "l" and "L" may be used for the litre unit.

The prefixes and their symbols listed in **F-II, Annex 2, 1.3** may be used in conjunction with the units and symbols contained in this table.

**F-II 2 Units which are defined on the basis of SI units but are not decimal multiples or submultiples thereof**

Quantity	Unit		
	Name	Symbol	Value
Plane angle	revolution <sup>(a)</sup>		1 revolution = 2 π rad
	grade or gon	gon	1 gon = π / 200 rad
	degree	°	1° = π / 180 rad
	minute of angle	'	1' = π / 10 800 rad
	second of angle	"	1" = π / 648 000 rad
Time	Minute	min	1 min = 60 s
	Hour	h	1 h = 3 600 s
	Day	d	1 d = 86 400 s

(a) No international symbol exists

The prefixes listed in **F-II, Annex 2, 1.3** may only be used in conjunction with the names "grade" or "gon" and the symbols only with the symbol "gon".

**F-II 3 Units used with the SI, and whose values in SI are obtained experimentally**

The unified atomic mass unit is 1/12 of the mass of an atom of the nuclide <sup>12</sup>C.

The electronvolt is the kinetic energy acquired by an electron passing through a potential difference of 1 volt in a vacuum.

Quantity	Unit		
	Name	Symbol	Value
Mass	unified atomic mass unit	u	1 u ≈ 1,6605655 x 10 <sup>-27</sup> kg
Energy	Electronvolt	eV	1eV ≈ 1,6021892 x 10 <sup>-19</sup> J

The value of these units, expressed in SI units, is not known exactly.

The prefixes and their symbols listed in **F-II, Annex 2, 1.3** may be used in conjunction with these two units and with their symbols.

**F-II 4 Units and names of units permitted in specialised fields only**

Quantity	Unit		
	Name	Symbol	Value
Vergency of optical systems	dioptré		1 dioptré = 1 m <sup>-1</sup>
Mass of precious stones	metric carat		1 metric carat = 2 x 10 <sup>-4</sup> kg
Area of farmland and building land	are	a	1 a = 10 <sup>2</sup> m <sup>2</sup>
Mass per unit length of textile yarns and threads	tex	tex	1 tex = 10 <sup>-6</sup> kg.m <sup>-1</sup>

## **J LIST OF SECTIONS AMENDED IN THIS REVISION**

The amendments introduced are intended to remove potential misinterpretations of the EPO practice. These amendments have been extensively discussed with external and internal users with the aim to clarify how the established practice is applied. This work will continue in future editions of the Guidelines, for example by including further examples to illustrate the practice.

### MAJOR AMENDMENTS

<b>PART A</b>	<u><a href="#">A-II, 4.1.5</a></u> ; <u><a href="#">A-II, 5.1</a></u> ; <u><a href="#">A-II, 5.2</a></u> ; <u><a href="#">A-II, 5.4</a></u> ; <u><a href="#">A-II, 5.4.1</a></u> ; <u><a href="#">A-II, 5.4.2</a></u> ; <u><a href="#">A-II, 6</a></u> ; <u><a href="#">A-II, 6.1</a></u> ; <u><a href="#">A-II, 6.2</a></u> ; <u><a href="#">A-II, 6.3</a></u> ; <u><a href="#">A-II, 6.4</a></u> ; <u><a href="#">A-II, 6.4.1</a></u> ; <u><a href="#">A-II, 6.4.2</a></u> ; <u><a href="#">A-II, 6.4.3</a></u> ; <u><a href="#">A-II, 6.5</a></u> ; <u><a href="#">A-II, 6.6</a></u> ; <u><a href="#">A-II, 6.7</a></u> ; <u><a href="#">A-II, 6.8</a></u> ; <u><a href="#">A-II, 6.9</a></u> ; <u><a href="#">A-III, 3.2.2</a></u> ; <u><a href="#">A-III, 6.5.1</a></u> ; <u><a href="#">A-III, 6.7</a></u> ; <u><a href="#">A-III, 6.8.4</a></u> ; <u><a href="#">A-III, 9</a></u> ; <u><a href="#">A-IV, 1.1</a></u> ; <u><a href="#">A-V, 3</a></u> ; <u><a href="#">A-VI, 1.3</a></u> ; <u><a href="#">A-XI, 2.1</a></u> ;	Updated or new sections in view of amended <b>Rule 56</b> , new <b>Rule 56a</b> and the withdrawal of the notification of the partial incompatibility with <b>Rule 20.5bis PCT (OJ EPO 2022, A3, OJ EPO 2022, A71)</b> .
	<u><a href="#">A-II, 5.5</a></u> ; <u><a href="#">A-III, 3.2</a></u> ; <u><a href="#">A-III, 3.2.1</a></u> ; <u><a href="#">A-III, 3.3</a></u> ; <u><a href="#">A-III, 16.1</a></u> ; <u><a href="#">A-VIII, 2.1</a></u> ; <u><a href="#">A-VIII, 2.3</a></u> ; <u><a href="#">A-IX, 1.1</a></u> ; <u><a href="#">A-IX, 1.2</a></u> ; <u><a href="#">A-IX, 3</a></u> ; <u><a href="#">A-IX, 4.2</a></u> ; <u><a href="#">A-IX, 7.1</a></u> ; <u><a href="#">A-IX, 7.5.1</a></u> ; <u><a href="#">A-IX, 7.5.4</a></u> ; <u><a href="#">A-IX, 8</a></u> ; <u><a href="#">A-IX, 11.2.1</a></u> ;	Updated sections reflecting the legal changes as decided by the Administrative Council CA/30/22 rev. 2 to support the digital transformation in the PGP
	<u><a href="#">A-III, 12.1</a></u>	Updated in view of Montenegro's accession to the EPC
	<u><a href="#">A-III, 13.2</a></u> ;	Updated sections in view of amended <b>Rule 56</b> , new <b>Rule 56a</b> and the withdrawal of the notification of the partial incompatibility with <b>Rule 20.5bis PCT (OJ EPO 2022, A3, OJ EPO 2022, A71)</b> ; the legal changes as decided by the Administrative Council CA/30/22 rev. 2 to support the digital transformation and the entry into force of WIPO Standard 26 ( <b>OJ EPO 2021, A97</b> ).
	<u><a href="#">A-IV, 5</a></u> ; <u><a href="#">A-IV, 5.2</a></u> ; <u><a href="#">A-IV, 5.3</a></u> ; <u><a href="#">A-IV, 5.4</a></u> ;	Updated sections in view of the entry into force of WIPO Standard 26 ( <b>OJ EPO 2021, A96, A97</b> ).
<b>PART B</b>	<u><a href="#">B-III, 3.3</a></u> ; <u><a href="#">B-III, 3.3.1</a></u> ; <u><a href="#">B-XI, 2.1</a></u>	Updated sections in view of amended <b>Rule 56</b> , new <b>Rule 56a</b> and the withdrawal of the notification of the partial incompatibility with <b>Rule 20.5bis PCT (OJ EPO 2022, A3, OJ EPO 2022, A71)</b> .
	<u><a href="#">B-IV, 1.2</a></u> ; <u><a href="#">B-IV, 3.3</a></u> ; <u><a href="#">B-VI, 6.3</a></u> ; <u><a href="#">B-X, 9.1.2</a></u> ; <u><a href="#">B-X, 9.1.3</a></u> ; <u><a href="#">B-X, 11</a></u> ; <u><a href="#">B-X, 11.1</a></u> ; <u><a href="#">B-X, 11.2</a></u> ; <u><a href="#">B-X, 11.3</a></u> ; <u><a href="#">B-X, 11.5</a></u> ; <u><a href="#">B-X, 12</a></u> ; <u><a href="#">B-XI, 3</a></u>	Updated sections reflecting the legal changes as decided by the Administrative Council CA/30/22 rev. 2 to support the digital transformation.
	<u><a href="#">B-X, 11.6</a></u>	Updated practice concerning citation of video/audio fragments from the internet.
<b>PART C</b>	<u><a href="#">C-III, 1.1.1</a></u> ; <u><a href="#">C-III, 1.3</a></u>	Updated sections in view of amended <b>Rule 56</b> , new <b>Rule 56a</b> and the withdrawal of the notification of the partial incompatibility with <b>Rule 20.5bis PCT (OJ EPO 2022, A3, OJ EPO 2022, A71)</b> .
	<u><a href="#">C-III, 5</a></u>	Updated practice of summoning to oral proceedings as first action in examination in the case of divisionals identical to a refused parent.
	<u><a href="#">C-IV, 7.2</a></u>	Updated practice in view of the top-up search for national prior rights
	<u><a href="#">C-V, 1.1</a></u>	Updated sections reflecting the legal changes as decided by the Administrative Council CA/30/22 rev. 2 to support the digital transformation.
<b>PART D</b>	<u><a href="#">D-III, 3.1</a></u> ; <u><a href="#">D-III, 5</a></u> ; <u><a href="#">D-VII, 4.3</a></u>	Updated sections reflecting the legal changes decided by the Administrative Council CA/30/22 rev. 2 to support the digital transformation.
<b>PART E</b>	<u><a href="#">E-II, 2.3</a></u> ; <u><a href="#">E-II, 2.4</a></u> ; <u><a href="#">E-III, 8.7.2</a></u> ; <u><a href="#">E-XII, 7.4.4</a></u>	Updated sections reflecting the legal changes as decided by the Administrative Council CA/30/22 rev. 2 to support the digital transformation.

# K ALPHABETICAL KEYWORD INDEX

## A

**Abandonment of claims** [B-III, 3.4](#)

**Abandonment of subject-matter** [C-IX, 1.3](#)

**Abbreviations** [General Part, 2.2](#)

**Absence of well-known details** [F-III, 5.2](#)

**Abstract** [A-III, 10](#), [A-III, 10.1](#), [A-III, 16.2](#), [E-IX, 2.3.10](#), [F-II, 1](#), [F-II, 2](#), [F-II, 2.2](#), [F-II, 2.7](#), [G-IV, 5.1](#)

**Abstract in examination** [F-II, 2.7](#)

Checklist [F-II, 2.5](#)

Checklist for considering the abstract [F-II, An. 1](#)

Conflict between abstract and source document [B-VI, 6.3](#)

Conflict with other European applications [G-IV, 5.1](#)

Content of a European patent application (other than claims) [F-II, 2](#)

Content of the abstract [A-III, 10.2](#), [F-II, 2.3](#)

Definitive content [A-III, 10.2](#), [B-X, 7](#), [F-II, 2.2](#)

Examination of formal requirements [A-III, 10](#)

Figure accompanying the abstract [A-III, 10.3](#), [F-II, 2.4](#)

Instructions in Chapter [A-III](#)

("Examination of formal requirements") [E-IX, 2.3.10](#)

Purpose of the abstract [F-II, 2.1](#)

Summaries, extracts or abstracts [B-X, 11.5](#)

Title, abstract and figure(s) to be published with the abstract (as indicated on supplemental sheet A) [B-X, 7](#)

Transmittal of the abstract to the applicant [F-II, 2.6](#)

### Accelerated

Accelerated processing before the boards of appeal [E-VIII, 6](#)

Accelerated processing of oppositions [E-VIII, 5](#)

Accelerated prosecution of European patent applications [E-VIII, 4](#)

Accelerated examination [E-VIII, 4.2](#)

Accelerated search [E-VIII, 4.1](#)

Patent Prosecution Highway (PPH) [E-VIII, 4.3](#)

**Access to EPO documentation for the national patent offices** [B-IX, 5](#)

**Accorded date of filing and content of the application still subject to review** [G-IV, 5.1.2](#)

**Account of the search** [B-X, 3.3](#)

### Accounts

Debit orders for deposit accounts held with the EPO [A-II, 1.5](#)

Deposit accounts with the EPO [A-X, 4.2](#)

Safety provision for late replenishment of deposit accounts [A-X, 6.2.2](#)

**Activity of the opposition division** [D-IV, 2](#)

**Adaptation of the description** [C-V, 4.5](#)

### Additional

Additional European searches [B-II, 4.2](#)

#### Additional fee

Additional fee (if application documents comprise more than thirty-five pages) [A-III, 13.2](#)

Additional fee for a European patent application [A-III, 13.2](#)

Additional fee for divisional applications of second or subsequent generations [A-IV, 1.4.1.1](#)

#### Additional fee for divisional applications

[A-III, 13.3](#)

Additional fee for divisional applications of second or subsequent generations [A-IV, 1.4.1.1](#)

#### Additional fee for pages

[A-II, 5.6](#), [A-II, 6.8](#)

Correction of erroneously filed application documents or parts [A-II, 6.8](#)

Late filing of missing drawings or missing parts of the description [A-II, 5.6](#)

#### Additional search

[D-VI, 5](#)

Applicant has not paid all additional search fees [B-VII, 1.2.3](#)

Invitation to pay additional search fees combined with invitation to restrict the scope of the search [C-III, 3.2.3](#)

Limitation to searched invention no additional search fees paid [C-III, 3.2.1](#)

Refund of additional search fees [C-III, 3.4](#)

#### Additional search fees paid

[C-III, 3.2.2](#)

Limitation to searched invention no additional search fees paid [C-III, 3.2.1](#)

Additional searches during examination [C-IV, 7.3](#)

**Adherence to the text of the European patent submitted or approved by the patent proprietor** [D-VI, 2](#)

Basis for the examination [D-VI, 2.1](#)

Revocation of the patent [D-VI, 2.2](#)

**Adjournment of oral proceedings due to lack of time** [E-III, 8.11.2](#)

**Administrative fees** [A-XI, 1](#), [A-XI, 2.2](#), [E-XIV, 3](#)

**Administrative structure** [D-II, 1](#)

**Admissibility** [H-VI, 2.1](#), [H-VI, 3.1](#)

**Admissibility in opposition and limitation proceedings** [H-VI, 2.1.1](#)

Errors in the description, claims and drawings [H-VI, 2.1.1.1](#)

**Admissibility in opposition procedure** [H-II, 3](#)

Amendments in reply to the notice of opposition [H-II, 3.1](#)

Amendments not related to the grounds for opposition [H-II, 3.2](#)

Amendments occasioned by national rights [H-II, 3.3](#)

Insistence on unallowable amendments [H-II, 3.4](#)

Late-filed requests in opposition proceedings [H-II, 3.5](#)

**Admissibility in the examination procedure** [H-II, 2](#)

Admissibility in the examination procedure after receipt of the search report - **Rule 137(2)** [H-II, 2.2](#)

Admissibility in the examination procedure at an advanced stage of the proceedings [H-II, 2.4](#)

Admissibility in the examination procedure before receipt of the search report - **Rule 137(1)** [H-II, 2.1](#)

Admissibility in the examination procedure further requests for amendment after approval [H-II, 2.6](#)

Amendments filed in reply to a **Rule 71(3)** communication [H-II, 2.5](#)

Late-filed requests after summons to oral proceedings in examination [H-II, 2.7](#)

**Admissibility in the examination procedure after receipt of the first communication** - **Rule 137(3)** [H-II, 2.3](#)

Examples of the exercise of discretion under **Rule 137(3)** [H-II, 2.3.1](#)

**Admissibility of amendments** [C-V, 4.4](#), [H-II, H-III](#)

# Indexed Unitary Patent Guide (Apr 22)

Major changes

x x  
2022

		<b>Page</b>
<b>A : GENERAL PART</b>		<b>499</b>
	<b>FOREWORD</b>	499
	<b>I Introduction</b>	499
	1 Introduction	499
#	<b>II Legal framework</b>	499
# 6	2x EU regulations adopted under enhanced cooperation	499
# 7	"Participating Member States"	500
# 10	Agreement on Unified Patent Court	500
# 15	Secondary legislation	500
	<b>III Unitary Patents: concept</b>	501
18	Unitary Patent architecture	501
20	Figure: Overview of Unitary Patent procedure	501
21	Uniform protection and equal effect	501
22	When and for which EP patents can Unitary Patent be requested?	501
23	Territorial scope of a Unitary Patent	501
	<b>IV Unitary Patent: additional option enhancing EP patent system</b>	502
27	Unitary Patent: additional option enhancing EP patent system	502
#	<b>V Benefits of Unitary Patent</b>	502
31	Benefits of Unitary Patent	502
38	Table: Renewal fees for Unitary Patent	503
	<b>VI EPO's Unitary Patent Protection Division</b>	503
41	Introduction	503
43	Decisions of Unitary Patent Protection Division	503
<b>B : HOW TO OBTAIN UNITARY PATENT</b>		<b>505</b>
#	<b>I Requirements</b>	505
# 44	Requirements	505
	<b>II Request for unitary effect</b>	505
45	Form and time limit	505
52	Mandatory information to be provided in request for unitary effect	505
# 53	Voluntary indication of place of business on date of filing of EP appln (A.7(1)(b) Regulation (EU) No 1257/2012 and R.16(1)(w) UPR)	506
56	Translation of EP patent	506
	<b>III Filing request for unitary effect</b>	506
62	Language of request for unitary effect	506
63	How and where to file request for unitary effect	507
65	Acknowledgement of receipt	507
67	Re-establishment of 1-month period for requesting unitary effect	507
68	Withdrawal of request for unitary effect	507
	<b>IV Examination of request for unitary effect by EPO</b>	507
69	Examination of request for unitary effect by EPO	507
70	Figure: Registration of unitary effect	508
	<b>V Filing documents other than request for unitary effect</b>	508
71	Filing documents other than request for unitary effect	508
74	Acknowledgement of receipt	508

## Indexed Unitary Patent Guide

	EUR		EUR
2nd year	35	11th year	1 460
3rd year	105	12th year	1 775
4th year	145	13th year	2 105
5th year	315	14th year	2 455
6th year	475	15th year	2 830
7th year	630	16th year	3 240
8th year	815	17th year	3 640
9th year	990	18th year	4 055
10th year	1 175	19th year	4 455
		20th year	4 855

- Additional fee for belated payment of a renewal fee = 50% of the belated renewal fee ([Article 2\(1\), item 2, RFeesUPP](#))  
[Article 2\(1\), item 2, RFeesUPP](#)
- 15% reduction in renewal fee in cases the proprietor filed a statement with the EPO offering a licence of right ([Articles 8\(1\) and 11\(3\) Regulation \(EU\) No 1257/2012, Rule 12\(1\) UPR, Article 3 RFeesUPP](#)) [Articles 8 and 11\(3\) Regulation \(EU\) 1257/2012, Rule 12\(1\) UPR, Article 3 RFeesUPP](#)

**39** A Unitary Patent offers small and medium-sized enterprises (SMEs) and other small entities, which typically have only limited resources available, a simpler and more cost-effective route to broad and uniform protection for their inventions. A particular advantage of a Unitary Patent for these entities is the **compensation scheme**, which reduces translation costs for SMEs, natural persons, non-profit organisations, universities and public research organisations by providing for a lump-sum payment of EUR 500 ([see point 75 onwards](#)).

**40** Finally, as regards the **management of a Unitary Patent**, transfers, licences and other rights no longer have to be registered country by country in the national patent registers. Instead, a single registration entered in the Register for unitary patent protection centrally administered by the EPO is sufficient ([see points 114 and 118](#)). The same applies to statements regarding licences of right ([see point 123](#)). This considerably reduces administrative complexity, as the EPO operates under a single legal regime, also with regard to the kind of documents and evidence required. It also reduces the associated costs such as administrative fees or costs incurred in hiring multiple local agents.

## VI. The EPO's Unitary Patent Protection Division

### Introduction

**41** A "**Unitary Patent Protection Division**" has been set up at the EPO as a special department to deal with Unitary Patents. It is responsible for all the EPO's additional tasks relating to Unitary Patents referred to in [Article 9\(1\) Regulation \(EU\) No 1257/2012](#) and entrusted to it by the participating Member States under [Rule 1\(1\) UPR](#). [Article 143\(2\) EPC](#) [Rule 4 UPR](#)

**42** The EPO departments entrusted with the procedures laid down in the EPC, namely the search, examining and opposition divisions and the Boards of Appeal, will have no responsibilities in relation to Unitary Patents. In particular, actions against decisions of the Unitary Patent Protection Division must be brought before the Unified Patent Court (see [Articles 32\(1\)\(i\) and 47\(7\) UPCA](#)) and not before the EPO Boards of Appeal. [Article 32\(1\)\(i\) UPCA](#) [Article 47\(7\) UPCA](#)

### Decisions of the Unitary Patent Protection Division

**43** Decisions of the Unitary Patent Protection Division are taken by one legally qualified member. The President of the EPO may, however, entrust employees who are not legally qualified members with carrying out duties of the Unitary Patent Protection Division that involve no legal difficulties. [Rule 4\(3\) UPR](#) [Rule 4\(4\) UPR](#)

## **B HOW TO OBTAIN UNITARY PATENT**

### **I. The requirements**

**44** In order to be eligible for registration as a Unitary Patent, a European patent must have been granted with the **same set of claims in respect of all the 25 participating Member States** ([Article 3\(1\)](#) in conjunction with [Recital 7 Regulation \(EU\) No 1257/2012](#); [Rule 5\(2\) UPR](#)). This condition must be met irrespective of the number of participating Member States in which the UPCA will have taken effect at the date of registration of unitary effect by the EPO ([see point 23](#)). It is therefore important not to withdraw the designation of any of the 25 participating Member States because this would rule out obtaining a Unitary Patent. Moreover, a European patent should not contain a different set of claims for any of the participating Member States (see [Rule 138 EPC](#)), as this too would also prevent the EPO from registering a Unitary Patent ([Rule 5\(2\) UPR](#)). [Article 3\(1\) Regulation \(EU\) No 1257/2012](#) [Rule 5\(2\) UPR](#) [Rule 138 EPC](#)

### **II. The request for unitary effect**

#### **Form and time limit**

**45** As regards the procedure for obtaining a Unitary Patent, the proprietor of a European patent must file a formal "request for unitary effect" in writing with the EPO ([Rule 5\(1\) UPR](#)). It is strongly recommended that the dedicated **EPO Form 7000** be used to file the request. **The request must be filed no later than one month after the mention of the grant of the European patent is published in the European Patent Bulletin** (see [Article 9\(1\)\(g\) Regulation \(EU\) No 1257/2012](#); [Rule 6\(1\) UPR](#); [Article 97\(3\) EPC](#)). It is important to bear in mind that this is a non-extendable period ([see point 67](#) for the legal remedy available if it is not observed). The requester must be the proprietor mentioned in the European Patent Register at the date of filing of the request for unitary effect or, at the latest, at the date of registration of unitary effect. [Article 9\(1\)\(g\) Regulation \(EU\) No 1257/2012](#) [Rule 6\(1\) UPR](#) [Article 97\(3\) EPC](#)

**46** The request must be **duly signed**. It may be signed by the representative if one has been appointed. Where it is signed on behalf of a legal person, the signatory's position within that legal entity must also be indicated. If it is filed using Online Filing, the signature may be in the form of a facsimile, text string or enhanced electronic signature. If it is filed using Online Filing 2.0 or the web-form filing service, the signature may take the form of a facsimile signature or a text string signature. If it is filed on paper, it may be a handwritten signature or a reproduction of the filer's signature (on faxes).

[Rule 20\(2\)\(c\) UPR](#) [Rule 50\(3\) EPC](#)

**47** Where the request for unitary effect is filed on paper, one copy of the request itself must be filed; the receipt for documents (page 4 of the form for filing the request for unitary effect) must however be filed in triplicate. If it is filed online, no additional copies are necessary.

**48** A Unitary Patent can also be requested for a European patent granted to multiple proprietors in respect of the same or different participating Member States as long as it was granted with the same set of claims in respect of all those participating Member States.

**49** If there is more than one proprietor, the request for unitary effect should preferably **appoint one proprietor or representative as common representative**. If it does not name a common representative, the first-named requester will be deemed to be the common representative. However, if one of the requesters is obliged to appoint a professional representative, that representative is deemed to be the common representative unless the first-named requester has appointed a professional representative (see [Rule 151\(1\) EPC](#), which applies *mutatis mutandis* under [Rule 20\(2\)\(l\) UPR](#)).

[Rule 20\(2\)\(l\) UPR](#) [Rule 151\(1\) EPC](#)

**50** Only, however, if the request for unitary effect has been duly **signed** by all the proprietors (or their representative(s)) is their common representative entitled to act for them all. Multiple proprietors need not be listed in the request for unitary effect in the same order as in the request for grant (EPO Form 1001) or in the European patent specification.

**51** Please note that a co-proprietor of a European patent who owns that patent exclusively in respect of one or more EPC contracting states not territorially covered by the Unitary Patent scheme ([see point 23](#)) cannot request unitary effect or be designated as common representative. For instance, this will apply where the European patent is granted to a co-proprietor either exclusively for one or more EPC contracting states that are not participating Member States (e.g. Switzerland or the United Kingdom) or exclusively for one or more participating Member States in which the UPCA has not taken effect. Such a co-proprietor should therefore not be listed in the request for unitary effect.

#### **Mandatory information to be provided in the request for unitary effect**

**52** The request for unitary effect must contain the following information ([Rule 6\(2\) UPR](#)): [Rule 6\(2\) UPR](#)

- (a) particulars of the proprietor of the European patent making the request as provided for in [Rule 41\(2\)\(c\) EPC](#);
- (b) the number of the European patent to which unitary effect is to be attributed;
- (c) where the requester has appointed a representative, particulars as provided for in [Rule 41\(2\)\(d\) EPC](#).

## **C. COMPENSATION SCHEME**

### **I. Eligibility and procedure**

**75** Under certain conditions, proprietors of European patents with unitary effect for which the European patent application was filed in an **official EU language other than English, French or German** are entitled to compensation for their translation costs. [Article 9\(1\)\(f\) Regulation \(EU\) No 1257/2012](#) [Article 5 Regulation \(EU\) No 1260/2012](#)  
[Rule 8 UPR](#)

**76** To be eligible for this compensation, they must have their **residence or principal place of business in an EU Member State**. It does not matter if the Member State is not one participating in the Unitary Patent scheme. Furthermore, they must either be a natural person or fall within one of the following categories: [Rule 8\(1\) UPR](#) [Rule 8\(2\) UPR](#)

- small and medium-sized enterprises as defined in European Commission Recommendation 2003/361/EC dated 6 May 2003, or
- non-profit organisations as defined in Article 2(1)(14) of Regulation (EU) No 1290/2013, or
- universities or public research organisations.

**77** Universities and public research organisations are not expressly defined in any EU legislation, but a definition – as well as more details on the definitions of SMEs and non-profit organisations – can be found in the notice from the EPO dated 10 January 2014 ([OJ EPO 2014, A23](#)). [OJ EPO 2014, A23](#)

**78** Compensation is granted only at the express request of the patent proprietor. The request for compensation must be filed together with the request for unitary effect. It must contain a declaration that the proprietor is a natural person or one of the entities mentioned above. Both Form 7000 and the various online options for filing requests for unitary effect include a check box for making the required declaration of eligible status, making it easy in practice to request compensation. [Rule 9 UPR](#)

**79** If the request for compensation is submitted by the same entity as the one that filed the European patent application, the above eligibility criteria must be fulfilled at the time of filing the European patent application. [Article 5 Regulation \(EU\) No 1260/2012](#) [Recital 10 Regulation \(EU\) No 1260/2012](#)

**80** Where a request for compensation is submitted after ownership of the European patent application or European patent has changed (e.g. following a transfer or merger), compensation will be granted only if both the original applicant and the new proprietor (in the latter's case, at the time of requesting compensation) fulfil the eligibility criteria set out above (see [Rule 8\(4\) UPR](#)). [Rule 8\(4\) UPR](#)

**81** If there are multiple proprietors, compensation will be granted only if each proprietor fulfils the above-mentioned eligibility criteria ([Rule 8\(3\) UPR](#)). [Rule 8\(3\) UPR](#)

**82** The compensation scheme applies not only to Euro-direct applications filed at the EPO but also to Euro-PCT applications originally filed at a PCT receiving Office or the International Bureau in an EU official language that is not one of the EPO's official languages (see [Rule 8\(5\) UPR](#)). [Rule 8\(5\) UPR](#)

**83** The EPO will examine requests for compensation and then notify the proprietor whether or not it can be granted. The EPO cannot pay compensation until unitary effect has been entered in the Register for unitary patent protection ([Rule 10\(1\) UPR](#)). Once compensation has been granted, proprietors retain it regardless of any possible subsequent change in status, i.e. even if, for instance, they no longer fulfil the SME criteria or assign their Unitary Patent to a new proprietor who does not meet the above eligibility criteria (see [Rule 10\(2\) UPR](#)). [Rule 10\(1\) UPR](#) [Rule 10\(2\) UPR](#)

**84** The compensation amounts to EUR 500 and is paid as a lump sum (see [Rule 11 UPR](#) in conjunction with [Article 4\(1\) RFeesUPP](#)). It can be combined with a reduction in the filing or examination fee provided for under the EPC (see [Rule 6\(3\) to 6\(7\) EPC](#)). [Rule 11 UPR](#) [Article 4\(1\) RFeesUPP](#)

### **II. False declaration of eligibility**

**85** If the EPO has serious doubts about the correctness of the declaration filed with the request for compensation, e.g. on the basis of information received from a third party, it can review the grant of compensation and request that the beneficiary provide evidence that the eligibility criteria are met in proceedings under [Articles 113\(1\) and 114 EPC](#) (see [Rule 10\(3\) UPR](#)). [Rule 10\(3\) UPR](#) [Article 113\(1\) EPC](#) [Article 114 EPC](#)

**86** If, at the end of these proceedings, the EPO still believes that a false declaration has been made, it will inform the beneficiary under [Rule 10\(4\) UPR](#) that it has revised its decision to grant compensation and require payment of an **additional fee** with the next renewal fee for the Unitary Patent in question. This additional fee is composed of the amount of the compensation paid by the EPO, plus an administrative fee amounting to 50% of that compensation amount (see [Article 4\(2\) RFeesUPP](#)). If the additional fee is not paid in due time, the Unitary Patent will lapse under [Rule 14 UPR](#).

[Rule 10\(4\) UPR](#) [Rule 14 UPR](#) [Article 4\(2\) RFeesUPP](#)