

# Newsletter

## The European Patent Team

April 2005

### European Patent Office Fee, Rule and Procedural Changes

This paper outlines a broad range of recent and upcoming fee, rule and procedural changes announced by the European Patent Office (EPO). These changes relate mainly to search, examination and allowance, and to the filing and publication of applications and other documents. Final guidelines elaborating on some of the changes are still to be provided by the EPO, so please contact us if you have any questions or would like further details or updates on anything discussed in this paper.

James Sunderland – for further information e-mail [jimsunderland@haseltinlake.com](mailto:jimsunderland@haseltinlake.com)

### Summary of new EPO Fees effective in 2005

EPO Fees Applying to European and Euro-PCT Applications	Previous Fee Euro (€)	New Fee Euro (€)	Effective Date
Filing fee (Normal "on paper" filing)	125	160 <sup>[3]</sup>	1 January 2005
Filing fee (Online filing)	90	90 <sup>[3]</sup>	1 January 2005
Search fee *	690	960 <sup>[1]</sup>	1 July 2005
Examination fee applicable to European and Euro-PCT applications for which a search fee is payable **	1,430	1,280 <sup>[1]</sup>	1 July 2005
Examination fee applicable to Euro-PCT applications for which no search fee is payable **	1,430	1,430 <sup>[1]</sup>	1 July 2005
Fee for Further Processing	75	200 <sup>[2]</sup>	1 April 2005
Fee for Re-establishment of Rights	75	350	1 April 2005

EPO Fees Applying to International Applications	Previous Fee Euro (€)	New Fee Euro (€)	Effective Date
Fee for late furnishing of sequence listings	–	200	1 April 2005

\* We assume that search fee reductions will still apply to Euro-PCT applications for which the International search was carried out by certain International Search Authorities (e.g. JPO, KPO, USPTO – 20% reduction), and in other cases.

\*\* We anticipate that examination fee reductions will still apply to Euro-PCT applications for which no search fee is payable and International preliminary examination was carried out by the EPO (50% reduction), and in other cases.

### Summary of EPO Rule and Procedural changes effective in 2005

#### [1] Combining search and examination:

For European patent applications filed on or after 1 July 2005, to which the increased search fee (see Table above) will apply, an "extended" European search report will be issued. This will include a written opinion on whether the application meets the EPO requirements for patentability. An increased search fee will also apply to supplementary European searches for Euro-PCT applications – i.e. International applications which enter the European regional phase – which are based on International applications filed on or after 1 July 2005. Supplementary European search reports issued for such applications will also be extended to include written opinions on patentability.

The EPO hopes that issue of a written opinion at the search stage will encourage the applicant to act early, by argument, voluntary amendment to overcome problems mentioned in the written opinion, or even by early abandonment of the application if the outlook for success seems very poor. Early response to a written opinion could smooth subsequent examination and lead to faster completion of the application.

For European patent applications, and Euro-PCT applications for which a supplementary European search is required, the increased search fee effective 1 July 2005 will be partly offset by a lower examination fee. For Euro-PCT applications in respect of which no supplementary European search is required, and hence no search fee payable, a higher examination fee will still apply (see table).

The new provisions allow the written opinion accompanying the search report to be omitted if, instead, a normal examination report or notice of allowance can be issued. This is so if responsibility for the application has passed to an Examining Division of the EPO, rather than a Search Division. This would be the case if the applicant has requested examination and paid the examination fee before issue of the search report but has foregone the right to the invitation provided for by Article 96(1) EPC, so that the request for examination cannot be retracted on issue of the search report. This could also be the case if the provisions of Rule 112 EPC apply to the search report. In such special circumstances effectively replacing the written opinion by a normal examination report or notice of allowance, subject to a term for response, will more encourage rapid completion of the application.

### **[2] Shortening allowance procedures:**

At present, under Rule 51(4) EPC, the term for filing translations of the claims (and paying grant and printing fees) on allowance of the application can be extended on request, at no cost, by two months. Rule 51(4) EPC will be amended so that such extension will no longer be available. This will apply where the Communication under Rule 51(4) EPC – the notice of allowance – is issued on or after 1 April 2005. The possibility of using “further processing” to extend the term will still be available, though an increased further processing fee will apply (see table).

Removal of the opportunity for free extension of the Rule 51(4) term clearly presses the applicant to complete allowance procedures in a timely manner. The increased fee for further processing may discourage applicants from using the further processing option to obtain extensions of time, not only in allowance procedures but also at other points in the application process.

### **[3] Less paper:**

From 1 April 2005, European patent applications, search reports and the specifications of European patents will no longer be published in paper form. They will be published online only. The written opinions included in extended search reports will not be published even in online form (although they should be included in online file histories). The certificate for a European patent will in future be issued to the applicant without a paper copy of the European patent specification, unless a copy is specifically requested within the term set under Rule 51(4) EPC for filing translations of the claims on allowance of the application. This will apply to all applications for which the Communication under Rule 51(4) EPC is issued on or after 1 April 2005.

Effective 1 February 2005, the scope for fax filing of applications and other documents – without need for subsequent confirmation by “original” documents unless specifically requested by the EPO – was widened. We note, however, that the risks of incomplete or imperfect document reception associated with fax transmission are still carried by the applicant and there are still some documents which cannot be filed by fax. (Also effective 1 February 2005, filing of European patent applications and other documents by telex and some other out-dated modes of communication is no longer permitted.)

The fee for normal (“on paper”) filing of European and Euro-PCT applications increased earlier this year, but the fee for online filing did not (see table), a measure clearly intended to encourage online filing. Beyond this, the EPO offers an increasing range of other online services through “epoline®” ([www.epoline.org](http://www.epoline.org)), including secure online patent attorney access to non-public file histories of their cases and electronic issue of some official communications. Future plans for further services encompass provisions for secure online filing of a wider range of documents and more extensive issue of official communications by secure electronic means, with the ultimate aim of enabling essentially all transactions to be effected online.

### **[4] Technical rule correction:**

Effective 1 April 2005, a new paragraph (4) will be added to Rule 108 EPC to remove a flaw in the provisions relating to Euro-PCT applications, i.e. entry into the European regional phase of International applications. The flaw could in some circumstances have the effect of preventing the applicant adding designated countries at a relatively late stage by paying designation fees together with surcharge fees. With the new paragraph in place the possibility of adding designated countries at a relatively late stage will be the same for all Euro-PCT applications.

### **JAMES SUNDERLAND, Partner – Munich**

*UK and European Patent Attorney*

*MA in Physics “Electronics and Solid State Physics” (Oxford University)*

Jim has wide experience in the fields of electronics and solid state devices, and in relation to computers and software. He also has extensive experience of all aspects of European Patent Office practice in particular, hearings at the European Patent Office before first-instance Examining and Opposition Divisions, and also before the Boards of Appeals. Jim has broad experience of dealing with procedural and legal issues which can arise in connection with European patents and applications, at the first-instance level of decision making and before the Legal Board of Appeal.



*for further information e-mail [jimsunderland@haseltinlake.com](mailto:jimsunderland@haseltinlake.com)*

Email [hl@haseltinlake.com](mailto:hl@haseltinlake.com) [www.haseltinlake.com](http://www.haseltinlake.com)

London: Imperial House, 15 – 19 Kingsway, London WC2B 6UD  
Tel: +44 (0) 20 7420 0500 Fax: +44 (0) 20 7420 0505

Leeds: West Riding House, 67 Albion Street, Leeds LS1 5AA  
Tel: +44 (0) 113 233 9400 Fax: +44 (0) 113 233 9401

Munich: Rosenheimer Strasse 30, D-81669 Munchen, Germany  
Tel: +49 (0) 89 6227 1760 Fax: +49 (0) 89 485 686

Bristol: Redcliff Quay, 120 Redcliff Street, Bristol BS1 6HU  
Tel: +44 (0) 117 910 3200 Fax: +44 (0) 117 910 3201